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. IPR2025-00050
Patent No. 10,880,592

PATENT OWNER'S SUPPLEMENTAL PRELIMINARY RESPONSE TO ADDRESS DISCRETIONARY DENIAL OF INSTITUTION

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LISTING OF EXHIBITS

Exhibit	Description
2001	Disclaimer in Patent under 37 CFR 1.321(a) filed February 27, 2025
2002	Board's April 8, 2005 email authorizing Patent Owner to file this supplemental brief
2003	*NL Giken Inc. v. Amazon.com, Inc., et al.*, Civil Action No. 24-28-MN, D.I. 86 (Defendants' Opening Brief in Support of Their Motion to Stay Pending *Inter Partes* Review without exhibits) (D.Del. April 4, 2025)
2004	Declaration of Gerald B. Hrycyszyn
2005	Oral Order Re Motion to Stay Pending Inter Partes Review, *PayRange, Inc. v. CSC Serviceworks, Inc.*, Case No. 1-23-CV-00278, D.I. 61 (D. Del., Feb. 26, 2024)
2006	Plaintiff's Opposition to Motion to Stay Pending IPR, *PayRange, Inc. v. CSC Serviceworks, Inc.*, Case No. 1-23-CV-00278, D.I. 59 (D. Del., Feb. 23, 2024)
2007	Official Transcript of Discovery Dispute*, Exact Sciences Corporation v. Geneoscopy, Inc.*, Case No. 1-23-CV-01319, D.I. 168 (D. Del., Nov. 1, 2024)
2008	Disclaimer in Patent Under 37 CFR 1.321(a) filed April 11, 2025
2009	Defendants' Initial Invalidity Contentions, *NL Giken Inc. v. Amazon.com, Inc. et al.*, Case No. 1:24-cv-00028-MN (D. Del. Nov. 15, 2024)

The Board should exercise its discretion under 35 U.S.C. § 314(a) to deny the Petition. *See* EX2002. Far from diligent, Petitioners waited nearly eleven months after service of the complaint in the related litigation to file this Petition. At the time of institution decision (ID) alone, the Parties will be within five days of ***completing*** fact discovery in the related litigation. And at the time of the Board's final written decision, ***the jury trial will be just a few weeks away*** (scheduled for June 22, 2026). Irrespective of Petitioners' belated *Sotera* stipulation, on balance, it would be a waste of party and Board resources for these competing proceedings to advance in parallel and to reward delayed filing gamesmanship. Discretionary denial is in order.

I. DISCRETIONARY DENIAL IS WARRANTED

A. Each *Fintiv* Factor Favors Discretionary Denial Or Is Neutral

On February 28, 2025, the USPTO rescinded the June 21, 2022, Memorandum entitled "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (Memorandum). Accordingly, the Memorandum's absolute safe harbor provision for a *Sotera* stipulation no longer applies, and Petitioners' March 8th *Sotera* stipulation is no longer dispositive. Considering all the *Fintiv* factors holistically, discretionary denial is in order.

1. Stay Potential Favors Neither Party

Petitioners requested a stay of the related litigation (EX2003), which Patent Owner will oppose. The District Court is likely to deny the request to stay because the Board has only issued IDs in two of five IPRs challenging the asserted patents

in the related litigation. *See* EX2004, at ¶ 6. The Judge before whom the related litigation is pending routinely denies motions for stays for that reason. *See e.g., PayRange v. CSC ServiceWorks*, Case No. 1-23-CV-00278, D.I. 61, D.I. 59, p. 1(D. Del., Feb. 23-26, 2024) (EX2005 and EX2006); *Exact Sciences v. Geneoscopy*, Case No. 1-23-CV-01319, D.I. 168, pp. 28-29 (D. Del., Nov. 1, 2024) (EX2007).

This factor is neutral at best because the Board "will not attempt to predict" how the district court will proceed if a stay has not been granted. *Sand Revolution v. Continental*, IPR2019-01393, Paper 24, 7 (Jun. 16, 2020) (informative).

2. Court Will Hold Trial About Same Time FWD Is Due

The statutory deadline for a FWD is set just a few weeks before the District Court trial date of June 22, 2026. EX1008, at 3. Had Petitioners been diligent and not delayed 11 months in filing the Petition, they could have avoided the trial date being scheduled so close to the FWD deadline. Petitioners' delay favors discretionary denial under this factor.

