

Patent Owner's Brief in Support of Request for Discretionary Denial
IPR2025-01364 (U.S. Patent No. 10,735,320)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIENA CORPORATION,
Petitioner,

v.

K.MIZRA LLC,
Patent Owner.

Case IPR2025-01364
Patent 10,735,320

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST
FOR DISCRETIONARY DENIAL**

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PATENT OWNER'S EXHIBIT LIST

No.	Exhibit Description
2001	10/6/2025 Nokia email
2002	3/26/25 Stewart Memorandum
2003	2/28/25 USPTO Bulletin
2004	3/24/25 APJ Boalick Memorandum
2005	EDTX Complaint
2006	First Amended DCO in Nokia case
2007	NDGA Statistics
2008	10/21/2005 Hearing Transcript
2009	Nokia invalidity contentions excerpted
2010	First Amended Complaint NDGA
2011	FAQs for Interim Processes No. 22
2012	Hausman Declaration

I. INTRODUCTION

Patent Owner K.Mizra LLC (“K.Mizra” or “Patent Owner”) respectfully requests that the Director exercise his discretion and deny institution of this Petition for *inter partes* review of U.S. Patent No. 10,735,320 (Ex. 1001, “the ’320 patent”) under 35 U.S.C. § 314(a).

The Director should deny institution based on application of the *Fintiv* factors as detailed below. The ’320 patent is currently asserted by Patent Owner in two separate district court litigations—one involving Petitioner Ciena Corporation (“Ciena” or “Petitioner”) in the Northern District of Georgia (“NDGA Case”) (Pet. at 87), and another involving defendant Nokia Corporation (“Nokia”) in the Eastern District of Texas (the “EDTX Case”) (*id.*), which is on schedule for trial in August 2026—far ahead of the deadline for a final written decision here, should the Petition be instituted. Moreover, Nokia has informed Petitioner and Patent Owner of its intent to file a “copycat petition of [Petitioner’s] IPR for the ’320 patent” and “concurrently filing a motion for joinder ... regarding the same.” Ex. 2001 (10/6/2025 Nokia email).

Also, owing in part to Petitioner’s substantial delay in filing the Petition, significant investments have already been made in the EDTX Case regarding challenges to validity of the ’320 patent. For example, expansive invalidity contentions have been served in that case including 94 prior art references and 16

individual claim charts that add up to nearly 2000 pages, and include the same primary reference asserted in the Petition. Despite this overlap, Petitioner has failed to quell concerns of inefficiency and inconsistent rulings by timely submitting a *Sotera* stipulation regarding the NDGA Case. Notably, Nokia has also not indicated whether it would submit a *Sotera* stipulation in the event it filed its copycat petition. Ex. 2001.

In addition, as will be addressed in detail in Patent Owner's forthcoming preliminary response, neither of the two grounds in the Petition discloses each limitation of the challenged claims, a fatal flaw warranting denial.

The Director should also exercise his discretion and deny institution under the factors that Acting Director Stewart outlined in her March 26, 2025 memorandum (Ex. 2002) that lists, among others, the following non-exclusive factors:

- The strength of the unpatentability challenge;
- The extent of the Petition's reliance on expert testimony; and
- Settled expectations of the parties, such as the length of time the claims have been in force.

Each of these additional factors further support discretionary denial here: (1) the merits of the Petition are weak; (2) the Petitioner extensively relies on and largely parrots an expert declaration; and, (3) the claims have been in force for many years

and despite Petitioner having notice of the infringement claims for nearly two years have never been subject to challenge at the Office until now.

II. INSTITUTION SHOULD BE DENIED UNDER *FINTIV*

The Director should exercise his discretion to deny institution under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A) (“*Sotera*”); and their progeny, in accordance with the USPTO’s February 28, 2025 guidance withdrawing former Director Vidal’s June 21, 2022 memorandum entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation.” See Ex. 2003 (withdrawing former Director Vidal’s memorandum and citing *Fintiv I* and *Sotera*); see also Ex. 2004 (March 24, 2025 memorandum by Chief APJ Boalick providing further guidance on the rescission).

