

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.

U.S. Patent No. 6,411,941 B1

Case No.: IPR2021-01338

**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION
FOR *INTER PARTES* REVIEW UNDER 37 C.F.R. § 42.107**

TABLE OF CONTENTS

| | |
|--|-----|
| Table of Authorities | iii |
| List of Exhibits | vi |
| I. Introduction | 1 |
| II. Standard for Granting <i>Inter Partes</i> Review | 3 |
| III. Overview of the '941 Patent | 4 |
| A. The Key Innovation of the '941 Patent Is Use of an OS-Level Software Agent To Interact With BIOS Memory Without Requiring Additional or Specialized Hardware | 4 |
| 1. The Patentee Disclaimed Methods Requiring Use of Additional Hardware | 6 |
| 2. Another “Key Distinction” Over the Prior Art Was Using an OS-Level Software Agent to Store Verification Structures and License Records in BIOS Memory..... | 8 |
| B. The '941 Patent Has Survived Four Separate Challenges to Its Validity and Patentability..... | 12 |
| C. Recent IPRs That Were Instituted (But Terminated) Based on Hellman and Chou Did Not Address Key Claim Construction Issues | 14 |
| IV. Claim Construction | 15 |
| A. “a computer” | 17 |
| B. “using an agent to set up a verification structure in the erasable, non-volatile memory of the BIOS” | 20 |
| 1. “agent” | 20 |
| 2. “to set up a verification structure” | 31 |
| 3. “memory of the BIOS” | 35 |
| V. The Asserted Prior Art | 40 |
| A. Hellman | 40 |
| B. Chou | 44 |
| C. Schneck | 47 |
| VI. The Asserted Combinations Fails To Disclose Key Elements of Claim 1 of the '941 Patent | 48 |
| A. The Only “Agent” Petitioner Identifies is Hellman’s “Update Unit 36,” which Requires “Add-on Hardware” and Thus Fails to Disclose the “Using an Agent...” Limitation..... | 48 |

| | | |
|------|---|----|
| B. | Petitioner’s Proposed Combination Does Not “Set Up A Verification Structure” and Petitioner Fails to Disclose How it is “Set Up” by the “Agent” | 52 |
| C. | The Proposed Combination Fails to Teach Using “Memory of the BIOS” for Storing a “Verification Structure” or “License Record” .. | 57 |
| D. | Petitioner Does Not Assert That Schneck Discloses Either Claim 1 Limitation at Issue | 63 |
| VII. | Conclusion | 64 |
| | Certificate of Service | 65 |
| | Certificate of Compliance Pursuant to 37 C.F.R. §42.24..... | 67 |

Table of Authorities

Cases

| | |
|---|---------------------------------------|
| <i>Am. Med. Sys., Inc. v. Biolitec, Inc.</i> , 618 F.3d 1354 (Fed. Cir. 2010)..... | 18 |
| <i>Ancora Techs., Inc. v. Apple, Inc.</i> , 744 F.3d 732 (Fed. Cir. 2014)..... | 5, 6, 9-13, 16, 23, 25-30, 35, 39, 51 |
| <i>Ancora Techs., Inc. v. HTC Am., Inc.</i> , 908 F.3d 1343 (Fed. Cir. 2018)..... | 4-6, 12, 14, 23, 25, 30-36, 39, 64 |
| <i>Applied Med. Res. Corp. v. U.S. Surgical Corp.</i> , 448 F.3d 1324 (Fed. Cir. 2006)..... | 2, 55 |
| <i>Ariosa Diagnostics v. Verinata Health, Inc.</i> , 805 F.3d 1359 (Fed. Cir. 2015)..... | 4 |
| <i>Cutsforth, Inc. v. Motivepower, Inc.</i> , 643 F. App'x 1008 (Fed. Cir. 2016)..... | 1 |
| <i>Elbit Systems of America, LLC v. Thales Visionix, Inc.</i> , 881 F.3d 1354 (Fed. Cir. 2018)..... | 57 |
| <i>Genetics Inst., LLC v. Novartis Vaccines & Diagnostics, Inc.</i> , 655 F.3d 1291 (Fed. Cir. 2011)..... | 2 |
| <i>HTC Corp. v. Ancora Techs., Inc.</i> , No. CBM2017-00054, Decision Denying Institution (PTAB Dec. 1, 2017)..... | 12, 14 |
| <i>In re Magnum Oil Tools Int'l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016)..... | 3, 57, 64 |
| <i>Indivior Inc. v. Dr. Reddy's Lab'ys, S.A.</i> , 930 F.3d 1325 (Fed. Cir. 2019)..... | 27 |
| <i>Kinetic Concepts, Inc. v. Smith & Nephew, Inc.</i> , 688 F.3d 1342 (Fed. Cir. 2012)..... | 3 |

| | |
|--|--------|
| <i>Medicines Co. v. Mylan, Inc.</i> , 853 F.3d 1296 (Fed. Cir. 2017)..... | 27 |
| <i>Samsung v. Ancora</i> , IPR2020-01184, Paper 1 (PTAB Jan. 5, 2021)..... | 38 |
| <i>SciMed Life Systems v. Advanced CardioVascular</i> , 242 F.3d 1337 (Fed. Cir. 2001)..... | 27 |
| <i>Sony Mobile Commc 'ns Ab v. Ancora Techs., Inc.</i> , No. IPR2021-00663, Paper 17 (PTAB June 10, 2021) | 40 |
| <i>TCT Mobile (US) Inc. v. Ancora Techs., Inc.</i> , IPR2020-01609 (PTAB Feb. 2, 2021)..... | 15 |
| <i>Traxcell Techs., LLC v. Nokia Sols. & Networks Oy</i> , 15 F.4th 1136 (Fed. Cir. 2021)..... | 22, 25 |
| <i>Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.</i> , 853 F.3d 1272 (Fed. Cir. 2017)..... | 55 |
| <i>Watts v. XL Sys., Inc.</i> , 232 F.3d 877 (Fed. Cir. 2000)..... | 26 |

Statutes

| | |
|----------------------|----|
| 35 U.S.C. §101 | 14 |
| 35 U.S.C. §103 | 3 |
| 35 U.S.C. §314 | 3 |

Other Authorities

| | |
|--|----|
| Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,756 (Aug. 14, 2012)..... | 3 |
| PTAB Rules of Practice for Instituting on All Challenged Patent Claims, 85 Fed. Reg. 79,120, 79,121 | 51 |

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.