

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMAZON.COM SERVICES LLC,  
Petitioner

v.

INTERDIGITAL VC HOLDINGS, INC.,  
Patent Owner

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Case IPR2026-00192  
U.S. Patent No. 12,143,606

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**PATENT OWNER'S BRIEF ON  
DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
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**PATENT OWNER'S EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Description</b>
2001	Complaint, <i>InterDigital, Inc. v. Amazon.com Services LLC</i> , Case No. 2:25-cv-00822 (EDVA Dec. 18, 2025)
2002	“Licensing at InterDigital,” <i>InterDigital</i> , available at <a href="https://www.interdigital.com/licensing">https://www.interdigital.com/licensing</a> (last accessed Feb. 20, 2026)
2003	Declaration of Ryan Pohlman
2004	“InterDigital renews license agreement with Sony,” <i>InterDigital</i> , available at <a href="https://ir.interdigital.com/news-events/press-releases/news-details/2026/InterDigital-renews-license-agreement-with-Sony/default.aspx">https://ir.interdigital.com/news-events/press-releases/news-details/2026/InterDigital-renews-license-agreement-with-Sony/default.aspx</a> (last accessed Mar. 3, 2026)
2005	“InterDigital signs license agreement with HP,” <i>InterDigital</i> , available at <a href="https://ir.interdigital.com/news-events/press-releases/news-details/2025/InterDigital-signs-license-agreement-with-HP/default.aspx">https://ir.interdigital.com/news-events/press-releases/news-details/2025/InterDigital-signs-license-agreement-with-HP/default.aspx</a> (last accessed Mar. 3, 2026)
2006	“InterDigital enforces patents against Amazon,” <i>InterDigital</i> , available at <a href="https://ir.interdigital.com/news-events/press-releases/news-details/2025/InterDigital-enforces-patents-against-Amazon/default.aspx">https://ir.interdigital.com/news-events/press-releases/news-details/2025/InterDigital-enforces-patents-against-Amazon/default.aspx</a> (last accessed Mar. 3, 2026)
2007	“2025: InterDigital’s Year In Review,” <i>InterDigital</i> , available at <a href="https://www.interdigital.com/post/2025-interdigitals-year-in-review">https://www.interdigital.com/post/2025-interdigitals-year-in-review</a> (last accessed Mar. 3, 2026)
2008	Docket Entries, <i>InterDigital, Inc. v. Amazon.com Services LLC</i> , Case No. 2:25-cv-00822 (EDVA)
2009	Time to Trial Statistics
2010	U.S. Publication No. 2007/0121728 to Wang et al.
2011	Espace Search Result - US Publication No. 2008/170615 A1 (Sekiguchi)

<b>Exhibit No.</b>	<b>Description</b>
2012	File History of U.S. Application No. 13/389,872
2013	Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (March 24, 2025), available at <a href="https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf">https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf</a> (last accessed March 5, 2026)
2014	Enforcement and Non-waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses Of General Knowledge In <i>Inter Partes</i> Reviews (July 31, 2025), available at <a href="https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf">https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf</a> (last accessed March 5, 2026)
2015	InterDigital, Inc. Form 10-K (Annual Report), United States Securities and Exchange Commission, File No. 1-33579
2016	<i>Amazon.com, Inc. et al. v. InterDigital et al.</i> , Claim No. HP-2025-000043 Transcript of Proceedings December 3, 2025 in the High Court of Justice, London, England

## I. INTRODUCTION

Patent Owner InterDigital VC Holdings, Inc. (“InterDigital”) respectfully requests that the Director exercise discretion and deny institution of *inter partes* review of U.S. Patent No. 12,143,606 (“the ’606 patent”). There are no less than five bases that make it clear that it would not be an appropriate use of the Board’s resources to reconsider the patentability of the challenged claims of the ’606 patent.

*First*, InterDigital’s settled expectations in the ’606 patent favor denial. InterDigital has extensively licensed the ’606 patent, which provides settled expectations for InterDigital despite the fact that the ’606 patent has not been in force for long. Further, InterDigital attempted, over the course of several years, to find a mutually agreeable solution to resolve Amazon’s unauthorized use of its digital video technology, but Amazon instead initiated worldwide litigation and filed this and other IPRs.

