

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIENA CORPORATION,
Petitioner,

v.

K.MIZRA LLC,
Patent Owner.

Case No. IPR2025-01362

U.S. Patent 8,782,282

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

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	PROCEDURAL BACKGROUND	2
III.	STIPULATION	4
IV.	INSTITUTION IS WARRANTED TO CORRECT THE ERRONEOUS ISSUANCE OF THE '282 PATENT	5
	A. The Petition Demonstrates that the '282 Patent Should Never Have Been Issued	5
	B. Review Is Warranted to Correct the Error in Granting the '282 Patent	7
V.	THE '282 EX PARTE REEXAMINATION DOES NOT WARRANT A DISCRETIONARY DENIAL UNDER FINTIV OR OTHERWISE.	8
VI.	THE <i>FINTIV</i> FACTORS WARRANT INSTITUTION	11
	A. Factor 1: Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.....	11
	B. Factor 2: Proximity of the court's trial date to the Board's projected statutory deadline	12
	C. Factor 3: Investment in the parallel proceeding by the court and the parties	13
	D. Factor 4: Overlap between issues raised in the petition and in the parallel proceeding.	15
	E. Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party.....	16
	F. Factor 6: Other circumstances that impact the Board's exercise of discretion, including merits.....	16

VII. THE SETTLED EXPECTATIONS DOCTRINE DOES NOT
WARRANT SHIELDING THE '282 PATENT FROM REVIEW17

VIII. THE PETITION IS SUPPORTED BY REASONED EXPERT
TESTIMONY CORROBORATED BY DOCUMENTARY
SUPPORT20

IX. CONCLUSION.....20

TABLE OF AUTHORITIES

Federal Cases

Daiichi Sankyo, Inc. v. Vidal, 681 F.Supp.3d 490 (E.D. Va. 2023)10

Fox Factory, Inc. v. SRAM, LLC, 944 F.3d 1366 (Fed. Cir. 2019)17

In re GPAC Inc., 57 F.3d 1573 (Fed. Cir. 1995)18

In re Keller, 642 F.2d 413 (CCPA 1981)7

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007).....6

In re Merck & Co., Inc., 800 F.2d 1091 (Fed. Cir. 1986).....7

In re Mouttet, 686 F.3d 1322 (Fed. Cir. 2012)7

Administrative Cases

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,
IPR2019-01469, Paper 6 (Feb. 13, 2020) (designated: March 24, 2020) .. 8-9, 15

American Airlines, Inc. et al. v. Intellectual Ventures I LLC, IPR2025-00786
Paper 12 (Aug. 29, 2025).....13, 19

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11, March 20, 2020
(precedential) *Passim*

Aylo Freesites Ltd. f/k/a MG Freesites Ltd. v. WellcomeMat, LLC, IPR2024-
00710, Paper 13 (Sept. 5, 2024)16

HP Inc. v. Slingshot Printing LLC, IPR2020-01084, Paper 13 (Jan. 14, 2021).....16

Intel Corp. v. Proxense LLC, IPR2025-00327, Paper 12 (June 26, 2025)17

Resmed Corp. v. Cleveland Medical Devices, Inc., IPR2025-00160, Paper 11
(June 13, 2025)..... 8-9

Sotera Wireless, Inc. v. Masimo Corporation, IPR2020-01019, Paper 12
(Dec. 1, 2020) 4-5, 15

