

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC
Petitioner

v.

K.MIZRA LLC
Patent Owner

Case No. IPR2026-00254
Patent 8,144,717

**PETITIONER'S SUR-REPLY TO PATENT OWNER'S REQUEST
FOR DISCRETIONARY DENIAL**

In response to Patent Owner’s Reply in Support of Request for Discretionary Denial (Paper 12, “PO Reply”), Petitioner maintains that discretionary denial is unwarranted (*see* Paper 11, “Opp.” and reasons below).

First, the PO Reply would have the Board condone a materially flawed Examiner search strategy with little to no keyword variance and overly restrictive search operators/clauses. Opp., 4-7. The Examiner’s narrow keyword search strategy required the term “non-associated” (and variants thereof) in 37 of the 50 searches performed by the Examiner, thereby excluding relevant synonyms such as the more common term “unassociated” which appears in Yoon. EX1002, 18-23, 26 (searches L4-L15, L19-L25, L29, L31-L37, L41-L42, S7-S11, S15-S18, S20-S21, S23).

The remaining 13 Examiner searches failed to cure the flawed search: (i) six were broad classification searches with no keyword limitations that yielded unmanageable results (L16-L18, L38-40); (ii) five were starting point searches—three of which were identical and yielding over 125,000 hits—that were immediately narrowed using the term “non-associated” already discussed (L1, L28, L30, S6, S14); and (iii) two were inventor and assignee searches that were also immediately narrowed using the term “non-associated” (S19, S22). EX1002, 18-23, 26.

Petitioner’s examples demonstrating how Yoon could have been uncovered are not a “reverse-engineered” argument based on the terms used in Yoon. A “reverse-engineered” search would have proposed terms used excessively in Yoon,

such as the term “isolated” to replace the uncommon term “non-associated,” not Petitioner’s proposed term “unassociated.” PO acknowledges that Petitioner did not propose searching for the term “isolated.” PO’s complaint that Yoon discloses the term “unassociated” only once is irrelevant as Yoon would have been discovered had the Examiner searched for that more common term.

Second, PO fails to account for repeated use of the term “associated” throughout Yoon and the ’717 Patent. Although the Examiner searched for “associated state” (which appears 6 times in Yoon), Yoon was not discovered because the Examiner appended the overly restrictive “non-associated” clause. Minor proposed changes to searches performed by the Examiner based primarily on terms in the ’717 Patent do not constitute “reverse-engineering.” Merely changing an operator and including the equivalent “unassociated” to L5 would have uncovered Yoon. Opp., 5. As another example, searching for “node,” which likewise appears throughout the ’717 Patent, along with “stage,” “state,” and “mode,” and “unassociated” as an alternative to “non-associated,” among US patent documents filed before Dec. 30, 2005 would have uncovered Yoon.

Third, PO’s highlighting the Examiner’s search with reference to Yoon’s specific subclass is disingenuous. PO Reply, 1. PO alleges that the Examiner’s broad classification searches included a subclass appearing on the Yoon Patent. This argument assumes that proper classification searches yielded a manageable, not

overly narrow or broad, pool of results. Rather, the Examiner’s class-based searches (L16-L18, L38-40) yielded thousands of results, many of which were subsequently overly narrowed with the term “non-associated.”

Fourth, the absence of a first substantive office action may not be dispositive of material error, but it certainly supports it here. Had the Examiner not rushed to allowance and conducted an adequate search, Yoon would have been discovered.

Fifth, PO’s ludicrous assertion that “under Petitioner’s apparent standards, ... examiners would be forced to spend *weeks* on every search” is wrong. PO Reply, 3 (emphasis added). The Examiner spent at most about *three and a half hours* searching. EX1002, 18-23, 26 (“L” search history time stamps from 16:10 to 18:39; “S” time stamps from 13:06 to 14:00). The Examiner’s search was overly restrictive and overlooked “areas with the highest probability of finding prior art” (M.P.E.P. §904.02) including Yoon.

Sixth, PO’s reliance on *Magnivision* is misplaced. That case relates to inequitable conduct, not PTAB discretionary denial. *See Magnivision*, 115 F.3d at 960. “A substantial showing of apparent examiner error can overcome other factors that suggest discretionary denial.” *Magnolia Medical Tech., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 (Director May 14, 2026). There is no Fintiv issue (Opp., 13-17). There are no settled expectations because of the clear material error.

Patent Owner’s Request for Discretionary Denial should be denied.

Date: June 17, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 17th day of June, 2026, a true and correct copy of the foregoing **PETITIONER'S SUR-REPLY TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** is being served upon Patent Owner's counsel via electronic mail as follows:

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