*Second*, institution should be denied in view of the co-pending district court litigation. Not only do the *Fintiv* factors weigh in favor of denial, but the district court is also the more efficient forum to resolve the parties’ dispute. Indeed, the co-pending district court proceeding includes three additional patents that have not been challenged at the PTAB. Instituting this IPR would *not* resolve the majority of complex disputes that would still remain in the district court proceeding.

*Third*, Amazon's Petition should also be denied under 35 U.S.C. § 325(d) for at least two independent reasons. All of Petitioner's asserted grounds rely on the same secondary reference (VCEG-AJ21) in the same way, and for the same feature identified as a point of novelty during prosecution. However, a similar rejection to the grounds now being proposed based on the VCEG-AJ21 reference was also presented and overcome during prosecution of the '606 patent.

*Fourth*, Amazon's Petition is also deficient under § 325(d) as one of the primary references (Sekiguchi) and one of the secondary references (H.264), which is used in both grounds, are cumulative of references that were considered during prosecution. Amazon also cannot point to any material error by the Examiner, because there was none. Rather, the Examiner thoroughly considered the claims. Mere disagreement with the Examiner's allowance is insufficient to show error.

*Fifth*, Amazon's arguments on the merits are weak—failing to identify disclosure of multiple claim elements in the cited art—which causes the Petition to improperly rely on expert testimony to supply missing elements in the cited art.

For all of these reasons, InterDigital respectfully requests denial of this IPR.

## **II. BACKGROUND**

InterDigital has been at the forefront of developing foundational video, wireless communication, and other digital technologies for more than 50 years.

EX2015, 4. Each year, InterDigital invests significantly—well over nine figures—

in its world-class research and development, including in multiple facilities located in the United States. EX2015, 4-6. InterDigital employees have researched, designed, and developed technologies instrumental to video coding that are critical for providing efficient and high-quality transmission of video. EX2015, 6.

It is critically important to InterDigital's business to protect its innovations. This allows InterDigital to reinvest revenue back into the innovation cycle to fund its ongoing research and development, significantly contributing to technological advancement in multiple industry segments. EX2002; EX2001, ¶¶19-20. Consistent with its longstanding practice, InterDigital attempted to find a mutually agreeable solution to resolve the unauthorized use by Amazon of InterDigital's patented technology. EX2001, ¶¶2-3. Rather than taking a license or putting an end to its infringing conduct—like many other companies have done—Amazon initiated worldwide litigation attacking InterDigital's portfolio. EX2001, ¶3. Amazon's attack continued when it filed IPRs against the '606 patent and other InterDigital patents. The Director should not permit Amazon to use the PTAB as a forum to avoid responsibility for its ongoing infringement of InterDigital's intellectual property.

### **III. MULTIPLE INDEPENDENT REASONS WARRANT DENIAL.**

The Director should exercise discretion to deny institution for multiple independent reasons, including (1) InterDigital has settled expectations despite the

relatively short time the patent has been in force; (2) the *Fintiv* factors favor denial because the district court is likely to assess patentability of the '606 patent before the Board's FWD deadline; (3) the district court is the more efficient forum to address the full scope of the parties' dispute; (4) the Petition runs afoul of § 325(d) because it is based on cumulative art and arguments already overcome during prosecution; and (5) the Petition improperly ignores Board regulation and guidance by relying on expert testimony to fill gaps in the prior art. Each of these reasons independently supports denial. Taken together, the case for denial is even stronger.

**A. InterDigital's settled expectations favor denial.**

Even when a patent has not been in force for a significant amount of time, there may be reasons a patent owner can have settled expectations. *See Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 at 2 (PTAB July 24, 2025) (informative). For example, licensing activity can provide a patent owner with settled expectations. *See Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950, Paper 11 at 3 (PTAB Sept. 19, 2025) (informative). InterDigital has licensed the '606 patent to several entities, creating settled expectations in favor of InterDigital and supporting denial of this IPR.

Further relevant here, InterDigital undertook significant efforts over the course of several years in attempting to find a mutually agreeable solution to resolve Amazon's unauthorized use of its digital video technology. Instead,

Amazon initiated worldwide litigation and filed this IPR (and others). These facts further weigh in favor of discretionary denial of this IPR.