Under those authorities, the Director may deny institution of petitions when related litigation is co-pending and an IPR would not be “an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential)). When evaluating whether to deny a petition under *Fintiv*, the Director balances six factors. *Fintiv I* at 5-6. “These factors relate

to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* When analyzing and weighing these factors, the Director takes “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* As is addressed below, on balance, the *Fintiv* factors weigh in favor of denying the Petition.

A. *Fintiv* Factor 1: Petitioner has not indicated that it intends to file for any pre-institution or post-institution stays.

Petitioner has not requested a pre-institution stay in the parallel NDGA Case, nor has it given any indication that it plans to do so. Petitioner has also not given any indication that it intends to request a post-institution stay.

Similarly, in the EDTX Case no stay has been requested. Moreover, EDTX is not likely to grant IPR stays, *see, e.g., Force Mos Tech., Co. v. Asustek Comput., Inc.*, No. 2:22-cv-00460-JRG, 2024 U.S. Dist. LEXIS 66423, at *3 (E.D. Tex. Apr. 11, 2024) (Gilstrap, J.) (“[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”) (quoting *Nanoco Techs. Ltd. v. Samsung Elecs. Co.*, No. 20-cv-00038-JRG, 2021 U.S. Dist. LEXIS 134729, at *1 (E.D. Tex. Jan. 8, 2021) (Gilstrap, J.)), especially where all the patents-in-suit are not addressed, as here. *See, e.g., Ex. 2005* (EDTX Complaint) at ¶ 1 (four other patents asserted). The ’320 patent is just one of five patents asserted

in the EDTX Case, and even if the Director grants the Petition here, Judge Gilstrap is unlikely to sever and stay the EDTX Case allegations concerning the '320 patent, as “it is often most efficient to resolve the diverse allegations together in the same action instead of creating numerous distinct cases for every different accused technology, patent, or party.” *Polaris PowerLED Techs., LLC v. Samsung Elecs. Am., Inc.*, No. 2:22-cv-00469-JRG, 2024 U.S. Dist. LEXIS 46070, at *5, *13-17 (E.D. Tex. Mar. 15, 2024) (Gilstrap, J.) (denying motion to sever allegations concerning a patent on which IPR had been instituted and stay that portion of the case); *see also Headwater Research LLC v. Samsung Elecs. Co.*, No. 2:22-cv-00422-JRG-RSP, 2024 U.S. Dist. LEXIS 94021, at *6 (E.D. Tex. May 27, 2024) (rejecting stay where IPR was instituted only as to a subset of the asserted patents because “even an ultimate finding [by the PTAB] invalidating all claims of the other patents would leave material disputes for the Court to decide”); *Cisco Sys., Inc. v. WSOU Investments LLC*, IPR2025-00429, Paper 15 at 2 (PTAB June 25, 2025) (“[T]here is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial.”).

Given these facts, the first *Fintiv* factor weighs in favor of denying institution.

B. *Fintiv* Factor 2: Trial in a parallel district court is estimated to occur six months before the Board's deadline for a final written decision.

The scheduled parallel district court trial date counsels against institution. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution.” *Fintiv I* at 9. Based on the Notice of Filing Date Accorded issued on September 11, 2025, the deadline for a final written decision in this IPR is March 11, 2027, which may be extended to September 13, 2027 for good cause or in the case of joinder. 37 C.F.R. § 42.100(c). In the EDTX Case, trial is scheduled to begin on August 31, 2026—***more than six months*** prior to the statutorily mandated deadline of March 11, 2027 for the instant Petition, if the Board does not require the optional extension. Ex. 2006 (First Amended DCO in EDTX Case). Institution has been previously denied under similar circumstances. *Koito Manufacturing Co., Ltd. v. Longhorn Automotive Group LLC*, IPR2025-00955, Paper 9 at 1-2 (PTAB Sept. 19, 2025) (denying institution where the earliest district court scheduled trial against a third party would predate the projected final written decision by over six months).

And, while the court in the NDGA Case has not yet set a trial date, data from NDGA provides an average median time to trial of approximately 33.97 months based upon the average time to trial for civil cases over the last three years. Ex.

