

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.

IPR2024-00626 (Patent 11,805,267 B2)
IPR2024-00627 (Patent 11,805,267 B2)¹

Before GREGG I. ANDERSON, STEVEN M. AMUNDSON, 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)

¹ This order is being entered in two cases because it addresses issues common to both. The parties may not use this style heading for any papers filed in these cases unless authorized to do so.

I. SUMMARY

Petitioner requests authorization to file a preliminary reply to Patent Owner's Preliminary Response, addressing Patent Owner's arguments about discretionary denial under 35 U.S.C. § 325(d) and the proper construction of a claim term. *See* Ex. 3001 (email).² Patent Owner opposes this request. *Id.* Judges Anderson, Amundson, and Repko held a conference call with counsel for the parties. A transcript of that call has been entered into the record. Ex. 1017 ("Tr.").

We grant Petitioner's request with respect to the discretionary-denial issue but deny the request with respect to the claim-construction arguments. We authorize Patent Owner to file a preliminary sur-reply. Our reasoning follows.

II. ANALYSIS

A. *Discretionary Denial*

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 determine whether to deny the petition for this reason, 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

² Unless otherwise indicated, all citations in this order refer to the papers filed in IPR2024-00626. In some cases, the same papers were filed in IPR2024-00627: Ex. 3001 (email), Exhibit 1017 (transcript). In both cases, the Petition is Paper 3 ("Pet."), and Patent Owner's Preliminary Response is Paper 8 ("Prelim. Resp."). The challenges in the petitions are based on the same art, which are given the same exhibit numbers (1004, 1005, and 1006) in each case.

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).

In both petitions, Walker³ is the sole basis for Petitioner’s first ground. Pet. 12–13.⁴ The combination of Karczewicz-I⁵ and Karczewicz-II⁶ is the basis for the second ground. *Id.* In both petitions, Petitioner addressed the issue of discretionary denial under § 325(d), arguing that Walker and Karczewicz-I were not cited or considered during prosecution and Karczewicz-II was cited but there is no substantive analysis of it in the record. *Id.* at 86 (citing Ex. 1003 ¶¶ 46, 127, 131; Ex. 1002, 74–78).⁷

In both cases, Patent Owner argues in its Preliminary Response that the Board should exercise its discretion to deny the Petition under § 325(d)

³ U.S. Patent Application Publication No. US 2005/0281334 A1, published Dec. 22, 2005 (Ex. 1004).

⁴ This material is found on the same page in both petitions. Also, the same references are cited in both petitions.

⁵ U.S. Patent Application Publication No. US 2011/0007799 A1, published Jan. 13, 2011 (Ex. 1005).

⁶ U.S. Patent Application Publication No. US 2009/0257499 A1, published Oct. 15, 2009 (Ex. 1006).

⁷ Petitioner makes the same argument in both cases.

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because the grounds are based on substantially the same art that was cited to the Office during prosecution of the '267 patent. Prelim. Resp. 32–45.

As for the Petition's first ground, Patent Owner argues that Petitioner has not shown Walker differs in any material way from Ye '262⁸, Panchal⁹, or Karczewicz '057¹⁰, which were cited during prosecution. *Id.* at 32–36. In Patent Owner's view, Walker is cumulative to Ye '262, Panchal, Karczewicz '057, and other weighted bi-prediction references that the Examiner considered. *Id.* at 35.

As to the Petition's second ground, Patent Owner argues that Petitioner has not shown that Karczewicz-II differs in any material way from Ye '503¹¹ or VCEG-AI33¹², which were cited during prosecution. *Id.* at 36. Patent Owner also argues that Petitioner has not shown that the Karczewicz-I differs in any material way from Ye '262, Panchal, or Karczewicz '057, which were cited during prosecution. *Id.* at 43.

Patent Owner also argues "Petitioner has *not* presented an argument (nor can it) that the Patent Office erred in issuing the Challenged Claims included in the '267 Patent." *Id.* at 44–45.

⁸ U.S. Patent Application Publication No. US 2013/0142262 A1, published June 6, 2013 (Ex. 2009).

⁹ U.S. Patent Application Publication No. US 2010/0086027 A1, published Apr. 8, 2010 (Ex. 2008).

¹⁰ U.S. Patent No. US 9,161,057 B2, issued Oct. 13, 2015 (Ex. 2011).

¹¹ U.S. Patent Application Publication No. US 2009/0257503 A1, published Oct. 15, 2009 (Ex. 2007).

¹² "High Precision Interpolation and Prediction," ITU - Telecommunications Standardization Sector Study Group, Video Coding Experts Group (VCEG), 35th Meeting, Berlin, Germany (July 16–18, 2008) (Ex. 2010).

Petitioner requests additional briefing to address these arguments.

Ex. 3001. Petitioner argues that it would not have been reasonable to expect that Patent Owner would select several patents cited to the Office during prosecution on the Information Disclosure Statement (IDS) and try to argue that they were similar enough to warrant discretionary denial. Tr. 22:23–23:8.

