

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. IPR2025-01364

U.S. Patent 10,735,320

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

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PETITIONER’S LIST OF EXHIBITS

Exhibit	Brief Description
1001	U.S. Patent No. 10,735,320 (“the ’320 Patent”)
1002	Prosecution History for U.S. Patent No. 10,735,320
1003	Declaration of Dr. Reddy
1004	Prosecution History for U.S. Patent No. 10,411,999 (parent to the ’320 Patent)
1005	U.S. Patent No. 7,477,657 (“ <i>Murphy</i> ”), filed May 8, 2002.
1006	Certified Translation of Japanese Patent Application Publication No. JP 2003-258857 (“ <i>Taguchi</i> ”), with certification of translation.
1007	<i>Awduche et al.</i> , “Internet traffic engineering using multi-protocol label switching (MPLS),” Elsevier Science B.V., Computer Networks 40, 111-129 (2002) (“ <i>Awduche</i> ”)
1008	U.S. Patent Application Publication No. 2004/0165600 (“ <i>Lee</i> ’600”)
1009	Certified Translation of Korean Patent Application Publication No. KR 10-2005-0077938 (“ <i>Lee</i> ’938”), with certification of translation, published August 4, 2005.
1010	<i>Deering et al.</i> , “Internet Protocol, Version 6 (IPv6),” The Internet Society, Network Working Group, Request for Comments: 2460 (December 1998) (“ <i>Deering</i> ”)
1011	<i>Stewart et al.</i> , “Stream Control Transmission Protocol,” The Internet Society, Network Working Group, Request for Comments: 2960 (October 2000) (“ <i>Stewart</i> ”)
1012	<i>Harry Newton</i> , “Newton’s Telecom Dictionary,” Miller Freeman, Inc., Fifteenth Edition (February 1999) (“ <i>Newton</i> ”)
1013	<i>Claise, et al.</i> , “Cisco Systems NetFlow Services Export Version 9,” The Internet Society, Network Working Group, Request for Comments: 3954 (October 2004) (“ <i>Claise</i> ”)
1014	<i>Basel et al.</i> , “Ports, Protocols, and Services Management Process for the Department of Defense,” Software Engineering Technology, Systems & Software Technology Conference (April 2005) (“ <i>Basel</i> ”)

Exhibit	Brief Description
1015	U.S. Patent Application Publication No. 2004/0037279 (“ <i>Zelig</i> ’279”), published February 26, 2004
1016	U.S. Patent Application Publication No. 2006/0285500 (“ <i>Booth</i> ”), filed June 15, 2005.
1017	U.S. Patent Application Publication No. 2004/0133619 (“ <i>Zelig</i> ’619”), published July 8, 2004.
1018	U.S. Patent Application Publication No. 2005/0013300 (“ <i>Akahane</i> ”), published January 20, 2005
1019	<i>Tschofenig et al.</i> , “RSVP Security Properties, draft-ietf-nsis-rsvp-sec-properties-06.txt,” The Internet Society, Internet-Draft (February 20, 2005)
1020	<i>Awduche et al.</i> , “Requirements for Traffic Engineering Over MPLS,” The Internet Society, Network Working Group, Request for Comments: 2702 (September 1999) (“RFC 2702”)
1021	Applications and Patents related to the ’320 Patent. Pulled from Patent Center on August 24, 2025
1022	<i>Bur Goode</i> , “Voice Over Internet Protocol (VoIP),” Proceedings of the IEEE, Vol. 90, No. 9 (September 2002) (“ <i>Goode</i> ”)
1023	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
1024	Complaint, <i>K.Mizra LLC v. Ciena Corp.</i> , Case No. 1:24-cv-05442 (N.D. Ga), Dkt. 1 (Nov. 25, 2024)
1025	Docket Sheet, <i>K.Mizra LLC v. Ciena Corp.</i> , Case No. 1:24-cv-05442 (N.D. Ga), retrieved Dec. 9, 2025
1026	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)
1027	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)

Exhibit	Brief Description
1028	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)
1029	Lawsuits filed by K.Mizra LLC, retrieved from Docket Navigator (docketnavigator.com) Dec. 10, 2025
1030	Proceedings Involving the '320 Patent, retrieved from Docket Navigator (docketnavigator.com) Dec. 10, 2025

I. INTRODUCTION

Ciena Corporation (“Petitioner”) opposes the request by K.Mizra LLC (“Patent Owner” or “PO”) for Discretionary Denial of Institution (Paper 6, “Request”). The ’320 Patent never should have issued, as demonstrated by the strong, new evidence of invalidity in the Petition. The Petition is based on prior art that was not before the Patent Office during examination. The prior art teaches the very limitation that was thought to be missing from the prior art during the original prosecution that led to the erroneous issuance of the patent. Patent Owner does not even request denial under 35 U.S.C. § 325(d), underscoring the importance of this Petition to the validity of the ’320 Patent and the integrity of the patent system.

