

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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

v.

RESONANT SYSTEMS, INC.,  
Patent Owner

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Case No.: IPR2025-00680  
U.S. Patent No. 8,860,337  
Issue Date: October 14, 2014

Title: LINEAR VIBRATION MODULES AND LINEAR-RESONANT  
VIBRATION MODULES

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**PETITIONERS' MOTION FOR JOINDER  
UNDER 35 U.S.C. §315(C) AND 37 CFR § 42.122(B)**

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## **I. STATEMENT OF THE PRECISE RELIEF REQUESTED**

Petitioners Nintendo Co., Ltd., and Nintendo of America Inc. (“Nintendo”), respectfully submit this Motion for Joinder (“Motion”) together with a Petition (“Nintendo Petition”) for *Inter Partes* Review of U.S. Patent. No. 8,860,337 (the “’337 Patent”). The Board instituted *inter partes* review of claims 2-3 of the ’337 Patent in *Apple Inc. v. Resonant Systems, Inc.*, IPR2024-00807 (“Apple IPR”) on October 15, 2024. See IPR2024-00807, Paper 10 (claims 1, 4, and 5 were statutorily disclaimed before institution). Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b), Nintendo respectfully requests institution of an *inter partes* review of the same claims of the ’337 Patent based on the same grounds presented in the Apple IPR and requests joinder with the Apple IPR.

Nintendo submits that joinder is appropriate because: (1) the Nintendo Petition is substantively identical to Apple Inc.’s petition (“Apple Petition”) in the Apple IPR, including that it relies on the same expert declaration; (2) the Apple IPR is ongoing with an active petitioner and Nintendo is not seeking to replace one petitioner with another; (3) Nintendo is willing to assume a “silent understudy” role only assuming an active role in the event Apple ceases to participate in the instituted IPR; and (4) joinder would not affect the pending schedule in the Apple IPR nor increase the complexity of that proceeding, minimizing costs. Moreover, the petitioner in the Apple IPR does not oppose Nintendo’s joinder. Accordingly, joinder

is appropriate because it will promote efficient determination of the validity of the '337 Patent in a single IPR proceeding without prejudice to Patent Owner.

Although this Motion is being filed after the one-month date on which the Apple IPR was instituted, the Board should exercise its discretionary authority under § 42.5(b) to grant this motion. Patent Owner chose to sue Nintendo Co., Ltd., well after that one-month date. Moreover, despite Patent Owner suing the wrong Nintendo entity in the Eastern District of Texas (“the EDTX Action”) and despite the substantial case history and materials to review (e.g., related litigations materials, related IPRs, and prior art), Nintendo moved swiftly; it retained counsel, proactively agreed to waive service, and prepared and filed its petition and this joinder motion just 38 days after Patent Owner filed the EDTX Action.

## **II. BACKGROUND AND RELATED PROCEEDINGS**

### **A. Related District Court Litigation**

The '337 Patent is the subject of the following district court litigation:

- *Resonant Systems, Inc. v. Nintendo Co., Ltd.*, Civil Action No. 2:25-cv-00090-RSG (E.D. Tex., filed January 31, 2025);
- *Resonant Systems, Inc. v. Meta Platforms, Inc.*, Civil Action No. 7:25-cv-00035-DC (W.D. Tex., filed January 31, 2025);
- *Resonant Systems, Inc. v. Apple, Inc.*, Civil Action No. 7:23-cv-00077-ADA (W.D. Tex., filed June 1, 2023); and

- *Resonant Systems, Inc. v. Sony Group Corporation (Japan) et al.*, Civil Action No. 2:22-cv-00424-JRG (E.D. Tex., filed October 26, 2022).

In addition, Resonant has asserted patents related to the '337 Patent in:

- *Resonant Systems, Inc. v. Samsung Electronics Co. Ltd.*, Civil Action No. 2:22-cv-00423-JRG (E.D. Tex., filed October 26, 2022).

## **B. Related IPR Proceedings**

Besides the present petition, the Apple IPR is the only active IPR challenging the claims of the '337 Patent. Apple filed its petition for *inter partes* review of the '337 Patent on April 12, 2024. IPR2024-00807, Paper 1. The Board instituted review in the Apple IPR on October 15, 2024. IPR2022-00807, Paper 10.

