

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,

Petitioner,

v.

K.MIZRA LLC,

Patent Owner.

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IPR2025-01437

U.S. Patent No. 9,516,048

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**PATENT OWNER K.MIZRA LLC'S  
REQUEST FOR DISCRETIONARY DENIAL**

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2002	U.S. Patent No. 9,420,065 to Mayo et al.
2003	Screenshot of web page “Cisco Systems Inc. Be The Bridge to Possible” ( <a href="https://www.cloud.google.com/find-a-partner/partner/cisco-systems-inc">https://www.cloud.google.com/find-a-partner/partner/cisco-systems-inc</a> , last accessed Nov. 21, 2025) and “Cisco and Googler partner on a new open hybrid cloud solution spanning on-premises environments and Google Cloud Platform” ( <a href="https://www.cloud.google.com/find-a-partner/partner/cisco-systems-inc">https://www.cloud.google.com/find-a-partner/partner/cisco-systems-inc</a> , last accessed Nov. 21, 2025)
2004	Screenshot of web page “Hewlett Packard Enterprise Delivering true hybrid cloud for containers” ( <a href="https://cloud.google.com/find-a-partner/partner/cloud-technology-partners-ctp-an-hpe-company">https://cloud.google.com/find-a-partner/partner/cloud-technology-partners-ctp-an-hpe-company</a> , last accessed Nov. 21, 2025) and “Enterprise partner to deliver hybrid cloud solutions to customers” ( <a href="https://cloud.google.com/blog/topics/partners/google-cloud-partners-with-hpe-on-hybrid-cloud-next19">https://cloud.google.com/blog/topics/partners/google-cloud-partners-with-hpe-on-hybrid-cloud-next19</a> , last accessed Nov. 21, 2025)
2005	Declaration of Charles J. Hausman in Support of Patent Owner’s Request for Discretionary Denial
2006	Patent and Trademark Office, Notice of Proposed Rulemaking - Revision to Rules of Practice before the Patent Trial and Appeal Board, <a href="https://federalregister.gov/d/2025-19580">https://federalregister.gov/d/2025-19580</a> , Oct. 17, 2025
2007	Scheduling Order, <i>K.Mizra LLC v. Google LLC</i> , 1:25-cv-00236-ADA (W.D. Tex.) (ECF No. 39)
2008	Standing Order Governing Proceedings (OGP) – Patent Cases, J. Albright (W.D. Tex.)
2009	Screenshot of Trial Statistics 01/01/2009 – 10/16/2025, U.S. District Court for the Western District of Texas
2010	Order Denying Motion to Dismiss, <i>K.Mizra LLC v. Google LLC</i> , 1:25-cv-00236-ADA (W.D. Tex., Oct. 22, 2025)

2011	Claim Construction Order and Memorandum in Support Thereof, <i>K.Mizra LLC v. Google LLC</i> , 1:25-cv-00236-ADA (W.D. Tex.) (ECF No. 57)
2012	Order Setting Trial Date & Discovery Deadlines, Referring Case to Mediation & Referring Discovery Motions to United States Magistrate Judge, <i>K.Mizra LLC v. Citrix Systems, Inc. et al.</i> , No. 0:25-cv-60803-WPD (S.D. Fla.) (ECF No. 46)
2013	Screenshot of Judge William P. Dimitrouleas Median Time-to-Trial and with Motion to Dismiss Statistics, U.S. District Court for the Southern District of Florida
2014	Clerk's Notice of Judge Assignment to Judge William P. Dimitrouleas, <i>K.Mizra LLC v. Citrix Systems, Inc. et al.</i> , No. 0:25-cv-60803-WPD (S.D. Fla.) (ECF No. 20)
2015	Order Denying Defendant's Motion to Dismiss, <i>K.Mizra LLC v. Citrix Systems, Inc. et al.</i> , No. 0:25-cv-60803-WPD (S.D. Fla.) (ECF No. 34)
2016	Google, LLC's Invalidity Contentions, <i>K.Mizra LLC v. Google LLC</i> , 1:25-cv-00236-ADA (W.D. Tex., July 15, 2025)
2017	Defendants' Amended Answer and Affirmative Defenses to Plaintiff's Complaint, <i>K.Mizra LLC v. Citrix Systems, Inc. et al.</i> , No. 0:25-cv-60803-WPD (S.D. Fla.) (ECF No. 44)
2018	Patent and Trademark Office, Interim Director Discretionary Process, <a href="https://www.uspto.gov/patents/ptab/interim-director-discretionary-process">https://www.uspto.gov/patents/ptab/interim-director-discretionary-process</a> , Nov. 21, 2025
2019	Complaint for Patent Infringement, <i>K.Mizra LLC v. Google LLC</i> , 1:25-cv-00236-ADA (W.D. Tex.) (ECF No. 1)

