

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

INGENIOSPEC, LLC,
Patent Owner.

Patent No. 12,001,599

Inter Partes Review No. IPR2026-00143

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. ARGUMENT.....	4
A. The '599 Patent Resulted From Material USPTO Error.....	4
1. The Examiner's Prior Art Search Was Materially Defective	5
2. The Examiner Overlooked the Teachings of the Prior Art.....	7
B. Settled Expectations Favor the Petitioner, Not the Patent Owner	8
C. Petitioner Does Not Present Inconsistent Claim Construction Positions	9
D. The <i>Fintiv</i> Factors Are Neutral or Favor Institution	11
1. Factor 1: The Likelihood of a Stay Is Neutral	12
2. Factor 2: The Parallel Trial Date Weighs Against Discretionary Denial	12
3. Factor 3: Limited Investment in Parallel Proceeding Weighs Against Discretionary Denial	15
4. Factor 4: Limited Overlap Between the Petition and Parallel Proceeding Weighs Strongly Against Discretionary Denial Because Petitioner Agreed to a <i>Sotera</i> Stipulation.....	16
5. Factor 5: Whether the Parties Are the Same Is Neutral.....	18
6. Factor 6: Other Considerations, Including the Strength of the Petition, Weigh Against Discretionary Denial	18
E. Patent Owner's Pattern of Enforcement Supports Institution.....	19

TABLE OF CONTENTS
(continued)

	Page
III. CONCLUSION.....	20

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Inc. v. Ferid Allani</i> , IPR2025-00856, Paper 11 (Sept. 5, 2025)	9, 12
<i>Bio-Rad Lab’ys, Inc. v. Cal. Inst. of Tech.</i> , IPR2024-01451, Paper 11 (Mar. 27, 2025)	16
<i>ClearCorrect Operating, LLC v. Align Tech., Inc.</i> , IPR2025-00814, Paper 14 (Aug. 29, 2025)	4, 15
<i>CrowdStrike, Inc. v. Open Text Inc.</i> , IPR2023-00289, Paper 7 (July 21, 2023)	19
<i>Dabico Airport Sols. Inc. v. AXA Power ApS</i> , IPR2025-00408, Paper 21 (June 18, 2025)	19
<i>Eunsung Global Corp. v. HydraFacial LLC</i> , IPR2025-00445, Paper 14 (July 10, 2025)	2
<i>Interval Licensing LLC v. AOL, Inc.</i> , 766 F.3d 1364 (Fed. Cir. 2014)	10
<i>IOENGINE, LLC v. Roku Inc.</i> , No. 6:21-cv-01296-ADA, ECF No. 306 (W.D. Tex. Sept. 19, 2023).....	13, 14
<i>Liberty Energy Servs., LLC v. U.S. Well Servs., LLC</i> , IPR2025-00139, Paper 14 (June 11, 2025).....	17
<i>Microsoft Corp. v. Edge Networking Sys., LLC</i> , IPR2025-00617, Paper 12 (July 31, 2025)	8
<i>Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH</i> , IPR2025-00318, Paper 9 (June 12, 2025).....	2, 12
<i>Motion Offense, LLC v. Google LLC</i> , No. 6:21-cv-0514-ADA, ECF No. 68 (W.D. Tex. June 10, 2022).....	13, 14

<i>Realtime Data LLC v. Iancu</i> , 912 F.3d 1368 (Fed. Cir. 2019)	10
<i>Revvo Techs., Inc. v. Cerebrum Sensor Techs. Inc.</i> , IPR2025-00632, Paper 20 (Nov. 3, 2025)	9, 10
<i>Samsung Elecs Co. v. Wilus Inst. of Standards and Tech., Inc.</i> , IPR2025-01043, Paper 11 (Oct. 10, 2025)	4
<i>Sand Revolution II, LLC v. Cont’l Intermodal Grp. – Trucking LLC</i> , IPR2019-01393, Paper 24 (June 16, 2020).....	16
<i>Shenzhen Root Tech. Co. v. Chiaro Tech. Ltd.</i> , IPR2024-01296, Paper 9 (Feb. 25, 2025)	18
<i>Snap, Inc. v. SRK Tech. LLC</i> , IPR2020-00820, Paper 15 (Oct. 21, 2020)	18
<i>Sotera Wireless, Inc., v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (Dec. 1, 2020)	16
<i>Stingray Grp. Inc. v. Hernandez-Mondragon</i> , IPR2025-00349, Paper 19 (June 13, 2025).....	17
<i>Tesla v. Intellectual Ventures II LLC</i> , IPR2025-00340, Paper 18 (Nov. 5, 2025)	3, 11
<i>W. Digit. Corp. v. Kuster</i> , IPR2020-01391, Paper 10 (Feb. 16, 2021).....	12

