

Filed on behalf of IngenioSpec, LLC
By: Douglas R. Wilson
Michelle E. Armond
Joseph Li
Monica Arnold
ARMOND WILSON LLP
4685 MacArthur Court, Suite 390
Newport Beach, CA 92660
Telephone: (949) 932-0778
Email: ipr@armondwilson.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

INGENIOSPEC, LLC,
Patent Owner.

Case No. IPR2026-00142
U.S. Patent No. 8,112,104

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	OVERVIEW OF THE '104 PATENT	2
III.	LEVEL OF ORDINARY SKILL IN THE ART	3
IV.	CLAIM CONSTRUCTION IS NOT NECESSARY TO DENY INSTITUTION.....	3
V.	THE ZHANG GROUNDS ARE NOT REASONABLY LIKELY TO PREVAIL.....	4
A.	The Ground 1 Challenges To Independent Claims 1, 23, And 42 Cannot Prevail.....	5
1.	The Petition Fails To Meet Its Burden On Claim 1	5
a)	Claim 1[B]	5
b)	Claim 1[F]	8
2.	The Petition Fails To Meet Its Burden On Claims 23 And 42	10
B.	The Grounds 1-6 Challenges To Dependent Claims Cannot Prevail (Claims 2, 4-6, 8-22, 24-26, 28-39, 43, And 45-47).....	15
VI.	THE JANNARD GROUNDS ARE NOT REASONABLY LIKELY TO PREVAIL	15
A.	The Ground 7 Challenges To Independent Claims 1, 23, And 42 Cannot Prevail.....	16
1.	The Petition Fails To Meet Its Burden On Claim 1	16
a)	Claims 1[E]-1[H].....	16
b)	No Supported Motivation To Combine	18

2.	The Petition Fails To Meet Its Burden On Claim 23	20
3.	The Petition Fails To Meet Its Burden On Claim 42	22
B.	The Grounds 7-12 Challenges To Dependent Claims Cannot Prevail (Claims 2-22, 24-41, And 43-47).....	22
VII.	EFFICIENCY SUPPORTS DENYING INSTITUTION RATHER THAN INSTITUTING IPR AS TO ALL CHALLENGED CLAIMS	23
VIII.	PETITIONER’S VERBATIM EXPERT DECLARATION SUPPORTS DENYING INSTITUTION	24
IX.	CONCLUSION	25

TABLE OF AUTHORITIES

<i>Apple v. DH Int'l</i> , IPR2025-00173, Paper 8 (P.T.A.B. June 25, 2025)	14
<i>Chevron Oronite v. Infineum USA</i> , IPR2018-00923, Paper 9 (P.T.A.B. Nov. 7, 2018)	23
<i>Deeper v. Vexilar</i> , IPR2018-01310, Paper 7 (P.T.A.B. Jan. 24, 2019)	23
<i>EiKO Global v. Blackbird Tech</i> , IPR2017-00980, Paper 16 (P.T.A.B. Sept. 1, 2017)	7
<i>Google v. Dialect</i> , IPR2024-00748, Paper 11 (P.T.A.B. Oct. 11, 2024)	9
<i>HTC Corp. v. Cellular Commc'ns Equip.</i> , IPR2014-01133, Paper 48 (P.T.A.B. Jan. 4, 2016)	18
<i>Huawei Techs. v. Samsung Elecs.</i> , IPR2017-01983, Paper 9 (P.T.A.B. Mar. 16, 2018)	21
<i>Johnson & Johnson Surgical Vision v. Alcon</i> , IPR2021-01003, Paper 14 (P.T.A.B. Nov. 23, 2021)	3
<i>In re Magnum Oil Tools Int'l</i> , 829 F.3d 1364 (Fed. Cir. 2016)	14, 15
<i>Par-Kan v. Unverferth Mfg.</i> , IPR2024-01426, Paper 10 (P.T.A.B. Mar. 19, 2025)	23
<i>Realtime Data v. Iancu</i> , 912 F.3d 1368 (Fed. Cir. 2019)	3
<i>Securus Techs. v. Global Tel*Link Corp.</i> , IPR2016-00267, Paper 10 (P.T.A.B. Sept. 12, 2016)	14
<i>SMA Solar Tech. Am. v. Tigo Energy</i> , IPR2023-00879, Paper 31 (P.T.A.B. Oct. 28, 2024)	8

Apple Inc. v. IngenioSpec, LLC
U.S. Patent No. 8,112,104 – IPR2026-00142

<i>TikTok v. NTECH Props.</i> , IPR2024-01339, Paper 9 (P.T.A.B. Feb. 25, 2025)	24
<i>Triller v. TikTok</i> , IPR2022-00181, Paper 9 (P.T.A.B. May 16, 2022)	14
<i>TQ Delta v. Cisco Sys.</i> , 942 F.3d 1352 (Fed. Cir. 2019)	21
<i>Ubiquiti v. Intellectual Ventures</i> , IPR2024-01290, Paper 9 (P.T.A.B. Mar. 7, 2025)	15, 22
<i>UiPath v. Rule 14</i> , IPR2024-01306, Paper 8 (P.T.A.B. Mar. 14, 2025)	19
<i>Xerox v. Bytemark</i> , IPR2022-00624, Paper 9 (P.T.A.B. Aug. 24, 2022)	<i>passim</i>
<i>Yita v. MacNeil IP</i> , 69 F.4th 1356 (Fed. Cir. 2023)	7

