

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC., AMAZON.COM SERVICES LLC,

Petitioner,

v.

NOKIA TECHNOLOGIES OY,

Patent Owner.

IPR2024-00605

U.S. Patent No. 10,536,714

**PETITIONER'S PRELIMINARY REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

Rusert, Karczewicz, and Lin are not cited on the face of the '714 patent. WD4 and Nakamura's 10-page document (Ex-1007) are cited (Ex-1002, 100 (No. 36 "10 pages")), but there is no evidence that the full reference—which also includes Nakamura's WD (Ex-1008) and Presentation (Ex-1009)—was considered.

The Office has never considered the allowability of the '714 patent's claims in view of Rusert. PO argues for discretionary denial based on Rusert's citation in the prosecution of a *later*-filed continuation in the same family. POPR at 40. On June 7, 2021, *over a year and half after the '714 patent issued* (on Jan. 14, 2020), Nokia submitted an IDS that identified a Rusert family member among 43 other references. Ex-2004, 151-53. That application eventually issued as US 11,570,467, but with different claim scope than the '714 patent. The '467 patent's claims lacked the reduced comparison limitation ("without making a comparison of each pair from the set of spatial motion vector prediction candidates") that the Examiner cited as the reason for allowance for the parent of the '714 patent (Ex-1015, 390; Ex-1002, 118), and which PO did not dispute is taught by Rusert (*see generally* POPR). The Examiner had no reason to consider Rusert's reduced comparison teachings during prosecution of the '467 patent because that limitation was not present.

PO cites *Live Nation*, PGR2017-00038, Paper 11 (PTAB Jan. 16, 2018). However, the petitioner in *Live Nation* copied a third party submission from a child application that had similar claim scope as the challenged patent and presented the

same art and arguments—unlike here, where the challenged claims include a reduced-comparison limitation that was a reason for allowance but is missing in the child '467 patent. PO also cites *Ivantis*, IPR2022-01529, Paper 16 (PTAB Mar. 21, 2023), but in that case, the reference was cited in an earlier parent application and made of record in the challenged patent before issuance. *Id.* at 15. While the reference was also cited against later-filed continuations, those later claims had similar scope to the challenged claims. Neither is true here, as Rusert was not previously submitted before the '714 patent issued, and the claims of the '467 patent are missing the reduced-comparison limitation.

Factors (a), (b), and (d) weigh against denial because Rusert, Karcewicz, and Lin (Grounds 1-2) were not cited or considered during prosecution *of the '714 patent* and therefore are not the same or substantially the same as the cited references. Rusert is materially different from the cited art because it teaches a dynamically-constructed PMV_CANDS list using reduced comparisons (Pet., 40-41), which the Examiner overlooked and never commented on.

For Ground 3, nothing in the file history indicates that the full Nakamura reference was considered. Moreover, even if cited, the references were never discussed and the *combination* of Nakamura and WD4 was never considered. Ex-1015, 211, 308 (citing WD4 and 10-page Nakamura in different IDS forms 7 months apart). Therefore, Ground 3 is not the same or substantially the same as the

art or arguments that were previously presented. *See Samsung Electronics Co., Ltd. v. Evolved Wireless LLC*, IPR2021-00943, Paper 9 at 10-12 (PTAB Dec. 1, 2021) (no denial when file history provides little insight into the Examiner’s evaluation of art and Petitioner demonstrates with a reasonable likelihood that the previously presented art discloses the allegedly patentable features).

Rusert and Nakamura both teach the reduced-comparison limitation cited as the reason for allowance for the ’833 patent, which is missing from the ’467 patent. Pet., 40-42, 71. Rusert’s and Nakamura’s teachings are directly relevant to the alleged point of novelty, and therefore not cumulative of Han, Tai, and Huang. PO never addresses that both Rusert and Nakamura teach reduced comparisons which is irreconcilable with the NoA for the ’833 and ’714 patents. PO does not allege that any of Han, Tai, or Huang teach this limitation, nor could it, otherwise PO would be admitting that the ’833 patent was issued in error over the references.

Here, the combinations presented in Grounds 1-3 were never considered by the Examiner. PO attacks Karcewicz and Lin individually but fails to address the combinations with Rusert. PO does not contend that Petitioner’s obviousness arguments were considered by the Examiner or that the references alleged to be similar to Karcewicz and Lin were combined with a reference that is duplicative of Rusert. The Board has found error in prosecution when the Examiner “overlooked, or did not appreciate, the materiality of [prior-art] references” and “a reasonable

basis for a person having ordinary skill in the art to have combined the teachings in the manner recited in the claims.” *Snap, Inc. v. Playvuu, Inc.*, IPR2023-00848, Paper 12, 12-16 (PTAB December 6, 2023).

Factor (d) weighs against denial because the arguments made during prosecution do not overlap with Petitioner’s arguments. Indeed, the POPR did not repeat arguments from prosecution. Instead, the POPR introduced new arguments that attempt to distinguish Rusert and Nakamura, arguing that Rusert’s subset somehow does not depend on the scan pattern. In fact, as the Petition explained, Rusert’s subset is defined by—thus depends on—the x,y- position of the PMV candidate block; the subset includes candidates from the blocks in Rusert’s scan pattern up to the selected candidate. Pet., 36-37.

Factors (c), (e), and (f) also weigh strongly against denial. The allowance of the ’714 patent was in error because Rusert and Nakamura both teach the alleged point of novelty (involving reduced comparisons, as explained above). Factor (c) strongly weighs against denial because none of the prior art references were ever the basis of a rejection in any Office Action. Likewise, Factor (e) also weighs against denial because the Examiner failed to consider Rusert’s and Nakamura’s teachings of reduced comparisons. Finally, Factor (f) weighs against denial because the Petition presents testimony from Dr. Creusere explaining Rusert, Nakamura, and the H.264 and H.265 standards, which was not before the Examiner.

Respectfully submitted,

SHEPPARD, MULLIN,
RICHTER & HAMPTON LLP

/Harper Batts/

Harper Batts (Reg. No. 56,160)

Attorney for Petitioner

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing Petitioner's Preliminary Reply to Patent Owner's Preliminary Response complies with 37 CFR § 42.6 and the four-page limit specified by the Board. The page count does not include those portions excepted by 37 C.F.R. § 42.24(a)(1).

Respectfully submitted,

SHEPPARD, MULLIN,
RICHTER & HAMPTON LLP

/Harper Batts/

Harper Batts (Reg. No. 56,160)

Attorney for Petitioner

Date: September 20, 2024

1540 El Camino Real Suite 120
Menlo Park, CA 94025
Tel: (650) 815-2673

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on September 20, 2024, a true and correct copy of the Petitioner's Preliminary Reply to Patent Owner's Preliminary Response was served in entirety via email to all parties to this proceeding at the addresses indicated:

***Counsel for Patent Owner
Nokia Technologies OY***
Scott W. Hejny
shejny@McKoolSmith.com
Eric S. Hansen
ehansen@mckoolsmith.com

MCKOOL SMITH, P.C.
300 Crescent Court, Suite 1200
Dallas, Texas 75201
Telephone: 214.978.4000
Facsimile: 214.978.4044

SHEPPARD, MULLIN,
RICHTER & HAMPTON LLP

/Harper Batts/
Harper Batts (Reg. No. 56,160)
Attorney for Petitioner

Date: September 20, 2024

1540 El Camino Real Suite 120
Menlo Park, CA 94025
Tel: (650) 815-2673