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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

INGENIOSPEC, LLC,
Patent Owner.

Case No. IPR2026-00143
U.S. Patent No. 12,001,599

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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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	RESERVED
2009	RESERVED
2010	Exhibit E-3 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)
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	DocketNavigator Case List for U.S. Patent No. 11,829,518
2013	Office Action in Apple Patent Application Citing U.S. Patent No. 7,890,128
2014	Information Disclosure Statement in Apple Patent Application Listing U.S. Patent Application Publication No. 2004/0208324
2015	Declaration of Peter Tong

I. INTRODUCTION

In piecemeal fashion, Apple challenged three of six patents asserted in the consolidated district court cases, in which the court has set a firm trial date of April 26, 2027, before the Board’s June 3, 2027 statutory deadline for a final written decision here. EX2005 at 1; EX2001 ¶¶ 20-22; EX2002 ¶¶ 20-22; EX2003 at 1; Paper 2 (“Pet.”); IPR2026-00142, Paper 2; IPR2026-00144, Paper 2. The three patents challenged by Apple—U.S. Patent Nos. 8,112,104; 8,582,789; and 12,001,599—issued in 2012, 2013, and 2024, respectively. *See* EX1001; IPR2026-00142, EX1001; IPR2026-00144, EX1001.

As explained below, discretionary denial is warranted because efficiency and IngenioSpec’s settled expectations counsel heavily in favor of a jury deciding the overlapping patentability challenges presented here. The patents issued some time ago and also have been licensed. Moreover, the parallel district court litigation has been progressing since June 2025 and is set to resolve all the issues raised in this IPR, and more, before the Board’s projected final written decision due date. Apple’s narrow stipulation neither eliminates duplication nor mitigates the inconsistency stemming from Apple’s asserting different claim construction positions in the two forums. The Petition is also facially deficient and does not meet the threshold showing required for institution. Institution should be denied.

II. PATENT OWNER’S SETTLED EXPECTATIONS FAVOR DISCRETIONARY DENIAL

In considering discretion, the Director may address the “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Memorandum, “Interim Processes for PTAB Workload Management,” at 2 (Mar. 26, 2025) (“Interim Processes Memo”). Although the ’599 Patent issued only recently, IngenioSpec has licensed the patent as well as provided actual notice to Apple of the ’599 Patent creating settled expectations despite its recent issuance. Also, the likely denial of institution for the parallel ’104 and ’789 Patent IPRs based on strong settled expectations, among other issues, suggests that institution of the ’599 Patent alone would be an inefficient use of Board resources.

The challenged patents, including the ’599 Patent, have been licensed to third parties, supporting IngenioSpec’s settled expectations. EX2015 ¶¶ 2-4; *Alliance Laundry Sys. v. PayRange*, IPR2025-00950, Paper 11 at 3 (P.T.A.B. Sept. 19, 2025) (informative) (“settled expectations favoring Patent Owner” where “Patent Owner presents evidence that it has licensed the challenged patent”); *Hisense v. VideoLabs*, IPR2025-00880, Paper 11 at 2 (P.T.A.B. Oct. 10, 2025) (settled expectations where “the challenged patents have been licensed”). On the flip side, Apple cannot seriously assert that it did not expect enforcement of the ’599 Patent, when the ’599 Patent’s parent, U.S. Patent No. 11,829,518, was asserted recently in the same

district court cases against Samsung, Sony, Bose, and LG identified in Apple’s ’789 Patent IPR Petition. *Compare* EX2012 at 1, *with* IPR2026-00144, Paper 2 at 81.

IngenioSpec also wrote to Apple on June 21, 2024 notifying Apple of its infringement of the ’599 Patent before the parallel litigation was filed, EX2015 ¶ 5, which further “favor[s] discretionary denial,” *Hisense*, IPR2025-00880, Paper 11 at 2 (“Patent Owner sent Petitioner a notice letter regarding Patent Owner’s patent portfolio.”).

The ’104 and ’789 Patents challenged in IPR2026-00142 and -00144 have been in force for 14 and 12 years, respectively, “creating strong settled expectations for Patent Owner” favoring discretionary denial. *Amazon.com v. Audio Pod IP*, IPR2025-00768, Paper 15 at 2 (P.T.A.B. Aug. 14, 2025); *see also Samsung Elecs. v. Sinotechnix*, IPR2025-00331, Paper 13 at 2 (P.T.A.B. July 2, 2025) (discretionary denial: “the challenged patents have been in force for more than 10 years, creating strong settled expectations”).

