

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIKTOK INC.,
Petitioner,

v.

NTECH PROPERTIES, INC.,
Patent Owner.

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

PATENT OWNER'S PRELIMINARY SUR-REPLY

I. INTRODUCTION

With respect to **Grounds 1-3**, AB step one is satisfied because the examiner raised Marcus156 during prosecution of the parent, and step two is satisfied because the only errors alleged in the Reply depend on misreading Marcus156 and applying an overbroad construction of “second video programming,” which NTech disclaimed during prosecution. With respect to **Grounds 4-5**, AB step one is satisfied because (1) Petitioner does not dispute that its arguments based on Ferman are substantially the same as those the examiner considered and rejected with respect to Begeja during prosecution of the parent, and (2) Ferman is substantially similar to Begeja because while Petitioner identifies some differences between the references, it does not allege that any that are material to patentability. AB step two is satisfied because Petitioner alleges no error in the examiner's determination.

II. ARGUMENT

A. The Board Should Deny Ground 1 Under § 325(d)

1. AB Step 1: Marcus156 Was Previously Presented

Petitioner's admission that the examiner cited Marcus156 in an office action rejection (Reply at 1) is sufficient to satisfy AB step one. *Roku, Inc. v. Universal Elecs., Inc.*, No. IPR2019-01619, Paper 11 at 12 (P.T.A.B. Apr. 2, 2020) (If “the same prior art was previously presented to the Office, [the Board] need not reach the question of ‘whether the same or substantially the same arguments previously were presented to the Office.’”).

2. AB Step Two: Petitioner Has Not Shown Error

Petitioner admits that the only possible errors under AB step two turn on (1) the proper understanding of Marcus156's disclosure at 14:35-58 and (2) the proper construction of "second video programming." Reply at 3-4.

Petitioner's first argument is meritless because the cited "passage explicitly contradicts Petitioner's claim that Marcus156 discloses generating a 'new stream of video programming' based on interactive searches and video selections." POPR at 30-31 ("The system will then generate suitable transitions and **add those assets to the programming.**") (quoting Marcus156 at 14:40-55). Petitioner does not address this dispositive disclosure or NTECH's arguments about it in its Reply. Reply at 3.

Prosecution history disclaimer resolves Petitioner's second argument—that the Examiner erred in adopting the same claim construction argument presented in the POPR—in NTECH's favor. *Techtronic Indus. Co. v. Int'l Trade Comm'n*, 944 F.3d 901, 907 (Fed. Cir. 2019) (an applicant may disavow claim scope "by distinguishing the claimed invention over the prior art") (citation omitted). Indeed, Petitioner's argument that NTECH's statements during prosecution are "not relevant" (Reply at 2) misstate the law because the disclaimer "analysis focuses on what the applicant said, not on whether the representation was necessary or persuasive." *Uship Intell. Props., LLC v. United States*, 714 F.3d 1311, 1315-16 (Fed. Cir. 2013).

NTECH's statements distinguishing Marcus156 establish that it disavowed the construction that Petitioner admits is required to support its argument under § 325(d). Reply at 3-4. Notably, while NTECH's POPR made the same arguments, based on the same evidence, NTECH did not believe there was any dispute over the correct construction of this term in view of Petitioner's recognition that the "second video programming" must be a "new stream of video programming." POPR at 30-32; Pet. at 22. In any event, NTECH disavowed the interpretation that Petitioner belatedly presses, which encompasses appending additional video clips to the "first video programming" (Reply at 4):

The invention, unlike Marcus[156], provides customized first video programming as a basis from which to select a wide range of **additional second video programming** that is also customized, and which adheres to template rules by which this **different video programming** is related or consistent

Ex. 1005 at 240-41 (emphasis added). NTECH's remarks distinguishing Begeja reinforce this disavowal. *Id.* at 241 (Begeja only allows for "more of an entire video program," not "additional programming").

The Board should reject Ground 1 under § 325(d) because Marcus156 was previously presented, and Petitioner has not established any error.

B. Petitioner's Arguments About Ferman are Substantially Similar to Begeja and Ferman is No More Relevant

1. AB Step One: The Office Considered Substantially Similar Arguments and Art

AB step one is satisfied because Petitioner does not dispute that its arguments based on Ferman are substantially the same as the arguments the Office rejected based on Begeja. *Gardner Denver, Inc. v. Utex Indus., Inc.*, No. IPR2020-00333, Paper 12 at 6, 8-11 (P.T.A.B. Aug. 5, 2020) (exercising § 325(d) discretion because the petitioner's arguments "mirror[ed] Examiner's reliance" on different art); POPR at 20-22. The Ferman and Begeja arguments both claimed that providing more or less of the same video program based on a user interaction satisfies the "second video programming" limitation. POPR at 24-25; Ex. 1005 at 153-54 (rejection over Begeja); Pet. at 47 (searching for "clips from the same program"), 50-51 (playing highlights of the same program). However, as persuasively argued during prosecution, merely providing "more of an entire video program" is not tantamount generating "second video programming." Ex. 1005 at 240-41. Thus, the arguments the Office considered and rejected based on Begeja are substantially similar to those Petitioner raises with respect to Ferman.

AB step one is also satisfied because Ferman is cumulative to Begeja. *Regents of the Univ. of Calif. v. Eli Lilly & Co.*, 119 F.3d 1559, 1574-75 (Fed. Cir. 1997) (a reference is cumulative and not "material" when it "teaches no more than what a reasonable examiner would consider to be taught by the prior art already before the

PTO”) (citation omitted). Petitioner does not identify a single disclosure in Ferman that makes it more relevant to patentability than Begeja was. Reply at 4-5. Thus, although Petitioner identifies some differences between Ferman and Begeja, it does not allege that any differences are “material.” *Id.*

2. AB Step Two: Petitioner Alleges no Error

In Reply, Petitioner only argues that Ferman is not cumulative to Begeja. *Id.* at 4-5. It did not dispute the fact that its arguments premised on Ferman are substantially similar to those already rejected with respect to Begeja, and it did not *allege any error* in the examiner’s analysis of NTECH’s argument on this issue. *Id.* Denial of Petitioner’s Grounds 4-5 under § 325(d) is, therefore, warranted in view of the Office’s “commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Advanced Bionics, LLC v. MED-EL Elektromedizinisch Geräte GmbH*, No. IPR2019-01469, Paper 6 at 9 (P.T.A.B. Feb. 13, 2020).

III. CONCLUSION

NTECH respectfully requests that the Board deny institution because Petitioner (1) raises the same prior art (Marcus156) already considered during prosecution based on a theory that requires a claim construction that NTECH expressly disclaimed during prosecution and (2) raises substantially the same prior art (Ferman) and arguments without distinguishing its arguments based on Ferman from those considered with respect to Begeja and without alleging examiner error.

Respectfully submitted,

Dated: February 5, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the Patent Trial and Appeal Case Tracking System (P-TACTS) and e-mailing an electronic copy to counsel of record for Petitioner constitutes electronic service, service was made on Petitioner as detailed below.

<i>Date of service</i>	February 5, 2025
<i>Manner of service</i>	Electronic Filing and Electronic Mail (jimglass@quinnemanuel.com; ogizivojnovic@quinnemanuel.com; qe-bytedance-ntech-iprs@quinnemanuel.com)
<i>Documents served</i>	PATENT OWNER'S PRELIMINARY SUR-REPLY
<i>Persons Served</i>	Quinn Emanuel Urquhart & Sullivan LLP, James M. Glass Ognjen Zivojnovic

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