

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NINTENDO CO., LTD., and NINTENDO OF AMERICA INC.,
Petitioners,

v.

ANCORA TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2021-01338
U.S. Patent No. 6,411,941 B1

**UNOPPOSED MOTION TO STAY *EX PARTE* REEXAMINATION OF
U.S. PATENT NO. 6,411,941**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

I. BRIEF STATEMENT OF RELIEF REQUESTED

In response to the Board’s email of March 25, 2022, Patent Owner Ancora Technologies, Inc. (“Ancora” or “Patent Owner”) requests the Board to stay the *ex parte* reexamination (control no. 90/014,865) of U.S. Patent No. 6,411,941 (“the ’941 patent”), pending resolution of this *inter partes* review of the ’941 patent. Petitioner Nintendo Co., Ltd., and Nintendo of America Inc. (collectively “Nintendo” or “Petitioner”) and Requestor, through its counsel, do not oppose this motion.

II. STATEMENT OF MATERIAL FACTS

Each of the challenges discussed herein arises out of litigation filed by Ancora for infringement of the ’941 patent. Ancora filed a complaint against Nintendo Co., Ltd. in the Western District of Texas on July 16, 2021, asserting the ’941 patent. *See Ancora Technologies, Inc. v. Nintendo Co., Ltd.*, No. 6:21-cv-00738 (W.D. Tex.). On the same day, Ancora filed a complaint against Roku and Vizio, also in the Western District of Texas, also asserting the ’941 patent. *See Ancora Technologies, Inc. v. VIZIO, Inc.*, No. 6:21-cv-00739 (W.D. Tex.); *Ancora Technologies, Inc. v. Roku, Inc.*, No. 6:21-cv-00737 (W.D. Tex.). A third case, between Ancora and HTC Corp., remains pending and is related as discussed below.

Ancora sued HTC for infringement of the ’941 patent on December 15, 2016. As discussed below, Ancora believes the ’865 reexamination request is the latest of

IPR2021-01338: Unopposed Motion to Stay *Ex Parte* Reexamination

many challenges lodged at the USPTO by HTC. HTC filed a petition for CBM review on May 26, 2017, asserting the '941 patent was invalid under § 101 for lack of patentable subject matter, under § 112 for indefiniteness and lack of written description, and under § 103 for obviousness over European Patent Application Publication No. EP0766165 to Hasebe, in view of Desktop Management BIOS Specification Version 2.0 (Mar. 6, 1996). *HTC Corp. v. Ancora Techs. Inc.*, Case No. CBM2017-00054, Paper 1 (PTAB May 26, 2017). The Board denied institution of HTC's petition, noting that the '941 patent was not a covered business method patent because it disclosed a technical solution—i.e., storing a license record in the nonvolatile BIOS memory. *HTC*, CBM2017-00054, Paper 7 (PTAB Dec. 1, 2017). Subsequently, on February 19, 2021 HTC filed an IPR petition asserting the same art against the same claims as are challenged here. *HTC Corp. v. Ancora Techs. Inc.*, IPR2021-00570, Paper 1 (PTAB Feb. 19, 2021). Like this case and the '865 reexamination request, discussed below, HTC's petition in IPR2021-00570 asserted the same art against the same claims as was previously asserted in IPR2020-01609. The Board exercised its discretion to deny HTC's petition as an improper follow-on petition under the *General Plastic* factors. *HTC*, IPR2021-00570, Paper 17 (PTAB June 10, 2021).

A. Facts Relating to IPR2021-01338

Nintendo filed its IPR petition in this matter on August 10, 2021, asserting the same art against the same claims as was previously asserted in IPR2020-01609. Specifically, Nintendo’s IPR petition asserts two grounds. First: that claims 1–2, 11, and 13 of the ’941 patent would have been obvious under 35 U.S.C. § 103 over U.S. Patent No. 4,658,093 to Hellman et al. (hereinafter “Hellman”) in view of U.S. Patent No. 5,892,906 to Chou (hereinafter “Chou”). (Pet. at 7.) Second: that claims 1–3, 6–14, and 16 of the ’941 patent would have been obvious under 35 U.S.C. § 103 over Hellman in view of Chou and further in view of U.S. Patent No. 5,933,498 to Schneck (hereinafter “Schneck”). (*Id.*) Nintendo’s IPR petition is supported by the declaration of Dr. Andrew Wolfe. (*Id.*; *see also* Ex. 1003.)

B. Facts Relating to IPR2021-01406

Roku and Vizio filed the IPR petition in IPR2021-01406 on August 24, 2021, also asserting the same art in the same combinations against the same claims as was previously asserted in IPR2020-01609. *Roku, Inc. v. Ancora Techs. Inc.*, IPR2021-01406, Paper 3 at 8 (Aug. 24, 2021). The grounds asserted in the Roku/Vizio IPR petition are supported by the same declarant, Dr. Andrew Wolfe. *Id.*; *see also* IPR2021-01406, Ex. 1003. The Roku/Vizio IPR petition notes that “Dr. Wolfe submitted a substantively similar supporting declaration in . . . Nintendo’s IPR against the ’941 Patent.” *Id.*

C. Facts Relating to Reexamination No. 90/014,865

Reexamination No. 90/014,865 was filed by litigation counsel for HTC Corp. and HTC America, Inc. (hereinafter “HTC”) on September 21, 2021, also asserting the same art against the same claims as was previously asserted in IPR2020-01609. (Ex. 2018 at 2.) The ’865 reexamination request challenges the same claims 1–3, 6–14, and 16 of the ’941 patent as Nintendo’s IPR petition. (*Id.*) The ’865 reexamination request asserts identical grounds as this IPR: First: that claims 1–2, 11, and 13 of the ’941 patent would have been obvious under 35 U.S.C. § 103 over Hellman in view of Chou. (*Id.* at 21.) Second: that claims 1–3, 6–14, and 16 of the ’941 patent would have been obvious under 35 U.S.C. § 103 over Hellman in view of Chou and further in view of Schneck. (*Id.* at 29.) The ’865 reexamination request is supported by yet another declaration from Dr. Andrew Wolfe. (*Id.* at 6.) Reexamination has been ordered, and the Examiner issued a non-final office action on March 11, 2022, rejecting the challenged claims on the same grounds raised in the Request. Patent Owner’s response to the non-final office action is due May 11, 2022.

