

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ASUSTEK COMPUTER INC.  
Petitioner,

v.

NOKIA TECHNOLOGIES OY  
Patent Owner.

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Case IPR2025-01153  
Patent 10,536,714

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**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL OF INSTITUTION**

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**LIST OF EXHIBITS**

| <b>Exhibit No.</b>    | <b>Description</b>                                                                                                                                                                                                                                                   |
|-----------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>ASUS-1001</b>      | U.S. Patent No. 10,536,714 to Bici, et al. (“the ’714 patent”)                                                                                                                                                                                                       |
| <b>ASUS-1002</b>      | Prosecution File History for the ’714 patent (“Prosecution History”)                                                                                                                                                                                                 |
| <b>ASUS-1003</b>      | Declaration of Joseph Havlicek (“Havlicek Declaration”)                                                                                                                                                                                                              |
| <b>ASUS-1004</b>      | U.S. Patent Application Publication No. 2011/0194609 to Rusert et al (“Rusert”)                                                                                                                                                                                      |
| <b>ASUS-1005</b>      | U.S. Patent Application Publication No. 2011/0249721 to Karczewicz et al (“Karczewicz”)                                                                                                                                                                              |
| <b>ASUS-1006</b>      | U.S. Patent Application Publication No. 2014/0092981 to Lin et al (“Lin”)                                                                                                                                                                                            |
| <b>ASUS-1007</b>      | Nakamura et al., “Unification of derivation process for merge mode and MVP,” Joint Collaborative Team on Video Coding (JCT-VC) of ITU-T SG16 WP3 and ISO/IEC JTC1/SC29/WG11, 6th Meeting, Torino, Italy, Jul. 14-22, 2011, Document JCTVC-F419 (“Nakamura Document”) |
| <b>ASUS-1008-1011</b> | [RESERVED]                                                                                                                                                                                                                                                           |
| <b>ASUS-1012</b>      | U.S. Provisional Application 61/301,649 (“Rusert Provisional”)                                                                                                                                                                                                       |
| <b>ASUS-1013</b>      | U.S. Provisional Application 61/500,903 (“Lin Provisional”)                                                                                                                                                                                                          |
| <b>ASUS-1014</b>      | [RESERVED]                                                                                                                                                                                                                                                           |
| <b>ASUS-1015</b>      | Prosecution File History for U.S. Patent No. 9,571,833 (“’833 Prosecution History”)                                                                                                                                                                                  |
| <b>ASUS-1016</b>      | [RESERVED]                                                                                                                                                                                                                                                           |
| <b>ASUS-1017</b>      | European Prosecution File History for 12845839 (“European Prosecution History”)                                                                                                                                                                                      |
| <b>ASUS-1018</b>      | U.S. Patent Application Publication No. 2012/0128067 to Liu (“Liu”)                                                                                                                                                                                                  |
| <b>ASUS-1019</b>      | Gary J. Sullivan, Recent Developments in Standardization of High Efficiency Video Coding (HEVC) (“Sullivan”)                                                                                                                                                         |
| <b>ASUS-1020</b>      | Frank Bossen, HEVC Complexity and Implementation Analysis (“Bossen”)                                                                                                                                                                                                 |
| <b>ASUS-1021</b>      | Jian-Wei Chen et al, Introduction to H.264 advanced video coding. In: Proceedings of the 2006 Asia and South Pacific                                                                                                                                                 |

