

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 RESPONSE TO
PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW**

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PO is a foreign non-practicing entity¹ manipulating the U.S. legal system and PTAB in its attempt to extort payment from one of the United States' largest employers. PO's assertion of five meritless patents in the related district court litigation is the epitome of the reason that Congress created the PTAB process—a cost-effective pathway to resolve disputes over junk patents. A foreign non-practicing entity should not be allowed to take advantage of the U.S. legal system to assert infringement in district court, and yet completely avoid the PTAB process put in place for a quick and fair review of those patents. As explained below, here, the PTAB process is working as it is designed and should be allowed to proceed. Further, as described below, PO has not shown any error in the Board's analysis.

I. DISCRETIONARY DENIAL IS NOT APPROPRIATE

Despite PO's strategic decision to waive any argument regarding discretionary denial in its POPR (Paper 9), PO now asks the Director to overturn institution because it characterizes the PTAB process as “repugnant” when it is used to prove multiple asserted patents unpatentable (Request at 12). But this attack on the PTAB process is a thinly veiled attempt to avoid substantive review by the PTAB in favor of the costly alternative of the district court.

Here, the record shows that these IPRs are fulfilling their intended purpose

¹ Giken's alleges an 18-year long business, but provides no evidence of anything made or sold, or of any services offered or provided.

by correcting mistakes made by the USPTO and acting as a true and cost-effective alternative to the related litigation. So far, in its POPRs, PO disclaimed several claims of both the '236 patent (IPR2025-00250) and the '592 patent (IPR 2025-00050). PO has informed Petitioner that PO now disclaimed the entire '615 patent (Request, n.3), which was the subject of IPR2025-01161. PO's decision to wholly disclaim one of those patents and disclaim a significant number of claims in two other patents proves that the IPR system is working to correct the USPTO's mistaken allowances of these claims, and as a true alternative to the district court litigation by eliminating junk patents and claims in a cost-effective manner. All of these IPRs should be allowed to proceed.

II. THE BOARD'S CLAIM CONSTRUCTIONS ARE CORRECT

PO's allegations of errors by the Board are an incoherent jumble that seem to be based on a fundamental misunderstanding regarding the law of claim construction.

A. The Constructions of “Designation Software Controller” and “Step of Controlling the Keeping” Are Correct

“Designation software controller” (“DSC”) is not a means-plus-function (“MPF”) term. The Board is correct that the lack of the word “means ... creates a rebuttable presumption that §112(6) does not apply.” D.I. 10. The Board correctly determined that the presumption was not overcome because the claim language itself “appears to provide structure.” D.I. 12; *Sage Prods., Inc. v. Devon Indus.*,

Inc., 126 F.3d 1420, 1427-28 (Fed. Cir. 1997) (“where a claim recites a function, but then goes on to elaborate sufficient structure, material, or acts within the claim itself to perform entirely the recited function, the claim is not in means-plus-function format”).

Also, the step of controlling the keeping is not a step-plus-function (“SPF”) term. There is a presumption that §112(6) does not apply because the claim recites “step of” rather than “step for.” D.I. 13 (citing *Masco Corp. v. U.S.*, 303 F.3d 1316, 1327 (Fed. Cir. 2002)). And, the Board correctly states that “the recited ‘keeping’ and ‘designating’ are specific acts such that” this term is not a step-plus-function term as a matter of law. D.I. 13; *see also TriMed, Inc. v. Stryker Corp.*, 514 F.3d 1256, 1259-60 (Fed. Cir. 2008) (“Sufficient structure exists when the claim language specifies the exact structure that performs the functions in question without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the structure.”). PO’s arguments that the Board erred in its analysis of this claim term are incoherent and fail to show that the Board erred. Request at 3, 5.

At bottom, PO fails to show any error regarding the Board’s analysis of the construction of either term.