## **I. INTRODUCTION**

Instituting review of expired U.S. Patent No. 9,516,048 (“the ’048 Patent”) is not a good use of Board resources. Petitioner waited for nine years after the ’048 Patent issued, more than three years after the Parties began discussions about Patent Owner’s portfolio, three years after a previous petition challenging this patent was denied, and seven months after Petitioner was sued in district court, to file its Petition. Two district court cases are already at an advanced stage and will likely reach trial before any final decision here. And even when Petitioner got around to filing it, the Petition introduces confusion that Patent Owner and the Board should not be required to untangle. There is no reason to institute *inter partes* review for this now-expired patent.

## **II. INSTITUTION SHOULD BE DENIED UNDER 35 U.S.C. § 314(a)**

### **A. Settled Expectations Favor Denial**

The ’048 Patent issued December 6, 2016, more than nine years before the filing of the Petition. (Ex. 1001.) A patent in force that long creates strong settled expectations. *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, 2 (denying institution for nine-year-old patent). The settled expectations are strengthened because the ’048 Patent is expired. *See Omnivision Techs., Inc. v. RE Secured Networks, LLC*, IPR2025-01019, Paper 14, 2. Here, the age of the now-expired patent alone is enough to warrant discretionary denial.

Moreover, Petitioner acknowledges that it had licensing discussions with K.Mizra starting in June 2022, more than three years before it filed this challenge. (Ex. 2001.) Yet at no time during those three years did Petitioner seek review of the '048 Patent from the Board, and Petitioner fails to explain its extensive delay in seeking *inter partes* review. Additional evidence suggests that Petitioner was aware of this patent family before those discussions as well. (Ex. 2002 (citing U.S. Patent No. 7,630,381 to Roskind).)

The long history of enforcement of the '048 Patent against other cloud security and technology companies (Pet. 4–6) further supports settled expectations. Indeed, many of the prior defendants are partners with Petitioner, including Cisco (Ex. 2003) and HPE (Ex. 2004). Patent Owner has also licensed the '048 Patent to several of Petitioner's computer security product competitors. (Ex. 2005.) These facts further strengthen the settled expectations of K.Mizra. *Alliance Laundry Sys., LLC v. Payrange LLC*, IPR2025-00950, Paper 11, 3.

Notwithstanding these considerations, Petitioner suggests that this is “an exceptional case of unsettled expectations” because of a prior invalidity challenge involving a different patent. (Pet. at 3.) The argument fails. First, Petitioner's premise is undermined by the denial of a prior challenge to the '048 Patent. (Pet. 3 (“The recent IPR of the '048 Patent was denied institution.”).) Second, the claim that the '705 Patent—*not* the '048 Patent—is under a “cloud of invalidity” (Pet. at