There is no basis to give the invalidity of the ’320 Patent a pass under *Fintiv*. 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. Patent Owner attempts to rely on an unrelated case it brought against several Nokia parties to create a *Fintiv* issue. However, Petitioner is not a party to that litigation, which is directed to materially different issues at least because the grounds of invalidity in the Petition are not present in that litigation. Thus, the *Fintiv* factors weigh in favor of institution, and it would be manifestly unfair to Ciena, and prejudicial to the integrity of the patent

system, to use the unrelated Nokia case to skirt the critical invalidity challenge presented in the Petition. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (March 20, 2020) (precedential) (“*Fintiv*”).

There is also no basis to shield the ’320 Patent’s invalidity using the new “settled expectations” doctrine. To the extent the doctrine is valid at all, it does not apply — the ’320 Patent is **just five years old**.

For these and the reasons below, Petitioner respectfully requests that the request for discretionary denial be denied and that *inter partes* review be instituted on the merits.

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-1024. In addition to the instant patent, K.Mizra asserted U.S. 9,485,176 (“the ’176 Patent”) and U.S. 8,782,282 (“the ’282 Patent”), which Ciena contemporaneously challenges in IPR2025-01362.

K.Mizra also filed suit against several Nokia parties unrelated to Petitioner, on a distinct 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*, Case 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 (the one subject to Ciena’s petition in IPR2025-01362) in the Nokia Litigation. *Id.* Ciena is unaware of the patent challenged in the present IPR having ever been asserted prior to November 2024.

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-1025 (Dkt. 21, 22). The motions automatically stayed the case. EX-1026, 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-1027 39:10-15.

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 Petition 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 '320 PATENT

A. The Petition Demonstrates that the '320 Patent Should Never Have Been Issued

As explained in the Petition, the '320 Patent issued based on the Examiner's mistaken belief that the prior art did not show a “distributed mapping” of an application flow to a plurality of pseudowires. Petition, 12-13. But *Taguchi* teaches that very feature, and the Petition puts forward compelling evidence that it would have been obvious to combine *Murphy* with *Taguchi* to achieve that very purpose, while teaching all limitations of the claims. Petition, 1-5, 56-61. Patent Owner is wrong when it argues that *Taguchi* instead teaches “sequential path selection, rather

than distributing the flow.” Req. 15 (citing Ex. 1006 at ¶¶ 28, 46, 191). But, to the extent the Patent Owner’s arguments are even commensurate with the claim requirements, it is incorrect and ignores the contrary evidence presented in the Petition. For example, Patent Owner ignores that *Taguchi* disclosed that when its “virtual communication path” had multiple LSP paths, (*see Taguchi* Fig. 1, ¶52, Pet. 59), “the stream” — singular — “is transferred while being scheduled **for each LSP** so as **not to exceed the resource capacity of each LSP.**” EX 1006 ¶73; EX 1003 ¶132. By distributing the single stream onto the two paths, *Taguchi* was able to send a stream that might otherwise “exceed” the capacities of the individual paths. *Id.* Patent Owner’s argument lacks merit.

Thus, the very basis upon which the grant of the ’320 Patent rests is eviscerated by the Petition. The patent is invalid. It never should have issued. The Patent Office should protect the integrity of the patent system by instituting review and invalidating the patent claims, or at the very least, adjudicating the serious question of patentability presented by *Taguchi* in the Petition. Discretionary denial under these circumstances would do violence to the patent system and core principles of free market competition.

**B. Review Is Warranted to Correct the Error in Granting the
’320 Patent**

Patent Owner does not make any arguments under Section 325(d), effectively conceding that the grounds in the Petition present an important challenge never

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 '320 Patent.

V. THE *FINTIV* FACTORS WARRANT INSTITUTION

The *Fintiv* factors warrant consideration of the merits and institution of review.

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-1026, 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-1025 (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-1027, 39:5-6, 40:7-11, 17-20.

The Patent Owner relies heavily on the Nokia Litigation to argue that denial is warranted under the *Fintiv* factors. *Fintiv* Factor 1, however, still weighs in favor of institution in view of the Nokia Litigation, as any stay of that case remains speculative, and thus does not materially change the analysis. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (May 13, 2020) (informative) (“We decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here.”); *Sand Revolution II, LLC v. Continental Intermodal Group*, IPR2019-01393, Paper 24 at 7 (June 16, 2020) (informative). Thus, on balance 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-1025, 8-10; EX-1026, 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-1023, 093; Req. 6 (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* IPR2025-01364 Paper 5 (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 request for discretionary denial where FWD would precede trial by nine months). Even according to Patent Owner’s unreasonable projections, the trial would still not occur until September 2027, *a full six months* behind the FWD deadline here. *See* Request 6-7. 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.