|                       |                                                                                                                                                                                                           |
|-----------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
|                       | Design Automation Conference vol. 2006, pp. 736–741 (2006)                                                                                                                                                |
| <b>ASUS-1022</b>      | Won, Kwanghyun et al, Motion vector coding using decoder-side estimation of motion vector. In 2009 IEEE International Symposium on Broadband Multimedia Systems and Broadcasting (BMSB). IEEE, 2009       |
| <b>ASUS-1023</b>      | Gary J. Sullivan et al, The H.264/AVC Advanced Video Coding Standard: Overview and Introduction to the Fidelity Range Extensions, SPIE Conference on Applications of Digital Image Processing XXVII, 2004 |
| <b>ASUS-1024-1051</b> | [RESERVED]                                                                                                                                                                                                |
| <b>ASUS-1052</b>      | Institution Decision IPR2024-00604, Paper 11, November 7, 2024                                                                                                                                            |
| <b>ASUS-1053</b>      | Institution Decision IPR2024-00605, Paper 11, November 7, 2024                                                                                                                                            |
| <b>ASUS-1054</b>      | August 1, 2025 ASUS Stipulation                                                                                                                                                                           |
| <b>ASUS-1055</b>      | U.S. Patent No. 9,571,833 to Bici, et al. (“the ’833 patent”)                                                                                                                                             |
| <b>ASUS-1056</b>      | Office Action of August 16, 2021 in U.S. Application No. 16/741,156                                                                                                                                       |
| <b>ASUS-1057</b>      | Amendment of February 16, 2022 in U.S. Application No. 16/741,156                                                                                                                                         |

## I. INTRODUCTION

ASUSTeK Computer Inc. (“Petitioner” or “ASUS”) seeks review of U.S. Pat. No. 10,536,714 (“the ’714 patent”). The factors set forth in Deputy Director Stewart’s March 2025 memo and subsequent decisions support institution: ASUS repeats a prior successful challenge to a young patent (less than six years old) that was issued in error.

Indeed, the appropriateness of referral is underscored by the Board’s prior institution of earlier-filed petitions by Amazon, Inc. on the *same* challenged claims of the ’714 patent based on the *same* prior art (Rusert, Karczewicz, and Lin) that ASUS applies in the present Petition. *See* ASUS-1052 (IPR2024-00604); ASUS-1053 (IPR2024-00605).<sup>1</sup> Through institution of Amazon’s Petitions, the Office already found a reasonable likelihood that the Challenged Claims are unpatentable over Rusert and Karczewicz. ASUS-1052, p. 40; ASUS-1053, p. 41. ASUS simply asks the Board to pick back up where it left off in reviewing the Rusert, Karczewicz, and Lin grounds that the Board previously endorsed in Amazon’s Petitions.

In addition, the ’714 patent is young, as it issued just five years ago in 2020. And the challenge leveraged in the present petition was first made by Amazon on

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<sup>1</sup> IPR2024-00604 and IPR2024-00605 terminated pursuant to settlement shortly after institution. ASUS was not a party to these proceedings.

April 8, 2024 when the '714 patent was only four years old. Accordingly, Nokia has not yet developed settled expectations in its recently-issued patent. *See Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 12 at 2-3 (Stewart June 26, 2025) (finding that patents issued in 2019 and 2020 have “not been in force for a significant period of time” and thus Patent Owner’s settled expectations “[did] not favor discretionary denial”).

Further, as discussed in more detail below, Examiner error occurred in the Office’s issuance of the '714 patent. Specifically, in issuing the '714 patent, the Examiner improperly relied on examination of the parent application to the '714 patent without adequately searching for the subject matter claimed in the '714 patent and failed to identify Rusert, a reference that was used to reject claims in a child application that are similar to the claims in the '714 patent.

To sum, at least the three reasons discussed above (and reproduced below) justify the use of PTAB resources in the dispute between Nokia and ASUS:

- 1) Grounds based on a prior successful challenge;
- 2) Early challenge to a patent where expectations are not settled; and
- 3) Correction of errors that occurred during examination.

Each of these justifications has been identified by the Deputy Director as warranting use of PTAB resources. And each is applicable to the Nokia/ASUS dispute for reasons that are similar to prior cases that have been referred.

Although each of these factors alone justifies referral of the present Petition, taken collectively, these factors strongly favor institution and override any concern over parallel proceeding overlap. This is particularly true here where ASUS has eliminated potential overlap by offering a sweeping *Sotera*-plus stipulation that includes foregoing the use of the asserted art in combination with system art (or any prior art) in accordance with the Deputy Director's *Motorola* decision.

