

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SANDPIPER CDN, LLC,
Patent Owner.

Case IPR2025-00969
Patent No. 8,478,903

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

TABLE OF CONTENTS

I. Introduction.....1

II. The Office’s “Material Error” During Prosecution Favors Referral.....3

III. Settled Expectations Also Favor Referral6

 A. Patent Owner Cannot Reasonably Contend the Age of Its Patent
 Should Immunize That Patent from Review7

 B. That the ’903 Patent Has Expired Weighs Even Further in
 Favor of Referral11

 C. Any “Settled Expectations” in This Case Favor Google15

IV. The *Fintiv* Factors Favor Referral16

 A. Factor 1: whether the court granted a stay or evidence exists
 that one may be granted if a proceeding is instituted.....16

 B. Factor 2: proximity of the court’s trial date to the Board’s
 projected statutory deadline for a final written decision.....19

 C. Factor 3: investment in the parallel proceeding by the court and
 the parties19

 D. Factor 4: overlap between issues raised in the petition and in the
 parallel proceeding21

 E. Factor 5: whether the petitioner and the defendant in the parallel
 proceeding are the same party23

 F. Factor 6: other circumstances that impact the Board’s exercise
 of discretion, including the merits.....24

V. Patent Owner’s Merits-Based Arguments Should Be Rejected24

VI. Google’s Reliance on Expert Testimony Is Not Excessive or Improper26

 A. The Petition Does Not Rely On Expert Testimony to Fill Gaps.....26

 B. Patent Owner Has Not Presented Competing Expert Testimony27

C. Criticizing Reliance on Expert Testimony Contradicts the
AIA’s Particularity Requirements and Ignores That
Testimony’s Role in Providing Substantial Evidence.....29

VII. Compelling Economic and Public Interest Concerns Favor Referral30

A. Compelling Economic Interests Favor Institution30

B. Compelling Public Interests Favor Referral.....31

VIII. Conclusion33

TABLE OF AUTHORITIES

	Page(s)
Federal Cases	
<i>Apple Inc. v. Gesture Tech. Partners, LLC</i> , 127 F.4th 364 (Fed. Cir. 2025)	14
<i>Belden Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	28
<i>Brand v. Miller</i> , 487 F.3d 862 (Fed. Cir. 2007)	28
<i>Celgene Corp. v. Peter</i> , 931 F.3d 1342 (Fed. Cir. 2019)	7
<i>Genetics Inst., LLC v. Novartis Vaccines & Diagnostics, Inc.</i> , 655 F.3d 1291 (Fed. Cir. 2011)	14
<i>Icon Health & Fitness, Inc. v. Strava, Inc.</i> , 849 F.3d 1034 (Fed. Cir. 2017)	28
<i>Ingenico Inc. v. IOENGINE, LLC</i> , 136 F.4th 1354 (Fed. Cir. 2025)	22-23
<i>Inwood Lab 'ys, Inc. v. Ives Lab 'ys, Inc.</i> , 456 U.S. 844 (1982)	28
<i>Kirwa v. U.S. Dep't of Def.</i> , 285 F. Supp. 3d 21 (D.D.C. 2017)	6
<i>Koninklijke Philips N.V. v. Google LLC</i> , 948 F.3d 1330 (Fed. Cir. 2020)	26, 27
<i>KSR Int'l Co. v. Teleflex, Inc.</i> , 550 U.S. 398 (2007)	26
<i>Lynk Labs, Inc. v. Samsung Elecs. Co.</i> , 125 F.4th 1120 (Fed. Cir. 2025)	23

<i>Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC</i> , 584 U.S. 325 (2018)	13
<i>Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.</i> , 24 F.4th 1406 (Fed. Cir. 2022)	29
<i>Realtime Data LLC v. Teradata Operations, Inc.</i> , No. 2:16-cv-02743, 2017 WL 3453295 (C.D. Cal. Feb. 27, 2017)	20
<i>SAS Inst., Inc. v. Iancu</i> , 584 U.S. 357 (2018)	8
<i>Shoes by Firebug LLC v. Stride Rite Children’s Grp., LLC</i> , 962 F.3d 1362 (Fed. Cir. 2020)	29
<i>Tafas v. Dudas</i> , 511 F. Supp. 2d 652 (E.D. Va. 2007)	6
<i>Trs. of Columbia Univ. in City of N.Y. v. Illumina, Inc.</i> , 620 F. App’x 916 (Fed. Cir. 2015)	28
<i>Yorkey v. Diab</i> , 601 F.3d 1279 (Fed. Cir. 2010)	28
P.T.A.B. Cases	
<i>Anthony Inc. v. ControlTec, Inc.</i> , IPR2025-00559, Paper 12 (P.T.A.B. July 16, 2025)	2, 4
<i>Apple Inc. v. Ferid Allani</i> , IPR2025-00856, Paper 11 (P.T.A.B. Sept. 5, 2025)	11
<i>Apple Inc. v. Gesture Tech. Partners, LLC</i> , IPR2021-00922, Paper 10 (P.T.A.B. Nov. 29, 2021)	13, 14
<i>Berkshire Hathaway Energy Co. v. Birchtech Corp.</i> , IPR2025-00274, Paper 23 (P.T.A.B. July 2, 2025)	24
<i>Dabico Airport Sols. Inc. v. AXA Power ApS</i> , IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025)	10, 18
<i>Ecto World, LLC v. Rai Strategic Holdings Inc.</i> , IPR2024-01280, Paper 13 (P.T.A.B. May 19, 2025)	1, 3