Both bases for settled expectations are addressed below.

**1. Interdigital has settled expectations because it has licensed the '606 patent.**

In recognition of the importance of the '606 patent's innovative technology, dozens of entities have taken a license to the '606 patent. EX2003, ¶3; *see also* EX2015, 8-9 (InterDigital Form 10-K, discussing 2025 patent licensing activity). Press releases announcing recent exemplary license agreements and renewals provide further evidence of InterDigital's licensing activity. *See* EX2004; EX2005; EX2007. These press releases also underscore the importance of such licenses to not only InterDigital but to the industry as a whole. InterDigital's licensing activity favors denial of institution. *Alliance Laundry*, IPR2025-00950, Paper 11 at 3 (“[A]lthough the challenged patent has not been in force for a significant period of time (issued in 2021), Patent Owner presents evidence that it has licensed the challenged patent, which creates some settled expectations favoring Patent Owner.”).

**2. InterDigital's general practice is to engage potential licensees in good faith with the goal of finding a mutually beneficial solution; InterDigital took this approach here.**

When companies use InterDigital's patented technologies without permission, InterDigital's practice is to engage such companies in good faith

negotiations with the goal of finding a mutually beneficial solution. EX2001, ¶2; EX2003, ¶4. This solution usually takes the form of a global patent license achieved through a mutual exchange of license offers and technical information regarding InterDigital's patents and the companies' product. EX2001, ¶2; EX2003, ¶4. These negotiations take place under the protection of confidentiality in order to resolve the unauthorized patent use by mutual agreement—and without resort to litigation. EX2001, ¶2; EX2003, ¶4. Such licensing negotiations can take up to several years. EX2003, ¶4.

Consistent with its commitment to resolve intellectual property matters amicably, InterDigital undertook this approach with respect to Amazon. EX2001, ¶2; EX2003, ¶5. Despite InterDigital's significant efforts in attempting to find a mutually agreeable solution to resolve Amazon's unauthorized use of its digital video technology, Amazon abruptly initiated litigation in the United Kingdom and later in Sao Paulo, Brazil. EX2001, ¶3; EX2003, ¶5; *see also* EX2006 (quoting Josh Schmidt, Chief Legal Officer, InterDigital: "Our preference is always to sign licenses through amicable negotiation but Amazon's decision to initiate litigation against InterDigital earlier this year shows that Amazon is more interested in litigating than negotiating."); EX2016, 19:11-12, 19:16-18 (public transcript from the UK proceedings, affirming that "InterDigital, of course, considers that Amazon has jumped the gun commencing these proceedings," and "InterDigital takes the

position that Amazon should have been continuing to negotiate”). Only after being sued by InterDigital for patent infringement in the Eastern District of Virginia, in response to Amazon first initiating litigation in the United Kingdom and Brazil, did Amazon file this IPR. *See* EX2001 (complaint filed December 18, 2025).

\* \* \*

For each of these reasons, InterDigital has settled expectations for the ’606 patent, which support denial of this IPR. *See Amgen*, IPR2025-00601, Paper 9 at 2.

**B. The *Fintiv* factors favor discretionary denial**

The ’606 patent is at issue in *InterDigital, Inc. v. Amazon.com Services LLC*, No. 2:25-cv-00822-AWA-DEM (E.D. Va.) (“EDVA proceeding”). EX2001. A holistic assessment of the *Fintiv* discretionary factors favors denial in view of the EDVA proceeding. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”).

**Fintiv factor 1**: No stay motion has been filed in the district court. *See* EX2008. And the Board should not speculate with respect to how the court would rule on a stay should such a stay motion be filed prior to the institution decision. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (holding the Board should “decline to infer ... how the District Court would rule should a stay be requested by the parties”). Thus, factor 1 favors denial or is at least neutral.

**Fintiv factor 2:** The Board’s projected statutory deadline for issuing a FWD in this IPR is July 8, 2027. Trial has yet to be scheduled in the EDVA proceeding. However, median time-to-trial statistics are also relevant in assessing the proximity of the district court’s trial date to the FWD deadline. *See* EX2013, 3. Here, the median time-to-trial statistics for EDVA show that the Court is likely to assess the patentability of the ’606 patent *before* the July 8, 2027 projected FWD deadline.

