

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

ANCORA TECHNOLOGIES, INC.,
Patent Owner.

IPR2021-01338
Patent 6,411,941 B1

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

CHANG, *Administrative Patent Judge.*

DECISION

Granting Motion to Stay Reexamination Control No. 90/014,865
35 U.S.C. § 315(d); 37 C.F.R. § 42.122(a)

I. INTRODUCTION

Nintendo Co., Ltd. and Nintendo of America Inc. (collectively, “Petitioner”) 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.”), 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. IPR2021-01406, Paper 9 (Institution Decision).

On April 1, 2020, Patent Owner filed a Motion to Stay Reexamination Control No. 90/014,865 (“the ’865 reexamination”) of the ’941 patent, pending resolution of the instant IPR and the ’1406 IPR. Paper 16 (“Mot.”), 7. In its Motion, Patent Owner indicates that Petitioners of both IPRs and Requestor of the ’865 reexamination do not oppose this Motion. *Id.* For the reasons discussed below, we determine that it is appropriate to stay the ’865 reexamination, pending resolution of the instant IPR and the ’1406 IPR.

II. ANALYSIS

The Director has authority to stay a reexamination proceeding 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).

Consistent with 35 U.S.C. § 315(d), the Board may enter an order staying a reexamination proceeding pursuant to 37 C.F.R. § 42.122(a), which states:

(d) *Multiple Proceedings*. Where another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including for the stay, transfer, consolidation, or termination of any such matter.

37 C.F.R. § 42.122(a); *see also* 37 C.F.R. § 42.3(a) (permitting the Board to exercise exclusive jurisdiction within the Office over an involved patent during the proceeding). The Board considers several factors when deciding whether to stay a co-pending reexamination, including:

1. whether the claims challenged in the IPR are the same as or depend directly or indirectly from claims at issue in the reexamination;
2. whether the same grounds of unpatentability or the same prior art are at issue in both the IPR and the reexamination;
3. whether simultaneous conducting the reexamination and IPR will duplicate efforts within the Office;
4. whether the reexamination could result in inconsistent results between proceedings;
5. whether amending the claim scope in one proceeding would affect the claim scope in another proceeding;
6. the respective timeline and stage of each proceeding;
7. the statutory deadlines of the reexamination and IPR; and

8. whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16654, 16,657 (Apr. 22, 2019).

We have considered Patent Owner's Motion in light of the factors identified above. For the reasons discussed below, we find that Patent Owner has shown that good cause exists to stay the '865 reexamination, pending resolution of the instant IPR and the '1406 IPR.

As to Factor 1, Patent Owner indicates that the '865 reexamination involves the same claims as the instant IPR and the '1406 IPR—claims 1–3, 6–14, and 16 of the '941 patent. Mot. 4. We agree with Patent Owner. Ex. 3001, 10 (Order Granting Request for *Ex Parte* Reexamination entered on November 17, 2021 in the '865 reexamination); Ex. 3002, 2 (Non-Final Office Action entered on March 11, 2022 in the '865 reexamination); Pet. 6; Dec. 2; IPR2021-01406, Paper 9, 2. Therefore, we find Factor 1 favors staying the '865 reexamination.

Regarding Factor 2, Patent Owner indicates that the '865 reexamination asserts identical grounds and prior art as the instant IPR and the '1406 IPR—(1) claims 1–2, 11, and 13 are unpatentable under § 103(a) as obvious over Hellman¹ and Chou²; and (2) claims 1–3, 6–14, and 16 are

¹ U.S. Patent No. 4,658,093 issued on April 14, 1987 (Ex. 1004).

² U.S. Patent No. 5,892,906 issued on April 16, 1999 (Ex. 1005).

unpatentable under § 103(a) as obvious over Hellman, Chou, and Schenck³. Mot. 4. We agree with Patent Owner. Ex. 3001, 10; Ex. 3002, 4, 7; Pet. 7; Dec. 33; IPR2021-01406, Paper 9, 33. Therefore, we find Factor 2 favors staying the '865 reexamination.

For Factor 3, Patent Owner argues that, given the complete overlap of prior art and issues, conducting the '865 reexamination concurrently with the instant IPR and the '1406 IPR would result in an inefficient use of the Office resources. Mot. 6. We agree with Patent Owner and find Factor 3 favors staying the '865 reexamination.

Regarding Factor 4, Patent Owner argues that, given the complete overlap of prior art and issues, the Office's Central Reexamination Unit ("CRU") 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." *Id.* at 5–6. We agree with Patent Owner and find Factor 4 favors staying the '865 reexamination.

As to Factor 5, Patent Owner indicates that amendments are not possible in the '865 reexamination because the '941 patent has expired. *Id.* at 5; Ex. 1001, code (22) (The application issued as the '941 patent was filed on October 1, 1998). Patent Owner also is not permitted to amend the claims of the '941 patent in the instant IPR and the '1406 IPR because the '941 patent has expired. We find Factor 5 weighs against a stay because there is no risk of a claim amendment in one proceeding affecting claim scope in another proceeding.

³ U.S. Patent No. 5,933,498 issued on August 3, 1999 (Ex. 1006).

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