

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NINTENDO CO., LTD., and NINTENDO OF AMERICA INC.,
Petitioner for IPR2021-01338,
ROKU, INC. and VIZIO, INC.,
Petitioner for IPR2021-01406

v.

ANCORA TECHNOLOGIES, INC.,
Patent Owner.

IPR2021-01338; IPR2021-01406¹
Patent 6,411,941 B1

Before THU A. DANG, JONI Y. CHANG, and KEVIN W. CHERRY,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

DECISION

Dismissing Joint Motions to Consolidate as Moot
Granting Requests for Changing Oral Hearing Date and Due Dates
35 U.S.C. § 315(d); 37 C.F.R. §§ 42.5 and 42.71

¹ This Decision applies to each of the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this heading style in any subsequent papers.

I. INTRODUCTION

Nintendo Co., Ltd. and Nintendo of America Inc. (collectively, “Nintendo”) filed a Petition requesting an *inter partes* review (“IPR”) of claims 1–3, 6–14, and 16 (“the challenged claims”) of U.S. Patent No. 6,411,941 B1 (Ex. 1001, “the ’941 patent”) in IPR2021-01338 (“the ’1338 IPR”). Paper 1², 6. Ancora Technologies, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7). On January 27, 2022, we instituted the instant IPR as to all of the challenged claims and all of the grounds asserted in the Petition. Paper 9 (“Dec.”). On February 22, 2022, we also instituted an IPR as to the same claims and the same grounds in IPR2021-01406 (“the ’1406 IPR”) based on a Petition filed by Roku, Inc. and VIZIO, Inc. (collectively, “Roku”). IPR2021-01406, Paper 10 (Institution Decision).

On April 1, 2022, Patent Owner, Nintendo, and Roku filed a Joint Motion to Consolidate the ’1338 IPR and the ’1406 IPR in each case.³ Paper 17 (“Mot.”). On April 28, 2022, we held a conference call with the parties for both IPRs to seek clarifications regarding their Joint Motions.

For the reasons discussed below, we dismiss the parties’ Joint Motions to Consolidate as moot, and we grant the parties’ requests to align the trial schedules for both IPRs.

² We cite to the record in IPR2021-01338, unless otherwise noted.

³ Both Joint Motions are substantively the same. *Comparing* Paper 17, with IPR2021-01406, Paper 17.

II. ANALYSIS

The Director has authority to consolidate proceedings pursuant to 35 U.S.C. § 315(d), which states:

(d) Multiple Proceedings.—Notwithstanding sections 135(a), 251, and 252 and chapter 30, during the pendency of an inter partes, 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).

In their Motions, the parties for both proceedings indicate that they agree that a single deposition for each expert will be shared between both IPRs. Mot. 3. During the conference call, we explained that, even without a consolidation of the proceedings, the parties may agree to sharing a single deposition for each expert between both IPRs. Therefore, consolidating the proceedings is not necessary for sharing depositions between the IPRs.

In their Motions, the parties also indicate that: (1) “the parties anticipate filing separate papers for each matter”; (2) “[t]he parties further agree that separate counsel for Petitioners will have the opportunity to argue, to address differences between the respective matter”; and (3) “[t]he parties will seek additional time for each side beyond normal limits and the Petitioners will share the time allocated for their side.” Mot. 4.

Under that scenario, it appears that Nintendo and Roku, as Petitioner for a consolidated proceeding, may not necessarily speak with a uniform voice, as they may not share the same position on any issue. Indeed, during

the conference call, Nintendo and Roku confirmed that, for example, they do not share the same claim construction position for certain claim terms.

An IPR is not like a trial in the district court. For efficiency, we generally consolidate proceedings under 35 U.S.C. § 315(d) with the same petitioner, providing a single Final Written Decision to resolve the issues between the petitioner and patent owner. *See, e.g., Nevro Corp. v. Boston Sci. Neuromodulation Corp.*, IPR2017-01812, Paper 79 at 2 (PTAB Feb. 1, 2019). According to 37 C.F.R. § 42.2, “Petitioner” means “the party filing a petition requesting that a trial be instituted.” In an IPR, the separate companies, who filed the petition, constitute and stand in the shoes of a single “Petitioner.” Because those companies constitute collectively a single party, they speak with a single voice, both in writing and oral representation. *See, e.g., Agilysys, Inc. v. Ameranth, Inc.*, CBM2014-00014, Paper 11, 3 (PTAB Feb. 11, 2014); *505 Games, Inc. v. Babbage Holdings, Inc.*, IPR2014-00954, Paper 17 at 2 (PTAB Aug. 22, 2014); *Cradlepoint, Inc. v. 3G Licensing S.A.*, IPR2021-00639, Paper 12 at 2 (PTAB May 13, 2021).

