

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

ADVANCED CODING TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-00374
Patent 8,090,025 B2

Before BART A. GERSTENBLITH, NATHAN A. ENGELS, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

ORDER

Granting-in-part Petitioner's Request to File a Preliminary Reply to the
Preliminary Response
37 C.F.R. §§ 42.5, 42.108(c)

I. SUMMARY

Petitioner requested a conference call to discuss authorization to file a seven-page preliminary reply to Patent Owner’s Preliminary Response (Paper 6, “Prelim. Resp.”) to address the construction of two claim terms, “border motion vector data” and “satisfies Poisson’s Equation,” and discretionary denial under 35 U.S.C. § 325(d). *See* Ex. 3001 (email). Patent Owner opposes this request. *Id.* Judges Gerstenblith, Engels, and Repko held a conference call with counsel for the parties. A court reporter was present, and a transcript has been entered into the record as Exhibit 1023.

For the reasons that follow, we grant Petitioner’s request to file a preliminary reply only with respect to the construction of “border motion vector data” and discretionary denial under § 325(d). We deny the request with respect to the limitation “satisfies Poisson’s Equation.”

II. ANALYSIS

1. “border motion vector data”

The first issue is the construction of “border motion vector data.” Ex. 1023, 27:16–17. Claim 6 recites, in part,

a zone-border motion compensator to define a boundary condition of a border that corresponds to the *border motion vector data*

Ex. 1001, 34:32–39 (emphasis added). Claims 1, 4, 7, and 10 recite a similar limitation. *Id.* at 31:60–61 (claim 1), 32:67–33:2 (claim 4), 35:41–42 (claim 7), 36:66–67 (claim 10).

According to the Petition (Paper 2, “Pet.”), “no formal claim constructions are necessary.” Pet. 2. The ’025 patent is involved in a pending district court case between the parties. *See, e.g.*, Pet. 109; Prelim. Resp. 46–52; Paper 5 (Patent Owner’s Mandatory Notice). In that case, the parties

agreed that “border motion vector data” means “data representing the difference in spatial position between a border of the block to be predicted in the picture to be coded and the best-matched border in the reference picture.” Prelim. Resp. 16–17 (citing Ex. 2004, 2). In its Preliminary Response, Patent Owner argues that the prior art cited in the Petition does not teach or suggest “border motion vector data,” under the construction that the parties agreed to in district court. *Id.* at 31–33.

According to Petitioner, “the construction only developed after a complex negotiation amongst three parties of the litigation that didn’t resolve until months after the Petition was filed.” Ex. 1023, 29:7–11. Petitioner agrees that the construction should be applied in this proceeding. *Id.* at 28:2–25. Petitioner argues that the requested reply would cover “why the analysis in the Petition and the cited prior art satisfies the construction of this term that was advanced in the [P]reliminary [R]esponse.” *Id.* at 27:20–23.

Patent Owner responded that good cause does not exist for a reply to the Preliminary Response because the agreed-to construction was foreseeable when the Petition was filed. *Id.* at 33:13–34:9. According to Patent Owner, “this Petition was filed on the 8th of January, and on the 9th of January, Samsung proposed that ‘border motion vector data’ should be construed, [and] did not propose that plain and ordinary meaning should apply.” *Id.* at 33:16–20.

Here, Petitioner has shown that there is good cause to file a reply addressing the construction of “border motion vector data”: The parties did not agree to the construction in the district-court litigation until after the Petition was filed. Ex. 1023, 29:7–11. And the parties agree that the

construction should apply to this proceeding. *See id.* at 28:2–25; Prelim. Resp. 16. Thus, we grant Petitioner’s request for a preliminary reply on why the analysis in the Petition shows that the cited prior art teaches or suggests “border motion vector data” under the agreed-upon construction. We also authorize Patent Owner to file a preliminary sur-reply, responding to the arguments raised in Petitioner’s preliminary reply.

2. “*satisfies Poisson’s Equation*”

The second issue relates to the limitation “satisfies Poisson’s Equation.” Ex. 1023, 30:3–31:2. Claim 6 recites, in part,

a zone-border motion compensator to . . . generate an estimated video signal in each rectangular zone in the picture to be coded, that *satisfies Poisson’s Equation*, thus producing a first predictive picture.

Ex. 1001, 34:32–39 (emphasis added). Claims 1, 4, 7, and 10 recite a similar limitation. *Id.* at 31:60–61 (claim 1), 32:67–33:2 (claim 4), 35:41–42 (claim 7), 36:66–67 (claim 10).

In its Preliminary Response, Patent Owner argues that the Petition should be denied because (1) it relies on an incorrect construction of “satisfies Poisson’s Equation” and (2) the Petition is silent about one entire side of the equation. Prelim. Resp. 36–39.

Petitioner argues that Patent Owner’s construction of this phrase in its Preliminary Response is inconsistent with the ’025 patent. Ex. 1023, 30:9–13. Petitioner requests additional briefing to identify “the relevant disclosure in the ’025 patent that confirms that Patent Owner’s construction is incorrect.” *Id.* at 30:13–18. In Petitioner’s view, the construction was not foreseeable because (1) it was not “raised at all in the litigation” and

(2) “there’s examples in the patent that specifically contradict it.” *Id.* at 30:16–18.

