

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

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

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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

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Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 1 (W.D. Tex. June 5, 2025)	2001
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IPR2026-00143

Patent No. 12,001,599

Exhibit Description	Exhibit
Declaration of Peter Tong	2015

I. INTRODUCTION

Pursuant to Board authorization provided May 29, 2026 (Exhibit 3100), Petitioner responds to Patent Owner’s Request for Director Review (Paper 14, “Request”). The Request should be denied.

Patent Owner does not identify any overlooked fact, intervening change in law, or material error warranting Director Review. Instead, the Request asks the Director to revisit two issues that Patent Owner already presented before institution. *First*, Patent Owner contends that Apple’s claim construction positions warranted discretionary denial. *Second*, Patent Owner contends that the Petition failed to address the “at least partially in the wireless wearable device” claim limitations. Both arguments were already briefed, considered, and rejected.

Patent Owner now seeks to unwind the decision to institute, but offers no proper basis to do so. Its claim construction argument is not new. Patent Owner fully briefed the same argument in its Request for Discretionary Denial (Paper 7), and Apple answered it in its Opposition (Paper 9). Apple explained then, as it explains again here, how its positions are consistent across forums. In the district court, Apple argued that the preambles of claims 1, 20, 22, and 24 are limiting and indefinite. In this proceeding, Apple did not seek a different or broader construction to support unpatentability. Rather, Apple explained, prior to institution, that the Petition’s prior art satisfies the preambles regardless of whether

they are limiting and regardless of any uncertainty in their outer bounds. That is not gamesmanship; it is the straightforward, transparent approach contemplated by the Director's guidance in *Revvo* and *Tesla*.

Patent Owner's merits argument is similarly repetitive. In its Request and its Preliminary Response (Paper 8), Patent Owner argued—without expert testimony or any other evidentiary support—that the Petition failed to address limitations requiring certain components to be “at least partially in the wireless wearable device.” The Director nevertheless instituted after reviewing the merits. Patent Owner's argument, as best understood, rests on an unnatural reading of the Petition. Patent Owner focuses on whether the Petition separately discussed the words “at least partially in” for each challenged component, while overlooking that the Petition identified those components as parts of the prior art wearable devices themselves. As Apple explained in the Opposition, the Petition's element-by-element mappings show exactly where the claimed components are located in the prior art wearable devices. For example, the Petition, drawing from expert support, shows Jannard's power contacts as part of Jannard's audio device, and Griffin's charging terminals as integrated into Griffin's wireless wearable module. That showing is more than sufficient. To the extent Patent Owner disagrees with the Petition's analysis, it will have a full opportunity to make its case at trial.

Patent Owner's newly cited decisions do not change the result. Those cases involved petitioners that failed to explain inconsistent positions, changed positions after institution, or offered petitions that did not show how the prior art satisfied the disputed claim language. This case is different: Apple disclosed and explained its district court positions before institution; Apple's positions have not changed; and the Petition affirmatively maps the prior art to the challenged limitations. Apple's approach promotes the predictability and certainty emphasized in *Magnolia Medical*.

Director Review should therefore be denied, and the proceeding should continue toward a Final Written Decision.

II. APPLE'S CLAIM CONSTRUCTION POSITIONS ARE CONSISTENT

Patent Owner's principal argument is that this IPR "never should have been instituted" because Apple supposedly advanced inconsistent claim construction positions relating to the preambles of claims 1, 20, 22, and 24. (Request, 1-6.) But Patent Owner made that same argument in its Request for Discretionary Denial. (Paper 7, 16-17.) Apple responded in detail. (Paper 9, 9-11.) The Director considered this briefing in instituting the Petition, and Patent Owner identifies no basis to revisit that determination.

A. Apple Did Not Seek a Broader Construction in the IPR

Patent Owner's argument begins from a false premise. Apple did not ask the Board to adopt one construction while asking the district court to adopt another. Nor did Apple rely on a broader IPR construction to establish unpatentability while preserving a narrower litigation position to avoid infringement. Apple's Petition stated that no express construction was necessary because the prior art renders the challenged claims (including the preambles) obvious under any reasonable interpretation. (Pet., 6.)

