

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TikTok Inc.,
Petitioner,

v.

NTECH Properties, Inc.,
Patent Owner.

Case No. IPR2024-01339
U.S. Patent No. 9,317,597

PETITIONER'S PRELIMINARY REPLY

PO makes three arguments for discretionary denial under 35 U.S.C. § 325(d): 1) the examiner considered and rejected Marcus156’s disclosure of “second video programming”; 2) Ferman (Ex. 1012) is cumulative of Begeja (Ex. 2001); and 3) secondary references not considered during prosecution are “immaterial.” These arguments are meritless, and the Board should institute this IPR.

I. The PTO Did Not Consider Whether Marcus156 Disclosed “Second Video Programming”

Petitioner relies on Marcus156 as a primary reference, but the examiner only considered Marcus156 as a secondary reference, ***and only in the context of a different patent application***. To overcome this substantial difference in how Marcus156 is applied—which warrants institution under *Becton* factor (d)—PO contends the examiner found Marcus156 was missing “second video programming” that is the focus of the PO’s validity argument. PO is incorrect.

When the examiner first raised Marcus156 as a secondary reference ***in a different patent application***, the examiner had already found in prior office actions that the “second video programming” limitation was met by the primary reference, Kaiser. Ex. 1005 at 183 (“Kaiser clearly teaches ... ‘defin[ing] second video programming’, as currently claimed.”). Thus, there was no reason for the examiner to consider whether a secondary reference, Marcus156, ***also*** disclosed that same limitation. Instead, the examiner only relied on Marcus156 for a different, newly-added claim element. Ex. 1005 at 200-204 (applicant adding “the template comprises

a plurality of variable corresponding to potential viewing scenarios of two or more selected video clips in a temporal relationship to each other” and arguing Kaiser lacked it), 219-21 (examiner cited Marcus156 only for the new limitation); POPR at 6 (“the Examiner cited Marcus156 for its temporal ordering”).

Instead of relying on the *examiner’s* statements and actions, PO repeatedly cites the *applicant’s* remarks. POPR at 1-2, 6-16. The applicant’s remarks about Marcus156 and “second video programming” are not relevant, because no pending rejection relied on any disclosure by Marcus156 for that limitation. Moreover, the examiner never endorsed the applicant’s remarks. PO contends that the examiner’s generic statement in the notice of allowance—that the prior art of record did not teach the claims—was a blanket endorsement of the applicant’s characterization of Marcus156. POPR at 9.¹ That is not the law, and PO cites no authority for such a broad interpretation. To the contrary, examiner endorsement requires an affirmative statement of agreement with the PO’s specific arguments, which is absent here. *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1375 (Fed. Cir. 2003). Because PO’s

¹ PO also claims that during the prosecution of yet another different patent, the “Examiner determined ... Marcus156 ... does not disclose ‘searching’ for and ‘defining second video programming.’” POPR at 9 (citing Ex. 1006 at 99-102). That is false. There, the examiner again made a generic statement that the cited art did not teach the claims, without saying which limitations were missing from Marcus156.

argument was not responsive to any outstanding rejection, the examiner did not need to agree with PO's characterization of Marcus156 to allow the claims. Finally, PO's suggested rule would improperly incentivize applicants to put reams of irrelevant, self-serving, but ultimately incorrect statements into the record that the examiner would then need to waste time rebutting to avoid automatically endorsing.

To the extent the examiner agreed with the applicant's characterization of Marcus156 and "second video programming" (there is no evidence he did), the examiner erred, making denial unwarranted under *Becton* factor (e). *Advanced Bionics, LLC v. MEL-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (material error includes "misapprehending or overlooking specific teachings of the relevant prior art").² First, there is no evidence the examiner ever considered a critical disclosure in Marcus156 of generating a "second video programming." *Compare* Ex. 1005 (never citing Marcus156 at 14:35-58), *with* Pet. at 21-24 (explaining how Marcus156 at 14:35-58 discloses the claimed "second video programming"). Second, if the examiner did consider Marcus156 at 14:35-58 and found that it did not disclose the claimed "second programming," then the examiner erred by adopting the same incorrect claim construction of "second video programming" advanced by PO in the POPR. Specifically, PO's basis for

² PO contends that Petitioner "alleges no error in the Office's prior consideration," POPR at 17, but that is false. *See* Pet. at 68.

contending that Marcus156 does not disclose “second video programming” is because (according to PO) that limitation is not met by a sequence of “additional video clips” just because those clips are appended to the “first video programming.” POPR at 7-8. PO has no support for its construction, and the examiner’s reliance on any such construction would thus have been erroneous. Moreover, Marcus156 discloses “second video programming” even under PO’s improper construction. Ex. 1009 at 14:35-58 (“interactive video” (claimed “second video programming”) is separate from “a predetermined program” (claimed “first video programming”)).

II. Ferman Is Not Cumulative of Begeja

PO’s arguments directed to Ferman are similarly unavailing. First, it is undisputed that Ferman was never cited or considered during prosecution, counseling against denial under *Becton* factor (c). Second, substantial differences between Ferman and Begeja confirm that institution is proper under *Becton* factors (a) and (b). PO’s chart of alleged similarities, POPR at 21-23, quotes arbitrary portions of these references but lacks any analysis in support of PO’s contention that the references are similar or cumulative. For example, PO contends that “Ferman is less relevant to the Challenged Claims than Begeja because Ferman’s selection is through a ‘Length’ window with no identification of first video clips.” But the Petition addresses in detail how Ferman discloses that limitation. Petition at 51-52 (citing Ferman at Fig. 10; [0105], [0107], [0112], [0114], [0152], [0154], [0250]).

In contrast, the POPR contains no analysis showing how Begeja is purportedly more relevant than Ferman. PO also contends that, “[l]ike Begeja, Ferman’s system presents a system to generate highlight reels from a full version of a video.” POPR at 2. But PO does not identify any “highlight reels” in Begeja that would render Ferman cumulative. Third, PO’s cited cases are inapposite. *Alarm.com, Inc. v. Vivint, Inc.*, IPR2022-00728, Paper 6 at 19-20 (PTAB Nov. 1, 2022) addressed references that “share[d] the same written description and drawings in all relevant parts.” There is no such overlap between Ferman and Begeja. Similarly, in *Autel Intelligent Tech. Corp. v. Orange Elec. Co.*, IPR2021-01545, Paper 8 at 23 (PTAB Apr. 8, 2022), “[f]our out of the five references cited by the Petition are identical to the references considered in the Third Reexamination”—not the case here.

III. Petitioner’s Secondary References Further Warrant Institution

All grounds in the Petition incorporate secondary references not cited or considered during prosecution, counseling in favor of institution under *Becton* factor (f). PO attempts to summarily dismiss these references as “immaterial” because they allegedly do not render obvious “second video programming.” POPR at 26. PO is wrong. For example, Petitioner expressly cited Hosken to the extent PO argues the other art “does not fully render obvious a second video search.” Pet. at 35-39. Hosken discloses the “multiplicity of branched and inter-related programming” that PO contends the examiner found missing from Marcus156. POPR at 29.

Respectfully submitted,

Dated: January 22, 2025

By: /s/ James M. Glass

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing document was served on January 22, 2025 via email directed to counsel of record for Patent Owner.

Dated: January 22, 2025

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