Petitioner's Updated Exhibit List

Exhibit Description	Exhibit #
U.S. Patent No. 12,001,599 to Howell et al.	EX1001
Prosecution History of U.S. Patent No. 12,001,599	EX1002
Declaration of Dr. Joshua R. Smith	EX1003
Curriculum Vitae for Dr. Joshua R. Smith	EX1004
U.S. Provisional Patent Appl. No. 60/725,896	EX1005
U.S. Provisional Patent Appl. No. 60/725,999	EX1006
U.S. Provisional Patent Appl. No. 60/787,850	EX1007
U.S. Provisional Patent Appl. No. 60/846,150	EX1008
U.S. Provisional Patent Appl. No. 60/592,045	EX1009
U.S. Provisional Patent Appl. No. 60/605,191	EX1010
U.S. Provisional Patent Appl. No. 60/618,107	EX1011
U.S. Provisional Patent Appl. No. 60/620,238	EX1012
U.S. Provisional Patent Appl. No. 60/646,836	EX1013
U.S. Provisional Patent Appl. No. 60/647,826	EX1014
U.S. Patent Appl. No. 11/183,256	EX1015
U.S. Patent No. 10,222,617 to Jannard	EX1016
U.S. Patent No. 7,313,423 to Griffin et al.	EX1017
U.S. Patent No. 7,046,230 to Zadesky et al.	EX1018
U.S. Patent No. 10,729,371 to Abreu	EX1019

Exhibit Description	Exhibit #
U.S. Patent No. 6,923,688 to Burson et al.	EX1020
Excerpts from Edwards, C. and Penney, D., ELEMENTARY DIFFERENTIAL EQUATIONS WITH BOUNDARY VALUE PROBLEMS, 4TH ED. (Prentice-Hall, Inc., 2000)	EX1021
PatentBots Statistics for Examiner Ammar T. Hamid and Art Unit 2695 (February 25, 2026)	EX1022 (NEW)
USPTO, “Patent Public Search – Advanced Search overview Quick Reference Guide 2024”	EX1023 (NEW)
USPTO, Selected Definitions for CPC and USPC Subclasses	EX1024 (NEW)
U.S. Patent No. 6,769,767 to Swab et al.	EX1025 (NEW)
Docket Navigator, Judge Albright Patent Case Time-to-Trial Statistics	EX1026 (NEW)
Jan. 31, 2025, Order Assigning Business of the Court (W.D. Tex.)	EX1027 (NEW)
Defendant’s Opening Claim Construction Brief, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, ECF No. 50 (W.D. Tex. Jan. 14, 2026)	EX1028 (NEW)
Plaintiff’s Responsive Claim Construction Brief, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, ECF No. 51 (W.D. Tex. Feb. 4, 2026)	EX1029 (NEW)
Defendant’s Reply Claim Construction Brief, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, ECF No. 52 (W.D. Tex. Feb. 18, 2026)	EX1030 (NEW)

Patent Owner's Exhibit List

Exhibit Description	Exhibit
Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 1 (W.D. Tex. June 5, 2025)	2001
Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00877, Dkt. No. 1 (W.D. Tex. June 6, 2025)	2002
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)	2003
Scheduling Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 36 (W.D. Tex. Nov. 17, 2025)	2004
Scheduling Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 39 (W.D. Tex. Dec. 5, 2025)	2005
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)	2006
RESERVED	2007
RESERVED	2008
RESERVED	2009
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)	2010
Defendant's Proposed Claim Constructions, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867 (W.D. Tex. Dec. 22, 2025)	2011
DocketNavigator Case List for U.S. Patent No. 11,829,518	2012
Office Action in Apple Patent Application Citing U.S. Patent No. 7,890,128	2013
Information Disclosure Statement in Apple Patent Application Listing U.S. Patent Application Publication No. 2004/0208324	2014

Exhibit Description	Exhibit
Declaration of Peter Tong	2015

I. INTRODUCTION

Discretionary denial of Apple’s IPR petition should be declined, and the petition should be referred for review on the merits, because the Board is in the best position to rectify numerous errors committed by the Office during prosecution of the recently-issued ’599 patent; and to stop Patent Owner from exploiting those errors through serial multi-district litigation.

