

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.

IPR2024-01507
Patent 8,996,693 B2

Before JAMESON LEE, STEVEN M. AMUNDSON, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

ORDER

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

I. BACKGROUND

In an email to the Board, Petitioner requested permission for leave to file a five-page preliminary reply to Patent Owner's Preliminary Response in this proceeding. *See* Ex. 3001. Petitioner indicates that Patent Owner opposes the request. *Id.*

Judges Lee, Amundson, and Repko held a conference call with counsel for the parties. A court reporter was present, and Petitioner filed the transcript as Exhibit 1018 ("Tr.").

The Board was unpersuaded by Petitioner's arguments and denied Petitioner's request during the conference call. Tr. 16:3–5. This Order memorializes the Board's decision and provides the reasoning for denying Petitioner's request.

II. ANALYSIS

A petitioner may request to file a reply to the preliminary response. 37 C.F.R. § 42.108(c). "Any such request must make a showing of good cause." *Id.* "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, 52 (USPTO Nov. 2019).¹

In determining whether to grant the request for a reply, the Board considers "the specific facts of the particular case." *Id.* For example, 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 Board may authorize a reply to afford a

¹ <http://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>

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 conference call, Petitioner’s counsel argued that good cause exists because it was not foreseeable that Patent Owner would misquote and mischaracterize what Petitioner’s expert said and make false statements about the Petition. Tr. 4:1–17, 7:2–8:25. According to Petitioner’s counsel, Patent Owner also raises an unexpected argument that Petitioner’s proposed construction for “processing element” is inconsistent with the term’s plain and ordinary meaning. *Id.* at 8:15–25. Petitioner’s counsel argued that Patent Owner’s argument about the recited “processing element” raises an unexpected legal issue concerning lexicography and patentee disavowal. *Id.* at 8:6–14. Petitioner’s counsel also argued that it could not expect Patent Owner to argue for a construction that excludes embodiments in the challenged patent’s specification. *Id.* at 6:6–14.

Patent Owner’s counsel responded that the disagreement was foreseeable because its argument is simply that the plain and ordinary meaning for “processing element” should apply. *Id.* at 9:11–10. Patent Owner’s counsel argued that the Board is capable of resolving this claim-construction dispute without additional briefing and determining whether Patent Owner’s characterization is correct. *Id.* at 9:11–10, 10:14–23.

We see nothing unforeseeable here that would give rise to good cause to file a reply. Patent owners routinely argue that claims, construed in light of the specification, do not read on the prior art. Also, it may frequently be the case that one party disagrees with how the other party characterizes the arguments or evidence. Nor do we see any other circumstances that would

give rise to good cause for a reply. Here, Petitioner proposed a claim construction for “processing element” in its Petition (*see* Pet. 19), and Patent Owner disagreed (*see* Prelim. Resp. 17–32). During the call, Petitioner’s counsel acknowledged that its request for a Reply was not based on any new developments in the co-pending district court proceeding that occurred after the Petition’s filing. Tr. 5:7–14. The Board is fully capable of resolving the claim-construction dispute, including alleged mischaracterizations, based on the arguments provided in the Petition, Preliminary Response, and a review of the record without additional briefing.

ORDER

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

IPR2024-01507
Patent 8,996,693 B2

FOR PETITIONER:

Harper Batts
Christopher Ponder
Jeffrey Liang
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
hbatts@sheppardmullin.com
cponder@sheppardmullin.com
jliang@sheppardmullin.com

FOR PATENT OWNER:

Scott Hejny
Eric Hansen
MCKOOL SMITH, P.C.
shejny@mckoolsmith.com
ehansen@mckoolsmith.com