

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC
Petitioner

v.

K.MIZRA LLC
Patent Owner

Case No. IPR2026-00304
Patent 8,438,120

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST
FOR DISCRETIONARY DENIAL**

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I. INTRODUCTION

The Director should reject Patent Owner’s request for discretionary denial (Paper 7, “DD Req.”) and institute this Petition (Paper 2, “Pet.”) pursuant to Director Squires’s institution guidance that a substantial showing of Examiner material error favors institution, even where factors might otherwise suggest discretionary denial.¹ *See, e.g., Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 (Director July 16, 2025) (informative). Recent Director guidance addresses allocation of resources, the IPR being an alternative to addressing invalidity in parallel litigation, proper use of AIA review, U.S. based presence of the Petitioner, and public interest. *See Magnolia Medical Tech., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 (Director May 14, 2026) (precedential). Petitioner’s IPR overwhelmingly warrants institution based on this guidance.

The U.S. Patent and Trademark Office resources are the proper, most judicially efficient vehicle to address a failed obligation to the public based on

¹ Petitioner reserves the right to challenge the March 26, 2025 *Interim Processes for PTAB Workload Management*, including that document’s list of “relevant considerations,” at least because that document is legally invalid as (1) exceeding the Director’s authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

material errors committed during examination of the '120 Patent. These errors are demonstrated in the file history by, for example, the cursory reasons for allowance provided in a first Office Action allowance. There was no substantive rejection of the claims despite an International Search Report of record which identified four bases of unpatentability. The file history also demonstrates the Examiner's failure to conduct the requisite search of "all areas with the highest probability of finding prior art" under M.P.E.P. §904.02. The Examiner's cursory, overly narrow search applied search terms and classifications that were not targeted to the claims at hand. The Examiner therefore failed to consider the Watanabe document cited herein, which a proper search would have revealed. The material errors and related administrative oversight warrant institution to invoke the remedial actions of an IPR's claim review/amendment process pursuant to the America Invents Act (AIA).

The Director has instituted IPRs regardless of the patent's grant date where, as here, egregious material error by the Office occurred.

Petitioner should not be burdened with solicitations tied to overly broad, unpatentable claims. PO's delayed acquisition and enforcement actions instilled in Petitioner a settled expectation that it need not be concerned with the '120 Patent.

This IPR is the most judicially efficient forum to address the material errors uncovered and constitutes an alternative to raising issues before the District Court in view of Petitioner's Sotera stipulation. After Google was first solicited for a license

to K.Mizra’s patent portfolio, K.Mizra threatened infringement of the ’120 Patent in 2025 which precipitated Google’s filing of a declaratory judgement action in California District Court *for non-infringement*, to specifically preserve a parallel IPR process for an invalidity challenge. That non-infringement action was dismissed, but the present IPR remains as Petitioner Google’s sole action to challenge unpatentability. Patent Owner (“PO”) filed a lawsuit in Texas District Court nearly contemporaneously with this IPR, such that there is no *Fintiv* issue at hand. Institution of this IPR will properly and efficiently use Office resources to address the material errors that occurred within the Office.

II. INSTITUTION WILL SERVE PUBLIC INTEREST AND THE CONSTITUTION BY CORRECTING MATERIAL ERRORS COMMITTED BY THE PATENT OFFICE DURING PROSECUTION

A. The Examiner Committed Material Error in Allowing the ’120 Patent

The Examiner materially erred during examination by not considering and applying the Watanabe document cited herein. PO does not contest the materiality of Watanabe or allege that Watanabe is cumulative.

The ’120 Patent was allowed in a first action allowance with a cursory statement of reasons for allowance, despite an International Search Report that identified four bases of unpatentability. EX1003, 16-17. The Examiner’s search yielded only family documents of the ’120 Patent. The Examiner failed to conduct a reasonable search in “all areas with the highest probability of finding prior art” as

required under M.P.E.P. §904.02 (“*an examiner must conduct a thorough and complete search of the prior art*. A search is considered thorough when *all areas with the highest probability of finding prior art relevant to the invention as it is claimed and described in the specification* are identified for search.” (emphasis added)).

