

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

K.MIZRA LLC,

Patent Owner.

IPR2026-00304

U.S. Patent No. 8,438,120

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

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2001	Plaintiff Google LLC’s Complaint for Declaratory Judgment of Non-Infringement of U.S. Patent No. 81,44,717 and U.S. Patent No. 8,438,120, <i>Google LLC v. K.Mizra LLC</i> , Case No. 3:25-cv-08107-JCS (N.D. Cal. Sept. 24, 2025, ECF No. 1)
2002	America Invents Act, H.R. 112-98, 112th Cong. (2011)
2003	Questions for the Parties, <i>Google LLC v. K.Mizra LLC</i> , Case No. 3:25-cv-08107-JCS (N.D. Cal. Mar. 19, 2026, ECF No. 40)
2004	Plaintiff Google LLC’s Notice of Voluntary Dismissal, <i>Google LLC v. K.Mizra LLC</i> , Case No. 3:25-cv-08107-JCS (N.D. Cal. Mar. 27, 2026, ECF No. 46)
2005	Transcript from March 24, 2026 Hearing on Defendant K.Mizra LLC’s Plaintiff Google LLC’s Motion to Dismiss, <i>Google LLC v. K.Mizra LLC</i> , Case No. 3:25-cv-08107-JCS (N.D. Cal. Mar. 24, 2026)
2006	Plaintiff K.Mizra LLC’s Complaint for Patent Infringement, <i>K.Mizra LLC v. Google LLC</i> , Case No. 1:26-cv-00754 (W.D. Tex. Mar. 27, 2026, ECF No. 1)
2007	Plaintiff K.Mizra LLC’s Complaint for Patent Infringement, <i>K.Mizra LLC v. Amazon.Com, Inc. et al.</i> , Case No. 1:26-cv-00316 (W.D. Tex. Feb. 10, 2026, ECF No. 1)
2008	Patent and Trademark Office, Interim Director Discretionary Process, https://www.uspto.gov/patents/ptab/interim-director-discretionary-process , Oct. 3, 2025
2009	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
2010	Scheduling Order, <i>K.Mizra LLC v. Google LLC</i> , Case No. 1:25-cv-00236 (W.D. Tex. June 17, 2025, ECF No. 39)
2011	Patent and Trademark Office, Additional Discretionary Institution Considerations – U.S. Manufacturing and Small Business Use of AIA Proceedings, https://www.uspto.gov/patents/ptab/interim-director-discretionary-process , Mar. 11, 2026
2012	Google Cloud Documentation, TPU Architecture
2013	Collection of Documents Indicating TPUs Manufactured in Taiwan
2014	Alphabet Inc. (Google), Annual Report (Form 10-K) (Dec. 31, 2025)

2015	Collection of Documents Regarding Google's Overseas Manufacturing Activities
2016	Collection of Documents Regarding Google's Offshoring of American Jobs

I. INTRODUCTION

Despite U.S. Patent No. 8,438,120 (“the ‘120 Patent”) having been in force for over 13 years, and despite the fact that discussions with Petitioner Google LLC regarding Patent Owner K.Mizra LLC’s portfolio began in 2022, Petitioner waited until March 2026 to file its Petition—several months after it had already sued Patent Owner for a declaratory judgment of non-infringement of the ‘120 Patent.¹ This Petition seeks to needlessly expand the dispute to yet another forum, asking the Board to institute *inter partes* review (“IPR”) of the same patent on which Petitioner initiated litigation in district court. But this is just another chapter in Petitioner’s strategy to use its substantial resources (and the USPTO’s resources) to its own advantage: Petitioner has turned a single litigation filed by Patent Owner in early 2025² into three district court actions in two different courts,³ four petitions for *inter partes* review,⁴ and two *ex parte* reexamination applications.⁵

¹ *Google LLC v. K.Mizra LLC*, No. 3:25-cv-08107-TLT (N.D. Cal.).

² *K.Mizra LLC v. Google LLC*, No. 1:25-cv-00236-ADA (W.D. Tex.).