Xerox Corp. v. Bytemark, Inc., IPR2022-00624, Paper 9 (Aug. 24, 2022).....20

Federal Statutes

35 U.S.C. § 1036
35 U.S.C. § 315(d)10
35 U.S.C. § 325(d)1, 7, 9, 15

Regulations

37 C.F.R. § 42.6(a)(3)20
37 C.F.R. § 42.20(c)18
37 C.F.R. § 42.65(a)20

PETITIONER’S LIST OF EXHIBITS

Exhibit	Brief Description
1001	U.S. Patent 8,782,282 (“the ’282 Patent”)
1002	Prosecution History for U.S. Patent 8,782,282
1003	Declaration of Dr. Douglas Schmidt
1004	U.S. Patent No. 7,209,968 (“ <i>Secer</i> ”), issued April 24, 2007, filed May 29, 2001
1005	U.S. Patent Pub. No. 2003/0177411 (“ <i>Dinker</i> ”), published September 18, 2003, filed March 12, 2002
1006	WIPO Publication WO 00/08823 (“ <i>Keene</i> ”), published February 17, 2000
1007	U.S. Patent Pub. No. 2003/0028654 (“ <i>Abjanic</i> ”), published February 6, 2003, filed August 10, 2001
1008	U.S. Patent No. 6,718,377 (“ <i>Bischoff</i> ”), issued April 6, 2004, filed March 15, 2000
1009	U.S. Patent No. 5,742,762 (“ <i>Scholl</i> ”), issued April 21, 1998
1010	U.S. Patent No. 7,043,525 (“ <i>Tuttle</i> ”), issued May 9, 2006, filed December 14, 2001
1011	U.S. Patent No. 6,470,394 (“ <i>Bamforth</i> ”), issued October 22, 2002
1012	U.S. Patent Pub. No. 2004/0008717 (“ <i>Verma</i> ”), published January 15, 2004, filed July 12, 2002
1013	U.S. Patent 6,260,062 (“ <i>Davis</i> ”), issued July 10, 2001
1014	U.S. Patent Pub. No. 2003/0120502 (“ <i>Robb</i> ”), published June 26, 2003, filed April 23, 2002
1015	NDGA Trial Statistics – U.S. District Court - Judicial Caseload Profile (June 2025), for the Northern District of Georgia, https://www.uscourts.gov/sites/default/files/document/fcms_na_distpr ofile0630.2025.pdf , accessed Dec. 9, 2025
1016	Complaint, <i>K.Mizra LLC v. Ciena Corp.</i> , Case No. 1:24-cv-05442 (N.D. Ga), Dkt. 1 (Nov. 25, 2024)

Exhibit	Brief Description
1017	Docket Sheet, <i>K.Mizra LLC v. Ciena Corp.</i> , Case No. 1:24-cv-05442 (N.D. Ga), retrieved Dec. 9, 2025
1018	Standing Order Regarding Civil Litigation, <i>K.Mizra LLC v. Ciena Corp.</i> , Case No. 1-24-cv-05442 (N.D. Ga), Dkt. 6 (Nov. 27, 2024)
1019	Excerpts of transcript, Oral Argument on Motions to Dismiss, <i>K.Mizra LLC v. Ciena Corp.</i> , Case No. 1-24-cv-05442 (N.D. Ga), Dkt. 63 (Nov. 10, 2025)
1020	K.Mizra’s Opp. to Ciena’s Motion to Dismiss for Failure to State a Claim Under Fed. R. Civ. P. 12(B)(6), <i>K.Mizra LLC v. Ciena Corp.</i> , Case No. 1-24-cv-05442 (N.D. Ga), Dkt. 36 (March 14, 2025)
1021	Lawsuits filed by K.Mizra LLC, retrieved from Docket Navigator (docketnavigator.com) Dec. 10, 2025
1022	Proceedings Involving the ’282 Patent, retrieved from Docket Navigator (docketnavigator.com) Dec. 11, 2025
1023	Internet Archive of Blue Planet, Multi-Domain Service Orchestration website (Oct. 17, 2015) <i>available at</i> https://web.archive.org/web/20151017054021/http://www.blueplanet.com/products/multi-domain-service-orchestration.html (last visited Dec. 11, 2025).

I. INTRODUCTION

Ciena Corporation (“Petitioner”) opposes the request by K.Mizra LLC (“Patent Owner” or “PO”) for Discretionary Denial of Institution (Paper 7, “Request”). Petitioner respectfully submits that the Request should be denied and *inter partes* review instituted.

The ’282 Patent is invalid, as demonstrated by the strong, new evidence of obviousness in the Petition. The Petition is based on prior art that was not previously before the Patent Office and shows the very claim limitations that led to the erroneous issuance of the patent. Patent Owner does not request denial under 35 U.S.C. § 325(d), underscoring the importance of this Petition to the validity of the ’282 Patent and the integrity of the patent system. *Fintiv* considerations likewise call for institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, March 20, 2020 (precedential). The corresponding district court litigation against Petitioner in the Northern District of Georgia is stayed and **will not go to trial until one to two years after** the instant IPR reaches final written decision. Indeed, Ciena has not even answered the Amended Complaint in that litigation yet. While the ’282 Patent has been in force for 11 years, there are no facts that would make any settled expectation of validity particularly compelling here or outweigh that other discretionary considerations that favor institution. In particular, the Board is well positioned to apply its technical and legal expertise to the prior art references at issue

to streamline adjudication of the broader dispute between the parties, just as was intended by the AIA.

