Paper No. 11

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

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

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PATENT OWNER'S EXHIBIT LIST

No.	Description
Ex. 2001	Declaration of Robin Elenga on behalf of patent owner Resonant Systems, Inc.
Ex. 2002	June 10, 2019 presentation from RevelHMI to Nintendo
Ex. 2003	June 11, 2019 email from RevelHMI to Nintendo
Ex. 2004	*Resonant Systems v. Nintendo*, 2:25-cv-00090 (E.D. Texas), Docket Control Order
Ex. 2005	Eastern District of Texas Case Management Statistics

I. INTRODUCTION

The challenged '337 patent claims have been in force for more than a decade and have given rise to significant settled expectations. Moreover, Petitioners have been aware of this patent and its relevance to their products for more than six years. They nonetheless waited until now to seek any form of review of this patent's claims. Because these factors strongly favor discretionary denial and because other relevant factors are neutral or favor denial, the Director should exercise discretion and deny institution of this IPR petition.

II. ARGUMENT

A. Patent Owner's Settled Expectations Strongly Favor Discretionary Denial

The March 26, 2025 Interim Processes for PTAB Workload Management Memorandum ("Workload Memo") permits the parties to address "all relevant considerations" for discretionary denial and lists among possible considerations "[s]ettled expectations of the parties, such as the length of time the claims have been in force." Workload Memo at 2.

The challenged '337 patent issued on October 14, 2014, more than a decade before Nintendo's Petition was filed. Ex. 1001 at 1. The application leading to it was filed on May 31, 2012 and was a continuation-in-part of an application filed January 6, 2010, which itself lead to U.S. Patent No. 8,093,767, issued on January 10, 2010.

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A patent that has been in force for so long, from a patent family that predates the 2011 enactment of the America Invents Act, has created settled expectations. As the President and former CEO of Resonant Systems explains in his declaration, these settled expectations played an important role in Resonant's ability to raise investor capital to develop its compact and energy-efficient haptic technology. Ex. 2001, ¶¶ 1–2. These settled expectations also played an important role in allowing Resonant to engage in discussions with potential customers of its technology, as it did when it reached out to the Petitioners in 2019. Ex. 2001, ¶¶ 3–4.

These longstanding settled expectations should be respected and discretionary denial of institution be granted. *See iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, Case No. IPR2025-00363, Paper 10 (PTAB June 6, 2025) (granting discretionary denial of IPR for four related patents, issued between 2012 and 2018, on settled expectations grounds).

B. Petitioners' Longstanding Knowledge of the '337 Patent and Related Patents also Strongly Favors Discretionary Denial

Not only have the '337 patent and related patents been in force for over a decade, but the Petitioners have been aware of these patents and their relevance to their products since at least 2019.

As then-CEO of Resonant Robin Elenga explains in his declaration, he met on June 10, 2019 in Redmond, Washington with representatives of the

Petitioners, as potential customers of Resonant's compact and energy-efficient haptic technology. Ex. 2001, ¶ 3. At that meeting, he presented slides to the Nintendo representatives, which highlighted the existence of Resonant's patents and included a list of the patents it had been granted to date. Ex. 2001, ¶¶ 5–6; Ex. 2002 at 14, 18. That list included the '337 patent and three other members of the same patent family, 8,093,767, 9,369,081, and 9,941,830. Ex. 2002 at 18.

The following day, on June 11, 2019, Mr. Elenga emailed representatives of Petitioners, attaching a copy of the slides he had presented at the meeting. Ex. 2001, ¶ 6; Ex. 2002; Ex. 2003. As this evidence shows, Petitioners were aware of the '337 patent—and of related patents including the parent '767 patent—no later than June 2019. Ex. 2001, ¶ 7. Nintendo was also aware of the potential relevance of these patents to haptic technology that it uses or might use in its products. *See* Ex. 2002.

Despite this knowledge of the '337 patent and its relevance to its products, Nintendo failed to timely seek review of the patent. As the Director held in *iRhythm*, "Petitioner's awareness of Patent Owner's applications and failure to seek early review of the patents favors denial and outweighs [other contrary] considerations." *iRhythm*, Case No. IPR2025-00363, Paper 10 at 3.

C. The *Fintiv* Factors Favor Discretionary Denial

Prior to issuance of the Workload Memo, the Board had set forth six factors for determining whether discretionary denial in light of such parallel litigation is appropriate, and in analyzing them, "takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv I*"); *see also Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-17 (PTAB May 13, 2020) (informative) ("*Fintiv II*").