First, the ’599 patent was allowed in less than four months by a lenient examiner, with an exceptionally high grant rate of 92 percent (13th percentile for “[d]ifficulty” among USPTO examiners). (EX1022.) That Examiner committed a series of material errors during his hasty examination. He relied on faulty textual and classification searching, which limited his searches to only a subset of the claim scope. This caused him to miss key prior art references—including specific references presented in the Petition. Once the Examiner identified allegedly patentable features, he neglected to conduct a search for those features to verify his hypothesis. And further, the Examiner overlooked the teachings of Swab, his “[m]ost relevant prior art of record,” which includes repeated disclosures of specific features that the Examiner believed to be patentable. (EX1002, 1001.) Patent Owner’s Request (Paper 7, “Request”) fails to account for these errors, instead remaining conspicuously silent on the matter—even though Office error was expressly identified in the Petition. (Pet., 4-5.)

Discretionary denial is inappropriate because these compound material errors allowed the '599 patent to issue with claims taught by the prior art, as demonstrated by the Petition. *See Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, 3 (June 12, 2025) (“*ParTec*”)

(“[D]iscretionary denial of institution is not warranted because of Petitioner’s showing of material error during patent examination.”); *Eunsung Global Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14, 3 (July 10, 2025) (“*Eunsung Global Corp.*”) (declining discretionary denial because “the patent examiner overlooked certain teachings in [the prior art] that appear to disclose the allowable features of the claims”). When material prosecution error is shown, the Board has declined discretionary denial even where “the scheduled district court trial is set to precede the expected final written decision due date,” and where the age of the patent “would ordinarily favor denying institution.” *ParTec*, 3; *Eunsung Global Corp.*, 2.

Second, the Request misapprehends the facts and the Board’s precedent, and cannot make a credible case for discretionary denial. For example, Patent Owner contends it has settled expectations in the '599 patent, which only issued in June 2024, less than 1.5 years before the Petition was filed. Patent Owner argues that its settled expectations arise from Patent Owner’s unrelated and expired patents. (Request, 2-4.) But these patents are not relevant to the “length of time *the claims* have been in force.” (See PTAB March 26, 2025, Guidance, 2 (emphasis added).)

The claims in question were not even *filed* until November 2023, only two years before the Petition. To the contrary, it is Petitioner who has settled expectations of non-enforcement based on Patent Owner’s history of non-enforcement of its patents against Apple—including in extensive litigation campaigns where Patent Owner targeted dozens of other technology companies. Apple’s strong settled expectations based on this history further cut against discretionary denial.

Third, Patent Owner is mistaken with respect to claim construction. (Request, 16-17.) Apple proposed in the district court that the preambles of claims 1, 20, 22, and 24 are limiting and indefinite. (EX2011, 2.) Apple took a consistent approach in the Petition, which shows how the preambles are satisfied by the prior art, regardless of whether they are limiting and/or indefinite. For example, the Petition demonstrates that “help[ing] the user hear audio outputs” is met by a prior art feature (noise cancellation) that *both parties* agreed falls within the scope of the claims. (Pet., 6, 7 n.1, 15-17.) Petitioner’s approach promotes predictability and certainty, consistent with the Director’s guidance in *Tesla*, by demonstrating that the claims are invalid unconditionally. *Tesla v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18, 3-4 (Nov. 5, 2025) (“*Tesla*”) (informative).

Fourth, the *Fintiv* factors weigh in favor of institution and against discretionary denial. For example, the Board recently considered the time-to-trial statistics for Judge Albright and the Western District of Texas; and found

discretionary denial of an IPR petition to be “not appropriate” even where Judge Albright had scheduled trial for six months before the Final Written Decision deadline. *ClearCorrect Operating, LLC v. Align Tech., Inc.*, IPR2025-00814, Paper 14, 2 (Aug. 29, 2025) (“*ClearCorrect*”). Here, in the parallel litigation before Judge Albright, the scheduled trial date leads the Final Written Decision by only about five weeks, far less than in *ClearCorrect*; and the statistics (including a median time to trial of 43 months for patent cases in 2025) demonstrate that the current trial date is speculative and unlikely to hold. When these statistics are taken into account, the Final Written Decision is likely to *lead* the trial date by almost one year. Indeed, Patent Owner’s superficial *Fintiv* analysis fails to address even the possibility that the currently scheduled trial date may be postponed.