2007¹; Ex. 2004 (March 24, 2025 memorandum by Chief APJ Boalick opining that “the Board may consider any evidence that the parties make of record that bears on the proximity of the district court’s trial date ... including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides.”). Given the NDGA Case’s filing date of November 25, 2024, the trial is anticipated to occur in the September 2027 timeframe. This also favors denial. *See, e.g., Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasy, Inc.*, IPR2025-00354, Paper 11 at 2 (PTAB June 12, 2025) (Stewart, Acting Director) (denying institution where the district court trial was set to occur one-and-a-half months prior to the projected final written decision due date because “[e]xercising discretion to deny the petition in this case reduces the inefficiencies and burdens on the parties to maintain two parallel proceedings”); *EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (“*EClinicalWorks*”) (finding this factor weighed in favor of discretionary denial and denying institution where “the beginning of the jury trial in the WDTX Cases is roughly one or two months before any final decision would have been due had inter partes review been instituted”); *Samsung Elecs. Co. v.*

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SiOnyx, LLC, IPR2025-00064, Paper 16 at 11 (PTAB June 6, 2025) (denying institution in part because the trial date was two months earlier than the final written decision deadline); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (PTAB May 13, 2020) (“*Fintiv I*”) (same); *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 9 (PTAB May 2, 2022) (same), reh’g denied, Paper 20 (PTAB Aug. 25, 2022).

Because of these earlier and proximate trial dates (even without the optional 6-month extension of time), the second *Fintiv* factor weighs in favor of denial.

C. *Fintiv* Factor 3: The court and parties have substantially invested in the parallel EDTX Case, and Petitioner unduly delayed in filing the Petition.

Given the substantial investments in the parallel district court cases, Factor 3 favors denial. This factor relates to the “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*” *Fintiv I* at 9. For example, “if ... the district court has issued substantive orders related to the patent at issue in the petition,” this factor favors denial. *Id.* at 9-10. “Likewise, district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* at 10. Here, the parallel district court cases have and are anticipated to require significant resources to resolve, including infringement and invalidity contentions,

substantial written discovery and responses thereto and associated document productions, including the examination of source code.

For example, the litigants in the EDTX Case have already invested substantial resources in that proceeding, including providing infringement and invalidity contentions, producing documents, and serving and responding to written discovery. *See* Ex. 2006 (First Amended DCO). Moreover, upon projected issuance of an institution decision, on or about March 11, 2026, the Texas parties will have substantially completed all document production; the Texas court will also have held the *Markman* hearing, scheduled for February 19, 2026, and likely issued its claim construction order. *Id.*

Likewise, in the NDGA Case the parties have invested in several rounds of briefing on currently pending motions to dismiss brought by Petitioner. At the October 21, 2025 hearing on those motions, the Court indicated it expects an order before then end of the year (Ex. 2008 (Oct. 21, 2025 Hrg. Tr.) at 39:5-20), after which Patent Owner expects the district court to set a trial date and discovery to begin in earnest.

Because of the substantial investments that either have already been made or will have been made as of the time for the March 2026 institution decision, the third *Fintiv* factor weighs in favor of denying institution. *See, e.g., Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9 at 2 (PTAB

June 12, 2025) (Stewart, Acting Director) (denying institution even though the district court trial would occur *after* the due date for a final written decision as a result “of the parties’ meaningful investment in the district court proceeding,” discovery was underway and *Markman* hearing was set to occur before the due date for an institution decision); *Roku, Inc. v. IOEngine, LLC*, IPR2022-01551, Paper 11 at 12 (PTAB May 5, 2023) (denying institution in part because claim construction was complete and fact discovery was nearly completed); *10X Genomics, Inc. v. President & Fellows of Harvard College*, IPR2023-01299, Paper 15 at 18 (PTAB Mar. 7, 2024) (same); *Samsung Elecs. Co. v. Mojo Mobility Inc.*, IPR2023-01094, Paper 11 at 9 (PTAB Feb. 9, 2024) (same).

Moreover, a significant reason that the EDTX Case will have progressed so significantly is because Petitioner unduly delayed in filing the Petition. The Petition was filed on August 28, 2025, over nine months after the filing of the complaints in the parallel district court cases in November 2024. Pet. at 87. Making Petitioner’s filing delay more egregious, the record demonstrates Petitioner was aware of the ’320 patent for at least eighteen months before filing the Petition. *See infra* § III.C. Petitioner offers no explanation for its extensive delay.