In particular, in EDVA, the median time-to-trial from filing is 17.4 months. EX2009, 25. Based on a filing date of December 18, 2025, this puts the projected trial date in the EDVA proceeding in late May 2027, *before* the projected FWD deadline.<sup>1</sup> Therefore, it is “unlikely that a final written decision in this proceeding will issue before district court trial occurs, resulting in significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions.”

*Samsung Elecs. Co. v. VB Assets, LLC*, IPR2025-00870, Paper 11 at 2 (PTAB Oct. 10, 2025). Even where, as here, the projected trial date and FWD deadline are close in time such that “a district court trial date [may] occur[] after a projected final written decision date reduc[ing] the possibility of conflicting decisions, *that*

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<sup>1</sup> The EDVA complaint was served on January 6, 2026. EX2008, 1 (Dkt. No. 14). Even counting the median time-to-trial from that date gives a projected date of mid-June 2027, which is still before the July 8, 2027 FWD deadline.

*benefit does not outweigh the efficiencies gained by avoiding parallel proceedings* under these circumstances.” *Id.* (emphasis added). Thus, factor two favors denial.

**Fintiv factor 3:** The EDVA proceeding is in its early stages, with the answer due on March 13, 2026. EX2008, 2 (Dkt. No. 27). The lack of current investment in the EDVA proceeding weighs against denial. However, when considered holistically with the other factors, particularly the lack of a stay and the inefficiencies created by having the cases proceed to final determination on parallel timing, this factor does not outweigh the other factors.

**Fintiv factor 4:** Even in view of Amazon’s *Sotera* stipulation (EX1021), filed seven weeks after the Petition, factor 4 does not favor institution. Instead, Amazon’s stipulation does nothing to mitigate concerns of inefficiency or duplication of effort such that this “IPR proceeding[] would be a ‘true alternative’ to the district court.” *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025) (on Director Review, vacating institution decision and denying under *Fintiv*).

Amazon has not yet provided invalidity contentions, and Amazon’s stipulation does not prevent them, for example, from raising combinations of the asserted art with “unpublished system art, which [Amazon’s *Sotera*] stipulation is not likely to moot.” *Id.*; *see also Cisco Sys. Inc. v. WSOU Investments LLC*, IPR2025-00188, Paper 14 at 2-3 (PTAB Aug. 22, 2025) (on Director Review,

vacating institution decision and denying under *Fintiv* where the petitioner's *Sotera* stipulation did not prevent reliance in district court on unpublished system art in combination with prior art asserted in the IPR).

Indeed, in view of the Federal Circuit's decision in *Ingenico*, Amazon's stipulation "not to pursue any grounds after institution in the district court that are within the scope of the statutory estoppel," EX1021 (Amazon's stipulation, filed Feb. 23, 2026), is in essence completely ineffective at eliminating overlap between this IPR and the EDVA proceeding. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. 2025). In *Ingenico*, the Federal Circuit held that "IPR estoppel *does not preclude a petitioner from asserting the same prior art raised in an IPR* in district court." *Id.*, 1365-66 (emphasis added). In other words, a petitioner may rely on the same prior art "as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use." *Id.*, 1366. Thus, under *Ingenico*, Amazon's stipulation does not estop them from using the same art asserted here in the EDVA proceeding. Factor 4, thus, does not favor institution.

**Fintiv factor 5:** Factor 5 favors denial because the parties in the parallel litigation are the same as the parties here. *See Ericsson Inc. v. Active Wireless Techs. LLC*, IPR2024-00886, Paper 8 at 13-14 (PTAB Nov. 12, 2024) (factor five weighs in favor of denial where the district court is likely to precede the FWD).

**Fintiv factor 6:** Factor 6 also favors denial because, as discussed below and more fully explained in the forthcoming POPR, the Petition fails to establish that the challenged claims are unpatentable over the Grounds asserted therein. *See* Interim Process<sup>2</sup>, § II.C.i (patent owner may direct attention to an anticipated POPR and evidence for discussion of the merits). Indeed, the Petition is based on cumulative art and arguments that were already overcome during prosecution, and Amazon relies on improper gap filling by its expert in an attempt to paper over obvious weaknesses of the asserted references.