3) runs directly contrary to federal law. *See* 35 U.S.C. § 282 (“A patent shall be presumed valid.”). Indeed, the Director has recognized that “reasonable minds may, and frequently do, disagree about whether a particular patent claim meets the statutory requirements” and thus “even extremely strong patents depend on a presumption of validity for their survival.” (Ex. 2006.) Third, the closest thing to a final decision in the IPR central to Petitioner’s argument, the Board’s Final Written Decision (“FWD”), found all claims of the ’705 Patent—again, *not* the ’048 Patent—patentable. (Pet. at 10.) Fourth, Petitioner’s argument incorrectly suggests that an unresolved invalidity challenge—although not the one it asserts here—undermines settled expectations even if it is directed to a different patent that is separately presumed valid. But nearly every patent litigation is settled before all invalidity challenges are resolved, with the Director consistently finding that previous assertions *confirm* settled expectations. *See, e.g., Intel Corp.*, Paper 12, 2–3 (noting settled expectations may be undermined where a patent has *not* been litigated).<sup>1</sup> Fifth, the “settled expectations” analysis is ultimately about whether a particular petitioner should have already challenged the patent if it intended to do so. *See, e.g., Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11,

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<sup>1</sup> Settlement of an IPR is “neither unusual or rare” and does not justify Petitioner’s delay. *Pfenex, Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01478, Paper 9, 12.

2–3. An unresolved prior invalidity challenge has no impact on whether Petitioner should have previously challenged the '048 Patent (such as by filing this challenge in 2022, when the prior IPR was denied and the parties began licensing discussions).

It is therefore not surprising that the Director has previously rejected Petitioner's argument. For example, in IPR2025-00998, Petitioner argued that a prior institution decision which was followed by settlement undermined settled expectations. *Google LLC v. Advanced Coding Techs. LLC*, IPR2025-00998, Paper 8, 20–21 (“Any expectation that ACT may have once had regarding the challenged claims’ patentability has long since been unsettled.”). But the discretionary denial decision nonetheless found that the settled expectations weighed in favor of denial. *Id.*, Paper 11, 2. The same conclusion should be reached here.

#### **B. Trial Dates/Schedules Weigh Strongly In Favor Of Denial**

Discretionary denial is appropriate to avoid “significant duplication of effort, additional expense, and a risk of inconsistent decisions.” *Koito Mfg. Co. v. Longhorn Auto. Grp.*, IPR2025-00955, Paper 9, 2. Here, there are *three* parallel litigations that will require duplicative efforts and risk inconsistent outcomes.<sup>2</sup> *See Comcast Cable Commc’ns, LLC v. Entropic Commc’ns, LLC*, IPR2025-00183,

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<sup>2</sup> In addition to the two cases referenced below, the '705 Patent is at issue in *Netskope, Inc. v. K.Mizra LLC*, No. 25-cv-04833-RS (N.D. Cal.).

Paper 11, 3 (“Because there are multiple ongoing district court proceedings, discretionary denial of the Petitions reduces the chances of duplicative workloads and inconsistent outcomes.”).

The district court trial between Patent Owner and Petitioner is scheduled to begin well before a FWD would be expected, around March 23, 2027. Judge Albright has ordered trial in *K.Mizra LLC v. Google LLC*, No. 1-25-cv-00236 (W.D. Tex.) (the “*Google Action*”) to commence November 2, 2026, nearly five months before the FWD deadline. (Ex. 2007.) He has also ordered that “the Court will not move the trial date except in extreme situations.” (Ex. 2008.) These facts support denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 13 (“We generally take courts’ trial schedules at face value absent some strong evidence to the contrary.”); *see also Linkplay Tech. Inc. v. Sonos, Inc.*, IPR2025-00509, Paper 10, 2 (denying institution where parties agreed to trial date and judge expressed intention to maintain that date). Even in an “extreme situation,” time-to-trial statistics suggest trial would still occur two months before the FWD deadline in late March 2027. (Ex. 2009 (showing median time-to-trial for district is 22 months).) And the Parties and the Court have already devoted substantial resources to this action. The Court has ruled on a motion to dismiss on infringement issues, held a *Markman* hearing, and issued a 47-page claim construction order. (Exs. 2010, 2011.) The Parties have also exchanged initial infringement and invalidity contentions. (Ex. 2007.) By the

institution deadline, the Parties will have served final infringement and invalidity contentions, and only a few months will remain in fact discovery. (*Id.*)