<i>Eunsung Glob. Corp. v. HydraFacial LLC</i> , IPR2025-00445, Paper 14 (P.T.A.B. July 10, 2025)	3
<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-00806, Paper 13 (P.T.A.B. Sept. 12, 2025)	1, 11, 16, 18
<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-00826, Paper 14 (P.T.A.B. Sept. 12, 2025)	1, 16, 18
<i>Globus Med., Inc. v. Spinelogik, Inc.</i> , IPR2025-00226, Paper 8 (P.T.A.B. June 12, 2025)	11
<i>Inari Agric., Inc. v. Corteva Agrisci. LLC</i> , IPR2024-01014, Paper 15 (P.T.A.B. Dec. 16, 2024)	13
<i>Mercedes-Benz Grp. AG v. Phelan Grp., LLC</i> , IPR2025-00413, Paper 13 (P.T.A.B. June 25, 2025)	9
<i>Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH</i> , IPR2025-00318, Paper 9 (P.T.A.B. June 12, 2025)	<i>passim</i>
<i>Motorola Solutions, Inc. v. Stellar, LLC</i> , IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025)	23
<i>NHK Spring Co. v. Intri-Plex Tech., Inc.</i> , IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018)	8
<i>Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.</i> , IPR2025-00531, Paper 10 (P.T.A.B. July 17, 2025)	2, 10, 11
<i>Skullcandy, Inc. v. Earin AB</i> , IPR2025-00690, Paper 9 (P.T.A.B. July 31, 2025)	24
<i>Tesla, Inc. v. Charge Fusion Techs., LLC</i> , IPR2025-00152, Paper 11 (P.T.A.B. June 12, 2025)	3-4
<i>Tesla v. United States of Am. as represented by the Sec'y of the Navy</i> , IPR2025-00341, Paper 12 (P.T.A.B. June 13, 2025)	8, 19
<i>Xencor, Inc. v. Merus N.V.</i> , IPR2024-00604, Paper 12 (P.T.A.B. July 17, 2025)	3, 5, 10

Statutes

5 U.S.C. § 706(2)(A)	7
35 U.S.C. § 101	18, 19, 21
35 U.S.C. § 286	14
35 U.S.C. § 311	14
35 U.S.C. § 311(a)	30
35 U.S.C. § 311(b)	14
35 U.S.C. § 311(c)	8
35 U.S.C. § 312(a)(3)(B)	29
35 U.S.C. § 315	13, 14
35 U.S.C. § 315(b)	8, 12
35 U.S.C. § 315(e)	22
35 U.S.C. § 316(a)	30
AIA § 3(n)(1)	7
AIA § 6(f)(2)(A)	7
AIA § 18(a)(3)	7

Regulations

37 C.F.R. § 42.100(b)	13, 14
-----------------------	--------

Legislative Materials

H.R. Rep. No. 112-98, pt. 1 (2011)	7, 8
------------------------------------	------

Other Authorities

83 Fed. Reg. 51341 (Oct. 11, 2018)	14
------------------------------------	----

I. Introduction

This case should be referred to the Board for evaluation of the Petition on the merits. As Patent Owner acknowledges, the '903 patent expired in 2023. While in force, the '903 patent was never asserted against Google nor any other party. Only after its expiration did Patent Owner acquire the patent and file suit in district court. Google thus had settled expectations of non-enforcement of the '903 patent, favoring referral. And the parallel district court proceeding has been stayed pending a decision whether to institute Google's IPR requests, further weighing against discretionary denial. The Director recently referred petitions in related proceedings under nearly identical circumstances. *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00806, Paper 13 at 2-3 (P.T.A.B. Sept. 12, 2025); *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00826, Paper 14 at 2-3 (P.T.A.B. Sept. 12, 2025). The same result is appropriate here.

The Office also committed a "material error during patent examination" when it failed to find, consider, and evaluate highly pertinent prior art showing the unpatentability of the challenged claims. *See, e.g., Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9 at 3 (P.T.A.B. June 12, 2025); *Ecto World, LLC v. Rai Strategic Holdings Inc.*, IPR2024-01280, Paper 13 at 5 (P.T.A.B. May 19, 2025) (precedential). Indeed, the Petition relies on a nearly anticipatory reference, Kenner, that the Examiner failed to identify and apply to the

pending claims during prosecution. While U.S. counterparts to Kenner were listed on an IDS and thus at the Examiner's disposal, there is no evidence they were ever analyzed. As the Director has reasoned, "it is an appropriate use of Office resources to review [such] potential error." *Microsoft*, IPR2025-00318, Paper 9 at 3.

Instead of addressing such material error, Patent Owner cites its own purported "settled expectations" to suggest denial is more appropriate. But as the Director has advised in the related proceedings, settled expectations favor Google. Regardless, any expectations Patent Owner may have had are outweighed by other factors, such as a material error committed by the Examiner during prosecution or a lack of commercialization by patent owner, as present here. *See Anthony Inc. v. ControlTec, Inc.*, IPR2025-00559, Paper 12 at 2 (P.T.A.B. July 16, 2025) (finding material error outweighed settled expectations); *see also Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00531, Paper 10 at 3 (P.T.A.B. July 17, 2025) (finding that a lack of commercialization or assertion outweighed settled expectations). Patent Owner has not shown that denial is the appropriate remedy here.

Patent Owner's remaining arguments regarding *Fintiv*, the Petition's merits, the Petition's prototypical reliance on expert testimony, and economic and public

interest factors are likewise unavailing. The Director should decline to exercise her discretion and refer the Petition to the Board.

II. The Office’s “Material Error” During Prosecution Favors Referral

The Office committed a “material error” during prosecution when it failed to find, consider and evaluate pertinent prior art showing the unpatentability of the challenged claims, despite U.S. counterpart applications to Kenner (the Petition’s primary reference) being listed in an IDS. *See, e.g., Microsoft*, IPR2025-00318, Paper 9 at 3; *Ecto World*, IPR2024-01280, Paper 13 at 5; *Xencor, Inc. v. Merus N.V.*, IPR2024-00604, Paper 12 at 3 (P.T.A.B. July 17, 2025). The Director has consistently found that such an error by the Office can outweigh other factors that may otherwise favor denial. *Microsoft*, IPR2025-00318, Paper 9 at 3 (finding “it is an appropriate use of Office resources to review the potential error,” and reasoning this error required review, even though the parties had a trial date “preced[ing] the date projected for a Board final written decision”); *Eunsung Glob. Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14 at 2-3 (P.T.A.B. July 10, 2025) (finding “Petitioner provides persuasive reasoning” that denial is not appropriate “due to a material error in examination,” even though the challenged patent “issued in 2017, and this would ordinarily favor denying institution”); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11 at 2 (P.T.A.B. June 12, 2025) (referring and finding the “[p]etitioner provides persuasive evidence that the

Office erred in a manner material to the patentability of the challenged claims by overlooking the teachings of [a prosecution reference]”); *Anthony*, IPR2025-00559, Paper 12 at 2 (referring and finding showing of material error favored referring to panel for both 17- and 18-year-old patents). The same result is appropriate here.

