UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

RESONANT SYSTEMS, INC.,
Patent Owner

Case No. IPR2025-00680
U.S. Patent No. 8,860,337

PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

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1001	U.S. Patent No. 8,860,337
1002	U.S. Patent No. 8,860,337 File History
1003	Declaration of Blake Hannaford
1004	U.S. Patent No. 7,843,277 to Pedro Gregorio, et al. ("Gregorio")
1005	U.S. Patent No. 7,005,811 to Hiroshi Wakuda, et al. ("Wakuda")
1006	U.S. Patent Application Publication No. 2008/0294984 to Erin B. Ramsay, et al. ("Ramsay")
1007	U.S. Patent Application Publication No. 2006/0109256 to Danny A. Grant, et al. ("Grant")
1008	U.S. Patent Application Publication No. 2005/0134561 to Kollin M. Tierling, et al. ("Tierling")
1009	U.S. Patent Publication No. 2008/0246532 ("Cosper")
1010	U.S. Patent Application Publication No. 2008/0198139 to Robert Andre Lacroix, et al. ("Lacroix")
1011	U.S. Patent Application Publication No. 2005/0134562 to Danny Grant, et al.
1012	C. McLyman, *Transformer and Inductor Design Handbook*, Marcel Dekker, Third Edition, Revised and Expanded, 2004
1013	U.S. Patent No. 6,088,017 to Mark R. Tremblay, et al.
1014	U.S. Patent No. 8,686,952 to Bobby Burrough, et al.
1015	U.S. Patent No. 8,207,832 to Jue Byung Yun, et al.
1016	U.S. Patent No. 8,203,640 to Jong Hwan Kim, et al.

EXHIBIT NO.	DESCRIPTION
1017	U.S. Patent Application Publication No. 2007/0285216 to Kollin M. Tierling, et al.
1018	Thorsten A. Kern, *Engineering Haptic Devices: A Beginner's Guide for Engineers*, Springer, 2009
1019	U.S. Patent No. 6,982,696 to Erik J. Shahoian
1020	U.S. Patent No. 4,879,641 to Domenico Rossi, et al. ("Rossi")
1021	Jack Aldrich, et al, *Controller for Driving a Piezoelectric Actuator at Resonance*, NASA Tech Briefs, April 2008 ("Aldrich")
1022	Declaration of June Munford re Aldrich
1023	U.S. Patent No. 7,027,032 to Louis B. Rosenberg, et al. ("Rosenberg")
1024	U.S. Patent No. 5,736,797 to Ryo Motohashi, et al. ("Motohashi")
1025	U.S. Patent No. 5,955,799 to Hidetoshi Amaya, et al. ("Amaya")
1026	J. Peckol, *Embedded Systems, A contemporary Design Tool*, 2008 ("Peckol")
1027	Corrosion - two case studies: aluminium and iron, Primary Connections: Linking science with literacy, available at https://www.primaryconnections.org.au/themes/custom/connections/assets/SBR/data/Chem/sub/corrosion/corrosion.htm#:~:text=When%20it%20starts%20to%20corrode,keep%20attacking%20the%20underlying%20iron (retrieved 2/12/2024)
1028	How to Protect Aluminum From Corrosion, OneMonroe, available at https://monroeengineering.com/blog/how-to-protect-aluminum-from-corrosion/ (retrieved 2/12/2024)
1029	Electrical Conductivity of Materials, Blue Sea Systems, https://www.bluesea.com/resources/108/Electrical_Conductivity_of_Materials (retrieved 2/12/2024)

EXHIBIT NO.	DESCRIPTION
1030	Thermal Conductivity, available at hyperphysics.phy-astr.gsu.edu/hbase/Tables/thrcn.html (retrieved 2/12/2024)
1031	U.S. Patent No. 8,134,437 to Elliot Brooks
1032	Magnetic Materials, Phys 251; archived at Wayback Machine; citing a capture dated March 23, 2002 (https://web.archive.org/web/20020323183824/http://webphysics.iupui.edu/webscience/physics_archive/magneticmaterials.html)
1033	Resonant Systems Proposed Claim Constructions, 7-23-cv-00077 (WDTX) (Feb. 15, 2024)
1034	Apple, Inc. Proposed Claim Constructions, 7-23-cv-00077 (WDTX) (Feb. 15, 2024)
1035	Types of Magnetism, DolTPoMS, Department of Materials Science and Metallurgy, University of Cambridge; archived at Wayback Machine; citing a capture dated October 9, 2006 (https://web.archive.org/web/20061015000000*/https://www.doitpoms.ac.uk/tlplib/ferromagnetic/types.php)
1036	Motion to Transfer Venue, 7-23-cv-00077 (WDTX)
1037	Moskowitz, B.M. (1991). Hitchhiker's Guide to Magnetism. In Environmental Magnetism Workshop, pp. 1–38. Minneapolis: The Institute for Rock Magnetism and the Global Paleorecords Research Training Group
1038	Resistance and Ohm's Law; archived at Wayback Machine; citing a capture dated February 18, 1999 (https://web.archive.org/web/19990218085938/https://physics.bu.edu/~duffy/PY106/Resistance.html)
1039	[RESERVED]
1040	U.S. Patent Publication No. 2011/0133682 ("Egger")
1041	U.S. Patent Publication No. 2008/0001484 ("Fuller")

