

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

**PETITIONERS' RESPONSE TO PATENT OWNER'S SUPPLEMENTAL
BRIEF REQUESTING DISCRETIONARY DENIAL**

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LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 10,880,592 (the “ 592 patent ”).
1002	Declaration of Dr. Chandrajit Bajaj.
1003	File History of U.S. Patent No. 10,880,592.
1004	U.S. Patent App. Pub. No. 2002/0194619 (“ Chang ”).
1005	U.S. Patent App. Pub. No. 2005/0160465 (“ Walker ”).
1006	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , No. 1:24-cv-00028 (D. Del. Oct. 4, 2024) (Exhibit B, NL Giken Initial Infringement Claim Chart for US 10,880,592) (FILED UNDER SEAL).
1007	U.S. District Courts— <i>Combined Civil and Criminal Federal Court Management Statistics</i> (Jun. 30, 2024).
1008	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , No. 1:24-cv-00028, Dkt. 32, 1:24-cv-00028 (D. Del. Jun. 18, 2024) (Joint Scheduling Order).
1009	Concise Oxford English Dictionary (11th ed. 2008) definition of “accordance.”
1010	Amazon Fire TV Product Page (Oct. 14, 2024)
1011	Amazon Fire TV Stick 4k Product Page (Oct. 14, 2024)
1012	Docket Navigator, time-to-trial data for Hon. Judge Maryellen Noreika (printed Apr. 11, 2025).
1013	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , No. 1:24-cv-00028 (D. Del. Apr. 9, 2025) Defendants’ Supplemental Invalidity Contentions Cover Pleading.
1014	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , No. 1:24-cv-00028 (D. Del. Feb. 28, 2025) Defendants’ Initial Proposed Constructions.

In parallel with this response, Petitioner is requesting authorization to move to strike PO's Supplemental Preliminary Response for exceeding the bounds of the Board authorization, which was to "address the rescission of the June 21, 2022, memorandum." EX2002. PO's brief goes far beyond that authorization, such as by addressing every *Fintiv* factor and discretionary denial under § 325(d). Tellingly, PO makes no argument that arises from the rescission. Even if PO's improper arguments are considered, the *Fintiv* factors do not warrant discretionary denial.

I. PO EXCEEDS THE BOARD'S AUTHORIZATION

The Petition explained why the *Fintiv* factors and § 325(d) all weigh against discretionary denial. Paper 1 at 71-75. PO did not request any discretionary denial in its Preliminary Response. Paper 9.

The 2022 memorandum addressed four things: (1) the role of compelling merits; (2) the ITC and *Fintiv*; (3) *Sotera* stipulations; and (4) trial date statistics. The Board authorized PO to address the rescission of that memorandum, but none of PO's arguments address any change in the discretionary denial analysis *based on the rescission of the memo*. PO creates the false appearance that the arguments in its brief are justified solely by referring to a March 8, 2025 *Sotera* stipulation and arguing it is no longer dispositive, but no such stipulation exists and thus the rescission of the memorandum's *Sotera* stipulation safe harbor is irrelevant here. The other changes associated with the rescission also do not justify PO's

arguments: there is no parallel ITC proceeding, PO's POPR has already addressed the merits of the challenges in the Petition, and PO does not address trial date statistics. Despite the Board's express prohibition on addressing the Interim Processes (EX2002), PO addresses the new *extent of the petition's reliance on expert testimony* factor announced therein by citing the number of pages in Petitioner's expert testimony. Paper 10 at 5 ("weaving in over 100 pages of expert testimony"). The Board therefore should ignore PO's arguments as unauthorized.

II. DISCRETIONARY DENIAL IS NOT WARRANTED

As explained in the Petition, the *Fintiv* factors weigh against discretionary denial. Paper 1 at 71-75.

A. Factor 1 Is Neutral

Since the Petition, Petitioner has filed a motion to stay in the underlying litigation, as PO acknowledges. This factor remains neutral. Paper 1 at 72.

B. Factor 2 Favors Institution

The PTAB would issue a FWD in this IPR weeks before the scheduled trial date and months before the October 2026 trial calculated based on median time to trial in the district. Paper 1 at 72. Moreover, based on the Docket Navigator time-to-trial statistics for Judge Noreika (the Judge presiding over the related district court proceeding), the trial would not begin until December 2026. EX1012.