Finally, the merits of the Petition are strong and well-supported by competent expert testimony and contemporaneous third-party evidence. Thus, under these facts and given the present record, ASUS respectfully requests that the Deputy Director decline Nokia's request to discretionarily deny institution of this IPR and refer ASUS's Petition for a determination on the merits

## **II. *INTER PARTES* REVIEW IS AN APPROPRIATE USE OF OFFICE RESOURCES**

### **A. The Petition Presents a Strong Patentability Challenge Based on the Same Prior Art That the PTAB Previously Endorsed Through Institution of Earlier IPRs Challenging the '714 Patent**

The Petition presents straightforward obviousness grounds that are especially strong on the merits. This is evident from the Board's prior institution of Amazon's petitions challenging the '714 patent based on the *same* prior art—Rusert, Karczewicz, and Lin—that ASUS applies in the current Petition. *Compare* Paper 2, *with* ASUS-1052; ASUS-1053. For example, the present Petition relies in Ground

1 on Rusert and Karczewicz to demonstrate obviousness of claims 1-3, 5-10, 12-17, 19- 24, and 26-30 of the '714 patent. The Board's institution decisions in the Amazon proceedings addressed similar contentions of obviousness based on Rusert and Karczewicz and found that the combination renders obvious all limitations of the claims including the feature that led to allowance—comparing motion information of the first spatial motion vector prediction candidate with motion information of spatial motion vector prediction candidates in the determined subset of spatial motion vector prediction candidates without making a comparison of each pair from the set of spatial motion vector prediction candidates. ASUS-1052, pp. 35-36; ASUS-1053, pp. 35-36; ASUS-1002, p. 118. The second ground that relies on Lin further strengthens the merits of the Petition's challenge.

Notably, the Deputy Director has repeatedly referred petitions challenging claims on which the Board previously instituted an IPR challenge or which the Board had finally determined to be unpatentable. *See Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, at 2-3 (“Other considerations, however, counsel against discretionary denial. For example, Petitioner ... asserts that the merits are strong because the Board previously determined there was a reasonable likelihood that similar claims of an ancestor patent were unpatentable in three separate proceedings with respect to some of the challenged patents in these proceedings.”); *Posco Co., LTD. V. Arcelormittal*, IPR2025-00370, Paper 10 at 3 (PTAB Jun. 25,

2025) (“[I]t is an appropriate use of Office resources to provide consistency and predictability to the public and to ensure that a patent applicant or owner does not take action inconsistent with the judgment in a prior Office proceeding.”); *Mercedes-Benz Group AG v. The Phelan Group, LLC*, IPR2025-00758, Paper 8 at 2 (PTAB August 14, 2025) (referral decision highlighting that “[t]he challenged patent” in a recently instituted IPR “has similar claims to those challenged in this proceeding”); *Padagis US v. Neurelis*, IPR2025-00464, Paper 12 at 2-3 (PTAB July 16, 2025) (a prior decision indicating unpatentability of claims of a related patent reciting similar subject matter as the challenged claims weighs against discretionary denial); *Nintendo Co., LTD et al., v. Resonant Systems*, IPR2025-00680, Paper 18 at 3 (PTAB August 14, 2025) (“Other factors counsel against discretionary denial as well. In particular, in an *inter partes* review of a continuation patent of the challenged patent, the Board has determined claims that are substantially similar to the challenged claims to be unpatentable.”). The principle highlighted in these decisions should apply in even greater force here where ASUS’s petition does not merely challenge “similar” or “related” claims to those challenged in a previously instituted IPR, but rather challenges the *same* claims as those challenged in the instituted Amazon petitions based on overlapping prior art.

Notably, Nokia’s discretionary denial brief does not raise any road mapping concerns as ASUS stayed true to the arguments set forth in Amazon’s petitions. And

ASUS took steps to make the Amazon petitions more efficient for the Board and the parties. Specifically, ASUS consolidated the two Amazon petitions into a single petition and also removed the Nakamura grounds where the Board determined that “Petitioner has not shown a reasonable likelihood that it would prevail.” ASUS-1052, pp. 59-60; ASUS-1053, pp. 61-62. Thus, ASUS’s petition was crafted with fairness and efficiency in mind.

