

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.

IPR2024-01175
Patent 6,856,701 B2

Before JAMESON LEE, JOHN D. HAMANN, and
JASON M. REPKO, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Denying Petitioner's Request for Additional Briefing
37 C.F.R. §§ 42.5, 42.108(c)

On February 13, 2025, Petitioner sent an email requesting authorization to file a preliminary reply to Patent Owner's Preliminary Response. This request was opposed by Patent Owner. On February 21, 2025, we held a call¹ with counsel for the parties during which the parties presented arguments as to Petitioner's request. We were unpersuaded by Petitioner's arguments, and we denied Petitioner's request on the call. This Order memorializes our decision, and provides our reasoning.

A petitioner "seek[ing] leave to file a reply to the preliminary response . . . must make a showing of good cause." 37 C.F.R. § 42.108(c) (2024). When determining good cause, we look to whether the argument at issue in the preliminary response was reasonably foreseeable. *See, e.g., Illumina, Inc. v. The Trs. of Columbia Univ. in the City of New York*, IPR2018-00797, Paper 17, 3 (PTAB Aug. 7, 2018).

First, Petitioner argued that Patent Owner implicitly construed the term "context" which was not foreseeable because Patent Owner did not construe context in the underlying district court litigation. But we are a separate forum than the district court, and parties may have reasons to pursue certain arguments in one forum and not the other. This separateness is foreseeable and consistent with our guidance as to claim construction for proceedings before the Board:

The Board will determine the claim construction based on the record of the proceeding at issue. Thus, as in a district court proceeding, the parties should point out the specific portions of the specification, prosecution history, and relevant extrinsic evidence they want considered, and explain the relevancy of any such evidence to the arguments they advance.

¹ Petitioner arranged for a court reporter for the call, and we requested that Petitioner file a copy of the transcript as an exhibit.

Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”) 46.

Second, Petitioner argued that Patent Owner’s construction for “context” was not foreseeable because Patent Owner incorrectly argued that the ’701 patent’s Specification defines “context.” Rather, other portions of the Specification show that “context” is not narrowly defined, according to Petitioner. But these arguments did not warrant a preliminary reply. Patent Owner purportedly relies on the Specification, which obviously Petitioner had when filing the Petition. That the parties have differing views of what the Specification discloses is not only foreseeable, but commonplace. The Board is fully capable of reviewing the parties’ arguments and the Specification’s disclosures to make an initial claim construction determination without additional briefing.

Accordingly, we determined that Petitioner had not established good cause.

Thus, it was:

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

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