

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 SUPPLEMENTAL REPLY BRIEF
OPPOSING PETITIONERS' MOTION FOR JOINDER

Petitioners cite the default briefing times of “37 C.F.R. § 42.45” [sic] to argue that Resonant has forfeited its opportunity to oppose joinder. But it is Petitioners that have forfeited their right to pursue joinder by failing to follow Board deadlines and procedures. § 42.25 provides that “[a] motion may only be filed according to a schedule set by the Board.” Relatedly, § 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 § 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).

The purpose of requiring authorization before filing motions is to further a “just, speedy, and inexpensive resolution” (37 C.F.R. § 42.1(b)) by limiting the burden of motion practice on the parties and the Board. This purpose would be frustrated if a party could file an unauthorized motion, take no steps to seek retroactive authorization, and then place the burden on the opposing party to either oppose the motion or otherwise seek relief, upon penalty of a forfeiture of rights. Yet this is exactly the rule that Petitioners now advance.

If Petitioners wished to pursue joinder, based upon a motion filed 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.

Any request to authorize a motion out of time would have been weak. The only cases Petitioners cite where the Board waived the one-month deadline were cases where the petitioner had previously moved for joinder within one month but needed to file a revised petition after the one month. *Sony Corp. of Am. V. Network-1 Security Solutions, Inc.*, IPR2013-00495, Paper 13 at 7 (Sept. 16, 2013); *GlobalFoundries U.S. Inc. v. Good Kaisha IP Bridge 1*, IPR2017-00925, Paper 13 at 7 (June 9, 2017). To the extent that the Board is willing to entertain Petitioners’ joinder motion at this very late date, the Board should set a schedule for full briefing and not limit Resonant to just three pages addressing Petitioners’ supplemental arguments. The proper response, however, would be to strike the unauthorized joinder motion in its entirety.

Petitioners’ claims that Resonant has shown a lack of candor are false. The ’337 patent remains at issue in the W.D. Texas Apple litigation. While Resonant did not submit an infringement expert opinion for the ’337 patent in that case, Apple did submit an invalidity expert report addressing the ’337 patent. Importantly, Apple has a pending summary judgment motion arguing

that Apple does not infringe the '337 patent, based in part upon the court's construction of the claim term "control component." *Resonant Systems v. Apple*, Case No. 7:23-cv-77, Dkt. 155 at 6–7 (W.D. Tex.). It is possible that the court could issue an opinion or judgment that bears on the issues in Nintendo's IPR petition. Thus, it would not have been proper—let alone mandatory—for Resonant to submit mandatory notices—original or updated—that omitted the Apple W.D. Texas lawsuit as a related matter. Nintendo's own mandatory notices confirm the point. Nintendo's petition lists Resonant's E.D. Texas lawsuit against Sony as a related matter. Paper 1 at 87. But that case was stayed by the court on December 18, 2024—more than three months before Nintendo's mandatory notices—due to an agreement in principle to settle the case. *Resonant Systems v. Apple*, Case No. 2:22-cv-424, Dkt. 167 (E.D. Tex.). Nonetheless, Nintendo properly listed this effectively-settled case as a related matter, because like the W.D. Texas Apple litigation, developments in the Sony case such as the court's claim construction order could bear on this IPR. Resonant complied with both the spirit and letter of § 42.8 by disclosing the Apple W.D. Texas litigation. It had no obligation to provide updates concerning potential partial resolution of the case, as Petitioners suggest. The *Atlanta Gas* case cited by Petitioners concerns a very different situation of a failure to disclose a new real party in interest, something not at issue in this IPR.

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CERTIFICATE OF SERVICE

I hereby certify that “Patent Owner’s Supplemental Reply Brief Opposing Petitioners’ Motion for Joinder” was served on June 16, 2025 by email sent to:

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