

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

RESONANT SYSTEMS, INC.,
Patent Owner.

Case No.: IPR2025-00823
U.S. Patent No. 8,860,337

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

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. FACTUAL BACKGROUND.....	4
A. Patent Owner Loses Claims Patentably Indistinct to the Challenged Claims	4
1. After Being Sued, Samsung Challenges Related Patents With Claims Patentably Indistinct From Those Here	4
2. After the Board Instituted the Samsung '081 IPR, Patent Owner Disclaimed Patentably Indistinct Claims of the '081 Patent	4
3. The Board Finds Unpatentable the Patentably Indistinct Claims of the '830 Patent.....	5
4. The Board Institutes Review of the Apple IPR That Challenges the '337 Patent.....	5
5. Immediately After Patent Owner Sues Meta, Petitioner Files This Copycat Petition.....	6
6. Patent Owner Agrees to Stay the District Court Litigation Pending the Apple IPR.....	6
III. ARGUMENT.....	7
A. The Director's Nintendo IPR Discretionary Denial Decision Supports Finding that this IPR Should Proceed to a Merits Decision.....	7
B. Patent Owner's Inconsistent Positions on Claim Construction Further Support Rejecting its Request for Discretionary Denial	10
C. The Discretionary Considerations of the March 26, 2025, Interim Processes for PTAB Workload Management Weigh in Favor of Institution.....	12
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	12

2.	Factor 2 Favors Institution Because the Board Found Patentably Indistinct Claims of a Related Patent Unpatentable	12
3.	Factor 3 Favors Institution Because the Petition Presents Grounds on Which the Board Has Already Instituted.....	13
4.	Factor 4 Favors Institution Because the Petition Properly Relies on Expert Testimony to Explain the Prior Art Supported by Citations to the Evidence.....	13
5.	Factor 5 Favors Institution Because the Public’s Settled Expectations Are That the Challenged Claims Are Unpatentable	15
6.	Factor 6 Is Neutral.....	17
7.	Factor 7 Favors Institution Because Meta Seeks a Consistent Outcome for the Challenged Claims.....	17
D.	Patent Owner Fails to Justify its Request for Discretionary Denial	18
IV.	CONCLUSION.....	21

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.</i> , No. IPR2025-00434, Paper 11 (PTAB June 26, 2025)	15
<i>Comcast Cable Commc'ns, LLC v. Entropic Commc'ns, LLC</i> , No. IPR2025-00183, Paper 11 (PTAB June 25, 2025)	18
<i>GD Energy Prods., LLC v. Kerr Mach. Co.</i> , No. PGR2025-00031, Paper 11 (PTAB June 25, 2025).....	14
<i>iRhythm Techs., Inc. v. Welch Allyn, Inc.</i> , No. IPR2025-00363, Paper 10 (PTAB June 6, 2025)	14
<i>Microsoft Corp. v. Partec Cluster Competence Center GMBH</i> , No. IPR2025-00318, Paper 9 (PTAB June 12, 2025)	10
<i>Nintendo Co. v. Resonant Systems, Inc.</i> , No. IPR2025-00680, Paper 18 (PTAB Aug. 14, 2025).....	<i>passim</i>
<i>Posco Co., Ltd. v. ArcelorMittal</i> , No. IPR2025-00370, Paper 10 (PTAB June 25, 2025)	2, 10, 17
<i>Tesla, Inc. v. Intellectual Ventures II LLC</i> , No. IPR2025-00217, Paper 9 (PTAB June 13, 2025)	13
<i>Twitch Interactive, Inc. v. Razdog Holdings LLC</i> , No. IPR2025-00307, Paper 18 (PTAB May 16, 2025)	15
<i>Zhuhai Cosmx Battery Co., Ltd. v. Ningde Amperex Tech. Ltd.</i> , No. IPR2025-00385, Paper 9 (PTAB July 2, 2025)	9
Other Authorities	
37 C.F.R. § 42.45(a)(1)	19
37 C.F.R. § 42.65(a).....	14
37 C.F.R. § 42.73	17

https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf	12
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EXHIBIT NO.	DESCRIPTION
1001	U.S. Patent No. 8,860,337
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1003	Declaration of Blake Hannaford
1004	U.S. Patent No. 7,843,277 to Pedro Gregorio, et al. (“Gregorio”)
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1051	Decision Granting Institution of Inter Partes Review, Apple Inc. v. Resonant Systems, Inc., IPR2024-00807, Paper 10 (October 15, 2024)
1052	IPR Petition, Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. v. Resonant Systems, Inc. IPR2023-00992, Paper 3 (June 14, 2023)
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1054	Statutory disclaimer of claims 15 and 16 of U.S. Patent No. 9,369,081
1055	’337/’081 Claim Comparison

