

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.: IPR2025-01098
U.S. Patent No. 8,860,337
Issue Date: October 14, 2014

Title: LINEAR VIBRATION MODULES AND LINEAR-RESONANT
VIBRATION MODULES

**PETITIONER'S EXPLANATION FOR AND RANKING OF TWO
PETITIONS CHALLENGING U.S. PATENT NO. 8,860,337**

I. INTRODUCTION

Petitioners Nintendo Co., Ltd., and Nintendo of America Inc. (collectively, “Nintendo” or “Petitioners”) provide this explanation of multiple petitions challenging U.S. Patent No. 8,860,337 (the “’337 patent”).

Patent Owner’s gamesmanship has required Nintendo to file two petitions challenging claims 2 and 3 of the ’337 patent (“the Challenged Claims”). And while Nintendo presents two petitions, it requests that the Board institute only one petition. See IPR2025-00680 (filed March 10, 2025) (“First Petition”)¹ and IPR2025-01098 (filed June 23, 2025) (“Second Petition”). The petition that the Board should institute turns on the Board’s decision on Nintendo’s Motion for Joinder. IPR2025-00680, Paper 4.

Nintendo’s First Petition is a “copycat” of a petition filed by Apple, Inc. (“Apple”). On October 15, 2024, the Board instituted *Inter Partes* Review of the Apple petition (“Apple IPR”), which challenges claims 2-3 of the ’337 patent. That IPR followed an infringement action filed against Apple on June 1, 2023. Patent Owner did not sue Nintendo, however, at that time. Instead, Patent Owner waited until January 31, 2025, to sue Nintendo Co., Ltd. In view of the Board’s desire for

¹ The Petition in IPR2025-00680, as filed, challenges Claims 1-4 because it is a “copycat IPR.” Claims 1 and 4 from the ’337 patent have been disclaimed.

efficient proceedings, 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 IPR2025-00680. Along with its petition in IPR2025-00680, Nintendo filed a Motion for Joinder to join the Apple IPR. In the first instance, Nintendo requests that the Board institute this IPR and grant joinder. As Nintendo explained in its joinder motion, joining Nintendo to the Apple IPR would promote efficiency and avoid duplicative work by the parties and the Board. IPR2025-00680, Paper 4.

If the Board is not inclined to join Nintendo to the Apple IPR, it should institute Nintendo’s Second Petition. The grounds in Nintendo’s Second Petition follow from Resonant’s gamesmanship resulting from unfavorable Board decisions on a related patent. On June 14, 2023, Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”) (which was sued by Patent Owner) filed IPR petitions against patents that are related to the ’337 patent. The Samsung IPRs advance different art than the Apple IPR. After institution of an IPR against one of those patents—U.S. Patent No. 9,369,081 (“the ’081 patent”)—Patent Owner statutorily disclaimed claims that are materially the same as the Challenged Claims. Further, on January 8, 2025—weeks before Patent Owner sued Nintendo on January 31, 2025—the Board issued its Final Written Decision in one of these other IPRs. There, the Board held unpatentable claims in U.S. Patent No. 9,940,830 (“the

'830 patent") that are materially the same as the Challenged Claims. The Challenged Claims are thus materially identical to claims that Resonant statutorily disclaimed in the '081 patent and that the Board already held unpatentable in the '830 patent. The Second Petition, which asserts against the '337 patent the same grounds that led to the Board's unpatentability finding against the '830 patent, will therefore undoubtedly be successful.