II. ARGUMENT

A. The ’599 Patent Resulted From Material USPTO Error

The ’599 patent was the product of compound material errors committed by the USPTO. Had the Examiner applied sound prior art search methodology, and fully evaluated the search results, he would have rejected the claims as obvious in view of the prior art, *e.g.*, the prior art references relied upon by the Petition. The Examiner’s failure to do so constitutes error material to patentability and supports institution. *See Samsung Elecs Co. v. Wilus Inst. of Standards and Tech., Inc.*,

IPR2025-01043, Paper 11 (Oct. 10, 2025) (denying request for discretionary denial based on material examiner error).

1. The Examiner’s Prior Art Search Was Materially Defective

First, as evidenced by the Examiner’s published search strategy, the Examiner’s text-based searches were unduly limited to only a subset of the claim scope. (*See* EX1002, 978-992.) For example, in the Examiner’s text-based search queries (other than searches for the inventors’ names or for specific application numbers), the Examiner limited his search query by the word “head” or the word “glasses.” (EX1002, 983-988.) These searches were underinclusive: while the ’599 patent describes glasses and headwear embodiments, the claims are directed more broadly to “wireless wearable device[s]”; and not a single claim recites either “head” or “glasses.” (EX1001.) Further, the Examiner neglected to broaden his search keywords—*e.g.*, by including wildcards such as *head** or **glasses*, or by searching for related terms, such as *eyewear* or *headset*. (EX1002, 983-988; *see* EX1023, 5 (USPTO reference describing wildcard symbols and techniques in Patent Public Search).) The Examiner thus overlooked prior art that did not utilize his specific search terms; for example, the Griffin reference presented in the Petition does not include the word “head” or the word “glasses,” and thus would not have appeared in searches limited to either of those terms. (EX1017.)

Second, the Examiner utilized classification-based searches based on the USPTO's Cooperative Patent Classification (CPC) and United States Patent Classification (USPC) schemes. But, as with the Examiner's textual searching, his classification searches did not capture the full claim scope. For example, most of the Examiner's classification-based searches were limited to the subclass CPC G02C, which "concerns *only* extracorporal ophthalmic devices," and "covers spectacles or goggles *insofar they have features of vision correction or protection.*" (EX1024, 568 (emphasis added).) But the claims recite "wireless wearable device[s]," not extracorporal ophthalmic devices such as spectacles or goggles; and not even a single claim recites features of vision correction or protection. (EX1017.) Each of the Examiner's other classification searches was also inapt. For example, the Examiner searched within subclass G06F1/163, which is limited to devices "whereby the portable computer itself is worn by a user"—a limitation not recited in any of the claims. (EX1024, 13, *see also* 621, 643, 644, 685; EX1001, (58); EX1002, 978-988.)

Third, once the Examiner concluded that the claims recited limitations not found in the prior art, he failed to test his hypothesis. For example, the Examiner indicated in the Notice of Allowance that he believed removably coupling conductive areas "at least via spring-force" to be a novel feature. (EX1002, 1001-

1002.) But his search history does not include even a single search for springs or related terms; or within a classification directed to springs. (EX1002, 983-998.)

2. The Examiner Overlooked the Teachings of the Prior Art

The Examiner compounded his search errors by overlooking the plain teachings of the references. For example, the Examiner allowed the claims in part because he believed the limitation *a microphone at least partially in the wireless wearable device* was not taught by the prior art, including Swab. (EX1002, 1001-1002.)

Swab is the only reference cited by the Examiner during prosecution, and the Examiner described it as the “[m]ost relevant prior art of record.” (EX1002, 1001.) Yet the Examiner overlooked numerous disclosures in Swab’s figures, written description, and claims of exactly the type of microphone he believed was novel. (See, e.g., EX1025, 2:49-53, 5:48-51, 5:59-65, 7:5-12, FIGs. 3, 8, 12, Claims 13, 15, 20.) For

example, Swab discloses that left temple 19 of the wireless electronic eyewear 12 “preferably houses . . . microphone 54,” illustrating such a

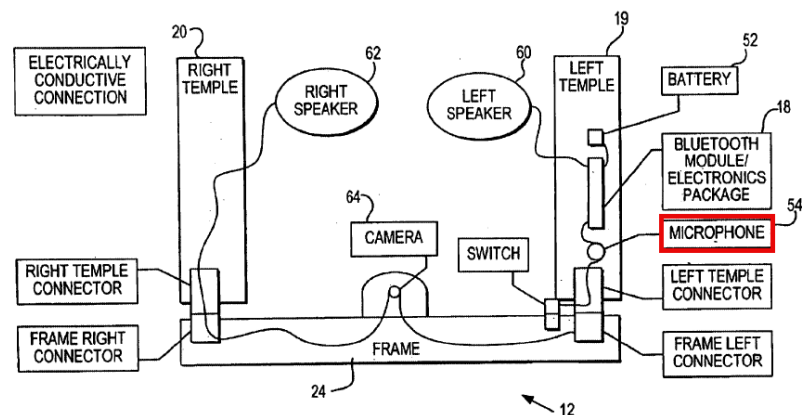


FIG. 8

configuration in Figure 8. (EX1025, 7:4-12, FIG. 8 (annotated).)