EXHIBIT NO.	DESCRIPTION
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1057	'337/'830 Claim Comparison
1058	Apple IPR hearing transcript, Apple Inc. v. Resonant Systems, Inc., IPR2024-00807, Paper 31 (August 8, 2025)
1059	Patent Owner's Proposed Construction (August 14, 2025), Resonant Systems, Inc. v. Meta Platforms, Inc., 7:25-cv-35-DC-DTG
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1061	Email between counsel dated August 22, 2025
1062	Joint Motion to Stay (August 25, 2025) Resonant Systems, Inc. v. Meta Platforms, Inc., 7:25-cv-35-DC-DTG
1063	Meta's Proposed Construction (August 13, 2025) Resonant Systems, Inc. v. Meta Platforms, Inc., 7:25-cv-35-DC-DTG
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I. INTRODUCTION

Petitioner Meta Platforms, Inc. (“Meta”) respectfully submits this opposition to Patent Owner Resonant’s Request for Discretionary Denial of Institution (Paper 7, the “Request”). This IPR should proceed to a decision on the merits.

The Director recently denied Patent Owner’s request for discretionary denial in co-pending IPR2025-00680 (the “Nintendo IPR”), which involves the same U.S. Patent No. 8,860,337 (“the ’337 patent”), and should deny Patent Owner’s Request here for substantially the same reasons. *Nintendo Co. v. Resonant Systems, Inc.*, No. IPR2025-00680, Paper 18 (PTAB Aug. 14, 2025) (META-1064, “Nintendo IPR Discretionary Denial Decision”). As Patent Owner acknowledges in its Request, Meta’s IPR is “in substance identical” to both the Nintendo IPR and the earlier IPR2024-00807 proceeding involving the ’337 patent (the “Apple IPR”). Request, 1. Thus, it is not surprising that substantially the same facts are at issue here and overcome any settled expectations of the Patent Owner for the same reasons, including:

- the projected final written decision date for this IPR precedes the expected trial date in the district court given that the parties have agreed to stay the district court case pending the Apple IPR, just like the stayed district court case at issue in the Nintendo IPR. Nintendo IPR Discretionary Denial Decision, 2;

- the projected final written decision date for the Apple IPR (October 15, 2025) long precedes the expected trial date in the district court, and thus “if joinder were granted, it is even more likely that a final written decision will issue before the district court trial occurs.” *Id.*, 3;
- “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.” *Id.*; and
- “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.” *Id.*

Patent Owner’s recent actions in the district court litigation provide further support that the public has a strong interest in the Board’s review of 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). In addition to the inconsistencies highlighted by the Director in the Nintendo IPR Discretionary Denial Decision—i.e., the Board has found substantially similar claims in a continuation patent unpatentable, and Patent Owner disclaimed claims substantially the same as the challenged claims—Patent

Owner is now taking inconsistent positions with respect to construction of the '337 patent.

In the Apple IPR, the Board in its Institution Decision applied the construction adopted by the district court in the Resonant/Apple case for the term “control component.” At the July 17, 2025 hearing in the Apple IPR, Patent Owner represented that “the Board can and should decide the -- on [the] construction that it’s adopted [for the control component term].” META-1058 (Apple IPR hearing transcript) at 50:4-5; *see* 1051 (Apple IPR, Paper 10 (Institution Decision)) at 13 (adopting “the [Apple] district court’s construction” for the “control component” term). But less than a month later, on August 14, 2025, Patent Owner in the Meta litigation instead proposed “plain and ordinary meaning” for construction of the very same term. META-1059. Meta, by contrast, proposed the same construction as adopted by the district court in the Apple case and the Board in the Apple IPR. Patent Owner’s refusal to agree to the same construction it had urged to the Board less than one month prior creates a strong public interest in the Board’s review of the '337 patent to ensure consistent construction of the claim terms in the patent.