The '705 Patent, which Petitioner describes as having claims “similar in scope” to the '048 Patent (Pet. at 4), is also asserted in *K.Mizra LLC v. Citrix Sys., Inc. et al.*, No. 0-25-cv-60803 (S.D. Fla.) (the “*Citrix Action*”). Trial in that case has been scheduled for March 15, 2027, which is also before the late March FWD deadline. (Ex. 2012.) Time-to-trial statistics confirm that this Action is likely to go to trial ahead of the FWD deadline. (Ex. 2013.)<sup>3</sup> And again, the Parties and Court have already devoted substantial resources to litigating the *Citrix Action*. The Court has devoted significant resources to considering (and denying) defendant’s motion to dismiss under 35 U.S.C. § 101. (Ex. 2015.) By the institution decision, the Parties will be five months into fact discovery and claim construction briefing will be underway. (Ex. 2012.)

### **C. The *Fintiv* Factors Weigh Strongly In Favor Of Denial**

The first *Fintiv* factor is whether a stay has or is likely to be sought in the pending actions. *See Fintiv*, Paper 11, 6. No party has requested a stay, nor is there any indication that a stay would be granted—particularly given the Court’s

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<sup>3</sup> The *Citrix Action* was filed in April 2025 and is assigned to Judge Dimitrouleas. (Ex. 2014.)

significant investments in the district court case to date.

As explained above, the comparison of trial times to the timing of the FWD date also weighs in favor of denial under the second *Fintiv* factor.

The third *Fintiv* factor examines whether the Parties/Courts in the parallel proceedings have already there invested significant resources and whether that investment will be even greater at the institution deadline. As discussed above, *supra* Section II.B, the Parties and the Court have already devoted substantial resources to litigating both the *Google* Action and the *Citrix* Action, and will continue to do so for the next four months. These significant investments weigh in favor of denial. *See, e.g., Market dial Inc. v. Applied Predictive Techs., Inc.*, CBM2020-00025, Paper 8, 10–11. This is true even where trial may not occur before the FWD deadline. *See Be Smarter, LLC v. Yonder, Inc.*, IPR2025-00970, Paper 14, 2.

Petitioner nonetheless argues that denial is inappropriate because the case is at an early stage. (Pet. at 4.) The Board and Director have repeatedly rejected such arguments. For instance, in *Fintiv* itself, the Board found that both substantive orders (like the denial of the motions to dismiss in both actions) and claim construction orders (like the one issued in the *Google* Action) indicate investments that weigh in favor of denial. *Fintiv*, Paper 11, 9–10 (precedential). And previous discretionary denials have recognized “meaningful investments” sufficient to

overcome an uncertain trial date in less advanced cases. *See Be Smarter*, Paper 14, 2 (“For example, the parties have exchanged infringement and invalidity contentions, and a *Markman* hearing is scheduled to occur before the due date for an institution decision.”).

The fourth *Fintiv* factor, the overlap between the issues raised in the petition and the parallel proceedings, also supports denial. In the Petition, Google attacks the same claims of the ’048 Patent, proposes the same claim constructions and advances the same invalidity arguments based on identical references<sup>4</sup> as it has in the district court action. (Ex. 2016.)<sup>5</sup> The overlap between the proceedings favors denial.

*Arthrex Inc. v. Medshape, Inc.*, IPR2025-00053, Paper 11, 12–13 (finding inclusion of same references in invalidity contentions supports denial); *E-One, Inc. v. OshKosh Corp.*, IPR2019-00162, Paper 16, 11 (finding overlap in claim construction supports denial). Here, Patent Owner will have to deal with “repetitive challenges based on slightly rebranded evidence” or even “materially identical” challenges in both proceedings. (Ex. 2006, 5–6.) Fairness and efficiency thus weigh

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<sup>4</sup> The only exception is the Pujare reference. *But see infra* Section II.F.