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1042	U.S. Patent Publication No. 2006/0145547 ("Kraus")
1043	U.S. Patent Publication No. 2005/0275294 ("Izumi")
1044	[RESERVED]
1045	[RESERVED]
1046	Apple, Inc. Opening Claim Construction Brief, 7-23-cv-00077 (WDTX) (March 21, 2024)
1047	Resonant Systems, Inc's Responsive Claim Construction Brief, 7-23-cv-00077 (WDTX) (April 11, 2024)
1048	Plaintiff Resonant's Opposition to Nintendo Motion to Stay Pending *Inter Partes* Review, Dkt. No. 21, *Resonant Systems, Inc. v. Nintendo Co., Ltd.*, Case No. 2:25-cv-00090-JRG (E.D. Tex May 21, 2025)
1049	*Apple Inc. v. Resonant Systems, Inc.*, IPR2024-00807, Paper 2 (PTAB Apr. 12, 2024) (Petition for *Inter Partes* Review)
1050	*Apple Inc. v. Resonant Systems, Inc.*, IPR2024-00807, Ex. 2008 (PTAB July 29, 2024) (Statutory Disclaimer of U.S. Patent No. 8,860,337 claims 1, 4, and 5)
1051	*Apple Inc. v. Resonant Systems, Inc.*, IPR2024-00807, Paper 10 (PTAB Oct. 15, 2024) (Decision Granting Institution of *Inter Partes* Review)
1052	*Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. v. Resonant Systems, Inc.*, IPR2023-00992, Paper 3 (PTAB June 14, 2023) (Petition for *Inter Partes* Review)
1053	*Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. v. Resonant Systems, Inc.*, IPR2023-00993, Paper 3 (PTAB June 14, 2023) (Petition for *Inter Partes* Review)

EXHIBIT NO.	DESCRIPTION
1054	*Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. v. Resonant Systems, Inc.*, IPR2023-00992, Ex. 2015 (PTAB May 22, 2024) (Statutory disclaimer of claims 15 and 16 of U.S. Patent No. 9,369,081)
1055	Exhibit 12 to Nintendo Co., Ltd.'s Opposed Motion to Stay Pending *Inter Partes* Review, Dkt No. 18-13, *Resonant Systems, Inc. v. Nintendo Co., Ltd.*, Case No. 2:25-cv-00090-JRG (E.D. Tex May 7, 2025)
1056	*Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. v. Resonant Systems, Inc.*, IPR2023-00993, Paper 48 (PTAB Jan. 8, 2025) (Final Written Decision Determining Some Challenged Claims Unpatentable)
1057	Exhibit 13 to Nintendo Co., Ltd.'s Opposed Motion to Stay Pending *Inter Partes* Review, Dkt. No. 18-14, *Resonant Systems, Inc. v. Nintendo Co., Ltd.*, Case No. 2:25-cv-00090-JRG (E.D. Tex May 7, 2025)
1058	Complaint for Patent Infringement Against Nintendo Co., Ltd., Dkt. No. 1, *Resonant Systems, Inc. d/b/a RevelHMI v. Nintendo Co., Ltd.*, Case No. 2:25-cv-00090 (E.D. Tex. Jan. 31, 2025)
1059	Exhibit 1 to Complaint for Patent Infringement Against Nintendo Co., Ltd., Dkt. No. 1-1, *Resonant Systems, Inc. d/b/a RevelHMI v. Nintendo Co., Ltd.*, Case No. 2:25-cv-00090-JRG (E.D. Tex. Jan. 31, 2025)
1060	Print out of Indiegogo webpage entitled "Revel Body: The World's Only Sonic Vibrator," from https://www.indiegogo.com/projects/revel-body-the-world-s-only-sonic-vibrator#/
1061	Print out of GeekWire article entitled, "The vibrator of the future: Revel Body uses sonic tech to power new sex toy line," dated January 10, 2012, from https://www.geekwire.com/2012/vibrator-future-revel-body-sonic-technology-power-sex-toy-line/

EXHIBIT NO.	DESCRIPTION
1062	Exhibit 19 to Defendant Nintendo Co., Ltd.'s Opposed Motion to Stay Pending *Inter Partes* Review, Dkt. No. 18-20, *Resonant Systems, Inc. d/b/a RevelHMI v. Nintendo Co., Ltd.*, Case No. 2:25-cv-00090 (E.D. Tex. May 7, 2025)
1063	Nintendo's Motion to Stay Pending *Inter Partes* Review, Dkt. No. 18, *Resonant Systems, Inc. v. Nintendo Co., Ltd.*, Case No. 2:25-cv-00090-JRG (E.D. Tex May 7, 2025)
1064	Print out of statistics from Docket Navigator showing a time-to-trial of 24 months in cases before Judge Gilstrap obtained July 10, 2025
1065	Nintendo's Motion to Transfer Venue to the Western District of Washington, Dkt. No. 24, *Resonant Systems, Inc. v. Nintendo Co., Ltd.*, Case No. 2:25-cv-00090-JRG (E.D. Tex May 23, 2025)
1066	Nintendo's Reply in Support of Its Motion to Stay Pending *Inter Partes* Review, Dkt. No. 30, *Resonant Systems, Inc. v. Nintendo Co., Ltd.*, Case No. 2:25-cv-00090-JRG (E.D. Tex May 29, 2025)
1067	First Amended Docket Control Order, Dkt. No. 41, *Resonant Systems, Inc. v. Nintendo Co., Ltd.*, Case No. 2:25-cv-00090-JRG (E.D. Tex June 17, 2025)

I. INTRODUCTION

Petitioners Nintendo Co., Ltd. and Nintendo of America Inc. (collectively, "Nintendo") submit this opposition to Patent Owner Resonant's Request for Discretionary Denial of Institution (Paper 11, the "Request"). This IPR should proceed to a decision on the merits.