II. PROCEDURAL BACKGROUND

In a letter dated February 13, 2024 (the “Feb. 2024 Letter”), K.Mizra sent Ciena infringement claim charts for some 13 disparate U.S. patents directed to a range of technologies, accusing a range of Ciena products. The patent challenged in this Petition was just one of the 13 patents. On November 25, 2024, K.Mizra filed suit against Ciena in the Northern District of Georgia, asserting three patents from three different patent families. *K.Mizra LLC v. Ciena Corporation*, Civil No. 1:24-CV-05442-SDG (N.D. Ga.) (“the Ciena Litigation”); EX-1016. In addition to the instant patent, K.Mizra asserted U.S. 9,485,176 (“the ’176 Patent”) and U.S. 10,735,320 (“the ’320 Patent”), which Ciena contemporaneously challenges in IPR2025-01364.

K.Mizra also filed suit against several Nokia parties unrelated to Petitioner, on a different set of five patents, involving different products, in a different venue. *K.Mizra LLC v. Nokia Corporation, Nokia Solutions and Networks Oy, and Nokia of America Corporation*, Civil Action 2:24-cv-00974-JRG (E.D. Tex., filed November 25, 2024) (“the Nokia Litigation”). K.Mizra asserts the ’320 and ’176 Patents in both litigations but asserts three other patents in three other patent families against Nokia that are *not* asserted in the Ciena Litigation. EX-2005, 1. K.Mizra

does *not* assert the '282 Patent in the Nokia Litigation. *Id.* Thus, none of K.Mizra's Nokia-Litigation-based *Fintiv* arguments made in the co-pending proceeding IPR2025-01364 are relevant to this Petition.

On February 14, 2025, and prior to commencing discovery, Ciena moved to dismiss K.Mizra's Complaint (i) for failing to state a claim and (ii) for asserting patents that Ciena contends are invalid for failure to claim patent-eligible subject matter. EX-1017 (Dkt. 21, 22). The motions automatically stayed the case. EX-1018, 7-8 ("During the pendency of a motion to dismiss ... all discovery is automatically stayed until the Court rules on the motion or otherwise directs. This stay includes all pretrial activity and deadlines"). On March 14, 2025, K.Mizra filed an amended complaint (the "Amended Complaint") changing its allegations of infringement. *Id.* (Dkt. 34). Ciena renewed its motions to dismiss on April 14, 2025 (*Id.* at Dkt. 41, 42), which the parties recently argued at an oral hearing on October 21, 2025. *Id.* (Dkt. 62, 63). The court has not yet issued any rulings on those motions. *Id.* The Ciena Litigation has consequently been effectively stayed since it was originally filed in 2024. At the oral argument on the motions, the court indicated that it would try to issue its rulings on the motions by the end of 2025. EX-1019, 39:10-15.

In the meantime, on May 15, 2025, a third party filed a request for *ex parte* reexamination of the '282 Patent, EPR No. 90/019,963 ("the '282 EPR"). The '282

EPR challenges the validity of all claims in the '282 Patent. The request is based on the grounds of invalidity that were *not* before Office during original examination, and were *not* presented in the Petition for IPR, namely: (i) anticipation by *Verma* (EX-1012) and (ii) obviousness over *Verma*. EX-2006, 11. On July 8, 2025, the USPTO granted the request, found substantial new questions of patentability, and ordered reexamination of the patent. EX-2007. Patent Center indicates that the case was forwarded to an examiner on November 7, 2025.

III. STIPULATION

Petitioner stipulates that if the Board grants the Petition and institutes an *inter partes* review, unless institution is later vacated, reversed, or otherwise withdrawn by rehearing or Director Review, Petitioner will not pursue in the Ciena Litigation the specific grounds asserted in the Petition, or any other ground that could have been reasonably raised in an IPR, or system versions of the prior art in the specific grounds in the Petition, or system prior art in combination with the prior art of the grounds asserted in the Petition. *See Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential).

Patent Owner argues that Petitioner should have issued a *Sotera* stipulation earlier. Petitioner did not do so as it did not expect Patent Owner to raise a *Fintiv* issue given how far ahead the Petition was filed compared to the stayed Ciena Litigation. As explained below, the *Fintiv* factors overwhelmingly favor institution.

A Petitioner should not be required to give up invalidity defenses early in a case merely because there may be some overlap, e.g., in the contention phase of fact discovery (which has not even happened here yet), with no chance of a trial in the parallel litigation occurring ahead of the IPR. Nonetheless, to streamline the issues raised by the Request, Petitioner provides the above “*Sotera Plus*” stipulation, *i.e.*, a conventional *Sotera* stipulation with additional assurances regarding certain system prior art, which the Board has found favorable to institution.