<sup>5</sup> Citrix, who has alleged invalidity of the ’705 Patent based on the same art Petitioner here advances (Ex. 2017), and Netskope are also likely to assert similar invalidity arguments.

in favor of denial as Petitioner has not even filed a *Sotera* stipulation,<sup>6</sup> which in any case would not avoid repetitive challenges, much less disclaimed any invalidity challenges based on §§ 102 and 103 to make the IPR “a complete substitute for at least some phase of the litigation.” (*Id.*, 12.)

The fifth *Fintiv* factor examines party identity, with Google being involved in both proceedings, meaning this factor too weighs in favor of denial. *See Keyme LLC v. The Hillman Grp.*, IPR2020-01485, Paper 11, 12; *see also Fintiv*, IPR2020-00019, Paper 11, 13–14 (noting that unrelated cases support denial to avoid duplication).

The sixth *Fintiv* factor, “other circumstances,” further tips squarely in favor of denial, as discussed in the other sections of this Request. Moreover, Petitioner waited at least three years after its initial knowledge of Patent Owner and its patent portfolio, and seven months after being sued for infringement of the ’048 Patent, to

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<sup>6</sup> Petitioner filed a stipulation shortly before Patent Owner’s deadline. (Paper 6). It should not be considered here. (Ex. 2018 at I.D (noting importance of early filing of stipulations so Patent Owner may respond).) Moreover, this stipulation by its terms only applies if the Board “maintain[s] a Final Written Decision,” making it essentially co-extensive with statutory estoppel and thus a nullity in view of the earlier trial date relative to the timing of the FWD here. (Paper 6.)

file this Petition. (Ex. 2019.) This delay further supports denial. *Fintiv*, , Paper 11, 11–12 (“[I]f the evidence shows that the petitioner did not file the petition expeditiously . . . or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.”).

**D. Petitioner’s Attempt To Leverage Previous IPRs Presents Fairness Issues And Supports Denial**

The serial use of the IPR process, which subjects patent owners to multiple challenges on the same patent, is contrary to recently articulated policy concerns of the Office and presents an additional reason to deny the Petition. Even in the absence of roadmapping, prior challenges favor denial. *Treasure Garden, Inc. v. Atleisure, LLC*, IPR2025-01005, Paper 10, 3.

A challenge to the ’048 Patent was filed by Petitioner’s partner Hewlett Packard Enterprise Company (“HPE”) in 2022. *See Hewlett Packard Enter. Co. v. K.Mizra LLC*, IPR2022-00843, Paper 1 (“the *HPE* IPR”). The Board denied institution of the *HPE* IPR. *Id.*, Paper 14. This further supports discretionary denial here. *Adv. Micro Devices, Inc. v. Adv. Cluster Sys., Inc.*, IPR2025-00862, Paper 14, 2–3.

Despite alleging that IPR2021-00593 (the “*Cisco* IPR”) left a different patent under a “cloud of invalidity” in a way that somehow unsettles expectations for the ’048 Patent (Pet. at 3), Petitioner **does not** contend here that the Board should review the same grounds. Instead, apparently recognizing that it could not succeed

using the art from the *HPE* IPR, Petitioner asks the Board to iteratively review a different multi-reference obviousness challenge. But Petitioner’s decision to pursue different art does not alleviate the strategic advantages provided to Petitioner. *See Videndum Prod. Sols., Inc. v. Rotolight Ltd.*, IPR2023-01219, Paper 9, 12–13 (finding valid roadmapping concerns when different grounds were used based on issues revealed through initial challenge). There is no question that Petitioner “was in a position to gain a benefit” from the *HPE* IPR. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, 10. Nor does reliance on different art solve the fairness and efficiency issues. (*Accord.* Ex. 2006 (noting that repeated challenges “frustrate the purpose” of the AIA)). The challenge should be denied for these reasons as well.