The public has a strong interest in the Board's review of U.S. Patent No. 8,860,337 ("the '337 patent"). The Director has held that "[i]t is an appropriate use of Office resources to provide consistency and predictability to the public, and to ensure that a patent applicant or owner does not take action inconsistent with the judgment in a prior Office proceeding." *Posco Co., Ltd. v. ArcelorMittal*, No. IPR2025-00370, Paper 10 at 3 (PTAB June 25, 2025). Here, Patent Owner is asserting the '337 patent despite the fact that Patent Owner has disclaimed—and the Board already found unpatentable—claims from related patents that are patentably indistinct from claims 2 and 3 ("Challenged Claims") of the '337 patent. And the Board has already found the same prior art grounds presented in this Petition to have a reasonable likelihood of success against the Challenged Claims. Discretionary denial here would be contrary to the public interest, because it would allow Patent Owner to take positions contrary to prior IPRs, creating inconsistency and unpredictability, and frustrating the public's ability to rely on IPR proceedings.

Although Resonant invokes the doctrine of settled expectations, settled expectations here cut ***against*** discretionary denial.

First, prior IPR proceedings have unsettled any Resonant expectations with respect to the Challenged Claims. As noted above, the Board has held unpatentable—and Resonant has disclaimed after an institution decision—claims in related patents that are patentably indistinct from the Challenged Claims. And the Board has already instituted review on the Challenged Claims based on the grounds raised in this Petition. In fact, Resonant disclaimed the majority of claims in the '337 patent. Thus, Resonant cannot have any settled expectation of immunity from IPR or of the Challenged Claims' validity.

Second, Resonant's past interactions with Nintendo weigh in favor of Nintendo's settled expectations, not Resonant's. Nintendo did meet with Resonant in June 2019 (unrelated to any released or planned product). At that time, Nintendo had already been selling the Nintendo Switch, the currently accused product, for approximately two years. Resonant did not contend that the Nintendo Switch infringed Resonant's patents. Resonant then sat on its patents for an additional five years until it asserted claims of patent infringement against the Nintendo Switch on January 31, 2025. In light of the parties' interactions, followed by Resonant's years of inaction, Nintendo had no reason to seek *inter partes* review because it had a settled expectation that the Switch does ***not*** infringe the challenged patent. But once

Resonant *did* file suit, Nintendo moved expeditiously. It filed this Petition just six days after agreeing to waive service of the complaint.

Patent Owner's discussion of the *Fintiv* factors similarly ignores key information that, when considered, show that the factors together strongly weigh in favor of institution. Critically, this Petition is a copy of the petition in IPR2024-00807 (the "Apple IPR"), which Nintendo has moved to join. Nintendo's motion for joinder weighs against discretionary denial because joining Nintendo to the Apple IPR will not create any additional work for the Board, while ensuring that the Board's investment in that proceeding does not go to waste if Apple withdraws. Resonant ignores that if Nintendo is joined to the Apple IPR, as Nintendo has requested, the Final Written Decision will predate the scheduled jury trial date by over one year.

For the reasons explained in this paper—and in the Petition itself—the Director should refer the Petition to the merits panel for an institution decision.

II. FACTUAL BACKGROUND

A. Nintendo Met With Patent Owner When the Currently Accused Product Had Been on Sale for at Least Two Years.

Patent Owner raises its discussions with Nintendo in June 2019 when it "reached out" to discuss its actuators for haptic feedback, including showing a presentation which "included the '337 patent and three other members of the same

patent family."[1] Request at 2-3. But Patent Owner fails to mention that the Switch had been released in the United States (and most countries worldwide) in March 2017, with millions of consoles sold, more than two years prior to Patent Owner's discussion with Nintendo.[2] Indeed, Resonant's infringement allegations are principally based on evidence that was available to it in 2017. NINTENDO-1059 (Nintendo District Court Action, Dkt. No. 1-1) (primarily citing Ex. NINTENDO-1062 (Nintendo District Court Action, Dkt. 18-20)). Resonant does not allege, nor could it, that it alleged that the Nintendo Switch infringes its patents during those discussions.

B. Patent Owner Loses Claims Patentably Indistinct to the Challenged Claims

Having failed to commercialize its product, which did not compete with Nintendo,[3] Patent Owner started a litigation campaign. Between 2022 and 2023, Patent Owner sued several defendants, including Samsung Electronics Co. Ltd. and

[1] The meetings were between Nintendo Technology Development Inc. and Patent Owner.

[2] https://www.nintendolife.com/news/2021/03/anniversary_nintendo_switch_launched_four_years_ago_today; https://www.gamespot.com/articles/switch-has-nearly-met-nintendos-first-month-sales-/1100-6448694/.

[3] Patent Owner marketed a personal vibrator. *See* NINTENDO-1060-1061.

Samsung Electronics America, Inc. (collectively, "Samsung"), Sony Group Corporation and Sony Interactive Entertainment, Inc. (collectively, "Sony"), and Apple, Inc. ("Apple") in separate cases alleging infringement of the '337 patent and other related patents.

1. After Being Sued, Samsung Challenges Related Patents With Claims Patentably Indistinct From Those Here

On June 14, 2023, Samsung filed petitions for IPR challenging U.S. Pat. Nos. 9,369,081 ("the '081 patent") and 9,941,830 ("the '830 patent"). NINTENDO-1052 (IPR2023-00992 ("Samsung '081 IPR"), Paper 3); NINTENDO-1053 (IPR2023-00993 ("Samsung '830 IPR"), Paper 3). The '830 and '081 patents are continuations of the '337 patent with materially identical specifications.