B. Settled Expectations Favor the Petitioner, Not the Patent Owner

Patent Owner contends it has settled expectations in the '599 patent, which only issued in June 2024—less than 1.5 years before the Petition was filed.

(EX1001; Request, 2-4.) Patent Owner does not identify any Board decision that found settled expectations of validity in such recent claims. To the contrary, the Board has consistently declined to apply settled expectations even to older claims. *See, e.g., Microsoft Corp. v. Edge Networking Sys., LLC*, IPR2025-00617, Paper 12, 2 (July 31, 2025) (finding no strong settled expectations for patents issued in 2020, 2021, and 2023). Patent Owner implausibly argues that its settled expectations arise from Patent Owner's unrelated and expired patents. (Request, 2-4.) But the Board has clarified that it is the “length of time the *claims* have been in force” that is relevant to discretionary denial. (PTAB March 26, 2025, Guidance, 2 (emphasis added).) Other patents, especially patents from other patent families, have no relevance.

To the contrary, it is Petitioner who has settled expectations of non-enforcement based on Patent Owner's history of not enforcing its patents against Apple. For example, in 2024, IngenioSpec asserted the parent '518 patent (but not the '599 patent) against four large technology companies, but elected not to file suit against Apple. Similarly, in 2023 through 2025, IngenioSpec asserted its patents in three ITC actions that targeted dozens of technology companies, but did

not include Apple. And Patent Owner’s affiliate, IpVenture, Inc. (*see* <https://www.ingeniospec.com/company>), has a similar history—dating to 2003—of asserting its patents against large technology companies, but excluding Apple from enforcement. For another patent, U.S. Patent No. 8,112,104, IngenioSpec sued a group of large technology companies in 2024; but did not assert the patent against Apple until months later, after the patent had expired. Apple’s settled expectations of non-enforcement based on this history cut against discretionary denial. *See Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11, 2-3 (Sept. 5, 2025) (“*Allani*”) (informative) (finding discretionary denial “not appropriate” where the petitioner “did not expect enforcement” of the patent).

C. Petitioner Does Not Present Inconsistent Claim Construction Positions

The Director clarified in *Revvo* that a petitioner taking “alternative positions” before the Board and a district court should “explain why alternative positions are warranted.” *Revvo Techs., Inc. v. Cerebrum Sensor Techs. Inc.*, IPR2025-00632, Paper 20, 3-4 (Nov. 3, 2025) (precedential). Here, there are no “alternative positions” presented. (Pet., 3.) In the district court proceeding, Apple proposed that the preambles of claims 1, 20, 22, and 24 are limiting and indefinite. (EX2011, 2.) In the Petition, Apple presents prior art that satisfies a limiting preamble and falls within the claims’ undisputed scope. As the Federal Circuit has explained, the Board need only construe the claim terms as necessary to resolve the

controversy at hand. (Pet., 6.) *See also Realtime Data LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019). The Board need not determine whether the preambles of claims 1, 20, 22, or 24 are limiting, because the Petition showed how each preamble is met by the prior art, regardless. (*See* Pet., 7 n.1, 15-17, 38, 61, 65, 70-71, 82, 95, 97.) Thus, there is no potential “gamesmanship” with respect to claim construction. *Revvo*, 2-3.

Further, Apple’s litigation position on indefiniteness is consistent with the Petition because it is distinct from and does not impact the Petition’s grounds. In litigation, Apple submits that the objective *boundaries* are unclear for the language “help the user hear audio outputs”. (EX1028, 18 (citing *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371-73 (Fed. Cir. 2014)); EX1030, 10.) But as Apple clarified, uncertain boundaries do not preclude all application of the language—for example, the patent’s specification describes that noise cancellation “help[s] a user hear audio outputs and certainly fall[s] within the scope of the claims”. (EX1028, 18.) Patent Owner agreed, similarly identifying noise cancellation as “exemplary processing” that “help[s] a user hear audio outputs.” (EX1029, 19.)

