

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
AMAZON.COM SERVICES LLC,
AMAZON WEB SERVICES, INC., and
TWITCH INTERACTIVE, INC.,
Petitioners,

v.

NL GIKEN INC.,
Patent Owner.

Case No. IPR2024-01161
Patent No. 9,319,615

PATENT OWNER'S PRELIMINARY RESPONSE

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I. INTRODUCTION

The challenged patent, U.S. Patent No. 9,319,615 (“the ’615 Patent”) claims a system in which remotely located friends can form a watch party to share a same multimedia program. The sharing of content among friends is particularly recited in the ’615 Patent claims as being communicated “*without request or acknowledgement.*” The primary reference of the Petition (Cooper)—relied upon for disclosing this feature across all Petition grounds—necessarily fails as plainly requiring a Buddy List program subscriber request or log-on acknowledgement prior to sharing content.

Cooper describes a systemically different sharing scheme in which sharing is responsive to either (1) initial subscriber log-in to a Buddy List program (i.e., request) or (2) based upon a Buddy List program log-in status confirmation (i.e., acknowledgement). Cooper explains a user’s “set-top box software *transmits* the user’s buddy list [] to the server” in response to the “user log[ging]-on” (i.e., a request to join the Buddy List program functionality (that may include different Buddy Lists for different friends) and “[t]he server *responds* by sending the set-top box TV viewing information for each member of the user’s buddy list.” EX1004, [0062]-[0063].¹

¹ Emphasis added throughout, unless otherwise noted.

Cooper explains that, when a user is “logged-in” (*i.e.*, current log-in acknowledged) the server “also transmits a message [] to each logged-in user” with information of a channel change by another user. EX1004, [0061], [0063] (“the server broadcasts [] the change to each **logged-on** user who included the channel changing user in their buddy list.”).

Cooper also explains that, before viewing information is sent to the set-top box, Cooper’s server must perform still a further acknowledgement that the user has not “Turned on Privacy.” EX1004, Fig. 14 (only “[t]ransmit[ting] [c]hange in [c]hannel [i]nformation” if the user has not “[t]urned on [p]rivacy”), [0063] (“[T]he Server broadcasts [] the change ... Viewers can turn off this feature if they do not want others to see the name of the TV show they are watching.”).

Not surprisingly, art substantially similar to Cooper (requiring request or acknowledgement) was already considered and distinguished in prosecution, which necessitated the “without request or acknowledgement” claim amendment in the first place.² Specifically, Kutsuna utilized a confirmation/acknowledgement as does Cooper. *See* Section VII.A. Petitioners ignore the previous Office analysis to

² EX1003, 83-100 (rejecting claims over Kutsuna (EX1017)), 54-60 (Amendment reciting “without request or acknowledgement”), 47 (AFCP decision stating “[t]he amended claims ... overcome the current references...”).

skirt their burden under 325(d), simply concluding Cooper is not “substantially the same” without providing any substantive analysis. Pet., 73. Mere difference does not satisfy the 325(d) standard and the Petition fails for this significant additional deficiency.

Further, Cooper fails to disclose or suggest that the broadcast program information is of “one definite broadcast program” and that the one definite broadcast program replaces a currently displayed program “without any [channel/program] selecting operation.” Rather than disclosing “one definite broadcast program,” as claimed, Cooper’s server transmits a plurality of links to programs. EX1004, [0059]-[0063]. Rather than replacing the program without a channel or program selecting operation, Cooper relies on a user selecting “the TV show or network” another viewer is watching, “displayed as a link” among other links in a list, in order to “watch the same show.” EX1004, [0060].

Accordingly, IPR of the ’615 Patent should be denied.

II. THE ’615 PATENT (SHARING OF MULTIMEDIA CONTENT)

The ’615 Patent relates to systems and devices for viewing television or other programs that communicate with another such device to display the same content. EX1001, Abstract, claims 1, 4, 8. Recognizing that family and friends may be geographically separated (EX1001, 1:20-38), the ’615 Patent provides a system in which changing a channel or program on a first device also causes the

channel or program to change on a second device. These systems “make[] it easier for one family to share the same experience or to check the broadcast program which the other family is watching.” EX1001, 3:36-38.