3. Litigation Investment Has Been Substantial

The parties' significant investment in the parallel court proceeding weighs in favor of denial. By the time the Board's ID is due ***alone***, the parties will have: nearly completed fact discovery (which closes on June 2); completed and served all final infringement, final noninfringement, final invalidity, and final validity contentions; produced and reviewed more than 50,000 pages of documentary evidence; produced source code (Petitioners); completed more than 30 days worth

of man-hours reviewing the source code (Patent Owner); and conducted numerous witness depositions on behalf of both parties, including deposition of a foreign-based witnesses who will have traveled to the U.S for days of proceedings. *See* EX2004, at ¶¶ 1-5. As in the Director's recent decision in *Motorola Solutions v. Stellar*, given the substantial time and effort the parties will have invested in the parallel proceeding, factor 3 strongly favors discretionary denial. IPR2024-01205, Paper 19, 2-3 (PTAB, Mar. 28, 2025).

4. Invalidity Issues Completely Overlap & Petitioners Have Demonstrated Their *Sotera* Stipulation To Be Meaningless

Because the FWD in this IPR is not due until close to trial in the related litigation, the issues in each will entirely overlap to the end of both proceedings. With the disclaimers (EX2001, EX2008), the only claims asserted in the related litigation (EX1006) are those challenged in this IPR (*i.e.*, claims 1-2, 3, 5).

Walker (EX1005) and Chang (EX1004) the primary references for all grounds in this IPR are also Petitioner's lead references in the litigation. EX2009, 12, 592.A, 592.B. Indeed, Petitioner, in its district court invalidity contentions expressly incorporates the grounds of this IPR. *Id.*

Rescission of the Memorandum removes the safe harbor for the belated *Sotera* stipulation. Also in the related litigation, Petitioners have identified system prior art in combination with Walker and Chang. EX20009, 12-13; EX2009, 592.E, E-14, 24, 35, 43, 49, 54, 58-59, 62-66, 69, 72; EX2009, 592.F, 15, 23, 35, 41, 47, 52, 58-59,

65-69, 81, 93. Thus, the *Sotera* stipulation is entirely toothless as Petitioners have already revealed their intention to litigate the ***exact same art again*** via procedural sleight of hand (*i.e.*, system art being ineligible for IPR). *Id*. EX20009, 12-13. As in the Director's recent decision in *Motorola Solutions*, "Petitioner's stipulation does not ensure that these IPR proceedings would be a 'true alternative' to the district court proceeding." IPR2024-01205, Paper 19, pp. 3-4. Like in *Motorola Solutions*, "Petitioner's invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner's stipulation is not likely to moot." *Id*.; EX2009. Accordingly, the stipulation does not outweigh the substantial investment in the district court proceeding or other *Fintiv* factors which weigh in favor of denial.

Further, Petitioners take inconsistent positions in the related litigation and in this IPR. In the related litigation, Petitioners argue that many limitations of the challenged claims here are indefinite. EX2009, 50-51. Petitioners appear to have no trouble understanding these terms here. Petitioners are talking out of both sides of their mouth to the detriment of the Patent Owner by playing both jurisdictions.

This factor thus weighs in favor of discretionary denial.

5. Litigation Defendants Are The Same Petitioners

Petitioners are defendants in the parallel district court proceeding. This factor weighs in favor of discretionary denial. *Fintiv* at 15.

6. Other Considerations

As detailed in the POPR, the Petition does not satisfy the compelling merits standard. The Petition does not present anticipatory prior art under §102. Instead the petition relies solely on obvious combinations under §103 (weaving in over 100 pages of expert testimony). Yet the petition provides ***no 325(d) analysis at all*** for the agency to assess if these combinations of features are rework or not. Petition, 75 (stating no "challenges" are "substantially the same"). Of course, a proper 325(d) analysis must assess the technical content of individual ***references*** relative to the previous prosecution history—not "challenges." And there are no "challenges" at all in patent examination and Petitioners cannot simply offload their 325(d) burden to the agency or Patent Owner to figure out. Petitioners' 325(d) failure is separately fatal but simultaneously demonstrates the significant weight to be accorded to this *Fintiv* factor in favor or the Patent Owner.

This final factor also weighs in favor of discretionary denial.

7. Balance of Factors Favor Denial

In sum, five of the six Factors (Factors 2 through 6) weigh in favor of discretionary denial. One factor (Factor 1) is neutral. Thus, the *Fintiv* factors considered as a whole favor denial and the Board should exercise its discretion to deny institution.

Respectfully submitted,

NL Giken Inc.

Date: April 11, 2025 /Scott A. McKown/

Scott A. McKeown, Reg. No. 42,866
WOLF, GREENFIELD & SACKS, P.C

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

I certify that on April 11, 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:

Jennifer Librach Nall	jennifer.nall@dlapiper.com
Robert Buergi	robert.buergi@dlapiper.com
Joseph Wolfe	joseph.wolfe@dlapiper.com
	DLA-Amazon-NLGiken@dlapiper.com

Date: April 11, 2025

/MacAulay Rush/
MacAulay Rush
Paralegal
WOLF, GREENFIELD & SACKS, P.C.