Because there has been and will be substantial investment in the parallel district court cases on the ’320 patent and Petitioner unduly delayed in filing the Petition, *Fintiv* Factor 3 weighs in favor of denial.

D. *Fintiv* Factor 4: The petition and the parallel proceedings raise substantially overlapping issues, and Petitioner has not submitted a *Sotera* stipulation to quell concerns of inefficiency and inconsistent rulings.

There is substantial overlap in the issues raised in the Petition and the parallel district court cases favoring denial. This factor looks at “whether all or some of the claims challenged in the petition are also at issue in district court” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv I* at 12-13. Here, substantially all of the challenged claims are asserted in the parallel district court cases and no party has submitted a *Sotera* stipulation to limit redundancy and inconsistent rulings.

In the EDTX Case, Nokia has asserted invalidity of claims 1-5, 7-12, and 14-20 of the '320 patent. Ex. 2009 (Nokia invalidity contentions excerpted).² The substantial overlap of the claims at issue counsels against institution. *See, e.g., Pharaoh Energy Servs., LLC v. Flex-Chem Holding Co.*, IPR2024-00815, Paper 7

² That the instant Petition also challenges dependent claims 6 and 13 that are not being litigated in Texas is immaterial. *See e.g. Samsung Elecs. Co. Ltd. v. Secure Wi-Fi LLC*, IPR2024-01367, Paper 10 at 16 (PTAB Mar. 24, 2025) (finding that “challenging several dependent claims [did] not mitigate any of the concerns that guide [the *Fintiv*] analysis.”).

at 13-14 (PTAB Sept. 20, 2024) (denying institution in part because the same claims were challenged at the PTAB and asserted in litigation); *EClinicalWorks* at 12 (same). Among the various prior art references asserted is the same *Murphy* reference that Petitioner relies upon as a primary prior art reference in its obviousness combinations for Grounds 1 and 2 of the Petition. Ex. 2009 (Nokia invalidity contentions excerpted) at 6; Pet. at 24. Given Nokia's stated intention of filing a duplicative "copycat" petition and seeking joinder, this would result in significant duplicative effort. Ex. 2001 (10/6/2025 Nokia email).

In the NDGA Case, the issues are also expected to be duplicative. Like in the EDTX Case, the same claims challenged in the Petition are also at issue. Pet. at 1, 4; Ex. 2010 (NDGA First Amended Complaint (FAC)). Although Petitioner has not yet indicated what prior art it intends to rely upon in the NDGA Case, Petitioner's failure to timely submit a *Sotera* stipulation by the deadline, or at all at this point in time, guarding against potential duplicative effort by the parties weighs against institution. On April 17, 2025, the PTAB held a Boardside Chat (*see* archived video at <https://www.youtube.com/watch?v=TwaTg4pbfPg> ("April 17 Boardside Chat"), last accessed October 15, 2025) explaining updates to the discretionary denial procedure. During the Q&A portion, Acting Senior Lead Advisor to the Acting Director, Michelle Ankenbrand, stated that petitioners who wished to have a *Sotera* stipulation "taken into account for purposes of discretionary decision making ...

must file the stipulation *no later than one month* after the notice of filing date accorded to a petition” to give patent owner the opportunity to address that stipulation. *See* April 17 Boardside Chat at 29:09-31:18 (emphasis added). Here, that deadline has passed; thus, even if Petitioner later elected to later submit a *Sotera* stipulation, it should not be considered for purposes of discretionary denial.³ By failing to submit a *Sotera* stipulation, Petitioner has essentially reserved itself a second bite at the apple with the freedom to retry prior art challenges in the parallel NDGA Case rendering “the overlap in issues between the two proceedings ... substantial.” *See, e.g., Code200, UAB v. Luminati Networks, Ltd.*, IPR2020-01506, Paper 10 at 11-12 (PTAB Feb. 16, 2021) (finding Factor 4 weighed in favor of denial of institution where there were common prior art challenges between the proceedings); *see also U.S. Venture, Inc. v. Sunoco Partners Mktg. & Terminals LP*, IPR2020-00728, Paper 10 at 11-12 (PTAB Oct. 1, 2020) (holding that overlap between primary references, even without overlap of all secondary references,