Likewise, to the extent the Patent Owner quibbles with the stipulation above as not being sufficient, that is unreasonable. An accused infringer cannot be asked to abdicate all prior art invalidity defenses, even those that are not available in an IPR. That would go well beyond any grant of authority to the USPTO in the AIA, and thus would violate the AIA, APA, and the U.S. Constitution.

IV. INSTITUTION IS WARRANTED TO CORRECT THE ERRONEOUS ISSUANCE OF THE '282 PATENT

A. The Petition Demonstrates that the '282 Patent Should Never Have Been Issued

The strength of the invalidity evidence presented in the Petition merits institution. As explained in the Petition, *Secer*, which is titled “**System and Method for Recovering Management of Network Element(s) Responsive to Failure of a Distributed Gateway**” demonstrates the same distributed architecture of a network management server and distributed communication adapters/gateways that are

disclosed and claimed in the '282 Patent with the exception, as the Petition discusses, that *Secer* does not teach clustering its server and providing load balancing and failover among the clusters (just for the gateways/adapters). Pet. 1-5. But clustering a server and providing load balancing and failover among the cluster was both well known in the art (Pet. §IV.F.3, 4), and taught specifically by the secondary reference, *Dinker*, which is titled “System and Method for **Enabling Failover for an Application Server Cluster.**” Pet. 5, 33-35, 37-38. The Petition presents a thoroughly supported combination of *Dinker*'s server-clustering techniques to *Secer*'s server. Pet. 35-42. This is exactly the type of combination of prior art elements for their intended purposes that 35 U.S.C. § 103 is designed to prevent. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007) (the improvement must be “more than the predictable use of prior art elements according to their established functions.”).

Moreover, it was precisely these teachings that the examiner was looking for, but failed to find, that led to the erroneous issuance of the '282 Patent. Pet. 9-11. Neither *Secer* nor *Dinker* were before the Patent Office during examination (Pet. 29, 33), and the examiner did not find corresponding prior art that demonstrate the load balancing, failover and server clustering so clearly taught by the art of the Petition. Pet. 8-11. The examiner did not appreciate that these prior art load balancing and failover techniques were routinely used with application server clusters. In fact, the

examiner's search log (EX-1002, 051-075) shows that the examiner only conducted a single search using the term "cluster" (*id.* at 057, search S56 on "2010/08/06"). Worse, he conducted that sole search over *three years* before he performed his January 2014 searches that led him to allow the claims. *Id.* at 025, 065-072. It was error for the examiner not to search for patents directed to application server clusters as this would have invariably identified *Dinker*, as demonstrated by *Dinker's* title.

Patent Owner's discussion of the merits only highlights the strength of the Petition. Req. 12-14. Patent Owner does nothing more than attack *Secer* and *Dinker* individually. *Id.* This type of argument fails as a matter of black letter law. One cannot show non-obviousness by attacking references individually where invalidity is based on a combination of references. *In re Keller*, 642 F.2d 413 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986). This is because "[T]he test for obviousness is what the *combined teachings* of the references would have suggested to those having ordinary skill in the art." *In re Mouttet*, 686 F.3d 1322, 1333 (Fed. Cir. 2012). In short, Patent Owner's critique of the *Secer* and *Dinker* references individually is a nullity. It is gibberish. In contrast, the evidence of obviousness in the Petition squarely shows that the '282 Patent is invalid under the governing law of obviousness. Review should be instituted.

B. Review Is Warranted to Correct the Error in Granting the '282 Patent

Patent Owner chose not to make any denial arguments under Section 325(d),

effectively conceding that the grounds in the Petition present an important challenge never before considered by the Patent Office. *Inter partes* review is thus particularly important because the pre-grant examination by the Patent Office failed to uncover or consider the art and grounds of this Petition, which are neither cumulative nor redundant to the examination upon which the patent rests for its validity. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, p. 8 (Feb. 13, 2020) (designated: March 24, 2020). Indeed, as discussed above, the grounds in the Petition show that the Challenged Claims never should have issued. The original examination’s failure to uncover pertinent prior art directly led to the mistaken issuance of invalid claims in the ’282 Patent. This prior art in the Petition should be considered on the merits to, at a minimum, protect the integrity of the patent system and the reputation of the United States Patent Office.