III. FULL STATEMENT OF THE REASONS FOR STAY

Under 35 U.S.C. § 315(d), “if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for

stay, transfer, consolidation, or termination of any such matter or proceeding.” 35 U.S.C. § 315(d); *see also* 37 C.F.R. §§ 42.122(a), 42.3(a). In determining whether to grant a stay of a pending reexamination proceeding, the Board considers several factors including: (1) whether claim amendments in one proceeding could interfere with another proceeding; (2) whether the proceedings include common issues, such that conducting the proceedings concurrently would result in an inefficient use of Office resources or produce inconsistent results; and (3) whether an IPR proceeding could result in a decision on the merits before a final decision in a reexamination, simplifying the issues remaining in the reexamination proceeding. *See, e.g., Goertek, Inc. v. Knowles Elecs., LLC*, IPR2013-00614, Paper 11 at 3 (Nov. 13, 2013). The issues involved in the IPR2021-01338, IPR2021-01406, and ’865 reexamination proceedings warrant granting a stay of the ’865 reexamination.

Amendments are not possible in the ’865 reexamination, because the ’941 patent has expired. *See* 35 C.F.R. § 1.530(j) (“No amendments may be proposed for entry in an expired patent.”). Nevertheless, allowing the ’865 reexamination to proceed would result in inefficient use of the Office’s resources and could produce inconsistent results in the three proceedings. The proceedings include identical issues, with the exact same grounds asserted against the ’941 patent in the ’865 reexamination and each of the two pending IPRs, IPR2021-01338 and IPR2021-01406. In all three matters, claims 1–2, 11, and 13 of the ’941 patent are asserted to

IPR2021-01338: Unopposed Motion to Stay *Ex Parte* Reexamination

have been obvious under 35 U.S.C. § 103 over Hellman in view of Chou, and claims 1–3, 6–14, and 16 of the '941 patent are asserted to have been obvious under 35 U.S.C. § 103 over Hellman in view of Chou and further in view of Schneck. The '865 reexamination request and the IPR petitions filed in each of IPR2021-01338 and IPR2021-01406 are all substantively the same as the IPR petition filed by TCT in IPR2020-01609. Further, each of the challengers in these matters relies on a declaration from Dr. Andrew Wolfe, which is substantively the same as the declaration he filed in IPR2020-01609. Given the complete overlap of prior art and issues, the Office's Central Reexamination Unit and the Board may reach contrasting positions, at different stages of the proceedings in connection with interpretations of the claims, the prior art, or other issues, producing inconsistent results. At minimum, conducting the '865 reexamination concurrently with the IPR2021-01338 and/or IPR2021-01406 proceedings would result in an inefficient use of Office resources.

The Board's final determination in the IPR2021-01338 and IPR2021-01406 proceedings will simplify issues in the '865 reexamination and is likely to precede conclusion of the '865 reexamination. The Board has already decided to institute the two IPR proceedings. In IPR2021-01338 the Board's final determination must issue before January 27, 2023. *See* 35 U.S.C. § 316(a)(11) (requiring final decision within 12 months of institution decision). Similarly, in IPR2021-01406 the Board's final determination must issue before February 22, 2023. *Id.* For reexaminations, USPTO

statistics indicate average overall pendency is 25.7 months. USPTO Comm’r for Patents, *Ex Parte* Reexamination Filing Data (Sep. 30, 2020), available at <https://www.uspto.gov/learning-and-resources/statistics/reexamination-information>. The ’865 reexamination, in which the request was filed on September 21, 2021, is therefore not likely to conclude before October of 2023—many months after a final written decision issues in either of the IPR proceedings. In short, any final written decision issued by the Board in the IPR2013-00567 and/or IPR2013-00568 proceedings will precede any final decision in the ’865 reexamination. Staying the ’865 reexamination, therefore, would most likely simplify the issues remaining in that proceeding based on the Board’s decision(s) in the IPR matters.

IV. CONCLUSION

For at least the reasons set forth above, Patent Owner requests that the Board stay the ’865 reexamination until the IPR2021-01338 and IPR2021-01406 proceedings are completed, whether by final written decision or other mechanisms provided for by the Rules. As noted, Patent Owner has conferred with counsel for Petitioners in IPR2021-01338 and IPR2021-01406, and with counsel for the Requestor in the ’865 reexamination. These parties do not oppose the requested stay.

Respectfully submitted,
FITCH EVEN TABIN & FLANNERY LLP

Dated: April 1, 2022

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on April 1, 2022, a complete and entire copy of Ancora's Unopposed Motion to Stay *Ex Parte* Reexamination was served via electronic mail, on Requestor's counsel in Reexamination No. 90/014,865 at irfan.lateef@knobbe.com, and on Petitioner's counsel in IPR2021-01338 at PerkinsService-Nintendo-Ancora-IPR@perkinscoie.com and at the electronic mail addresses below:

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