Both in the litigation and here, Apple argues that noise cancellation is within the preamble. The Petition presents obviousness grounds satisfying the undisputed scope of “help the user hear audio outputs.” Those grounds are unaffected by and do not impact the litigation’s indefiniteness dispute. Instead, they demonstrate

obviousness based on prior art disclosures that, as the parties agree, the POSITA would understand to “help a user hear audio outputs and certainly fall within the scope of the claims.” (EX1028, 18; *see* Pet., 15-17, 38, 61, 65, 70-71, 82, 95, 97.) For example, the Petition shows that the “help a user ...” element is met by Jannard’s audio device providing “*noise cancellation* functionality to help the user hear the audio output”—a feature that was disclosed in the ’599 patent, and that both parties agreed is within the scope of the claims. (Pet., 17 (emphasis added).) Far from presenting “inconsistent invalidity challenges,” Apple’s IPR and district court positions agree and suggest no gamesmanship. *See Tesla*, 3-4.

Thus, as with the question of whether the preambles are limiting, the Board need not address questions of indefiniteness in this proceeding, because Petitioner has shown that the claims are met regardless of indefiniteness. *See Tesla*, 3-4 (“Petitioner’s explanation may have risen to a sufficient level, for example, if Petitioner had shown that, notwithstanding the alleged indefiniteness of the claim term, an ordinarily skilled artisan would understand that the asserted art satisfies the claim limitation.”).

D. The *Fintiv* Factors Are Neutral or Favor Institution

As noted above, the Board has declined discretionary denial when, as here, material error during prosecution is shown—even where “the scheduled district court trial is set to precede the expected final written decision due date,” and where

other *Fintiv* factors would weigh in favor of discretionary denial. *See ParTec*, 3. More generally, the *Fintiv* factors are not dispositive, and the Board has referred petitions for merits review even when the *Fintiv* factors supported discretionary denial. *See Allani*, 2-3 (finding discretionary denial “not appropriate” even in view of a trial date scheduled for more than four months before the final written decision, and “meaningful investment in the district court proceeding”). Even so, the *Fintiv* factors here are neutral or favor institution.

1. Factor 1: The Likelihood of a Stay Is Neutral

Patent Owner suggests that a stay of litigation is unlikely. (Request, 5.) But the Board has previously “decline[d] to speculate on the likelihood of Judge Albright entering a stay after institution,” finding this factor neutral. *See W. Digit. Corp. v. Kuster*, IPR2020-01391, Paper 10, 8-9 (Feb. 16, 2021). Accordingly, this factor is neutral.

2. Factor 2: The Parallel Trial Date Weighs Against Discretionary Denial

This factor weighs against discretionary denial because the trial date in the parallel district court litigation before Judge Albright in the Western District of Texas is likely to occur after the Board would issue the Final Written Decision in the present IPR proceeding.

Under the current schedule in the district court, trial is scheduled to begin on April 26, 2027—approximately five weeks before the Board would issue its Final

Written Decision on June 3, 2027. (EX2005.) But Patent Owner’s Request does not discuss the likelihood of trial actually proceeding according to the currently scheduled date, and does not even entertain the possibility of the trial date being rescheduled, as has happened with other patent cases before Judge Albright. *See Motion Offense, LLC v. Google LLC*, No. 6:21-cv-00514-ADA, ECF No. 68 (W.D. Tex. June 10, 2022) (“Due to a scheduling conflict with a trial, the Court hereby vacates the remaining scheduled deadlines in this case.”); *IOENGINE, LLC v. Roku Inc.*, No. 6:21-cv-01296-ADA, ECF No. 306 (W.D. Tex. Sept. 19, 2023) (notifying the parties that “due to the Court’s schedule, the trial will have to be reset to the coming spring”). For example, Patent Owner offers no time-to-trial statistics for Judge Albright or the Western District of Texas, nor any other evidence bearing on the expected trial date. (*See* March 24, 2025 USPTO Memorandum, 3 (“in applying *Fintiv*, the Board may consider . . . median time-to-trial statistics for civil actions in the district court”).)

In fact, the time-to-trial statistics indicate that the trial date in the district court proceeding will likely be months *after* the Board issues the Final Written Decision. For the year ending June 2025, the median time to trial in the Western District of Texas is 32.8 months, having increased from 22.4 months in 2020. (EX1026.) If this district-wide median applied to the parallel litigation, the trial would be pushed from April 2027 to March 2028—nine months after the Final

Written Decision in June 2027. However, Judge Albright's median time to trial in patent cases *exceeds* that of the Western District of Texas more broadly: for patent cases occurring in 2024 and 2025, Judge Albright's median time to trial is 35 months. (EX1026, 1.) Based on this data, trial is likely to be delayed until at least May 2028—nearly one year after the expected Final Written Decision.