OTHER AUTHORITIES

37 C.F.R. § 42.104	10, 14
35 U.S.C. § 314	1

TABLE OF EXHIBITS

Exhibit No.	Description
2001	Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 1 (W.D. Tex. June 5, 2025)
2002	Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00877, Dkt. No. 1 (W.D. Tex. June 6, 2025)
2003	Order Granting Joint Motion to Consolidate, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 25 (W.D. Tex. Oct. 14, 2025)
2004	Scheduling Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 36 (W.D. Tex. Nov. 17, 2025)
2005	Scheduling Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 39 (W.D. Tex. Dec. 5, 2025)
2006	Defendant Apple Inc.'s Preliminary Invalidity Contentions, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867 (W.D. Tex. Nov. 21, 2025) (cover pleading)
2007	RESERVED
2008	Exhibit D-4 to Defendant Apple Inc.'s Preliminary Invalidity Contentions, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867 (W.D. Tex. Nov. 21, 2025)
2009	Exhibit D-5 Defendant Apple Inc.'s Preliminary Invalidity Contentions, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867 (W.D. Tex. Nov. 21, 2025)
2010	RESERVED
2011	Defendant's Proposed Claim Constructions, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867 (W.D. Tex. Dec. 22, 2025)
2012	RESERVED
2013	Office Action in Apple Patent Application Citing U.S. Patent No. 7,890,128
2014	RESERVED
2015	Declaration of Peter Tong

I. INTRODUCTION

IngenioSpec is a California company that has led innovation in wearable electronic devices for more than a decade. EX2002 ¶¶ 3-4. Its cutting-edge wearable technology seamlessly integrates electronics into the wearable devices to deliver practical solutions that positively transform consumers' daily lives. *Id.* ¶ 4. Through its patented wearable device technologies, these solutions include health monitoring, hands-free communication, enhanced hearing, and integrated audio and video playback. *Id.* ¶¶ 5, 7-8.

Despite its Petition spanning twelve grounds based on a collage of seven asserted references to target forty-seven patent claims, Apple has not met its burden to establish a reasonable likelihood of prevailing on any patent claim. Across the asserted grounds, the Petition's contentions are fatally deficient. By failing to show claim limitations are met, specifically identify devices in the asserted references corresponding to required elements of the claims, or show a supported motivation to combine, the Petition falls well short of meeting the threshold showing required by 35 U.S.C. § 314(a). Institution should also be denied because efficiency counsels against instituting trial as to all challenged claims and grounds even if the Petition established a reasonable likelihood of prevailing as to any or a subset of the challenged claims.

II. OVERVIEW OF THE '104 PATENT

The '104 Patent is titled “Adaptable Communication Techniques for Electronic Devices.” EX1001 at 1. The '104 Patent describes “electronic devices [that] have audio and/or textual output capabilities” and “[i]mproved approaches for users of electronic devices to communicate with one another.” *Id.* at Abstract. It explains that the “improved approaches can enable users to communicate in different ways depending on device configuration, user preferences, prior history, etc.” *Id.* at Abstract, 2:3-8. For example, the '104 Patent describes that, “[i]n one embodiment, the communication between users is achieved by short audio or textual messages.” *Id.* at 2:8-10.

Although the '104 Patent describes various implementations, in one embodiment, it describes “a wireless communication system [that] can, for example, include at least a wireless headset, and a wireless communication device that supports wireless communication, including messaging, for a first user” and that “is capable of wirelessly communicating with the wireless headset.” *Id.* at 2:42-47. In that embodiment, the “wireless communication device is configured to perform the method of: receiving an incoming text message from a second user; converting the incoming text message to an incoming audio message; presenting the incoming audio message for the first user via the wireless headset; recording a reply audio message by the first user via the wireless headset; converting the reply audio

message into a reply text message; and transmitting the reply text message to the second user.” *Id.* at 2:47-55. The described system provides “improved approaches to respond to an incoming text message.” *Id.* at 2:23-24.

III. LEVEL OF ORDINARY SKILL IN THE ART

For purposes of denying institution and finding that Apple has not met its burden to show a reasonable likelihood of prevailing, IngenioSpec submits that the Board need not determine the level of ordinary skill in the art. *Johnson & Johnson Surgical Vision v. Alcon*, IPR2021-01003, Paper 14 at 9 (P.T.A.B. Nov. 23, 2021) (denying institution: “For our analysis on whether to institute, we need not determine the level of ordinary skill in the art”).

IngenioSpec reserves the right to address the level of ordinary skill in the event the Board institutes trial.

IV. CLAIM CONSTRUCTION IS NOT NECESSARY TO DENY INSTITUTION

Apple asserts in the Petition that “no claim construction is necessary to resolve any issue” in this proceeding. Paper 2 (“Pet.”) at 3. For purposes of denying institution because Apple has not met its burden to show a reasonable likelihood of prevailing, IngenioSpec submits the Board need not construe any terms of the challenged claims. *Realtime Data v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms... that are in controversy, and

only to the extent necessary to resolve the controversy.” (quoting *Vivid Techs. v. Am. Sci. & Eng’g*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

IngenioSpec reserves the right to assert claim construction positions if trial is ordered.