**C. The District Court is the most efficient forum to resolve the parties’ dispute.**

There are three additional patents at issue in the EDVA proceeding: U.S. Patent No. 11,252,435; U.S. Patent No. 12,149,734; and U.S. Patent No. 8,149,338. *See* EX2001, ¶1. Amazon has *not* challenged these other patents at the PTAB. Instituting this IPR would, thus, create inefficiencies for the parties, requiring them to litigate the dispute across multiple forums. The Director should deny institution and allow the parties’ dispute to remain in the district court, where it can be decided together in a single forum. *See Samsung*, IPR2025-00870, Paper 11 at 2 (denying institution for 2 patents where 4 additional patents were at issue in a parallel district court proceeding, because “addressing all of the challenged

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<sup>2</sup> Available at [uspto.gov/patents/ptab/interim-director-discretionary-process](https://uspto.gov/patents/ptab/interim-director-discretionary-process)

patents in the district court proceeding would be ‘the fastest and most efficient resolution of the Parties’ many disputes’’); *see also Samsung Elecs. Co., Ltd. v. iCashe, Inc.*, IPR2025-00639 et al., Paper 11 at 3 (PTAB Aug. 14, 2025) (denying institution, where for two recently issued patents, the district court’s consideration of the validity of five additional patents “tip[ped] the balance to discretionary denial” as to the two recently issued patents because “referring [them] to the Board would be an inefficient use of Board resources”); *Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00757 et al., Paper 15 at 3 (PTAB Aug. 14, 2025) (same).

**D. Amazon’s Petition should be denied under § 325(d).**

The precedential *Advanced Bionics* decision sets forth a “two-part framework” for evaluating whether “the same or substantially the same prior art or arguments previously were presented to the Office” under 35 U.S.C. § 325(d). *Advanced Bionics v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7-11 (PTAB Feb. 13, 2020) (precedential). Applying the *Advanced Bionics* framework here, the Director should deny institution under § 325(d).

**1. *Advanced Bionics* Part 1: The Petition presents the same or substantially the same art and arguments that were before the Examiner during prosecution.**

The first part of the *Advanced Bionics* framework considers “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to

the Office,” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. The Examiner already considered the same or substantially the same art as relied upon in each of Petitioner’s asserted grounds. Most notably, both Grounds 1A and 2A (challenging the independent claims) rely on the same secondary reference—VCEG-AJ21—in the same way. But the Petition relies on VCEG-AJ21 for the same feature identified as a point of novelty during prosecution and for which a similar rejection was overcome. Further still, both Sekiguchi (the primary reference in Grounds 1A and 1B) and the H.264 reference (used in Grounds 1B and 2B to challenge certain dependent claims) also are cumulative of references that were considered during prosecution. *Advanced Bionics* part 1 is thus met.

**a. Amazon’s reliance on VCEG-AJ21 is cumulative of art and arguments overcome during prosecution.**

Applicant argued during prosecution, “[o]ne objective of the independent claims is intra chroma prediction of *multiple* chroma partition types.” EX1002, 1916 (emphasis original). Reflecting this objective, claim 1 recites, “encoding picture data for at least a block in a picture, by performing intra prediction with multiple partition types for chroma encoding of the block ... .” EX1001, 17:27-29 (1[b]). Independent claims 2, 10, and 14 include similar recitations. EX1001, 17:51-53 (2[a]), 18:44-46 (10[a], reciting “decoding...”), 19:20-21 (14[c], same).

In each of Grounds 1A and 2A, the Petition relies on VCEG-AJ21 for the “multiple partition types for chroma encoding” recited in claim 1. In particular,

Amazon alleges that VCEG-AJ21 teaches “extend[ing] the architecture of the H.264 codec with enlarged macroblock sizes.” Pet., 17-18. In both instances, Amazon applies VCEG-AJ21’s teachings regarding block sizes to the primary references’ discussion of *intra* prediction techniques. See, e.g., Pet., 18-20 (Ground 1A, motivation to combine), 22-26 (Ground 1A, discussion of 1[b]), 61-62 (Ground 2A, motivation to combine), 63-65 (Ground 2A, discussion of 1[b]). VCEG-AJ21’s teachings, however, are directed to *inter* prediction techniques, to the express exclusion of *intra* prediction techniques. See EX1006, 1 (“*In this proposal*, the extended architecture with the enlarged MB structure are first proposed for ME&MC but *new designs of ... intra prediction ... for the enlarged MB are not yet addressed.*” (emphasis added)).