V. THE ’282 EX PARTE REEXAMINATION DOES NOT WARRANT A DISCRETIONARY DENIAL UNDER FINTIV OR OTHERWISE.

Patent Owner briefly suggests discretionary denial is warranted based on the ’282 EPR under the heading “Other Factors Favor Denial” (Req. 17-18), and as part of a brief argument under *Fintiv* Factors 3 and 4 (Req. 7, 11). Whether under the guise of *Fintiv* or “other considerations”, the argument lacks merit.

Ciena did not file the ’282 EPR, but “even when filed by the same party” the Board commonly permits parallel *ex parte* reexaminations. *Resmed Corp. v. Cleveland Medical Devices, Inc.*, IPR2025-00160, Paper 11, pp. 9-10 (June 13,

2025) (collecting cases). As the Board rightly observed: “We are aware of no regulation, rule, case law, or Office guidance that prohibits a party from filing both an *ex parte* reexamination and an *inter partes* review...” *Id.* at 9. Indeed, the Patent Office even issues formal guidance as to *how* to pursue parallel reexamination and AIA proceedings. *Id.* (citing 84 Fed. Reg. 16,654, 16656–58 (Apr. 22, 2019)). As the Board found, such guidance indicates that “there is nothing per se improper about parallel *ex parte* reexaminations and *inter partes* reviews.” *Id.* at 9-10 (declining to discretionarily deny institution of *inter partes* review due to pending *ex parte* reexamination).

The Board has rejected the same type of duplicative effort arguments that Patent Owner raises here. *Id.* at 9-12. That is particularly so, given that there is no overlap between the grounds of invalidity presented in the ’282 EPR and the instant Petition. The instant Petition is based on the combination of *Secer* and *Dinker* (Req. 12), whereas the ’282 EPR is based on anticipation and obviousness of a different reference, *Verma*, (EX-2006, 11; Req. 7). That these grounds are materially different is underscored by the fact that Patent Owner did not challenge the Petition under 35 U.S.C. §325(d) or perform an *Advanced Bionics* analysis of the art. *Resmed Corp.*, IPR2025-00160, Paper 11, p. 12 (declining to discretionarily deny *inter partes* review in view of *ex parte* reexamination, noting differences in prior art “underscored” by patent owner’s choice “not to perform an *Advanced Bionics*

analysis”).

That the Petition and the '282 EPR both raise substantial, significant and completely different challenges to the validity of the '282 Patent only underscores that the '282 Patent never should have issued. The integrity of the patent system calls, at minimum, for adjudicating the challenges on the merits. To the extent parallel consideration of these challenges would be inefficient at all, staying one pending the outcome of the other would be the better remedy. 35 U.S.C. § 315(d).

Patent Owner’s attempt to bolster its *Fintiv* argument using the '282 EPR fails for similar reasons. First, Patent Owner cites no case, rule or other authority for applying *Fintiv* to parallel proceedings at the Patent Office such as an *ex parte* reexamination. Instead, the *Fintiv* factors are “for determining whether to institute review when there is ongoing parallel litigation in federal court...” *Daiichi Sankyo, Inc. v. Vidal*, 681 F.Supp.3d 490, 498 (E.D. Va. 2023). Second, the *Fintiv* Factors facially apply to litigation outside the Patent Office. Taking *Fintiv* Factor 1, for example, there is no need for the parties or Board to consider whether there is evidence that another tribunal will stay its proceeding, as the proceedings are under the common control of the Director. Indeed, 35 U.S.C. § 315(d) expressly gives the Director authority to coordinate multiple proceedings before the Office, including options for stays. Third, Patent Owner does not refer to the '282 EPR in its analysis of *Fintiv* Factors 1, 2, and 5, and only mentions the EPR in passing for Factor 4.

Req. 4-6, 11. One cannot seek a discretionary denial based on a proceeding under *Fintiv*, and but only evaluate *some* of the *Fintiv* factors. Thus, the Director should not deny institution based on the '282 EPR under *Fintiv* either.

VI. THE *FINTIV* FACTORS WARRANT INSTITUTION

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

Factor 1 favors institution. The Ciena Litigation has been stayed since its inception pending Petitioner's motions to dismiss. EX-1018, 7-8 ("During the pendency of a motion to dismiss ... all discovery is automatically stayed until the Court rules on the motion or otherwise directs. This stay includes all pretrial activity and deadlines"); EX-1017 (docket showing last substantive activity was oral argument), Dkt. 41-42 (renewed motions to dismiss), Dkt. 62 (October 2025 hearing on motions to dismiss). Thus, the corresponding Litigation remains in its infancy.

