

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETSKOPE, INC.,

Petitioner,

v.

K.MIZRA LLC,

Patent Owner.

IPR2025-01115

U.S. Patent No. 8,234,705

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

TABLE OF CONTENTS

TABLE OF AUTHORITIES	ii
TABLE OF EXHIBITS	iii
I. INTRODUCTION	1
II. INSTITUTION SHOULD BE DENIED UNDER 35 U.S.C. § 314(a).....	2
A. Settled Expectations Favor Denial	2
B. Petitioner Chose Court To Resolve Its Dispute With Patent Owner	2
C. Trial Dates/Schedules Weigh Strongly In Favor Of Denial	3
D. The <i>Fintiv</i> Factors Weigh Strongly In Favor Of Denial	5
E. Petitioner’s Attempt To Leverage Previous IPRs Presents Fairness Issues And Supports Denial	7
F. Recent Proposed Rulemaking Confirms Denial Is Appropriate	10
III. CONCLUSION.....	11

TABLE OF AUTHORITIES

Cases

<i>3M Co. v. Bay Materials, LLC</i> , IPR2023-00243	10
<i>Alliance Laundry Sys., LLC v. Payrange LLC</i> , IPR2025-00950	2
<i>Amazon Web Services, Inc. v. Croga Innovations, Ltd.</i> , IPR2025-00884	8
<i>Analog Devices, Inc. v. Number 14 B.V.</i> , IPR2025-00550	2
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019	4, 6, 7
<i>Arthrex Inc. v. Medshape, Inc.</i> , IPR2025-00053	7
<i>Be Smarter, LLC v. Yonder, Inc.</i> , IPR2025-00970	6
<i>Comcast Cable Commc'ns, LLC v. Entropic Commc'ns, LLC</i> , IPR2025-00183	3
<i>General Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357	9
<i>Illumina, Inc. v. Ravgen, Inc.</i> , IPR2021-01271	10
<i>Koito Mfg. Co. v. Longhorn Auto. Grp.</i> , IPR2025-00955	3
<i>Marktdial Inc. v. Applied Predictive Techs., Inc.</i> , CBM2020-00025	6
<i>Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.</i> , IPR2025-00354	6
<i>Unified Patents Inc. v. Finjan Inc.</i> , IPR2019-01611	9
<i>United Fire Prot. Corp. v. Engineered Corrosion Sols., LLC</i> , IPR2018-00991	8

TABLE OF EXHIBITS

Exhibit No.	Description
2001	Complaint for Declaratory Judgment of Non-Infringement of U.S. Patent No. 8,234,705, <i>Netskope, Inc. v. K.Mizra LLC</i> , No. 5:25-cv-04833 (N.D. Cal.) (ECF No. 1)
2002	Declaration of Charles J. Hausman in Support of Patent Owner’s Request for Discretionary Denial
2003	Screenshot of web page “Technology Partners & Integrations” (https://www.netskope.com/partners/technology-partners-integrations , last accessed Sept. 29, 2025)
2004	Screenshot of web page “Ivanti Acquires MobileIron and Pulse Secure to Deliver Intelligent and Secure Experiences Across All Devices in the Everywhere Enterprise” (https://www.ivanti.com/company/press-releases/2020/ivanti-acquires-mobileiron-and-pulse-secure , last accessed Sept. 29, 2025)
2005	America Invents Act, H.R. 112-98, 112th Cong. (2011)
2006	Scheduling Order, <i>K.Mizra LLC v. Google LLC</i> , 1:25-cv-00236-ADA (W.D. Tex.) (ECF No. 39)
2007	Standing Order Governing Proceedings (OGP) – Patent Cases, J. Albright (W.D. Tex.)
2008	Screenshot of Trial Statistics 01/01/2009 – 10/16/2025, U.S. District Court for the Western District of Texas
2009	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)
2010	Screenshot of Judge William P. Dimitrouleas Median Time-to-Trial Statistics, U.S. District Court for the Southern District of Florida
2011	Screenshot of Judge William P. Dimitrouleas Median Time-to-Trial with Motion to Dismiss Statistics, U.S. District Court for the Southern District of Florida
2012	Defendant Google LLC’s Reply in Support of Its Motion to Dismiss Under Federal Rule of Civil Procedure 12(b)(6), <i>K.Mizra LLC v. Google LLC</i> , 1:25-cv-00236-ADA (W.D. Tex.) (ECF No. 35)

