

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. IPR2025-00250
Patent No. 8,094,236

PATENT OWNER'S PRELIMINARY RESPONSE

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LISTING OF EXHIBITS

Exhibit	Description
2001	Reserved
2002	Reserved
2003	Disclaimer in Patent Under 37 CFR 1.321(a)
2004	PTAB Email Dated March 28, 2025 Extending Deadline for Discretionary Denial Briefing

I. INTRODUCTION

U.S. Patent No. 8,094,236 (“the ’236 Patent”) is directed to a viewing device, such as a television set that automatically generates predetermined information for communication to a remote counterpart. In operation, changes in the function of the viewing device (*e.g.*, turning the device on/off, changing the channel, adjusting the volume, abnormal use of the device or remote controller, *etc.*) results in a predetermined exchange of information with the remote counterpart. The exchanging of information provides the ability to continuously inform remotely located individuals of, and detect abnormalities in, each other’s device use. For example, to monitor safety of an elderly relative.

The Petition grounds fail to identify predetermined information that is generated in response to detecting a change in the viewing device function as claimed. The Petition’s grounds thus fail.

Pursuant to the Director’s March 26, 2025 memorandum regarding Interim Processes for PTAB Workload Management (“March 26, 2025 Memo”), Patent Owner NL Giken Inc. will separately request that the Director exercise her discretion under 35 U.S.C. § 314(a) to issue a decision denying institution of the Petition. The deadline for filing that paper is April 26, 2025. See EX2004.

II. '236 PATENT

The '236 Patent discloses innovative viewing devices that allow information exchange between users. EX1001, 1:41-49. The devices are configured to automatically generate emails in response to detecting the occurrence of predetermined events (*e.g.*, changes to device operation such as turning the device on/off, abnormal key presses on the remote controller indicating an emergency, *etc.*) and to send automatically generated emails to a counterpart device of a remotely located user to inform the user of the event. EX1001, 1:50-2:9, 5:60-6:16. These capabilities allow remotely located individuals to share viewing experiences and monitor the safety and well-being of each other (*e.g.*, family members living in different homes).

The '236 patent's claims are directed to viewing devices configured for automatically generating and sending predetermined information between devices when designated events occur.

Claim 1 recites, *inter alia*:

[1.pre] A television set comprising:

...

[1.g] an automatic generator provided inside the television set and arranged to generate predetermined second information in response to the detector which detects a cause of a predetermined change in the television function;

The Petition fails to demonstrate that the prior art relied upon discloses or suggests generating “predetermined second information” in response to a change television function. Grounds 2-4 all fail for at least this reason.

III. PERSON OF ORDINARY SKILL IN THE ART

For purposes of this Preliminary Patent Owner Response only, Patent Owner does not challenge Petitioner’s POSITA definition (Petition, 3) because the Petition fails even if Petitioner’s POSITA definition is adopted.

IV. GROUNDS 2-4: THE PETITION MISTAKENLY IDENTIFIES A PROTOCOL AS A PARAMETER: FAILING TO ESTABLISH THAT ANY PREDETERMINED SECOND INFORMATION IS GENERATED¹

Grounds 2-4 rely on Cooper’s email triggering process to meet limitation [1.g.]’s “predetermined second information” generated in response to detecting a change in television function. Petition, 47-48 (citing Cooper, ¶¶ 61, 63, FIG. 12A, FIG. 14). These grounds fail for two independent reasons.

First, Petitioners allege that Cooper’s email messaging protocol is “predetermined second information” because it is determined in advance that an email will be sent when the user changes the channel. But Cooper’s protocol is a mechanism that conveys information, it is not *itself* predetermined information. The claims of the ‘236 Patent plainly recite protocol mechanisms and the parameters

¹ Ground 1 is rendered moot by operation of disclaimer. EX2003

conveyed by such mechanisms, separately. *Compare* ‘236 claim 5 where the second predetermined information is attached to the email (*i.e.*, second predetermined information is not *itself* the email protocol).

Second, Petitioners allege that Cooper discloses transmitting the “new viewing information” the user is presently viewing after changing the channel (*e.g.*, the name of the show and/or the network), none of which is determined in advance of the channel change. Thus, even if Petitioners had pointed to Cooper’s message content (they did not), Cooper still would not disclose generating any “predetermined second information.”

A. Cooper’s Email Protocol

Cooper discloses that “when a user changes channels, set-top box software employs a messaging protocol that transmits a message to the server including the name of the show and/or the network the user is presently viewing.” Cooper, ¶¶ 61, 63 (“As each user changes channels 1402, the user’s set-top box transmits a message to the server describing the change 1404), FIG. 14 (annotated below).