Nintendo also intends to file IPR2025-00681 in the alternative to the instant petition IPR2025-00680 should the Board decline to grant this motion (along with the Notice of Ranking and Material Differences between Petitions in this proceeding and IPR2025-00681). Other PTAB proceedings challenging related patents that may involve similar claim construction and validity issues include the following: IPR2023-00992, IPR2023-00993, IPR2023-01025, IPR2024-00568, IPR2024-00569, IPR2024-00697, IPR2024-00698, IPR2024-00806, IPR2024-00808, and IPR2024-00983.

### **III. STATEMENT OF MATERIAL FACTS**

#### **A. The Apple IPR**

1. On April 12, 2024, Apple filed its petition for *inter partes* review of claims 1-4 of the '337 Patent.
2. Before Resonant filed its Preliminary Response, Resonant filed an Exhibit evidencing that it filed a disclaimer under 37 C.F.R. 1.321(a) statutorily disclaiming claims 1, 4, and 5 of the '337 Patent. IPR2024-00807, Ex. 2008.
3. On October 15, 2024, the Board entered a decision instituting *inter partes* review of the remaining challenged claims, claims 2 and 3 of the '337 Patent in the Apple IPR (IPR2024-00807, Paper 10) on the grounds that claims 2 and 3 were unpatentable under 35 U.S.C. § 103(a).
4. Apple is an active petitioner in the Apple IPR and the Apple IPR is still pending. Petitioner Apple's reply to Patent Owner Resonant's response is currently scheduled for May 20, 2025 in the Apple IPR.

#### **B. Resonant's Suit against Nintendo in the Eastern District of Texas**

5. Resonant filed a suit against Nintendo Co., Ltd., in the Eastern District of Texas ("the EDTX Action") on January 31, 2025, more than three months after the Apple IPR was instituted.

6. Concurrently with this Motion for Joinder, Nintendo is filing a Petition for *inter partes* review of claims 1-4 of the '337 Patent.
7. Nintendo's Petition is therefore timely under 35 U.S.C. § 315(b) because it is filed less than one year after Nintendo was served with the complaint in the EDTX Action.
8. The Petition includes grounds that are substantively identical to the grounds instituted in the Apple IPR.

#### **IV. LEGAL STANDARD**

The Leahy-Smith America Invents Act ("AIA") permits joinder of like review proceedings, e.g., an *inter partes* review ("IPR") may be joined with another *inter partes* review. 37 C.F.R. § 42.122(a). The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which states:

If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other

considerations, while being “mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, Paper No. 17 (July 29, 2013) at 3. The Board should consider “the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *Id.* at 10. Under this framework, joinder of Nintendo’s Petition with the Apple IPR is appropriate.

“A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.” *Id.* at 4.

Under 37 C.F.R. § 42.5(b), “[t]he Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.” The Board has exercised its authority under § 42.5(b) to waive the one-month deadline set out in § 42.122(b). *See, e.g., Sony Corp. of Am. V. Network-1 Security Solutions, Inc.*, IPR2013-00495, Paper 13 (Sept. 16, 2013); *GlobalFoundries U.S. Inc. v. Good Kaisha IP Bridge 1*, IPR2017-0925, Paper 13 (June 9, 2017).

## **V. STATEMENT OF REASONS FOR RELIEF REQUESTED**

### **A. Joinder will not impact the Board's ability to complete the review in a timely manner**

Joinder with the Apple IPR is appropriate because the Nintendo Petition involves the same patent, challenges the same claims, and is based on the same grounds and supported by the same technical expert declaration and evidence as the Apple Petition. Additionally, as noted below, the Nintendo Petition raises only the grounds instituted in the Apple IPR. In short, the Nintendo Petition is substantively identical to the Apple Petition. On the merits, the Nintendo Petition should therefore be instituted for at least the same reasons that the Board instituted the Apple Petition.

Further, good cause exists to allow joinder, given that the Nintendo Petition is substantively identical to the Apple Petition, and joinder would allow the Board to effectively resolve the identical challenges raised by both parties in a single proceeding. Nintendo would not be time barred from filing the present Petition without a corresponding motion for joinder. However, determining the same validity questions concerning the '337 patent in separate concurrent proceedings would duplicate efforts, and create a risk of inconsistent results and piecemeal review. Proceeding with a consolidated *inter partes* review would avoid potential inconsistency, promote efficient review of the same claims for the same patent under the same grounds, and would result in a final written decision without delay.

Accordingly, joinder in this case does not impact the Board's ability to complete its review in a timely manner.

Nintendo respectfully proposes that as long as Apple remains in the joined IPR, Nintendo remains in a limited "silent understudy" role that does not actively participate in the IPR. Nintendo agrees that it will not file additional written submissions, nor will Nintendo pose questions at depositions or argue at oral hearing. Only in the event that Apple ceases to participate in the IPR will Nintendo seek to become active in the joined IPR.