V. THE ZHANG GROUNDS ARE NOT REASONABLY LIKELY TO PREVAIL

The Petition does not meet its burden on at least one limitation in each of independent Claims 1, 23, and 42 challenged in Ground 1. As to Claim 1, the Petition fails to show Zhang’s “mobile telephone 202 with hands-free adapter 100” satisfies the Claim 1[B] requirement of “a wireless communication device that supports wireless communication, including messaging,” or that Zhang taught “recording a reply audio message by the first user via the wireless headset,” as required by Claim 1[F]. The Petition’s contentions for Claims 23 and 42 are also deficient because it is entirely unclear which device in Zhang the Petition is relying on for the claimed “mobile electronic device.” Having failed to meet its burden on any of Claims 1, 23, and 42, the Petition cannot prevail on any of the challenged dependent claims in Grounds 1-6 either.

A. The Ground 1 Challenges To Independent Claims 1, 23, And 42 Cannot Prevail

1. The Petition Fails To Meet Its Burden On Claim 1

a) Claim 1[B]

The Petition relies on Zhang’s “mobile telephone 202 with hands-free adapter 100” for the Claim 1[B] requirement of “a wireless communication device that supports wireless communication, including messaging, for a first user.” Pet. at 10, 110; EX1001 at 15:52-53. The Petition specifically asserts that “Zhang teaches a wireless communication device (*i.e., mobile telephone 202 with hands-free adapter 100*)” and that the “device supports wireless communication, *including messaging*, for the user.” Pet. at 10 (emphases added).

The Petition provides no showing that Zhang’s mobile telephone 202, or mobile telephone 202 with hands-free adapter 100, supports messaging. The Petition asserts that “[t]he device supports wireless communication, including messaging, for the user,” citing paragraph 37 of the Smith declaration. Pet. at 10 (citing EX1003 ¶ 37). But Dr. Smith’s declaration includes the same sentence verbatim with no additional support rendering it of no help to Apple. *Xerox v. Bytemark*, IPR2022-00624, Paper 9 at 16 (P.T.A.B. Aug. 24, 2022) (precedential) (denying institution) (“[V]erbatim restatement of the assertion being supported, without any supporting evidence or technical reasoning” is insufficient to “supply a limitation missing from the prior art.”).

The Petition also purports to include an example in support of its claim that mobile telephone 202 supports messaging: “For example, the device can be a mobile telephone, a pager, or a PDA, which can send and receive text messages (*e.g.*, SMS text messages).” Pet. at 10 (citing EX1005 at 4:58-5:3, 5:60-6:6, 9:35-60; EX1003 ¶ 37). But the cited passages in Zhang either do not mention mobile telephone 202 or are silent about any messaging capability, and they do not disclose that mobile telephone 202 can somehow be a pager or a PDA. *See* EX1005 at 4:58-5:3, 5:60-6:6, 9:35-60. Instead, for example, Zhang at 4:58-5:3 appears to teach that mobile telephone 202 would not have messaging capability:

For example, if the hands-free adapter is connected to a *mobile telephone*, then the *audio signals* received by the telephone in connection with an incoming call are forwarded to the headset. If the hands-free adapter is connected to a *pager or a PDA*, then the *text messages* received by the device are converted to audio signals and forwarded to the headset.

EX1005 at 4:60-66 (emphases added). Additionally, Zhang at 5:60-6:6 discusses mobile telephone 202 but does not mention messaging capability at all. Similarly, Zhang at 9:35-60 does not discuss mobile telephone 202 at all and discusses the Read and Reply commands relied upon by Apple only in the context of a “pager.” EX1005 at 9:37-41 (“The ‘Read’ command 702 instructs the hands-free adapter to retrieve a message from *the pager* and to play or read the message to the user. The ‘Reply’

command 704 instructs the hands-free adapter to generate a command to *the pager* to send a reply message.” (emphases added)). And although Apple’s expert again includes the same sentence verbatim in his declaration, he cites nothing more than the Petition does to support the assertion and provides no additional explanation, rendering his opinion of no help to Apple. *See* EX1003 ¶ 37; *Xerox*, IPR2022-00624, Paper 9 at 16.

Zhang’s other cited disclosures also fail to remedy the Petition’s deficiencies. For example, Zhang describes “exemplary voice commands for a hands-free adapter for an interactive pager, PDA or *SMS-enabled* mobile telephone.” EX1005 at 9:35-37 (emphasis added). However, that passage in Zhang does not describe the “mobile telephone 202” relied upon by the Petition. *See id.*; *see also EiKO Global v. Blackbird Tech*, IPR2017-00980, Paper 16 at 29 n.8 (P.T.A.B. Sept. 1, 2017) (denying institution: The Petition’s cited “passage does not support Petitioner’s assertions” because it “refers to a different embodiment than the one” relied upon and “does not refer to fixture 17, the alleged ‘ballast cover.’”).