Meta therefore requests that the Director refer this Petition to the merits panel for an institution decision for substantially the same reasons as in the Nintendo IPR and because of the strong public interest in ensuring consistency in the construction of the '337 patent.

II. FACTUAL BACKGROUND

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

Between 2022 and 2023, Patent Owner sued several defendants, including Samsung Electronics Co. Ltd. and 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”). META-1052 (IPR2023-00992 (“Samsung ’081 IPR”), Paper 3); META-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. META-1054 (Samsung ’081 IPR, META-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. META-1055 (’337/’081 Claim Comparison).

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

On January 8, 2025, the Board issued a Final Written Decision in the Samsung '830 IPR. META-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 in the current IPR 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). META-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 the Apple IPR. META-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. META-1050. 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* META-1051 (Apple IPR, Paper 10 (Institution Decision)) at 7, 48.

5. Immediately After Patent Owner Sues Meta, Petitioner Files This Copycat Petition

On January 31, 2025, Patent Owner sued Meta alleging infringement of the '337 patent. META-1060. 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.A.2; (2) after the Board issued its Final Written Decision in the Samsung IPR, *see* § II.A.3; and (3) after the Board instituted the Apple IPR, *see* § II.A.4. Petitioner worked diligently to file its Petition on April 23, 2025. This Petition is substantively identical to the petition in the Apple IPR, which Petitioner has moved to join. *See* Paper 1 (Petition) ("Pet."); Paper 3 (Motion for Joinder).

6. Patent Owner Agrees to Stay the District Court Litigation Pending the Apple IPR

On August 22, 2025, Patent Owner stated that it "agree[d] to stay the case pending the FWD in the 337 IPR." META-1061. On August 25, 2025, the parties filed their joint motion to stay. META-1062.

III. ARGUMENT

A. The Director’s Nintendo IPR Discretionary Denial Decision Supports Finding that this IPR Should Proceed to a Merits Decision

As Resonant acknowledges in its Request, Meta’s IPR is “in substance identical” to both the Nintendo IPR and the Apple IPR. Request, 1. Thus, unsurprisingly, the bases for the Director’s Nintendo IPR Discretionary Denial Decision similarly apply to this IPR, and the Director should refer this case to the merits panel for substantially the same reasons.

Here, as in the Nintendo IPR, the projected final written decision date (November 25, 2026) precedes the expected trial date given that the parties have agreed to stay the parallel district court proceeding. META-1061; META-1062. Though the stay has not been formally entered by the district court (since the parties only reached agreement three days ago and have just today filed their joint motion), because the parties agree to stay the case, it is likely that the case will be stayed, ensuring a final written decision in the Apple IPR will issue before any trial date is set. And because the original trial date (November 2, 2026) was already so close to the projected final written decision date in this IPR (November 25, 2026), even a short stay until the Apple IPR final written decision (October 15, 2025, i.e., a stay of nearly two months) will likely result in a reset trial date after the projected final written decision date in this IPR. Thus, as in the Nintendo IPR, “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.” Nintendo IPR Discretionary Denial Decision, 2.

Here, as in the Nintendo IPR, the projected final written decision date for the Apple IPR (October 15, 2025) long precedes the currently set trial date in the Meta district court case (November 2, 2026), and thus “if joinder were granted, it is even more likely that a final written decision will issue before the district court trial occurs.” Nintendo IPR Discretionary Denial Decision, 3.

Here, as in the Nintendo IPR, “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.” Nintendo IPR Discretionary Denial Decision, 3; *see also supra* § II.A.3.

Here, as in the Nintendo IPR, “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.” Nintendo IPR Discretionary Denial Decision, 3.; *see also supra* § II.A.2.

Thus, although the challenged patent has been in force for 10 years, which gives rise to “strong settled expectations for Patent Owner, this does not overcome

the aforementioned considerations that counsel against discretionary denial.”

Nintendo IPR Discretionary Denial Decision, 3.