The “Examiner’s search strategy and results” yielded only family members of the ‘120 Patent because the search operators and classifications used by the Examiner ignored key claim terms and were overly narrow. EX1002, 30-34. First, across each database accessed, Examiner performed a single, extremely restrictive keyword search, “‘hyperparameter vector’ AND ‘random sample’.” *Id.* The Examiner’s search of the USPTO’s database of patents/publications yielded only ‘120 Patent family members: (1) the examined application itself (Application No. 12/597,257, “the ’257 application”), (2) the corresponding PCT parent (PCT/NL08/50247), and (3) the corresponding European priority application (EP 07112037.2). EX1002, 34 (L1). ***The Examiner’s search yielded only these three patent family members of the application being examined.*** A single search yielding only patent family members of the application being examined does not constitute “a thorough and complete search of the prior art” as required by M.P.E.P. §904.02. Had the Examiner considered reasonable search strategies Watanabe would have been discovered. The Examiner’s search omitted relevant claim terms (e.g.,

“estimate” and “best result”) and their associated synonyms (e.g., “predict” or “prediction” as a synonym of “estimate”; “group” or “set” as synonyms of “sample”; “highest”, “optimal”, or “optimized” as synonyms of “best”; and “solution” or “output” as synonyms of “result”; etc.). *Id.*

Simple, reasonable search queries would have uncovered Watanabe. For example, searching for U.S. patents/publications before November 6, 2009 (the earliest claimed priority date of the ’120 Patent), having (i) “hyperparameter” or “parameter,” “vector,” and variations of “estimate” (e.g., “estimation,” “estimated,” “estimating”) and “predict” (e.g., “prediction,” “predicted,” “predicting”) in a common sentence, (ii) “random” and “group,” “set,” or “sample” in a common sentence, and (iii) any of “highest,” “optimal,” or “best” adjacent to any of “result,” “solution,” or “output” yields 93 results from only 57 unique families, with Watanabe being the 48th result. EX1026, at 1. Removing the variations of “predict” and the terms “group,” “highest,” and “output” yields only 66 results from 41 families, with Watanabe being the 34th result. EX1026, at 2. Removing the variations of “estimate” and narrowing the relational operators of clauses (i) and (ii) to within 5 words (i.e., from “WITH” to “ADJ5”; see below) yields only 56 results from 31 families, with Watanabe being the 28th result. EX1026, at 3. *See also* EX1031.

Exemplary searches yielding Watanabe are shown in the table below:

Search String	Total Results (Unique Families)	Watanabe Result
((hyperparameter <i>OR</i> parameter) <i>WITH</i> vector <i>WITH</i> (estimat\$3 <i>OR</i> predict\$3)) <i>AND</i> (random <i>WITH</i> (group <i>OR</i> set <i>OR</i> sample)) <i>AND</i> ((highest <i>OR</i> optimal <i>OR</i> best) <i>ADJ</i> (result <i>OR</i> solution <i>OR</i> output)) <i>AND</i> @fd<"20081106"	93 (57)	48
((hyperparameter <i>OR</i> parameter) <i>WITH</i> vector <i>WITH</i> estimat\$3) <i>AND</i> (random <i>WITH</i> (set <i>OR</i> sample)) <i>AND</i> ((optimal <i>OR</i> best) <i>ADJ</i> (result <i>OR</i> solution)) <i>AND</i> @fd<"20081106"	66 (41)	34
((hyperparameter <i>OR</i> parameter) <i>ADJ</i> 5 vector) <i>AND</i> (random <i>ADJ</i> 5 (set <i>OR</i> sample)) <i>AND</i> ((optimal <i>OR</i> best) <i>ADJ</i> (result <i>OR</i> solution)) <i>AND</i> @fd<"20081106"	56 (31)	28

Had the Examiner conducted a claim-language-based search, he would have found Watanabe and/or other pieces of relevant prior art to reject the broad claims that were allowed in a first action.