³ Moreover, if Petitioner eventually submits a *Sotera* stipulation before the Board renders its decision on whether to deny the institution, the fact of such stipulation is not dispositive under the Office’s current discretionary denial policies; rather, “the Board will consider such a stipulation as part of its holistic analysis under *Fintiv*.” *See* Ex. 2002.

weighed in favor of institution denial), reh'g denied, Paper 13 (PTAB Dec. 17, 2020); *DataDome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 13 at 3 (Aug. 14, 2025) (“Although there is no scheduled trial date ... Petitioner has not offered a stipulation to address concerns of duplicative efforts and potentially conflicting decisions, which weighs in favor of discretionary denial.”).

Because of the substantial overlap of claims and prior art at issue, as well as Petitioner's failure to offer a stipulation that quells efficiency concerns stemming from that overlap, the fourth *Fintiv* factor weighs in favor of denying institution.

E. *Fintiv* Factor 5: Petitioner is the parallel proceeding defendant.

Petitioner is the defendant in the parallel NDGA Case, and thus “this factor weighs in favor of discretionary denial.” Pet. at 87; *Fintiv II* at 15.

F. *Fintiv* Factor 6: None of the grounds asserted by Petitioner render the claims unpatentable because they do not disclose the core limitations of the claims.

The combinations offered in the Petition fail to disclose certain limitations in the independent claims favoring denial. The Petition asserts two grounds. Pet. at 24-86. Ground 1 relies on *Murphy* as a base reference in combination with secondary reference, *Taguchi*, to challenge the independent claims of the '320 patent. *Id.* at 24-78. However, as will be further detailed in Patent Owner's forthcoming Preliminary Response, neither *Murphy* nor *Taguchi* disclose the claim limitation “stored data

[that] indicates, for a sending device application, a distributed mapping of the application flow via at least one of the plurality of pseudowires” as required by each of the independent claims. *See, e.g.*, Ex. 1001 at 8:58-61.

Petitioner appears to contend that *Murphy*'s “LSPs” are the claimed pseudowires. *See, e.g.*, Pet. at 25-27. *Murphy* discloses the mapping of either two flows to a single LSP or a 1-to-1 mapping of a single flow to a single LSP as shown Figure 4 of *Murphy*. *See, e.g.*, Pet. at 57 (citing Ex. 1005 at Fig. 4). As explained in the '320 patent, mapping multiple flows to a single pseudowire as in *Murphy* is ***aggregated*** mapping—not ***distributed*** mapping, which is described in the '320 patent as mapping an application flow to multiple pseudowires, *e.g.*, splitting a large flow into multiple pseudowires. Ex. 1001 at 4:31-35, 5:57-6:12.

Petitioner attempts to combine *Murphy* with *Taguchi* to fill this gap. *See* Pet. at 58-61. However, *Taguchi* does not disclose a distributed mapping either. Instead, *Taguchi* teaches a data stream or session transported on a virtual communication path comprising LSPs and dynamically selecting such path based on Class of Service (CoS). *See, e.g.*, Ex. 1006 at ¶¶ 28, 46, 191. A stream is transported on a selected path at a selected time, *i.e.*, sequential path selection, rather than distributing the flow across the multiple paths. *Id.* Therefore, *Taguchi* does not cure the deficiencies of *Murphy*. Ground 2 challenges claims 6 and 13, which depend on independent claims 1 and 8, and therefore also fails for at least the same reasons. Accordingly, because

Grounds 1 or 2 fail to render the challenged claims unpatentable, the sixth *Fintiv* factor weighs in favor of denying institution.

III. ADDITIONAL FACTORS SET FORTH IN THE DIRECTOR'S MEMORANDUM SUPPORT DISCRETIONARY DENIAL

A. The Strength of the Unpatentability Challenge

The Director's Memorandum⁴ lists "[t]he strength of the unpatentability challenge" as one factor based upon which the Director may determine to deny institution. Ex. 2002. As previously explained for *Fintiv* Factor 6, "[t]he strength of the unpatentability challenge" is weak and the Petition lacks adequate support. *See supra* § II.F. The Petition therefore fails to show a reasonable likelihood of prevailing.

