

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NOKIA TECHNOLOGIES OY,
Patent Owner.

IPR2024-00691
Patent 8,050,321 B2

Before GREGG I. ANDERSON, STEVEN M. AMUNDSON, and
JASON M. REPKO, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Denying Petitioner's Request to File a Preliminary Reply
37 C.F.R. §§ 42.5, 42.108(c)

I. INTRODUCTION

Amazon.com, Inc. and Amazon.com Services LLC (collectively “Petitioner”) filed a Petition requesting an *inter partes* review of claims 8–11 in U.S. Patent No. 8,050,321 B2 (Ex. 1001, “the ’321 patent”) under 35 U.S.C. §§ 311–319. Paper 1. Nokia Technologies Oy (“Patent Owner”) filed a Preliminary Response. Paper 7.

On July 10, 2024, Petitioner’s counsel emailed the Board seeking leave to file a preliminary reply to Patent Owner’s Preliminary Response. *See* Ex. 3001. In particular, Petitioner requests authorization to address the following issues:

- (1) Patent Owner’s alleged “mischaracterization of the prior art’s teachings (MPEG-1 and Kim) and application of those teachings to element 8[a] (whether MPEG-1’s closed_GOP flag or temporal reference in exemplary embodiments teach ‘an indication’ of the first image frame recited in element 8[a] and whether Kim’s IAD similarly teaches such an indication)”;¹ and
- (2) Patent Owner’s alleged “mischaracterization of claim 8’s scope as limited to a particular order of operations.”

Id. Patent Owner opposes Petitioner’s request. *Id.*

On July 16, 2024, the panel (Judges Anderson, Amundson, and Repko) held a conference call with counsel for the parties to discuss Petitioner’s request. The record includes a transcript of the conference call. *See* Ex. 1016.

¹ *See* International Standard ISO/IEC 11172-2 (1st ed.) titled “Information Technology - Coding of Moving Pictures and Associated Audio for Digital Storage Media at Up to About 1,5 Mbit/s - Part 2: Video” (“MPEG-1”); and U.S. Patent No. 6,912,351 B1 titled “Method and Device for Condensed Image Recording and Reproduction” to Kim (“Kim”).

The Board's rules require that a petitioner make a showing of good cause for leave to file a preliminary reply. 37 C.F.R. § 42.108(c) (2024).

II. THE PARTIES' RESPECTIVE ARGUMENTS

During the conference call, Petitioner explained that it seeks authorization to file a preliminary reply to address arguments in Patent Owner's Preliminary Response that mischaracterize teachings in the references and how those teachings relate to the challenged claims. Ex. 1016, 4:13–17. Petitioner argued that good cause exists for a preliminary reply because Petitioner could not have reasonably anticipated that Patent Owner would mischaracterize the application of the references to element 8[a] or claim 8's scope as outlined in the July 10, 2024, email to the Board. *Id.* at 4:17–21; *see also* Ex. 3001.

Additionally, Petitioner contended that Patent Owner's Preliminary Response includes implicit claim constructions that exclude a preferred embodiment in the '321 patent or add a requirement not supported by intrinsic evidence. *See* Ex. 1016, 6:11–7:15. According to Petitioner, it could not have anticipated that Patent Owner would construe the challenged claims to exclude a preferred embodiment or to impute an order to the steps of the method recited in claim 8. *Id.* at 7:21–8:9.

Patent Owner responded that it did not intend to propose implicit claim constructions for the challenged claims in the Preliminary Response, but merely intended to distinguish the claims from the references. *See* Ex. 1016, 9:9–10:25, 16:5–8. Given this information, Patent Owner argued that good cause to grant Petitioner's request does not exist. *Id.* at 10:11–17. According to Patent Owner, all of Petitioner's arguments supporting its

request relate to what the references teach—not positions on claim construction. *Id.*; *see also id.* at 13:4–10.

Regarding the implicit claim-constructions issues, both parties stated that similar issues did not arise in a parallel civil action for patent infringement or in a related International Trade Commission investigation. Ex. 1016, 8:10–13, 13:21–14:7, 16:5–8.

Petitioner noted that it would have no need for a preliminary reply if the Board accepts Patent Owner’s representation about not proposing implicit claim constructions for the challenged claims in the Preliminary Response. Ex. 1016, 11:6–19. If, however, the Board is inclined to consider those arguments, Petitioner still would like the opportunity to address them. *Id.*; *see also id.* at 15:3–20.

III. ANALYSIS

As noted above, the Board’s rules require that a petitioner make a showing of good cause for leave to file a preliminary reply. 37 C.F.R. § 42.108(c). Under the circumstances here, we determine that Petitioner has not made a showing of good cause for leave to file a preliminary reply.

First, Petitioner has not established good cause for additional briefing based on Patent Owner’s alleged mischaracterizations of the references (MPEG-1 and Kim) because we are fully capable of reviewing the statements about the references in the Petition, the statements about the references in the Preliminary Response, and the references themselves to decide whether Petitioner satisfies the “reasonable likelihood” standard for instituting trial.

Second, Patent Owner represented that the arguments in the Preliminary Response do not rely on implicit claim constructions. At this early stage of the proceeding, we accept that representation.

Third, the parties agree that there are no new developments in the parallel civil action for patent infringement or in the related International Trade Commission investigation that would warrant Petitioner's request for a preliminary reply.

For these reasons, we deny Petitioner's request for leave to file a preliminary reply to Patent Owner's Preliminary Response.

IV. ORDER

Accordingly, it is

ORDERED that Petitioner's request for leave to file a preliminary reply to Patent Owner's Preliminary Response is *denied*.

IPR2024-00691
Patent 8,050,321 B2

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