Kenner was publicly available to the Examiner during prosecution of the ’903 patent. *See, e.g.*, EX-1005, Cover (published December 19, 1996); EX-1001, Cover (application maturing as the ’903 patent filed in 2005 and issuing in July 2013). Later-filed U.S. counterparts to Kenner were cited by the Applicant in an IDS, but the Examiner merely initialed these references in bulk and overlooked the material teachings of these references. EX-1002, 4, 629, 647, 657-59.

Indeed, Kenner—and its U.S. counterparts before the Examiner—disclose the very subject matter the Examiner found allowable. The Examiner allowed the application after Applicant amended the independent claims to incorporate the subject matter of dependent claim 53 deemed allowable: “analyz[ing], using the table, an alias name received with a client request for a particular resource to determine a content provider associated with the particular resource.” EX-1002, 210; *Id.*, 214, 217, 219-220 (including similar recitations). However, as explained in the petition, Kenner discloses cache servers that perform this form of analysis

using a table. Paper 1 at 24-25 (citing EX-1005, 41:13-15). Kenner's U.S. counterparts do too. EX-1029, 27:32-36; EX-1030, 28:56-63.

The Examiner materially erred by failing to identify Kenner's teachings of this subject matter. *See Microsoft*, IPR2025-00318, Paper 9 at 3 (finding the Office materially erred by failing to identify and thus "overlooking the teachings" of two prior art references and by failing to consider those references in combination with those that were already before the Office). And despite allowing the claims after finding analysis using a table was missing from the prior art, the Examiner never attempted any form of search including the term "table" or similar terms. EX-1002, 39-43, 119-143. This search would have at least identified Kenner's U.S. counterparts from among the references already present before the Examiner. *See, e.g.*, EX-1029, 14:12-16 (referring to an "IM List" shown in Table 1); EX-1030, 13:35-39 (same).

There is no evidence that the Examiner ever properly analyzed or even considered Kenner's U.S. counterparts listed in the IDS before deeming the subject matter allowable. EX-1002, at 24. The Examiner's failure to analyze the Kenner family of references and consider and apply a rejection based on Kenner constitutes material error favoring referral. *Xencor*, IPR2025-00604, Paper 12 at 2 (referring and finding material error when a reference cited in an IDS during prosecution taught the element cited as the basis for allowance).

III. Settled Expectations Also Favor Referral

Ignoring the material error by the Office during prosecution, Patent Owner instead contends that purported “settled expectations” favor denial in this case. *See, e.g.*, Paper 5 at 17-20. Not so. Importantly, the ’903 patent is expired, so, if anything, Google had a settled expectation that its Cloud CDN product, which was publicly known and launched nearly a decade ago, and its Media CDN, which launched in 2021, would not be accused of infringing a patent that the patent owner sat on for years until after the patent expired. Any settled expectations favor referral.¹

¹ The Director’s application of “settled expectations” is improper. For example, retroactively applying “settled expectations” as a basis to deny Google’s already-filed petition violates both the APA and Due Process. *See, e.g., Tafas v. Dudas*, 511 F. Supp. 2d 652, 666 (E.D. Va. 2007) (“[R]etroactivity is not favored in the law”); *Kirwa v. U.S. Dep’t of Def.*, 285 F. Supp. 3d 21, 41 (D.D.C. 2017) (“Any retroactive policy must have “sufficiently significant statutory interests” to counterbalance any “resulting inequities” from the retroactive agency action.” (citations omitted)). The Director’s application of “settled expectations” also exceeds her authority under the law and is barred by judicial estoppel based on the Office repeatedly advancing the position that a patentee lacked an expectation that

A. Patent Owner Cannot Reasonably Contend the Age of Its Patent Should Immunize That Patent from Review

Patent Owner contends “settled expectations” weigh in its favor because the ’903 patent has purportedly been “in force for many years.” *See id.* at 17. But Patent Owner’s argument runs afoul of governing IPR statutes. When Congress wanted to immunize patents of a certain age from any post-issuance challenges, it has expressly done so. When designing the regime for *inter partes* reexamination, for example, Congress expressly immunized (that is, carved out) “patents issued before 1999” from review. *See* H.R. Rep. No. 112-98, pt. 1, at 46-48 (2011). Congress similarly immunized patents of a certain age when it created the PGR procedure, restricting those challenges to patents with post-AIA effective filing dates, in turn foreclosing this avenue of review for older patents. *See, e.g.*, AIA §§ 3(n)(1), 6(f)(2)(A).²

Yet for IPRs, Congress took the opposite approach. Congress “eliminated” the *inter partes* reexamination date-based carveout so that, instead, “*all patents can*

its patents would not be challenged. *See Celgene Corp. v. Peter*, 931 F.3d 1342, 1361-62 (Fed. Cir. 2019); *see also* 5 U.S.C. § 706(2)(A).

² Congress also enacted a sunset provision for challenging covered business method (CBM) patents. *See, e.g.*, AIA § 18(a)(3).

be challenged in *inter partes* review,”³ regardless of age. *See* H.R. Rep. No. 112-98, at 46-48. And rather than restrict *inter partes* review based on a patent’s age or priority date, Congress only required a petitioner to wait for the nine-month PGR window to expire (to the extent applicable) (35 U.S.C. § 311(c)) and file within one year of being served with a complaint (§ 315(b)). “Congress’s choice to depart from the model of a closely related statute is a choice neither we nor the agency may disregard.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 364 (2018).

Patent Owner’s settled-expectations arguments also run afoul of Board precedent. In *NHK Spring*, for example, the Board held that a ten-year delay in challenging a patent *was not enough to preclude an otherwise timely challenge* to the patent in the absence of evidence the petitioner received a “tactical advantage” because it waited to file its petition. *NHK Spring Co. v. Intri-Plex Tech., Inc.*, IPR2018-00752, Paper 8 at 19-20 (P.T.A.B. Sept. 12, 2018) (precedential).⁴ Here,

³ All emphasis added unless otherwise indicated.