Here, Nintendo and Roku do not agree to consolidated filings or oral arguments for the proposed consolidated proceeding. Mot. 4. During the conference call, we explained that, under that scenario, we would need to maintain two separate file records and render two separate Final Written Decisions for clarity. Such a consolidation would not provide efficiency.

During the conference call, the parties alternatively requested to align the trial schedules for both IPRs. Mot. 4–5. The parties’ proposed schedule would not impact our ability to complete these trials within one year from institution, as required by 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

For example, the parties' proposed schedule would move the '1406 IPR's oral hearing date from November 10, 2022 to October 3, 2022, the same oral hearing date for the '1338 IPR. As such, we grant the parties' request to align the trial schedules for both IPRs in lieu of consolidating the IPRs. We dismiss as moot the parties' Joint Motions to Consolidate the proceedings.

As to aligning the trial schedules, the parties' proposed schedule⁴ would change the '1338 IPR's Due Dates 1–4 for filing Patent Owner Response, Petitioner's Reply, Patent Owner's Sur-reply, and Requests for Oral Hearing. *Id.* The '1338 IPR's Scheduling Order already allows Nintendo and Patent Owner to stipulate to different dates for Due Dates 1–3. Paper 10, 7. We authorize Nintendo and Patent Owner to stipulate to a different date for Due Date 4 (earlier or later, but no later than Due Date 5).

The parties' proposed schedule also would change the '1406 IPR's Due Dates 4–8. Mot. 4–5. The '1406 IPR's Scheduling Order already allows Roku and Patent Owner to stipulate to different dates for Due Dates 5 and 6. IPR2021-01406, Paper 11, 7. We authorize Roku and Patent Owner to stipulate to different dates for Due Date 4 (earlier or later, but no later than Due Date 5) and Due Date 7 (earlier or later, but no later than 1 week before the Oral Hearing). Also, as the parties proposed, the '1406 IPR's Due Date 8 for Oral Hearing will be moved to October 3, 2022. Mot. 5.

⁴ Because the '941 patent has expired, the parties' proposed schedule does not affect the Due Dates for filing a Motion to Amend, Opposition to a Motion to Amend, or Reply to the Opposition.

III. CONCLUSION

For the foregoing reasons, we dismiss the parties' Joint Motions to Consolidate as moot, and we grant the parties' requests to align the trial schedules for both IPRs.

IV. ORDER

Accordingly, it is

ORDERED that parties' Joint Motions to Consolidate IPR2021-01338 and IPR2021-01406 are *dismissed as moot*;

FURTHER ORDERED that the parties' requests to align the trial schedules for both IPR2021-01338 and IPR2021-01406 are *granted*, as provided in this Order;

FURTHER ORDERED that, in IPR2021-01338, Nintendo and Patent Owner may stipulate to a different date for Due Date 4 (earlier or later, but no later than Due Date 5);

FURTHER ORDERED that, in IPR2021-01406, Roku and Patent Owner may stipulate to different dates for Due Date 4 (earlier or later, but no later than Due Date 5) and Due Date 7 (earlier or later, but no later than 1 week before the Oral Hearing); and

FURTHER ORDERED that, in IPR2021-01406, Due Date 8 for Oral Hearing (if requested) is set to October 3, 2022.

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PETITIONER NINTENDO:

Jerry Riedinger
Jose Villarreal
Kyle Canavera
Tara Kurtis
PERKINS COIE LLP
riedinger-ptab@perkinscoie.com
villareal-ptab@perkinscoie.com
canavera-ptab@perkinscoie.com
kurtis-ptab@perkinscoie.com

PETITIONER ROKU:

Jon Wright
Lestin Kenton
Dohm Chankong
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
jwright-PTAB@sternekessler.com
lkenton-PTAB@sternekessler.com
dchankong-PTAB@sternekessler.com
PTAB@sternekessler.com

PATENT OWNER:

David Gosse
Nicholas Peters
Karen Wang
FITCH, EVEN, TABIN & FLANNERY LLP
dgosse@fitcheven.com
ntpete@fitcheven.com
kwang@fitcheven.com