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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 DIRECTOR REVIEW

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I. INTRODUCTION

This '599 Patent IPR never should have been instituted and, instead, should have been discretionarily denied at least under the Office's *Revvo* and *Tesla* decisions in view of Apple's inconsistent claim construction positions. *See* Paper 7 at 16-17. Several of the Office's decisions since *Revvo* and *Tesla*, including recent informative decisions, confirm that denial of institution is the appropriate course of action here. Apple's violation of this Office's precedent is compounded by the merits of its Petition, which on its face fails to satisfy 37 C.F.R. § 42.104(b)(4).

This IPR was one of three IPR challenges filed by Apple in November 2025. Institution was granted here, *see* Paper 13 at 2, and was discretionarily denied as to the two other challenges to the '104 and '789 Patents, *see* IPR2026-00142, Paper 10 at 1; IPR2026-00144, Paper 9 at 1. Through April 2026 including after two of its petitions were already denied, Apple staggered the filing of five additional IPR challenges to patents asserted in the parallel litigation, including two challenges each to the '355 and '693 Patents. IPR2026-00253, Paper 1; IPR2026-00331, Paper 2; IPR2026-00332, Paper 2; IPR2026-00339, Paper 2; IPR2026-00340, Paper 2. These remaining IPRs are awaiting discretionary denial decisions or have yet to be briefed on the same.

The Director should grant review, vacate the notice of institution as to this IPR, and deny institution.

II. PETITIONER’S INCONSISTENT CLAIM CONSTRUCTION POSITIONS WARRANT VACATING INSTITUTION

This Office has stated repeatedly that “a petitioner should present a single construction and apply that construction consistently before the Board and the district court.” *Terumo BCT v. Haemonetics*, IPR2025-01374, Paper 20 at 3 (P.T.A.B. May 12, 2026) (informative) (granting Director Review and denying institution: “Petitioner... advanced indefiniteness contentions in the district court litigation that are different from Petitioner’s proposed ‘plain and ordinary meaning’ constructions in these IPRs.”); *see also Magnolia Med. Techs. v. Kurin*, IPR2026-00097, Paper 17 at 8 (P.T.A.B. May 14, 2026) (precedential) (“Permitting different claim construction positions before a district court and the Board without sufficient explanation detracts from the Office’s goal of providing greater predictability and certainty in the patent system.”); *Infineon Techs. v. MOSAID Techs.*, IPR2025-01456, Paper 27 at 4 (P.T.A.B. Mar. 17, 2026) (“As stated repeatedly, a petitioner should pick one [construction], and one consistent with its asserted District Court position.”).

As explained in IngenioSpec’s Request for Discretionary Denial (Paper 7), Apple asserts “no claim construction is necessary” in this IPR and that it “does not concede that any preamble is limiting for any ground in the Petition,” Pet. at 6, 7 n.1, while simultaneously taking the contrary 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* Paper 7 at 16-17. Indeed, Apple’s invalidity contentions in the district court assert that “Claims 1, 20, 22, and 24, and all claims that depend therefrom” are “invalid under pre-AIA 35 U.S.C. § 112, ¶ 2 because the scope of to ‘help the user hear’ cannot be reasonably ascertained from the specification.” EX2006 at 89.

Apple’s inconsistent positions between the two forums run afoul of this Office’s precedent and “rules discourag[ing] 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); *see also* *Magnolia Med. Techs.*, IPR2026-00097, Paper 17 at 8. Apple’s purported explanation for its inconsistent positions is insufficient, *see* Paper 9 at 9-11, and its inability to raise indefiniteness in an IPR does not excuse them, *see* *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.”).

Apple’s assertions that 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” and that its indefiniteness “litigation position” “does not impact the Petition’s grounds,” Paper 9 at 10, do not save its Petition. First, Apple’s position that “[b]oth in the litigation and here, Apple argues that noise cancellation is within the preamble,” *id.*, is inconsistent with its litigation position that “the objective *boundaries* are unclear for the language ‘help the user hear audio outputs,’” *id.* (emphasis in original). Apple cannot assert that the *boundaries* of the claim limitation are unclear and yet assert for purposes of its Petition that noise cancellation is within the *boundaries* of the limitation. Apple’s duplicity is apparent. *See, e.g., Terumo*, IPR2025-01374, Paper 20 at 3 (granting Director Review and denying institution: “Petitioner... advanced indefiniteness contentions in the district court litigation that are different from Petitioner’s proposed ‘plain and ordinary meaning’ constructions in these IPRs.”)