Patent Owner responds that its arguments were foreseeable and should have been addressed in the Petition because the references considered by the Examiner are substantially similar to those relied upon in the Petition. *See id.* at 14:19–16:1. For example, Patent Owner argues that the references cited in the Petition and those considered by the Examiner have identical tables and equations. *Id.* at 14:18–15:3.

A petitioner must show good cause to file a reply to a preliminary response. 37 C.F.R. § 42.108(c) (2024). We agree that Petitioner has shown good cause for additional briefing here: There were 77 references cited to and considered by the Examiner. Ex. 1002 (Prosecution History), 144–148 (IDS considered Nov. 3, 2022), 204 (IDS considered May 14, 2023), 345–346 (IDS considered Jun. 8, 2023), 366 (IDS considered Sept. 21, 2023). One ground in the Petition relies, in part, on one of the references cited on an IDS. Pet. 12–13, 86. Patent Owner’s discretionary-denial arguments are directed to several of the other 76 IDS references. Prelim. Resp. 28–44. The present record does not indicate that Petitioner had a reason to preemptively present arguments comparing the prior art cited in the Petition to Ye ’262, Panchal, Karczewicz ’057, Ye ’503, or VCEG-AI33, which were among the many other IDS references previously presented to the Office. *See* Ex. 1002. For example, the Examiner did not issue any rejection based on these

references during the prosecution of the '267 patent. *See id.* at 124–130 (Non-Final Rejection, dated Nov. 2, 2022); *see also* Tr. 16:14–20.¹³ Nor did the Examiner otherwise substantively discuss any of them. *See* Pet. 86 (arguing there is “no substantive analysis in the file history”); Ex. 1002, 124–130, 186–187 (Notice of Allowance, dated May 14, 2023), 327–329 (Notice of Allowance, dated June 6, 2023).

Thus, we grant briefing limited to (1) whether Walker, Karczewicz-I, and Karczewicz-II are substantially similar to art previously presented to the Office and (2) whether the Office erred in a manner material to the patentability of the challenged claims. *See Advanced Bionics*, Paper 6 at 8–9.

We also authorize Patent Owner to file a preliminary sur-reply on this issue.

B. Claim Construction

The second issue relates to the meaning of the claim term “prediction.” Claim 1 recites, in part,

using said first reference block to obtain a first prediction, said first prediction having a second precision, which is higher than said first precision;
using said second reference block to obtain a second prediction, said second prediction having the second precision;

¹³ During prosecution of a parent application to the '267 patent, the Examiner issued a rejection based on Ye '262. Ex. 1007, 249–252 (Non-Final Rejection, dated July 28, 2015, Appl. No. 13/344,893); Ex. 1001, item (63) (Related U.S. Application Data). As for the '267 patent, the Examiner's only rejection in the Non-Final Rejection dated November 2, 2022 was based on nonstatutory obvious-type double patenting over U.S. Patent No. 11,019,354 (Appl. No. 16/729,974) and U.S. Patent No. 10,523,960 (Appl. No. 15/876,495). Ex. 1002, 126.

obtaining a combined prediction based at least partly upon said first prediction and said second prediction.

Ex. 1001, 21:14–34. Independent claim 13 recites a similar limitation. *Id.* at 22:43–67.

In the Petition and Preliminary Response, neither the Petitioner or Patent Owner addressed the construction of the term “prediction” in the respective sections on claim construction. *See* Pet. 12; Prelim. Resp. 27. In the Preliminary Response, Patent Owner argues “Petitioner’s interpretation that a weight, applied to a prediction, creates a higher precision prediction . . . contradicts the specification and prosecution history of the ’267 Patent, the understanding of a person of skill in the art and the express teachings of Walker.” Prelim. Resp. 46 (citing Pet. 19–23, Ex. 2001 ¶¶ 93, 102–116).

Petitioner argues that this argument is based on an implicit claim construction of the term “prediction.” Tr. 11:3–12:25. In Petitioner’s view, there is good cause to address this construction because it is a new claim construction that is contradicted by the challenged patent’s claims and specification. *Id.* at 12:15–18. According to Petitioner, Patent Owner mischaracterizes the file history in proposing its implicit construction. *Id.* at 12:19–22.

Patent Owner contends that it is simply relying on the plain and ordinary meaning of “prediction” and that Petitioner is construing the term incorrectly. *Id.* at 13:14–14:15.

We determine that Petitioner has not shown good cause to file a reply on this issue. Petitioner only seeks to respond to Patent Owner’s arguments in the Preliminary Response about the claim term “prediction.” The Board is able to assess whether Patent Owner’s arguments about that term are

consistent with the '267 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).

Thus, we deny Petitioner's request for a preliminary reply to address Patent Owner's alleged implicit construction of "prediction" in its Preliminary Response.

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 August 12, 2024, must be no more than four pages, and must be limited to addressing discretionary denial under § 325(d);

FURTHER ORDERED that Patent Owner is authorized to file a preliminary sur-reply no later than August 19, 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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