Six additional searches of the USPTO's database across just *two minutes*, further demonstrate that the Examiner's search was not "thorough and complete." These consisted of an inventor search (L2) yielding 5 results, two broad searches (L3 and L4) to entire USPC classes with no keyword limiting, and three searches (L5-7) of verbatim claim language (likely double patenting searches), each of which yielded 0 results. The Examiner did not search any of the three USPC classes wherein Watanabe is classified (700/28, 706/13, 702/85).

The Examiner's single, incredibly narrow keyword search conducted in rushed fashion demonstrates material error. *Id.*; *see generally* EX1002. The Examiner's broad classification-based searches coupled with an overly restrictive keyword search failed to meet the M.P.E.P. definition of a thorough search wherein "all areas with the highest probability of finding prior art relevant to the invention as it is claimed and described in the specification are identified for search." (M.P.E.P. §904.02). This flawed search led to an improper grant of the '120 Patent. Had the Examiner conducted a reasonable search, the Examiner would have uncovered Watanabe and rejected the claims at hand.

B. The Examiner's Material Errors Outweigh Any Possible "Settled Expectations" of the Current PO

Examiner error during examination can outweigh even "strong settled expectations". *See, e.g., Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12, pages 2-3 (PTAB Jul. 17, 2025) (DD request of IPR challenging a 2016 patent denied given that "discretionary denial under 35 U.S.C. §325(d) is not appropriate because the Office materially erred during prosecution of the challenged patent."); *See also, Padagis US LLC v. Neurelis, Inc., supra; Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13 at 2 (PTAB Jun. 25, 2025) (DD request of IPR challenging a 2008 patent denied where "no trial date is scheduled in the district court" and "discretionary denial under 35 U.S.C. §325(d) is not appropriate because the Office erred in a manner material to the patentability of the challenged claims."); *Google*

LLC v. Headwater Research LLC, IPR2026-00050, Paper 11 (PTAB Feb. 24, 2026) (DD request in IPR challenging a 2014 patent denied where material error identified); and *Google LLC v. Headwater Research, LLC*, IPR2026-00049, Paper 13 (PTAB April 1, 2026, re: U.S. Patent No. 9,179,359), instituted April 1, 2026. Here, there can be no settled expectations other than those of the Petitioner Google.

PO's delayed acquisition and assertion give rise to Petitioner Google's settled expectations. PO's flawed assertion of settled expectations based on the 2013 issue date of the '120 Patent (DD Req., 1-2) ignores that this patent was acquired by the current PO in 2020. EX1027.

Google had settled expectations that PO (past or present) would not assert the '120 Patent against its US-based products and services. PO concedes that discussions regarding PO's portfolio began in 2022. DD Req., 1. Yet, PO waited until February of 2026 to assert the '120 Patent, thereby undermining Google's settled expectations of 14 years that PO would not assert the '120 Patent against Google.

C. Petitioner's U.S. Headquarters and Attendant Domestic Industry Outweigh PO's Lack of U.S. Investment

Petitioner Google is a U.S. headquartered company with numerous products, data centers, and services that support and benefit the U.S. public. Although Google is an international conglomerate, its U.S. business is substantial, e.g., Google has announced record-setting plans to spend up to \$185 billion in capital investments in

2026 to include data center expansion in the U.S. EX1028. PO's attempted diversion of focus from Google's U.S. business interests and tax base is disingenuous. PO asserts that Google's Nest products are allegedly manufactured outside of the United States. DD Req., 13-14. While certain of Google's products are understandably made, sold and used in whole or in part abroad, Google remains a U.S. headquartered company with substantial investments in the U.S., employing more than 100,000 U.S. employees in 26 states. EX1029.

PO, on the other hand, does not allege any significant U.S. investments, U.S. employment or a U.S. tax base providing U.S. tax revenue. PO K.Mizra admits it is "a patent licensing company" that offers no goods or services in Petitioner's particular technology space. As PO explains,

K.Mizra is a patent licensing company run by experienced management. The company focuses on high-value, high-quality patents and owns patent portfolios originating from a wide array of inventors, including patents and patent portfolios developed by well-known multinational corporations such as IBM, Intel, Rambus and others, as well as from research institutes.... By focusing on high-quality patents, K.Mizra provides a secondary market that enables inventors to recoup their research and development investments and to continue their innovations. K.Mizra offers licenses to its patents on reasonable terms and, in this way, plays an important role in the development of technologies that improve businesses and lives.