During prosecution, the Examiner considered the issue of whether such teachings related to *inter* prediction techniques apply to the claimed *intra* prediction techniques with multiple chroma partition types. In particular, the Examiner contended Wang (EX2010) taught “performing intra prediction with multiple partition types chroma coding of the block,” as recited in an earlier version of the claims. EX1002, 1859-1860. Applicant amended the claims to their current state and argued that Wang’s teachings of multiple block sizes for motion compensation (i.e., *inter* prediction) did *not* teach the use of multiple block sizes for *intra* prediction, as claimed. EX1002, 1917-1918. The Examiner was persuaded

that Wang’s teachings of multiple chroma partition sizes for *inter* prediction did not teach the claimed use of multiple chroma partition types for *intra* prediction, and allowed the claims. EX1002, 1923-1930 (Notice of Allowability).

This same flawed argument is presented against the independent claims in both grounds of the Petition, simply replacing Wang’s teaching of multiple chroma partition sizes for *inter* prediction with a similar teaching in VCEG-AJ21, which is also limited to *inter* prediction. The Board should not reconsider this issue here.

**b. Sekiguchi’s foreign counterpart and full English translation thereof were considered by the Examiner.**

A foreign counterpart of Sekiguchi, the primary reference in Grounds 1A and 1B, was considered by the Examiner during prosecution. In particular, corresponding Chinese application CN10122644 (“CN-Sekiguchi”) was cited in an Information Disclosure Statement (IDS) and marked as considered by the Examiner. EX1002, 1538, 1634; EX2011. As noted on the IDS, CN-Sekiguchi was “\* cited in parent application,” i.e., U.S. Application No. 13/389,872. In the parent application, CN-Sekiguchi was submitted with a full English translation. EX2012, 1135-1264. A comparison of the figures confirms Sekiguchi and CN-Sekiguchi disclose the same embodiments. *Compare* EX1005, Figs. 1-23, *with* EX2012, 1173-1193 (Figs. 1-23 of CN-Sekiguchi). Thus, Sekiguchi’s teachings were already considered by the Examiner. *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5 (PTAB May 19, 2025)

(precedential) (a reference cited on an IDS satisfies prong one of *Advanced Bionics*); *Becton, Dickinson & Co v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 16-28 (PTAB Dec. 15, 2017) (precedential) (denying institution based on grounds relying on prior art that was considered during the prosecution of the parent applications). At a minimum, CN-Sekiguchi is cumulative of Sekiguchi.

**c. The prior version of the H.264 reference was considered by the Examiner.**

The H.264 reference asserted in Grounds 1B and 2B, challenging certain dependent claims of the '606 patent, is the November 2007 version of the H.264 standard, titled "Advanced video coding for generic audiovisual services." EX1010, 1. The just-prior March 2005 version of this standard was considered by the Examiner during prosecution. It was cited on an IDS and marked as considered, and discussed extensively in the background of the '606 patent. EX1001, 1:21-3:19; EX1002, 1539, 1635. *Ecto World*, IPR2024-01280, Paper 13 at 5.

The Examiner was thus made aware of the relevance of this document, and the differences between this document and what is disclosed in the detailed description and the claims of the '606 patent. The November 2007 version Amazon relies on in the Petition is largely cumulative of the March 2005 version. Indeed, Amazon provides cross-citations to the March 2005 version throughout. *See Pet.*, 46 n.8 (providing alternative citations in case the November 2007 version is not determined to be publicly available prior to the '606 patent's priority date).