C. Factor 3 Favors Institution

The district court has not made a single substantive ruling regarding the '592

patent, which alone favors institution. “If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution under *NHK*.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 10 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”). Moreover, much work remains to be done in the district court, as shown below:

Date	Event	Time from Institution
Jun. 25, 2025	Opening Claim Construction Brief	13 days
Jul. 18, 2025	Responsive Claim Construction Brief	36 days
Sept. 16, 2025	Claim Construction Hearing	96 days
Dec. 22, 2025	Expert Discovery Closes	193 days
Jun. 22, 2026	Jury Selection	375 days

This weighs against discretionary denial, particularly because *Markman* briefing has not yet begun here. Notably, the Board has found that this factor favors institution even in cases that have advanced beyond the completion of *Markman* briefing. See *Samsung Display Co., Ltd., v. Pictiva Displays Int’l Ltd.*, IPR2024-01222, Paper 12 at 7 (P.T.A.B. Mar. 6, 2025) (post-rescission) (this factor weighs against denial, even though a *Markman* hearing has been held, in part because “much remains to be done, including expert discovery”); see also *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01432, Paper 14 at 8-9 (P.T.A.B. Apr. 7, 2025) (factor 3 favored institution even after *Markman* briefing was complete).

PO’s citation to *Motorola Solutions, Inc. v. Stellar, LLC* is inapposite if not misleading because the parties there had “served opening and rebuttal expert

reports, filed claim construction briefs,” and the **court** had “held a claim construction hearing and construed the disputed claim terms,” none of which have happened here. IPR2024-01205, Paper 19 at 3 (P.T.A.B., Mar. 28, 2025).

D. Factor 4 Favors Institution

Because the statutory deadline for the final written decision predates both the scheduled and calculated trial dates (§II(B)), the issues decided during *inter partes* review will be different from the issues decided by the district court due to estoppel. Paper 1 at 73. PO’s assertion that Walker and Chang are Petitioner’s “lead references in the litigation” is only correct if institution is denied. Paper 10 at 3. For the avoidance of doubt, Petitioners hereby stipulate that if the Board institutes this IPR, then Petitioner will not rely on Walker or Chang in the district court. This stipulation, plus the estoppel that will automatically apply post-FWD, renders indisputable that this IPR is a true alternative to the district court litigation. PO’s argument about Petitioner’s indefiniteness contentions is disingenuous and misleading because it ignores the fact that these indefiniteness contentions were dropped in Petitioner’s claim constructions served in February, and is further confirmed in supplemental contentions served prior to PO’s brief. EX1014, 1-3; EX1013, 45-47.

E. Factor 5 Favors Institution

Because the statutory deadline for the final written decision predates both

the scheduled and calculated trial dates (§II(B)), this factor weighs against discretionary denial. *Samsung Elecs. Co. Ltd. v. Staton Techiya, LLC*, IPR2022-00282, Paper 12 at 16-18 (P.T.A.B. Jun. 17, 2022).

F. Factor 6 Favors Institution

This factor favors institution. Paper 1 at 74-75. PO's § 325(d) argument fails because Petitioner has no burden in its petition to prove a negative—the absence of a § 325(d) issue. *See Masimo Corp. v. Apple Inc.*, IPR2023-00634, Paper 14 at 12-13 (P.T.A.B. Sept. 25, 2023) (“Patent Owner identifies no rule, statute, or precedent that requires a petitioner to meet any burden on § 325(d) issues in the petition.”). And PO shows no substantially similar prior art from the '592 patent prosecution history, let alone prior art that would warrant discretionary denial under § 325(d).

PO also ignores the fact that, since the Petition, it has disclaimed the '592 patent's claims 4 and 6-13, implicitly conceding their unpatentability and casting doubt on the patentability of the remaining claims. EX2001; EX2008.

III. CONCLUSION

The Board should deny PO's belated request for discretionary denial.

Date: April 18, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) that on April 18, 2025, a true and correct copy of this **brief and exhibits EX1012 - EX1014** were served via email:

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