³ *K.Mizra LLC v. Google LLC*, No. 1:26-cv-00316 (W.D. Tex.).

⁴ IPR2025-01436; IPR2025-01437; IPR2026-00254; and IPR2026-00304 (this IPR).

⁵ U.S. Reexamination Application No. 90/016,172 (filed April 8, 2026); U.S. Reexamination Application No. 90/016,173 (filed April 8, 2026).

Moreover, Petitioner’s challenges are nearly impossible to understand given Petitioner’s failure to propose and apply a consistent construction of the claimed “hyperparameters” term. Indeed, Petitioner first argues that the standard interpretation of that term as of the critical date differs from how that term is used in the ‘120 patent, without resolving how the Petitioner believes the “hyperparameters” should be interpreted as required under the Board’s rules. Then in its substantive challenges, Petitioner advances no fewer than six possible interpretations, presented with “to the extent that” caveats, and without taking any position on which interpretation is correct. While the Director disfavors inconsistent claim construction positions between an IPR and litigation, here the Director need not look any further than the Petition itself to find an abundance of Petitioner’s claim construction inconsistencies. This defect also warrants denial.

Given the settled expectations with respect to this 13-year-old patent, the Parties’ longstanding licensing discussions, the nearly-guaranteed duplication of efforts with multiple district court proceedings, and Petitioner’s claim construction failures, Patent Owner respectfully asks that the Petition be denied.

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

A. Settled Expectations Favor Denial

The ‘120 Patent issued May 7, 2013, nearly 13 years before the filing of the Petition. (Ex. 1001.) Here, the age of the patent alone is enough to warrant discretionary denial, and Patent Owner’s acquisition of the ‘120 Patent in 2020

does not undermine these settled expectations. *See, e.g., Datadome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 13, 2-3 (noting “strong settled expectations” despite acquisition in 2021).

Petitioner also acknowledges that Patent Owner has licensed the ‘120 Patent to various industry participants (Ex. 2001 ¶ 26), further strengthening the Parties’ settled expectations. *Alliance Laundry Sys., LLC v. Payrange LLC*, IPR2025-00950, Paper 11, 3. These licenses show that the ‘120 Patent has recognized value in the industry, and Patent Owner has been a willing licensor of its portfolio of patents including and related to the ‘120 Patent.

Moreover, Petitioner has been aware of Patent Owner’s patent portfolio (including the ‘120 Patent) based on discussions between the Parties in 2022 and early 2023, three years before Petitioner filed this challenge. (Ex. 2001 ¶¶ 8-10 (noting, among other things, that “[o]n or about March 7, 2023, K.Mizra’s CEO directly communicated to a third Google employee that K.Mizra sought Google to take a license to K.Mizra’s Patent Portfolio” and that “K.Mizra’s Patent Portfolio already included” the ‘120 Patent).) Petitioner fails to explain its three-year delay in seeking *inter partes* review. This, too, favors denial. *See, e.g., Hisense USA Corp. v. Videolabs, Inc.*, IPR2025-00880, Paper 11, 2-3 (knowledge of patent portfolio for almost three years favors denial); *see also Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00757, Paper 15, 2-3 (knowledge of patent portfolio including ancestor patents favors denial).

B. Petitioner Chose To Resolve Its Dispute with Patent Owner in District Court

Petitioner also needlessly burdens the Board by asking it to review the ‘120 Patent after having already initiated a separate dispute over the ‘120 Patent with Patent Owner in district court. Several months before filing its Petition, Petitioner filed a Complaint for Declaratory Judgment of non-infringement against Patent Owner in the United States District Court for the Northern District of California. (Ex. 2001.) Despite the concerns it now raises on invalidity, Petitioner chose not to seek declaratory judgment of invalidity in the California action and offers no rationale to justify bifurcating its dispute. This strongly suggests that Petitioner 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).⁶

⁶ In a related response, Petitioner argues it purposefully pursued a dual-track attack: district court for non-infringement and PTAB for invalidity. IPR2026-00254, Paper 11, 16-17. Even ignoring that this admits Patent Owner’s argument, Petitioner surely knows that invalidity would necessarily become an issue in a DJ action because an infringement counterclaim is compulsory. *Accord. Fitbit, Inc. v. Koninklijke Philips N.V.*, IPR2020-00771, Paper 4 (noting declaratory judgment for noninfringement is relevant to *Fintiv* analysis).