2. After the Board Instituted the Samsung '081 IPR, Patent Owner Disclaimed Patentably Indistinct Claims of the '081 Patent

On April 16, 2024, after the Board instituted the Samsung '081 IPR, Patent Owner statutorily disclaimed claims 15 and 16 of the '081 patent. NINTENDO-1054 (Samsung '081 IPR, Ex. 2015). Claim 15 is materially the same as claim 2 of the '337 patent, and claim 16 is materially the same as claim 3 of the '337 patent. NINTENDO-1055 ('337/'081 Claim Comparison).

3. The Board Finds Unpatentable Patentably Indistinct Claims of the '830 Patent

On January 8, 2025, the Board issued a Final Written Decision in the Samsung '830 IPR. NINTENDO-1056 (Samsung '830 IPR, Paper 48). Relevant here, the Board found that claims 1, 15, 16, and 17 were unpatentable over the prior art. *Id.* at 18-24, 33-34, 56-62, 66-70. Both Challenged Claims are materially the same as the claims found unpatentable in the Samsung '831 IPR. Specifically, claim 2 of the '337 patent is materially the same as claims 15 and 17 of the '830 patent (both of which depend on claim 1). NINTENDO-1057 ('337/'830 Claim Comparison). Claim 3 of the '337 patent is materially the same as claims 16 and 17 (both of which depend on claim 1). *Id.*

4. The Board Institutes Review of the Apple IPR That Challenges the '337 Patent

On April 12, 2024, Apple filed a petition for IPR challenging claims 1-4 of the '337 patent in *Apple Inc. v. Resonant Sys., Inc.*, IPR2024-00807 ("Apple IPR"). NINTENDO-1049 (Apple IPR, Paper 2). In response to the Apple IPR petition and a separate petition from Sony, Patent Owner statutorily disclaimed claims 1, 4, and 5 of the '337 patent. NINTENDO-1050 (Apple IPR, Ex. 2008). As a result of Patent Owner's statutory disclaimer, only claims 2 and 3 of the '337 patent (the "Challenged Claims" here) remain. On October 15, 2024, the Board instituted the Apple IPR on the two remaining claims (claims 2-3), concluding that Apple had

shown a reasonable likelihood of success on each of its six asserted grounds. *See* NINTENDO-1051 (Apple IPR, Paper 10 (Institution Decision)) at 7, 48.

5. Immediately After Patent Owner Sues Nintendo, It Files This Copycat Petition

On January 31, 2025, Patent Owner sued Nintendo alleging infringement of the '337 patent. NINTENDO-1058. Patent Owner's complaint was filed 1) after Patent Owner had already disclaimed claims patentably indistinct from the remaining claims in the '337 patent, *see* §II.B.2; 2) after the Board issued its Final Written Decision in the Samsung IPR, *see* §II.B.3; and 3) after the Board instituted the Apple IPR, *see* §II.B.4. Patent Owner accused the Nintendo Switch, a gaming console, of infringing. NINTENDO-1058 at 3.

Nintendo worked quickly to file its Petition in IPR2025-00680. Just 38 days after being sued, and only 6 days after agreeing to waive service of the complaint, Nintendo filed this Petition. This Petition is substantively identical to the petition in the Apple IPR, which Nintendo has moved to join. *See* Paper 1 (Petition) ("Pet."); Paper 4 (Motion for Joinder).

III. ARGUMENT

A. The Discretionary Considerations of the March 26, 2025, Interim Processes for PTAB Workload Management Weigh in Favor of Institution

The factors listed in the Director's March 26, 2025, memorandum[4] weigh in favor of institution of this Petition.

1. Factor 1 Favors Institution Because the Board Found Patentably Indistinct Claims of a Related Patent Unpatentable and Already Instituted IPR on the Challenged Claims

Factor 1 is "[w]hether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims." Interim Process at 2.

This factor favors institution. First, in the Samsung '830 IPR, the Board already held unpatentable claims materially the same as the Challenged Claims here. *See* §II.B.3. Second, the Board already held in the Apple IPR that the same prior art presented by Nintendo in this IPR, challenging the same claims of the '337 patent, "establish[es] a reasonable likelihood that [Apple] would prevail with respect to at least one challenged claim." NINTENDO-1051 (Apple IPR, Paper 10 (Institution Decision) at 2; §II.B.4.

[4] https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf ("Interim Process").

2. Factor 2 Factor Favors Institution Because the Board Found Patentably Indistinct Claims of a Related Patent Unpatentable

Factor 2 is "[w]hether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability." Interim Process at 2.

This factor favors institution for the same reasons discussed above for Factor 1. *See* §III.A.1.

3. Factor 3 Favors Institution Because the Petition Presents Grounds on Which the Board Has Already Instituted

Factor 3 is "[t]he strength of the unpatentability challenge." Interim Process at 2.

This factor favors institution because the grounds presented in Nintendo's Petition are strong. Nintendo's Petition for IPR presents grounds based on prior art that the Board already found "establish[es] a reasonable likelihood that [the petitioner] would prevail with respect to at least one challenged claim." NINTENDO-1051 (Apple IPR, Paper 10 (Institution Decision)) at 2; *see also* §§II.B.2, II.B.4. That "the Board previously determined there was a reasonable likelihood that [these] claims … were unpatentable" on the same Grounds as raised in this Petition indicates that its merits are strong, and weighs against discretionary

denial. *See Tesla, Inc. v. Intellectual Ventures II LLC*, No. IPR2025-00217, Paper 9 at 2-3 (PTAB June 13, 2025).

4. Factor 4 Favors Institution Because the Petition Properly Relies on Expert Testimony to Explain the Prior Art Supported by Citations to the Evidence

Factor 4 is "[t]he extent of the petition's reliance on expert testimony." Interim Process at 2.