The Petition further presents no argument that it would have been obvious to modify Zhang’s “mobile telephone 202 with hands-free adapter 100” to support messaging. *See* Pet. at 10-11. Having presented no such argument in the Petition, it is too late for Apple to do so on reply. *See, e.g., Yita v. MacNeil IP*, 69 F.4th 1356, 1367 (Fed. Cir. 2023) (improper on reply to present “an argument that it would have

been obvious to a relevant artisan to modify” the prior art to arrive at the claim limitation which “was a ‘meaningfully distinct contention’... from those made in [the] petition, which focused (for the claim limitation at issue) only on what [the prior art] discloses”); *SMA Solar Tech. Am. v. Tigo Energy*, IPR2023-00879, Paper 31 at 27 (P.T.A.B. Oct. 28, 2024) (“obvious to modify” reply argument improper where “the Petition and [expert’s] Declaration rely on Mieth’s express disclosure for that limitation and do not present or support any obviousness rationale”).

Because the Petition does not show Zhang’s “mobile telephone 202 with hands-free adapter 100” is a “wireless communication device that supports... messaging” as required by Claim 1[B], the Petition is unlikely to prevail on Claim 1.

b) Claim 1[F]

The Petition also fails to show that Zhang taught the Claim 1[F] requirement of “recording a reply audio message by the first user via the wireless headset.” *See* Pet. at 14-15; *see also id.* at 110 (reciting claim language for Claim 1[F]); EX1001 at 15:63-64. The Petition asserts that “[t]he wireless headset 204 includes a microphone for the user to provide the audio message.” Pet. at 14. Based on that assertion, the Petition next asserts that one of skill in the art “would further understand the detected message to be stored in a memory (*e.g.*, a buffer, such as a buffer of DSP 108)” and that “[t]hus, the wireless headset is used to record reply audio messages.” Pet. at 14-15 (citing EX1003 ¶ 43). The Petition supplies no

reasoning or evidence why the message would be stored, and the Petition’s only support for this assertion is a cite to an expert declaration that merely parrots the language in the Petition and provides no further support. *Compare* Pet. at 14-15, with EX1003 ¶ 43. Dr. Smith’s “*verbatim* restatement of the assertion being supported, without any supporting evidence or technical reasoning” cannot “supply a limitation missing from the prior art.” *Xerox*, IPR2022-00624, Paper 9 at 16.

Additionally, the Petition’s reliance on Zhang’s Reply command, Pet. at 14, overlooks that Zhang’s Reply command is described as an operation of “the pager,” not mobile telephone 202, *see* EX1005 at 9:39-44. Without any explanation or argument as to why this operation would apply to mobile telephone 202 in Zhang, which the Petition asserts is the claimed “wireless communication device,” the Petition’s reliance on the Reply command is baseless. *See Google v. Dialect*, IPR2024-00748, Paper 11 at 20 (P.T.A.B. Oct. 11, 2024) (“Because Petitioner’s arguments and evidence do not address sufficiently persuasively the [limitation at issue,] the record does not demonstrate a reasonable likelihood of Petitioner prevailing with respect to any of the challenged claims.”).

Because the Petition fails to show Claims 1[B] and 1[F] are satisfied, the Ground 1 challenge to Claim 1 cannot prevail.

2. The Petition Fails To Meet Its Burden On Claims 23 And 42

The Ground 1 challenge to independent Claims 23 and 42 cannot prevail because the Petition does not clearly identify which device in Zhang it is relying on for the claimed “mobile electronic device,” and thus fails to “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4).

As explained below for Claim 23, the Petition inconsistently and ambiguously references the claimed “mobile electronic device” throughout its analysis, repeatedly resorting to an undefined “wireless communication device”¹ not disclosed by Zhang or identified by the Petition.

- For Claim 23[Preamble], the Petition maps the claimed “mobile electronic device” to Zhang’s “hands-free adapter 100.” Claim 23[Preamble] requires, *inter alia*, that “said wireless headset operatively connects to a mobile electronic device having wireless communication capability.” Pet.

¹ Neither Zhang nor Claim 23 uses the phrase “wireless communication device.” *See generally* EX1005; EX1001 at 17:42-57. The usage of “wireless communication device” throughout Apple’s analysis of Claim 23 appears to be a remnant from the Petition’s discussion of Claim 1, which does recite a “wireless communication device.” EX1001 at 15:50-67.

at 115; EX1001 at 17:42-45. For that limitation, the Petition maps the claimed “mobile electronic device” to Zhang’s “hands-free adapter 100,” stating: “Zhang discloses that headset 204 wirelessly communicates with the *hands-free adapter 100* via a wireless network.” Pet. at 21 (emphasis added).

- The Petition’s Claim 23[Preamble] discussion distinguishes Zhang’s “wireless communication device” from Zhang’s hands-free adapter. For Claim 23[Preamble], the Petition further states: “Zhang’s wireless communication device supports wireless communication, including messaging, and can send and receive text messages (*e.g.*, SMS messages).... As examples, a ‘Read’ command 702 instructs *the hands-free adapter to retrieve a text message from the device* and to read the message to the user; and a ‘Reply’ command 704 instructs the device to send a reply text message.” Pet. at 22 (emphasis added). In this discussion, the Petition distinguishes Zhang’s undefined “wireless communication device” from Zhang’s hands-free adapter, which “retrieve[s] a text message from the device.” Pet. at 22. Thus, Zhang’s hands-free adapter—the Petition’s alleged “mobile electronic device” for Claim 23[Preamble]—is distinct from the “wireless communication device,” whatever it is.

