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

PETITIONERS' SUR-REPLY TO PATENT OWNER'S REQUEST TO THE DIRECTOR FOR DISCRETIONARY DENIAL OF INSTITUTION

Patent Owner's position is baseless. Under the *Fintiv* analysis, there has not been significant investment in litigation. And, Patent Owner's rhetoric and complaints regarding Petitioners' stipulation are unsupportable by the facts of this case.

I. THERE HAS BEEN NO SIGNIFICANT INVESTMENT IN LITIGATION UNDER *FINTIV* FACTOR 3

Petitioners rebutted Patent Owner's arguments related to the alleged significant investment. Paper 11 at 5-8 ("Patent Owner's list of tasks completed in the litigation likewise is flawed because it includes many tasks that typically take place relatively early in litigation and therefore do not show 'significant investment'").

As Petitioner previously showed, ***both*** the amount and type of work that remains indicates that a significant investment has not yet occurred. Paper 11 at 5 (showing that Markman briefing, Markman hearing, opening expert reports, rebuttal expert reports, and reply expert reports will all not be complete as of the institution decision date). In *Fintiv*, the PTAB recognized that substantive orders by the ***court*** are a significant factor in assessing the investment in the parallel proceeding. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9-10 (PTAB Mar. 20, 2020) (precedential) ("if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition"). Here, the ***court*** has not made any significant investment because it has not issued

any orders and has not held a *Markman* hearing.

Patent Owner's citation to *Motorola* is inapposite. In *Motorola*, the Director found that Factor 3 favored institution because that "the parties had already 'served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions.'" Paper 12 at 2 (citing *Motorola Solutions, Inc. v. Stellar, LLC,* IPR 2024-01205, Paper 19 at 3 (PTAB Mar. 28, 2025)). Here, unlike in *Motorola*, the parties have yet to serve opening and rebuttal expert reports, have yet to file claim construction briefing, and have yet to conduct the Markman hearing. *See* Paper 11 at 6.

Moreover, Patent Owner's arguments in response to Petitioners' Motion to Stay in the parallel proceeding contradict Patent Owner's positions in this IPR. In particular, in the parallel proceeding, Patent Owner argued that issuing a stay is premature because fact discovery is incomplete, "the claim construction hearing is not scheduled to occur until almost two months after the last of the institution decisions is expected," and that the "majority of the remaining schedule for this case (claim construction, expert discovery, and trial) will still be ahead of the parties after the final institution decision issues." EX1017, 4. Thus, Patent Owner's arguments in the parallel proceeding admit that the majority of investment in the parallel proceeding has not yet occurred.

Patent Owner alleges that Petitioners "are talking out of both sides of their mouth" (Paper 12 at 4) based on the acknowledgement in the Motion to Stay regarding the possibility of inconsistent positions in the parallel proceeding versus the IPR. However, it is accurate to acknowledge the possibility for inconsistency (if the requested stay is not granted) while also acknowledging that the majority of investment in the parallel proceeding has not yet occurred. Moreover, since that time, Petitioners have expanded their pre-POPR stipulation under *Sotera* to an unprecedented, broader stipulation that ensures that there are no possible overlapping invalidity questions.

Accordingly, Factor 3 weighs against discretionary denial.

II. PETITIONERS' STIPULATIONS ARE TIMELY AND WEIGH AGAINST DISCRETIONARY DENIAL

Patent Owner's arguments that Petitioners' stipulations are "belated" is unsupported by any citation to precedent. Paper 11 at 11. There is nothing Patent Owner has shown to be belated about Petitioners' stipulations.

Moreover, no stipulation takes effect until the institution decision, so Patent Owner's complaints of "gamesmanship" and prejudice ring hollow. The filing of these stipulations presents no prejudice to Patent Owner—Patent Owner has not and cannot identify any action that would have occurred differently had the stipulations been given at an earlier point in these proceedings. Patent Owner's complaints regarding their wasted effort in "assessing the prior art for months" is

not more than empty rhetoric. Absent a stay of the parallel proceeding—which Patent Owner is fighting—there is nothing Patent Owner would have been able to do differently had Petitioner filed a stipulation earlier.

Similarly, there is absolutely nothing prejudicial to Patent Owner regarding Petitioner expanding its pre-POPR stipulation under *Sotera* to an unprecedented, broader stipulation. Petitioners' expanded stipulation reduces any chance of prejudice by affirmatively giving up Petitioners' rights that exist in the parallel proceeding. Patent Owner's attempt to characterize the stipulation as anything other than a boon for Patent Owner should be soundly rejected.

III. CONCLUSION

Petitioner requests that the Director deny Patent Owner's request for discretionary denial.

Date: May 9, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Petitioner certifies that this brief includes 780 words, as measured by Microsoft Word, exclusive of the table of contents, the table of authorities, the certificate of service, the certificate of word count, and the index of exhibits.

Date: May 9, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) that on May 1, 2025, a true and correct copy of this brief and any new exhibits was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

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