This factor favors institution because Patent Owner does not contest Nintendo's usage of expert testimony. It would be baseless to do so. The Board already credited the same expert's testimony in the Apple IPR when it instituted that IPR. *See* §II.B.4.

Specifically, Nintendo's Petition is a "copycat" of the Apple IPR petition and relies on the same testimony of the expert, Dr. Blake Hannaford, in the Apple IPR. *See generally* NINTENDO-1003. The Board credited and relied on Dr. Hannaford's opinions several times in finding that "Petitioner has established a reasonable likelihood that it would prevail with respect to at least one challenged claim." *See* NINTENDO-1051 (Apple IPR, Paper 10 (Institution Decision)) at 2, 7, 10, 34, 43, 48. Nintendo's reliance on Dr. Hannaford's testimony complied with regulations requiring disclosure of "underlying facts or data" as required by 37 C.F.R. § 42.65(a)). Thus, this factor weighs in favor of institution. *See GD Energy Prods., LLC v. Kerr Machine Co.*, No. PGR2025-00031, Paper 11 at 2 (PTAB June 25,

2025); *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, No. IPR2025-00363, Paper 10 at 2-3 (PTAB June 6, 2025) (the "Petitioner appears to rely on its expert to explain the background knowledge of a person of ordinary skill in the art, and the expert provides citations to evidence in support of his statements in the required manner … weighs against discretionary denial").

Furthermore, in its Request, Patent Owner did not allege that Nintendo's Petition unduly relies on Dr. Hannaford's testimony expert. Thus, this factor is not a proper basis for discretionary denial. *See, e.g., Twitch Interactive, Inc. v. Razdog Holdings LLC*, No. IPR2025-00307, Paper 18 at 3 (PTAB May 16, 2025) (insufficient explanation as to "alleged improper or undue reliance on expert opinion" means this factor does not support discretionary denial); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, No. IPR2025-00434, Paper 11 at 2-3 (PTAB June 26, 2025) (denying Patent Owner's request for discretionary denial in part because "[a]lthough Patent Owner argues that discretionary denial is warranted because Petitioner is over-reliant on expert testimony, Patent Owner does not identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art.").

5. Factor 5 Favors Institution Because the (a) Public's Settled Expectations Are That the Challenged Claims Are Unpatentable and (b) Nintendo's Settled Expectation Is That the Asserted Patent Is Unrelated to Nintendo's Products

Factor 5 is the "[s]ettled expectations of the parties, such as the length of time the claims have been in force." Interim Process at 2.

This factor favors institution because (1) litigation removed any expectation Patent Owner had, or has, as to the validity of the Challenged Claims and, to the contrary, created a settled expectation among the public that the claims are unpatentable; and (2) Patent Owner's belated suit against Nintendo disturbed Nintendo's settled expectation that the Nintendo Switch does not infringe the '337 patent or Patent Owner's related patents.

First, any expectation that Patent Owner may have once had regarding the validity of the Challenged Claims has long since been unsettled. Patent Owner argues that because "the '337 patent and related patents [have] been in force for over a decade," it has settled expectations as to the patent's validity. Request at 1-2. But, since the '337 patent issued, Patent Owner was unwilling to defend the patentability of the '081 patent's claims—which are materially the same as the Challenged Claims—disclaiming those claims after the Board instituted IPR on the '081 patent. *See* §II.B.2. Moreover, the Board found that claims of the '830 patent—which are materially the same as the Challenged Claims—are unpatentable. S*ee* §II.B.3. And

the Board, in its Institution Decision in the Apple IPR, agreed with Apple that multiple, independent grounds are likely to render unpatentable the claims of the '337 patent. NINTENDO-1051 (Apple IPR, Paper 10 (Institution Decision)) at 2; §II.B.4. Finally, Resonant disclaimed the majority of claims from the '337 patent as well.

These proceedings have conferred on both Nintendo, and the general public, a settled expectation that the Challenged Claims are unpatentable. Indeed, the Director has held that "[i]t is an appropriate use of Office resources to provide consistency and predictability to the public, and to ensure that a patent applicant or owner does not take action inconsistent with the judgment in a prior Office proceeding." *ArcelorMittal*, Paper 10 at 3. Institution here would provide consistency and predictability by ensuring that essentially the same claims in different patents are treated the same. Denial of institution here would disturb Nintendo's and the public's settled expectations from ***three*** Patent Office proceedings and enable Patent Owner to take positions inconsistent with those prior proceedings contrary to 37 C.F.R. § 42.73.

Second, based on Nintendo's[5] meetings with Patent Owner and Patent Owner's years-long delay in bringing suit thereafter, Nintendo had the settled expectation that Patent Owner did not contend that the now-accused product (the Nintendo Switch) infringed the '337 patent. *See* §II.A. At the time of discussions with Resonant, Nintendo had already been selling the Nintendo Switch for approximately two years. *Id.* Patent Owner does not, nor can it, allege that Patent Owner asserted in those discussions that the Nintendo Switch infringes. And after those discussions, Patent Owner did nothing for over 5 years—it made no infringement accusations or licensing demands. Put simply, Patent Owner's silence regarding the Nintendo Switch during the meetings, which continued for more than five years thereafter, left Nintendo with settled expectations that Patent Owner did not contend that the Switch infringed the '337 patent. Just as it is "an inefficient use of Board resources to review patents that have been dismissed on a joint motion by Petitioner and Patent Owner" with no party to join, it would have been an inefficient use of Board resources for Nintendo to seek IPR of the '337 patent after

[5] Patent Owner also fails to mention that it disclaimed, and the PTAB found unpatentable, claims from two of the three "other members of the same patent family" that were virtually identical to those claims now asserted against Nintendo. Request at 3.

circumstances led it to reasonably believe there was no assertion of infringement. *Cellco P'ship d/b/a Verizon Wireless, T-Mobile USA, Inc. v. Pegasus Wireless Innov. LLC*, No. IPR2025-00137, Paper 17 at 4 (PTAB June 26, 2025).