Apple has also had actual knowledge of the ’104 Patent family since at least 2012 and the ’789 Patent family since at least 2016. *See* EX2013 at 1, 3 (office action in Apple patent application rejecting claims based on the ’104 Patent’s parent, U.S. Patent No. 7,890,128); EX2014 at 2 (Apple IDS listing U.S. Patent Application Publication No. 2004/0208324, which claims priority to the same provisional applications as the ’789 Patent). Apple’s knowledge of the challenged “patent family

for a significant period of time” favors discretionary denial. *Amazon.com*, IPR2025-00768, Paper 15 at 3; *see also Dabico Airport Sols. v. AXA Power*, IPR2025-00408, Paper 21 at 3 (P.T.A.B. June 18, 2025) (informative) (“[P]atent applications... and issued patents are almost always publicly available to provide notice....”).

While the ’599 Patent at issue here “has not been in force as long as the other patents challenged,” because the district court will also be considering the validity of the ’599 Patent, *see* EX2006 at 77-89, “referring [this IPR] to the Board would be an inefficient use of Board resources and tips the balance to discretionary denial as to that patent too.” *Amazon.com*, IPR2025-00768, Paper 15 at 3; *see also Nvidia v. Neural AI*, IPR2025-00606, Paper 18 at 2-3 (P.T.A.B. July 31, 2025) (similar: “inefficient use of Board resources and tips the balance to discretionary denial” for patent that “has not been in force for a significant period of time”).

IngenioSpec’s settled expectations favor discretionary denial so that all validity issues can be efficiently resolved by the district court.

III. THE *FINTIV* FACTORS SUPPORT DISCRETIONARY DENIAL

The Director should also discretionarily deny institution under 35 U.S.C. § 314(a) because none of the *Fintiv* factors supports proceeding with a trial here. *See Apple v. Fintiv*, IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020) (precedential). “[T]he... *Fintiv* factors... are used to assess whether instituting Patent Office review would be an inefficient use of resources given

parallel district court proceedings.” *Intel v. VLSI Tech.*, No. 2021-1614, 2021 WL 5968443, at *1 (Fed. Cir. May 5, 2021). A jury deciding the overlapping patentability challenges presented here, as well as additional issues, before any Final Written Decision, strongly favors denial.

1. Factor 1: Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.

Neither party has sought a stay, and there is no evidence that the district court would stay its case if this IPR were instituted. Indeed, even if instituted, Judge Albright rarely stays cases where only a subset of asserted patent claims is subject to IPR, which would be the case here where Apple has not filed IPR challenges against three of the six patents asserted in the district court. *See, e.g., Edge Networking Sys. v. Microsoft*, No. 1:24-cv-00215-ADA, Dkt. 63 at 1-2 (W.D. Tex. Nov. 21, 2025) (denying motion to stay where only a subset of asserted patent claims “are subject to the pending IPR challenge”).

Fintiv factor 1 thus favors denial or is neutral. *See, e.g., Samsung Elecs. v. Cerence Operating*, IPR2025-00458, Paper 14 at 2 (P.T.A.B. June 25, 2025) (discretionary denial where “there is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial”); *Full-Metal-Power v. InFocus Downhole Sols.*, IPR2025-00391, Paper 14 at 2 (P.T.A.B. June 25, 2025) (same).

2. Factor 2: The proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.

The co-pending litigation in Texas is scheduled for trial on April 26, 2027, *before* the June 3, 2027 statutory deadline for a Final Written Decision in this IPR. EX2005 at 1. The earlier district court trial date tips factor 2 strongly in favor of discretionary denial. *See, e.g., Full-Metal-Power*, IPR2025-00391, Paper 14 at 2 (denying institution where, like here, the district court’s scheduled trial date is just over five weeks before the projected final written decision due date); *Cerence Operating*, IPR2025-00458, Paper 14 at 2; *NXP USA v. Redstone Logics*, IPR2025-00485, Paper 11 at 2 (P.T.A.B. July 10, 2025).