Patent Owner's gamesmanship forced Nintendo to seek joinder with a First Petition while preparing a Second Petition that includes the Samsung grounds. Patent Owner continues its gamesmanship by arguing against joinder both in supplemental briefing and in its discretionary denial briefing. This is despite Patent Owner's failure to file any opposition to Nintendo's joinder motion pursuant to 37 C.F.R. § 42.25(a)(1). What is more, Patent Owner indicated on a call with the Board that it is urging Apple to terminate its IPR, apparently seeking another avenue to defeat Nintendo's joinder. Thus, in the event that the Board denies joinder (e.g., in view of the parties terminating that IPR), Nintendo filed its Second Petition in IPR2025-01098 by combining (1) a ground from the instituted Apple IPR and (2) prior art from the Samsung IPR that led to a finding of unpatentability for claims that are materially identical to claims 2-3 of the '337 patent. Thus, should the Board deny joinder, Nintendo respectfully requests that the Board institute Nintendo's Second Petition (IPR2025-01098).

II. EXPLANATION OF WHY NINTENDO FILED TWO PETITIONS

Patent Owner's behavior throughout its years-long campaign of asserting the '337 patent (and related patents) against several defendants put Nintendo in a position where it had little choice but to file multiple petitions for IPR. A review of Patent Owner's litigation campaign demonstrates that it has attempted to avoid not only adverse decisions by the Board, but its own statutory disclaimer of claims that are materially the same as those it asserted against Nintendo.

Between 2022 and 2023, Patent Owner sued several defendants including Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc., Sony Group Corporation and Sony Interactive Entertainment, Inc. (collectively, "Sony"), and Apple, Inc. in separate cases alleging infringement of the '337 patent (against Apple and Sony) and other related patents (against Apple, Sony, and Samsung).

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-1027 (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-1028 (Apple IPR, Ex. 2008). As a result of Patent Owner's statutory disclaimer, only claims 2 and 3 of the '337 patent remain. On October 15, 2024, the Board instituted the Apple IPR for 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-1057 (Apple IPR, Paper 10 (Institution Decision)) at 7, 48.

Separately, Samsung also filed petitions for *Inter Partes* Review challenging U.S. Pat. Nos. 9,369,081 and 9,941,830, relying on different prior art than in the Apple IPRs. NINTENDO-1029 (IPR2023-00992 (“Samsung ’081 IPR”), Paper 3); NINTENDO-1030 (IPR2023-00993 (“Samsung ’830 IPR”), Paper 3). The ’830 and ’081 patents are continuations of the ’337 patent with materially identical specifications.

After the Board instituted the Samsung ’081 IPR, Patent Owner statutorily disclaimed claims 15 and 16 of the ’081 patent. NINTENDO-1031 (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-1059 (’337/’081 Claim Comparison).

On January 8, 2025, the Board issued a Final Written Decision in the Samsung ’830 IPR. NINTENDO-1058 (Samsung ’830 IPR, Paper 48). Relevant here, the Board found claims 1, 15, 16, and 17 unpatentable over the prior art. Claims 2 and 3 of the ’337 patent—which are the only remaining claims of the ’337 patent—are materially the same as those that the Board found unpatentable in the Samsung ’830 IPR. NINTENDO-1060 (’337/’830 Claim Comparison).

On January 31, 2025, Patent Owner sued Nintendo alleging infringement of the '337 patent. NINTENDO-1032. Patent Owner's complaint was filed 1) after the Board instituted the Apple IPR on October 15, 2024; 2) after the Board issued its Final Written Decision in the Samsung IPR on January 8, 2025; and 3) after Patent Owner had already disclaimed claims virtually identical to the remaining claims in the '337 patent.

Patent Owner accused the Nintendo Switch, a gaming console, of infringing. *Id.* 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 its IPR petition which is substantively identical to Apple's petition, and Nintendo also moved to join the already-instituted Apple IPR. NINTENDO-1034 (IPR2025-00680, Paper 1 (Petition)); NINTENDO-1035 (IPR2025-00680, Paper 4 (Motion for Joinder)).

