

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

RESONANT SYSTEMS, INC.,
Patent Owner.

IPR2025-00680
Patent 8,860,337 B2

Before KARL D. EASTHOM, NORMAN H. BEAMER, and
BRIAN D. RANGE, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5(a), 42.22(d), 42.71(a)

Petitioner, Nintendo Co., Ltd., and Nintendo of America Inc., requested a conference call via email (Ex. 3001) to request supplemental briefing to address recent developments in a district court related to its Motion for Joinder (Paper 4, “Motion”). *See Resonant Systems, Inc. d/b/a Revel HMI v. Apple, Inc.*, No. 7:23-cv-00077 (W.D. Tex.) (the “Apple Litigation”). The Motion seeks to join Petitioner as a party to *Apple Inc. v. Resonant Systems, Inc.*, IPR2024-00807 (“Apple IPR”).¹ Petitioner also sought to discuss management of the proceedings.

As background, the Apple IPR involves the same claims as challenged here, claims 2 and 3 of the U.S. Patent No. 8,860,337 B2 (the “’337’ patent”). *See* Paper 1 (Petition); *supra* note 1. The Motion for Joinder states that the Petition is substantively the same as the petition in the Apple IPR. Motion 1–2.

The panel conducted the conference call on June 3, 2025.² Counsel for Petitioner, Jeremy Jason Lang and Parth Sagdeo, counsel for Patent Owner, Resonant Systems, Inc., Neil A. Rubin, and counsel for petitioner Apple, Inc. (“Apple”) in the Apple IPR, Thomas Rozylowicz and Craig Deutsch, participated in the conference call.

During the call, Petitioner contended that Patent Owner recently indicated in the district court proceedings that it had decided not to continue to assert the ’337 patent against Apple in the Apple Litigation. Patent Owner agreed with Petitioner’s contention. Petitioner argued that this circumstance strongly favors institution and that it warrants supplemental

¹ *See Apple Inc. v. Resonant Systems, Inc.*, IPR2024-00807, Paper 10 (PTAB, Oct. 10, 2024) (decision instituting on claims 2 and 3 of the ’337 patent).

² One panel member, Judge Brian D. Range, was unavailable.

briefing to record this and other circumstances arising since, and impacting, the Motion for Joinder.

The panel and parties discussed expediting the due date of the preliminary response for Patent Owner to ensure that the Board is able to decide the Motion for Joinder while Apple remains as petitioner in the Apple IPR. Patent Owner indicated that discretionary denial considerations may warrant denying the Motion for Joinder.³ Patent Owner noted that its brief on discretionary denial and its preliminary response are due on June 16, 2025, and July 16, 2025, in the instant case, respectively.⁴ The parties also noted that the Apple IPR is ongoing. On June 4, 2025, Apple filed a request for an oral hearing in that trial, scheduled currently for July 17, 2025. *See* IPR2024-00807, Paper 27.

Regarding Patent Owner’s brief on discretionary denial due on June 16, 2025, Patent Owner “may file a brief explaining any applicable bases for discretionary denial of institution,” and Petitioner “may file an opposition brief no later than one month after the patent owner files its brief.” *See* Guidance Memorandum 2; *supra* note 4. Also, “consistent with the discretionary considerations enumerated in existing Board precedent (including *Fintiv*, *General Plastic*, and *Advanced Bionics* and the Consolidated Trial Practice Guide (Nov. 2019), the parties are permitted to address all relevant considerations, which may include . . . [a]ny . . .

³ Patent Owner cited *Apple Inc. v. UNILOC 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020).

⁴ *See* Memorandum: Interim Processes for PTAB Workload Management (Mar. 26, 2025), *available* at <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf> (“Guidance Memorandum”) (outlining processes for discretionary denial briefing and decision by Director regarding same).

considerations bearing on the Director's discretion.” *Id.* at 2–3 (internal footnote omitted, citing the following: “*Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential); *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2027) (precedential as to § 11.B.4.i); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gertite GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential).”).⁵

Based on the foregoing, it appears that discretionary denial issues may impact a decision on the Motion for Joinder, and Petitioner establishes good cause to file the requested supplemental briefing directed to updating the Board as to circumstances arising since the filing of the Motion for Joinder.

With regard to expediting briefing for the preliminary response,

[t]he Director [(or the Board acting on the Director’s behalf)] shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after—(1) receiving a preliminary response to the petition under section 313; or (2) if no such preliminary response is filed, the last date on which such response may be filed.

35 U.S.C. § 314(b). Given the timing of the briefing on discretionary denial and the preliminary response as outlined above, the current due date for the filing of a preliminary response may precede or fall close to the date of a Director decision on discretionary denial. Therefore, at this juncture, we decline to expedite the due date for the filing of the preliminary response.

⁵ This panel will not be deciding discretionary denial issues due to the Director’s bifurcation procedure. As such, this panel is not in a position to address what briefing will be permitted regarding discretionary denial issues (beyond noting what the Office has previously stated).

ORDER

In consideration of the foregoing, it is hereby

ORDERED that Petitioner may file a supplemental brief directed to joinder issues as outlined above of no more than three pages due on or before June 9, 2025; and

FURTHER ORDERED that Patent Owner may file a supplemental reply brief responding to issues raised in Petitioner's brief of no more than three pages due on or before June 16, 2025.

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