These six *Fintiv* factors are neutral or weigh in favor of exercising discretion to deny institution here. For Factor 1, no stay of the parallel district court litigation has been granted, and any claim that a stay is likely is speculative. For Factor 2, the district court trial is scheduled to begin within less than three weeks after the deadline for a final written decision in this proceeding. For Factor 3, fact discovery will be well underway by the time the Board issues its institution decision. For Factor 4, there is complete overlap in the claims and substantial overlap in the art at issue in this proceeding and in the district court; Petitioner has not made a *Sotera* stipulation to address the concerns of inefficiency and inconsistent rulings. For Factor 5, Petitioner is defendant in the parallel litigation. And for Factor 6, the Petition fails to present

a compelling challenge on the merits. Each of these factors is addressed in more detail below.

1. The *Fintiv* Factors Should Be Evaluated from an Assumption That Joinder Will Not Be Granted

Petitioners are likely to argue that the *Fintiv* factors should be evaluated based upon the assumption that this IPR will be joined with the pending IPR2024-00807 brought by Apple challenging the '337 patent, with a current final written decision due date of October 29, 2025. But it would not be proper to assume joinder at this stage of the proceeding. By statute, the decision to grant joinder to Nintendo can only be made after the time for submitting a preliminary response has passed, and the director has determined that Nintendo's petition "warrants the institution of an inter partes review." 35 U.S.C. § 315(c).

Moreover, as explained further in patent owner's supplemental reply brief filed concurrently as Paper 12, joinder would not be proper in this case. In particular, the Petitioners have not filed an authorized motion for joinder that follows the Board's deadlines and procedures. 37 C.F.R. § 42.20(b) provides that: "A motion will not be entered without Board authorization . . . in an order of general applicability or during the proceeding." No order authorizing a motion for joinder was filed during the proceeding, and the only order of general applicability authorizing joinder motions is 37 C.F.R. § 42.122(b),

which requires the motion to be filed "no later than ***one month*** after the institution date of any *inter partes* review for which joinder is requested" (emphasis added).

Here, IPR2024-00807 which Petitioners seek to join was instituted on October 15, 2024. *Apple Inc. v. Resonant Systems, Inc.*, Case No. IPR2024-00807, Paper 10 (PTAB October 15, 2024). The motion for joinder was not filed until March 10, 2025, nearly five months later. Paper 4.

If Petitioners wished to pursue joinder, based upon a motion filed so far outside of the deadline in § 42.122(b), they should at the very least have promptly reached out to the Board to address the issue. Indeed, the 2019 Consolidated Trial Practice Guide states that "A party who files a motion for joinder should arrange a conference call with the panel, petitioner, and patent owner of the first proceeding within five business days of filing the motion." Guide at 76. Here Petitioners waited until May 30, 2025—81 days after the joinder motion was filed—to arrange a conference call with the Board. Ex. 3001.

Any request to authorize a motion out of time would have been weak. The only cases Petitioners cite (*see* Paper 4 at 6) where the Board waived the one-month deadline were cases whether the petitioner had previously moved for joinder within one month but needed to file a revised petition after the one

month period. *Sony Corp. of Am. V. Network-1 Security Solutions, Inc.*, Case No. IPR2013-00495, Paper 13 at 7 (Sept. 16, 2013); *GlobalFoundries U.S. Inc. v. Good Kaisha IP Bridge 1*, Case No. IPR2017-00925, Paper 13 at 7 (June 9, 2017).

The one-month deadline of § 42.122(b) and five-business-day guideline of the Trial Practice Guide serve important goals by allowing the Board to resolve joinder issues early in the proceedings and to avoid disruptions and delays to proceedings that might result from late joinder. Having waited more than five years after learning of the '337 patent to raise this challenge and having failed to seek authorization for its joinder motion or otherwise comply with the Board's timelines for deciding joinder, Petitioners should not now be heard to demand that their improper request for joinder be granted and potentially disrupt a set of oral arguments that are scheduled for only a month from today. *Apple Inc. v. Resonant Systems, Inc.*, Case No. IPR2024-00807, Paper 26 (PTAB June 11, 2025).

2. *Fintiv* Factor 1: The district court has not granted a stay, nor is there any evidence that a stay will be granted.

In the parallel district court proceeding (*Resonant Systems, Inc. v. Nintendo Co., Ltd.*., Case No. 2:25-cv-00090-JRG (E.D. Tex.)) involving the same challenged claims of the '337 Patent and involving the Petitioner, the district court has not granted a stay pending IPR. Further, any argument that

Nintendo's pending motions to stay or to transfer the case are likely to be granted would be speculative. *See Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, Case No. IPR2025-00223, Paper 9 at 3 (PTAB June 12, 2025) ("Petitioner's arguments based on the likelihood of the district court granting its motion to transfer are speculative and not sufficiently persuasive to overcome the aforementioned considerations favoring discretionary denial.")