Furthermore, this case presents the rare scenario that institution would occur unusually far out ahead of the Ciena Litigation, at the *beginning* of fact discovery. Thus, the district court litigation would be in prime position to continue or resume a further stay to limit issues and receive the benefit of the USPTO's expertise in resolving the complex technological issues of prior art invalidity. That is particularly so here because the judge presiding over the Ciena Litigation is not technically trained and has had limited exposure to patent cases, unlike the Board. For example, to his credit, the judge in the Ciena Litigation humbly raised the

desirability of engaging a special master having better capacity for the complications of claim construction in patent cases, if the case proceeds. *See* EX-1019, 39:5-6, 40:7-11, 17-20. Thus, this Factor weighs in favor of institution.

B. Factor 2: Proximity of the court’s trial date to the Board’s projected statutory deadline

This factor strongly favors institution. Based on time-to-trial statistics and the long-stayed posture of the Ciena Litigation, the FWD deadline (March 11, 2027) is expected to occur *almost two years before* trial in the Ciena Litigation.

The Ciena Litigation has been stayed for over a year. EX-1017, 8-10; EX-1018, 7-8. The most recent statistics show that civil cases in the Northern District of Georgia take a median time to trial of about *three years* (35.9 months). EX-1015, 093; Req. 5 (averaging statistics over last three years to arrive at ~34 months). Thus, even if the current stay were lifted imminently, Ciena would not answer the amended complaint and the case would not get underway until early 2026, making the expected trial occur around January of **2029**. In contrast, this IPR is scheduled to conclude years before that. *See* Paper 6 (filing date noticed on Sept. 11, 2025). The institution decision is due March 11, 2026 and the final written decision (FWD) is due the following year, March 11, 2027. *Id.* Thus, the FWD is projected to occur some *twenty-one months earlier* than trial in the Ciena Litigation.

Even if one were to accept PO’s counterfactual hypothesis that the Ciena Litigation should reach trial in just two years (as if a year of discovery had already

occurred), the trial would still not occur until late November 2027, a **full eight months after** the FWD deadline of March 2027, weighing strongly in favor of institution. *American Airlines, Inc. et al. v. Intellectual Ventures I LLC*, IPR2025-00786 Paper 12 (Aug. 29, 2025) (denying discretionary denial where FWD would precede projected trial by nine months). Even under Patent Owner’s unreasonable projections, the trial would still not occur until September 2027, a **full six months** behind the FWD deadline here. *See* Req. 4-6. Straining credibility, the Request reads as if the facts were the other way around, citing cases where institution was denied because the projected trial *pre-dated* the FWD. Thus, the cases Patent Owner cites undermine its position under the facts it concedes. This factor strongly favors institution.

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

Factor 3 strongly favors institution. As held by the Board in *Fintiv*, “[i]f, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution under *NHK*.” *Fintiv*, 10. No *Markman* or prior art invalidity orders have been issued or are expected before institution in the Ciena Litigation. The case against Ciena is stayed. EX-1018, 7-8; EX-1017. Ciena has not yet answered the amended complaint. *Id.* Discovery has not begun. *Id.* No contentions have been exchanged. *Id.* PO has not identified its asserted claims. *Id.* The *Markman* process

has not started or even been scheduled. *Id.* The court has not appointed a special master. *Id.* No trial date is set. *Id.* As detailed above, nothing has happened in the Ciena Litigation. This factor weighs heavily in favor of institution.

While Patent Owner argues that it has invested time in briefing Ciena's motions to dismiss in the Ciena Litigation and complains that Ciena should have brought the Petition sooner, those arguments should be given little weight. First, Ciena diligently prepared and filed the instant Petition within five months of the Amended Complaint, and well within statutory timeframes. Second, Patent Owner stymied Ciena's invalidity efforts through its own obfuscation of its infringement allegations, asserted claims and asserted patents. Patent Owner could have settled on its infringement theory, patents and claims early and brought that to Ciena's attention, instead of the shifting sands approach that it adopted—starting with a letter and chart on some 13 patents, only to change its allegations when it brought suit, and then amend them further in its pleadings. EX-1016, 142-143; EX-1019, 36:9-11 (counsel for Patent Owner: “Have the claim charts changed? Sure they've change[d].”); EX-1020, 2-3 (describing amendment, shift of allegations to “software-as-a-service” theory, and shift in claims for the '176 and '320 Patents). Thus, the timing of the proceedings is of Patent Owner's own making. Moreover, Patent Owner can hardly argue that its corrective amendment to its complaint and its opposition to Ciena's motions to dismiss reflect a meaningful investment of effort

in the context of *Fintiv*; these efforts have nothing to do with prior art invalidity.