Patent Owner's reliance on *iRhythm* misses the mark. *See iRhythm Techs., Inc. v. Welch Allyn, Inc.*, No. IPR2025-00363, Paper 10 at 2-3 (PTAB June 6, 2025). In *iRhythm*, the petitioner knew of the challenged patent but there is no evidence that the patent owner knew of the petitioner or of the product later accused of infringement. Here, in contrast, Patent Owner knew of the accused product when it met with Nintendo, yet never contended that the accused product infringed until it sued Nintendo over five years later. *See* §II.A. Unlike in *iRhythm*, Petitioner's conduct here did ***not*** settle any expectations of Patent Owner. To the contrary, Patent Owner's conduct settled Nintendo's expectations that the '337 patent was not relevant to the product now accused.

6. Factor 6 Is Neutral

Factor 6 is "[c]ompelling economic, public health, or national security interests." Interim Process at 2. This factor is neutral. Patent Owner did not allege that its accusations of infringement against Nintendo (and other entities in the gaming industry) raise interests under this factor.

7. Factor 7 Favors Institution Because Nintendo Seeks a Consistent Outcome for the Challenged Claims, and Because Patent Owner's Lack of Diligence Has Prejudiced Nintendo

Factor 7 is "[a]ny other considerations bearing on the Director's discretion." Interim Process at 3.

Nintendo is not seeking to institute "multiple parallel proceedings" and as such there is no risk of "inconsistent outcomes." *Comcast Cable Commc'ns, LLC v. Entropic Commc'ns, LLC,* No. IPR2025-00183, Paper 11 at 2 (PTAB June 25, 2025). Rather, Nintendo is advocating ***for*** consistent outcomes: that Patent Owner cannot end-run its own disclaimer and the Board's finding that patentably indistinct claims are unpatentable over the prior art. That is, Nintendo requests the Board to institute IPR on the asserted claims of the '337 patent so that the Board has an opportunity to render a Final Written Decision consistent with its prior ruling on patentably indistinct claims of a related patent. *See* §II.B.3. Instituting Nintendo's IPR helps ensure that the Board's investment in the Apple IPR—including considering the arguments made by Apple and credited by the Board in its institution decision—does not go to waste if Apple withdraws.

Moreover, principles of equity weigh against discretionary denial. Although laches is not a defense to patent infringement, the Board has recognized that equitable principles may "tip the balance" with respect to discretionary denial. *Tessell, Inc. v. Nutanix, Inc.*, IPR2025-00322, Paper 14 (PTAB June 12, 2025)

(applying assignor estoppel in the discretionary-denial context despite doctrine inapplicability on the merits). The equitable doctrine of laches applies when there is "(1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense." *Costello v. United States*, 365 U.S. 265, 282 (1961). Both requirements are met here. As noted above, Patent Owner knew of the accused product when it engaged in discussions with Nintendo in 2019, yet Patent Owner only asserted its claim in 2025. §II.A. Patent Owner's over five delay in asserting the '337 patent was not diligent, particularly given that Resonant's infringement allegations are principally based on evidence that was available to it in 2017. NINTENDO-1059 (Nintendo District Court Action, Dkt. No. 1-1) (primarily citing NINTENDO-1062 (Nintendo District Court Action, Dkt. 18-20)). And, to the extent that the age of the '337 patent is weighed against institution (for the reasons above, it should not be), Patent Owner's delay prejudices Nintendo. Simply put, the Board should not permit a Patent Owner to intentionally delay suit for years after it knows of the allegedly infringing product—all the while providing no indication that it believes the allegedly infringing product, in fact, infringes—in order to insulate its patents from Board review.

B. The *Fintiv* Factors Weigh in Favor of Institution

Patent Owner primarily relies on the *Fintiv* factors in arguing that the Director should discretionarily deny Nintendo's Petition. *See* Request at 4-11. But Patent

Owner omits several facts which, when considered, show that the *Fintiv* factors collectively favor institution.

1. Factor 1 Favors Institution Because the Court Often Grants Stays in Similar Circumstances

Factor 1 is "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB March 20, 2020).

Nintendo's Motion to Stay filed in the parallel district court case shows that Nintendo has strong grounds for a stay. *See generally* NINTENDO-1063. For example, the Apple IPR has already been instituted on all remaining claims of the '337 patent—and Nintendo's petition presents the same prior art grounds. *See* §II.B.4; Pet. The Apple IPR is scheduled to conclude in October, over a year before the scheduled trial date. Fact discovery has yet to begin in earnest (only a single venue-related deposition has been taken), and Patent Owner will face no prejudice other than the "delay inherent in the IPR process" if a stay is granted. *Foras Techs. Ltd. v. Aptiv PLC*, No. 2:23-CV-00314-JRG, 2024 WL 5348631, at *3 (E.D. Tex. July 25, 2024)

The District Court has granted stays in similar situations. *See Foras Techs.*, 2024 WL 5348631, at *1 (the Court granting a stay because IPR had been instituted on all asserted claims, the case was in its early stages—"[f]act discovery [had] just begun"—and there was no apparent prejudice to the plaintiff "beyond the delay

inherent in the IPR process") (internal quotation marks and citation omitted); *see also Advanced Mktg. Sys., LLC v. CVS Pharm., Inc.*, No. 6:15-CV-134-JRG-KNM, 2016 WL 3277258, at *2 (E.D. Tex. June 14, 2016) ("Additionally, [the plaintiff] does not directly compete against [the defendants], and thus, a stay will not cause any undu[e] prejudice.").