⁴ Likewise, the Director has referred cases with patents in force longer than the ’903 patent, given the complexities of the case. *See, e.g., Tesla, Inc. v. United States of Am. as represented by the Secretary of the Navy*, IPR2025-00341, Paper 12 (P.T.A.B. June 13, 2025) (no discretionary denial despite 18-year-old patent); *Tesla*

there is no allegation that the timing of Google’s Petition filing provided Google with any tactical advantage. The only party receiving a tactical advantage here is Patent Owner, who has asserted a patent that was not asserted by its predecessors for a decade, while Google spent years developing and bringing products to market. Patent Owner cannot now cry foul because Google is challenging its patent after Patent Owner sued Google for infringement.

But even if Patent Owner could rely on the age of its patent, the Director’s March 26, 2025, Memo suggests that settled expectations are only decided based on “the length of time the claims have been in force.” *See* EX-2013, 2. Here, the ’903 patent issued in 2013, *and expired in 2023*, making the “length of time the claims have been in force” 10 years. *See* EX-1001, cover. The Director has referred to the Board for further evaluation challenges for patents that have been in force for similar durations. *See Mercedes-Benz Grp. AG v. Phelan Grp., LLC*, IPR2025-00413, Paper 13 at 2 (P.T.A.B. June 25, 2025) (referring to panel where patent in force over 8 years). And regardless, the duration that a patent is in force is

v. Intel. Ventures II, IPR2025-00217, Paper 9 (P.T.A.B. June 13, 2025) (no discretionary denial despite 14-year-old patent).

routinely outweighed by other factors present here.⁵ *See Xencor*, IPR2024-00604, Paper 12 at 3 (referring although “patent ha[d] been in force for approximately nine years” when “Office materially erred during prosecution”).

Patent Owner does not assert in the co-pending district court litigation that it owns any product practicing the '903 patent claims. EX-1031, 8-9. Patent Owner does not present any evidence of commercialization of such products. Nor has Patent Owner pointed to any marking or licensees of the patent. Instead, Patent Owner only recently acquired the patent in 2024—after its expiration. *See* EX-1027. And the patent’s previous owners never asserted it over the decade it was in force. Thus, it was not until 2024 that Petitioner had any awareness of Patent Owner’s mistaken belief of the patent’s claim scope.

These factors outweigh any of Patent Owner’s purported settled expectations. In *Shenzhen*, for example, a patent challenged in an IPR had been in force for approximately 10 years. *See Shenzhen*, IPR2025-00531, Paper 10 at 3. However, the Director referred the Petitions to the Board, finding that Petitioner’s evidence the patent was never “commercialized, asserted, marked, licensed, or

⁵ In this way, this case is distinguishable from *Dabico*, cited in Patent Owner’s brief. *See, e.g.*, Paper 5 at 17-18 (citing *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025)).

otherwise applied” weighed against any settled expectations. *Id.* The same result is appropriate here.

B. That the ’903 Patent Has Expired Weighs Even Further in Favor of Referral

Patent Owner also contends that settled expectations weigh in its favor, because it would be a waste of judicial resources for the Board to examine an expired patent. Paper 5 at 1, 16-20. However, it was Patent Owner that chose to acquire an expired patent and assert it in district court. *See* EX-1027. Patent Owner cannot now use the patent’s expired status as a shield against validity challenges, especially when the patent was never previously asserted or commercialized. *See Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 at 3 (P.T.A.B. Sept. 5, 2025) (referring where “Patent Owner did not assert the challenged patents against Petitioner until after they expired”); *Shenzhen*, IPR2025-00531, Paper 10 at 3. And regardless, the Director has referred petitions that have challenged an expired patent in similar circumstances. *See Google*, IPR2025-00806, Paper 13 at 2-3 (citing *Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00226, Paper 8 at 2 (P.T.A.B. June 12, 2025) (referring to panel where patent had expired and, “accordingly, [petitioner] expected nonenforcement of the challenged patent”). A reasonable party would not expect a patent that expired in 2023 to be highly likely to be asserted in a litigation. *Id.*

Moreover, it is unreasonable to expect would-be petitioners to file post-grant review challenges against any known patent regardless of whether the patentee has threatened litigation or asserted the patent against others. At a minimum, this runs contrary to the statutory scheme, which contemplates petitioners filing challenges within one year of being served with a complaint that alleges infringement, regardless of how long the patent has been in force. *See, e.g.*, 35 U.S.C. § 315(b). It also runs contrary to the realities and actual expectations of patent owners and petitioners over the past decade, where the vast majority of post-grant challenges have come *only after* patent owners have alleged infringement in a co-pending district court litigation.⁶ It also runs contrary to the well-established practice that defendants could challenge patent validity in district court or in reexamination proceedings. Given this history, Patent Owner cannot reasonably contend (nor does it try to contend) that it did not expect the '903 patent to be challenged in an IPR within one year of it serving its complaint, because that is precisely how these disputes have proceeded since the AIA took effect.

⁶ As the Board's statistics show, over 80% of patents involved in post-grant challenges are involved in co-pending litigation. *See, e.g.*, EX-1022, 3; EX-1023, 10.

The Board has also expressly rejected Patent Owner’s “waste of resources” argument in similar circumstances. In *Inari Agriculture*, for example, the patent owner sought denial of institution of an expired patent to “preserve administrative efficiency.” *Inari Agric., Inc. v. Corteva Agrisci. LLC*, IPR2024-01014, Paper 15 at 24 (P.T.A.B. Dec. 16, 2024). The Board correctly recognized there was “no good reason” to discretionarily deny “a second look at an earlier administrative grant of a patent” merely because the patent expired, and instituted. *Id.* (citing *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 584 U.S. 325, 336 (2018)). The Board explained that “[t]he statutes and our Rules governing *inter partes* review do not exclude expired patents or those not subject to civil actions.” *Id.* (citing 35 U.S.C. §§ 311, 315; 37 C.F.R. § 42.100(b)).