2013	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)
2014	Order Requiring Counsel to Meet, File Joint Scheduling Report and Joint Discovery Report, <i>K.Mizra LLC v. Citrix Systems, Inc. et al.</i> , No. 0:25-cv-60803-WPD (S.D. Fla.) (ECF No. 12)
2015	Google, LLC’s Amended Invalidity Contentions, <i>K.Mizra LLC v. Google LLC</i> , 1:25-cv-00236-ADA (W.D. Tex.) (Aug. 5, 2025)
2016	Petition for Inter Partes Review of U.S. Patent No. 8,234,705 Under 35 U.S.C. §§ 311-319 and 37 C.F.R. §§ 42.1-100, et seq., <i>Citrix Systems, Inc. et al. v. K.Mizra LLC</i> , IPR2025-01468 (Paper 1)
2017	Patent and Trademark Office, Interim Director Discretionary Process, https://www.uspto.gov/patents/ptab/interim-director-discretionary-process , Oct. 21, 2025
2018	Comparison of Petitions for <i>Inter Partes</i> Review from <i>Cisco Systems, Inc. v. K.Mizra LLC</i> (IPR2021-00593) to <i>Netskope, Inc. v. K.Mizra LLC</i> (IPR2025-01115)
2019	Comparison of Expert Declarations from <i>Cisco Systems, Inc. v. K.Mizra LLC</i> (IPR2021-00593) to <i>Netskope, Inc. v. K.Mizra LLC</i> (IPR2025-01115)
2020	Patent and Trademark Office, Notice of Proposed Rulemaking - Revision to Rules of Practice before the Patent Trial and Appeal Board, https://federalregister.gov/d/2025-19580 , Oct. 17, 2025

I. INTRODUCTION

Petitioner initially chose to sue Patent Owner for a declaratory judgment of non-infringement of U.S. Patent No. 8,234,705 (“the ’705 Patent”) in district court (“the DJ Action”).¹ Petitioner now seeks to needlessly expand the dispute to a second forum, asking the Board to institute *inter partes* review (“IPR”) of the same Patent and asserting that its claims are obvious over art that was the subject of earlier, now-dismissed IPR proceedings. Instead of taking note of prior settlements involving the ’705 Patent, Petitioner viewed the past proceedings as a roadmap for challenging the ’705 Patent, admittedly seeking to bolster prior challenges in its renewed attack on the ’705 Patent.

Given the settled expectations with respect to this 13-year-old patent, the pendency of multiple district court actions that will likely reach trial before this challenge will be decided, and Petitioner’s admitted use of the prior IPR as a roadmap for this Petition, Patent Owner respectfully asks that the Petition be denied.

¹ *Netskope, Inc. v. K.Mizra LLC*, No. 3-25-cv-04833 (N.D. Cal.). Petitioner’s district court DJ action carefully avoided bringing a claim for “invalidity,” but invalidity will certainly be an issue if the district court action proceeds given Petitioner’s decision to submit a *Sotera* stipulation in this IPR.

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

A. Settled Expectations Favor Denial

The '705 Patent issued July 31, 2012, more than 13 years before the filing of the Petition here. (Ex. 1001.) A patent in force that long “create[es] strong settled expectations.” *Analog Devices, Inc. v. Number 14 B.V.*, IPR2025-00550, Paper 10, 2 (denying institution for 13-year-old patent). Here, the age of the patent alone is enough to warrant discretionary denial. Petitioner also acknowledges that Patent Owner has licensed the '705 Patent to several of its competitors in the computer security field (Ex. 2001 ¶ 29; Ex. 2002), further strengthening the parties' settled expectations. *Alliance Laundry Sys., LLC v. Payrange LLC*, IPR2025-00950, Paper 11, 3. Petitioner also acknowledges the long history of enforcement of the '705 Patent (Pet. 1–2) against many “major cloud security and technology companies.” (Ex. 2001 ¶ 17.) Indeed, Petitioner is a technology partner with prior defendants Forescout (a party to the prior IPR), Fortinet, and Pulse Secure (which is now part of Ivanti). (Exs. 2003, 2004.) This history further supports Patent Owner's settled expectations.

B. Petitioner Chose Court To Resolve Its Dispute With Patent Owner

In the DJ Action, Petitioner asked only for judgment of non-infringement and declined to request judgment of invalidity. (Ex. 2001 ¶¶ 33-39.) Petitioner offers no rationale to justify bifurcating its dispute with Patent Owner by filing this

Petition, strongly suggesting it intended to impose on Patent Owner the heavier costs and time burdens of two concurrent proceedings while circumventing statutory estoppel under 35 U.S.C. § 315(a). Petitioner’s decision to file a *Sotera* stipulation (Paper 6) acknowledges that invalidity will be an issue in both actions.

Congress was clear that “harassment . . . through ***repeated litigation and administrative attacks***” is improper because it “frustrate[s] the purpose of the section as providing quick and cost-effective ***alternatives*** to litigation.” (Ex. 2005 at 48 (emphasis added)). Rather than using an IPR as an alternative to litigation, Petitioner seeks to use this IPR ***in combination*** with the litigation process to visit upon Patent Owner the exact type of “abuses” that IPRs were designed to avoid and that Congress intended for the USPTO to address. (*Id.*)

C. 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. *See Comcast Cable Commc’ns, LLC v. Entropic Commc’ns, LLC*, IPR2025-00183, 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.”).

