

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

JOINT MOTION TO CONSOLIDATE IPR2021-01338 AND IPR2021-01406

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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 on March 25, 2022, Patent Owner Ancora Technologies, Inc. (“Ancora” or “Patent Owner”), Petitioners Nintendo Co., Ltd., and Nintendo of America Inc. (collectively “Nintendo”) and Petitioners Roku, Inc. and Vizio, Inc. (collectively “Roku/Vizio” and jointly with Nintendo “Petitioners”) jointly request the Board to consolidate certain aspects of IPR2021-01338 and IPR2021-01406, both of which challenge U.S. Patent No. 6,411,941 (“the ’941 Patent”).

II. STATEMENT OF MATERIAL FACTS

Each of the matters 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.).

Both IPR2021-01338 and IPR2021-01406 assert the same grounds against the same claims as were previously asserted by petitioner TCT Mobile in IPR2020-01609, as discussed below.

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.*

III. PROPOSED CONSOLIDATION

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). The significant overlap of issues in IPR2021-01338 and IPR2021-01406 warrants consolidation of these matters for efficiency and fairness. As noted above, IPR2021-01338 and IPR2021-01406 involve identical grounds asserted against the same claims of the ’941 patent. Both petitions are supported by substantively identical declarations submitted by Dr. Andrew Wolfe. Ancora intends to use a single expert for both matters, and expects differences between the arguments and issues in the two IPRs to be minimal.

The Parties have conferred and jointly propose the following alignment of these two matters, in the interest of fairness and efficiency. First, the parties agree that it would be inefficient and unfair to hold separate expert depositions for the two matters. The parties therefore agree that a single deposition for each expert will be shared between the two IPRs. In view of the minor differences between the declarations for each matter and to allow counsel for both parties the opportunity to question the witness, the parties agree that each deposition will run a maximum of

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nine hours of deposition time on the clock. The parties agree that this time may be spread across more than one day.

Second, the parties anticipate filing separate papers for each matter.

Third, the parties agree that a single oral hearing (if held) will encompass all issues for both proceedings. The parties further agree that separate counsel for Petitioners will have the opportunity to argue, to address differences between the respective matters. The parties will seek additional time for each side beyond normal limits and the Petitioners will share the time allocated for their side.

Fourth, the parties propose the following consolidated schedule, to accommodate discovery and align the oral hearings in each matter. Patent Owner Ancora will not file a motion to amend the '941 patent, which allows for some compression in the proposed schedule:

		Existing Dates for IPR2021-01338 (Nintendo)	Existing Dates for IPR2021-01406 (Roku/VIZIO)	Dates Sought for Consolidated Proceeding
Due Date 1	P.O. Response	April 7, 2022	May 3, 2022	May 3, 2022
Due Date 2	Pet. Reply	June 16, 2022	July 12, 2022	July 12, 2022
Due Date 3	P.O. Sur-Reply	July 25, 2022	August 19, 2022	August 19, 2022
Due Date 4	Request Oral Hearing	August 15, 2022	September 9, 2022	August 22, 2022

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