Even if the Director considers the currently set schedule despite the parties’ agreement to stay, under which the final written decision here would issue in less than a month after the district court trial, the Director has denied requests for discretionary denial in similar circumstances. For example, in a proceeding where the final written decision date was August 2026 and the district court trial date was July 2026, the Director denied a request for discretionary denial because “[a]lthough there may be some inefficiencies with two proceedings operating in parallel, the early challenges to the patents tip the balance against discretionary denial.” *Zhuhai Cosmx Battery Co., Ltd. v. Ningde Amperex Tech. Ltd.*, No. IPR2025-00385, Paper 9 at 2 (PTAB July 2, 2025). So too here: Meta filed its Petition early after being sued, within three months. And Meta sought to efficiently join an existing proceeding, which would—as the Director recognized in the Nintendo IPR Discretionary Denial Decision—allow this case to proceed even more expeditiously than a normal Petition.

Thus, the fact that Meta’s district court case is not yet stayed but merely agreed to be stayed—the only minor difference from the Nintendo IPR Discretionary Denial Decision—does not support discretionary denial here. 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).

Thus, for substantially the same as cited in the Nintendo IPR Discretionary Denial Decision, the Director should refer Meta’s petition to the merits panel.

B. Patent Owner’s Inconsistent Positions on Claim Construction Further Support Rejecting its Request for Discretionary Denial

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).

As explained above, the Director has already identified multiple inconsistencies in the Nintendo IPR Discretionary Denial Decision, including that (1) the Board has found substantially similar claims in a continuation patent unpatentable and (2) Patent Owner disclaimed claims substantially the same as the challenged claims.

Patent Owner’s recent actions raise even further inconsistencies with respect to construction of at least the “control component” term in the ’337 patent. In the Apple IPR Institution Decision, the Board adopted “the [Apple] district court’s

construction” for the “control component” term. META-1051 (Apple IPR, Paper 10 (Institution Decision)) at 13. At the July 17, 2025, hearing in the Apple IPR, Patent Owner urged the Board to maintain that construction: “the Board can and should decide the -- on construction that it’s adopted.” META-1058 (Apple IPR hearing transcript) at 50:4-5. But less than a month later, in the district court litigation against Petitioner here, Patent Owner proposed “plain and ordinary meaning” for construction of the very same term. META-1059. Petitioner, by contrast, proposed the exact construction from the Apple district court litigation, which the Board adopted in its Apple IPR Institution Decision and which Patent Owner had just urged the Board to maintain as its construction. META-1063.

Patent Owner’s actions thus raise the possibility of inconsistent decisions with respect to construction of the ’337 patent. The public thus has a strong interest in continued review of the ’337 patent in this case, to ensure a consistent construction of the claims that will provide the public clear and consistent notice of the scope of the ’337 patent. The Director should therefore refer this petition to the merits panel for decision.

C. 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 memorandum¹ 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.A.3. Second, the Board already held in the Apple IPR that the same prior art presented by Meta 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.” META-1051 (Apple IPR, Paper 10 (Institution Decision) at 2; § II.A.4.

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

¹ <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf> (“Interim Process”).

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.C.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 Meta’s Petition for IPR are strong. Meta’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.” META-1051 (Apple IPR, Paper 10 (Institution Decision)) at 2; *see also* §§ II.A.2, II.A.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 Meta’s use 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.A.4.

Specifically, Meta’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* META-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* META-1051 (Apple IPR, Paper 10 (Institution Decision)) at 2, 7, 10, 34, 43, 48. Meta’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 Mach. 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 Meta’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 Public’s Settled Expectations Are That the Challenged Claims Are Unpatentable

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 prior PTAB proceedings, and Patent Owner’s disclaimer of substantially similar claims, 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.

Any expectation that Patent Owner may have once had regarding the validity of the Challenged Claims has long since evaporated. Patent Owner argues that because “the ’337 patent issued on October 14, 2024, more than a decade before Meta’s petition was filed,” it therefore “has settled expectations in the ’337 patent that further support discretionary denial of institution.” Request, 2-3. 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.A.2. Moreover, the Board found that claims of the ’830 patent—which are materially the same as the Challenged Claims—were unpatentable. *See* § II.A.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. META-1051 (Apple IPR, Paper 10 (Institution Decision)) at 2; § II.A.4. Finally, Resonant disclaimed the majority of claims from the ’337 patent as well.

These proceedings have conferred on both Meta, and the 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. Denying institution here would disturb Meta’s and the public’s settled expectations resulting 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.

