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Paper 17
Date: June 10, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and HTC AMERICA, INC.,
Petitioner,

v.

ANCORA TECHNOLOGIES, INC.,
Patent Owner.

IPR2021-00570
Patent 6,411,941 B1

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

CHANG, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

Denying Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

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I. INTRODUCTION

HTC Corporation and HTC America, Inc. (collectively, "Petitioner" or "Petitioner HTC") 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"). Paper 1 ("Pet."). Petitioner HTC also filed a Motion for Joinder (Paper 3, "Mot."), seeking to join as a party to *TCT Mobile (US) Inc. v. Ancora Technologies, Inc.*, IPR2020-01609 (the "TCT IPR"), and a Reply (Paper 10, "Reply"). Ancora Technologies, Inc. ("Patent Owner") filed an Opposition to Petitioner HTC's Motion for Joinder (Paper 9, "Opp."), a Sur-reply (Paper 15, "Sur-reply"), and a Preliminary Response (Paper 16, "Prelim. Resp."). For reasons discussed below, we do not institute an *inter partes* review of the challenged claims and deny the Motion for Joinder.

A. Related Matters

The parties indicate that the '941 patent is involved in the following district court proceedings: *Ancora Technologies, Inc. v. TCT Mobile (US) Inc.*, No. 8:19-cv-02192 (C.D. Cal.); *Ancora Technologies, Inc. v. Lenovo Group Limited*, No. 1:19-cv-01712 (D. Del.); *Ancora Technologies, Inc. v. Sony Corp.*, No. 1:19-cv-01703 (D. Del.); *Ancora Technologies, Inc. v. LG Electronics, Inc.*, No. 1:20-cv-00034 (W.D. Tex.); *Ancora Technologies, Inc. v. Samsung Electronics Co.*, No. 6:19-cv-00385 (W.D. Tex.); *Ancora Technologies, Inc. v. HTC America, Inc.*, No. 2:16-cv-01919 (W.D. Wash.); and *Ancora Technologies, Inc. v. Apple Inc.*, No. 2:10-cv-10045-AG-MLG (N.D. Cal.) (the "Ancora v. Apple case"). Pet. 3−4; Paper 4, 1−2.

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The ’941 patent also was involved in *ex parte* Reexamination No. 90/010,560. Ex. 1001, 8−9 (*Ex Parte* Reexamination Certificate issued on June 1, 2010, confirming the patentability of claims 1−19 and indicating that no amendments have been made to the patent).

In addition, the ’941 patent was involved in the following proceedings: *Apple Inc. v. Ancora Technologies, Inc.*, CBM2016-00023 (Institution Denied); *HTC America, Inc. v. Ancora Technologies, Inc.*, CBM2017-00054 (Institution Denied); *Samsung Electronics Co. v. Ancora Technologies, Inc.*, IPR2020-01184 (Institution Denied).

The ’941 patent is currently involved in the following: *TCT Mobile (US) Inc. v. Ancora Technologies, Inc.*, IPR2020-01609; *LG Electronics, Inc. v. Ancora Technologies, Inc.*, IPR2021-00581; *Samsung Electronics Co. v. Ancora Technologies, Inc.*, IPR2021-00583; and *Sony mobile Communications AB v. Ancora Technologies, Inc.*, IPR2021-00663.

B. The ’941 patent

The ’941 patent discloses a method of restricting software operation within a license limitation that is applicable for a computer having a first non-volatile memory area, a second non-volatile memory area, and a volatile memory area. Ex. 1001, code (57). According to the ’941 patent, the method includes the steps of selecting a program residing in the volatile memory, setting up a verification structure in the non-volatile memories, verifying the program using the structure, and acting on the program according to the verification. *Id.*

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Figure 1 of the ’941 patent is reproduced below.

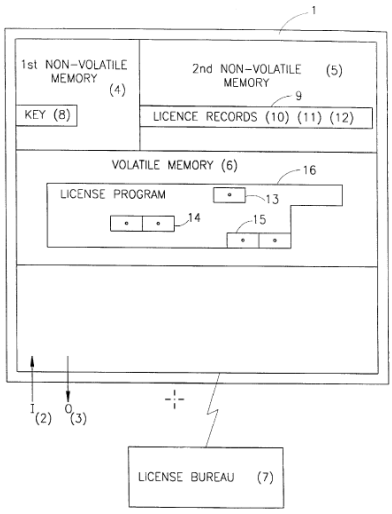

Figure 1 above shows a schematic diagram of computer processor 1 and license bureau 7. *Id*. at 5:9−19. Computer processor 1 is associated with input operations 2 and output operations 3. *Id*. Computer processor 1 contains first non-volatile memory area 4 (e.g., the ROM section of the Basic Input / Output System (“BIOS”)), second non-volatile memory area 5 (e.g., the E^2PROM section of the BIOS), and volatile memory area 6 (e.g., the internal RAM memory of the computer). *Id*.

C. Illustrative Claim

Of the challenged claims, only claim 1 is independent. Claims 2, 3, 6−14, and 16 directly or indirectly depend from claim 1. Claim 1 is illustrative:

> 1. A method of restricting software operation within a license for use with a computer including an erasable, non-volatile memory area of a BIOS of the computer, and a volatile memory area; the method comprising the steps of:
>
> selecting a program residing in the volatile memory,

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> using an agent to set up a verification structure in the erasable, non-volatile memory of the BIOS, the verification structure accommodating data that includes at least one license record,
>
> verifying the program using at least the verification structure from the erasable non-volatile memory of the BIOS, and
>
> acting on the program according to the verification.

Ex. 1001, 6:59:67–7:4.

D. Prior Art Relied Upon

Petitioner HTC relies upon the references listed below (Pet. 5):

Reference	**Issue Date**	**Exhibit No.**
Hellman, U.S. Patent No. 4,658,093	Apr. 14, 1987	Ex. 1004
Chou, U.S. Patent No. 5,892,906	Apr. 6, 1999	Ex. 1005
Schneck, U.S. Patent No. 5,933,498	Aug. 3, 1999	Ex. 1006

E. Asserted Grounds of Unpatentability

Petitioner HTC asserts the following grounds of unpatentability:

Claims Challenged	**35 U.S.C. §**[1]	**References**
1, 2, 11, 13	103(a)	Hellman, Chou
1−3, 6−14, 16	103(a)	Hellman, Chou, Schneck

[1] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the '941 patent was filed before March 16, 2013, the effective date of the relevant amendment, the pre-AIA version of § 103 applies.

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