Thus, 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. (Ex. 2002 at 48 (emphasis added)).

This Petition presents an extraordinary example of a petitioner multiplying proceedings for a tactical advantage. Petitioner’s declaratory judgment action was based on a draft amended complaint in yet another case, *K.Mizra LLC v. Google LLC*, No. 1:25-cv-00236 (W.D. Tex.), which was exchanged between litigation counsel in May 2025. (Ex. 2001 ¶ 14.)⁷ Petitioner could have addressed the ‘120 Patent in that case and resolved all issues between the Parties in one proceeding. Instead, Petitioner waited four months, filed its declaratory judgment action in a *different* district court, then waited *another* five months and filed the Petition, turning the single case in a single forum into three different proceedings in three disparate forums⁸ over nine months. The Board should not countenance Petitioner’s efforts to multiply proceedings in this manner.

⁷ Petitioner did not respond to those communications or otherwise attempt to discuss the ‘120 Patent before filing the declaratory judgment action.

⁸ Petitioner also seeks to tax the resources of this Office, having filed three other IPR petitions and two reexamination requests related to the original litigation. *See*

Should there be any doubt about Petitioner’s motives, its actions after filing this Petition confirm them. Patent Owner filed a motion to dismiss the California declaratory judgment action for lack of personal jurisdiction, and the Court indicated it was inclined to transfer the case to the Western District of Texas, where the Parties’ original dispute was being litigated. (Ex. 2003.) The day after the hearing on the motion, while the Court was considering the motion to dismiss, Petitioner dismissed its declaratory judgment complaint. (Ex. 2004.) To prevent Petitioner from dragging the same issues to yet another forum—Petitioner had already suggested the case might continue in Delaware (Ex. 2005)—Patent Owner moved to centralize the dispute in Texas, which the California court had indicated would be most appropriate. (Ex. 2006.) Petitioner will have a full opportunity to raise its invalidity arguments in that case.

C. Petitioner’s Failure to Construe the Claims Supports Denial

Discretionary denial is also compelling—if not required—based on the Director’s precedential decision in *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, due to Petitioner’s failure to proffer a “single claim construction that best captures the meaning of the patent claim.” IPR2025-00632, Paper 20, 4. Simply put, a petitioner cannot avoid a *Revvo* issue by providing no claim construction

IPR2025-01436; IPR2025-01437; IPR2026-00304; U.S. Reexamination Application No. 90/016,172; U.S. Reexamination Application No. 90/016,173.

whatsoever and then stepping through the applied references with “to the extent” hypotheticals that never provide Petitioner’s interpretation of the claim. Instead, Petitioner regurgitates the standard by which the Board construes claims in an IPR, quoting 37 C.F.R. § 42.100(b), without any statement of “[h]ow the challenged claim is to be construed” required by 37 C.F.R. § 42.104(b)(3). Pet., 22.

Indeed, Petitioner’s failure to take any claim construction position is even worse than what occurred in *Revvo*. Without a mooring, Petitioner is free to twist and turn the meaning of the claims in whatever way suits its needs. And indeed, this is exactly how Petitioner presents its challenges. Rather than complying with Board rules on claim construction, Petitioner offers a variety of “to the extent that” caveats that seek to patch gaps that would not be present under a “single claim construction that best captures the meaning of the patent claim.” See Pet. at 23 (addressing the preamble); 24 (addressing the “‘hyperparameters’ as that term is used in the ‘120 Patent”); 25 (addressing a second hyperparameter interpretation); 28 (addressing a third hyperparameter interpretation); 29 (addressing a fourth hyperparameter interpretation); 36 (addressing a fifth hyperparameter interpretation); 38 (addressing a sixth hyperparameter interpretation, including “the Examiner’s characterization”); 43 (failing to take a position concerning “a particular sequence” of steps).

