

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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

v.

ANCORA TECHNOLOGIES, INC.,  
Patent Owner.

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

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**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

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