To the extent Apple argues that “the district court scheduled trial date and the projected final written decision due date are in close proximity,” that further supports “[e]xercising discretion to deny the petition in this case” to “reduce[] the inefficiencies and burdens on the parties to maintain two parallel proceedings.” *Shenzen Tuozhu Tech. v. Stratasys*, IPR2025-00354, Paper 11 at 2 (P.T.A.B. June 12, 2025).

3. Factor 3: Investment in the parallel proceeding by the court and the parties.

The co-pending district court case has been moving forward since June 2025. Infringement and invalidity contentions have been exchanged, and claim

construction is underway with an April 2, 2026 *Markman* hearing scheduled to take place before the June 3, 2026 institution deadline. EX2004 at 2-5; EX2005 at 1.

Based on the “meaningful investment in the district court proceeding,” *Fintiv* factor 3 weighs in favor of discretionary denial. *Advanced Micro Devices v. Concurrent Ventures*, IPR2025-00223, Paper 9 at 2 (P.T.A.B. June 12, 2025) (denying institution where “the parties have exchanged infringement and invalidity contentions” and “a *Markman* hearing is scheduled to occur before the due date for an institution decision”); *see also NXP*, IPR2025-00485, Paper 11 at 2 (“meaningful investment” where “the district court has held a *Markman* hearing”).

4. Factor 4: Overlap between issues raised in the petition and in the parallel proceeding.

Apple’s invalidity contentions in the district court litigation challenge the same Claims 1-25 of the ’599 Patent based on the substantively identical Jannard, Griffin, Zadesky, Abreu, and Burson references.¹ Compare EX2006 at 78-79, with

¹ Apple’s invalidity contentions cite different versions of certain Petition references, but those versions are substantively identical in whole or in relevant part. In particular, Apple’s contentions rely on U.S. Patent No. 8,482,488 to Jannard; U.S. Patent Application Publication No. 2004/0063456 to Griffin; and U.S. Patent No. 7,187,960 to Abreu. EX2006 at 78. The Petition’s Jannard reference is a

Pet. at 6-7; *see also* EX2006 at 2. Apple’s invalidity contentions also purport to “incorporate[]... by reference all... *inter partes* review proceedings involving the ’599 Patent.” EX2006 at 86. Thus, “the patentability disputes before the [district court] will resolve all or substantially all of the patentability disputes between the parties.” *SK Innovation v. LG Chem*, IPR2020-00991, Paper 14 at 16 (P.T.A.B. Nov. 30, 2020) (citation omitted).

The district court litigation will also resolve issues beyond those in the IPR. Apple’s Petition is confined to whether the ’599 Patent “claims are unpatentable... as obvious, in view of the prior art.” Pet. at 6. Those issues are subsumed in the co-pending litigation. *See, e.g.*, EX2006 at 77-80. In addition to obviousness under 35 U.S.C. § 103, in the district court litigation, Apple asserts invalidity theories under §§ 102 and 112, including both written description and indefiniteness challenges. *See* EX2006 at 77-89. As explained in Section IV below, Apple’s positions in the district court are inconsistent with those taken in this IPR. Instituting IPR would not simplify the dispute and would instead force the parties and tribunals

continuation of the ’488 Patent, EX1016 at 1; the ’456 Publication is the publication of the application that issued as the Petition’s Griffin reference, EX1017 at 1; and the ’960 Patent is a parent of the Petition’s Abreu reference, EX1019 at 2.

to litigate in two forums simultaneously over overlapping facts and evidence, risking potentially inconsistent outcomes.

Apple proffers a narrow stipulation, *see* Paper 6 at 1, but its stipulation “does not ensure that these IPR proceedings would be a ‘true alternative’ to the district court proceeding.” *Motorola Sols. v. Stellar*, IPR2024-01205, Paper 19 at 3-4 (P.T.A.B. Mar. 28, 2025) (granting Director Review and denying institution). Apple’s extensive use of the asserted IPR art (or substantively identical versions of it) with other types of art in the district court to avoid estoppel renders its limited stipulation meaningless. *See* EX2006 at 80-86 (identifying “prior art apparatuses/systems”); EX2010 at 1-2 (identifying the “Jabra FreeSpeak system” that allegedly “would have been obvious to combine... with one or more of” “Griffin ’456,” “Zadesky ’230,” and “Burson ’688,” which are or are simply alternate versions of EX1017, EX1018, and EX1020, respectively). Indeed, “Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation” would not moot. *Motorola Sols.*, IPR2024-01205, Paper 19 at 4; *Shenzen Tuozhu*, IPR2025-00354, Paper 11 at 2; *see also* Interim Director Discretionary Process § I.D. (“Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity

theories, a stipulation may not be particularly meaningful because the efficiency gained in an AIA proceeding will be limited.”).