Nintendo Co., Ltd., is currently involved in litigation based on Patent Owner's allegation that Nintendo's products infringe the '337 Patent. *See Resonant Systems, Inc. v. Nintendo Co., Ltd.*, Civil Action No. 2:25-cv-00090-RSG, Dkt. No. 1 (E.D. Tex. Jan. 31, 2025). Nintendo therefore has a particular interest in the substantial questions of invalidity surrounding the '337 Patent. Joinder is appropriate for the additional reason that the invalidity grounds as to the challenged claims can be resolved if Nintendo continues participation in the IPR process through Final Written Decision, even if Apple ceases to participate in that proceeding. The public interest in "permitting full and free competition in the use of ideas which are in reality a part of the public domain" thus favors joinder. *Lear, Inc. v. Adkins*, 395 U.S. 653, 670 (1969).

**B. Nintendo’s Petition proposes no new grounds for unpatentability**

The Nintendo Petition does not present any new grounds or arguments regarding unpatentability. It is substantively identical to the Apple Petition.<sup>1</sup> The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *BlackBerry Corp. v. Uniloc 2017 LLC*, IPR2019-01283, Paper 10 at 8 (PTAB Nov. 5, 2019) (quoting *Samsung et al. v Raytheon Co.*, IPR2016-00962, Paper 12 at 9). This factor therefore favors joinder.

**C. Joinder will not unduly burden or negatively impact the Apple IPR trial schedule**

Joinder will not unduly burden Patent Owner. Because the Nintendo Petition presents the same grounds and arguments as the Apple Petition, there are no new issues for Patent Owner to address. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 15, 2015) (granting motion for joinder and instituting IPR where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]”).

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<sup>1</sup> The Nintendo Petition includes a summary of the preliminary reply and preliminary sur-reply in view of these papers being part of the Apple Institution Decision.

Likewise, joinder will not negatively impact the Apple IPR trial schedule. Nintendo expressly consents to the existing trial schedule. Further, Nintendo expressly agrees to take a “silent understudy” role in the joined proceeding, so long as Apple remains an active part in the joined proceeding. *See, e.g., Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 6–8 (PTAB May 30, 2019) (granting motion for joinder where the movant presented a substantively identical petition and agreed to take an “understudy” role in the joined proceeding); *Intel Corp. v. Alacritech, Inc.*, IPR2018-01352, Paper 11 at 3–5 (PTAB Jan. 8, 2019) (same).

Finally, the Nintendo Petition relies on the same technical expert declaration as the Apple Petition. Ex. 1003 (Decl. of Dr. Blake Hannaford). Therefore, joinder will not increase the complexity of the proceeding. Indeed, the Board typically grants joinder even where a petitioner presents a different witness with a substantially similar declaration. *See, e.g., Pfizer Inc. v. Sanofi-Aventis Deutschland GmbH*, IPR2019-00980, Paper 12 at 3–4, 6–7 (PTAB Aug. 15, 2019); *Everlight Electronics Co., Ltd.*, IPR2018-01260, Paper 12 at 4, 6–7 (PTAB Nov. 14, 2018); *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 (Oct. 30, 2018).

In fact, joinder is likely more convenient and efficient for Patent Owner by providing a single trial on the ’337 patent. By allowing all grounds of invalidity to be addressed in a single proceeding, the interests of all parties and the Board will be well served.

**D. Nintendo's joinder will not affect existing briefing and discovery schedules in the Apple IPR**

Nintendo agrees to take a “silent understudy” role in the joined proceeding, absent the original petitioner (Apple) withdrawing as a party. Specifically, Nintendo agrees to the following conditions regarding the joined proceeding, so long as Apple remains an active party in the joined proceeding:

1. Nintendo will not be making any substantive filings, and Nintendo agrees that Apple alone will be responsible for all substantive petitioner filings in the joined proceeding;
2. Nintendo agrees to be bound by all filings by Apple in the joined proceeding, except for filings regarding termination and settlement;
3. Nintendo must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding;
4. Nintendo shall not be permitted to raise any new grounds not already instituted by the Board in the Apple IPR, or introduce any argument or discovery not already introduced by Apple;
5. Nintendo shall be bound by any agreement between Patent Owner and Apple concerning discovery and depositions;
6. Nintendo will not cross-examine or defend any witness at deposition;
7. Apple will be responsible for any oral hearing presentation, including the preparation of demonstrative exhibits.

