

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NL GIKEN INC.,  
Patent Owner.

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Case No. IPR2024-01345  
Patent No. 9,948,968

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**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY  
IN SUPPORT OF ITS PETITION**

## **LISTING OF EXHIBITS**

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                                                                |
|----------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2001           | USPTO Memorandum entitled “Rejections under 35 U.S.C. 112, second paragraph, when examining means (or step) plus function claim limitations under 35 U.S.C. 112, sixth paragraph” (Sept. 2, 2008) |

Petitioners construed “designation software controller” (“DSC”) as “include[ing] software instructions that cause the system to perform the claimed function.” Pet., 5-6. The Reply does not deny that the Petition’s DSC construction references algorithmic structure that converts a generic controller to a specially programmed controller that performs the claimed function. Reply, 1-3. Nor do Petitioners deny that a computing element, such as a controller, that requires special purpose programming to carry out a claimed function is a computer-implemented means-plus-function (“MPF”) element. *See WMS Gaming v. Intern’l Game Tech.*, 184 F.3d 1339, 1348-49 (Fed. Cir. 1999) (“a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.”). Confusingly, Petitioners *now* argue that despite the fact that the Petition’s DSC construction requires algorithmic structure, that somehow an off-the shelf controller is capable of meeting the claimed functionality without it. But the Petition nowhere alleges that the DSC is an off-the-shelf controller. Quite the opposite, the Petition argues that the DSC and “its functionality are not described in the specification.” Pet. at 5. Petitioners cannot convert their controller + software DSC construction to just a “controller” by revisiting a presumption analysis that Petitioners’ own construction rendered moot.

The Petition correctly construed the DSC term and claim 5's "step of controlling" as MPF terms, but the Petition failed to identify any algorithmic structure in the challenged patent and the Petition failed to map anything in the prior art to such an algorithmic structure. POPR, 1-2, 4, 16-18. As such, the petition fails.

## **I. PETITIONERS IGNORE THEIR OWN CONSTRUCTION**

Petitioners ignore that the Petition construed DSC as a controller requiring specific algorithmic structure to perform the claimed function (Pet., 5-6) and the Petition alleged that claim 5's "step of controlling" should be construed "substantially similar to" the DSC term (Pet., 28, 58).<sup>1</sup> Petitioners now hope to manipulate inapposite case law to finesse a new position that somehow a standard, off-the-shelf, "controller" has sufficient structure to perform the claimed functions. Reply, 1-2. But that is inconsistent with the Petition's construction which expressly requires certain "software" to perform the claimed functions (Pet., 5-6, 28, 58), And in any event Petitioners' case law citations relate to different claimed functions that are plainly irrelevant here.

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<sup>1</sup> Petitioners argue (Reply, 5) that this statement was somehow attributable to Patent Owner, which is plainly false.

## II. PETITIONERS CITE INAPPOSITE CASES AND OFFER NO ANALYSIS OF THE CLAIM LANGUAGE OR SPECIFICATION

Petitioners offer only inapposite cases to support their argument that “‘controller’ recites sufficiently definite structure” for the DSC and the “step of controlling” recites sufficient structure and are thus not MPF terms. Reply, 1-4. That there are functions that might be claimed where a controller alone is sufficient structure is meaningless absent some analysis of a similar function being claimed by the DSC. Indeed, the Reply *never even mentions the function performed by the DSC or the “step of controlling”*, and *never considers how the specification uses those terms and the structure it links to those claimed functions*.

The Reply alleges that “identifying the structure in the specification that corresponds to a means-plus-function limitation’s function” is a step that “applies only *after* one has determined a limitation invokes §112, ¶6.” *Id.* (emphasis in original). But Petitioners conveniently ignore that their construction has already progressed beyond this step by defining the DSC as a specially programmed computer. Here Petitioners want to improperly focus on one term—controller—and ignore their own definition that explains the controller is *not enough* absent software instructions to perform the claimed function. Petitioners attempt at caselaw distraction cannot unring that bell.

## III. THE CLAIM LANGUAGE AND SPECIFICATION SUPPORT MPF

A general-purpose computer, *i.e.*, a “controller,” fails to recite sufficiently

definite structure for performing the DSC's claimed function. The Petition correctly construed the DSC as an MPF term requiring special software to perform the claimed function: a controller that "includes *software instructions that cause the system to perform the claimed functions* of controlling the memory to keep the information in response to a termination of viewing the viewed part and controlling the processor to automatically designate the part succeeding the viewed part of the digital moving image contents when the viewing starts again." Pet., 5-6.<sup>2</sup>

Indeed, the algorithmic structure linked to this claimed function is set forth in the '968 Patent at least at 11:17-59 and Fig. 4. The '968 Patent discloses that the DSC determines what episode a viewer stopped viewing (EX1001, Fig. 4, 11:17-22) and how to designate the correct next episode (*id.*, 11:17-31, 11:37-51). Thus, regardless of whether the Petition presented an MPF construction, the Board should find the same in denying the petition.

Federal Circuit precedent makes clear that where a claim term, like "controller", is supported in the specification by algorithmic structure as the Petition itself here admits by stating that construction of the DSC term includes "software" (Pet., 5-6), that algorithmic structure must be identified and mapped to the prior art. Where the "specification clearly links the function of [the claim term] to [an] algorithm," petitioner must show that the prior art "disclosed the algorithm

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<sup>2</sup> Emphasis added unless otherwise noted.

of the [] patent or the equivalent”. *Sony v. Iancu*, 924 F.3d 1235, 1241 (Fed. Cir. 2019). The Board’s rules require the same. 37 CFR § 42.104(b)(3). In *Sony*, the Board’s decision was vacated where it had construed a claim term “reproducing means” to merely require a “controller and a synthesizer, or the equivalent” that performed the claimed function. *Sony*, 924 F.3d at 1238. The Federal Circuit explained that the Board’s decision was in error because the “specification clearly links the function of the ‘reproducing means’ to the algorithm flowchart [in the specification] and conclude[d] that the ‘reproducing means’ . . . is more appropriately construed as computer-implemented, and that the corresponding structure is a synthesizer and controller ***that performs the algorithm disclosed in the specification.***” *Id.* at 1241. The same analysis and result apply to the DSC and the “step of controlling” terms.

#### IV. CONCLUSION

For the reasons detailed above and in the POPR, the Petition correctly construed the DSC and “step of controlling” terms as requiring algorithmic structure, which implicates the MPF nature of these terms, but the Petition failed to identify that algorithmic structure in the specification and failed to map the prior art to such an algorithmic structure. The Petition should thus be denied institution.

Date: February 13, 2025

Respectfully submitted,

*NL Giken Inc.*

/Scott A. McKeown/

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Scott A. McKeown, Reg. No. 42,866

**CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)**

I certify that on February 13, 2025, 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 Petitioner, upon the following:

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Date: February 13, 2025

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