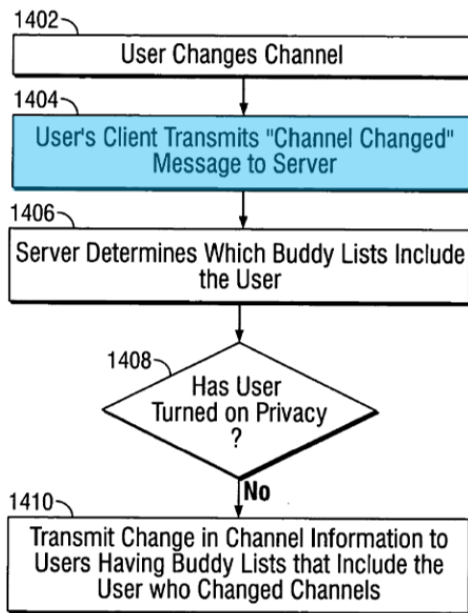


FIG. 14

The server updates its user list with the “new viewing information” received in the channel changed message and transmits a message with the new viewing information to logged-in users of its buddy list program. Cooper, ¶¶ 61, 63, FIGS. 12A, 12B, 14.

B. Petitioners Fail to Map Element 1[g] to Any “Information” in Cooper That Is Predetermined

Petitioners allege that “[t]he message to the server (*second information*) is *predetermined* because it is determined in advance that the set-top box will send a message to the server upon a channel change.” Petition, 47-48 (*italics original*). Petitioners do not allege that Cooper generates any “information” that is predetermined. Instead, the Petitioners identify an email protocol that is allegedly predetermined—*i.e.*, the “it” that Petitioner says is determined in advance refers to the protocol action “that” Cooper’s set-top box will take in response to a channel

change, not to any *information* that is predetermined. The protocol used for conveying information is not itself information. The email is only the mechanism that conveys information (*e.g.*, channel change identification). Indeed, the message stripped of the necessary channel *information* is useless for Cooper’s purpose of coordinating viewers based upon user channel selection.

Cooper’s predetermined protocol that involves triggering a message protocol does not satisfy [1.g]’s requirement of generating “***predetermined second information.***” While the Petition alleges that a message sent to the server includes “the name of the show and/or the network the user is presently viewing” (Petition, 47), that information is generated by user selection, the exact opposite of predetermined. If channel changes were predetermined, there would be no purpose to convey such actions piecemeal in Cooper as the server could just send a schedule of what the user intends to watch and when—which of course, is absurd absent psychic ability. As can be appreciated, the Petition fails to establish that Cooper generates any “predetermined second information” as required by limitation [1.g]. That is fatal to Grounds 2-4.

C. Cooper Does Not Disclose Generating Any Predetermined Information

None of the disclosed information included in Cooper’s email triggering protocol is determined in advance of the user changing the channel (the Petition’s alleged “predetermined change in the television function”), as required by limitation

[1.g]’s “predetermined second information.” *Supra* §**Error! Reference source not found.** Both the “name of the show and/or the network the user is presently viewing” after changing the channel (what Cooper refers to as the “new viewing information”) can only be determined after the user changes the channel—*i.e.*, when that information first becomes known. Cooper, ¶ 61².

Thus, even had Petitioners alleged that Cooper’s message includes “predetermined second information” (which Petitioners did not), Grounds 2-4 would still fail.

V. STATUTORY DISCLAIMER UNDER 37 C.F.R. § 1.321(A)

On March 21, 2025, Patent Owner filed a statutory disclaimer, disclaiming claims 3, 10 and 13 of the ’236 Patent under 35 U.S.C. § 253(a) and in compliance with 37 C.F.R. § 1.321(a), using the form approved for such submissions by the Office and accompanied by the appropriate fee. EX2003. Because “no *inter partes* review will be instituted based on disclaimed claims” (37 C.F.R. § 42.107(e)), Patent Owner respectfully submits that institution of a trial here would be improper with

² Of course, a message must include content that is arrived at prior to the time of communication. But construing “predetermined” as including content defined in the first instance at the time of message formation is entirely unreasonable in view of the ’236 Patent specification’s use of “predetermined.”.

respect to disclaimed claims 10 and 13 challenged only in Petition’s Ground 1. *See Unified Patents Inc. v. Sound View Innovations, LLC*, IPR2019-01113, Paper No. 8, 7-8 (PTAB November 22, 2019) (denying institution and holding that “[b]ecause [some of the challenged] claims . . . have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), we cannot institute a trial on these claims”); *SFC Co., Ltd. v. LG Chem, Ltd.*, IPR2020-00178, Paper No. 16, 7-8 (PTAB May 29, 2020) (similar); *Delta Electronics, Inc. v. Vicor Corporation*, IPR2024-00134, Paper No. 8, 11-12 (PTAB May 17, 2024) (similar); *see also Tandus Flooring, Inc. v. Interface, Inc.*, IPR2013-00526, Paper No. 7 (PTAB, February 14, 2014) (denying institution of trial because patent owner had disclaimed all of the challenged claims); *Inguran, LLC d/b/a Sexing Technologies v. Premium Genetics (UK) Ltd.*, IPR2016-00756, Paper No. 9 (PTAB, August 31, 2016) (same).

VI. CONCLUSION

For the reasons discussed above, the Board should deny the Petition in light of the facially deficient grounds presented.

Respectfully submitted,
NL Giken Inc.

Date: March 31, 2025

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

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** contains 1,503 words excluding; a table of contents, a table of authorities, a certificate of service or word count, or appendix of exhibits or claim listing. Patent Owner has relied on the word count feature of the word processing system used to create this paper in making this certification.

Date: March 31, 2025

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

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

I certify that on March 31, 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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