Fintiv factor 4 weighs in favor of denial.

5. Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party.

Factor 5 also supports denial of institution. Apple is both the Petitioner here and the defendant in the parallel Texas litigation.

6. Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits.

The “strength of the unpatentability challenge” may also be considered in deciding whether to exercise discretion to deny institution. Interim Processes Memo at 2. Here, Apple’s facially-deficient Petition supports denying institution.

First, the Petition fails to address at least one limitation in every challenged claim in each of the Petition’s eight grounds and thus on its face fails to satisfy 37 C.F.R. § 42.104(b)(4), requiring that “[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon” As identified in the bullet-point list below, the Petition does not address the requirement of “at least partially in the wireless wearable device” or comparable claim limitations for the following labeled limitations, which include limitations in all independent Claims 1, 20, 22, and 24 as well as numerous dependent claims. For example, in Ground 1, the Petition never addresses the Claim 1[B] requirement of

an electrical connector “at least partially in the wireless wearable device.” *See* Pet. at 18-21.

- Ground 1 (Claims 1-7, 10, 11, and 24): Claims 1[B], 1[E], 3[A], 6[A], 7[A], 10[A], 24[A], 24[D], 24[E], 24[F]. *See* Pet. at 18-21, 30, 32, 34-35, 36-37, 39-42.
- Ground 2 (Claim 8): Claim 8[B]. *See* Pet. at 45-47.
- Ground 3 (Claims 9, 12-18, 20, and 25): Claims 9[A], 14[A], 15[A], 16[A]², 17[A], 18[A], 20[B], 20[E], 20[G], 20[H]. *See* Pet. at 51-52, 58-63.
- Ground 4 (Claims 19 and 21-23): Claim 22[B], 22[E], 22[G], 23[A], 23[B]. *See* Pet. at 65-67.

² Claim 16[A] refers to “claim 9[B]” for its entire argument, but claim 9[B] does not exist. *See* Pet. at 51-55, 60.

- Ground 5 (Claims 1-7, 14-15, 20, and 24)³: Claims 1[B], 1[D], 1[E], 2[A], 3[A], 6[A], 7[A], 24[A], 24[C]⁴, 24[D], 24[E], 24[F]. *See* Pet. at 72-73, 75-78, 80-84.
- Ground 6 (Claims 8 and 11): Claim 8[B]. *See* Pet. at 87-88.
- Ground 7 (Claims 9-10, 12-18, 20, and 25): Claims 9[A], 10[A], 14[A], 15[A], 16[A]⁵, 17[A], 18[A], 20[B], 20[D], 20[E], 20[F], 20[G], 20[H]. *See* Pet. at 90-96.
- Ground 8 (Claims 19 and 21-23): Claims 22[B], 22[D], 22[E], 22[F], 22[G], 23[A], 23[B]. *See* Pet. at 97-98.

The Petition’s failure to show the above limitations are satisfied means Apple cannot sustain its burden on any claim, and institution should be denied. *See, e.g., Google v. Dialect*, IPR2024-00748, Paper 11 at 20 (P.T.A.B. Oct. 11, 2024) (denying institution “[b]ecause Petitioner’s arguments and evidence do not address”

³ Claims 14-15 and 20 are not addressed in the Petition’s Ground 5 even though the Petition’s heading says it challenges them. *See* Pet. at 68, 81-82.

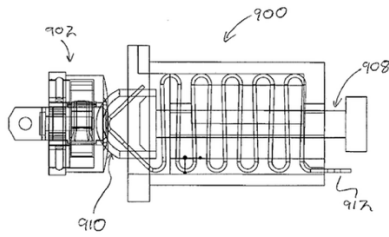
⁴ Claim 24[C] recites “in the wireless wearable device” instead of “at least partially in the wireless wearable device.”

⁵ Claim 16[A] refers to “claim 9[B]” for its entire argument, but claim 9[B] does not exist. *See* Pet. at 90-92, 94.

a claim limitation required by every challenged claim); 35 U.S.C. § 314(a) (IPR may not be instituted “unless... the information presented in the petition... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”).