EX2006, 3. PO is a patent monetization firm that acquired the '120 Patent solely to

leverage against operating companies like Google that provide commercialized products and services. Beyond making money for itself, K.Mizra's acquisition of the '120 Patent from non-domestic inventors/assignor has only served to advance foreign interests. The only overlap into Google's technological space is PO's recent solicitation to extract licensing fees.

Google's significant investment in the U.S. to benefit the U.S. public makes it especially deserving of a reliable patent system that grants valid U.S. patents to avoid needless, expensive litigation in Federal District Courts. This IPR constitutes appropriate use of Office resources as the most judicially efficient process to correct a patent granted through material error, and subsequently assigned 8 years later to a patent assertion entity with no goods or services. This IPR is not a "means to prevent market entry" given that PO offers no goods or services, and thus is consistent with legislative intent. *See Magnolia*, IPR2026-00097, Paper 17, at 2. *See also Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, pages 2-3 (Jun. 26, 2025).

III. RELATED LITIGATIONS INVOLVING THE '120 PATENT SUPPORT INSTITUTION AS A MATTER OF PUBLIC INTEREST AND JUDICIAL EFFICIENCY TO ADDRESS EXAMINER ERROR

Petitioner's N.D. Cal declaratory judgment action for *non-infringement* was terminated. This IPR was Petitioner's sole challenge to the '120 Patent's *validity*. PO's W.D. Tex Litigation was filed nearly contemporaneously with Petitioner's filing of this IPR. PO cannot complain that Petitioner delayed in filing this IPR.

These facts favor institution as a matter of public interest and judicial efficiency.

A. PO's W.D.Tex Litigation Was Filed Nearly Contemporaneously With This IPR Such That Fintiv Does Not Apply

The Director has stated that “the mere existence of co-pending litigation in and of itself may not necessarily raise concerns.” *Magnolia*, IPR2026-00097, Paper 17, at 3. There is no concern here given that the co-pending litigation was initiated by PO merely *four days* before this IPR. EX2006. Any purported concerns of overlap are mitigated by Petitioner's Sotera stipulation *infra*.

There is no Fintiv issue given that the complaint in the related litigation and this IPR were filed nearly contemporaneously, and no trial date has been set in the related litigation. Factor 2 strongly favors institution.

The other Fintiv factors also favor institution when taken holistically.

Factor 1 is neutral given that no party has requested a stay.

Factor 3 favors institution because the district court is at an early stage with no scheduling order yet entered. There is much work to be done in the district court and most of the work will be well in the future. Accordingly, the district court will not invest significant resources related to the challenged patent prior to the issuance of an institution decision. *See Fintiv*, IPR2020-00019, Paper 11 at 9-12; *DISH Network*, IPR2020-01280, Paper 17 at 18-21.

Concerning Factor 4, and consistent with *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020), Petitioner hereby stipulates

that, if the Board institutes inter partes review in this proceeding, IPR2026-00304, Petitioner will not pursue in the related litigation, *K.Mizra LLC v. Google LLC*, Civ. Action No. 1:26-cv-00754 (W.D. Tex.), an invalidity defense based on any ground that was raised or reasonably could have been raised in this *inter partes* review before the Board with respect to U.S. Patent No. 8,438,120. Thus, there will be no “overlap between issues raised in the petition and in the parallel proceeding.” *Apple v. Fintiv*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020).