As is apparent from these caveats, the Petition never sets forth a cogent construction of the term “hyperparameter,” or an understandable application of that

construction to the prior art disclosures. Petitioner argues that the term “hyperparameter” as used in the ‘120 Patent “conflates model parameters and configuration parameters of a decision function.” Pet. at 10-11. But if that was Petitioner’s position, the Petition should have provided a clear meaning and applied that clear meaning. Instead, the Petition tries to say the term hyperparameter “include[s] the model parameters,” Pet. at 10-11, and doesn’t include model parameters, *see, e.g.*, Pet. at 25 (providing second theory relying on configuration parameters rather than model parameters). The various definitions Petitioner uses to present its disparate theories oscillate between “plain and ordinary” meaning, the specification of the ‘120 Patent, the content of the references, and comments by the Examiner. So, even if a petitioner could regurgitate 37 C.F.R. § 42.100(b) as its position, Petitioner cannot square its position that all terms should be given their plain and ordinary meaning with the Petition: its arguments bounce around between the alleged “conflation” in the specification and other intrinsic evidence rather than the ordinary meaning of the term “hyperparameter.”

In any event, the use of such alternative constructions is not consistent with the Board’s rules. *See Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1383 n.10 (Fed. Cir. 2023) (noting that the Board’s claim construction rule “does not direct a petitioner to raise, address, and apply alternative possible constructions”).

Moreover, and as is relevant to the discretionary considerations here, presentation

of alternative arguments based on different claim constructions is “problematic.” *Infinion Techs. Ams. Corp. v. Mosaid Techs. Inc.*, IPR2025-01456, Paper 27, 3. As the Director has explained, the PTAB is “not in the business of aiding parties to stress test claim constructions to see which will prevail.” *Id.* “As stated repeatedly, a petitioner should pick *one*.” *Id.* (emphasis added).

This did not happen here. Instead, Petitioner asks the Board to allow it to stress test various interpretations of “hyperparameter,” and/or to pursue invalidity under constructions it will oppose in the district court litigation. Petitioner’s gamesmanship compels denial of the Petition.

This is just one example of the deficient claim construction issues in the Petition. Elsewhere, Petitioner notes that it “is not advocating a proposed claim construction” *in at least two instances* but then nonetheless argues that the claims are invalid under that construction. (Pet. at 42, 43.) And, although Petitioner does not make any express “means-plus-function” arguments, it conspicuously provided instructions on means-plus-function limitations to its expert (EX1018 ¶¶ 16, 54-55), suggesting it fully intends to argue that one or more claim terms is subject to such a construction.

In a related proceeding, Petitioner makes the unsupported assertion that multiple claim constructions are fine as long as the claim is invalid under both constructions. *See* IPR2026-00254, Paper 11, 18. To the contrary, the Director recently denied a request under *Revvo* in a nearly identical situation, where the

petitioner alleged plain and ordinary meaning but also explained how “how the prior art satisfied even [the patent owner’s] proposed constructions.”

Westinghouse Air Brake Techs. Corp. v. Railware, Inc., IPR2026-00133, Paper 17,

2. Once again: “[A] petitioner should present a single construction and apply that construction consistently.” *Id.* And as explained above, Petitioner asserts wholly different theories depending on how the Board construes “hyperparameter.”

Petitioner cannot circumvent the Board’s requirements by attempting to disguise its *Revvo* violations.