The Patent Owner nonetheless relies heavily on the Nokia Litigation to argue that denial is warranted under the *Fintiv* factors. *Fintiv* Factor 2, however, still weighs in favor of institution, notwithstanding the Nokia Litigation’s potential for an earlier trial. While the Nokia trial is currently scheduled to occur six months prior to the FWD, that venue routinely schedules multiple cases to the same trial date (an impossibility) and the cases regularly settle or are delayed for assorted reasons. *See, e.g., Multimedia Techs. PTE Ltd. v. LG Elecs. Inc., et al.*, 2:22-cv-00494-JRG-RSP, Dkt. 273 (E.D. Tex. Mar. 18, 2025) (noting cases still set ahead of case subjected to five-months delay: “[t]his case has been set for trial five times: November 18, 2024, January 27, 2025, February 7, 2025, March 3, 2025, and March 17, 2025. The parties

have also been notified that other cases are preferentially set ahead of them for the April 7, 2025 and April 21, 2025 trial settings.”). The existence of a trial at all is speculative and beyond any control or influence of Petitioner. Nokia and K.Mizra could settle their litigation (or drop the ’320 Patent) at any moment without notice or recourse for Ciena.

On balance, this factor still weighs in favor of 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-1026, 7-8; EX-1025. 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.

Factor 3 still weighs against denial notwithstanding the Nokia Litigation. At institution, much invalidity work appears to remain in that case: fact discovery will

still be ongoing and expert discovery will not have started. EX-2006. Patent Owner does not assert, and Petitioner has no knowledge, of whether the parties in the Nokia Litigation are even presenting any terms of the '320 Patent for construction by their judge.

While there has been some investment by Patent Owner in its case against Nokia, and Patent Owner attributes that to purported delay by Ciena in bringing the instant Petition, 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 can hardly complain that its case is progressing more quickly in the Eastern District of Texas than the Northern District of Georgia, as it chose the venues, targets, and timing of its suits. Third, 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-1024, 142-143; EX-1027, 36:9-11 (counsel for Patent Owner: “Have the claim charts changed? Sure they’ve change[d].”); EX-1028, 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. Notwithstanding some level of investment in the unrelated Nokia Litigation, this factor still 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.

Factor 4 also weighs in favor of institution in view of the Nokia Litigation. Critically, the combination of *Murphy* and *Taguchi* forms the basis of all grounds in the Petition, but that combination is not even present in the Nokia Litigation. *See* Req. 12; EX-2009 (excerpted invalidity contention). *See Fintiv*, 12-13 ("materially different grounds, arguments, and/or evidence" weighs against denial); *Unified Patents, LLC v. Navblazer LLC*, IPR2020-00983, Paper 11, 8-9 (Dec. 16, 2020) (factor weighs against denial where references are not the same.). Tellingly, Patent

Owner is silent as to *Taguchi*. As discussed above, the Petition here uses *Taguchi* to teach the distributed mapping limitations of the independent claims that led to the issuance of the '320 Patent. *Supra* §IV.A. Thus, this is a material difference that weighs against discretionary denial.

Perhaps understanding the weakness in its argument, Patent Owner posits that there will be “significant” duplicate effort *if* Nokia moves to join the Petition. While Nokia raised the possibility of joinder months ago (EX-2001), it did not pursue joinder and is now time barred. *See Realtek Semiconductor Corp. v. Parkervision, Inc.*, IPR2025-00324, Paper 11, at 3 (June 25, 2025) (joinder of time-barred petitioner requires “exceptional circumstances”). Thus, the notion of a Nokia joinder is highly speculative. More to the point, *Taguchi* is not in the Nokia Litigation, and the Eastern District of Texas is well known for its strict rules for amending contentions. That is the dispositive issue, and joinder does not change those facts. The *Fintiv* question under this factor is whether the *litigation* and this Petition would have materially different grounds or evidence—they would. *Fintiv*, 12-13.

Thus, this factor weighs in favor of institution.

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

Factor 5 weighs in favor of institution. As to the Ciena Litigation, 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).

While Patent Owner relies heavily on the Nokia Litigation to argue that denial is warranted, that is improper under Factor 5. Factor 5 weighs in favor of institution as Ciena is not a party to the Nokia Litigation. *Fintiv*, 13-14; *Navblazer*, IPR2020-00983, Paper 11, 9. Indeed, that case is a completely different, unrelated litigation with a distinct set of patents, in a different jurisdiction, against different products and parties, and having a significantly different procedural posture. *See supra* §II. Ciena has no control or involvement in that litigation, and no knowledge of whether the assertions Patent Owner makes about that case are accurate or realistic. Denial of Ciena’s Petition under *Fintiv* based on the unrelated litigation would be unfairly prejudicial to Ciena.