Nokia contends that the ITC is best positioned to consider the prior art advanced in the petition because the “ITC is very familiar with both the ’714 patent and the asserted prior art.” Paper 10, p. 17. Not so. The ITC only considered two prior art references against the ’714 patent—Nakamura and WD4. EX-2008, pp. 101-108. And, as discussed above, ASUS has removed the Nakamura and WD4 grounds from the Amazon petitions to avoid the inefficiency of repeating challenges that have previously been considered. To be clear, the ITC did not review the prior art advanced in this petition—Rusert, Karczewicz, and Lin. *Id.*

But the Board did. As set forth in its Institution Decision, the Board completed a detailed review of the ’714 patent and offered 28 pages of detailed analysis of the same prior art combinations advanced in the Petition. ASUS-1052, pp. 19-46. From the Board’s prior review, it is the Board that is best positioned to consider the prior art advanced in the Petition. For these reasons, it would be most efficient to allow the Board to pick back up where it left off in review of Rusert, Karczewicz, and Lin.

**B. Wilus Has Little to No Settled Expectations in the '714 Patent**

The '714 patent issued on January 14, 2020, and has thus been in force for less than six years. Because the '714 patent has not been in force “for a significant period of time,” Nokia “has not developed strong settled expectations that favor discretionary denial.” *Cambridge Indus.*, Paper 12 at 2-3 (Stewart June 26, 2025) (finding that patents issued in 2019 and 2020 have “not been in force for a significant period of time” and thus Patent Owner’s settled expectations “[did] not favor discretionary denial”).

In addition, the '714 patent was first challenged on April 8, 2024 when the '714 patent was only four years old. The prior successful challenge unsettled any expectations Nokia had in the '714 patent. Nokia also is still pursuing a continuation in this family (*see* U.S. Patent App. No. 18/161,722), further confirming that any rights related to this patent are not settled. With active prosecution, the public would benefit from Board review since a substantive review of the petition’s grounds would help guide examination of the pending continuation and help ensure the examiner reaches the correct patentability decision in the continuation application.

**C. Material Error by the Office Warrants Referral Where the Examiner Improperly Relied On Examination of a Parent Application and Failed to Identify Prior Art That Was Later Used to Reject Similar Claims in a Child Application**

Material error during prosecution weighs heavily against discretionary denial. When the Office has committed a material error in prosecution of a challenged patent, correction of such an error has been deemed to be of paramount importance, often overcoming facts that otherwise would have resulted in a *Fintiv* denial. *See, e.g., Microsoft Corp. v. Partec Cluster Competence Cent. GmbH*, IPR2025-00318, Paper 9, 3 (Stewart June 12, 2025) (“*Microsoft v. Partec*”); *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, 3 (Stewart July 16, 2025); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11, 2 (Stewart June 12, 2025); *Anthony Inc. v. ControlTec, Inc.*, IPR2025-00559, Paper 12, 2 (Stewart July 16, 2025) (“*Anthony*”); *USAA Federal Savings Bank v. PACid Technologies, LLC*, IPR2025-00697, Paper 9, 2-3 (Stewart August 14, 2025); *Samsung Electronics Co., Ltd., v. Wilus Institute of Standards*, IPR2025-00935, Paper 12, 2-3 (September 26, 2025). Indeed, when “[p]etitioner appears to show a material error by the office,” the Deputy Director has found that “it is an appropriate use of Office resources to review the potential error”—***even if the trial date in the copending litigation precedes the FWD date.*** *Microsoft v. Partec*, IPR2025-00318, Paper 9, 3 (referring to the panel, despite a later trial date, because

“Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error”); *Taiwan Semiconductor Manufacturing Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11, 3-4 (Stewart September 3, 2025) (referring to the panel where petitioner had shown “a material error by the Office” despite co-pending ITC litigation).

Here, the Examiner erred by improperly relying on examination of a parent patent and failing to appreciate prior art (i.e., Rusert) that was later used to reject similar claims in a child application. Specifically, during prosecution of the ’714 patent, the Examiner did not raise any rejections. *See* ASUS-1002; *Alliance Laundry Systems, LLC v. Payrange LLC*, IPR2025-00573, Paper 9, at 2 (Stewart July 17, 2025)(“the patent examiner did not apply any art or reference during prosecution”). In the Notice of Allowance, the Examiner noted that “the current application is a continuation of patent issued application no. 13/666,680 and ***includes limitations analogous to the claims of the patented application.***” ASUS-1002, p. 118. However, as shown below, a straightforward comparison of claim 1 of the parent patent (ASUS-1055; U.S. Patent No. 9,571,833) to claim 1 of the ’714 patent reveals that the claims are not analogous with claim 1 of the ’714 patent being materially shorter.