- For Claim 23[A], which requires that the wireless headset be configured to “wirelessly receive an incoming audio message from the mobile electronic device,” Pet. at 115; EX1001 at 17:46-48, the Petition maps the claimed “mobile electronic device” to Zhang’s “wireless communication device”:
“[T]he headset wirelessly receives an incoming audio message *from the wireless communication device*, after the DSP 108 converts an incoming text message to the audio message.” Pet. at 24 (emphasis added). The Petition also relies on Zhang’s “wireless communication device” as the “mobile electronic device” to meet the Claim 23[A] requirement that “the incoming text message being received at the mobile electronic device via a wireless network.” See Pet. at 24, 115; EX1001 at 17:50-52. Indeed, the Petition asserts that “Zhang discloses the *wireless communication device* may be SMS-enabled, and the POSITA would understand the SMS protocol to describe sending and receiving text messages between two or more wireless electronic devices via a wireless network.” Pet. at 24 (emphasis added). Thus, for Claim 23[A], the Petition adopts Zhang’s undefined “wireless communication device” as the claimed “mobile electronic device” that it previously asserted was Zhang’s “hands-free adapter 100,” which was distinct from the “wireless communication device” for Claim 23[Preamble].

- For Claim 23[D], the Petition maps both Zhang’s “hands-free adapter 100” and “wireless communication device” to the claimed “mobile electronic device.” Finally, for Claim 23[D], which includes the requirement of “wirelessly transmit the reply audio message to the mobile electronic device,” Pet. at 116; EX1001 at 17:56-57, the Petition confusingly appears to map both Zhang’s “hands-free adapter 100” and undefined “wireless communication device” to the claimed “mobile electronic device,” *see* Pet. at 24-25. The Petition asserts that “Zhang discloses the *hands-free adapter 100* wirelessly communicates with headset 204”—consistent with the Petition’s Claim 23[Preamble] contention—and also that “the POSITA would have understood that for the wireless communication device to send a reply message, the wireless headset must first transmit the audio signal containing the reply message’s content to the *wireless communication device.*” Pet. at 24-25 (emphases added).

In sum, the Petition’s showing for Claim 23 is deficient based on its inconsistent and unclear mapping for the claimed “mobile electronic device.” The Petition inconsistently relies on Zhang’s hands-free adapter 100 as the mobile electronic device and on an undefined “wireless communication device” from Zhang as the mobile electronic device even though Zhang does not disclose a “wireless communication device.” To cement the obscurity, the Petition distinguishes the

hands-free adapter 100 from the undefined “wireless communication device” in discussing Claim 23[Preamble]. There is thus no way to discern from the Petition where Apple contends the required “mobile electronic device” of Claim 23 is disclosed in Zhang as was its burden under 37 C.F.R. § 42.104(b)(4), precluding institution. *See, e.g., Apple v. DH Int’l*, IPR2025-00173, Paper 8 at 16 (P.T.A.B. June 25, 2025) (denying institution: “The Petition is unclear as to which McGregor device is being referenced, e.g., the smart card of Figure 2, the wallet embodiment of Figure 4, or some combination of embodiments disclosed in McGregor and Palmer.”).

The Petition relies entirely on its Claim 23 discussion for Claim 42, *see* Pet. at 28, which contains similar limitations as Claim 23, *compare* EX1001 at 17:42-57, *with id.* at 19:19-34. Thus, the Petition’s showing for Claim 42 is also deficient. *See, e.g., Triller v. TikTok*, IPR2022-00181, Paper 9 at 27 (P.T.A.B. May 16, 2022) (“Because Petitioner’s challenge to claims 19, 23, 24, and 28 relies on the same faulty analysis, Petitioner also fails to show a reasonable likelihood that any of these claims are unpatentable....”).

The Board’s “determination regarding institution” must be “based on what the Petition actually presented and not what it could have reasonably contained had it been reformulated.” *Securus Techs. v. Global Tel*Link Corp.*, IPR2016-00267, Paper 10 at 5 (P.T.A.B. Sept. 12, 2016); *see also In re Magnum Oil Tools Int’l*, 829

F.3d 1364, 1381 (Fed. Cir. 2016) (Board is not “free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR.”). The Petition’s faulty analysis for Claims 23 and 42 is fatal and fails to meet the threshold required for institution.

B. The Grounds 1-6 Challenges To Dependent Claims Cannot Prevail (Claims 2, 4-6, 8-22, 24-26, 28-39, 43, And 45-47)

The Grounds 1-6 challenges to dependent claims fall with the Ground 1 challenges to independent Claims 1, 23, and 42 from which they depend. As explained, the Ground 1 challenges to Claims 1, 23, and 42 fail. *Supra* § V.A. Thus, the Grounds 1-6 challenges to dependent claims also fail. *Ubiquiti v. Intellectual Ventures*, IPR2024-01290, Paper 9 at 32 (P.T.A.B. Mar. 7, 2025) (“Because each of the dependent claims incorporates the limitations of the independent claim from which it depends, Petitioner has also necessarily failed to demonstrate a reasonable likelihood that these claims are unpatentable over the prior art.”).