The Board in *Apple* similarly held that it has authority to review expired patents. *See Apple, Inc. v. Gesture Tech. Partners, LLC*, IPR2021-00922, Paper 10 at 17-19 (P.T.A.B. Nov. 29, 2021). Like *Inari*, the Board in *Apple* found that the Supreme Court has endorsed a second look at granted patents, and found that (1) the PTAB rules make clear that IPRs cover expired patents, and (2) statutes governing IPR proceedings *do not limit IPRs to non-expired patents*, even though

they impose other limitations. *Id.* (citing 37 C.F.R. § 42.100(b) (2012); 83 Fed. Reg. 51341 (Oct. 11, 2018); 35 U.S.C. § 311(b), (c); 35 U.S.C. § 315).⁷

Patent Owner’s argument that “[t]he subject matter of this patent is already available to the public” is also misplaced. Paper 5 at 19. If this were true, Patent Owner would have no rights to sue Google. But this is not the case—Patent Owner is currently asserting the ’903 patent in district court. *See Genetics Inst., LLC v. Novartis Vaccines & Diagnostics, Inc.*, 655 F.3d 1291, 1299 (Fed. Cir. 2011). The fact that a patent expired does not automatically convert that patent to the public when retroactive damages are still available. *See* 35 U.S.C. § 286.

The Federal Circuit has confirmed as much. *See Apple Inc. v. Gesture Tech. Partners, LLC*, 127 F.4th 364, 369 (Fed. Cir. 2025). The Federal Circuit explained, “although a patentee has fewer rights when its patent has expired, *it nevertheless maintains some rights, such as bringing an action for past damages.*” *Id.* (cleaned up). As such, the Federal Circuit stated that the Board’s interest in “protect[ing] the public’s paramount interest in seeing that patent monopolies are kept within their

⁷ Patent Owner cites a pending certiorari petition questioning the propriety of having the Board review expired patents. Paper 5 at 18 n.1. But until the Supreme Court suggests such a practice is improper (or a “waste of resources”), review of expired patents remains the status quo.

legitimate scope” extends beyond the patent’s expiration date. *Id.* (cleaned up).

And that includes allowing *inter partes* review of expired patents. Patent Owner’s arguments do not support discretionary denial in this case. *See* Paper 5 at 1, 16-20.

C. Any “Settled Expectations” in This Case Favor Google

Here, “settled expectations” favor Google and weigh against discretionary denial. Patent Owner accuses Google’s Cloud CDN and Media CDN of infringing. EX-1028, 4. Cloud CDN launched around June 2016, becoming known and available to the public at that time. Instead of taking any action, the prior owner of the ’903 patent never asserted it against Google or any other party. Years later, the current Patent Owner acquired the patent—after it expired—and filed suit in an opportunistic bid to capitalize on it. This “weighs against Patent Owner’s claim of strong settled expectations.” *See Shenzhen*, IPR2025-00531, Paper 10 at 3 (that the “challenged patent[] ha[s] never been ‘commercialized, asserted, marked, licensed, or otherwise applied’ in petitioner’s ‘particular technology space’” weighs against discretionary denial).⁸ The delay of the ’903 patent owners created settled

⁸ There is also no evidence Patent Owner commercialized a product. *See Shenzhen*, IPR2025-00531, Paper 10 at 3. At most, Patent Owner identifies the activity of its predecessors, before Patent Owner came to own the patent in April 2024. *See* Paper 5 at 2-5.

expectations for Google. Indeed, it is reasonable for a defendant to think that any dispute regarding its products would be brought soon (if ever) after a patent issued or even after the accused products launched, rather than a decade later.⁹

IV. The *Fintiv* Factors Favor Referral

A. Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

Factor 1 weighs in favor of referral because, as the Office has already recognized, “the parallel district court proceeding involving the parties has been stayed pending a decision whether to institute review of Petitioner’s *inter partes* review” requests. *Google*, IPR2025-00806, Paper 13 at 2; *Google*, IPR2025-00826, Paper 14 at 2. Patent Owner incorrectly contends that “[t]here is no stay of proceedings in the parallel district court case.” *See* Paper 5 at 21. The district court granted a stay in the parties’ parallel litigation pending the issuance of the Board’s discretionary denial decisions (a “pause”) except for the completion of claim construction discovery, which concluded July 18, 2025. EX-2006, 2-5. All aspects of the case have been paused, with the exception of the scheduled date of trial. *Id.* Consistent with standard practice in the Central District of California, the district

⁹ Regardless, Patent Owner only came into possession of the ’903 patent in 2024. *See* EX-1027. Patent Owner cannot assert it had any settled expectation before its ownership. *See* Paper 5 at 1, 16.

court also agreed to stay the case *in its entirety* if the Board institutes the pending IPRs, in large part because Patent Owner indicated that it “will agree” to such a stay if all IPRs are instituted. *Id.* Supporting a full stay, the district court found the parties “generally agree that *no undue prejudice would arise* from a post-institution stay.” *Id.* at 4.

Unlike other cases that present a binary choice between a stay being granted and not being granted, this case presents a unique scenario where the district court issued a partial stay, limiting the court’s schedule in deference to the Board. *Id.* (“After the close of claim construction discovery, which will be useful to both this case and any hypothetical PTAB proceedings, the Court orders a pause on claim construction and discovery work until the PTAB issues its discretionary denial decisions.”); *id.* at 3 (explaining “Google’s IPR petitions address all asserted claims, so if the PTAB institutes proceedings, *such proceedings could simplify the issues in this case. This is true even if all claims survive the IPRs* because the parties’ ... positions before the PTAB *could streamline claim construction proceedings before this Court, the Court will have the benefit of the PTAB’s expert review*, and Google will be estopped from raising certain invalidity grounds ... , narrowing the issues before the Court.”). This weighs in favor of referral.

Patent Owner's remaining arguments¹⁰ related to settled expectations do not relate to *Fintiv* Factor 1 and are without merit for the reasons discussed above. *See* Paper 5 at 21-22. Indeed, Patent Owner assumed it was a foregone conclusion that the proceedings in this IPR (IPR2005-00969), IPR2025-00806, and IPR2025-00826 would be denied because they involve expired patents that have purportedly been in force for over a decade, and as such, a stay will never occur because not all patents will be addressed by the Board in an *inter partes* review proceeding. *Id.* at 21. But the Director has rejected this reasoning for IPR2025-00806 and IPR2025-00826, referring both to the Board. *Google*, IPR2025-00806, Paper 13 at 2-3; *Google*, IPR2025-00826, Paper 14 at 2-3. Patent Owner's citation to *Dabico*, IPR2025-00408, Paper 21, does not require a different outcome because *Dabico* did not address expired patents. *See* Paper 5 at 21. Patent Owner's reference to the patents at issue in IPR2025-00846 and IPR2025-00952 being found ineligible under 35 U.S.C. § 101 also has no bearing in this case. *See id.* at 21-22. Nor does it disturb the existing pause or subsequent stay should the Board grant institution on the other patents because those two patents are no longer at issue in the litigation. *See* EX-2006, 2.