Only if Apple ceases participation in the proceeding:

8. Nintendo would assume a primary role, meaning it would take over the role previously filled by Apple.

*See Ericsson Inc. v. Uniloc 2017 LLC*, IPR2020-00376, Paper 16 at 10 (granting a motion for joinder with the same conditions).

The eight conditions listed above are intended to capture Petitioners’ proposed “silent understudy” role. The conditions are also consistent with the Board’s stated conditions of joinder in other cases. *Id.*; *see also AT&T Servs., Inc. v. Convergent Media Solutions, LLC*, IPR2017-01235, Paper 11 at 36–37 (PTAB May 9, 2017) (Lee, J.) (granting joinder with similar limitations on an understudy).

The Board has consistently found that the acceptance of an “understudy” role removes any undue complications or delay that might allegedly result from joinder. *See, e.g., Apple*, IPR2019-00958, Paper 9 at 6–8 (granting motion for joinder where the movant presented a substantively identical petition and agreed to take an “understudy” role in the joined proceeding); *Intel Corp.*, IPR2018-01352, Paper 11 at 3–5 (same); *Sony Corp.*, IPR2015-01353, Paper 11 at 6–7. As such, this factor also favors joinder.

**E. The Board should waive the usual one-month deadline for joinder motions**

While Nintendo’s joinder motion is filed outside the one-month deadline set forth in § 42.122(b), Nintendo respectfully requests that the Board waive that

deadline and permit joinder under § 42.5(b) for the reasons stated above and also the following reasons.

1. The Apple IPR is pending and currently has an active petitioner.

Accordingly, Nintendo's motion for joinder does not seek to substitute one petitioner with another. Nintendo is seeking to join the existing proceeding before any settlement or termination occurs. *See Sony*, IPR2013-00495, Paper 13 at 9.

2. Nintendo moved diligently and expeditiously to file its joinder motion as soon as possible. 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 Co. Ltd, however, was only sued on January 31, 2025. Thus, Nintendo had no motivation to join the Apple IPR until after January 31, far after November 15.

After being sued on January 31, Nintendo diligently and expeditiously retained counsel and prepared the present petition and joinder motion. At the outset, Nintendo's efforts were complicated by Resonant's failure to name the correct party in its lawsuit; despite Nintendo of America's presence in the United States, Resonant chose to sue Nintendo Co. Ltd., a Japanese company that does not market or sell the accused products in the United States (and which proactively agreed to waive service). Nintendo's preparation of the present petition was further complicated by the need to review the complex litigation history—involving not just the '337 patent but also other related patents—before district courts and the PTAB. § II.A-B. Many

of the issues in these cases are highly relevant to the case against Nintendo. In addition to its standard defense preparation, Nintendo had to evaluate the prior art advanced against the '337 patent (and related patents) by other defendants in the Resonant litigations. Despite these non-standard issues, Nintendo retained counsel, agreed to waive service, and managed to prepare and file its joinder motion within just 38 days of Resonant filing the EDTX Action Complaint against Nintendo Co., Ltd.

**F. If joinder were denied, Nintendo would seek institution of a separate petition with distinct grounds of unpatentability**

In addition to the present petition, Nintendo intends to file a separate petition for IPR (“Second Petition”) that includes grounds in addition to some (or all) of the grounds in the Apple IPR. As Nintendo will explain in its Notice of Ranking and Explaining Material Differences between Petitions, the present petition would be Nintendo’s first choice if joinder were granted. However, if joinder were denied, Nintendo’s Second Petition would be its first choice. The Second Petition introduces arguments and grounds not present in the Apple Petition and not presently before the Board. This would consume more of the Board’s and of Patent Owner’s resources and time. Accordingly, joinder of Nintendo to the Apple IPR is appropriate as it reduces the burden to the Board and Patent Owner relative to Nintendo’s alternative approach.

## VI. CONCLUSION

For the foregoing reasons, Nintendo respectfully requests that its Petition for *Inter Partes* Review of U.S. Patent No. 8,860,337 B2 be granted and that the proceedings be joined with *Apple Inc. v. Resonant Systems, Inc.*, IPR2024-00807.

Dated: March 10, 2025

Respectfully submitted,

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## CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing **PETITIONERS' MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)** were caused to be served on March 10, 2025 via overnight courier upon the following counsel of record for Patent Owner:

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Copies of this Petition and accompanying documents and exhibits 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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