Apple did not ask the Board to ignore the preambles: the Petition expressly mapped the preambles to the prior art without conceding that they are limiting. (Pet., 7 n.1, 15-17, 38, 61, 65, 70-71, 82, 95, 97.) As such, the Board need not resolve whether the preambles limit the claims to decide institution. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019). That approach narrows the issues before the Board: it removes claim construction as a threshold dispute and allows the merits to be evaluated in the proceeding under an undisputed claim scope.

Similarly, Patent Owner's reliance on Apple's district court indefiniteness position does not show any inconsistency. In district court, Apple argued that the objective boundaries of the phrase "help the user hear audio outputs" were unclear. But Apple also explained that uncertainty at the boundaries does not mean that no

embodiments fall within the claim language. For example, both parties agreed that noise cancellation is an example of processing that helps a user hear audio outputs. (See Paper 9, 10-11.) The Petition relies on that undisputed claim scope: the Petition explains that Jannard provides noise cancellation functionality to help the user hear audio output, *i.e.*, by reducing noise that would otherwise limit the user's ability to hear the audio output. (Pet., 15-17.)

Accordingly, Apple's IPR and district court positions are aligned. In the district court, Apple argued that the outer boundaries of the phrase are indefinite. In this IPR, Apple showed that the prior art satisfies the claim scope that both parties agree is within those boundaries. Those positions are consistent.

B. Apple Provided The Explanation Contemplated By *Revvo* And *Tesla*

Patent Owner relies on *Revvo* and *Tesla*, but those decisions support Apple, not Patent Owner. *Tesla* explained that a petitioner's explanation may be sufficient where, notwithstanding an alleged indefiniteness issue, the petitioner shows that an ordinarily skilled artisan would understand the asserted art to satisfy the claim limitation. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18, 3-4 (Nov. 5, 2025) ("*Tesla*") (informative). That is exactly what Apple did.

Apple did not merely say that its district court positions were irrelevant; Apple explained why the Petition's grounds do not depend on resolving the district court indefiniteness dispute. The Petition relies on prior art disclosures—such as

noise cancellation—that both parties recognized as falling within the scope of “help[ing] the user hear audio outputs.” (Paper 9, 10-11.) Thus, even accepting Apple’s district court position that the phrase has uncertain boundaries, the prior art still meets the claim language because it falls within the undisputed scope of the limitation. *See Tesla*, 3-4 (POSITA would understand prior art to satisfy an allegedly indefinite limitation “if the limitation prescribed a range and only the outer bounds of the range were unclear”).

Apple’s explanation was presented before institution. Patent Owner’s accusation of “strategic litigation-style behavior” ignores that timing. Unlike cases in which petitioners shifted positions after institution, Apple’s district court claim construction briefing was completed before institution, and Apple likewise explained its district court positions to the Director in its March 2026 discretionary denial opposition. (Paper 9, 9-11.) Apple’s positions have not changed since then.

C. Patent Owner’s Cited Cases Are Distinguishable

Patent Owner’s cited decisions involved materially different facts. In *Terumo*, the petitioner was faulted for advancing indefiniteness contentions in district court that differed from its proposed plain-and-ordinary-meaning constructions in the IPRs, and for conduct that suggested inconsistent positions to gain litigation advantage. *Terumo BCT Inc. v. Haemonetics Corp.*, IPR2025-01374, Paper 20 at 3 (May 12, 2026) (“*Terumo*”) (informative). That is not the

case here. Apple did not propose a broad “plain and ordinary meaning” construction to support institution while pursuing a narrower litigation construction. Apple showed that the asserted prior art satisfies the preambles if they are limiting, and satisfies the undisputed scope of the challenged language notwithstanding Apple’s district court indefiniteness position.

Ford is likewise inapposite. In *Ford*, as in *Terumo*, the Director criticized the petitioner for trying to “gain an upper hand” by advancing new contentions in the litigation “at its first opportunity to do so after institution was granted.” *Ford Motor Co. v. AutoConnect Holdings LLC*, IPR2025-01342, Paper 27 at 2-3 (May 12, 2026) (“*Ford*”) (informative). But here, Apple presented its litigation positions before institution. The Director considered those positions, and Apple’s explanation of them, in declining discretionary denial and granting institution. Apple’s positions did not change afterward.

