

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.: IPR2025-00407

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF U.S.
PATENT NO. 8,677,391 UNDER 37 C.F.R. § 42.72**

INDEX OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 8,677,391 (the “’391 patent”).
1002	Declaration of Dr. Chandrajit Bajaj.
1003	File History of U.S. Patent No. 8,677,391.
1004	U.S. Patent App. Pub. No. 2007/0288951 (“Ray”).
1005	U.S. Patent App. Ser. No. 60/745,998 (Ray provisional application).
1006	U.S. Patent App. Pub. No. 2006/0053049 (“Nolan”).
1007	U.S. Patent No. 8,016,185 (“Modi”).
1008	U.S. Patent No. 8,561,113 (“Cansler”).
1009	Excerpt of <i>The Chambers Dictionary</i> (10th ed. 2006) (definition of “present”).
1010	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , 1:24-cv-00028, (D. Del. Oct. 21, 2024), Patent Owner’s Initial Infringement Claim Chart for the ’391 Patent (Exhibit C-1).
1011	U.S. District Courts— <i>Combined Civil and Criminal Federal Court Management Statistics</i> (Sept. 30, 2024).
1012	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , 1:24-cv-00028, Dkt. 32 (D. Del. Jun. 18, 2024) (Scheduling Order).
1013	Docket Navigator, time-to-trial data for Hon. Judge Maryellen Noreika (printed Apr. 11, 2025).
1014	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , 1:24-cv-00028, (D. Del. Apr. 7, 2025), Patent Owner’s first set of interrogatories to Petitioner.
1015	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , 1:24-cv-00028, (D. Del. Apr. 18, 2025), Patent Owner email to Petitioner about source code review.
1016	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , 1:24-cv-00028, (D. Del. Apr. 4, 2025), Petitioner’s brief in support of its motion to stay.
1017	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , 1:24-cv-00028, (D. Del. Apr. 21, 2025), Patent Owner’s opposition to Petitioner’s motion to stay.
1018	Email from the PTAB to Petitioner authorizing the filing of a <i>Sotera</i> stipulation in this IPR (Mar. 10, 2025).
1019	Excerpt from the file history of Patent Owner’s U.S. Patent No. 9,319,615, disclaiming the patent’s entire term (Apr. 7, 2025).

Exhibit No.	Description
1020	<i>NL Giken Inc. v. Amazon.com, Inc.</i> , 1:24-cv-00028, (D. Del. Nov. 15, 2024), Petitioner’s invalidity claim charts for the ’391 patent based on Hisamune and Massive prior art references.
1021	Settlement Agreement.

I. INTRODUCTION

Pursuant to 37 C.F.R. §42.71(a), Petitioner, collectively Amazon.com Inc., Amazon.com Services LLC, Amazon Web Services, Inc., and Twitch Interactive, Inc., and Patent Owner NL Giken jointly request termination of the *Inter Partes* Review of U.S. Patent No. 8,677,391 (the “’391 Patent) in IPR2025-00407. On May 30, 2025, the Parties informed the Board of a settlement agreement between Petitioner and Patent Owner via email and requested authorization to file a Joint Motion to Terminate the proceedings with respect to both the Patent Owner and the Petitioner. As set forth in an email dated June 2, 2025, the Board authorized the filing of the requested Joint Motion to Terminate. Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

II. ARGUMENT

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

A. Brief Explanation as to Why Termination is Appropriate

Petitioner and Patent Owner have entered into a written confidential settlement agreement that fully resolves this matter. The Parties are concurrently filing a copy of the settlement agreement as Exhibit 1021 along with a request to treat it as business confidential information pursuant to 35 U.S.C. § 317(b). Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge, as of the filing of this Motion and the concurrent Motion to Keep Confidential, that Exhibit 1021 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1021 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding. The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

The Parties “may terminate the proceeding...unless the Board has already decided the merits of the proceeding.” Consolidated Office Patent Trial Practice Guide, at 4 (November 2019). This proceeding is still in its early stages as the parties are still awaiting the institution decision, which is due July 29, 2025. The Parties have now settled their dispute and have reached agreement to terminate the Petition. Termination is appropriate because public policy favors terminating the present petition for *inter partes* review. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *Delta Air Lines*,

Inc. v. August, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). The Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Office Patent Trial Practice Guide, at 86 (Nov. 2019).

B. Identification of Parties and Status of Litigation

The ’391 Patent is subject to the following actions:

- *NL Giken Inc. v. Amazon.com, Inc.*, No. 1:24-cv-00028 (D. Del.).

C. Identification and Status of Related Proceedings Before the USPTO

Petitioner has not filed any further Petition for *Inter Partes* Review related to the ’391 Patent. The institution decision in IPR2025-00407 is the next deadline in this proceeding and is due on July 29, 2025.

Date: June 3, 2025

By: /s/ Jennifer Librach Nall
Jennifer Librach Nall
Reg. No. 57,053
Counsel for Petitioner

By: /s/ Gerald B. Hrycyszyn
Gerald B. Hrycyszyn
Reg. No. 50,474
Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§42.6(e) and 42.105 that on June 3, 2025, a true and correct copy of the Joint Motion to Terminate *Inter Partes* Review of U.S. Patent No. 8,677,391 in connection with IPR2025-00407 was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

James Morris - James.Morris@WolfGreenfield.com

A courtesy copy was sent to the below counsel via electronic mail:

WGS-NLGikenv.Amazon@WolfGreenfield.com

Respectfully submitted,

Date: June 3, 2025

By: /s/ Jennifer Librach Nall
Jennifer Librach Nall
Reg. No. 57,053
Counsel for Petitioner