Patent Owner's only argument is that any argument of the likelihood of the Court granting Nintendo's "pending motions to stay or to transfer … would be speculative." Request at 7-8. Yet Patent Owner ignores the prior IPR proceedings unfavorable to Patent Owner, the timing of the Apple IPR, and the cases noted above, all of which increase the likelihood of a stay here.

2. Factor 2 Favors Institution Because the Trial Date Is Far After the Board's Projected Deadline for a Final Written Decision

Fintiv factor 2 is the "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision." *Fintiv*, Paper 11 at 6.

This factor favors institution because the trial date is (a) more than a year after the Board's projected deadline for a Final Written Decision should Nintendo be joined to the Apple IPR, and (b) still later than the Board's projected deadline for a Final Written Decision even if Nintendo is not joined to the Apple IPR.

As Patent Owner acknowledges, trial in the district court case is set to begin on November 2, 2026. Request at 8; NINTENDO-1067. Judge Gilstrap's time-to-

trial statistics suggest an even later trial date of late January 2027. NINTENDO-1064 (Docket Navigator statistics before Judge Gilstrap showing a time-to-trial of 24 months). However, Patent Owner attempts to bury the facts in focusing on a hypothetical ***extended*** deadline for final written decision without explaining why such a deadline is likely. Rather, it is more likely that the Final Written Decision will be due "not later than 1 year after the date on which the Director notices the institution of a review" per 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

The Apple IPR was instituted on October 15, 2024. Thus, the Final Written Decision is expected by October 15, 2025, over a year before the trial in the parallel district court case is set to begin.

Even if Nintendo is not joined to the Apple IPR and this IPR proceeds on its own track, the institution decision is expected by October 16, 2025; *See* Paper 5 (Notice of Filing Date Accorded mailed on April 16, 2025 and Patent Owner "may file a preliminary response … no later than three months from the date of [the] notice"); 35 U.S.C. §314(b) (institution decision due "within 3 months after" the later of the date the preliminary response is filed or due). The final written decision would then be due by October 16, 2026, which is weeks before the trial is set to begin in the parallel district court case. *See* 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c).

Patent Owner argues that this factor favors denial because of the ***possibility*** that the Board (1) does not join Nintendo to the Apple IPR ***and*** (2) extends its final written decision deadline by 6 months. *See* Request at 8-9. This unsupported conjecture makes little sense. Were the Board to join Nintendo in the Apple IPR, that IPR would conclude approximately seven months before the trial in the parallel district court case even with Patent Owner's speculative 6-month extension (it would conclude April 2026 with the extension). In contrast, if the Board chose not to join Nintendo in the Apple IPR, there would be no basis to extend the standalone Nintendo IPR proceeding. Put simply, Patent Owner's strained attempts to conjure a final written decision deadline after trial do not withstand scrutiny.

Board decisions hold that where the projected final written decision precedes the scheduled trial date, this weighs in favor of institution. *See, e.g.*, *Amazon.com, Inc., Amazon.com Svcs. LLC, Amazon Web Svcs., Inc., and Twitch Interactive, Inc. v. NL Giken Inc.*, No. IPR2025-00407, Paper 14 at 2-3 (PTAB May 16, 2025) ("discretionary denial of institution is not appropriate" where "it is likely that a final written decision in this proceeding will issue before the district court trial occurs"); *Twitch Interactive, Inc. v. Razdog Holdings LLC*, No. IPR2025-00307, Paper 18 at 2-3 (PTAB May 16, 2025) ("discretionary denial of institution is not appropriate in this proceeding" where no trial date was set but "even if a trial were to be scheduled" it would occur 6 to 7 months after the projected final written decision). Indeed,

where there are clear questions about the patentability of the challenged claims, discretionary denial "is not appropriate" even where "the scheduled district court trial is set to precede the expected final written decision due date by a month." *Microsoft Corp. v. Partec Cluster Competence Center GMBH*, No. IPR2025-00318, Paper 9 at 2-3 (PTAB June 12, 2025).

This factor strongly favors institution.

3. Factor 3 Favors Institution Because There Has Been Little Investment at the District Court

Factor 3 is "investment in the parallel proceeding by the court and the parties." *Fintiv*, Paper 11 at 6.

This factor weighs in favor of institution because there has been little investment between the parties and the court in the parallel district court proceeding. Nintendo just responded to the complaint on June 2, 2025. Nintendo is not set to serve invalidity contentions for over one month. The parties are not set to exchange proposed terms for claim construction until January next year, fact discovery does not close until June 15, 2026, and trial is not set to start until November 2, 2026. *See* NINTENDO-1067.

The only briefing in the district court case is irrelevant. Nintendo has moved to stay and to transfer. Neither motion is the sort of investment relevant to Factor 3 because that factor concerns duplication in effort between the district court and the Board. To the extent relevant at all, the stay motion weighs against discretionary

denial because, if granted, it would (1) result in no further investment in the case between the parties, and (2) move the trial date even later than currently scheduled.

Further, as a part of this factor if "the evidence shows that the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against exercising the authority to deny institution." *Fintiv*, Paper 11 at 11. Here, Nintendo worked as quickly as possible to file—just 38 days after Patent Owner filed its complaint against Nintendo, and a mere 6 days after Nintendo agreed to waive service of the complaint—a "copycat" petition in this IPR. *See* §II.B.5.