Second, the Petition is supported by an expert declaration that “merely repeats, *verbatim*, the conclusory assertion[s] for which it is offered to support.” *Xerox v. Bytemark*, IPR2022-00624, Paper 9 at 15 (P.T.A.B. Aug. 24, 2022) (precedential) (emphasis in original) (denying institution). Apple’s expert, Dr. Smith, simply repeats word for word the text of the Petition. *Compare* Pet. at 8-98, with EX1003 ¶¶ 32-260. Dr. Smith’s parroting verbatim Apple’s Petition, as shown in the illustrative snapshot below, confirms the Petition’s weakness. *See, e.g., 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.”).

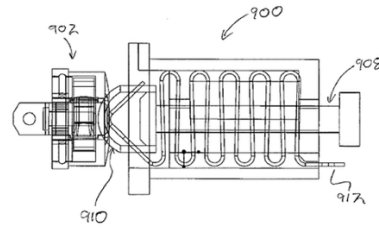
Pet. at 21-24 Ground 1, Claim 1[C] (excerpted)	Smith Decl. ¶¶ 49-53 Ground 1, Claim 1[C] (excerpted)
This element is met by Jannard in view of Burson. (EX1003, ¶49.) For example, Jannard discloses that “with an appropriate recharging cradle (not shown), the audio device 10D can be laid on the cradle, thereby making contact between the power contacts 164 and corresponding contacts in the cradle (not shown).” (EX1016, 33:16-20; EX1003, ¶49.) To the extent that Jannard alone does not teach the conductive areas coupling to corresponding conductive contacts, at least via spring-force, this element is taught by Jannard in combination with Burson. (EX1003, ¶50.) For example, as described above, Jannard discloses that power contacts on a wireless, wearable headset (Jannard’s audio device, <i>see</i> EX1016 at 38:62-39:1) can removably connect to corresponding contacts on a cradle to recharge the headset’s battery. (EX1003, ¶50.) Burson similarly discloses a wireless, wearable headset that utilizes a cradle to recharge its battery. (EX1003, ¶50.) In Burson, positive and negative surface charging contacts (which may be integrated with the headset) removably couple the device’s battery to corresponding charging contacts on a powered charging base. (EX1020, 2:5-53, 3:31-4:55, 8:54-57; EX1003, ¶50.) When the device is inserted into a docking cradle of the charging base, charging current is supplied through the coupled contacts to recharge the device’s battery. (EX1020, 1:26-42, 6:56-67; EX1003, ¶50.) Burson discloses that the charging base’s surface contacts can advantageously be spring-loaded, thus allowing the user to “simply drop the headset into [the] cradle without fumbling with a plug.” (EX1020, 1:43-59; EX1003, ¶51.) As the headset in Burson is inserted into the cradle, <i>e.g.</i>, via a downward and forward motion, the headset’s charging contacts exert pressure on the charging base’s corresponding spring-loaded contacts, causing the spring-loaded contacts to retract. (EX1020, 6:56-67; EX1003, ¶51.) Once the headset is fully inserted, the spring-loaded contacts “form an electrical connection” with the headset’s contacts. (EX1020, 6:56-67; EX1003, ¶51.) That is, once the headset’s contacts become aligned with the charging base’s contacts in a detent position, an actuator of the spring-loaded contact extends into the headset contact apparatus 902, “allowing the spring loaded contacts to couple with the corresponding contacts on the headset contact apparatus 902 to complete the charging loop.” (EX1020, 9:7-26; EX1003, ¶51.) Conversely, the electrical connection is discontinued when the headset is removed from the cradle. (EX1020, 9:27-37; EX1003, ¶51.) FIG. 9 illustrates an electrical coupling of headset contact apparatus 902 in the detent position with the corresponding spring-loaded contact 900, via actuator 910 and spring 912:	49. This element is met by Jannard in view of Burson. For example, Jannard discloses that “with an appropriate recharging cradle (not shown), the audio device 10D can be laid on the cradle, thereby making contact between the power contacts 164 and corresponding contacts in the cradle (not shown).” (EX1016, 33:16-20.) 50. To the extent that Jannard alone does not teach the conductive areas coupling to corresponding conductive contacts, at least via spring-force, this element is taught by Jannard in combination with Burson. For example, as described above, Jannard discloses that power contacts on a wireless, wearable headset (Jannard’s audio device, <i>see</i> EX1016 at 38:62-39:1) can removably connect to corresponding contacts on a cradle to recharge the headset’s battery. Burson similarly discloses a wireless, wearable headset that utilizes a cradle to recharge its battery. In Burson, positive and negative surface charging contacts (which may be integrated with the headset) removably couple the device’s battery to corresponding charging contacts on a powered charging base. (EX1020, 2:5-53, 3:31-4:55, 8:54-57.) When the device is inserted into a docking cradle of the charging base, charging current is supplied through the coupled contacts to recharge the device’s battery. (EX1020, 1:26-42, 6:56-67.) 51. Burson discloses that the charging base’s surface contacts can advantageously be spring-loaded, thus allowing the user to “simply drop the headset into [the] cradle without fumbling with a plug.” (EX1020, 1:43-59.) As the headset in Burson is inserted into the cradle, <i>e.g.</i>, via a downward and forward motion, the headset’s charging contacts exert pressure on the charging base’s corresponding spring-loaded contacts, causing the spring-loaded contacts to retract. (EX1020, 6:56-67.) Once the headset is fully inserted, the spring-loaded contacts “form an electrical connection” with the headset’s contacts. (EX1020, 6:56-67.) That is, once the headset’s contacts become aligned with the charging base’s contacts in a detent position, an actuator of the spring-loaded contact extends into the headset contact apparatus 902, “allowing the spring loaded contacts to couple with the corresponding contacts on the headset contact apparatus 902 to complete the charging loop.” (EX1020, 9:7-26.) Conversely, the electrical connection is discontinued when the headset is removed from the cradle. (EX1020, 9:27-37.) FIG. 9 illustrates an electrical coupling of headset contact apparatus 902 in the detent position with the corresponding spring-loaded contact 900, via actuator 910 and spring 912:



(EX1020, 9:7-26; EX1003, ¶51.)

Burson provides that in the detent position, pressure is applied by the actuator member against the headset contact to “complete the charging loop” and permit the electrical coupling. (EX1020, 9:7-26; EX1003, ¶52.) The POSITA would understand this pressure to be the result of a spring-force applied by spring 912: as the POSITA would recognize, when a spring (such as spring 912) is coupled to a mass (such as actuator 910) and compressed (e.g. by the downward and forward motion of the headset against the cradle), the spring—by the operation of Hooke’s law—exerts a restorative spring force on the mass. (See EX1021, 132-33; EX1003, ¶52.) Thus, the POSITA would understand spring 912 to exert a spring force on the actuator toward the headset contact 902 when the headset is docked, thereby “allowing the spring loaded contacts to couple with the corresponding contacts on the headset contact apparatus 902 to complete the charging loop.” (EX1020, 9:7-26; EX1003, ¶52.)

Applying Burson’s teachings to Jannard, the electrical contacts of Jannard’s docking cradle would be spring-loaded, as in Burson, to removably couple to (and separate from) the corresponding power contacts 164 of Jannard’s headset. (EX1003, ¶53.) The inclusion of the spring-loaded contacts would simplify charging by allowing a user to “simply drop the headset into [the] cradle without fumbling with a plug.” (EX1020, 1:43-59; EX1003, ¶53.) As described above for Burson, the spring-loaded contacts of the docking cradle would utilize spring-force to enable the docking cradle’s contacts to electrically connect to the corresponding power contacts 164 when Jannard’s headset is inserted into the charging cradle. (EX1003, ¶53.) This electrical connection between power contacts 164 and the charger’s corresponding contacts enables charging the battery of Jannard’s headset, as described above for Jannard. (EX1016, 33:13-15; EX1003, ¶53.)



(EX1020, 9:7-26.)

52. Burson provides that in the detent position, pressure is applied by the actuator member against the headset contact to “complete the charging loop” and permit the electrical coupling. (EX1020, 9:7-26.) The POSITA would understand this pressure to be the result of a spring-force applied by spring 912: as the POSITA would recognize, when a spring (such as spring 912) is coupled to a mass (such as actuator 910) and compressed (e.g. by the downward and forward motion of the headset against the cradle), the spring—by the operation of Hooke’s law—exerts a restorative spring force on the mass. (See EX1021, 132-33.) Thus, the POSITA would understand spring 912 to exert a spring force on the actuator toward the headset contact 902 when the headset is docked, thereby “allowing the spring loaded contacts to couple with the corresponding contacts on the headset contact apparatus 902 to complete the charging loop.” (EX1020, 9:7-26.)