**U.S. Patent No. 9,571,833**

1. A method comprising:  
receiving a block of pixels including a prediction unit;  
determining a set of spatial motion vector prediction candidates for the block of pixels; the spatial motion vector prediction candidates being provided with motion information;  
selecting a first spatial motion vector prediction candidate from the set of spatial motion vector prediction candidates as a potential spatial motion vector prediction candidate to be included in a merge list for the prediction unit, where the merge list is constructed based on the motion information of the spatial motion vector prediction candidates and is utilized to identify motion vector prediction candidates of which one spatial motion vector prediction candidate from the merge list is signaled as the motion information for the prediction unit;  
determining a subset of spatial motion vector prediction candidates based on a location of the block associated with the first spatial motion vector prediction candidate;  
comparing motion information of the first spatial motion vector prediction candidate with motion information of spatial motion vector prediction candidates in the determined subset of spatial motion vector prediction candidates without making a comparison of each possible candidate pair from the set of spatial motion vector prediction candidates, wherein comparing comprises performing an equivalence check or comparing a difference in motion information to a threshold or other similarity metric;  
if at least one of the comparisons indicates that the motion vector information of the spatial motion vector prediction candidates correspond with each other, excluding the first spatial motion vector prediction candidate from the merge list; and  
causing information identifying the one spatial motion vector prediction candidate from the merge list to be transmitted to a decoder or to be stored.

**The '714 Patent**

1. A method comprising:  
selecting a first spatial motion vector prediction candidate from a set of spatial motion vector prediction candidates for a block of pixels as a potential spatial motion vector prediction candidate to be included in a motion vector prediction list for a prediction unit of the block of pixels, where the motion vector prediction list comprises motion information of the spatial motion vector prediction candidates and is utilized to identify motion vector prediction candidates of which one spatial motion vector prediction candidate from the motion vector prediction list is signaled as the motion information for the prediction unit;  
determining a subset of spatial motion vector prediction candidates based on a location of the block associated with the first spatial motion vector prediction candidate;  
comparing motion information of the first spatial motion vector prediction candidate with motion information of spatial motion vector prediction candidates in the determined subset of spatial motion vector prediction candidates without making a comparison of each pair from the set of spatial motion vector prediction candidates;  
determining to include or exclude the first spatial motion vector prediction candidate in the motion vector prediction list based on the comparing; and  
causing information identifying the one spatial motion vector prediction candidate from the motion vector prediction list to be transmitted to a decoder or to be stored.

And as it relates to the “comparing” feature the Examiner identified in the reasons for allowance, the parent patent (ASUS-1055; U.S. Patent No. 9,571,833) has additional limitations missing from the '714 patent. Specifically, as shown below, the parent patent specifies that “wherein comparing comprises performing an equivalence check or comparing a difference in motion information to a threshold or other similarity metric.” *Id.*

**U.S. Patent No. 9,571,833**

comparing motion information of the first spatial motion vector prediction candidate with motion information of spatial motion vector prediction candidates in the determined subset of spatial motion vector prediction candidates without making a comparison of each possible candidate pair from the set of spatial motion vector prediction candidates, wherein comparing comprises performing an equivalence check or comparing a difference in motion information to a threshold or other similarity metric;

**The '714 Patent**

comparing motion information of the first spatial motion vector prediction candidate with motion information of spatial motion vector prediction candidates in the determined subset of spatial motion vector prediction candidates without making a comparison of each pair from the set of spatial motion vector prediction candidates;

Missing Limitation

For these reasons, the claims of the '714 patent are not analogous to the claims of its parent patent and the Examiner erred by relying too heavily on examination of the parent. In fact, as shown below, time stamps in the Examiner's search history indicate that the Examiner only spent **26 minutes** (12:14 to 12:40) searching for prior art related to the '714 patent. ASUS-1002, pp. 130-134.