Moreover, Judge Albright's median time-to-trial data shows a recent increase: from 23 months in 2022, to 27 months in 2023, 33 months in 2024, and 43 months in 2025. (EX1026, 2-5.) This trend reflects the increasing time to trial in the Western District of Texas more broadly—from 22.4 months in 2020 to 32.8 months in 2025. (EX1026.) It also reflects a specific recent expansion of Judge Albright's case load: in January 2025, the Chief Judge of the Western District of Texas assigned Judge Albright 40% of the Austin Division docket, in addition to his previous assignment of 100% of the Waco Division cases. (EX1027, 3.) Even before the influx of new Austin Division cases, Judge Albright's heavy caseload often resulted in delayed proceedings because of trial conflicts. *See Motion Offense*, ECF No. 68; *IOENGINE*, ECF No. 306. These delays can be expected to increase with Judge Albright's case load, consistent with the 30 percent increase in Judge Albright's median time to trial from 2024 to 2025.

In August 2025, the Board considered and declined a patent owner's discretionary denial request in view of parallel litigation before Judge Albright.

The Board found the request inappropriate where “the time-to-trial statistics suggest that the trial will not begin until” after the expected date of the Final Written Decision—even though Judge Albright had scheduled the trial for six months before that date. *ClearCorrect*, 2. This case is even more persuasive: trial is set for only about five weeks before the expected date of the Final Written Decision, and, as described above, the statistics suggest that trial will occur nearly one year after the Final Written Decision. Accordingly, this factor weighs against discretionary denial.

3. Factor 3: Limited Investment in Parallel Proceeding Weighs Against Discretionary Denial

Investment in the parallel proceeding weighs against discretionary denial because the parties have invested relatively little in the district court litigation thus far. The district court litigation is still in its relatively early stages. The parties have exchanged preliminary infringement and invalidity contentions, and are in the process of claim construction briefing. However, the court has not yet been asked to consider any dispositive motions on the prior art for the ’599 patent that would overlap with the *inter partes* review proceeding; the *Markman* hearing does not take place until at least April; and there is no timeline for a *Markman* order. (EX2005.) Substantive case events including final infringement and invalidity contentions, expert reports, fact and expert discovery, and dispositive motions are tied to the future *Markman* order, and are set for weeks or months after that order;

and thus have no specific timeline. (EX2004.) Additionally, these case events are subject to postponement for the reasons described above for Factor 2.

This factor weighs against exercising discretion to deny institution where “much more work remains [in the district court litigation], including, expert reports, expert discovery, expert depositions, and pretrial motions and disclosures.” *See Bio-Rad Lab’s, Inc. v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11, 10 (Mar. 27, 2025); *see also Sand Revolution II, LLC v. Cont’l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24, 11 (June 16, 2020) (“[M]uch work remains in the district court case as it relates to invalidity: fact discovery is still ongoing, expert reports are not yet due, and substantive motion practice is yet to come.”). Because these substantial events lie ahead in the parallel district court proceeding, this factor weighs against discretionary denial.

4. Factor 4: Limited Overlap Between the Petition and Parallel Proceeding Weighs Strongly Against Discretionary Denial Because Petitioner Agreed to a *Sotera* Stipulation

This factor weighs strongly against discretionary denial. Petitioner entered a *Sotera* stipulation to limit the potential overlap between this proceeding and the parallel litigation. (Paper 6.) A *Sotera* stipulation “weighs strongly in favor of not exercising discretion to deny institution” because it “mitigates any concerns of duplicative efforts between the district court and the Board.” *Sotera Wireless, Inc., v. Masimo Corp.*, IPR2020-01019, Paper 12, 19 (Dec. 1, 2020).

Patent Owner minimizes the impact of the stipulation because of Apple's supposedly "extensive" use of IPR prior art in the district court to "avoid estoppel." (Request, 9.) But Patent Owner can only point to three references (Griffin, Zadesky, Burson) from Apple's preliminary invalidity contentions, out of dozens cited in those contentions, that are also found in the '599 Petition. (Request, 9.) In the district court, under the stipulation, those references would at most play a secondary role in combination with system prior art (*e.g.*, Jabra FreeSpeak) that could not have been raised in the IPR and does not correspond to any of the IPR's prior art. (EX2006, 80-86.)