Further, as the Director noted in the Nintendo IPR Discretionary Denial Decision, any settled expectations in the patent can be and are outweighed by other factors such as the Board’s prior decision finding patentably indistinct claims unpatentable, *see* § II.A.3, and Patent Owner’s disclaimer of materially the same claims, *see* § II.A.2. *See* Nintendo IPR Discretionary Denial Decision, 3.

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 Meta raise interests under this factor.

7. Factor 7 Favors Institution Because Meta Seeks a Consistent Outcome for the Challenged Claims

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

Meta 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, Meta 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, Meta 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.A.3. Instituting Meta’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.

D. Patent Owner Fails to Justify its Request for Discretionary Denial

Patent Owner makes several arguments in support of its request, none of which justify discretionary denial or outweigh the extensive history of contradictory findings for patentably indistinct claims, and Patent Owner’s recent history of inconsistent claim construction positions on the ’337 patent.

First, Patent Owner complains that Meta’s motion for joinder is untimely and failed to follow the 2019 Consolidated Trial Practice Guide. Request at 1. Patent Owner made the same complaints in the Nintendo IPR (Ex. 1065), and the Director nevertheless denied its request for discretionary denial (Ex. 1064), apparently concluding that the other factors cited in the Nintendo IPR Discretionary Denial Decision outweighed any concerns about the joinder motion. The same result should apply here. Moreover, although the joinder decision is not before the Director at this stage of the proceedings, Resonant has forfeited any opposition to joinder by failing to timely file an opposition brief. 37 C.F.R. § 42.45(a)(1). And given that Meta seeks only to take a “silent understudy” role (Paper 3 at 1), and has not raised any separate issues, there is no reason to expect joinder to affect the trial schedule or to require any particular action from the Board (with respect to scheduling or otherwise).

Next, Patent Owner argues that “[c]onducting a second or third IPR on substantially identical grounds is not an efficient use of the Board’s resources and would be contrary to the workload management goals that motivated the Director’s March 26, 2025 memorandum.” Request, 2. But, as the Director held in the Nintendo IPR, “discretionary considerations are first reviewed for the Petition on its own, and then reviewed if joinder were to be granted.” Nintendo IPR Discretionary Denial Decision, 2. And the result of this analysis here is that if

joinder were granted, the projected final written decision date would be October 15, 2025, making it “even more likely that a final written decision will issue before the district court trial occurs.” *Id.*, 2-3. Thus, Meta’s request for joinder promotes, rather than hinders, Board efficiency.

Patent Owner further argues for discretionary denial based on the fact that the current trial date in the Meta litigation is “almost a month before” the projected final written decision date here (but only if joinder is not granted). Request, 2. But as the Director recognized, the fact that Meta is seeking to join the Apple IPR is highly relevant because it makes it “even more likely that a final written decision will issue before the district court trial occurs.” Nintendo IPR Discretionary Denial Decision, 3. Further, as explained above, Meta has moved to stay the district court litigation, trial statistics support a later trial date, and the Director has denied requests for discretionary denial in similar circumstances. *See supra* § III.A.

Finally, Patent Owner argues it has settled expectations based on the ’337 patent’s issuance date. Request, 2-3. As explained above, the public has contrary settled expectations in the ’337 patent’s invalidity given the prior proceedings on patentably indistinct claims. *See supra* § III.C.5. Further, the Director has already held that Patent Owner’s settled expectations were outweighed by other factors in the Nintendo IPR, for reasons that apply equally here. *See supra* § III.A.

IV. CONCLUSION

Institution is appropriate for the reasons explained herein and in the Petition. Meta respectfully requests that the Director deny Patent Owner's request to discretionarily deny institution of this IPR petition.

Dated: August 25, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing **PETITIONER’S
OPPOSITION TO PATENT OWNER’S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION** were caused to be served on
August 25, 2025 via electronic mail upon the following counsel of record for

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CERTIFICATE OF COMPLIANCE

This Opposition to Discretionary Denial Brief complies with the type-volume limitation of 14,000 words as it contains 4,498 words, excluding the parts exempted by 37 C.F.R. § 42.24(a).

This Opposition to Discretionary Denial Brief complies with the general format requirements of 37 C.F.R. § 42.24(a) and has been prepared using Microsoft Word in 14-point Times New Roman font.

Dated: August 25, 2025

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