A review of the *General Plastic* factors confirms denial is appropriate. The third *General Plastic* factor weighs heavily in favor of denial for the reasons discussed above. The first factor weighs in favor of denial because Petitioner is challenging the same claims that were previously challenged by its partner. The second, fourth, and fifth factors weigh in favor of denial because Petitioner was aware of the *HPE* IPR almost seven months before it filed its Petition (Ex. 2019 ¶ 19). *See Shenzhen Silver Star Intelligent Tech. Co. v. iRobot Corp.*, IPR2018-00898, Paper 9, 12–13 (noting seven-month delay “weighs strongly against institution”). Petitioner also identified and charted the references applied in the

Petition months before filing the Petition. (Ex. 2016.) And the sixth and seventh factors support denial because any review here will duplicate the efforts of the Board itself and multiple district courts, which is a poor use of resources.

**E. Petitioner’s Claim Construction Positions Also Support Denial**

Petitioner here improperly offers competing constructions for seven different terms in the ’048 Patent, without setting forth which construction(s) it believes are correct. (Pet. at 16–19.) First, in this proceeding, Petitioner fails to take any position on claim construction. The Petition does not state what construction(s) the Board should apply; rather, it just notes that Petitioner and Patent Owner have proposed certain constructions in the district court, without advocating for a particular construction and without taking a position on which construction(s) should apply to the Board’s validity analysis. (Pet. at 16.) Indeed, the Petitioner also mentions there may be “other constructions.” (Pet. at 19.) This does not comply with Petitioner’s obligation to identify “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). As the Federal Circuit has explained, this rule “does not direct a petitioner to raise, address, and apply alternative possible constructions.” *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1383 n.10 (Fed. Cir. 2023).

Second, to the extent Petitioner is offering alternative constructions, it is apparently asking that the Board determine the proper construction of the claims. But Petitioner acknowledges that these are the same issues that were before the

district court. (Pet. at 16 (“In Related Litigation, Petitioner and PO proposed certain constructions.”).) The district court has already resolved all those issues. (Ex. 2011.) Thus, Petitioner is really asking the Board to re-do claim construction that has already been done by the district court. This is not a good use of the Board’s limited resources. *E-One*, Paper 16, 7. Indeed, such duplicative claim construction is either a waste of the Board’s resources, if the Board agrees with the district court, or guarantees inconsistent results, if the Board adopts different constructions.

Third, the claim construction proposals offered by Petitioner are not properly supported. Petitioner must “explain, in detail, how the challenged claim is to be construed with supporting factual and legal analysis.” *Duo Sec., Inc. v. Strikeforce Techs., Inc.*, IPR2017-01064, Paper 7, 8. Rather than provide the necessary analysis, Petitioner merely identifies multiple potential constructions without any arguments that would help the Board determine how to construe the eight identified terms even if the Board wanted to construe them. This type of “choose-your-own-adventure” approach to claim construction is improper. *MIM Software Inc. v. Progenics Pharms., Inc.*, IPR2025-00725, Paper 13, 7–8 (rejecting multiple constructions without explanation of “under what circumstances one construction should be applied over the other [] construction.”).

Fourth, to the extent Petitioner argues that its claim construction positions are supported by the referenced exhibits from the district court action, this too is

improper. “Arguments must not be incorporated from one document into another document.” 37 C.F.R. § 42.6(a)(3). Offloading claim construction to district court briefs, as Petitioner does here, violates this rule. *Microchip Tech. Inc. v. Aptiv Techs. AG*, IPR2024-00558, Paper 12, 10–11. It is an end run around the word limits and independently justifies denial of the Petition. (Pet. at 85 (showing Petition includes 13,964 words).)