B. The Extent of the Petition's Reliance on Expert Testimony

As further enumerated in the Director's Memorandum, a relevant consideration is "[t]he extent of the petition's reliance on expert testimony." Ex. 2002. Here, the Petition relies extensively on the 94-page expert declaration of Dr. A.L. Narasimha Reddy (Ex. 1003), using the same language and citing to his declaration throughout for both grounds for all claims of the '320 patent. *See generally* Pet. Petitioner therefore failed to provide "focused expert testimony." *See*

⁴ The Director's Memorandum is available on the USPTO website at: <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>.

Ex. 2011 (FAQs for Interim Processes No. 22).

Moreover, when, as here, a petition relies on an expert declaration that is duplicative of the attorney arguments in the Petition, such circular citations are afforded little weight and favor discretionary denial. *See, e.g., Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15-17 (PTAB Aug. 24, 2022) (precedential) (denying institution and noting that the petitioner's expert declaration "merely repeats, verbatim, the conclusory assertion for which it is offered to support ... and is entitled to little weight"), *sua sponte Director Review*, Paper 12 at 5 (PTAB Feb. 10, 2023) (affirming denial of institution and "giving little weight to Petitioner's expert because the expert declaration merely offered conclusory assertions without underlying factual support and repeated, verbatim, Petitioner's conclusory arguments"), *POP Review denied*, Paper 13 (PTAB Feb. 10, 2023). Because the Petition cites Dr. Reddy's declaration over 200 times, and essentially repeats Petitioner's attorney argument nearly verbatim, such declaration should be accorded little weight here as well and the Director should discretionarily deny the Petition.

C. Settled Expectations of the Parties

The Director's Memorandum also lists "[s]ettled expectations of the parties, such as the length of time the claims have been in force" as another factor based upon which the Director may determine to deny institution. Ex. 2002. The expectations of the parties for the '320 patent claims are well-settled.

Patent Owner's Brief in Support of Request for Discretionary Denial
IPR2025-01364 (U.S. Patent No. 10,735,320)

The '320 patent claims were issued over five years ago on August 4, 2020 (Ex. 1001), and Patent Owner has paid maintenance fees, both of which militate against institution. *See, e.g., Samsung Elecs. Co., Ltd. v. GenghisComm Holdings, LLC*, IPR2025-00793, Paper 12 at 2-3 (PTAB August 22, 2025) (Desphande, Acting Deputy Chief Administrative Patent Judge) (denying institution where issuance dates for patents at issue spanned 2019-2022).

Additionally, Petitioner has known of the '320 patent since *at least* February 2024. Ex. 2010 (First Amended Complaint, ¶¶ 60-66). It was not until the filing of the Petition, in August of 2025, *eighteen months later* that Petitioner sought to challenge the '320 patent. This delay further supports the settled expectations of the parties. *See DataDome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 13 (Aug. 14, 2025) (denying institution where patent owner gave pre-suit written notice in December 2023 to petitioner identifying challenged patents).

The Petitioner and Patent Owner are not the only parties to have well-settled expectations with regard to the '320 patent. Prior to this Petition, the '320 patent has been licensed to multiple third-party industry competitors of Petitioner. Ex. 2012.

Patent Owner's 5 years of settled expectations in the '320 patent claims as well as Petitioner's knowledge of the '320 patent for more than eighteen months, and the reliance of third parties in obtaining licenses to the '320 patent all weigh heavily in favor of discretionary denial.

IV. CONCLUSION

The Director should exercise his discretion to deny institution of the Petition because each of the *Fintiv* factors weigh in favor of denial of institution. In addition, several of the considerations set forth in the Director's Memorandum likewise counsel in favor of exercising discretion to deny institution here.

Respectfully Submitted,

Dated: November 12, 2025

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the page count for all portions of the foregoing Patent Owner's Brief in Support of Request for Discretionary Denial totals 19 pages per Microsoft Word, which complies with the requirement of 20 pages allowed under the Interim Director Discretionary Process. *See* Interim Director Discretionary Process (II)(C)(iii) (<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>).

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CERTIFICATE OF SERVICE

As authorized by Patent Owner's Mandatory Notice, I hereby certify that on November 12, 2025, a copy of this document has been served in its entirety by electronic mail on Petitioner's lead and backup counsel.

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