Patent Owner's tactical behavior seeks to put Nintendo in an untenable position. On the one hand, Nintendo understands that for the sake of efficiency the Board may prefer Nintendo to seek joinder of an existing proceeding (*i.e.*, the Apple IPR), necessitating the first "copycat" petition. But while Patent Owner failed to oppose Nintendo's joinder motion as required by 37 C.F.R. § 42.25(a)(1), it nevertheless opposed joinder and institution as part of supplemental briefing and its discretionary denial briefing. See NINTENDO-1036 (IPR2025-00680, Paper 8

(Order granting Nintendo leave to file a supplemental brief in support of joinder)); NINTENDO-1037 (IPR2025-00680, Paper 9 (Nintendo's Supplemental Brief in Support of Motion for Joinder)); NINTENDO-1044 (IPR2025-00680, Paper 11 (Patent Owner's Request for Discretionary Denial of Institution)); NINTENDO-1045 (IPR2025-00680, Paper 12 (Patent Owner's Supplemental Reply Brief Opposing Petitioners' Motion for Joinder)).² Notably, Patent Owner is also actively attempting to terminate this proceeding and prevent Nintendo from joining. See NINTENDO-1036 (IPR2025-00680, Paper 8); NINTENDO-1037 (IPR2025-00680, Paper 9).

On the other hand, Patent Owner should not be able to assert claims that the Board, in effect, already found unpatentable in the Samsung IPR. But that is precisely what Patent Owner is trying to do. As a result, Nintendo presents its Second Petition (IPR2025-01098) in the event that its joinder motion is denied. Nintendo's Second

² The Apple IPR was instituted on October 15, 2024, so joinder motions under § 42.122(b) were to be filed by November 15, 2024. Nintendo, however, was only sued on January 31, 2025. Thus, Nintendo had no reason or motivation to join the Apple IPR until after January 31, 2025. Even after moving expeditiously, Patent Owner's strategic choice of timing ensured Nintendo could not meet this deadline. This required Nintendo to request that the Board waive the usual one-month deadline for joinder motions under § 42.5(b). NINTENDO-1035 (IPR2025-00680, Paper 4).

Petition raises three sets of grounds. One set (Ground 1) comprises the same prior art as one of the grounds in the Apple IPR Petition, which the Board already instituted. This set of grounds is necessary because Patent Owner is attempting to terminate that proceeding (and do so before Nintendo can join that proceeding). The second set of grounds (Grounds 2 and 3) are unique to Nintendo’s Second Petition but rely on the same art as raised in the Samsung ’830 IPR. The last set of grounds (Grounds 4 and 5) comprise the same prior art as grounds of the Samsung ’830 IPR which the Board already determined render obvious the same claim limitations in the related ’830 Patent.

III. ORDERING OF PETITIONS

In view of the guidance in the consolidated trial practice guide (Guide, 60), Nintendo requests that the Board consider the petitions in the following order:

Order	IPR Case No.	Challenged Claims
1 ³	IPR2025-00680	2-3 ⁴
2	IPR2025-01098	2-3

³ If the Motion for Joinder in IPR2025-00680 is not granted, the order would be reversed. In that situation Nintendo ranks IPR2025-01098 as 1 and IPR2025-00680 as 2.

⁴ Again, Patent Owner statutorily disclaimed all but claims 2 and 3 of the ’337 patent. However, the petition as originally filed challenged claims 1-4.

IV. CONCLUSION

Nintendo respectfully requests that the Board grant institution of IPR2025-00680 if Nintendo's Motion for Joinder in that proceeding is granted. But if the Board does not grant Nintendo's Motion for Joinder in IPR2025-00680, Nintendo respectfully requests that the Board grant institution of IPR2025-01098.

Respectfully submitted,

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Dated: June 23, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing PETITIONER'S EXPLANATION FOR AND RANKING OF TWO PETITIONS CHALLENGING U.S. PATENT NO. 8,860,337 were caused to be served on June 23, 2025 via overnight courier upon the following counsel of record for Patent Owner:

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Copies of this Notice were also served via electronic mail on Patent Owner's counsel of record for related PTAB proceedings and in the related district court litigation – RUSS AUGUST & KABAT:

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