

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

INTERDIGITAL INC.,
Patent Owner.

IPR2024-01441
Patent 9,674,556 B2

Before JAMESON LEE, KRISTEN L. DROESCH, and
LISA A. MURRAY, *Administrative Patent Judges*.

MURRAY, *Administrative Patent Judge*.

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

I. BACKGROUND

In an email to the Board dated February 26, 2025, Petitioner requested permission for leave to file a five-page Preliminary Reply to Patent Owner's Preliminary Response in this proceeding. Ex. 3001. Petitioner requested this authorization "to address Patent Owner's arguments regarding Section 325(d)." *Id.* The email indicated that Patent Owner opposes the request.

On February 27, 2025, Judges Lee, Droesch, and Murray held a conference call with counsel for the parties. A court reporter was present, and Petitioner's counsel was directed to enter the transcript into the record once it becomes available.

II. ANALYSIS

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) (2023). "However, the Board does not expect that such a reply will be granted in many cases due to the short time period the Board has to reach a decision on institution." Patent Trial and Appeal Board Consolidated Trial Practice Guide ("CTPG") at 52.¹

When determining whether a petitioner has shown good cause for a reply to a preliminary response, the Board may assess 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) (Order) (stating that "the

¹ Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), *available at* <http://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

Board may authorize a reply to afford a petitioner the opportunity to address evidence or arguments that it could not have reasonably foreseen”); *Sandoz Inc. v. AbbVie Biotech. Ltd.*, IPR2017-01824, Paper 13, 3 (PTAB Dec. 15, 2017) (Order) (same).

During the call, counsel for Petitioner argued that good cause exists to allow a preliminary reply to Patent Owner’s arguments urging the Board to deny the petition under 35 U.S.C. § 325(d) (Paper 6, “Prelim. Resp.”). Petitioner’s counsel argued that when the Petition (Paper 3, “Pet.”) was filed it was not foreseeable that Patent Owner would argue that various references are “cumulative” of other references under part one of the *Advanced Bionics*² analysis. See Prelim. Resp. 62–69 (arguing that Guleryuz³ is cumulative of Applicant Admitted Prior Art (“AAPA”)⁴ considered by the Examiner and that Chiang⁵ and VC1⁶ are cumulative of the Lee⁷ reference considered by the Examiner).

Counsel for Patent Owner responded that the issue of whether the references relied on in the Petition are cumulative of references previously

² *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (designated precedential Mar. 24, 2020) (“*Advanced Bionics*”).

³ Ex. 1010 (Onur G. Guleryuz, A Nonlinear Loop Filter for Quantization Noise Removal in Hybrid Video Compression, IEEE Int’l Conference on Image Processing) (“Guleryuz”).

⁴ As described in the patent at issue, US Patent No. 9,674,556 B2. Ex. 1001 at 2:4–13.

⁵ Ex. 1007 (U.S. Patent Appl. Publ. No. 2006/0110062) (“Chiang”).

⁶ Ex. 1009 (SMPTE Standard: VC-1 Compressed Video Bitstream Format and Decoding Process, SMPTE 421M-2006) (“VC1”).

⁷ Ex. 1006 (U.S. Patent Appl. Publ. No. 2003/0219073) (“Lee”).

before the Office was foreseeable at least because section 325(d) was addressed in the Petition. *See* Pet. 69–72 (arguing that the Board should not exercise its discretion under section 325(d) to deny institution). Patent Owner asserted that its cumulativeness arguments were foreseeable because the Petition uses the references relied upon in Grounds 2 (Chiang and Lin) and 3 (VC1 and Guleryuz) in the same way that it uses the references relied upon in Grounds 1A (Lee) and 1B (Lee and AAPA). The Lee and AAPA references were undisputedly considered by the Examiner during prosecution. Counsel for Patent Owner also contended that its arguments were foreseeable because the Guleryuz reference is cited in the Specification of the '556 patent and constitutes part of the AAPA.

After considering the parties' arguments and reviewing the Petition and Preliminary Response, we find that the section 325(d) issues relating to the references relied on in the Petition were addressed in both papers in sufficient detail that additional briefing is not necessary regarding the asserted prior art references. The Board has enough information to weigh both parties' arguments as to whether Lin, VC1, or Guleryuz are cumulative of Lee, Chiang, or AAPA, without further briefing at this time.

In its Preliminary Response, however, Patent Owner also argues that VC1 is cumulative to the H.264 reference,⁸ which the Petition uses as evidence of the public availability of Guleryuz. Prelim. Resp. 65–66; *see* Pet. 3. This issue was not addressed in the Petition. During the conference call, counsel for Petitioner argued that it could not have foreseen that Patent Owner would raise this argument concerning a reference that is not relied on

⁸ Ex. 1018 (Bojnordi, Mahdi Nazm et al., A Fast Two Dimensional Deblocking Filter For H.264/AVC Video Coding, May 2006) (“H.264”).

to show unpatentability of any of the claims in the Petition. We find this argument persuasive, and agree that additional briefing, limited to a response to Patent Owner's argument that VC1 is cumulative to H.264, would be helpful to the Board. Patent Owner has indicated that it does not oppose supplemental briefing limited to this one issue.

III. CONCLUSION

We determine that Petitioner has shown good cause to allow additional briefing limited in scope to the issue of whether VC1 is cumulative of H.264. Accordingly, Petitioner's request for leave to file a Preliminary Reply is granted in part.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for leave to file a preliminary reply to Patent Owner's Preliminary Response is *granted in part*;

FURTHER ORDERED that, within five business days of the entry of this Order, Petitioner shall submit its Preliminary Reply, limited to five pages, addressing only the issue of whether VC1 is cumulative of H.264; and

FURTHER ORDERED that, within five business days of the entry of Petitioner's Preliminary Reply, Patent Owner may submit a Preliminary Sur-reply, limited to five pages, addressing only issues raised in Petitioner's Preliminary Reply.

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