Patent Owner argues from the standpoint of the expected time of institution in this IPR. However, Patent Owner ignores that the Board already instituted the Apple IPR to which Nintendo seeks to join, and the Board is well aware that it often grants joinder and institution well before the institution deadline in such cases. Furthermore, even assuming institution in October 2025, Nintendo filed both a Motion to Stay as well as a Motion to Transfer in the parallel district court, which renders Patent Owner's assumption of the amount of work done by the parties by October 2025 speculative at best. NINTENDO-1063; NINTENDO-1065.

Finally, Patent Owner provides no support for its notion that parties who have exchanged contentions but are months away from the start of claim construction—the exchange of proposed claim terms is not scheduled until January 6, 2026—

constitutes enough investment to warrant discretionary denial. *See* Request at 9; NINTENDO-1067.

Overall, this factor weighs in favor of institution.

4. Factor 4 Favors Institution Because Nintendo Stipulated to Reduce Issue Overlap

Factor 4 is "overlap between issues raised in the petition and in the parallel proceeding." *Fintiv*, Paper 11 at 6.

Nintendo stipulated in the petition that it will not advance in district court any invalidity grounds advanced in this Petition. *See* Pet. at 85. First, the Board has found such stipulations, which eliminate the overlap between the co-pending proceedings, to weigh in favor institution. *Sand Revolution II, LLC v. Continental Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 11-12 (PTAB June 16, 2020) (informative).

Then, on May 29, 2025, Nintendo included an even broader stipulation in the parallel district court as a part of its briefing in support of its Motion to Stay pending IPRs. Specifically, Nintendo's stipulated to "IPR estoppel in connection with the Apple IPR: if the Board issues a FWD after a contested proceeding, Nintendo will not 'assert … in a civil action … that [any claim of the '337 patent] is invalid on any

ground that [Apple] raised or reasonably could have raised during [its] inter partes review.'"[6] *See* NINTENDO-1066.

Patent Owner argues that Nintendo's "*Sand Revolution* stipulation" is "extremely limited" and "should not be given any weight." Putting aside that this misstates the holding in *Sand Revolution*, Patent Owner completely ignores Nintendo's broader stipulation in the parallel district court. Nintendo's stipulation in the District Court applies the full scope of estoppel under 35 U.S.C. § 315(e) to that district court case (assuming the Apple case proceeds to a FWD after a contested proceeding). *See id.* Thus, Patent Owner's arguments are not only incorrect, they are irrelevant because they fail to address Nintendo's broader stipulation.

This factor weighs in favor of institution.

5. Factor 5 Is Neutral

Factor 5 is "whether the petitioner and the defendant in the parallel proceeding are the same party." *Fintiv*, Paper 11 at 6.

[6] Specifically, Nintendo stated that it "stipulates to IPR estoppel in connection with the Apple IPR: if the Board issues a FWD after a contested proceeding, Nintendo will not "assert … in a civil action … that [any claim of the '337 patent] is invalid on any ground that [Apple] raised or reasonably could have raised during [its] inter partes review." *See* NINTENDO-1066.

Both Nintendo and Patent Owner are parties in the parallel proceeding. This, however, is of little moment as parallel proceedings often result in party overlap.

6. Factor 6 Favors Institution Because the Merits Are Strong, as Confirmed by the Board's Apple IPR Institution Decision

Factor 6 is "[o]ther circumstances that impact the Board's exercise of discretion, including the merits." *Fintiv*, Paper 11 at 6.

Nintendo submits that its Petition has significant substantive merit. It is premised on clear, understandable prior art that the Patent Office did not previously consider during examination of the '337 patent. *See generally* Pet. The Board has already found a reasonable likelihood of success on each of multiple independently sufficient grounds for invalidating the Challenged Claims. *See* §§II.B, III.A.1-III.A.3.

Patent Owner does not even attempt to argue differently for this factor. Instead, it simply contends that the strength of this factor "cannot be sufficient to overcome the other factors." Request at 11. But as explained above, the other factors taken together also weigh in favor of institution and against discretionary denial.

This factor weighs in favor of institution.

C. The *General Plastic* Factors Weigh in Favor of Institution

Patent Owner does not raise any *General Plastic* factors. While Nintendo filed two IPR petitions, in Nintendo's Explanation For and Ranking of Two Petitions filed in both this IPR and IPR2025-01098, Nintendo explains that "while Nintendo presents two petitions, it requests that the Board institute only one petition" depending on the "Board's decision on Nintendo's Motion for Joinder" in this IPR. Paper 13 at 1, 8. As explained there, Patent Owner's gamesmanship has required Nintendo to file two petitions. Paper 13 at 1-3. As the Board need institute only one petition, *General Plastics* factors are not relevant here. What's more, given that Patent Owner is attempting skirt its own disclaimer and prior Board unpatentability findings, public policy strongly cuts against possible *General Plastic* argument. *See ArcelorMittal*, Paper 10 at 2-3.

IV. CONCLUSION

Institution is appropriate for the reasons outline above and in the Petition. Nintendo respectfully asks that the Director deny Patent Owner's request to discretionarily deny institution of this IPR petition.

Respectfully submitted,

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Dated: July 16, 2025

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that the foregoing PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION complies with the type volume limitation in 37 C.F.R. § 42.24(a). According to the utilized word-processing system's word count, the paper—excluding the caption, table of contents, table of exhibits, certificate of word count, and certificate of service—contains 5,800 words.

Dated: July 16, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that on July 16, 2025, a copy of the following was served in its entirety via electronic mail, upon the following attorneys of record for Petitioner:

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