The '615 Patent claims, *inter alia*:

1. A television set system comprising:

a television function unit;

a display arranged to display a broadcast program in accordance with the television function unit;

a receiver arranged to receive, without request or acknowledgement, information of one definite broadcast program which can be displayed on the display and is identified by a channel selection of another television set in another place

wherein the information includes information of a broadcast program which is currently not displayed on the display, but can be displayed by a channel change, . . .

For example, the '615 Patent describes an embodiment with first television set 2 and second television set 4 “in normal communication with each other ... by means of broadband line through” first communicator 15 and second communicator 16 “for one side to inform the other side of [the] television program which is watched on the one side and vice versa.” EX1001, 6:27-34, Fig. 1.

When the system is operated, the receiver of a first device “receive[s], without request or acknowledgment, information of one definite broadcast program

... identified by the channel selection” from a second device. *See, e.g.*, EX1001, claim 1. A message “is sent to the second television set [] if any change occurs” on the first set (EX1001, 13:49-53) and, the second device’s “display is automatically changed in response to the receipt of the information from a predetermined outside counterpart,” *i.e.*, the first device in this example (EX1001, 2:65-3:1). The ’615 Patent explains that the first device may send updates to the second device and the second device to the first device, interchangeably. EX1001, 6:27-34, 12:21-29. For example, e-mail communications may be exchanged between the devices. EX1001, 6:13-23.

III. CLAIM CONSTRUCTION

Patent Owner does not challenge Petitioners’ claim constructions because the Petition fails regardless of the constructions adopted. Patent Owner reserves the right to challenge these constructions as necessary should this IPR move to trial, or in different forums³.

³ For example, several of the Petition constructions appear to be directed to Petitioners’ non-infringement defenses. Of course, the Board does not assess infringement, and, as such Patent Owner need not address these constructions here.

IV. COOPER ONLY SHARES CONTENT UPON SUBSCRIBER BUDDY LIST PROGRAM REQUEST OR ACKNOWLEDGED LOG-IN

All Petition grounds rely on Cooper alone for disclosing the system receiving broadcast program information “*without request or acknowledgement*,” as recited in each of the independent claims. Pet., 8-46, 50-68. Specifically, Petitioners rely on “data 1202/1212” as the information received by the receiver. Pet., 17-18. Petitioners rely on the viewing information in Cooper’s enhanced Buddy List program as constituting information “displayed on the display.” Pet., 19-20.

Tellingly, despite a clear obligation to do so, Petitioners do not explain how Cooper operates “without request or acknowledgement” as claimed. 37 C.F.R. § 42.104(b)(4). Pet., 21-22. Instead, Petitioners attempt to distract from its burden, arguing that initial set-up and handshakes are exempt from the “without request or acknowledgement” requirement⁴. Pet., 21-22. But this argument bears no relation to the proposed grounds which clearly include subscriber-based Buddy List program requests and acknowledgements. Such requests and acknowledgements are explicitly excluded by the plain language of the ’615 Patent claims.

⁴ Patent Owner does not dispute that the claims can encompass devices utilizing basic communication handshake protocols.

The Petitioners’ problem is that the Buddy List subscriber management functionality of Cooper is not basic device handshaking, but a separate application program. EX1004, [0017]. Petitioners provide no explanation as to how a subscription-based application program is akin to device handshaking. Cooper plainly requires Buddy List subscriber management requests and acknowledgements prior to exchanging broadcast program information. As such, the Petition fails to demonstrate that either of its Petition grounds are reasonably likely to demonstrate unpatentability of any Challenged Claim.

A. Petitioners Cannot Meet Their Burden with Unsupported Speculation on What “Cooper Does Not Mention”

Next, Petitioners assert—in their only actual mapping of the “without request or acknowledgement” limitation—that “Cooper does not *mention* any ‘request or acknowledgement’ with respect to receipt of a ‘message’ or information [] corresponding to what a buddy is watching.” Pet., 22. This is hardly surprising given Cooper would not contradict its Buddy List program subscriber management functionality, which relies upon request and acknowledgement for facilitating sharing.

Setting the obvious explanation aside as to Cooper’s silence, Petitioners cannot meet their burden to show “without request or acknowledgement” by relying on what “Cooper does not mention.” A lack of disclosure *is not disclosure*. It is Petitioners’ burden to specify where each claim element is found

in the prior art. 37 C.F.R. § 42.104(b)(4); *see also Int'l Bus. Machines Corp. v. Iancu*, 759 F. App'x 1002, 1011 (Fed. Cir. 2019) (petitioner failed “to meet its burden” to show a “single-sign-on” where prior art was ambiguous as to a second sign-on); *Google, Inc. v. Core Wireless Licensing S.A.R.L.*, IPR2015-01715, Paper 30, 2019 WL 4733640, at *7 (PTAB Sept. 27, 2019) (“[p]etitioner’s contention that Staack does not expressly require a mobile station to pre-register for location finding services is not, alone, sufficient to show that Staack discloses, or teaches or suggests” a “without pre-registering” limitation); *Ericsson Inc. v. Koninklijke Kpn N.V.*, IPR2022-00069, Paper 31, 2023 WL 5156353, at *7-10 (PTAB May 12, 2023) (petitioner failed to meet its burden as to limitation directed to an “access operation [] configured for denying a network attach” by arguing that primary reference “d[id] not *preclude* restricting access ... by denying network attach”); *Snap Inc. v. Vaporstream, Inc.*, IPR2018-00416, Paper 36, 2019 WL 3504153, at *11-12 (PTAB Aug. 1, 2019).

B. Cooper’s Buddy List Subscriber Management Program Requires Requests and Acknowledgements

Cooper’s Buddy List subscriber management system includes (and requires) subscriber requests and acknowledgements for a device to receive information about what a different logged-in buddy of the list is watching. Specifically, Cooper discloses a Buddy List subscriber management program that either: (1) responds to user log-in that designates the user’s Buddy List to the server (request)

by sending channel information for the designated Buddy List (*see* Section IV.B.1), or (2) provides updated channel information for the designated Buddy List where user's log-in status since designating the Buddy List is confirmed (acknowledgement) (*see* Section IV.B.2). In each case, Cooper also requires a separate acknowledgement—a confirmation that the buddy has not “Turned on Privacy” (*see* Section IV.B.3).

1. Cooper Requires a Subscriber Request to a Chat Server (“log-in”) to Receive Information

Cooper teaches that program information is sent to the receiver in response to the receiver logging into the Buddy List program, *i.e.*, a request for viewing information for the designated Buddy List. This is not an initial device handshake of communicating devices, but a subscriber log-in authorization of a Buddy List program. Cooper describes a single “process for providing buddy lists that display the show or network a user is viewing.” EX1004, [0062]. This is the enhanced Buddy List on which the Petition relies. Pet., 19-20.

Specifically, Cooper states that “[a]*fter a user logs-on*, the set-top box transmits the user's buddy list [] to the server” and “[t]he server *responds* by sending the set-top box TV viewing information for each member of the user's buddy list.” EX1004, [0062]. The request and response process is depicted in Fig. 13. EX1004, [0062].

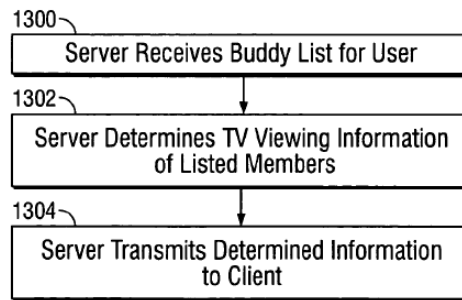


FIG. 13

As explained in paragraph [0062], the log-on designates the Buddy List to be received by the server in step 1300, which then leads to the server determining buddies' viewing information, and finally the server transmitting the responsive "[d]etermined [i]nformation," *i.e.*, the buddies' viewing information, to the client. EX1004, Fig. 13, [0062].

Cooper does not and cannot respond with buddy viewing information absent the subscriber log-in request to the Buddy List Program. EX1004, [0059]-[0064]. Although Cooper states that the Buddy List "may be permanently stored on the server 1204 or transmitted to the server 1204 by a set-top box when a user logs-on" (EX1004, [0061]), wherever the list is stored, there is no teaching of anything other than the log-on designating the Buddy List, and thus initiating the process described in paragraph [0062] and depicted in Fig. 13 for receiving the buddies' channel viewing information, and that process requires user log-on and a designated Buddy List. EX1004, [0062].

2. Cooper Provides Updates to Logged-on Buddies Only

As discussed above, Petitioners rely in part on data 1212 as information of one definite broadcast program. Pet., 17-18. The only other possible update comes to connected buddies only. Accordingly, these updates require both login with designated Buddy List (*i.e.*, request), continued connection (*i.e.*, acknowledgement), and a no privacy acknowledgement.

a. Log-in Designates the Buddy List

Petitioners ignore the fact that Cooper expressly teaches that the server transmits “message 1212 *to each logged-in user* that included the channel-changing user *in his or her list.*” EX1004, [0061]. There is no indication that message 1212 would be sent to any user without that user having been logged in to the Buddy List program and thus having designated the user’s Buddy List. *Id.*

Cooper discloses that subsequent channel change information is sent only to “*each logged-in user* that included the channel-changing user *in his or her list.*” EX1004, [0061]-[0063]. That is, a prerequisite to receiving information of a different broadcast program is an acknowledgement of an existing Buddy List program connection. *Id.* Only buddies confirmed as currently logged-in, *i.e.*, acknowledging a current connection status, receive viewing information. *Id.* More specifically, regarding the “process for updating the buddy list information” depicted in Fig. 14, below, Cooper explains that “[a]s each user changes channels 1402, the user’s set-top box transmits a message to the server describing the

change 1404. The server uses these messages to update its user list 1406. After updating 1404, the server broadcasts 1410 the change *to each logged-on user* who included the channel changing user *in their buddy list.*” EX1004, [0063]; *see also* EX1004, [0061] (“The server ... transmits a message 1212 *to each logged-in user* that include[s] the channel-changing user *in his or her [buddy] list.*”).

Accordingly, these updates stem from and require the initial log-in request and designation of a Buddy List. That is, a user is only a “logged-in user” when they have previously logged-in and sent a request designating their Buddy List to the Buddy List program.

3. Cooper Further Requires Acknowledgement that a Buddy has not “Turned on Privacy”

Cooper’s Buddy List program requires a further acknowledgement step during each of the processes in which the set-top box receives TV viewing information. Specifically, before Cooper’s server “transmits [a] change in channel information to [a] user[,],” the server determines whether the user whose channel information is to be shared “has [] turned on privacy.” EX1004, Fig. 14 (capitalization adjusted).

As shown in Fig. 14, the user channel change information is transmitted to the server regardless of whether or not the user has turned on “[p]rivacy.” *See* EX1004, Fig. 14 (step 1404 occurring before step 1408).

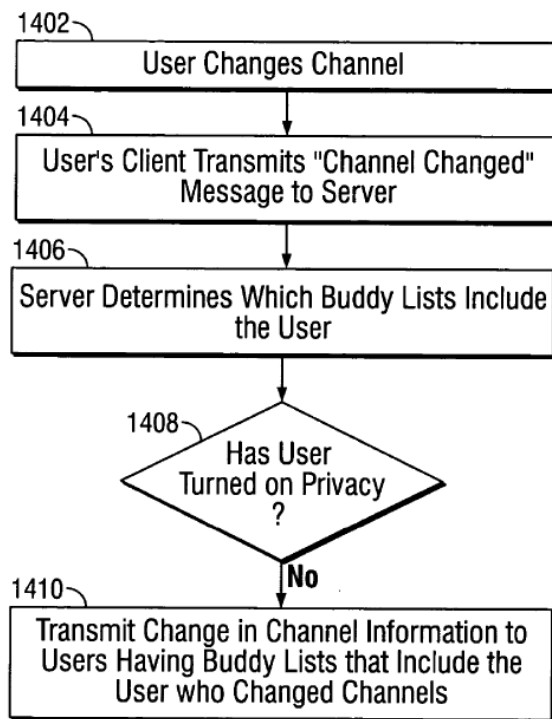


FIG. 14

EX1004, Fig. 14

Thus, acknowledgement that the privacy setting is not engaged is a limit on sending the channel information to the user, *not* the process of sending the channel information to the server. *See* EX1004, Fig. 14 (showing that the “Channel Changed” information is always transmitted to the server, but “Transmit[ting the] Change” to another user’s device only occurs if the user has not turned on privacy). Cooper confirms this at [0063], in which Cooper says that “[v]iewers can turn off [the] feature,” referring to “the server broadcast[ing]” channel change information (i.e., the information that is received by the other user’s device). EX1004, [0063].

Petitioner simply ignores this additional acknowledgement, providing no explanation of its impact on its flawed mappings to Cooper.

C. Expert Simply Parrots the Petition

Petitioners also cite to their expert's declaration in support of their arguments. Pet., 22 (citing EX1002, ¶¶79-80). However, the cited portions of the expert declaration merely parrot the Petition. *Compare* EX1002, ¶¶79-80 *with* Pet., 21-22. An expert declaration that “does not cite to any additional supporting evidence or provide any technical reasoning ... is entitled to little weight.” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15 (PTAB Aug. 24, 2022) (denying institution); *see also Free-Flow Packaging Int'l, Inc. v. Automated Packaging Sys., Inc.*, IPR2016-00447, Paper 7, 10 (PTAB Jun. 22, 2016) (denying institution where the petitioner's expert did “nothing more than parrot the language of the Petition word for word”).

V. COOPER FAILS TO DISCLOSE INFORMATION OF *ONE DEFINITE BROADCAST PROGRAM*

Claim 1 of the '615 Patent recites, *inter alia*:

1. A television set system comprising:

a television function unit;

a display arranged to display a broadcast program in accordance with the television function unit;

a receiver arranged to receive, without request or acknowledgement, ***information of one definite broadcast program*** which can be displayed on the display and is identified by a channel selection of another television set in another place

wherein the manual controller is arranged to instantly carry out replacement of the currently displayed broadcast program with ***the one definite broadcast program*** identified by the channel selection of the another television set . . .

Claims 4 and 8 include similar limitations.

As the '615 Patent explains, the system makes it possible to “easily and quickly change the channel number into one viewed in the other home” because “the first storage information 23 of the first television set 2 ***has the information of the channel number for the other home.***” EX1001, 11:62-12:9.

A. Petitioners Map to Cooper’s Entire Buddy List, Not “one definite broadcast program”

The Petition relies entirely on Cooper for the “one definite broadcast program” limitation and fails to explain how Cooper’s information of multiple available broadcast programs within a Buddy List is “information of one definite broadcast program.” Pet., 17-19 (pointing to data from Cooper’s server as the “information”). The Petition identifies the Buddy List in the aggregate as the “information” for its argument that the “information” is “displayed on the display” (Pet., 19-20) and relies on the user selecting a link from Cooper’s Buddy to replace the current channel with one shown in the Buddy List (Pet., 28).

The Petition fails to identify “one definite broadcast program” as claimed because Cooper’s TV-enhanced Buddy List is a list of links showing the programming that buddies are watching. EX1004, [0060] (“the enhanced buddy-list shows the TV show or network 1110 *each listed buddy 1108* is watching”), [0063]. As shown in Fig. 11, the Buddy List may also include information that buddies are “Offline” or in “Private” viewing mode. *See* EX1004, Fig. 11. To select a channel using the Buddy List, Cooper’s user must select from among the set of program information displayed in the Buddy List. EX1004, [0060] (user chooses “TV show and/or network” by “selecting [a] link” on the “enhanced buddy-list”).

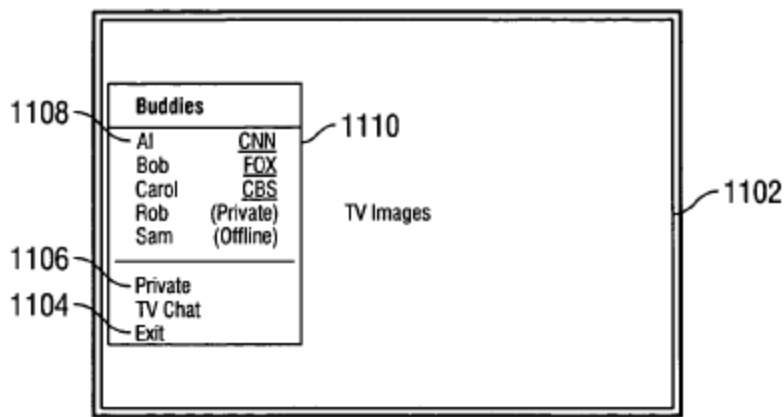


FIG. 11

EX1004, Fig. 11.

The Petition fails to identify, let alone explain, any modification to Cooper’s Buddy List to receive and display “information of one definite broadcast program.” Pet., 17-19.

Even to the extent Petitioners may rely on an update to a single user’s channel to meet the limitation (which is nowhere explained), there is no express disclosure in Cooper as to how that channel change information would be delivered. EX1004, [0059]-[0064]. On the contrary, Cooper states that the server processes plural “*messages*” before “broadcast[ing] [] the change to each logged in user.” EX1004, [0063]. Cooper elsewhere describes a goal of “reduc[ing] the number of messages produced when a viewer ‘channel surfs,’” (EX1004, [0058]), which would be further supported by combining channel change messages. According, Cooper does not disclose “one definite broadcast program.”

VI. GROUND 2 FAILS BECAUSE COOPER AND SLOTZNICK DO NOT DISCLOSE OR SUGGEST EACH LIMITATION OF CLAIMS 1-16

Ground 2 challenges claims 1-16 as allegedly obvious over the combination of Cooper and Slotznick and the knowledge of a POSA. Pet., 46.

As Cooper fails for the reasons discussed above in Sections IV-V, and Slotznick is not relied upon to remedy these deficiencies (Pet., 50-60), Ground 2 fails as well.

VII. ALTERNATIVELY, INSTITUTION SHOULD BE DENIED UNDER SECTION 325(D)

The Petition should be denied institution on the merits, for any of the independent reasons discussed above. Alternatively, the Board should exercise its discretion to deny institution under 35 U.S.C. § 325(d) and *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential).

Petitioner effectively ignores section 325(d), merely stating that “[n]either of the challenges are substantially the same” or “the examiner has made a clear error” without any discussion distinguishing the grounds over the art considered and overcome during examination. Pet., 72-73. However, as explained below, substantially the same art and arguments were previously presented.

A. Substantially the Same Prior Art and Arguments Were Previously Presented

Substantially the same art and arguments were previously presented to the Office—specifically, the Kutsuna reference which was applied and overcome in prosecution. EX1003, 20 (Notice of Allowance), 46 (“without the request or acknowledgement ... would overcome the current references”). The Petition does not explain how Cooper is meaningfully different from Kutsuna. “Petitioner’s failure to conduct *any* analysis of whether its art was cumulative is, by itself, fatal under *AB* part one.” *Parse Biosciences, Inc. v. 10X Genomics*, IPR2023-01033, Paper 8, 14 (PTAB Dec. 19, 2023) (denying institution under § 325(d)).

In fact, Cooper and Kutsuna are substantially the same in relevant part at least in that both require “request or acknowledgement” before transmitting and receiving broadcast program information and both receive information of a plurality of programs rather than “one definite broadcast program.”

B. Kutsuna (EX1017)

As with Cooper’s requests for channel viewing information described above (see Sections IV.B.1-IV.B.2), Kutsuna also teaches the user requesting viewing information of a partner TV by “transmit[ting] a master candidate request.” EX1017, [0193]. “[I]n response,” Kutsuna’s receiver “obtains a program information data column” and then “executes a switching to a simultaneous viewing mode.” EX1017, [0193]-[0194]. Kutsuna also describes a “process of the

control portion [] of the TV receiver” in which that the user requests viewing information. *See* EX1017, [0216]. “In response to a simultaneous viewing start request” the TV receiver “transmits a ... request” and, in response, receives “a program information data column.” EX1017, [0217], Fig. 10A (S206 including “transmit[ing] request of deriving program information” and S207 including “receiv[ing] program information data column”).

To select a channel, Cooper’s user must also select from the set of program information in the Buddy List. EX1004, [0060] (user chooses “TV show and/or network” by “selecting [a] link” on the “enhanced buddy-list”); *see also* Section V. Similarly, Kutsuna teaches a “common viewing program table” from which the user selects a channel. *Compare* EX1004, Fig. 11, [0033], [0060] *with* EX1017, [0150]-[0152], [0165]. Kutsuna describes a common viewing program table that “is an extraction of ***program information of programs broadcasted at a same time*** and having a matching program title” in different “region[s]” and which may be “arranged according to channel numbers.” EX1017, [0150]. During examination, the Applicant clarified that Kutsuna’s “common viewing program table” was not “information of one definite broadcast program. EX1003, 70. The Examiner acquiesced to this clarification, stating that the rejection relied on a different “hand shake” process and that the common viewing program table was merely an “extra feature[.]” of Kutsuna. EX1003, 51. In other words, the Examiner did not maintain

that a common viewing program table constituted information of one definite broadcast program in response to application's clarification. EX1003, 51.

C. Rejection Over Kutsuna

The Examiner extensively considered the Kutsuna reference, of which Cooper is duplicative as explained in Section B. During examination, the claims were rejected over Kutsuna and Kutsuna was the subject of extensive discussion. *See* EX1003, 193-199 (4/18/2014 OA), 181-183 (7/18/2014 Response), 163-172 (9/8/2014 OA), 148-152 (12/4/2014 Response), 119-129 (1/5/2015 OA), 108-111 (4/5/2015 Response), 88-98 (5/8/2015 OA), 70-75 (7/8/2015 Response), 51 (7/24/2015 Advisory Action), 46 (8/13/2015 Advisory Action).

The rejection over Kutsuna was overcome following amendment of the claims to recite "without request or acknowledgement." *See* EX1003, 83-100 (rejecting claims over Kutsuna (EX1017)), 54-60 (Amendment reciting "without request or acknowledgement"), 47 (AFCP decision stating "[t]he amended claims ... overcome the current references...").

D. No Showing of Office Error

Petitioners have not "demonstrated that the Office erred in a manner material to the patentability of challenged claims." *Advanced Bionics*, 8. Petitioners merely allege that "the examiner has made a clear error in allowing the claims." Pet., 73. But, the Petition in no way demonstrates that the Office erred in finding the '615 Patent's claims patentable. Because similar and cumulative prior art was

fully “evaluated during examination” and “was the basis for rejection,” and because Petitioners have not “pointed out sufficiently how the examiner erred,” nor adduced “additional evidence and facts ... warrant[ing] reconsideration,” each of *Becton, Dickinson* factors (c), (e) and (f) favor denial of institution. *Advanced Bionics*, 9 n.10. That is further reason why institution should be denied under 35 U.S.C. § 325(d). *Fortinet v. British Telecomms.*, IPR2019-01326, Paper 8, 14 (PTAB Jan. 7, 2020); *Neology v. Star Sys.*, IPR2019-00367, Paper 9, 13 (PTAB June 6, 2019); *ZTE v. Fractus*, IPR2018-01457, Paper 10, 13 (PTAB Feb. 28, 2019).

It is not up to the Board to guess at Petitioners’ arguments as to 325(d). “Instead, the onus [is] on Petitioner to at least develop its argument concerning error by the Office...” *Nespresso USA, Inc., v. K-Fee Sys. GMHB*, IPR2021-01221, Paper 11, 22 (PTAB May 6, 2022) (denying request for rehearing of denial of institution under § 325(d) and rejecting argument that merely pointing to the petition’s grounds sufficed to show error § 325(d)). A “conclusory” “contention that the Examiner erred” that “cites no evidence” is “not a meaningful identification of error by the Office” and fails to “show[] that the Office erred in a manner material to the patentability of challenged claims.” *Panduit Corp. v. Corning Optical Commc’ns LLC*, IPR2021-01562, Paper 20, 17-18 (PTAB Apr. 6, 2022) (denying institution under § 325(d)).

Accordingly, institution ought to be denied under 35 U.S.C. § 325(d).

VIII. CONCLUSION

As demonstrated above, the Petition fails to carry its burden of demonstrating a reasonable likelihood of prevailing in demonstrating any Challenged Claim unpatentable and fails to properly address the previous consideration of substantially similar art under 35 U.S.C. § 325.

Accordingly, the Board should deny institution.

Respectfully submitted,
NL GIKEN INC.

Date: December 11, 2024

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** contains 4,369 words excluding; a table of contents, a table of authorities, a certificate of service or word count, or appendix of exhibits or claim listing. Patent Owner has relied on the word count feature of the word processing system used to create this paper in making this certification.

Date: December 11, 2024

/MacAulay Rush/
MacAulay Rush
Paralegal
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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on December 11, 2024, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via electronic mail, as previously consented to by Petitioners, upon the following:

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