Patent Owner contends that Petitioner should have anticipated the arguments presented in Patent Owner’s Preliminary Response because the parties were arguing about the meaning of “satisfies Poisson’s Equation” in district court. *Id.* at 34:22–24, 41:16–43.

We determine that Petitioner has not shown good cause to file a reply on this issue. Unlike the “border motion vector data” issue (*see* § II.1 *supra*), Petitioner only seeks to respond to Patent Owner’s arguments in the Preliminary Response about the “satisfies Poisson’s Equation” limitation, instead of addressing a new construction raised in the district-court proceeding that should be adopted here. Ex. 1023, 30:9–24. Although Petitioner characterizes the Preliminary Response as advancing a construction for “satisfies Poisson’s Equation,” the Preliminary Response states that “a formal construction is not required.” Prelim. Resp. 18. Rather, according to the Preliminary Response, the Petition’s implicit construction is incorrect and inconsistent with the ’025 patent. *Id.*

The Board is able to assess whether Patent Owner’s arguments about the “satisfies Poisson’s Equation” limitation are consistent with the ’025 patent without further briefing from Petitioner. It may frequently be the case that a petitioner disagrees with a patent owner’s characterizations in its preliminary response. Our rules, though, provide for a preliminary reply only when good cause exists. 37 C.F.R. § 42.108(c). Petitioner may have an opportunity to brief the issue during the trial if institution is granted.

Thus, we deny Petitioner’s request for a preliminary reply to address Patent Owner’s arguments about the limitation “satisfies Poisson’s Equation” in its Preliminary Response.

3. 35 U.S.C § 325(d)

Under 35 U.S.C. § 325(d), the Board may exercise discretion to deny a petition that presents the same or substantially the same art or arguments as were previously presented to the Office. To evaluate arguments for discretionary denial under § 325(d), the Board uses a two-part framework:

(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and

(2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8–9 (PTAB Feb. 13, 2020) (precedential).

Petitioner relies on Saito¹ in each ground raised in the Petition. *See* Pet. 1. In its Preliminary Response, Patent Owner argues that Saito is substantially similar to Yamatani,² which was cited in an Information

¹ Naoki Saito, Jean-Francois Remy, *The polyharmonic local sine transform: A new tool for local image analysis and synthesis without edge effect*, 20 Applied and Computation Harmonic Analysis 41–73 (2006). Ex. 1007.

² Katsu Yamatani and Naoki Saito, *Improvement of DCT-based Compression Algorithms Using Poisson’s Equation* (Sept. 12, 2005). Ex. 2005.

Disclosure Statement (IDS) during prosecution of the application that issued as the '025 patent. Prelim. Resp. 23–28. Patent Owner argues that the Board should deny the Petition because substantially the same prior art and the same arguments were previously presented to the Office during prosecution, and, according to Patent Owner, Petitioner has not shown that the Office erred in a manner material to patentability. *Id.* at 23 (citing 35 U.S.C. § 325(d)).

Petitioner requests additional briefing to address this issue, explaining, for example, “why the prosecution history does not indicate that the [E]xaminer considered the disclosure in the Yamatani reference in the same way the Saito reference is being used in the Petition.” Ex. 1023, 31:7–15.

Patent Owner responds that its arguments about Yamatani were foreseeable and should have been addressed in the Petition because the Examiner considered the reference. *Id.* at 35:18–36:3.

We disagree with Patent Owner and determine that Petitioner has shown good cause for briefing on this issue. Here, it would be beneficial to receive additional briefing on the similarities between Yamatani and Saito. The two references are not identical. Although Yamatani was considered and listed on the IDS, Patent Owner’s arguments turn on a specific feature mentioned in Saito. Prelim. Resp. 27. In particular, Patent Owner identifies a citation to Yamatani on page 27 of Saito. *Id.* We agree with Petitioner that the argument about this specific citation was unforeseeable. Thus, we grant briefing limited to whether Saito is substantially similar to Yamatani under the two-part framework set forth in *Advanced Bionics*, and, if so, whether the Office erred in a manner material to the patentability of the challenged claims. We also authorize Patent Owner to file a preliminary sur-reply on

this issue, responding to the arguments raised in Petitioner’s preliminary reply.

III. ORDER

It is

ORDERED that Petitioner’s request to file a preliminary reply to Patent Owner’s Preliminary Response is *granted-in-part*;

FURTHER ORDERED that Petitioner’s preliminary reply must be filed no later than June 18, 2024, must be no more than four pages, and must be limited to addressing (1) why the analysis in the Petition shows that the cited prior art teaches or suggests “border motion vector data” under the agreed-upon construction discussed above in § II.1 and (2) whether, under the two-part framework set forth in *Advanced Bionics*, Saito is substantially similar to Yamatani and, if so, whether the Office erred in a manner material to the patentability of the challenged claims;

FURTHER ORDERED that Patent Owner is authorized to file a preliminary sur-reply no later than June 26, 2024, the preliminary sur-reply must be no more than four pages, and must be limited to responding to Petitioner’s preliminary reply; and

FURTHER ORDERED that the parties are authorized to file documentary evidence in support of any facts asserted in the preliminary reply or preliminary sur-reply but are not authorized to file additional declarations.

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