

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTEL CORPORATION,

Petitioner

v.

TELEFONAKTIEBOLAGET LM ERICSSON,

Patent Owner.

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IPR2024-01008

U.S. PATENT NO. 9,641,841

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

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**LIST OF EHXIBITS**

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                                                           |
|--------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Ex-2001            | Declaration of Dr. Iain Richardson                                                                                                                                           |
| Ex-2002            | <i>Curriculum Vitae</i> of Dr. Iain Richardson                                                                                                                               |
| Ex-2003            | ITU Webpage showing ITU-T Rec. H.261, first published in 1988, <a href="https://www.itu.int/rec/T-REC-H.261-198811-S/en">https://www.itu.int/rec/T-REC-H.261-198811-S/en</a> |
| Ex-2004            | PDF Print of FiltScript2.m                                                                                                                                                   |
| Ex-2005            | PDF Print of TestFilt2.m                                                                                                                                                     |
| Ex-2006            | PDF Print of FiltBlocksAltThr_2a.txt                                                                                                                                         |
| Ex-2007            | PDF Print of FiltBlocksAltThr_2b.txt                                                                                                                                         |
| Ex-2008            | PDF Print of FiltBlocksThr1Thr2_2a.txt                                                                                                                                       |
| Ex-2009            | PDF Print of FiltBlocksThr1Thr2_2a.txt                                                                                                                                       |
| Ex-2010            | PDF Print of FiltStatsAltThr_2a.txt                                                                                                                                          |
| Ex-2011            | PDF Print of FiltStatsAltThr_2b.txt                                                                                                                                          |
| Ex-2012            | PDF Print of FiltStatsThr1Thr2_2a.txt                                                                                                                                        |
| Ex-2013            | PDF Print of FiltStatsThr1Thr2_2b.txt                                                                                                                                        |
| Ex-2014            | PDF Print of TestUint8.c                                                                                                                                                     |
| Ex-2015            | Sullivan et al., <i>HEVC: Algorithms and Architectures</i> (2014)                                                                                                            |

Institution of inter partes review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding”). Section 325(d) permits the Director to “take into account whether, and reject the petition or request because, the same or substantially the same prior art *or* arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

First, Petitioner asserts that the Board should not exercise discretionary denial because there is no substantive reason offered for discretionary denial of Ground 1. Petitioner’s Preliminary Reply at 1. However, Petitioner relies on disclosure from Bjontegaard (Ground 1) and Aksu (Ground 2) for the same proposition that the Challenged Claims are unpatentable because the prior art in the asserted Grounds allegedly discloses or renders obvious two separate block-specific calculations to determine how many pixels to filter in each block based on specific Laplacian equations. As explained in Patent Owner’s Preliminary Response and below, that combination of elements was previously presented to the Examiner during prosecution.

Second, Petitioner does not appear to dispute that the disclosure in Aksu on which the Petition is based, for example, is cumulative of the disclosure of List. Instead, Petitioner’s argument that discretionary denial should not be exercised boils down to the notion that, even though the Examiner *expressly relied upon the*

*combination* of Bjontegaard '048 and List to reject the pending claims during prosecution, the Examiner did not recognize or consider the combination of Bjontegaard '048' "Laplacian" equations with List's separate equations because the Examiner did not include enough analysis of these elements in its rejection.

Even if the Examiner did not expressly cite portions of List in the reasoning for the rejection, this combination of references was undeniably presented to and considered by the Examiner. Specifically, Examiner stated that the combination of Bjontegaard and List taught each element of the pending independent claims, further explaining that "[o]ne of ordinary skill in the art, at the time of Applicant's invention, would have been motivated to combine the elements taught by Bjontegaard with those of List because both publications are drawn to the same field of endeavor and because such a combination of teachings is helpful for a skilled artisan to understand a full implementation of the H.264 deblocking algorithm." Ex-1002, at 411. The disclosure of List was previously presented to the Examiner, which the Board should consider when determining whether to exercise discretionary denial. *Ivantis, Inc. et al. v. Sight Sciences, Inc.*, IPR2022-01533, Paper 14 at 14 (exercising discretionary denial based on a reference that the Examiner "did not expressly rely on" during prosecution, but was previously presented to Examiner).

Petitioner effectively disregards whether the same or substantially the same prior art previously was presented to the Office, focusing instead almost exclusively

on whether the Examiner, in the rejection, expressly responded to the same arguments now presented in the Petition. In doing so, Petitioner “disregards the conjunctive ‘or’ that appears in the statute. 35 U.S.C. § 325(d).” *Nespresso USA, Inc. v. K-Fee System GmbH*, IPR2021-01223, Paper 9 at 12. Despite Petitioner’s argument to the contrary, “[w]here either the prior art references advanced or the arguments raised in a petition previously were presented to the Office, the inquiry shifts to whether the petitioner establishes a material error.” *Id.* at 12-13 (citing *Advanced Bionics, LLC v. MED-EL Elektronmedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8). Petitioner has not established such an error.

For the foregoing reasons, when deciding whether to institute or deny the Petition, the Board should take into consideration that the same or substantially the same prior art was previously presented to the Office.

Date: November 8, 2024

Respectfully Submitted

/ David Frist /

David Frist, Reg. No. 60,511

John Haynes, Reg. No. 44,754

Christopher TL Douglas, Reg. No. 56,950

Stephen R. Lareau, Reg. No. 63,273

### **CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on November 8, 2024, a complete and entire copy of this Reply to Petitioner's Preliminary Reply were provided via email, to the Petitioner by serving the email correspondence addresses of record as follows:

kaiser-ptab@perkinscoie.com  
Sathe-ptab@perkinscoie.com  
Lembo-ptab@perkinscoie.com  
Kendrick-ptab@perkinscoie.com  
Onley-ptab@perkinscoie.com  
yang-ptab@perkinscoie.com  
Intel-Ericsson-IPRs@perkinscoie.com

Date: November 8, 2024

By: / David Frist /  
David Frist (Reg. No. 60,511)