VI. THE JANNARD GROUNDS ARE NOT REASONABLY LIKELY TO PREVAIL

The Petition does not meet its burden on at least one limitation in each of independent Claims 1, 23, and 42 challenged in Ground 7. For Claim 1, the Petition identifies no “wireless communication device” in Jannard that performs the method steps of Claims 1[E], 1[F], 1[G], and 1[H] and establishes no supported motivation to combine Jannard and Vuori. As to Claim 23, the Petition fails to show that Jannard

taught or suggested the Claim 23[A] requirement of “an incoming text message from another wireless electronic device.” The Petition further establishes no motivation to combine for Claim 42. Having failed to meet its burden on any of Claims 1, 23, and 42, the Petition also cannot prevail on any of the challenged dependent claims in Grounds 7-12.

A. The Ground 7 Challenges To Independent Claims 1, 23, And 42 Cannot Prevail

1. The Petition Fails To Meet Its Burden On Claim 1

a) Claims 1[E]-1[H]

Claim 1 recites a “wireless headset” and separately a “wireless communication device” that “is configured to perform the method” steps recited in Claims 1[C]-1[H]. Pet. at 110; EX1001 at 15:50-67. For Claim 1[A]’s “wireless headset,” the Petition relies on Jannard’s “audio device 10C.” Pet. at 60-61, 110. However, as explained below, the Petition never addresses the Claim 1 requirement that the “wireless communication device” is configured to perform the method steps in Claims 1[E]-1[H].

- For the Claim 1[E] step of “presenting the incoming audio message for the first user via the wireless headset,” Pet. at 110, the Petition identifies no “wireless communication device” in Jannard that performs the claimed step, *see* Pet. at 63-64. The Petition vaguely asserts that “the system of

Jannard presents the audio message to the user using a wireless headset,” but overlooks the Claim 1 requirement that the “wireless communication device” must be configured to perform the claimed step. *See* Pet. at 63.

- For the Claim 1[F] step of “recording a reply audio message by the first user via the wireless headset,” Pet. at 110, the Petition asserts that “the microphone 124 of the audio device 10C can record a reply email from the first user,” Pet. at 65. But the Petition identifies no “wireless communication device” in Jannard that is configured to perform the claimed step, apart from the “audio device 10C” mapped to the separate “wireless headset” limitation. *See* Pet. at 64-65.
- For the Claim 1[G] step of “converting the reply audio message into a reply text message,” Pet. at 110, the Petition relies on the combination of Jannard and Vuori, but its contentions suffer from the same issue, *see* Pet. at 65-67. The Petition relies on “modify[ing] Jannard’s system to convert the audio reply message recorded via the headset to a reply text message,” but again identifies no “wireless communication device” in Jannard, alone or as modified by Vuori, configured to perform the claimed step. *See* Pet. at 67.
- For the Claim 1[H] step of “transmitting the reply text message to the second user,” Pet. at 110, the Petition also relies on the combination of Jannard and Vuori, asserting that, “[w]hen viewed in combination with the

teachings of Vuori, Jannard teaches transmitting a reply email containing a reply text message that was converted from the recorded reply audio message,” Pet. at 67. Again, the Petition fails to identify the “wireless communication device” in Jannard configured to perform the claimed step. *See* Pet. at 67.

Separate from identifying Jannard’s alleged wireless headset or referring generally to “Jannard” or “Jannard’s system,” the Petition thus fails to identify the “wireless communication device” in Jannard configured to perform the steps in Claims 1[E]-1[H], as required by Claim 1. Without this identification, the Ground 7 challenge to Claim 1 cannot prevail. *See, e.g., HTC Corp. v. Cellular Commc’ns Equip.*, IPR2014-01133, Paper 48 at 13 (P.T.A.B. Jan. 4, 2016) (confirming patentability where the petition did “not identify separate components in Calder and Richardson for performing the diverting and controlling steps in claim 1”).

b) No Supported Motivation To Combine

The Claim 1 challenge also fails because the Petition establishes no supported motivation to combine Jannard and Vuori.

The Petition’s purported motivation to combine is supported exclusively by Dr. Smith’s parroting declaration testimony that cites no additional supporting evidence. *Compare* Pet. at 66, *with* EX1003 ¶ 205. Moreover, the Petition’s alleged motivation to combine Jannard and Vuori is substantially similar to the Petition’s

reasoning for the combination of Zhang and Vuori, which only confirms the conclusory nature of the alleged motivation. *Compare* Pet. at 38-39 (Ground 3, Claim 4: “Zhang’s system would thus face a problem if the recorded audio message were too long....”), *with id.* at 66 (Ground 7, Claim 1: “Jannard’s system would thus face a problem if the recorded audio message were too large....”); *see also UiPath v. Rule 14*, IPR2024-01306, Paper 8 at 26 (P.T.A.B. Mar. 14, 2025) (denying institution: “[R]epeating the identical argument emphasizes Petitioner’s conclusory reasoning that one skilled in the art would simply combine the references for the purposes of adding the feature, entirely independent of the primary references’ teachings.”).