Petitioner’s language in its *Sotera* stipulation clarifies the circumstances for triggering the stipulation by expressly contemplating situations where the PTAB terminates an IPR proceeding without issuing a final written decision, e.g., the action taken in *Interactive Communications International, Inc. v. Blackhawk Network Inc.*, IPR2024-00465, Paper 39 (PTAB Oct. 1, 2025). To be clear, the stipulation does not extend to scenarios where the USPTO institutes but later vacates institution of IPR2026-00304, or otherwise terminates the proceeding without issuing an appealable Final Written Decision, as those scenarios would no longer involve an instituted *inter partes* review. Thus, if IPR2026-00304 is not instituted, is instituted but later de-instituted, or otherwise terminates without an appealable Final Written Decision, Petitioner reserves the right to pursue in the Related Litigation any ground that was raised or reasonably could have been raised in IPR2026-00304. Therefore, this factor favors institution.

Concerning Factor 5, overlap of parties is neutral as it is “far from an unusual circumstance that a petitioner in [an IPR] and a defendant in a parallel district court proceeding are the same.” *Sand Revolution*, IPR2019-01393, Paper 24 at 12-13.

Concerning Factor 6, the Grounds present a compelling case of unpatentability and the merits of the Petition are strong. The challenges presented in this Petition are particularly compelling given that the Grounds are a straightforward obviousness challenge based on express teachings found in the prior art. *See, e.g., Inergy Tech., Inc. v. Force Mos Tech., Co., Ltd.*, IPR2024-00094, Paper 9 (PTAB May 21, 2024) at p. 36 (finding compelling merits where the obviousness ground is “seemingly straightforward” and “Petitioner’s motivation for this modification comes from an express teaching in [the cited reference]”). The Ground asserted herein was not previously considered by either the Office or the district courts, also favoring institution. *See Comcast Cable Commn’s, LLC v. Rovi Guides, Inc.*, IPR2019-00231, Paper 14 at 11 (PTAB May 20, 2019) (challenges not “previously considered by the Office or any court” weigh in favor of not denying institution).

Nor is the pending litigation against Amazon justification for discretionary denial. Google is not a party to that litigation (EX2007). All hearings and trial dates in the Amazon litigation were recently vacated. EX1030. PO cannot bring multiple suits against different defendants in separate actions and then complain that each defendant is utilizing the resources available to them to challenge patent validity.

B. The N.D.Cal Litigation was Terminated

Petitioner initially sought to resolve the parties' dispute by filing a declaratory judgment action in the N.D. Cal for *non-infringement* where invalidity was intentionally not raised. PO opposed that action, moving to dismiss for lack of jurisdiction. Petitioner separately initiated this IPR to resolve questions concerning invalidity given the substantial errors that occurred during examination.²

The N.D. Cal. Litigation for *non-infringement* does not bar the filing of this IPR. *See* 35 U.S.C. §315(a)(1). PO opposed this action, opting to dispute jurisdiction and bring its own action in a forum of its choosing (*i.e.*, W.D. Tex).

PO cannot justifiably contest the judicial efficiency that institution of this IPR affords the parties. Moreover, this IPR will help restore public confidence in the U.S. patent system to correct material errors of patent prosecution. *See Magnolia*, IPR2026-00097, Paper 17, at 6 (AIA review is appropriate to “correct possible error in the original patent grant” in view of public interest, as here).

² Patent Owner filed its motion to dismiss of November 17, 2025, and the N.D.Cal case was terminated on March 27, 2026.

IV. THE PETITION SETS FORTH COMPREHENSIVE INVALIDITY GROUNDS WITH A CONSISTENT CLAIM CONSTRUCTION

A. PO Mischaracterizes Petitioner’s Citing to Different Examples of “Hyperparameters” in Watanabe as Proffering Different Claim Constructions

PO asserts that Petitioner “fail[s] to construe the claims.” DD Req., 6. PO is wrong because the Petition states that the claims are interpreted “in accordance with the ordinary and customary meaning.” Pet., 22. The Petition then provides examples of how the claim terms map to exemplary features of the Watanabe document.

PO complains that the Petition sets forth seven different claim constructions of the term “hyperparameter” instead of a “single claim construction.” DD Req., 7. PO confuses claim construction with claim mapping. For example, the Petition refers to examples in Watanabe of “hyperparameters”. These references are not distinct claim constructions but rather examples of “hyperparameters” pursuant to the ordinary and customary meaning of that term.