3. *Fintiv* Factor 2: The district court trial will occur more than four months before the deadline for a final written decision in this proceeding.

"If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*." *Fintiv I* at 9.

Here, absent joinder the deadline for a final written decision in this IPR is October 16, 2026, which may be extended to April 16, 2027, for good cause or in the case of joinder. 37 C.F.R. § 42.100(c). Meanwhile, the district court litigation is set for trial on November 2, 2026. (Ex. 2004 at 1.) The timeframe set by the district court is consistent with the Federal Court Management Statistics for the Eastern District of Texas. Those statistics indicate that, over the past six years, a civil case in the district was brought to trial 21.3 months after filing. Ex. 2005 (indicating median times to trial for civil cases for the twelve-

month period ending in March for 2020-2025 as 17.7, 19.5, 24.2, 19.0, 21.3, and 25.9). Here, the trial is set approximately 21 months after January 31, 2025, the date the case was filed. (Ex. 2004 at 1; *Resonant Systems, Inc. v. Nintendo Co., Ltd.*., Case No. 2:25-cv-00090-JRG (E.D. Tex.), Dkt. 1.)

Thus, the district court trial is set to occur only 17 days after the deadline for a final written decision, and possibly more than five months before the deadline if extended. This weighs against institution. By the time of a final written decision, the parties will have already completed a substantial majority of the work required to try the case, and the court will have invested a very substantial amount of work into the case. *See iRhythm*, Case No. IPR2025-00363, Paper 10 at 3 (denying institution even though final written decision was due seven months prior to scheduled trial).

4. *Fintiv* Factor 3: By the time an institution decision is reached, fact discovery will be well underway.

Factor 3 relates to the "amount and type of work already completed in the parallel litigation by the court and the parties ***at the time of the institution decision***." *Fintiv I* at 9 (emphasis added). Here, the institution decision is due on October 16, 2025. By then, the parties will have exchanged contentions, discovery will have been ongoing for months, and the claim construction process will be about to begin. Ex. 2004 at 4.

5. *Fintiv* Factor 4: There is substantial overlap between this IPR and the district court proceeding.

This factor looks at "whether all or some of the claims challenged in the petition are also at issue in district court" and whether the "petition includes the same or substantially the same claims, grounds, arguments, and evidence" as the parallel district court case. *Fintiv I* at 12-13. Here, there is complete overlap between the challenged and asserted claims.

Petitioners argue that their *Sand Revolution* stipulation will reduce overlap in the issues. Paper 1 at 85. But this extremely limited stipulation should not be given any weight. It not only does not cover other art that could have been raised in the IPR petition, but it also does not cover grounds based upon the same art raised in the petition or upon combinations of such art with other art. *See Motorola Sol'ns, Inc. v. Stellar, LLC*, Case No. IPR2024-01205, Paper 19 at 4 (PTAB March 28, 2025) (vacating grant of institution and holding that *Sotera* stipulation did not outweigh other factors where district court invalidity arguments included "combinations of the prior art asserted in these proceedings with unpublished system prior art"); *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365–66 (Fed. Cir. 2025) ("IPR estoppel does not preclude a petitioner from asserting the same prior art raised in an IPR in district court, but rather precludes a petitioner from asserting grounds that were raised or reasonably could have been raised during an IPR").

6. *Fintiv* Factor 5: Petitioner is the defendant in the district court litigation.

Petitioner is defendant in the parallel litigation. "Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial." *Fintiv II* at 15.

7. *Fintiv* Factor 6: Other circumstances weigh strongly against institution, including the weakness of the Petition and Petitioner's delay.

This factor looks at "other circumstances that impact the Board's exercise of discretion, including the merits." *Fintiv I* at 9. The only evidence that the Petition points to on this factor is the decision to institute Apple's IPR on this patent. Paper 1. But this alone cannot be sufficient to overcome the other factors supporting discretionary denial, because the only petitions where discretionary denial would make a difference are precisely those that establish a reasonable likelihood of success on the merits.

III. CONCLUSION

For the foregoing reasons, the *Fintiv* factors are either neutral or weigh somewhat in favor of discretionary denial. The long settled expectations of the patent owner and Petitioners' failure to previously seek review of this patent, in spite of knowing of the patent and its relevance for more than five years, strongly favor discretionary denial. Accordingly, Resonant respectfully

asks that the Director exercise discretion and deny institution of this IPR petition.

Dated: June 16, 2025

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CERTIFICATE OF WORD COUNT

I certify that there are 2,545 words in this paper, excluding the portions exempted under 37 C.F.R. § 42.24(a)(1), according to the word count tool in Microsoft Word.

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CERTIFICATE OF SERVICE

I hereby certify that "Patent Owner's Request for Discretionary Denial of Institution" was served on June 16, 2025 by email sent to:

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