This limited inclusion of Griffin, Zadesky, and Burson thus presents no attempt to "avoid estoppel," as Patent Owner imagines. Patent Owner's speculations ignore Board precedent determining that this factor weighs strongly against discretionary denial because it "obviate[s] much, if not all, of any potential overlap between the issues in the proceeding and the district court proceeding." *Liberty Energy Servs., LLC v. U.S. Well Servs., LLC*, IPR2025-00139, Paper 14, 13-14 (June 11, 2025); *see also Stingray Grp. Inc. v. Hernandez-Mondragon*, IPR2025-00349, Paper 19, 7-8 (June 13, 2025) (finding this factor weighs against discretionary denial where Petitioner committed to a *Sotera* stipulation).

5. Factor 5: Whether the Parties Are the Same Is Neutral

The parties before the Board in this *inter partes* review proceeding and in the parallel district court litigation are the same. Where the parties are identical between two parallel proceedings, the Board has held that this factor is “neutral or, at most, weighing slightly in favor of exercising discretion to deny institution.” *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, 16 (Oct. 21, 2020); *see also Shenzhen Root Tech. Co. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9, 19-20 (Feb. 25, 2025) (finding this factor neutral where parties are the same).

6. Factor 6: Other Considerations, Including the Strength of the Petition, Weigh Against Discretionary Denial

Factor 6 weighs against discretionary denial because the Petition provides strong arguments on the merits of the ’599 patent’s validity. The Petition, supported closely by the expert testimony of Dr. Joshua R. Smith, demonstrates that all claims are obvious based on multiple grounds of invalidity, based on prior art references that were not presented or considered during prosecution.

Patent Owner incorrectly suggests that the Petition “does not address” the claim requirement of an electrical connector “at least partially in the wireless wearable device” (*e.g.*, Claim 1[B]). (Request, 10-11.) Not so: the Petition shows clearly, for all applicable claims, and with specific citation to the prior art and to expert support, and how this limitation (and all other limitations) are met by the prior art. (*See, e.g.*, Pet., 15-19 (showing how the claimed electrical connector is

met by Jannard's power contacts 164 included in the audio device), 70-73 (showing same for Griffin's charging terminals).) For example, for Griffin, the Petition specifically illustrates the charging terminals (56a/b) within the wireless wearable device. Contrary to Patent Owner's misreading, these specific evidence-based showings of the claim limitations illustrate the *strength* of the Petition's merits.

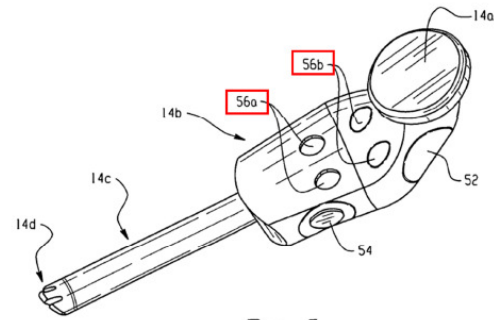


Fig. 5

(EX1017, FIG. 5 (annotated); EX1003, ¶171.)

Here, as described above, the *Fintiv* factors are neutral or point in favor of institution. Under these circumstances, discretionary denial is not appropriate. *See CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00289, Paper 7, 17 (July 21, 2023) (declining to exercise discretion to deny the petition where “no *Fintiv* factor weighs in favor of exercising our discretion to deny institution, while two factors weigh against, and four factors are neutral”).

(Pet., 73; EX1017, FIG. 5 (annotated).)

E. Patent Owner's Pattern of Enforcement Supports Institution

Patent Owner's conduct with respect to its patents presents additional “persuasive reasons why the Office should review the challenged patent.” *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21, 3 (June 18, 2025) (informative). Patent Owner has elected to enforce its patents in serial fashion by

suing unrelated defendants in multiple federal district courts over a span of several years. Patent Owner has reached settlement with many of these defendants, thus concluding the litigation without any determination of validity.

This pattern, in which Patent Owner continues to exploit erroneously issued patents while they go unchecked by the courts, demonstrates that instituting the Petition is an appropriate use of Board resources. It is the Board's role to promote the integrity and prevent the abuse of the U.S. patent system; and Patent Owner's litigation history shows that it is the Board, not a series of district court judges and juries in disparate court filings, that is in the best position to adjudicate the '599 patent's validity and curtail Patent Owner's ongoing misuse.

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Director decline to exercise discretion to deny institution and refer the Petition to a panel to decide whether to institute based on the merits.

Dated: March 3, 2026

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Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION was served on the below date via e-mail (by agreement) to the following counsel of record for the Patent Owner:

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