**2. *Advanced Bionics* Part 2: The Office committed no material errors during prosecution.**

Under the second part of the *Advanced Bionics* framework, the Board determines “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. Here, the Examiner committed no material errors that require correction at the PTAB. Indeed, examination of the ’606 patent was very thorough, involving:

(1) eight prior-art searches by the Office on: August 28, 2021 (EX1002, 1461-1463), January 15, 2022 (EX1002, 1464-1486), May 7, 2022 (EX1002, 1413-1457), September 30, 2022 (EX1002, 1321-1409), February 10, 2023 (EX1002, 1141-1317), September 9, 2023 (EX1002, 784-1137), February 10, 2024 (EX1002, 400-780), and June 13, 2024 (EX1002, 28-372);

(2) seven Office Actions on the merits (EX1002, 1616-1629, 1654-1664, 1684-1695, 1729-1741, 1781-1792, 1805-1817, 1856-1867);

(3) ten rounds of claim amendments and remarks (EX1002, 1646-1653, 1671-1680, 1698-1706, 1717-1726, 1747-1756, 1795-1804, 1820-1829, 1841-1850, 1870-1882, 1908-1920); and

(4) an information disclosure statement citing *inter alia* CN-Sekiguchi and H.264 (March 2005) (EX1002, 1537-1539).

Amazon thus cannot credibly allege that the Examiner's prior art searches or thoroughness of examination were inadequate.

*Advanced Bionics* recognizes that “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability. At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 9. Petitioner may disagree with the Examiner's conclusion that the claims are not obvious, but mere disagreement with the Office's prior determinations is an insufficient basis for institution. *Id.* Here, the Director should defer to the Office's previous evaluation of arguments that are substantially similar to those presented in the Petition, namely arguments regarding the application of VCEG-AJ21's *inter* prediction-related teachings to the *intra* prediction techniques described in Sekiguchi and Xiong (the primary reference in Grounds 2A and 2B).

Further, the H.264 reference is also not new for at least the reasons presented above. But even if it were, relying on a secondary reference for a few dependent claims does not outweigh the clear relevance of § 325(d) to the art and arguments asserted against the independent claims. *Kayak Software Corp. v. Int'l Bus. Mach. Corp.*, CBM2016-00075, Paper 16 at 10 (PTAB Dec. 15, 2016) (informative).

\* \* \*

For at least these reasons, application of the *Advanced Bionics* framework here shows that the Director should deny institution under § 325(d).

**E. Amazon improperly relies on expert testimony to fill gaps in the alleged prior art.**

The Petition improperly uses alleged knowledge of a POSITA and state of the art to fill missing limitations in the grounds. The statutory basis for *inter partes* review limits unpatentability grounds to prior art “consisting of patents or printed publications.” 35 U.S.C. § 311(b). The corresponding regulation requires a petition to “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4); *see also* 35 U.S.C. § 312(a)(3); EX2014 (Office guidance on the proper application of Rule 104(b)(4)); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1331-32 (Fed. Cir. 2019). The Petition here fails to do this. Compounding this error, the expert testimony on which the Petition relies to fill these gaps is conclusory, and provides no analysis, evidence, or explanation.

For example, in its analysis of limitation 1[b], Amazon over-relies on conclusory expert testimony to bridge a fundamental gap in the prior art, alleging that VCEG-AJ21 discloses 32x32 and 16x16 prediction modes usable for “both inter and intra prediction.” Pet., 24 (citing EX1003 (Havlicek Decl.), ¶84). However, VCEG-AJ21 explicitly states—and Dr. Havlicek also admits—that *intra* prediction is “not yet addressed.” EX1006, 1; EX1003, ¶¶72-73. Not only is this

reliance on expert testimony improper, it is also wrong for reasons that will be discussed in the POPR. Additional examples of improper gap filling by Amazon's expert will be provided in the POPR, which InterDigital requests the Director consider when making the determination whether to discretionarily deny this IPR. *See* Interim Process, § II.C.i.

The Petition's cursory and conclusory analysis falls well short of Petitioner's obligation to perform a reasoned analysis—based on the references asserted in its challenges—and runs afoul of the Office guidance that compliance with Rule 104(b)(4) precludes reliance on expert testimony for claim limitations. EX2014. Accordingly, this is an additional reason the Director should deny institution.

#### **IV. CONCLUSION**

Each of these reasons discussed herein, considered both independently and together, supports denial of the Petition. InterDigital therefore respectfully requests that the Director exercise his discretion to deny institution.

Respectfully submitted,

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**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))**

I certify that the above-captioned **PATENT OWNER'S BRIEF ON DISCRETIONARY DENIAL** and associated Exhibits 2001-2016 were served in their entireties on March 9, 2026, upon the following parties via electronic mail:

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