The Petition presents a comprehensive analysis of how Watanabe maps to the claimed term “hyperparameter” in a variety of ways. PO’s assertion that the Petition is “nearly impossible” to understand due to a purported “failure to propose and apply a consistent construction” (DD Req., 7-8) is without merit. PO does not substantively contest Watanabe’s disclosures of various “hyperparameters.”

There is no *Revvo* issue. In *Revvo*, the petitioner adopted PO’s constructions from the related litigation in the IPR and “proposed different constructions for the

claim terms in the district court litigation [without] explain[ing] why it was taking a different position [in the IPR].” *Revvo Tech., Inc., v. Cerebrum Sensor Tech., Inc.*, IPR2025-00632, Paper 20 at 2 (Director Nov. 3, 2025). Unlike *Revvo*, Petitioner in this case has unequivocally stated that the claims are interpreted in accordance with their ordinary and customary meaning. Pet., 22. Petitioner has not proffered different constructions across multiple forums, which was the problem in *Revvo*.

In *Revvo*, Director Squires provided a safe harbor for when it would be appropriate for a petitioner to advance inconsistent constructions in an IPR and district court. *Id.*, 5 (“if a party advances a narrow construction ... and the district court declines to adopt the narrow construction, the party would have sufficient reason for advancing the broader, court-adopted construction”). There is no potential for inconsistency here given that the Petition demonstrates unpatentability irrespective of the specific claim construction of “hyperparameter.” This is precisely the reason why Petitioner provided a comprehensive analysis of how the prior art satisfies the “hyperparameter” claim term.

The Petition also does not raise any *Revvo* concerns because Petitioner has demonstrated patentability under all (purported) claim constructions in this IPR. PO’s complaint that Petitioner addressed comments made during prosecution relating to claim construction (DD Req., 9) lacks merit for the same reason. The particular construction of “hyperparameter” does not matter given that the claims

are unpatentable under all potential claim constructions.

PO complains that Petitioner’s expert declaration contains background on means-plus-function limitations. DD Req., 9. PO then makes the leap that this suggests that Petitioner “fully intends to argue that one or more claim terms is subject to such a construction.” *Id.* This background section was included in the event that, for example, the Board later raises means-plus-function in this proceeding. PO misapprehends IPR procedure and the Trial Practice Guide which expressly contemplates constructions proffered by patent owners and the Board after the filing of the petition. *See* Trial Practice Guide, §II.B.6. (PO may raise “new claim construction issues,” the Board may raise “a claim construction issue on its own”).

The Related Litigation is at its inception. The district court has yet to rule on claim construction. *Whether the court gives “hyperparameter” its ordinary and customary meaning or arrives at an express construction does not matter given the Petition’s comprehensive treatment of “hyperparameter.” The claims are invalid under any potential interpretation because Watanabe discloses hyperparameters that are identical to hyperparameters of exemplary embodiments in the ’120 Patent.* This demonstrated strength of the merits is reason for institution.

B. Petitioner’s Claim Construction of “Hyperparameter” is Consistent

PO asserts that Petitioner presents different invalidity theories based on different claim constructions. DD Req., 17. PO overlooks that the Petition provides

an explanation of the ordinary and customary meaning of “hyperparameter”: “The term ‘hyperparameter’ was not prevalent at the time of the ’120 Patent but had been used previously in the statistical literature to denote parameters for fitting a model to data (i.e., training), for defining structure and behavior of training algorithms, etc., and had been recognized as being distinct from the model parameters.” Pet., 10-11 (citing EX1018, ¶41). This construction is consistently applied throughout the Petition. *That the term “hyperparameter” was not prevalent at the time of the ’120 Patent—a fact that PO does not dispute—further demonstrates the reasonableness of Petitioner’s approach of citing the various examples of hyperparameters disclosed by Watanabe given the term’s ordinary and customary usage.*

The exposition of hyperparameters and model parameters in the Petition is done to: (1) explain that the ’120 Patent conflates hyperparameters with model parameters; and (2) demonstrate that a POSITA would have understood the difference despite the ’120 Patent’s statements. The Petition explains that the ’120 Patent’s treatment of “hyperparameter” and “model parameter” is immaterial because the prior art invalidates the Challenged Claims under any construction, regardless of whether the “hyperparameter” requires a “model parameter.”