D. Challenges to the ‘120 Patent Will Continue in Other Forums

As already noted above, Petitioner filed this Petition as a (late-filed) companion to its own declaratory judgment action filed in district court. Although that action was dismissed, Patent Owner thereafter centralized the Parties’ dispute by filing a patent infringement action in a WDTX district court. (Ex. 2006.) That district court action—like Petitioner’s declaratory judgment action—involves both the ‘120 Patent *and* U.S. Patent No. 8,144,717 (“the ‘717 Patent”). (*Id.* ¶¶ 72, 93.) Granting the Petition when the district court case will necessarily proceed on another patent is an inefficient use of the Board’s resources. *See Samsung Elecs. Co., Ltd. v. iCashe, Inc.*, IPR2025-00641, Paper 12, 3.

The same consideration applies with even greater force to another case where the ‘120 Patent has been asserted. In *K.Mizra LLC v. Amazon.com, Inc.*, No. 1:26-cv-00316 (W.D. Tex.), the ‘120 Patent is just one of the six patents that have

been asserted. (Ex. 2007 ¶¶ 9-14, 87, 105, 124, 137, 150, 166.) So, the validity of the ‘120 Patent will be evaluated in two different pending cases. Instituting review of the ‘120 Patent in a third concurrent proceeding is not an efficient use of the Board’s resources.

Further, Petitioner has not filed a *Sotera* stipulation or any other agreement that it will not pursue even these exact same invalidity arguments if the IPR is instituted—even after Patent Owner pointed out that the lack of such a stipulation strongly weighed in favor of denial in the prior petition involving the ‘717 Patent.⁹ Even if Petitioner had filed (or eventually files) an appropriate stipulation, that stipulation would not apply to Amazon, meaning that the district court would still need to address these same arguments in the *Amazon* litigation. *See Samsung Bioepis Co., Ltd. v. Regeneron Pharms., Inc.*, IPR2025-00176, Paper 12, 19-20 (finding *Sotera* stipulation does not mitigate concerns of overlap where it does not apply to “other [] defendants who are similarly motivated to try to invalidate” the claims).

⁹ In that proceeding, Patent Owner filed a *Sotera* stipulation with its response. *But see* Ex. 2008 (“If a petitioner chooses to file a stipulation, such as a *Sotera* stipulation, they should file it as soon as practicable, so that the patent owner may address the impact of the stipulation in its discretionary denial brief.”).

Moreover, even a *Sotera* stipulation would not meaningfully mitigate the overlap between the proceedings. The Director has recognized that despite such stipulations a patent owner 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.” (Ex. 2009, at 5-6, 9.)

In view of these fairness and efficiency concerns, Petitioner’s failure to disclaim any invalidity challenges to ensure that the IPR is not “a complete substitute for at least some phase of the litigation” should be the death knell for the Petition. (*Id.*, 12.) Moreover, the Director has previously observed that 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 may have substantially fewer resources than a challenger and thus may be financially unable to sustain infringement claims over such a long period. (*Id.*, 7.) This is true here, where Petitioner has weaponized its financial advantages so blatantly and across multiple forums.

Petitioner may argue that the litigation nonetheless weighs against discretionary denial because no trial date has been set. But this argument asks the Director to ignore all context. If Petitioner had requested issues related to the ‘120 Patent be addressed when they were first raised in district court—rather than

multiplying the proceedings and filing a declaratory judgment action in a district court that lacked personal jurisdiction *after* waiting several months (Ex. 2001)—the ‘120 Patent would be going to trial in November 2026, nearly a year before the Final Written Decision deadline. (Ex. 2009.)¹⁰ Petitioner should not be rewarded for its gamesmanship.

E. Petitioner’s Foreign Manufacturing Favors Denial

The Director recently issued guidance on three additional discretionary institution considerations. (Ex. 2011.) One of those considerations is whether the products accused of infringement are manufactured in the United States.

The product at issue in the declaratory judgment action is Petitioner’s Vertex AI system. (Ex. 2006 ¶ 33.) Patent Owner understands that Vertex AI runs on Google’s Tensor Processing Units (TPUs). (Ex. 2012.) Based on publicly-available information, TPUs are manufactured outside of the United States. Specifically, publicly-available information suggests that Petitioner’s TPUs are manufactured in Taiwan by Taiwan Semiconductor Manufacturing Company. (Ex. 2013.) And Petitioner’s most recent annual report does not identify any manufacturing facilities but instead indicates that it relies on “contract manufacturers.” (Ex. 2014

¹⁰ Trial is likely to be delayed due to recent unrelated events, but that case remains significantly ahead of this matter.

at 22, 70.) In fact, Petitioner has long been a leader in offshoring manufacturing. (Ex. 2015.)