¹⁰ Patent Owner's arguments on the merits are addressed below in Section V. *See* Paper 5 at 22.

B. Factor 2: proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision

Factor 2 is neutral. Trial in the litigation is set for September 28, 2026—two months before the anticipated Final Written Decision. However, because fact discovery has already been paused for at least three months, the trial date will likely be delayed to allow sufficient time for the parties to complete fact and expert discovery if the stay is lifted. *See id.* at 3, 5. And Patent Owner has already agreed to a stay in district court if all IPRs are instituted. *Id.* at 3.

The PTAB cases Patent Owner relies on are not dispositive. *See* Paper 5 at 23. For example, the Director has determined that the complexity of the parallel litigation may outweigh the proximity of a trial date. *See Tesla*, IPR2025-00341, Paper 12. That is the case here. Not including the patents already found ineligible under § 101, the parties’ litigation involves at least five distinct patent families, creating a labyrinth that would be simplified by the Board’s review of the asserted patents. *See* EX-2004, 9-14 (describing priority claims of asserted patents).

C. Factor 3: investment in the parallel proceeding by the court and the parties

Factor 3 weighs in favor of institution. Patent Owner contends that “[s]ignificant work has already been done in the parallel district court litigation,” and as such, Factor 3 should weigh in favor of institution. Paper 5 at 23-24. But this contradicts Patent Owner’s earlier admission that “the parallel district court

case *is in its early stages*” (*id.* at 17), and that, in district court, the parties “generally agree[d]” that the case is in the “relatively early stages” (EX-2006, 3) (“*parties generally agree* that, although some work has been done, this case remains in the *relatively early stages with more work ahead of the parties and the Court than behind*” (citing *Realtime Data LLC v. Teradata Operations, Inc.*, No. 2:16-cv-02743, 2017 WL 3453295, at *2 (C.D. Cal. Feb. 27, 2017))).

Regardless, a significant amount of work remains. To accommodate the IPRs, the district court’s partial stay has delayed the case. EX-2006, 5. Fact and expert discovery are stayed pending resolution of at least the PTAB’s discretionary denial decisions. *Id.* And even without any further stay (which, as discussed above, cannot be assumed), opening claim construction briefs would not be due until after the institution deadline for the ’112 and ’517 patents (*see id.*), while responsive briefs would not be due until after the institution decisions for the ’573 and ’903 patents are expected, and roughly around the time an institution decision is expected for the ’332 patent. *Id.* The *Markman* hearing is delayed until at least after the last institution decision is expected. *See id.* While the district court permitted the parties to complete claim construction discovery, that phase concluded on July 18, 2025, and the case is now fully stayed pending the Board’s discretionary denial decisions. *Id.* at 4 (“After the close of claim construction discovery, which will be useful to both this case and any hypothetical PTAB

proceedings, the Court orders a pause on claim construction and discovery work until the PTAB issues its discretionary denial decisions.”). The district court’s partial stay has minimized investment by the parties.

Patent Owner also contends that the district court has “become well-versed with the underlying patented technology (per *Alice* step one), and the general state of the art and specific disclosures of the pertinent prior art (per *Alice* step two)” because of motions briefing for two unrelated patents found patent ineligible. Paper 5 at 23-24; EX-2007. But Patent Owner declines to mention that the § 101 motions were heard and decided by Judge Philip S. Gutierrez (EX-2007, 1), and the case has since been *reassigned* to Judge André Birotte Jr. when Judge Gutierrez retired (EX-1017, 1). Thus, there is little “judicial economy” in denying institution, as Patent Owner contends, because the court will need to be brought up to speed, just as the Board will, in the underlying patented technology, the general state of the art, and the specific disclosures of the pertinent prior art.

D. Factor 4: overlap between issues raised in the petition and in the parallel proceeding

Factor 4 weighs in favor of institution. As an initial matter, the district court found that “Google’s IPR petitions address all asserted claims, so if the PTAB institutes proceedings, such proceedings could simplify the issues in this case.” EX-2006, 3. There will be tangible benefits for the district court if the PTAB

institutes this proceeding, realizing the underlying goals of the IPR regime to simplify issues. *See id.*

Moreover, Google timely entered a *Sotera* stipulation with its Petition, stating that it “stipulates that, if the PTAB institutes an IPR proceeding on the grounds presented in Google’s petition challenging the claims of the ’903 patent, Google will not pursue in this district court litigation the same grounds in the petition or any grounds that reasonably could have been raised during the IPR with respect to the patent claims subjected to the instituted IPR (i.e., any ground that reasonably could have been raised under 35 U.S.C. §§ 102 or 103 on the basis of prior art patents or printed publications).” EX-1016.

Patent Owner’s assertion that this stipulation is “nominal[.]” (*see* Paper 6 at 24) is incorrect because it diminishes the scope of estoppel expressly provided for by statute. 35 U.S.C. § 315(e). To require Google (and in effect all petitioners) to accept more than the full scope of estoppel at institution penalizes all petitioners beyond what was contemplated by Congress. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1360 (Fed. Cir. 2025) (noting that Congress’s “stated intent ... was to allow the PTO to evaluate patents and printed materials, matters which are normally handled by patent examiners, while excluding challenges to validity on other grounds (e.g., public uses or sales), which would remain the province of the

courts” (quoting *Lynk Labs, Inc. v. Samsung Elecs. Co.*, 125 F.4th 1120, 1128 (Fed. Cir. 2025))).

To that end, this case is distinguishable from *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025), cited by Patent Owner. Paper 5 at 25. There, the Director found that the investment in litigation that is not present here, including the parties serving expert reports, conducting “several depositions,” and the court holding a *Markman* hearing and construing several claims, “strongly” favored discretionary denial. *See, e.g., Motorola*, IPR2024-01205, Paper 19 at 3-4. In contrast, here, the case is stayed pending the discretionary denial decision and little investment has been made in the case so far. *See* Sections IV.A-IV.C. Nonetheless, *Motorola* does not establish, as a matter of course, that *Sotera* stipulations are insufficient to make IPR proceedings a “true alternative” to district court litigation. *See* Paper 5 at 25.

E. Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party

Factor 5 favors institution or is at most neutral. Although the parties are involved in parallel litigation, Patent Owner has asserted the '903 patent against other parties, including at least Comcast and Microsoft. *See* EX-1024, 18-25; EX-1025, 14-22. And there is no indication Patent Owner will not continue to assert the '903 patent against future defendants. Instituting review benefits not only

the district court proceeding involving Google, but also the litigations with other defendants. *See Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2-3 (P.T.A.B. July 2, 2025) (“Because the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient.”).

F. Factor 6: other circumstances that impact the Board’s exercise of discretion, including the merits.

Factor 6 weighs in favor of institution. As described below in Section V, the Petition presents compelling merits based on prior art the Examiner should have identified and used to reject the claims of the ’903 patent. This warrants institution. *See Microsoft*, IPR2025-00318, Paper 9 at 3 (examiner error outweighed *Fintiv*); *cf. Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9 at 2 (P.T.A.B. July 31, 2025) (finding a material error during examination weighed in favor of institution as part of *Fintiv* Factor 6 analysis).

V. Patent Owner’s Merits-Based Arguments Should Be Rejected

As discussed, Kenner is a near anticipatory prior art reference and the Petition’s merits are strong. Patent Owner’s contrary arguments mischaracterize the prior art and the arguments in the Petition. *See, e.g.*, Paper 6 at 25-38.

For example, Patent Owner incorrectly argues that Kenner’s video ID is not an alias name because “nothing is *directed* to the PIM ... *based on* the ‘video ID.’” Paper 5 at 32-35. However, as explained in the Petition, Kenner discloses instances

in which a request is directed to a primary IM by a neighboring IM based on the video ID. Paper 1 at 22 (citing EX-1005, 40:29-33, 36:28-31, 41:1-5). To rebut this point, Patent Owner offers only an unsupported assertion that “this does not associate the video ID with a PIM.” Paper 5 at 34. To the contrary, the video ID is used to identify the primary IM by the neighboring IM. EX-1005, 41:1-5 (indicating the neighboring IM would “determine which IMs are likely to have the desired clip, and query only those IMs”).

Patent Owner’s contention that “[t]he mere inclusion of the provider’s account number in the video ID does not indicate that a content provider *is authorized to have resources delivered to client machines via the at least one shared repeater server*” misinterprets the Petition’s arguments. Paper 5 at 36. Rather, the Petition explains that Kenner discloses this authorization because the primary IM “checks the user’s subscription rights in its user database” to determine if the download is “authorized and necessary.” Paper 1 at 19 (citing EX-1005, 37:18-31, 38:17-22, 52:7-12).

Patent Owner further contends that Kenner does not teach or suggest analyzing an alias name using the table because Kenner’s “primary IM could identify the source IM with the video ID because the video ID itself contains the provider’s account number.” Paper 5 at 37. However, Patent Owner’s speculation about what the primary IM “could” do contradicts Kenner’s express disclosure. As

explained in the Petition, the primary IM “contact[s] the source IM 90, where the content provider first uploaded the file” using the “Internet address of the source IM 90 ... provided in the clip database of the PIM 64.” Petition at 25; *see* EX-1005, 41:13-15. Patent Owner’s merits-based arguments should thus be rejected and the strong merits of the Petition weigh in favor of referral.

VI. Google’s Reliance on Expert Testimony Is Not Excessive or Improper

A. The Petition Does Not Rely On Expert Testimony to Fill Gaps

Contrary to Patent Owner’s arguments, Google does not overly rely on expert testimony or use it to “fill in ... gaps” in the prior art. Paper 5 at 39.

Google’s explanation of what a POSITA would have understood or recognized in the prior art does not amount to “gap filling.” *See id.* To the contrary, explaining how a POSITA would have understood the asserted art, and how and why a POSITA would have combined references, is required to establish obviousness. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 401 (2007); *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1337 (Fed. Cir. 2020) (“[I]nquiry into whether any ‘differences’ between the invention and the prior art would have rendered the invention obvious to a skilled artisan *necessarily depends* on such artisan’s knowledge.”).

Indeed, Patent Owner has not identified a single example of a “gap” that the Petition purportedly fills with expert testimony. Paper 5 at 39-40. Rather, Patent

Owner vaguely references thirteen different claims or claim limitations where the declaration is used to “provide the understanding and interpretation of a POSA.”

Id. This is entirely proper. *See Philips*, 948 F.3d at 1337.

Regarding element [1.pre], for example, the Petition explains that Kenner’s architecture delivers resources to multiple terminals, citing Dr. Mowry’s explanation of how the neighboring region in Kenner’s Fig. 4 would include its own terminal. Paper 1 at 12-13. (citing EX-1003, ¶67). Where Dr. Mowry first introduces the modified Fig. 4, he explains that “[a]lthough Fig. 4 does not show the terminals associated with other IMs, the IM for a neighboring region may equally include an associated user terminal,” citing Kenner’s explanation that “[t]he neighboring region 89, like the home region 81, also has a head-end network communication interface 98 capable of supporting a large number of user terminals.” EX-1003, ¶55 (citing EX-1005, 32:4-6). This is not gap filling.

B. Patent Owner Has Not Presented Competing Expert Testimony

Patent Owner contends that it “will present and rely heavily on competing expert testimony” so extensively that resolution is purportedly better suited for district court litigation. *See* Paper 5 at 40. But Patent Owner’s assertion that it will file competing expert testimony does not substitute for actually presenting such testimony here. Patent Owner’s arguments related to the teachings of Kenner and what a POSITA would have understood rely solely on attorney argument, which is

not evidence. *See Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017). That Patent Owner expects to rely so heavily on expert testimony to rebut a nearly anticipatory reference only confirms the Petition’s merits.