| Ref # | Hits  | Search Query                       | DBs                                                                        | Default Operator | Plurals | Time Stamp          |
|-------|-------|------------------------------------|----------------------------------------------------------------------------|------------------|---------|---------------------|
| L1    | 63216 | (spatial or intra) with predict\$3 | US-PGPUB;<br>USPAT;<br>USOCR;<br>FPRS; EPO;<br>JPO;<br>DERWENT;<br>IBM_TDB | OR               | ON      | 2019/08/10<br>12:14 |

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| L50 | 8 | L46 and L49 | US-PGPUB;<br>USPAT;<br>USOCR;<br>FPRS; EPO;<br>JPO;<br>DERWENT;<br>IBM_TDB | OR | ON | 2019/08/10<br>12:40 |
|-----|---|-------------|----------------------------------------------------------------------------|----|----|---------------------|

The Examiner also neglected to initial the references cited on the applicant's information disclosure statement at the time of allowance (*see* ASUS-1002, pp.

126-129) and only referred to prior art on Form PTO-892 in the reasons for allowance. *See* ASUS, p. 118 (“none of the cited prior arts (See PTO-892) teach the above feature”). Given the differences in the claims of the ’714 patent and its parent application, the Examiner’s cursory review was improper and constitutes material examiner error. Indeed, the Examiner’s review pales in comparison to the resistance applied to the European counterpart by the European Patent Office, which required lengthy limitations making claim 1 *three pages long* in the corresponding European patent. ASUS-1017, 000335-351.

Had the Examiner completed a more thorough review the Examiner would have uncovered the Rusert prior art reference applied in the present petition. As the Board previously found, Rusert discloses the “comparing” limitation the Examiner cited in the Reasons for Allowance. ASUS-1052, pp. 35-36; ASUS-1053, pp. 35-36; *see also* Paper 2, pp. 32-36. Also, in a continuation of the ’714 patent, the Examiner applied Rusert in a rejection of claims that are similar to those issued in the ’714 patent. *See* ASUS-1056. Specifically, upon review of Rusert, the Examiner revoked a prior indication of allowability and found that Rusert teaches a limitation similar to the “comparing” limitation used to justify allowance of the ’714 patent. ASUS-1056, pp. 3, 6-7.

***Allowable Subject Matter***

The indicated allowability of claims 1-30 is withdrawn in view of the newly discovered reference(s) to Rusert et al. (Pub. No. US 2011/0194609 A1). Rejections based on the newly cited reference(s) follow.

**Mapping Rusert to Comparing Limitation**

**along with an identifier of the motion vector, e.g. an index); comparing motion information of the first spatial motion vector prediction candidate with motion information of spatial motion vector prediction candidates in a subset of spatial motion vector prediction candidates that are based on a location of the block associated with the first spatial motion vector prediction candidate (T10071, 0075-0076: One measure for reducing the number of candidates is to avoid duplicate occurrences of the same motion vector in a given PMV\_CANDS list. This can be done, when updating the list, by comparing the candidates already in the list with the new vector that could be added, and if a duplicate is found, either removing the duplicate vector or skipping the new vector...The following methods can be used when updating a PMV\_CANDS list in order to sort the candidates in a way that is beneficial for overall coding efficiency. .. The motion vectors corresponding to blocks that are close to the current block (using some distance metric) will get a position closer to the start of the list compared to motion vectors belonging to blocks that are further away from the current block); determining to include or exclude the first spatial motion vector prediction candidate in**

In response, Nokia did not argue that Rusert lacked the “comparing” limitation. Instead, Nokia made significant amendments to the claims and argued that Rusert lacked disclosure of a different feature. *See* ASUS-1057.

**Arguments Addressing Rusert**

As described, Rusert therefore fails to teach or suggest that the subset of the set of spatial motion vector prediction candidates is determined based on a location of the block associated with the first spatial motion vector prediction candidate, which is itself a member of the set of spatial motion vector prediction candidates for a block of pixels. As such, independent Claim 1, as amended, is not taught or suggested by Rusert and the rejection of Claim 1 is overcome.

Because the Examiner subsequently applied Rusert to reject claims that are similar to the claims of the '714 patent, the Examiner erred in issuing the '714 patent. *See Western Digital Technologies, Inc. v. Godo Kaisha IP Bridge 1*, IPR2025-00701, Paper 9, at 2 (Stewart August 14, 2025)(“Subsequently, the same patent examiner found the prior art taught the previously allowable subject matter, and rejected then-pending child applications of the challenged patent.”).

