

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.

IPR2024-01139 (Patent 6,950,469 B2)
IPR2024-01140 (Patent 7,280,599 B2)
IPR2024-01141 (Patent 8,036,273 B2)¹

Before SCOTT B. HOWARD, STEVEN M. AMUNDSON, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

ORDER

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

¹ This Order addresses issues that are the same in each of the above-identified proceedings. The combined caption is for administrative convenience only and does not indicate that these proceedings have been joined. The parties are not authorized to use this caption without express permission from the Board.

IPR2024-01139 (Patent 6,950,469 B2)
IPR2024-01140 (Patent 7,280,599 B2)
IPR2024-01141 (Patent 8,036,273 B2)

I. SUMMARY

Petitioner emailed the Board requesting a conference call to discuss authorization to file a preliminary reply to Patent Owner's Preliminary Response in all three cases to address (1) Patent Owner's arguments for discretionary denial in view of the parallel district-court litigation and (2) Patent Owner's mischaracterization of the Petition. *See* Ex. 3001 (Petitioner's email to the Board). Patent Owner opposes additional briefing on the alleged mischaracterizations but does not oppose additional briefing on the parallel district-court litigation. *Id.* Judges Howard, Amundson, and Repko held a conference call with counsel for the parties.

We deny Petitioner's request for a preliminary reply. Our reasoning follows.

II. ANALYSIS

A petitioner must show good cause to file a preliminary reply to a preliminary response. 37 C.F.R. § 42.108(c) (2024). Here, Petitioner argues that additional briefing on both issues is supported by good cause because the Preliminary Response mischaracterizes the Petition and the parallel district-court litigation.

For example, as for the parallel litigation, Petitioner disagrees with the Preliminary Response's discussion of when Petitioner filed its motions under 35 U.S.C. § 101. *See, e.g.*, IPR2024-01139, Paper 9 ("Prelim. Resp.") at 67–68.² Petitioner's proposed additional briefing, however, would not

² Similar arguments were made in IPR2024-01140 (*see* Paper 7, 64–65) and IPR2024-01141 (Paper 7, 67–68).

IPR2024-01139 (Patent 6,950,469 B2)
IPR2024-01140 (Patent 7,280,599 B2)
IPR2024-01141 (Patent 8,036,273 B2)

cover developments in the parallel litigation since the Petition or Preliminary Response was filed.

Petitioner also argued that Patent Owner mischaracterized the Petition's arguments about how the TML6³ source code functions (*see* Prelim. Resp. 31–32)⁴ and Petitioner's motivation to combine the TML6 source-code files (Prelim. Resp. 38–40).⁵ According to Petitioner, good cause exists for a preliminary reply to the Preliminary Response because Petitioner could not have anticipated Patent Owner's mischaracterizations and should have a fair opportunity to address them.

Patent Owner disagrees that Petitioner has shown good cause here. Patent Owner argues that Petitioner merely seeks an additional opportunity to present its arguments. According to Patent Owner, the TML6 arguments in the Preliminary Response were foreseeable for at least the reason that, before the Petition was filed, the same issues were argued in other petitions for *inter partes* review.⁶ Patent Owner argues that, although Petitioner

³ TML-6 is H.26L Test Model Long Term Number 6 draft0 Reference Code. This source code is Exhibit 1005 in all proceedings and is a basis for challenging the patentability of the claims at issue in each proceeding.

⁴ The argument also appears in IPR2024-01140 (*see* Paper 7, 32) and IPR2024-01141 (Paper 7, 33).

⁵ The argument also appears in IPR2024-01140 (*see* Paper 7, 38–40) and IPR2024-01141 (Paper 7, 39–41).

⁶ A different Petitioner filed the previous petitions. *See* Ex. 3001 (discussing IPR2020-01685, Paper 14 at 28, 46–48; IPR2021-00035, Paper 12 at 28, 47–49; IPR2021-00036, Paper 11 at 29, 47–49; IPR2021-00037, Paper 11 at 27–28, 46–48; IPR2021-00038, Paper 10 at 29, 47–49; IPR2021-00039, Paper 10 at 27–28, 46–48; IPR2021-00040, Paper 11 at 28, 47–49; IPR2021-00041, Paper 11 at 27, 47–49; IPR2021-00042, Paper 13 at 27, 47–49; IPR2021-00043, Paper 11 at 29, 50–52).

IPR2024-01139 (Patent 6,950,469 B2)
IPR2024-01140 (Patent 7,280,599 B2)
IPR2024-01141 (Patent 8,036,273 B2)

argues that the TML6 source-code files should be considered a single, publicly available reference, Petitioner does not sufficiently explain why a person of ordinary skill in the art would have been motivated to combine the different source-code files.

We determine that Petitioner has not shown good cause to file a preliminary reply to the Preliminary Response. During the conference call, Petitioner acknowledged that there were no developments in the parallel district-court proceeding that support its request for a preliminary reply here. Although Patent Owner does not oppose briefing on the parallel district-court litigation, the Board is capable of reviewing the arguments of record about the litigation without further briefing from the parties. For both issues that Petitioner proposes to cover in a preliminary reply, the sole basis for Petitioner's request is a desire to respond to Patent Owner's arguments in the Preliminary Response. The Board needs no further briefing to determine whether the arguments in Patent Owner's Preliminary Response mischaracterize the Petition. Thus, Petitioner has not established good cause under 37 C.F.R. § 42.108(c), and Petitioner's request to file a preliminary reply is denied.

IPR2024-01139 (Patent 6,950,469 B2)
IPR2024-01140 (Patent 7,280,599 B2)
IPR2024-01141 (Patent 8,036,273 B2)

III. ORDER

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

IPR2024-01139 (Patent 6,950,469 B2)
IPR2024-01140 (Patent 7,280,599 B2)
IPR2024-01141 (Patent 8,036,273 B2)

FOR PETITIONER:

Jessica Kaiser
Robin Brewer
Jonathan R. Carter
PERKINS COIE LLP
kaiser-ptab@perkinscoie.com
brewer-ptab@perkinscoie.com
carter-ptab@perkinscoie.com

FOR PATENT OWNER:

Scott W. Henry
Eric S. Hansen
MCKOOL SMITH, P.C.
shejny@mckoolsmith.com
ehansen@mckoolsmith.com