UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NOKIA TECHNOLOGIES OY,
Patent Owner

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Case: IPR2024-00626
U.S. Patent No. 11,805,267

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PATENT OWNER'S SUR-REPLY TO ITS PRELIMINARY RESPONSE

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Patent Trial and Appeal Board
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P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF EXHIBITS

Exhibit	Description
2001	Declaration of Dr. Iain Richardson
2002	CV of Dr. Iain Richardson
2003	File History of App. Ser. No. 15/250,124 ("'124 Application")
2004	File History of App. Ser. No. 15/490,469 ("'469 Application")
2005	File History of App. Ser. No. 15/876,495 ("'495 Application")
2006	File History of App. Ser. No. 16/729,974 ("'974 Application")
2007	Pat. App. Pub. No. US 2009/0257503 to Yan Ye, Peisong Chen, and Marta Karczewicz ("Ye '503")
2008	Pat. App. Pub. No. US 2010/0086027 to Rahul Panchal and Marta Karczewicz ("Panchal")
2009	Pat. App. Pub. No. US 2013/0142262 to Yan Ye and Alexandros Tourapis ("Ye '262")
2010	VCEG-AI33 by Yan Ye, Peisong Chen, and Marta Karczewicz
2011	U.S. Pat. No. 9,161,057 to Marta Karczewicz, Peisong Chen, and Yan Ye ("Karczewicz '057")
2012	Excerpts from "The H.264 Advanced Video Compression Standard", Richardson, 2010 (Cover pages, book pages 28-38, 69, 106, 108, 223-229)

Petitioner's Reply is a misguided attempt to argue points that could have been made in the Petition but were not. A Reply is not an appropriate means to address arguments "Petitioner could have reasonably foreseen" when filing its Petition. *Sandoz Inc. v. Abbvie Biotechnology Ltd.*, No. IPR2018-00002, Paper 11, 3 (P.T.A.B. Mar. 6, 2018).

Ground 1. Petitioner incorrectly contends, for the first time, that Walker, a reference on which Petitioner relies in its Petition, but which was not considered by the Patent Office when allowing the '267 Patent to issue, is not materially the same as Ye '262, a reference already considered by the Examiner. *See* Reply, 2. Petitioner's new Reply argument is improper. Patent Trial and Appeal Board, Consolidated Trial Practice Guide, 73 (Nov. 2019) ("Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.").

Petitioner's new Reply argument that Walker is not materially similar to Ye '262 is also incorrect. As explained in the Patent Owner Preliminary Response ("POPR"), Walker is materially similar to Ye '262, and therefore, pursuant to *Advanced Bionics* and *Becton*, the Board should not institute the IPR. Even if the IPR is instituted, the similarity of Walker to Ye '262 means that the Challenged

Claims are patentable over Walker, just as the Examiner found when he issued the claims of the ’267 Patent over Ye ’262.

Petitioner ignores the fact that Ye ’262 and Walker teach nearly identical equations for bi-direction. *See* POPR, 32-34. Instead, Petitioner now attempts to argue that the Walker reference is materially different than the Ye reference because Ye ’262 does not disclose “the number of bits needed[,]” whereas “Walker explicitly teaches the number of bits needed[.]” Reply, 2.

Petitioner’s Reply argument is misleading and wrong. What the Examiner found to be required by the Challenged Claims, but lacking in Ye ’262, is a second precision that is higher than the first precision, wherein the second precision indicates the number of bits needed to represent values of the first prediction and values of the second prediction. Ex-1007, 000252; POPR, 17. Petitioner, however, has not shown that Walker discloses a second precision that is higher than the first precision, wherein the second precision indicates the number of bits needed to represent values of the first prediction and values of the second prediction, which the Examiner found to be lacking in Ye ’262.

As Patent Owner demonstrated, Walker, like Ye ’262, lacks the claimed limitation of a second precision that is higher than the first precision, wherein the second precision indicates the number of bits needed to represent values of the first prediction and values of the second position. POPR, 33. This is because “Walker’s

detailed step-by-step disclosure of its bi-prediction methods show that both the input predictions (pred0 or pred1) and the final values of each bi-prediction process have the same precision, namely [using] 8 bits[,]" which is *different than* the bits needed, as illustrated in Tables 2, 3, and 4 of Walker. Ex-2001, ¶ 114; Ex-1004 ¶¶ 84, 89, 93; Tables 2-4; POPR, 55. Therefore, "[t]he first and second predictions of Walker represent only 256 possible values (8 bits), and whether those possible values are separated by 1 (unweighted) or by w0 or w1 (weighted) does not change the precision of the prediction." Ex-2001, ¶ 115; POPR, 56.

Even if Petitioner's arguments in its Reply are correct, which they are not, they are insufficient to rebut Patent Owner's contention that the Board should deny the Petition under *Advanced Bionics*. Petitioner fails to address, let alone rebut, Patent Owner's contentions: (1) that Walker does not differ in any material way from the Panchal and Karczewicz '057 references cited during prosecution (POPR, 34-36); and (2) that Petitioner has not established that the Patent Office erred during prosecution (POPR, 44-45).

Ground 2. Although Petitioner acknowledges that K2 was cited in an IDS during the prosecution of the '267 Patent, Petitioner wrongfully asserts that the Examiner erred by "overlooking *combinations* based on [Karczewicz-I ("K1")] and [Karczewicz-II ("K2")]" and therefore, according to Petitioner, institution should not be denied under *Advanced Bionics* with respect to K1 and K2. Reply, 4.

First, in its Petition, Petitioner does not contend that K2 is materially different than Ye '503 or VCEG-AI33, both of which were before the Examiner during prosecution. POPR, 36-37. Second, Petitioner now admits that K2 is similar to Ye '503 and VECG-AI33 (Reply, 3), which contradicts Petitioner's argument in the first place. Third, Petitioner fails to address Patent Owner's contention that K1 does not differ in any material way from Ye '262, Panchal, or Karczewicz '057, all of which were before the Examiner. POPR, 43-44.

The fact that K1 and K2 are materially similar to references that the Examiner considered, but did not attempt Petitioner's proposed modified combination, means that the Examiner did not err by "overlooking" the purported K1-K2 combination. There is no "overlooking," or any Examiner error, in a case where the Examiner had before him materially similar references that he did not attempt to combine.

Petitioner further fails to address Patent Owner's contention that Petitioner failed to even demonstrate a motivation to combine K1 and K2. POPR, 57-63. Petitioner's unsupported conclusion that there "is express motivation to combine K1 and K2" (Reply, 4) is also contradicted by the references themselves, which teach generating and using input bit-depth precision predictions. Breaking multiple references to recreate a claim using hindsight does not mean an examiner erred by not using hindsight when evaluating claims.

Dated: August 19, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S SUR-REPLY TO ITS PRELIMINARY** has been served on Petitioner via email on the following counsel of record for Petitioner:

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