These problems are only emphasized by Petitioner’s means-plus-function argument for “remediation host.” (Pet. at 18–19.) Initially, Petitioner acknowledges that it contends this term is “indefinite for lack of corresponding structure.” (Pet. at 18.) As Petitioner is aware, this is improper. *See Google LLC v. Uniloc 2017 LLC*, IPR2020-00397, Paper 11, 10 (declining to institute IPR based on means-plus-function limitations that Petitioner stated were “arguably indefinite”). Nonetheless, Petitioner is clear that it is only identifying “*purported* corresponding structure,” and “[m]erely for compliance with 37 C.F.R. § 42.104(b)(3) *in this IPR*.” (Pet. at 19 (emphasis added).) *But see EBates Performance Mktg., Inc. v. IBM Corp.*, IPR2022-00439, Paper 11, 11 (denying IPR where structure identified “for the purpose of the present invalidity analysis only”).

Furthermore, Petitioner identifies this “purported corresponding structure” only by “stating a bare conclusion that [remediation host] is a mean-plus-function limitation pursuant to 35 U.S.C. § 112(6) and listing the alleged structure and

function with one unexplained citation to the [’048] patent specification.” *Duo Sec.*, Paper 7, 9. As just one example for why this is insufficient, Petitioner “provides no analysis directed to rebutting the [] presumption, under governing Federal Circuit precedent, that § 112(6) is inapplicable” in the absence of the word “means.” *Id.* at 8–9. Additionally, Petitioner is clear that it contends that any corresponding structure for “remediation host” must include an algorithm. (Ex. 1014, 28.) However, the “purported corresponding structure” identified by Petitioner does not include any such algorithm. (Pet. at 18–19.) Therefore, Petitioner’s own arguments undermine any suggestion that it has satisfied 37 C.F.R. § 104(b)(3). *See Innolux Corp. v. Phenix Longhorn LLC*, IPR2025-00044, Paper 11, 22.

#### **F. The Bases For The Petition Are Unclear**

Discretionary denial is also appropriate because the Petition is unclear, forcing both Patent Owner and the Board to guess what Petitioner’s argument may be.

Petitioner was required to support its challenge by “identif[y]ing, in writing and with particularity . . . the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also* 37 C.F.R. §§ 42.104(3)–(5). Petitioner has failed to do so here. For example, although Petitioner alleges that its challenge is based on Freund, Ball, *and* Pujare (Pet. at 8), the Petition fails to identify how Pujare renders

obvious any element of the challenged claims, or how or why a POSITA would be motivated to combine Pujare with Freund and Ball. Similarly, the Petition does not disclose that Lewis is part of the alleged grounds. But Petitioner explains that “Lewis discloses an alternative means of re-routing service requests” in connection with element [1.10]. (Pet. at 43.)<sup>7</sup> In making a similar argument in a Petition for the ’705 Patent, Petitioner included Lewis as part of the grounds. *See Google LLC v. K.Mizra LLC*, IPR2025-01436, Paper 2, 8. So is Petitioner’s challenge based on Freund, Ball, Lewis, and Pujare? Or is it based on Freund, Ball, and Pujare, but not Lewis (as Petitioner claims)? Or perhaps just Freund and Ball? The Board’s job is to evaluate the merits of the challenge, but here the Board would be forced to wade through the Petition just to figure out what the challenge is. This is not a proper use of the Board’s resources. Indeed, the same failures likely require denial on the merits as well. *See EIK Eng’g Sdn. Bhd. V. Wilco Marsh Buggies & Draglines, Inc.*, IPR2020-00344, Paper 7, 12–16 (denying institution under 35 U.S.C. § 312 (a)(3) where petitioner failed to address why all identified references would be combined);

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<sup>7</sup> *See Eton Pharms., Inc. v. Exela Pharma Scis., LLC*, PGR2020-00064, Paper 12, 14 (noting that grounds that do not identify alternative references do not “allow[] Patent Owner the ability to respond and leaves Patent Owner, and the Board for that matter, to guess how the references are applied to each particular ground.”).