Patent Owner relies on the '282 EPR to bolster *Fintiv* Factor 3, but the argument fails. Req. 7. As discussed above (§V), there is no basis to apply *Fintiv* to reexaminations, and the '282 EPR is irrelevant to this Factor, which is directed to the investment by “the court and the parties” in the Ciena Litigation. That is even more so given that, as already explained, the grounds of the '282 EPR are different than the Petition. *Supra* §V. Patent Owner complains that the Petition cites *Verma*, but *Verma* is properly used as corroboration for the state of the art. *See, e.g.*, Pet. 14-16, 19-20. That is hardly a basis to deny institution, especially when Patent Owner acknowledges the grounds are materially different and does not raise any 35 U.S.C. § 325(d) issues or undertake an *Advanced Bionics* analysis. *Supra* §V. Thus, this factor weighs in favor of institution.

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

Factor 4 favors institution. There has been no overlap to date; as the Ciena Litigation has been stayed, K.Mizra has not revealed its asserted claims, and contentions have not been exchanged. Furthermore, this IPR is so far out ahead of the Ciena Litigation that the IPR will naturally streamline, not duplicate, efforts in the litigation, as Petitioner will face the prospect of statutory estoppel very early on. Likewise, both parties will know that the prior art invalidity ground in the Petition will have been thoroughly presented to the Board. Indeed, in view of Petitioner’s

Sotera Plus stipulation (§III), there will be no overlap between the issues raised in the petition and issues to be adjudicated in the Ciena Litigation.

Patent Owner briefly posits that the Petition’s reference to *Verma* somehow “underscores Petitioner’s intention to recycle prior art arguments,” a false assumption belied by (a) the *Sotera Plus* stipulation (§III) and (b) the materially different grounds presented by the Petition and the ’282 EPR (§V).

Thus, this factor weighs heavily in favor of institution.

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

Factor 5 is neutral. The Board has long recognized that it is commonplace for petitioners to be defendants and that does *not* weigh in favor of denial. *See HP Inc. v. Slingshot Printing LLC*, IPR2020-01084, Paper 13 at 9 (Jan. 14, 2021) (having the “same parties as parallel proceeding” makes factor 5 “neutral”); *Aylo Freesites Ltd. f/k/a MG Freesites Ltd. v. WellcomeMat, LLC*, IPR2024-00710, Paper 13, at 17-18 (Sept. 5, 2024) (“this factor adds little if anything to the discretionary denial analysis **unless the petitioner is not named as a defendant** (or declaratory judgment plaintiff) in parallel district court patent litigation.”) (emphasis added).

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

As explained above, §IV, the evidence of invalidity in the Petition is overwhelming, and presents prior art that is unlike any of the art that the Examiner

considered when deciding to issue the Challenged Claims. Integrity of the patent system counsels that the Director should not exercise discretion to prevent considering the merits of the critical evidence of invalidity presented in the Petition. *Fintiv*, 14-15.

VII. THE SETTLED EXPECTATIONS DOCTRINE DOES NOT WARRANT SHIELDING THE '282 PATENT FROM REVIEW

The evidence of settled expectations is weak and outweighed by other considerations. The case for settled expectations is based solely on the age of the patent and a vague reference to licensing that is meaningless. As the Director has acknowledged, “a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space.” *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, at 2-3 (June 26, 2025). Such considerations “weigh against a patent owner’s claim of settled expectations and bears on the Director’s discretion.” *Id.* at 3. Here, there is no evidence that Patent Owner or its predecessors ever attempted to commercialize, mark, or assert the '282 Patent. Public records indicate that the '282 Patent has only ever been asserted in the Ciena Litigation and has not been part of any other post-grant proceedings. EX-1022.

Patent Owner posits briefly that the '282 Patent has been “licensed to multiple third-party industry competitors” (Req. 17; EX-2005), but Patent Owner fails to provide critical details of the purported license(s). A patent license may not have

any nexus to a given licensed patent. *See Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019); *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). Here, Patent Owner does not say whether the license covers other unidentified patents, and if so, how many, or the relative contribution of the '282 Patent to the portfolio, or whether the license was taken to settle litigation on different patents. *In re GPAC Inc.*, 57 F.3d at 1580. Without such information, one cannot discern whether the purported licensee took the license “out of recognition” of the '282 Patent. *Id.* Public records show that K.Mizra brought and terminated at least 18 lawsuits. EX-1021. However, the '282 Patent has only ever been asserted against Ciena. EX-1022. Thus, any license is likely nothing more than a portfolio license taken by one or more of the 18 defendants (EX-1021) to settle litigation brought on *other* patents. In short, K.Mizra has not shown that there are any licenses that would be probative of “settled expectations” of the '282 Patent, as is its burden on its motion. 37 C.F.R. § 42.20(c).