B. The Petition Does Not Admit or Imply that Either Term Is Subject to §112(6) Construction

PO alleges that Petitioner’s analysis of DSC in the Petition was an implicit

admission that the term is MPF. It was clearly not. The Petition states that there is nothing in the specification that corresponds to the claimed controller. Pet. at 5 (“‘Designation software controller’ and its functionality are not described in the specification.”). This statement, which appears at the outset of the Petition’s analysis of the DSC limitation, is antithetical to an assertion that a claim limitation is subject to MPF construction and provides context for the remainder of the analysis. The Petition then demonstrates that the claim itself includes a required algorithm for the controller (“this ***limitation includes software instructions*** that cause the system to perform the claimed functions . . .”), consistent with well-established case law. Pet. at 5; *e.g.*, *TriMed*, 514 F.3d at 1259-60. The Board both understood the analysis in the Petition and, as discussed above, rightly found that analysis to be correct. PO admits that the Petition treats the “step of controlling” as being substantially similar to the DSC. Therefore, PO is wrong as to both terms: the Petition does not assert, admit, or imply that the “designation software controller” or the “step of controlling” limitations are subject to §112(6) construction.

PO alleges that Petitioner completely “pivoted” and changed its proffered construction in the reply to the POPR. However, Petitioner’s reply brief only rebuts the unexpected (and unsupported) argument in the POPR that MPF or SPF claiming applies. Paper 12. Petitioner’s reply to the POPR did not change anything

about its own construction or the application of that construction in the grounds.

III. PETITIONER’S CLAIM CONSTRUCTION POSITIONS ARE CONSISTENT BETWEEN THE DISTRICT COURT AND PTAB

Without any evidence, PO accuses Petitioner of improper “gamesmanship” and “flip-flopping” on whether “designation software controller” is a MPF term. To be clear, Petitioner has never alleged that “designation software controller” is a MPF term based on the claims or the specification prior to PO’s arguments in the POPR. However, after receiving the POPR, Petitioner alleged that prosecution disclaimer applies to this term based on PO’s POPR argument that MPF construction applies to these terms. The law is clear that, although a PO’s disclaimer during IPR is “binding” to the district court proceeding, it cannot impact the construction in these IPR proceedings. *CUPP Computing AS v. Trend Micro Inc.*, 53 F. 4th 1376, 1383-84 (Fed. Cir. 2022) (“disclaimer in an IPR proceeding is binding in later proceedings Disclaimers in an IPR proceeding are not binding in the proceeding in which they are made.”). Moreover, PO’s attempt to incorporate new evidence regarding claim construction is improper. Had PO believed this was relevant to institution, it should have requested leave to supplement the record for the Board to decide this issue in the first instance.

IV. CONCLUSION

The Board’s Decision on Institution was correct for all of the above reasons.

Date: April 16, 2025

Respectfully submitted,

/s/ Jennifer Librach Nall

Jennifer Librach Nall

Reg. No. 57,053

DLA Piper LLP (US)

303 Colorado Street

Suite 3000

Austin, TX 78701

Phone: + 1 512 457 7249

Fax: + 1 512 721 2249

jennifer.nall.ptab@us.dlapiper.com

*Attorney for Petitioners Amazon.com,
Inc., Amazon.com Services, Inc.,
Amazon Web Services, Inc., and Twitch
Interactive, Inc.*

CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§42.6(e) that on April 16, 2025 a true and correct copy of the PETITIONER'S RESPONSE TO PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW was served via email:

- Scott A. McKeown (SMcKeown-PTAB@WolfGreenfield.com)
- Gerald B. Hrycyszyn (GHrycyszyn-PTAB@WolfGreenfield.com)
- Victor Cheung (VCheung-PTAB@WolfGreenfield.com)

Date: April 16, 2025

/s/ Jennifer Librach Nall
Jennifer Librach Nall
Reg. No. 57,053
DLA Piper LLP (US)
303 Colorado Street, Suite 3000
Austin, Texas 78701
Phone: 512.457.7249
Fax: 512.721.2249
jennifer.nall.ptab@dlapiper.com

*Attorney for Petitioners Amazon.com,
Inc., Amazon.com Services, Inc.,
Amazon Web Services, Inc., and Twitch
Interactive, Inc.*