The Petition’s conclusory reasoning, supported by an expert declaration that repeats the Petition verbatim with no supporting evidence, is insufficient to prove a motivation to combine. *See, e.g., UiPath*, IPR2024-01306, Paper 8 at 27 (“Because Petitioner’s reasoning is conclusory and not supported by evidence, we are not persuaded that Petitioner has shown sufficiently that one skilled in the art would have combined the references.”); *Xerox*, IPR2022-00624, Paper 9 at 15 (Declaration testimony that “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support” is “entitled to little or no weight.” (citing 37 C.F.R. § 42.65(a))).

2. The Petition Fails To Meet Its Burden On Claim 23

The Petition’s Ground 7 challenge to Claim 23 cannot prevail because the Petition supplies no evidence to show that Jannard taught the Claim 23[A] requirement of “an incoming text message from another wireless electronic device” separate from the “mobile electronic device.” *See* Pet. at 74-75; *see also id.* at 115 (reciting claim language for Claim 23[A]); EX1001 at 17:46-52.

For Claim 23[A], the Petition asserts that one of skill in the art “would have understood that Jannard teaches the audio device (*e.g.*, a headset) wirelessly receives an incoming audio message from the source device,” which the Petition maps to the claimed “mobile electronic device.” Pet. at 74-75. The Petition then asserts that one of skill “further would have understood that an incoming text message is received from another wireless electronic device via a wireless network.” Pet at 75 (citing EX1003 ¶ 230). In conclusory fashion, Apple contends that incoming emails to the alleged mobile electronic device of Jannard would necessarily be received from *another* wireless electronic device. The Petition’s only support for this assertion is a cite to Dr. Smith’s expert declaration that merely parrots the language in the Petition and provides no further support. *Compare* Pet. at 74-75, with EX1003 ¶ 230. Again, this is insufficient. *Xerox*, IPR2022-00624, Paper 9 at 16 (“[*V*] *erbatim* restatement of the assertion being supported, without any supporting evidence or

technical reasoning” is insufficient to “supply a limitation missing from the prior art.”).

The Petition’s additional statement that “**Zhang** discloses that incoming text message is an email, which the POSITA would understand to be received from another wireless electronic device via the wireless network connection” fails to move the needle. Pet. at 75 (emphasis added) (citing EX1003 ¶ 230; EX1001 at 4:2-17). First, Zhang is not part of the ground and thus may not be considered. *See, e.g., Huawei Techs. v. Samsung Elecs.*, IPR2017-01983, Paper 9 at 18 (P.T.A.B. Mar. 16, 2018) (“[W]e do not generally consider references outside of the asserted ground for teaching limitations in a challenged claim....”). Second, even if considered, the Petition provides no explanation how or why Zhang’s disclosure is relevant to what Jannard taught or suggested. *See* Pet. at 75. The Petition does not even cite Zhang, instead citing Dr. Smith’s parroting declaration and the ’104 Patent itself, *see* Pet. at 75, which is plainly insufficient, *Xerox*, IPR2022-00624, Paper 9 at 15-16; *TQ Delta v. Cisco Sys.*, 942 F.3d 1352, 1361 (Fed. Cir. 2019) (“impermissible” to “use the challenged patent as a roadmap to reconstruct the claimed invention”). Even ignoring the improper reference to disclosure that is not part of the ground, neither the Petition nor Dr. Smith’s verbatim declaration provides any explanation why one of skill would understand that an email would be received from “another wireless electronic device” as is required for the text message of Claim 23[A]. Given that

emails were and even today are routinely sent by desktop computers, it is inconceivable that one of skill would have such an understanding.

Because the Petition does not show Claim 23[A] is satisfied, the Ground 7 challenge to Claim 23 fails.

3. The Petition Fails To Meet Its Burden On Claim 42

The Petition’s Ground 7 challenge to Claim 42 cannot prevail because, like Claim 1, the Petition establishes no supported motivation to combine Jannard and Vuori. Indeed, for Claim 42, the Petition merely relies on the same purported motivation to combine for Claim 1, which is conclusory and deficient for the reasons explained above in Section VI.A.1.b). *See* Pet. at 78 (Claim 42[B] cross-referencing “claim 24[A]” for motivation to combine); *id.* at 76 (Claim 24[A] cross-referencing “claim 1[G]” for motivation to combine).

B. The Grounds 7-12 Challenges To Dependent Claims Cannot Prevail (Claims 2-22, 24-41, And 43-47)

The Grounds 7-12 challenges to dependent claims fall with the Ground 7 challenge to independent Claims 1, 23, and 42 from which they depend. As explained, the Ground 7 challenges to Claims 1, 23, and 42 fail. *Supra* § VI.A. Thus, the Grounds 7-12 challenges to dependent claims also fail. *Ubiquiti*, IPR2024-01290, Paper 9 at 32 (A petitioner necessarily fails to show unpatentability of

dependent claims by failing to show unpatentability of independent claim from which they depend.).