As discussed above for Factor 4, the invalidity grounds in the Nokia Litigation are not the “same as, or substantially similar to, those already or about to be litigated” in this case, making discretionary denial particularly improper over the Nokia Litigation. *Fintiv*, 14.

On balance, this factor weighs in favor of institution.

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

1. The Strong Merits Favor Institution

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.

2. The Pending Rule Making Is Not Complete and Thus it Would be Improper for the Patent Office to Use Third-Party Litigation Like the Nokia Litigation to Implicitly Deny Institution Prior to Any New Rule Being Effective

The Patent Owner’s arguments relying on the Nokia Litigation appear to assume that the pending Notice of Proposed Rule Making (90 Fed. Reg. 48,335 (Oct. 17, 2025)) has concluded and resulted in new, broad regulations that would effectively bar any IPR if another forum will likely have a trial that considers prior art invalidity. That is not the case. For the very reason the Patent Office needed to go through official notice-and-comment rulemaking, the Patent Office could not now act as if notice-and-comment rulemaking were unnecessary. Moreover, such a rule and/or reason for denying this Petition would be beyond any authority granted to the

Patent Office by the AIA, and would effectively nullify the AIA, including its statutory provisions on when an IPR will be considered timely. Thus, such a rule and/or reason for denying this Petition would violate the AIA, APA, and the U.S. Constitution.

VI. THE SETTLED EXPECTATIONS DOCTRINE DOES NOT WARRANT SHIELDING THE '320 PATENT FROM REVIEW

The '320 Patent issued on August 4, 2020, just five years before the Petition was filed. EX-1001. That is too young under the new settled expectations doctrine. *Shenzen Tuozhu Technology Co., LTD v. Stratasys, Inc.*, IPR2025-00611, Paper 10 (Jul. 17, 2025) (rejecting settled expectations argument for denial because patents issued in 2020 had “not been in force for a significant period of time”). The '320 Patent is likewise too young as compared to the six-year period that the Director has referenced in support of the settled expectations doctrine. *Dabico Airport Solutions Inc. v. AXA Powers APS*, No. IPR2025-00408, Paper 21 (June 18, 2025) (referencing the six-year statutory limit on past damages to justify doctrine and deny review of a patent that had been “in force for almost eight” years). Thus, even to the extent that the settled expectations doctrine is valid, here the patent is too young for the Petition to be denied on that basis.

Patent Owner posits briefly that the '320 Patent has been “licensed to multiple third-party industry competitors” (Req. 18; EX-2012), but Patent Owner fails to justify why that should expand the new settled expectations doctrine to a young

patent here. Under well-known principles, 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). It is telling what Patent Owner does not say. Patent Owner provides no information about critical details of the license—e.g., whether the license covers other unidentified patents, and if so, the relative contribution of the '320 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 even begin to discern whether the purported licensee took the license “out of recognition” of the '320 Patent. *Id.* Public records show that K.Mizra brought and terminated at least 18 lawsuits. EX-1029. However, Ciena is unable to find any public record of the '320 Patent having been asserted in anything other than the Ciena Litigation and Nokia Litigation. EX-1030. Thus, any license is likely nothing more than a portfolio license taken by one or more of the 18 defendants (EX-1029) to settle litigation asserting *other* patents, i.e., having nothing to do with the “settled expectations” of anyone regarding the '320 Patent. In short, K.Mizra has not shown that there are licenses that would be probative of the “settled expectations” of the '320 Patent, as is its burden on its motion. *See Geotab USA, Inc. v. Omega Patents, LLC*, IPR2023-00504, Paper 11, at *16 (July 25, 2023) (citing 37 C.F.R. § 42.20(c)).

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.

VII. 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. Reddy (EX-1003) fails for several reasons. Req. 16-17. Dr. Reddy'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.

VIII. CONCLUSION

When viewed holistically, the Petition's timing is reasonable, the Ciena Litigation is stayed, and the Petition provides an overwhelming case of unpatentability that is *not* present in the Nokia Litigation. The patent is too young

for the settled expectations doctrine, and there is no probative evidence that the patent has ever been commercialized, marked, or successfully licensed or asserted. It would be manifestly unfair, irrational, and anti-competitive to prop up a patent like the '320 Patent by shielding it from such a meritorious *inter partes* review. At a minimum, the integrity of the patent system and reputation of the Patent Office calls for consideration of the merits of the new evidence of invalidity presented in the Petition. The Director should decline to exercise his discretion and allow the Petition to be considered on its merits as a good and appropriate use of the Board's resources.

Date: December 11, 2025

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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:

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