**III. DISCRETIONARY DENIAL IS NOT WARRANTED**

**A. Discretionary Denial is Not Warranted Under *Fintiv***

For ITC cases, *Fintiv* is judged based on the ITC’s Final Determination date relative to the Board’s deadline for issuing a Final Written Decision. Here, the ITC’s target date for the Final Determination is October 3, 2026, which is just three months prior to the Board’s deadline for the Final Written Decision. Also, the parallel district court case filed by Nokia against ASUS—*Nokia Technologies Oy v. ASUSTeK Computer Inc. et al.*, 2-25-cv-03053 (CDCA), filed April 07, 2025—is stayed and remains well behind the Board’s deadline for the Final

Written Decision.

As *Fintiv* instructs, in cases where both parallel district court and ITC cases are ongoing, the focus should be on “whether the patentability disputes before the ITC will resolve all or substantially all of the patentability disputes between the parties, regardless of the stay.” *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 9 (PTAB Mar. 20, 2020) (precedential). Here, if IPR is instituted, the ITC will not resolve the grounds in this petition and, thus, cannot “resolve all or substantially all of the patentability disputes between the parties.” *Id.*

Specifically, ASUS has stipulated to forgo pursuing “the specific grounds asserted in *inter partes* review in IPR2025-01153, or any other ground that could have been reasonably raised in IPR2025-01153 (i.e., any ground that could have been raised under §§ 102 or 103 on the basis of prior art patents or printed publications).” *See Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (PTAB December 1, 2020). ASUS also stipulated that, “if the PTAB institutes review in IPR2025-01153, ASUS will not pursue in the co-pending litigation combinations of the prior art asserted in IPR2025-01153 with unpublished system prior art (or any other type of prior art).” *See Motorola*, IPR2024-01205, IPR2024-01206, IPR2024-01207 & IPR2024-01208, Paper 19; ASUS-1054. ASUS’s stipulation mitigates the risk of significant duplication of effort, additional expense for the parties, and the risk of inconsistent decisions by

removing from the litigation invalidity contentions that include not only the prior art references from these grounds, but also system prior art that could be combined with the prior art references and combinations presented in the Petition. ASUS's willingness to forgo such a large swathe of prior art from the litigation is indicative of two things: 1) ASUS's commitment to the IPR process as the appropriate forum for adjudicating the question of patentability, and 2) ASUS's confidence in the strength of the merits of the grounds in the Petition.

Contrary to Nokia's assertion, ASUS diligently filed the '714 patent petition just over two months from the filing of the ITC complaint and nearly ten months prior to ASUS's bar date. And despite the time difference between the ITC Final Determination and the projected Final Written Decision, ASUS filed its Petitions with the express purpose of pursuing the question of unpatentability to a final decision before the Board. The fact that ASUS is committed to the IPR process and the removal of bad patents, regardless of the outcome of the ITC case, demonstrates its dedication to strengthening the patent landscape and reducing the economic impact of bad patents for all stakeholders.

What's more, when "[p]etitioner appears to show a material error by the office," the Director has found that "it is an appropriate use of Office resources to review the potential error"—*even if the trial date in the copending litigation precedes the FWD date*. *Microsoft v. Partec*, IPR2025-00318, Paper 9, 3

(referring to the panel, despite a later trial date, because “Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error”).

Also, based on the Board’s previous institution of the same grounds as presented here, there is no question that the Petition presents a compelling case for unpatentability. ASUS-1052; ASUS-1053. Indeed, the PTAB has already recognized the strong merits of the grounds asserted against the ’714 patent by Amazon, the same grounds presented in this IPR. *Id.* (decisions to institute IPR trials on the merits).

These factors outweigh concerns of parallel proceeding overlap, particularly because ASUS’s stipulation confirms that the ITC will not resolve all or substantially all of the patentability disputes between the parties. Indeed, it would be most efficient for the Board to resume its prior review of the grounds set forth in the present petition. For these reasons, based on (1) the prior successful challenge before the Board, (2) the early challenge to a patent without settled expectations, and (3) material errors in examination that led to the ’714 patent, the Board is the most appropriate forum to consider the grounds advanced in the present petition.