C. Watanabe’s Multiple Embodiments Bear a Common Iterative Process which Supports Both Anticipation and Obviousness Challenges

PO faults Petitioner for relying on multiple embodiments disclosed by Watanabe (DD Req., 17-18) but overlooks the fact that Watanabe’s embodiments

“all relate to a common iterative process to produce an estimate of a solution vector as an optimal solution.” Pet., 31. Watanabe describes certain functionalities and use of components differently in its embodiments, but all embodiments perform a common iterative process. PO does not dispute that the relied-on embodiments relate to a common iterative process. The functionalities and components expounded upon by Watanabe are incidental and supplementary to this common process, i.e., “[t]he components and functionalities of the various embodiments relied upon by Petitioner are compatible and combinable to one another.” Pet., 32.

PO’s assertion that Petitioner fails to provide any motivation to combine elements of Watanabe’s embodiments (*see* DD Req., 18-19) is untenable. Each of Watanabe’s embodiments relates to a common iterative process in which incidental/supplementary features and components are described in differentiated detail. Watanabe affirms that “[t]he specific problem treated here and the method of expressing the elements of a solution vector are the same as those described in [other] embodiments of the invention.” Pet., 32. This constitutes a motivation to combine especially when, as is the case here, a “POSITA is presumed to have been motivated to combine elements in a single prior art reference.” Pet., 33.

PO complains that Petitioner’s argument regarding the Claim 1 preamble (Pet., pp.23-39) improperly places the phrase “constructed appropriately” (Pet., p.26, ll.14-16) in quotations because “the phrase ‘constructed appropriately’ does not

appear anywhere in column 49 of Watanabe.” DD Req., 19-20. Page 26 of the Petition cites to a solution vector set and to configuration parameters α and η (*i.e.*, “hyperparameters”) at Watanabe, col. 49:1-28. The phrase “constructed appropriately” appears in Watanabe, 1:53 as cited at Petition, p.37, l.12. Petitioner’s argument makes clear that α and η fall within the ordinary and customary meaning of the term “hyperparameter” as properly construed.

V. INSTITUTION IS WARRANTED DUE TO THE OFFICE’S MATERIAL ERROR DURING EXAMINATION

Discretionary denial under Section 325 is unwarranted given the Office’s material error. *See* Section II. The *Becton, Dickinson* factors weigh in favor of institution. In *Advanced Bionics*, the Board stated that “[a]n example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” The Office’s failure to consider the prior art documents cited in the Petition constitutes material error because these documents directly impact patentability.

VI. CONCLUSION

PO’s Request for Discretionary Denial should be denied in the interests of public interest and judicial efficiency.

Date: July 1, 2026

Respectfully submitted,

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APPENDIX A – LIST OF EXHIBITS

Exhibit No.	Description
1002	File History of U.S. Patent Application No. 12/597,257
1003	PCT Publication No. WO 2008/133509, published on November 6, 2008
1018	Declaration of Michael J. Pazzani, Ph.D.
1026	Search results for U.S. patents/publications before November 6, 2009 downloaded from USPTO Patent Center on June 23, 2026
1027	Recorded Assignment from Dataserve Technologies LLC to K.Mizra LLC recorded in the USPTO on August 21, 2020 at Reel/Frame 053579/0590
1028	https://www.crn.com/news/cloud/2026/google-unveils-twonew-us-data-centers-as-185-billion-commitment-getsunderway downloaded May 26, 2026
1029	https://economicimpact.google/usimpact/ downloaded May 26, 2026
1030	Order Regarding Austin Division Docket, <i>K.Mizra LLC v. Amazon.com, Inc.</i> , Case No. 1-26-cv-00316 (W.D. Tex. May 13, 2026, ECF No. 26)
1031	Declaration of Maxwell Ludwikowski
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)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 1st day of July, 2026, a true and correct copy of the foregoing **PETITIONER'S OPPOSITION 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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