VII. EFFICIENCY SUPPORTS DENYING INSTITUTION RATHER THAN INSTITUTING IPR AS TO ALL CHALLENGED CLAIMS

As explained in Sections V-VI above, the Petition has not established a reasonable likelihood of prevailing as to any challenged claim in any ground. Nonetheless, even if the Petition established a reasonable likelihood of prevailing as to any or a subset of the challenged claims, the Board should deny institution because it would be an inefficient use of Board resources to institute as to all forty-seven challenged patent claims across the Petition's twelve grounds. *See, e.g., Deeper v. Vexilar*, IPR2018-01310, Paper 7 at 43 (P.T.A.B. Jan. 24, 2019) (informative) (“[I]nstituting a trial with respect to all twenty-three claims and on all four grounds based on evidence and arguments directed to only two claims and one ground would not be an efficient use of the Board’s time and resources.”); *Chevron Oronite v. Infineum USA*, IPR2018-00923, Paper 9 at 11 (P.T.A.B. Nov. 7, 2018) (informative) (“[I]nstituting a trial with respect to all twenty claims based on evidence and arguments directed to [two claims] is not an efficient use of the Board’s time and resources.”); *Par-Kan v. Unverferth Mfg.*, IPR2024-01426, Paper 10 at 15 (P.T.A.B. Mar. 19, 2025) (declining to institute as to all eight challenged claims based on reasonable likelihood of prevailing as to only one claim).

VIII. PETITIONER’S VERBATIM EXPERT DECLARATION SUPPORTS DENYING INSTITUTION

The Petition is supported by an expert declaration that “merely repeats, *verbatim*, the conclusory assertion[s] for which it is offered to support.” *Xerox*, IPR2022-00624, Paper 9 at 15. With respect to the Petition’s deficiencies identified in Sections V-VI above, even if Apple could rely on its expert declaration for arguments not made in the Petition (it cannot), Apple’s expert, Dr. Smith, simply repeats word for word the text of the Petition and thus fails to remedy any of the deficiencies identified above. *Compare* Pet. at 5-107, with EX1003 ¶¶ 30-378.

Dr. Smith’s parroting verbatim Apple’s Petition, as shown in the illustrative snapshot below, confirms the Petition’s weakness and supports denying institution. *See, e.g., Xerox*, IPR2022-00624, Paper 9 at 15-17 (declining to institute IPR where expert declaration “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support”); *TikTok v. NTECH Props.*, IPR2024-01339, Paper 9 at 16 (P.T.A.B. Feb. 25, 2025) (“Petitioner fails to establish a reasonable likelihood of” prevailing where its expert “testimony repeats, almost verbatim, the language in the Petition without any further explanation or supporting reasoning or evidence.”).

Pet. at 16 Ground 1, Claim 1[H]	Smith Decl. ¶ 46 Ground 1, Claim 1[H]
Zhang discloses the mobile device sends the reply message. (EX1005, 9:35-54, FIG. 7; EX1003, ¶46.) For example, Zhang teaches the user can say “Goober, Reply yes” to “send a reply message” stating “Yes.” (EX1005, 9:35-54; EX1003, ¶46.) Thus, the reply message is transmitted to the second user, <i>i.e.</i>, the user that sent the initial incoming message. (EX1003, ¶46.)	46. Zhang discloses the mobile device sends the reply message. (EX1005, 9:35-54, FIG. 7.) For example, Zhang teaches the user can say “Goober, Reply yes” to “send a reply message” stating “Yes.” (EX1005, 9:35-54.) Thus, the reply message is transmitted to the second user, <i>i.e.</i>, the user that sent the initial incoming message.

IX. CONCLUSION

For any of these reasons, the Board should deny institution of the Petition.

ARMOND WILSON LLP

Dated: March 2, 2026

By: /Douglas R. Wilson/
Douglas R. Wilson (Reg. No. 54,542)
Michelle E. Armond (Reg. No. 53,954)
Joseph Li (Reg. No. 74,998)
Monica Arnold (Reg. 77,262)
Attorneys for IngenioSpec, LLC

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** exclusive of the parts exempted as provided in 37 C.F.R. § 42.24, contains 5,303 words and therefore complies with the type-volume limitations of 37 C.F.R. § 42.24.

ARMOND WILSON LLP

Dated: March 2, 2026

By: /Douglas R. Wilson/
Douglas R. Wilson (Reg. No. 54,542)
Michelle E. Armond (Reg. No. 53,954)
Joseph Li (Reg. No. 74,998)
Monica Arnold (Reg. 77,262)
Attorneys for IngenioSpec, LLC

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a true copy of the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** is being served electronically on March 2, 2026 to the following lead and backup counsel for Petitioner to the following email addresses:

Alex S. Yap
AYap@mofo.com

Mehran Arjomand
MARjomand@mofo.com

Bryan Blumenkopf
BBlumen@mofo.com

Apple-IngenioSpec-IPR@mofo.com

ARMOND WILSON LLP

Dated: March 2, 2026

By: /Douglas R. Wilson/
Douglas R. Wilson (Reg. No. 54,542)
Michelle E. Armond (Reg. No. 53,954)
Joseph Li (Reg. No. 74,998)
Monica Arnold (Reg. 77,262)
Attorneys for IngenioSpec, LLC