In a related IPR, Petitioner has argued that the Director should focus instead on its U.S. headquarters and attendant domestic industry. IPR2025-00254, Paper 11, 10-12. This does not bear on the Director’s concerns of the “significant economic and national security damage” caused by companies such as Petitioner moving its manufacturing overseas. (Ex. 2011.) However, to the extent Petitioner believes broader commercial interests are relevant, the Director may also wish to consider Petitioner’s commitment to offshoring non-manufacturing American jobs as well. (Ex. 2016.)

Nor can Petitioner—one of the largest companies in the world—fall back on the small business considerations. To the contrary, the Director has previously described how large technology companies such as Petitioner use the IPR process as a weapon: “When a large company is free to copy a patented invention because it believes it can invalidate the patent through multiple validity challenges, the large company’s other advantages, such as superior brand recognition and manufacturing scale, will often give it an edge over smaller competitors.” (Ex. 2009). There can be no question that Petitioner has waged “multiple validity challenges” here. In this manner, Petitioner seeks to gain an edge over both Patent Owner and companies that have done the right thing and agreed to license the ‘120 Patent.

F. Petitioner Fails to Demonstrate Material Error

The “material error” inquiry has its roots in the *Advanced Bionics* case, here 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. In such situations, the challenger was required to identify a specific way in which the Examiner misapprehended the prior art to avoid denial under Section 325(d).

Here, in contrast, Petitioner appears to take the position that “overlooking the relevant prior art” was the material error. Pet. at 2. Indeed, Petitioner mentions material error only once in passing and provides no further explanation for how the Examiner erred. It thus appears that Petitioner’s argument is that denial is appropriate 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 that 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.

This is not the proper role of the material error inquiry. Indeed, the Director recently noted the *Padagis US LLC v. Neurelis, Inc.* decision as an example of a “substantial showing of apparently examiner error.” *Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17, 8. In that case, a prior patent had been

found invalid and the Board determined that the claims were not entitled to the priority date of the provisional application. *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, 2. Despite this finding, the Examiner later found that highly-similar claims were entitled to the earlier priority date. *Id.* at 3. The Acting Director found that “the patent examiner’s conclusion directly contradicts the Board’s determination and raises concerns of material error such that review of the challenged patents is an appropriate use of Office resources.” *Id.* In other words, the challenger there did significantly more¹¹ than just identifying a new reference that allegedly invalidates the claims. Indeed, the Board has previously noted that “material error” is not synonymous with the merits of an 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”); *see also Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, 6 (precedential) (“Petitioner’s generalized statements as to the strength of its Petition fail to identify sufficiently a material error.”).

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.”

¹¹ Indeed, this material error was discussed in detail in the Petition. *See, e.g., id.*, Paper 2, 6-10, 67.

Advanced Bionics, Paper 6, 9. Here, Petitioner fails to establish that the Board should disturb the prior evaluation. Indeed, there are numerous problems with Petitioner's arguments that should preclude a finding of "material error," including the following:

Claim Construction. As noted above, Petitioner presents different invalidity theories based on claim construction. Petitioner's anticipation theory based on Watanabe appears to be based on a construction that Petitioner appears to acknowledge is inconsistent with the plain and ordinary meaning of the term "hyperparameter." Indeed, the Petition includes several descriptions of hyperparameters as being the configuration parameters rather than the model parameters. (Pet. at 20 ("the parameters for training a classifier, i.e., hyperparameters"); 25 ("configuration parameters (i.e., hyperparameters)"). Given that even Petitioner is unwilling to commit to its interpretation of "hyperparameter," Petitioner cannot credibly argue that the Examiner materially erred by using a different interpretation.

