Paper No. 9

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

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

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General Plastic Indus. v. Canon Kabushiki Kaisha,
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iRhythm Technologies, Inc. v. Welch Allyn, Inc.,
Case No. IPR2025-00363, Paper 10 (PTAB June 6, 2025) 5, 6

PATENT OWNER'S EXHIBIT LIST

No.	Description
Ex. 2001	Declaration of Robin Elenga on behalf of patent owner Resonant Systems, Inc.
Ex. 2002	June 10, 2019 presentation from RevelHMI to Nintendo
Ex. 2003	June 11, 2019 email from RevelHMI to Nintendo

I. INTRODUCTION

This is the second petition filed by Nintendo challenging claims 2 and 3 of the ’337 patent. The first is likely to reach a final written decision before an decision on institution is due in this IPR. Further, Petitioner expressly asked the Board to only institute one of the two IPRs and that it be the earlier IPR assuming its joinder motion concerning that IPR is granted. In addition, the challenged ’337 patent claims have been in force for more than a decade and have given rise to significant settled expectations, and Petitioners have been aware of this patent and its relevance to their products for more than six years. For all of these reasons, the Director should exercise discretion and deny institution of this IPR.

II. ARGUMENT

A. This Petition Is Likely to Be Barred Under 35 U.S.C. § 315(e)(1) Prior to Institution

This is the second IPR filed by Nintendo challenging claims 2 and 3 of the ’337 Patent.[1] The prior IPR, IPR2025-00680 (the “-00680 IPR”), was filed on March 10, 2025, three and a half months before the present IPR was filed. The -00680 IPR seeks joinder to *Apple Inc. v. Resonant Systems, Inc.*, Case No. IPR2024-00807. The Director issued a decision on discretionary denial in

[1] Claims 2 and 3 are the only remaining claims in the ’337 Patent, as claims 1, 4, and 5 are subject to a statutory disclaimer. (Ex. 1028.)

the -00680 IPR on August 14, 2025, referring the petition to the Board for decision on institution and joinder. (IPR2025-00680, Paper 18.) Institution in the -00680 IPR is due no later than October 16, 2025. Absent joinder, the final written decision in the Apple IPR is due no later than October 15, 2025. While Patent Owner has opposed both institution and joinder of the -00680 IPR, Patent Owner expects that the -00680 IPR will be instituted and joined and that a final written decision in the Apple IPR and -00680 IPR will issue in October 2025, most likely before the Director's decision on discretionary denial in the present IPR.

Assuming institution, joinder, and a final written decision in the -00680 IPR in October 2025, the present IPR will be barred under 35 U.S.C. § 315(e)(1), either before a decision on discretionary denial in this IPR is expected or shortly thereafter. Accordingly, it would not be an efficient use of the Board's resources for this petition to be referred to the Board for institution, and the Director should exercise her discretion to deny institution.

B. Petitioner Should Be Held to Its Request that the Board Institute Only One Petition Challenging the '337 Patent

In addition to the § 315(e)(1) bar issue, the Petitioner's Explanation for and Ranking of Two Petitions Challenging U.S. Patent No. 8,860,337 (Paper 4) provides an additional reason to deny institution. In that explanation and ranking, the Petitioner states that "while Nintendo presents two petitions, it

requests that the Board institute only one petition." (Paper 4 at 1.) Petitioner's ranking placed the -00680 IPR above the present IPR. (*Id.* at 8.) At least so long as the joinder motion is granted, Petitioner asks that the -00680 IPR be instituted and not the present IPR. (*Id.* at 8–9.)

Based upon the decision on discretionary denial in the -00680 IPR, it appears likely that joinder will be granted. (IPR2025-00680, Paper 18 at 2–3.) Assuming that is the case, Petitioner should be held to its request that only the -00680 IPR be instituted, and the present IPR should be denied institution.

Even absent Petitioner's request and ranking of its two petitions, the *General Plastic* factors further support denial. *General Plastic Indus. v. Canon Kabushiki Kaisha*, Case No. IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017). In particular, the art relied upon in this petition was previously used in Apple and Samsung IPRs on the '337 patent or its family members, filed in 2023 and 2024, before the filing of the -00680 IPR. (Paper 4 at 4–5 and 7–8.) The institution decision in the Apple IPR (IPR2024-00807) and the final written decision in the Samsung '830 IPR (IPR2023-00993) were both issued before the -00680 IPR was filed. (Paper 4 at 6.) Petitioner provides no explanation for waiting to file a second IPR with this prior art. Accordingly, the *General Plastic* factors favor discretionary denial.