*see also Canon Inc. v. WSOU Investment, LLC*, IPR2022-01532, Paper 14, 20 n.8 (“We acknowledge that Petitioner’s obviousness contentions [] rely on Kubo sparingly, if at all . . . [E]ven where Kubo might not be necessary for teaching the limitations of certain terms, we evaluate Petitioner’s obviousness ground as it has been presented in the Petition, which necessarily includes Petitioner’s rationale for combining Kubo with Sugitani.”); *id.* at 34 n.9.

### **G. Petitioner Fails To Establish Material Error**

The “material error” inquiry has its roots in the *Advanced Bionics* case, where it was recognized as an exception to the rule that denial was appropriate if the Examiner has already considered the art during prosecution. *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6, 8. Here, only Lewis was cited in prosecution. (Ex. 1001.) Petitioner bears the burden of identifying the material error. *See, e.g., Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 10, 11. Although Petitioner alleges “material error” during prosecution, it does not really explain what the material error was. Petitioner first alleges that the “[t]he Examiner committed material error because the prior art cited herein” discloses “the exact claimed features.” (Pet. at 1–2.) But “material error” is not synonymous with the merits of the invalidity challenge. *See, e.g., ABS Global, Inc. v. Cytonome/ST, LLC*, IPR2021-00306, Paper 13, 9 n.5 (noting that the inquiry “does not necessarily consider the merits.”). Petitioner then alleges:

The Challenged Claims are therefore unpatentable due to clear material error that occurred during initial examination. *See* EX1005, EX1006, EX1009, EX1013 each in its entirety.

(Pet. at 2–3.) Finally, Petitioner seems to allege that the “material error” is related to the art in the *Cisco* IPR which, again, is for a different patent. (Pet. at 3.) There is no explanation of the specific nature of this “material error.”

Indeed, it appears that Petitioner’s argument is that denial is inappropriate whenever a challenger can identify new art that was not before the Examiner. But this turns the “material error” inquiry of *Advanced Bionics* on its head, suggesting that discretionary denial will never be appropriate if a Patent Owner cannot show the same or materially similar art was in front of the Examiner. In Petitioner’s view, then, Section 325(d) is controlling and Section 314 is irrelevant to the discretionary denial decision.

Even if Petitioner were correct that new prior art by itself could support a finding of “material error,” denial would still be appropriate here. The “material error” inquiry “reflects a commitment to defer to previous Office evaluations.” *Advanced Bionics*, Paper 6, 9. Here, Petitioner fails to establish that the Board should disturb the prior evaluation. Indeed, it appears that Petitioner is attempting to bootstrap some alleged (although still unexplained) material error from the ’705 Patent into this IPR. (Pet. at 3, 4.) But Petitioner does not explain how that material error (even if it existed) infects a patent that, although related, has different claim

scope. A mere disagreement with the Examiner's decision to issue a patent is not material error. *Advanced Bionics*, Paper 6, 9 (no material error where "reasonable minds can disagree" on the issue).

### **III. CONCLUSION**

Discretionary denial is respectfully requested under the facts and factors surrounding the '048 Patent. These factors include the strong settled expectations based on the age of the now-expired '048 Patent and the Parties' previous licensing discussions, the prior rejected IPR challenge, the advanced stage of at least two co-pending litigations, and the lack of clarity based on both claim construction and application of the cited references. When these factors are considered individually, each weighs strongly in favor of discretionary denial and would be sufficient to warrant denial. However, when these factors are evaluated together, discretionary denial is extremely compelling and should be granted. Based on a holistic review of the circumstances here, Patent Owner respectfully asks that the Director exercise discretion to deny institution.

Respectfully submitted,

Dated: November 23, 2025

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## CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a) and (b), I certify that on November 23, 2025, a true and accurate copy of this paper, **PATENT OWNER K.MIZRA LLC'S REQUEST FOR DISCRETIONARY DENIAL**, was served on the following counsel for Petitioner via email, pursuant to Petitioner's consent to e-mail service:

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Dated: November 23, 2025

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