

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

META PLATFORMS, INC.,
Petitioner,

v.

RESONANT SYSTEMS, INC.,
Patent Owner.

IPR2025-00823
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
Denying Institution of *Inter Partes* Review

Resonant Systems, Inc. (“Patent Owner”) filed a request for discretionary denial (Paper 7, “DD Req.”) in the above-captioned case, and Meta Platforms, Inc. (“Petitioner”) filed an opposition (Paper 8, “DD Opp.”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is 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.

Some considerations counsel against discretionary denial. For example, the projected final written decision due date in this Board proceeding is November 25, 2026. DD Req. 2. The parties have jointly moved to stay the parallel proceeding in district court. DD Opp. 6; Ex. 1062. As such, it is likely that a final written decision will issue before the district court trial occurs. The projected final written decision due date in IPR2024-00807, the proceeding Petitioner seeks to join, is October 15, 2025. Therefore, if joinder were granted, it is even more likely that a final written decision will issue before the district court trial occurs.

Additional considerations also counsel against discretionary denial. 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. 12. 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. *Id.* at 16.

Other considerations, however, weigh in favor of discretionary denial. This Petition is the fourth petition for *inter partes* review of the challenged patent. The first petition was denied, and no trial was instituted. *Sony Interactive Entm't Inc. v. Resonant Sys., Inc.*, IPR2024-00569, Paper 9 (PTAB Aug. 26, 2024) (denying institution). The second petition was granted, trial was instituted, and a final written decision by the Board is pending. *Apple*, IPR2024-00807, Paper 10. As noted above, this is the proceeding Petitioner seeks to join. The third petition, which also requests joinder to IPR2024-00807, was referred to the Board to handle the case in the normal course. *Nintendo Co. Ltd. v. Resonant Sys., Inc.*, IPR2025-00680, Paper 18 (Director Aug. 14, 2025).

Petitioner has not adequately shown why a fourth petition requesting *inter partes* review of the challenged patent is appropriate here. Nor has Petitioner sufficiently explained why there is a need for another party to join the ongoing proceeding in IPR2024-00807. Under these circumstances, it is not an efficient use of Board resources to further consider the Petition.

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition is denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *granted*; and

IPR2025-00823
Patent 8,860,337 B2

FURTHER ORDERED that the Petition is *denied*, and no trial is instituted.

IPR2025-00823
Patent 8,860,337 B2

FOR PETITIONER:

Brian Ferguson
WINSTON & STRAWN LLP
beferguson@winston.com

FOR PATENT OWNER:

Reza Mirzaie
Kristopher Davis
Neil Rubin
Qi Tong
RUSS AUGUST & KABAT
rmirzaie@raklaw.com
kdavis@raklaw.com
nrubin@raklaw.com
ptong@raklaw.com