Nintendo may point to alleged "gamesmanship" or "tactical behavior" by Patent Owner in disclaiming claims 15 and 16 of the '830 Patent. (Paper 4 at 2, 6.) There was no gamesmanship in that disclaimer. Rather, in the course of litigation, Patent Owner realized that it had obtained a dependent claim 15 in the '081 patent with materially the same scope to that of independent claim 2 of its parent '337 patent and that likewise dependent claim 16 of the '081 patent had materially the same scope as dependent claim 3 of the '337 patent. Recognizing this error and seeking to avoid future arguments that one or more of the claims were invalid for double patenting, Patent Owner disclaimed claims 15 and 16 of the '081 patent.

C. Patent Owner's Settled Expectations Strongly Favor Discretionary Denial

The challenged '337 patent issued on October 14, 2014, more than a decade before Nintendo's Petition was filed. Ex. 1001 at 1. The application leading to it was filed on May 31, 2012 and was a continuation-in-part of an application filed January 6, 2010, which itself lead to U.S. Patent No. 8,093,767, issued on January 10, 2010.

A patent that has been in force for so long, from a patent family that predates the 2011 enactment of the America Invents Act, has created settled expectations. As the President and former CEO of Resonant Systems explains in

his declaration, these settled expectations played an important role in Resonant's ability to raise investor capital to develop its compact and energy-efficient haptic technology. Ex. 2001, ¶¶ 1–2. These settled expectations also played an important role in allowing Resonant to engage in discussions with potential customers of its technology, as it did when it reached out to the Petitioners in 2019. Ex. 2001, ¶¶ 3–4.

These longstanding settled expectations should be respected and discretionary denial of institution be granted. *See iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, Case No. IPR2025-00363, Paper 10 (PTAB June 6, 2025) (granting discretionary denial of IPR for four related patents, issued between 2012 and 2018, on settled expectations grounds).

D. Petitioners' Longstanding Knowledge of the '337 Patent and Related Patents also Strongly Favors Discretionary Denial

Not only have the '337 patent and related patents been in force for over a decade, but the Petitioners have been aware of these patents and their relevance to their products since at least 2019.

As then-CEO of Resonant Robin Elenga explains in his declaration, he met on June 10, 2019 in Redmond, Washington with representatives of the Petitioners, as potential customers of Resonant's compact and energy-efficient haptic technology. Ex. 2001, ¶ 3. At that meeting, he presented slides to the

Nintendo representatives, which highlighted the existence of Resonant's patents and included a list of the patents it had been granted to date. Ex. 2001, ¶¶ 5–6; Ex. 2002 at 14, 18. That list included the '337 patent and three other members of the same patent family, 8,093,767, 9,369,081, and 9,941,830. Ex. 2002 at 18.

The following day, on June 11, 2019, Mr. Elenga emailed representatives of Petitioners, attaching a copy of the slides he had presented at the meeting. Ex. 2001, ¶ 6; Ex. 2002; Ex. 2003. As this evidence shows, Petitioners were aware of the '337 patent—and of related patents including the parent '767 patent—no later than June 2019. Ex. 2001, ¶ 7. Nintendo was also aware of the potential relevance of these patents to haptic technology that it uses or might use in its products. *See* Ex. 2002.

Despite this knowledge of the '337 patent and its relevance to its products, Nintendo failed to timely seek review of the patent. As the Director held in *iRhythm*, "Petitioner's awareness of Patent Owner's applications and failure to seek early review of the patents favors denial and outweighs [other contrary] considerations." *iRhythm*, Case No. IPR2025-00363, Paper 10 at 3.

III. CONCLUSION

For the foregoing reasons, the Board should not institute this second-filed IPR from Nintendo challenging the '337 patent. The long settled expectations

of the patent owner and Petitioners' failure to previously seek review of this patent, in spite of knowing of the patent and its relevance for more than five years, further strongly favor discretionary denial. Accordingly, Resonant respectfully asks that the Director exercise discretion and deny institution of this IPR petition.

Dated: September 9, 2025

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CERTIFICATE OF SERVICE

I hereby certify that "Patent Owner's Request for Discretionary Denial of Institution" was served on September 9, 2025 by email sent to:

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