One litigation is already scheduled to go to trial well before a Final Written Decision (“FWD”) would be expected around February 21, 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 four months before the FWD deadline. (Ex. 2006.) He has also ordered that “the Court will not move the trial date except in extreme situations.” (Ex. 2007.) 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.”). Even in an “extreme situation,” time-to-trial statistics suggest trial would still occur two months before the FWD deadline in late February 2027. (Ex. 2008 (showing median time-to-trial for district is 22 months).)

The trial date has not yet been set in a second case, *K.Mizra LLC v. Citrix Sys., Inc. et al.*, No. 0-25-cv-60803 (S.D. Fla.) (the “*Citrix Action*”), but that trial is also likely to be held before the February 2027 FWD deadline. The *Citrix Action* was filed in April 2025 and is assigned to Judge Dimitrouleas. (Ex. 2009.) Time-to-trial statistics indicate that this Action is likely to go to trial within 16 months, or around August 2026, more than six months ahead of the FWD deadline. (Ex. 2010.) The median time-to-trial is only slightly longer (around 17 months) where, as here, a motion to dismiss has been filed. (Ex. 2011.)

D. The *Fintiv* Factors Weigh Strongly In Favor Of Denial

The first *Fintiv* factor, IPR2020-00019, Paper 11, 6, is whether a stay has or is likely to be sought in the pending actions. No party has requested a stay, nor is there any indication that a stay would be granted—particularly because estoppel would not apply to non-parties Google and Citrix.

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 invested significant resources in those proceedings and whether that investment will be even greater at the institution deadline. In the *Google* Action, the parties have already fully briefed a motion to dismiss on infringement issues, exchanged infringement and invalidity contentions, and completed claim construction briefing. (Exs. 2006, 2012.) By the institution deadline, the Court will have held a *Markman* hearing (and likely issued a claim construction order), the parties will have served final infringement and invalidity contentions, and only a few months will remain in fact discovery. (Ex. 2006.) Similarly, in the *Citrix* Action, the Court has already devoted significant resources to considering (and denying) defendant's motion to dismiss under 35 U.S.C. § 101. (Ex. 2013.) By the institution decision, the parties will be four months into fact discovery. (Ex. 2014.) These significant investments also weigh strongly in favor

of denial. *See, e.g., Marketdial Inc. v. Applied Predictive Techs., Inc.*, CBM2020-00025, Paper 8, 10-11; *Fintiv*, IPR2020-00019, Paper 11, 10. 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.

The fourth *Fintiv* factor, the overlap between the issues raised in the petition and the parallel proceedings, also supports denial. Each of these matters involves claims of the '705 Patent. Google has also alleged invalidity based on each of the references here advanced, stating that any reference or combination “may be combined with any other reference to demonstrate [] invalidity.” (Ex. 2015.) Citrix, who has requested IPR of the '705 Patent based on the same grounds Petitioner here advances (Ex. 2016), and Petitioner are also likely to assert similar invalidity arguments in court to those advanced here.² The overlap between the proceedings

² A *Sotera* stipulation leaves much room for Petitioner to argue invalidity in court, including on substantially the same grounds raised in an IPR, through the use of system art in combination with here cited references. *Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00354, Paper 11, 2-3. It also has no effect on either the *Google* or *Citrix* Actions and leaves open other invalidity theories. (Ex. 2017 § I.D.)

favors denial. *Arthrex Inc. v. Medshape, Inc.*, IPR2025-00053, Paper 11, 12-13 (finding inclusion of same references in invalidity contentions supports denial).

The fifth *Fintiv* factor examines party identity, and while Petitioner is not the defendant in either the *Google* or *Citrix* Actions, *Fintiv* explicitly states that unrelated cases may still justify a denial to avoid duplication of another tribunal's work, meaning this factor also weighs in favor of discretionary denial. *Fintiv*, IPR2020-00019, Paper 11, 13-14. And recent guidance from the USPTO emphasizes the importance of parallel litigations involving different defendants. For example, the Director's September 16, 2025 Memorandum entitled "PTAB consideration of prior findings of fact and conclusions of law," available at https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf, confirms the importance of these district court proceedings, regardless of party identity.

The sixth *Fintiv* factor, "other circumstances," further tips squarely in favor of denial, as discussed in the other sections of this Request.

E. 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. Here, Petitioner admits that its Petition attempts to build on a previous IPR involving the same

references. (Pet. at 4.) Under similar circumstances, the Director has determined such roadmapping favors denial of institution. *See Amazon Web Services, Inc. v. Croga Innovations, Ltd.*, IPR2025-00884, Paper 9, 2.