Further, any “settled expectation” should not be given much weight for the additional reason of the offsetting equitable expectations of Petitioner. Some of the products Patent Owner accuses of infringing the '282 Patent in the Ciena Litigation have been on sale for at least a decade free from any claim of infringement of the '282 Patent. EX-1023. Thus, Petitioner has accrued offsetting equitable expectations. Ciena had no reason to challenge the '282 Patent previously and

should fairly be permitted to challenge its validity now given that its assertion was unreasonably delayed for over a decade without justification.

Finally, Petitioner respectfully submits that the entire “settled expectations” doctrine is irrational and violates the APA, AIA and the U.S. Constitution. There is no statutory basis in the AIA to justify new age limits on IPRs that contravene the statutory framework and timelines proscribed by Congress.

The relatively weak case for settled expectations is outweighed by the other discretionary considerations above. *American Airlines*, IPR2025-00786, Paper 12 (denying request for discretionary denial, notwithstanding settled expectations from patents aged 14 and 18 years). For example, the merits of the invalidity challenge are overwhelming (*supra* §IV), and this proceeding is far out ahead of the *Ciena* Litigation (§VI), making the Board uniquely positioned to provide its expertise early in the dispute. The adjudication of the highly technical prior art references amid the intricacies of patent law is well suited to the expertise of the Board. *Cf. Id.* at 3 (“the Board is better suited”). That is particularly so here, given that the judge in the *Ciena* Litigation is not technically trained and does not have extensive experience with patent law, as he humbly indicated during a recent hearing. *See* EX-1019 39:5-6 (“For an English major like me, this is incredibly helpful.”), 40:7-11 (“my general preference is to appoint a special master for that purpose so that you have somebody who actually knows what they're doing”), 17-20. The Board is thus uniquely situated

to use its expertise in adjudicating the critically important invalidity challenge presented by the Petition, weighing in favor of institution.

VIII. THE PETITION IS SUPPORTED BY REASONED EXPERT TESTIMONY CORROBORATED BY DOCUMENTARY SUPPORT

Patent Owner's attack on Petition's reliance on the expert testimony of Dr. Schmidt (EX-1003) fails. Req. 15-16. Dr. Schmidt's declaration provides extensive citations to factual support and explains the technical reasoning for his opinions, properly complying with requirements to be given significant weight. 37 C.F.R. § 42.65(a). Furthermore, it is necessary that such opinions and factual citations be included in the Petition pursuant to 37 C.F.R. § 42.6(a)(3) which requires that "arguments must not be incorporated by reference from one document into another document." Patent Owner's reliance on *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at *15-17 (Aug. 24, 2022) is misplaced. The problem in *Xerox* was not that it repeated statements in the Petition, but instead that the expert's testimony was conclusory and lacked citations to supporting evidence or technical reasoning. *Id.* That is not the case here, and Patent Owner's argument falls short.

IX. CONCLUSION

Viewed holistically, the discretionary considerations weigh in favor of institution.

Date: December 11, 2025

Respectfully submitted,

By: /John M. Baird/
John M. Baird, Reg. No. 57,585
Patrick D. McPherson, Reg. No. 46,255
Paul H. Belnap, Reg. No. 73,106
Duane Morris LLP
901 New York Avenue NW
Suite 700 East
Washington DC 20001
T: (202) 776-7800

Daniel D. Mitchell, Reg. No. 75,226
Stephen J. Smith, Reg. No. 80,519
Duane Morris LLP
1075 Peachtree Street NE, Suite 1700
Atlanta, GA 30309
T: (404) 253-6900

COUNSEL FOR PETITIONER

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on December 11, 2025, a copy of the foregoing Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution and all supporting exhibits were served by electronic means to counsel of record in the present IPR:

Crawford Wells
David Schumann
FOLIO LAW GROUP PLLC
maclain@foliolaw.com
david.schumann@foliolaw.com

Date: December 11, 2025

Respectfully submitted,

By: /John M. Baird/
John M. Baird, Reg. No. 57,585
Duane Morris LLP
901 New York Avenue NW
Suite 700 East
Washington DC 20001
T: (202) 776-7800

COUNSEL FOR PETITIONER