53. Applying Burson’s teachings to Jannard, the electrical contacts of Jannard’s docking cradle would be spring-loaded, as in Burson, to removably couple to (and separate from) the corresponding power contacts 164 of Jannard’s headset. The inclusion of the spring-loaded contacts would simplify charging by allowing a user to “simply drop the headset into [the] cradle without fumbling with a plug.” (EX1020, 1:43-59.) As described above for Burson, the spring-loaded contacts of the docking cradle would utilize spring-force to enable the docking cradle’s contacts to electrically connect to the corresponding power contacts 164 when Jannard’s headset is inserted into the charging cradle. This electrical connection between power contacts 164 and the charger’s corresponding contacts enables charging the battery of Jannard’s headset, as described above for Jannard. (EX1016, 33:13-15.)

7. None Of The *Fintiv* Factors Supports Institution

The weight of the *Fintiv* factors supports the Director exercising its discretion to deny review under Section 314(a), thereby conserving Board and party resources

and preventing duplicative proceedings evaluating the same invalidity challenges against the same patent. None of the six *Fintiv* factors supports institution here.

IV. PETITIONER’S INCONSISTENT CLAIM CONSTRUCTION POSITIONS WARRANT DISCRETIONARY DENIAL

Board “rules discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability.” *Revvo Techs. v. Cerebrum Sensor Techs.*, IPR2025-00632, Paper 20 at 4 (P.T.A.B. Nov. 3, 2025) (precedential). That is precisely what Apple has done here: Apple asserts “no claim construction is necessary” in the IPR, while simultaneously proposing a different construction in the district court. Pet. at 6. Despite asserting in its Petition that it “does not concede that any preamble is limiting for any ground in the Petition,” Pet. at 7 n.1, Apple takes the position in the district court that the preambles of independent Claims 1, 20, 22, and 24 are both “limiting” and “indefinite,” EX2011 at 2; *see also* EX2006 at 89.

Apple’s inconsistent claim constructions between the two forums warrants denial of its Petition. *See, e.g., Sun Pharms. Indus. v. Nivagen Pharms.*, IPR2025-00893, Paper 18 at 3 (P.T.A.B. Sept. 19, 2025) (informative) (discretionary denial where the petitioner “advanced a narrow construction in district court and advances a broader construction in its Petition”); *Revvo Techs. v. Cerebrum Sensor Techs.*,

IPR2025-00632, Paper 36 at 4 (P.T.A.B. Jan. 26, 2026) (“The appropriate course of action... is to deny institution” where petitioner “raise[s] different claim constructions in the two forums.”). Apple’s inability to raise indefiniteness in an IPR does not excuse its inconsistent positions. *See, e.g., Tesla v. Intellectual Ventures*, IPR2025-00340, Paper 18 at 3 (P.T.A.B. Nov. 5, 2025) (informative) (denying institution: “Petitioner’s statement that it cannot raise indefiniteness challenges in an *inter partes* review is not a sufficient explanation.”).

V. APPLE CANNOT JUSTIFY USE OF BOARD RESOURCES

Institution would not be an appropriate or efficient use of Board resources here, and there is a significant risk of conflicting decisions with the co-pending litigation where the same parties have already committed substantial resources toward resolving a broader array of issues in the district court including those presented in Apple’s Petition and the validity of three additional patents that Apple has not challenged in IPR as of this filing. Absent “persuasive reasons why the Office should review the challenged patent... the Office is disinclined to disturb the settled expectations of Patent Owner.” *Dabico*, IPR2025-00408, Paper 21 at 3. The Board’s institutional policy weighs heavily in favor of discretionary denial where, as here, efficiency gains are nonexistent and the parallel litigation already subsumes all or substantially all issues, and more.

VI. CONCLUSION

The Director should discretionarily deny institution, allowing all validity issues to be efficiently resolved by the district court.

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Dated: February 3, 2026

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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 REQUEST FOR DISCRETIONARY DENIAL** and **EXHIBITS 2001-2006** and **2010-2015** are being served electronically on February 3, 2026 to the following lead and backup counsel for Petitioner to the following email addresses:

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