Moreover, the Board is well suited to make factual findings, including what the prior art discloses and whether there is sufficient motivation to combine. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015) (“Board members, because of expertise, may more often find it easier to understand and soundly explain the teachings and suggestions of prior art”); *Brand v. Miller*, 487 F.3d 862, 869 (Fed. Cir. 2007) (“PTAB’s expertise appropriately plays a role in interpreting record evidence.” (internal quotations omitted)). The Board is also capable of making determinations about expert testimony, including weighing the credibility of opposing experts. *Trs. of Columbia Univ. in City of N.Y. v. Illumina, Inc.*, 620 F. App’x 916, 922 (Fed. Cir. 2015) (Board is “entitled to weigh the credibility of the witnesses in light of their qualifications and evaluate their assertions accordingly”); *see also Inwood Lab ’ys, Inc. v. Ives Lab ’ys., Inc.*, 456 U.S. 844, 856 (1982) (“Determining the weight and credibility of the evidence is the special province of the trier of fact.”); *Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (“We defer to the Board’s findings concerning the credibility of expert witnesses.”). Patent Owner does not explain how or why a dispute between experts (if there will be one) is better suited for resolution in district court.

C. Criticizing Reliance on Expert Testimony Contradicts the AIA’s Particularity Requirements and Ignores That Testimony’s Role in Providing Substantial Evidence

Patent Owner faults Google for “rel[ying] on expert testimony for nearly every cited claim limitation, rather than providing a focused expert declaration addressing the limitations for which expert testimony is necessary.” Paper 5 at 39. This argument should be rejected.

As an initial matter, Google’s citations are expected given the obviousness grounds in the Petition and the technical analysis needed to support those grounds. Indeed, the IPR statute requires that grounds be identified with particularity and specifically contemplates petitioners using “evidence that supports the grounds for the challenge to each claim, including ... affidavits or declarations.” *See* 35 U.S.C. § 312(a)(3)(B). Google’s citations—to its expert and objective evidence—comport with this clear statutory direction and simply underscore the ample factual support provided in the Petition. Suggesting that Google curb its citations contradicts the requirement that substantial evidence support any obviousness positions. *Compare* Paper 5 at 38-40, *with Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.*, 24 F.4th 1406, 1413 (Fed. Cir. 2022); *Shoes by Firebug LLC v. Stride Rite Children’s Grp., LLC*, 962 F.3d 1362, 1372 (Fed. Cir. 2020) (affirming the Board’s findings based on weight of expert testimony).

VII. Compelling Economic and Public Interest Concerns Favor Referral

A. Compelling Economic Interests Favor Institution

Compelling economic interests favor referral. Google's strong economic presence in the United States has contributed to American innovation for almost 30 years. EX-1018; *see also* EX-1019 (Google investments have facilitated innovation, supporting goals of the USPTO, including by investing in research and development to power American technological leadership, and create leaps in AI and quantum computing that advance national security). Google employs over 100,000 people, many in the United States and contributing to continued economic growth. EX-1020.

Patent Owner suggests Google's size favors denial here, but provides no explanation as to why that is the case. *See* Paper 5 at 40-41. Restricting PTAB access by foreclosing a means for certain companies to challenge patents, as Patent Owner proposes, is contrary to the AIA, which allows *broad access* to any member of the public, stating that "*a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent.*" *E.g.*, 35 U.S.C. § 311(a). Denying petitions based on the size of a petitioner is at least a failure to engage in proper rulemaking, and at worst, an unlawful decision that would exceed the Office's authority to prescribe regulations related to IPRs. *See, e.g.*, 35 U.S.C. § 316(a).

On the other hand, Patent Owner is a holding company formed within the last two years. *See* EX-1021. It describes itself as a “spin off” and purports to own and manage “Sandpiper’s CDN technology, software, and intellectual property.” *Id.* But Patent Owner does not practice the claimed invention or sell any products related to the claimed technology. In other words, it does not contribute to or otherwise use its intellectual property for the advancement of economic interests in the United States. This favors institution in this case.

While Patent Owner argues that “the AIA was also a reaction to the financial hardship on many smaller defendants faced with complex commercial litigation,” Paper 5 at 40, the legislative history it cites does not support this broad proposition. The AIA was certainly designed to “reduce[] unwarranted litigation costs,” but this was not limited to savings for only some parties or courts. EX-1026, 39-40. Indeed, it is Google that is faced with costly litigation, and utilization of an IPR would help reduce those costs for both parties, as it would simplify the issues in district court. Economic interests thus favor referral.

B. Compelling Public Interests Favor Referral

Compelling public interest factors also favor institution. One motivation behind the AIA was “improving patent quality and providing a more efficient system for challenging patents that should not have issued.” *Id.* The strong merits

in the Petition (*see* Section V) suggest instituting would accomplish the AIA's goals of streamlining the litigation and reducing litigation costs.

Moreover, neither Patent Owner nor any prior owner asserted the '903 patent against Google since the patent's issuance. As discussed further *supra*, there are compelling economic and efficiency reasons to have the Board assess the patentability of all claims under §§ 102 and 103. Conversely, there are substantial negative economic consequences to all Parties and the public if the claims must be adjudicated in more expensive and time-consuming litigation.

Instituting would also not only streamline the instant dispute between Patent Owner and Google, but also disputes involving other parties. In addition to Google, Patent Owner has asserted the '903 patent, against both Comcast and Microsoft. *See* EX-1024, 18-25; EX-1025, 14-22. Institution and a finding of unpatentability would prevent the Patent Owner from continuing to unjustifiably assert the '903 patent against others.

VIII. Conclusion

For the foregoing reasons, Petitioner respectfully requests that the Director decline to exercise discretion to deny institution and let the panel decide whether to institute based on the merits of the Petition.

Dated: September 18, 2025

Respectfully submitted,

/Erika H. Arner/

Erika H. Arner, Lead Counsel
Reg. No. 57,540

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24 and the Memorandum on Interim Processes for PTAB Workload Management, dated March 26, 2025, Petitioners certify that the word count of the foregoing **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution** as measured by Microsoft Word is 7,309 words, excluding those portions identified in 37 C.F.R. § 42.24(a).

/Erika H. Arner/

Erika H. Arner, Lead Counsel
Reg. No. 57,540

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution** was served electronically via email on September 18, 2025, in its entirety on the following:

Jason D. Eisenberg
jasone-PTAB@sternekessler.com

Daniel S. Block
dblock-PTAB@sternekessler.com

Kristina Caggiano Kelly
kckelly-PTAB@sternekessler.com

Timothy L. Tang
ttang-PTAB@sternekessler.com

Todd C. Thurheimer
tthurheimer-PTAB@sternekessler.com

PTAB@sternekessler.com

Dated: September 18, 2025

/Daniel E. Doku/

Daniel E. Doku
Senior Litigation Paralegal
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP