

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.
Petitioner

v.

NL GIKEN INC.
Patent Owner

Inter Partes Review No.: IPR2024-01345

**PETITIONER'S REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

INDEX OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 9,948,968 (the “ ’968 patent ”).
1002	Declaration of Dr. Chandrajit Bajaj.
1003	File History of U.S. Patent No. 9,948,968.
1004	U.S. Patent App. Pub. No. 2008/0025693 (“ Lee ”).
1005	U.S. Patent No. 8,365,235 (“ Hunt ”).
1006	U.S. Patent No. 7,688,384 (“ Davis ”).
1007	U.S. Patent No. 8,032,919 (“ Inoue ”).
1008	U.S. Patent App. Pub. No. 2008/0122825 (“ Choi ”).
1009	U.S. Patent No. 7,643,095 (“ Yoshii ”).
1010	U.S. District Courts— <i>Combined Civil and Criminal Federal Court Management Statistics</i> (June 30, 2024).
1011	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , No. 1:24-cv-00028, Dkt. 32 (D. Del. Jun. 18, 2024) (Scheduling Order).
1012	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , No. 1:24-cv-00028, Dkt. 19-2 (D. Del. Mar. 18, 2024) (Amended Complaint Exhibit H).
1013	U.S. Patent No. 7,929,551 (“ Deitrich ”).
1014	U.S. Patent App. Pub. No. 2005/0160465 (“ Walker ”).
1015	U.S. Gen. Accounting Office, GAO-08-510, Report to Congressional Requesters: <i>Digital Television Transition Majority of Broadcasters Are Prepared for the DTV Transition, but Some Technical and Coordination Issues Remain</i> (April 2008) (“ GAO ”).
1016	U.S. Patent No. 5,699,125 (“ Rzeszewski ”).
1017	U.S. Provisional App. No. 61/014,745 (“ Provisional ”).
1018	U.S. Patent No. 9,019,830 (“ Delay ”).
1019	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , 1:24-cv-00028, (D. Del. Oct. 4, 2024), Patent Owner’s Initial Infringement Claim Chart for the ’968 Patent (Exhibit A).
1020	Excerpt of <i>Dictionary of ICT</i> (4th ed. 2004) (defining “controller”).
1021	Excerpt of <i>A Dictionary of Computing</i> (6th ed. 2008) (defining “controller”).

Petitioner submits this reply to Patent Owner's Preliminary Response ("POPR") pursuant to the Board's January 31, 2025 Order.

I. CLAIM CONSTRUCTION

Neither of the two claim limitations identified by Patent Owner invoke 35 U.S.C. §112, ¶6 (pre-AIA).

A. The "Designation Software Controller" Limitation of Claims 1 and 9 Is Not a Means-Plus-Function Limitation.

Because the "designation software controller ..." limitation does not use the word "means," there is a presumption that §112, ¶6 (pre-AIA) does not apply. EX1001, 17:30-35, 18:37-42; *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015). To overcome this presumption, Patent Owner must show that the claim term fails to recite "sufficiently definite structure" or fails to recite sufficient structure for performing the limitation's function. *Williamson*, 792 F.3d at 1349. Patent Owner did not attempt to do so in its POPR, and cannot do so because such a construction is contrary to law.¹

A "controller" recites sufficiently definite structure for this limitation. The PTAB has found that "controller" is not a nonce word and does not invoke §112, ¶6 because it recites sufficient structure. *Crusoe Energy Sys., LLC v. Upstream Data Inc.*, PGR2023-00052, Paper 9 at 37-43 (PTAB Mar. 29, 2024) ("controller"

¹ Patent Owner did not assert in its infringement contentions in the district court that this is a means-plus-function limitation. EX1019, 10-12, 22-23.

is not a ‘nonce’ word; but rather is understood by a person of ordinary skill in the art to have sufficiently definite meaning as the name for structure”); *Amazon.com, Inc. v. AC Techs. S.A.*, IPR2015-01803, Paper 10 at 10 (PTAB Mar. 8, 2016) (same); *see also DJI Europe B.V. v. Textron Innovations Inc.*, IPR2022-00453, Paper 27 at 14-19 (PTAB Aug. 1, 2023) (“controller” “recite[s] sufficient structure”). District courts repeatedly have found the same. *Sysmex Corp. v. Beckman Coulter, Inc.*, No. 1:19-cv-1642, 2021 WL 1259710, at *4 (D. Del. Apr. 6, 2021) (“the caselaw strongly supports the notion that, as a general matter, ‘controller’ describes a known class of structures and does not signal the use of means-plus-function claiming”); *Va. Innovation Scis., Inc. v. Amazon.com, Inc.*, No. 4:18-cv-474, 2019 WL 4259020, at *13 (E.D. Tex. Sept. 9, 2019) (“‘controller’ refers to a known class of structures in the art”); *Subotincic v. 1274274 Ontario Inc.*, No. 8:10-cv-1946, 2012 WL 3112005, at *16 (C.D. Cal. Jun. 14, 2012) (“controller ... connotes sufficient structure ... to avoid means plus function treatment”). Moreover, the adjective “software” in “software controller” does not change this conclusion because it merely indicates that, among the class of structures encompassed by “controller,” only those structures that are software are recited here. *See Westinghouse Air Brake Techs. Corp. v. Siemens Indus., Inc.*, IPR2017-00580, Paper 12 at 12 (PTAB Jul. 20, 2017) (construing “controller” to include “software”); *Powerbahn, LLC v. Zwift, Inc.*, No. 2:17-cv-01393, 2018 WL

3031707, at *7 (C.D. Cal. Jun. 13, 2018) (same); EX1020, 4 (defining “controller” to include a “software device”); EX1021, 4 (defining “controller” to be a “subsystem,” which includes software). This limitation therefore does not overcome the presumption against invoking §112, ¶6.

Patent Owner's arguments do not show otherwise. Patent Owner quotes part of *In re Aoyama* related to identifying the structure in the specification that corresponds to a means-plus-function limitation's function. POPR at 6-7; *In re Aoyama*, 656 F.3d 1293, 1297 (Fed. Cir. 2011) (“The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function.”). But this step applies only *after* one has determined a limitation invokes §112, ¶6, which this limitation does not. Patent Owner's quote from *Eon Corp.* about “the corresponding structure” has the same flaw. POPR at 7; *EON Corp. v. AT&T Mobility LLC*, 785 F.3d 616, 621 (Fed. Cir. 2015). Patent Owner's later argument that “the claim itself recites no structure for the DSC” ignores the fact that “controller” alone conveys sufficient structure, as established above. POPR at 8.

B. The “Step of Controlling” Limitation of Claim 5 Is Not a Step-Plus-Function Limitation.

Because the “step of controlling” limitation does not use the phrase “step for,” “there is a presumption that [it is] not subject to” §112, ¶6. *Generation II Orthotics Inc. v. Med. Tech. Inc.*, 263 F.3d 1356, 1368 (Fed. Cir. 2001); *see also*

Masco Corp. v. U.S., 303 F.3d 1316, 1327 (Fed. Cir. 2002) (“step of” does not create a presumption that §112, ¶6 applies); *Seal-Flex, Inc. v. Athletic Track and Court Const.*, 172 F.3d 836, 848 (Fed. Cir. 1999) (Rader, J., concurring) (“the phrase ‘steps of’ tend[s] to show that § 112, ¶ 6 does not govern”); 35 U.S.C. §112, ¶6 (pre-AIA) (“step for”). Patent Owner’s assertion that merely reciting “step” invokes a presumption that §112, ¶6 applies (POPR at 9-10) misstates the law. And, Patent Owner cannot overcome the presumption against invoking §112, ¶6.

For starters, step-plus-function limitations are exceedingly rare. *Seal-Flex*, 172 F.3d at 848 (Rader, J., concurring) (“This court has rarely examined step-plus-function claim elements”). Even Patent Owner does not cite a case in which a court construed a limitation as one. POPR, 9-11 (citing *Masco, O.I.*, and *Seal-Flex*). The *Masco* and *O.I.* courts found that the limitations at issue were not step-plus-function limitations. 303 F.3d at 1328; *O.I. Corp. v. Tekmar Co., Inc.*, 115 F.3d 1576, 1583 (Fed. Cir. 1997). In *Seal-Flex*, the parties agreed that §112, ¶6 applied, but “did not agree whether [the limitation] was a means-plus-function or step-plus-function” limitation, and the concurring opinion found that it was not a step-plus-function limitation. 172 F.3d at 842, 847, 851 (Rader, J., concurring).

Likewise, the limitation here does not overcome the presumption against invoking §112, ¶6. A “step” limitation will not invoke §112, ¶6 where “it recites sufficient acts for performing the specified function.” *Seal-Flex*, 172 F.3d at 842,

849 (Rader, J., concurring); 35 U.S.C. §112, ¶6 (pre-AIA) (“step for performing a specified function without the recital of ... acts in support thereof”). The limitation at issue recites at least two acts: 1) “controlling the keeping step,” for performing the function of “keep[ing] the information in response to a termination of viewing ...;” and 2) “control[ing] the executing step,” for performing the function of “automatically designat[ing] the succeeding part of the digital moving image contents” EX1001, 18:3-7. Each “control[ing]” is an act because it “correspond[s] to *how* the function is accomplished.” *See Masco*, 303 F.3d at 1327.

Patent Owner argues that this limitation is “substantially similar to the “DSC limitation of claim 1.” POPR at 9-10. But the DSC limitation does not invoke §112, ¶6 either, as established above. Patent Owner also attempts to recast “controlling the keeping step” and “control the executing step” as something other than acts because that language refers to other steps. POPR at 10-11. But the references to other steps, if anything, recites the two additional acts from those steps—“keeping information” and “executing ... instructions”—further precluding application of §112, ¶6. EX1001, 17:57, 17:61.

II. CONCLUSION

For the reasons above and in the Petition and supporting materials, Petitioner respectfully requests that the Board institutes trial.

Date: February 7, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that, on February 7, 2025, a copy of the foregoing paper was served via email to the following attorneys for the Patent Owner:

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