A challenge to the '705 Patent filed by Cisco Systems on the same grounds as presented by Petitioner here was previously instituted in IPR2021-00593 (the “Cisco IPR”). (Pet. at 3.) Two others, Hewlett Packard Enterprise and Forescout Technologies, joined that challenge. (Pet. at 3.) Petitioner did not. In that proceeding, the Board’s FWD concluded ***that no claims were unpatentable***. (Ex. 1024.) The Board specifically found that “Petitioner does not explain sufficiently why a [POSITA] would have been motivated to combine Gleichauf, Ovadia, and Lewis in the manner proposed by Petitioner,” or any of the cited references. (*Id.* at 15.)

While the Federal Circuit later remanded that FWD with instructions to the Board to ensure that every motivation-to-combine argument was addressed, the Cisco IPR was first terminated by agreement of the Parties. (Pet. at 4.) Notably, the Board has denied institution in similar situations. *See United Fire Prot. Corp. v. Engineered Corrosion Sols., LLC*, IPR2018-00991, Paper 10, 8-9 (denying institution of a second IPR where patent owner prevailed in a first IPR’s FWD, and Federal Circuit remanded for further consideration), *aff’d*, Paper 18, 15 (finding subsequent termination did not affect analysis).

The Board should be spared the need to devote its scarce resources to retry Petitioner’s iterative, multi-reference obviousness challenge. Yet that is exactly what Petitioner asks it to do here. In fact, Petitioner explicitly attempts to *fill in* the potential holes in Cisco’s challenges through additional arguments and analysis. (Pet. at 4 (noting, in a Section titled “Discussion of Prior IPR Proceedings,” that the Petition “provides further detailed analysis and evidence regarding motivations to combine” as well as “additional mappings and discussions that were not part of the prior IPRs”).) The Petition does not shy away from its roadmapping efforts, and directly responds to Patent Owner’s arguments from the *Cisco* IPR. (Pet. at 26 n.1.) Indeed, except for the roadmapped changes, the Petition and expert declaration are nearly identical to what was filed in the *Cisco* IPR. (Exs. 2018, 2019.) The Board has repeatedly expressed concerns about this type of abuse in denying incremental attacks. *Unified Patents Inc. v. Finjan Inc.*, IPR2019-01611, Paper 18, 16 (finding this factor weighed “heavily” in favor of denial where it was “apparent that Petitioner introduced elaboration meant to preempt arguments made by Patent Owner in [previous] IPR”). Such attacks are “unfair to patent owners and [are] an inefficient use of the *inter parties* review process.” *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 15, 17-18.

Indeed, 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 based on the same art (Pet. at 4) and using the same expert. *Illumina, Inc. v. Ravgen, Inc.*, IPR2021-01271, Paper 12, 20. The second, fourth, and fifth factors weigh in favor of denial because Petitioner was aware of the *Cisco* IPR almost five months before it filed its Petition (Ex. 2001 ¶ 19). *See 3M Co. v. Bay Materials, LLC*, IPR2023-00243, Paper 8, 10 (noting five-month delay supports denial). 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 the Board’s limited resources.

F. Recent Proposed Rulemaking Confirms Denial Is Appropriate

The USPTO recently issued a notice of proposed rulemaking addressing fairness and efficiency issues for IPRs (Ex. 2020) and it further confirms that denial here is appropriate. Even where a petitioner provides a *Sotera* stipulation, patent owners must still deal with “repetitive challenges based on slightly rebranded evidence” or even “materially identical” challenges in both proceedings, and thus “[p]atent owners often spend substantial funds defending their rights against multiple or duplicative challenges.” (*Id.*, 5-6, 9.) In view of these fairness and efficiency concerns, Petitioner’s failure to disclaim any invalidity challenges based on §§ 102 and 103 so as to make the IPR “a complete substitute for at least some phase of the litigation” favors denial. (*Id.*, 12.) Moreover, where a patent

owner prevails, IPRs can still delay resolution “at least 18 months during the IPR proceedings, and potentially longer if the stay remains in place pending any appeal or remand,” thereby resulting in substantial inefficiencies. (*Id.*) This is a particular burden for patent owners who generally have substantially fewer resources than a challenger and thus may be financially unable to sustain infringement claims over such a long period. (*Id.*, 7.)

III. CONCLUSION

Discretionary denial is respectfully requested under the facts and factors surrounding the '705 Patent. These factors include Petitioner's decision to first initiate a district court litigation to resolve its disputes with Patent Owner over the '705 Patent, the strong settled expectations based on the age of the '705 Patent, the prior IPR challenges to it, and the advanced stage of at least two co-pending litigations. 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: October 21, 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 October 21, 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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