Self-Conflicting Theories. Petitioner appears to acknowledge that its anticipation and obviousness theories are based on different embodiments of Watanabe. Pet. at 31 ("Petitioner relies on features described by Watanabe across multiple applications/embodiments."). Mixing of embodiments precludes Petitioner's anticipation theory. *See, e.g., New MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2016). Apparently seeking to avoid this result, and

despite having admitted using features “across multiple applications/embodiments,” Petitioner then contradicts itself and claims that any argument that the elements are not in a single embodiment is “untenable.” (Pet. at 32.) Confusingly, immediately before that sentence Petitioner takes the position that “[t]he components and functionalities of the various embodiments relied upon by Petitioner are compatible and combinable to one another.” (*Id.*) But is unclear why these components would need to be “combinable” if they were already part of a single embodiment. These self-contradicting claims undermine any allegation of material error.

No Motivation to Combine. Petitioner also fails to provide any motivation to combine. To be sure, the Petition includes a number of conclusory statements in that regard. (Pet. at 32-33.) But those conclusory statements are supported only by citations to the same conclusory statement in the expert declaration, without any support. It is not enough for an expert to merely say the relevant features are combinable without explaining why. Nor is it sufficient for an expert to merely state that a POSITA would have immediately envisaged a particular combination without explaining why. *See, e.g., Plexxikon Inc. v. Novartis Pharms. Corp.*, Case No. 4:17-cv-04405-HSG, 2021 U.S. Dist. LEXIS 36037, at *18 (N.D. Cal. Feb. 23, 2021) (discounting expert opinion under *Kennametal* [cited by Petitioner] for failure to address the number of categories and components disclosed in the prior art).

Petitioner also incorrectly asserts that no motivation is needed because a POSITA is presumed to be motivated to combine elements in a single prior art reference, citing to *General Elec. Co. v. Raytheon Techs.* (Pet. at 33.) But Petitioner’s admitted use of multiple embodiments requires a motivation to combine. *In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) (explaining “there must be a motivation to make the combination” when “combining multiple embodiments from a single reference”); *see also Guardant Health, Inc. v. Univ. of Wash.*, No. 2024-1129, 2026 U.S. App. LEXIS 1651, at *11 (Fed. Cir. Jan. 23, 2026) (non-precedential) (distinguishing *General Electric* from *Stepan*).

Petitioner cannot argue for material error when it ignores the requisite motivation to combine.

Reliance on Incorrect Quotes. Petitioner also relies on incorrect quotations to support its arguments. For example, Petitioner’s obviousness argument for Watanabe is based on the argument that: “Such a solution vector containing α and/or η would have been ‘*constructed appropriately*’ using the optimization methods disclosed by Watanabe. (See EX1006, 49:1-28).” (Pet. at 26 (emphasis added).) However, the phrase “constructed appropriately” does not appear anywhere in column 49 of Watanabe. Nor does Watanabe elsewhere suggest that this solution vector would be “constructed appropriately using the optimization methods disclosed by Watanabe.” Rather, the only use of “constructed appropriately” in Watanabe discusses the related art, not the optimization methods

of Watanabe, and is used in reference to an initial set of candidate vectors, not the output of any optimization method. Clearly, reliance on such a misleading or perhaps hallucinated quotation cannot support an argument that the Examiner materially erred.

For at least these reasons, and others that will be presented in Patent Owner's Preliminary Response (should it choose to file one), Petitioner's unsupported allegations of "material error" are wrong and cannot overcome the significant factors that weigh heavily in favor of denial here.¹²

III. CONCLUSION

For the reasons above, denial is respectfully requested.

Respectfully submitted,

Dated: June 1, 2026

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¹² Petitioner notes that in the IPR involving the '717 Patent, Petitioner presented new arguments for material error for the first time in its response. This is improper and, should Petitioner do so here, would further support denial. *See Ecto World*, Paper 10, 11 (denying where petitioner did not address or even allege material error in the petition).

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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 June 1, 2026, 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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