**B. Discretionary Denial is Not Warranted Based On the Prior ITC Investigation Involving Amazon**

The prior ITC case does not warrant denial of the present petition. As discussed above, the ITC only considered two prior art references against the '714 patent—Nakamura and WD4. EX-2008, pp. 101-108. Accordingly, the ITC's validity review was narrow, involving only one ground—a combination of Nakamura and WD4. *Id.* And, as discussed above, ASUS has removed the Nakamura and WD4 ground from the Amazon petitions to avoid the inefficiency of repeating challenges that have previously been considered. By limiting its petition to a single set of grounds that was not addressed in the prior ITC case, ASUS has narrowly tailored its petition to focus only on grounds that were previously found to be successful by the Board.

Without question, the ITC did not review the prior art advanced in this petition—Rusert, Karczewicz, and Lin. EX-2008, pp. 101-108. Thus, the prior ITC case, which was narrowly focused on a single ground, should not be used to justify denial of the present petition.

In addition, in pursuing the single ground before the ITC, Amazon appears to have erred in its assessment of the prior art. As the Initial Determination explained, “it is not even clear that Amazon and Dr. Schonfeld have described Nakamura

correctly.” EX-2008, pp. 108. ASUS should not be penalized simply because a prior litigant failed to interpret prior art correctly.

Moreover, although Nokia argues that the same deficiencies found in the prior art considered by the ITC are found in the petition’s Rusert grounds, the Board has already found otherwise. As set forth in the Board’s prior decisions, the Board found the same problem with the Nakamura grounds that the ITC identified in its decision. ASUS-1052, pp. 47-60; ASUS-1053, pp. 49-62. But the Board similarly assessed the Rusert grounds and did not identify the same problem. ASUS-1052, pp. 19-46; ASUS-1053, pp. 17-48. Thus, the Board has already confirmed that the Rusert grounds are meritorious and do not suffer from the deficiency in Nakamura identified in the ITC’s Initial Determination.

Finally, the same three factors that outweigh *Fintiv* concerns—(1) the prior successful challenge before the Board, (2) the early challenge to a patent without settled expectations, and (3) material errors in examination that led to the ’714 patent—outweigh concerns over the prior ITC case involving the ’714 patent.

### **C. The Focused and Well-Reasoned Expert Testimony Supports Institution**

Nokia argues that ASUS’s use of two expert declarations supports denial of institution. Not so. Because Dr. Creusere was unavailable to serve as an expert for ASUS, ASUS hired Dr. Havlicek to support its petition. And because ASUS’s

petition is based on a prior successful challenge supported by Dr. Creusere's declaration, ASUS asked Dr. Havlicek to review Dr. Creusere's declaration, rather than drafting a new declaration from scratch. Dr. Havlicek reviewed Dr. Creusere's declaration and offered a focused declaration that endorsed Dr. Creusere's analysis. By providing a relatively short declaration that relies on Dr. Creusere's analysis, Dr. Havlicek's testimony was focused and efficient, supporting institution.

Nokia also contends that the Petition uses paragraph 109 of Dr. Creusere's declaration to fill the gaps left by the prior art. But Nokia offers no explanation of what is being gap-filled. And a review of Paragraph 109 confirms that Paragraph 109 provides ample citations to Rusert and offers a straightforward explanation of blocks and prediction units in Rusert. Nothing in Paragraph 109 provides gap-filling for the prior art. Thus, the petition advances strong and meritorious grounds that are supported by focused and corroborated expert testimony.

#### **IV. CONCLUSION**

For the foregoing reasons, a holistic evaluation of the prior successful challenge to the '714 patent, the weak settled expectations, and the material errors committed during examination strongly weigh against discretionary denial. Petitioner therefore respectfully requests that this case proceed to an institution determination on the merits.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on October 7, 2025, a complete and entire copy of this Petitioner's Opposition To Patent Owner's Request For Discretionary Denial Of Institution and the associated exhibits were provided via email to the Patent Owner via electronic mail on Patent Owner's lead and backup counsel listed below at the following email address:

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