

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

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

v.

RESONANT SYSTEMS, INC.,
Patent Owner.

IPR2025-00680
Patent 8,860,337 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION
Referring the Petition to the Board

Resonant Systems, Inc. (“Patent Owner”) filed a request for discretionary denial (Paper 11, “DD Req.”) in the above-captioned case, and Nintendo Co., Ltd. and Nintendo of America Inc. (collectively, “Petitioner”) filed an opposition (Paper 15, “DD Opp.”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in this proceeding. This determination is based on the totality of the evidence and arguments the parties have presented.

Petitioner filed the Petition and an accompanying motion for joinder to IPR2024-00807, a proceeding that the Board instituted on October 15, 2024. *Apple Inc. v. Resonant Systems, Inc.*, IPR2024-00807, Paper 10 (PTAB Oct. 15, 2024). The Board first determines whether to institute a proceeding before considering a motion for joinder. 35 U.S.C. § 315(c). Accordingly, discretionary considerations are first reviewed for the Petition on its own, and then reviewed if joinder were to be granted.

First, the projected final written decision due date in this Board proceeding is October 16, 2026. DD Req. 8. The parallel proceeding in district court involving the parties has been stayed. Ex. 1068, 5. As such, it is likely that a final written decision will issue before the district court trial occurs, reducing the concern of inconsistent outcomes or significant duplication of efforts resulting from two proceedings operating in parallel. In addition, there has not been significant investment by the parties in the parallel proceeding. DD Req. 8; DD Opp. 20. These considerations counsel against discretionary denial.

Second, review of the facts as if joinder were to be granted also counsels against discretionary denial. The projected final written decision due date for IPR2024-00807, the proceeding that Petitioner seeks to join, is

October 15, 2025. DD Opp. 20. Therefore, if joinder were granted, it is even more likely that a final written decision will issue before the district court trial occurs.

Other factors counsel against discretionary denial as well. In particular, in an *inter partes* review of a continuation patent of the challenged patent, the Board has determined claims that are substantially similar to the challenged claims to be unpatentable. DD Opp. 5–6; Ex. 1057. Additionally, after the Board instituted an *inter partes* review of a different continuation patent of the challenged patent, Patent Owner disclaimed claims that are substantially the same as the challenged claims. DD Opp. 5–6; Ex. 1055.

Although the challenged patent has been in force for more than ten years, creating strong settled expectations for Patent Owner, this does not overcome the aforementioned considerations that counsel against discretionary denial.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition is referred to the Board to handle the case in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner’s request for discretionary denial is *denied*;

FURTHER ORDERED that the Petition is referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

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