Second, the Director recently granted review and denied institution in the face of nearly identical arguments. *See, e.g., Ford Motor Co. v. AutoConnect Holdings*, IPR2025-01342, Paper 27 at 2-3 (P.T.A.B. May 12, 2026) (informative) (granting Director Review and denying institution where petitioner argued “that although it has argued certain claim terms are indefinite in the district court... regardless of any claim boundary uncertainty, its Petitions demonstrate that a person of ordinary skill in the art ‘would have understood that the asserted prior art satisfies the challenged limitations’”); *Infineon Techs. v. MOSAID Techs.*, IPR2025-01171, Paper 27 at 3

(P.T.A.B. Feb. 19, 2026) (granting Director Review and denying institution where petitioner argued “that its district court positions are irrelevant here because they do not affect the Petition and Petitioner’s asserted prior art references teach each of the disputed claim terms”).

Following the Office’s discretionary denial determination in this IPR, *see* Paper 10 at 2, the district court issued its claim construction order ruling that “[t]he structural component of the preamble is limiting,” further contradicting Apple’s position in this IPR that it “does not concede that any preamble is limiting for any ground in the Petition,” Pet. at 7 n.1; *IngenioSpec v. Apple*, No. 1:25-cv-00867, Dkt. 69 at 4 (W.D. Tex. Apr. 6, 2026) (“CC Order”). Although the district court ultimately found the preamble language “to at least help [a/the] user hear audio outputs produced by the device” is “not indefinite,” CC Order at 4, that finding occurred “only *after* Petitioner’s actions ran afoul of *Revvo* and *Tesla* and only *after* Patent Owner brought those actions to the Office’s attention” and thus is “insufficient” to save the Petition, *Ford Motor Co.*, IPR2025-01342, Paper 27 at 3-4 (emphases in original); *see also Terumo*, IPR2025-01374, Paper 20 at 5 (granting Director Review and denying institution: “I would not have instituted these IPRs in the first instance had Petitioner engaged in this strategic litigation-style behavior before institution.”). Indeed, it is clear that Apple’s position “is less about a litigation alternative, as Congress intended, and more about inconsistent positions to gain an

upper hand in the overall litigation.” *Terumo*, IPR2025-01374, Paper 20 at 4; *see also Magnolia Med. Techs.*, IPR2026-00097, Paper 17 at 4 (“[P]arties seemingly take inconsistent positions, without sufficient reasoning, on overlapping issues between district court and the PTAB, suggesting that parties are misleading one tribunal or the other or pursuing alternative theories under a ‘wait and see’ approach presumably to gain a litigation advantage and/or settlement leverage.”).

The notice granting institution should be vacated and institution denied.

III. THE PETITION SHOULD HAVE BEEN DENIED FOR FAILURE TO ADDRESS AT LEAST ONE LIMITATION IN EVERY CLAIM

In addition to contravening this Office’s *Revvo* and *Tesla* decisions and their progeny, Apple’s Petition also 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 “specify where each element of the claim is found in the prior art patents or printed publications relied upon,” as required by 37 C.F.R. § 42.104(b)(4). As explained in IngenioSpec’s Preliminary Response (Paper 8), the Petition does not address the requirement of “at least partially in the wireless wearable device” or comparable claim limitations, including limitations in all independent Claims 1, 20, 22, and 24 as well as several dependent claims. *See* Paper 8 at 3-12; *see also Unified Patents v. SMTM Techs.*, IPR2019-00434, Paper 6 at 19 (P.T.A.B. July 30, 2019) (no

reasonable likelihood of success where “Petitioner entirely fails to address [claim] limitation”).

Further, although arguments cannot be incorporated by reference, even if Apple’s expert declaration is considered, it does not remedy the Petition’s deficiencies because it merely parrots the Petition. *See* Paper 8 at 12-15; *see also Xerox v. Bytemark*, IPR2022-00624, Paper 9 at 15-17 (P.T.A.B. Aug. 24, 2022) (precedential) (denying institution where expert declaration “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support” (emphasis in original)).

Director review and denial of institution is also warranted because the Petition did not and cannot meet its burden.

IV. CONCLUSION

For either of these reasons, IngenioSpec respectfully requests that the Director grant review, vacate the notice granting institution, and deny institution.

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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 DIRECTOR REVIEW** is being served electronically on May 29, 2026 to the following lead and backup counsel for Petitioner to the following email addresses:

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