Infineon is also distinguishable. Patent Owner cites *Infineon* as rejecting an argument that district court positions were irrelevant because they did not affect the petition. (Request, 4-5; *Infineon Techs. Am. Corp. v. MOSAID Techs. Inc.*, IPR2025-01171, Paper 27 at 3 (Feb. 19, 2026) (“*Infineon*”).) But Apple did more than assert irrelevance: Apple explained why the prior art satisfies the claim language under the undisputed scope of the limitation, and why the IPR grounds do not require the Board to resolve the litigation indefiniteness issue.

Finally, *Magnolia Medical* confirms why institution should be maintained. In *Magnolia Medical*, the Director emphasized predictability and certainty and discouraged unexplained inconsistent positions. *Magnolia Med. Techs. Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 8 (May 14, 2026) (“*Magnolia Medical*”) (precedential). Consistent with *Magnolia Medical*, Apple disclosed its positions prior to institution, explained why they are consistent, and showed that the prior art satisfies the challenged limitations regardless of the disputes being litigated in district court. Apple’s approach promotes predictability and certainty: it presents the petition’s merits independent of any future claim construction outcomes, and without relying on hidden or shifting positions across forums.

D. The District Court’s Claim Construction Order Confirms That Institution Was Proper

Patent Owner also points to the district court’s claim construction order, but that order does not support Director Review. Patent Owner acknowledges that the district court found the “help [a/the] user hear audio outputs” language not indefinite. (Request, 5.) The court ruling is consistent with Apple’s IPR approach of treating the preamble language as having ascertainable scope for purposes of applying the prior art. Patent Owner’s comparison of the court’s order to *Terumo* and *Ford* is inapt: unlike in those cases, as discussed above, Apple’s positions were explained to the Board prior to institution and have not changed. (Request, 4-5.)

The timing of the court’s order is out of the parties’ control and cannot represent “strategic litigation-style behavior.” (Request, 5 (citing *Terumo*, 4).)

Likewise, the district court’s finding that the structural component of the preamble is limiting also does not undermine the Petition. The Petition mapped the prior art to the preambles. (Pet., 15-17, 38, 61, 65, 70-71, 82, 95, 97.) Thus, the Petition already did what Patent Owner says was required: it showed that the preamble language is met.

III. THE PETITION ADDRESSES THE “AT LEAST PARTIALLY IN THE WIRELESS WEARABLE DEVICE” LIMITATIONS

Patent Owner’s second argument is that the Petition should have been denied because it allegedly failed to address at least one limitation in every challenged claim. (Request, 6-7.) That same argument was already made in Patent Owner’s Discretionary Denial Request, repeated in its Preliminary Response, considered at institution, and rejected. (Paper 7, 10-13; Paper 8, 3-12; Paper 13, 2.) Patent Owner offers no reason to revisit that determination.

A. Patent Owner Mischaracterizes The Petition

Patent Owner’s argument, as best understood, assumes that the Petition must have failed to address the “at least partially in” limitations if it did not analyze that specific phrase separately—that is, apart from the prior art disclosures identifying the claimed components. There is no such requirement. Under Rule 42.104(b)(4), a petition must specify where each claim element is found in the prior art; it is

unnecessary to restate every word of the claim if the petition's mapping of the claim elements to the prior art is clear.

Here, the Petition identified the relevant prior art components, explained that they are included in the wearable device, and cited disclosures showing where they are located. For example, the Petition explained that Jannard's audio device includes speakers, power contacts, a rechargeable power module, and microphones. (Pet., 15-30.) For claim 1[B], the Petition identified Jannard's power contacts 164 as the claimed electrical connector and explained that Jannard's audio device "include[s]" those power contacts for recharging batteries connected to the device. (Pet., 18-21.) The Petition further explained that the power contacts are disposed at the ends of the ear stems and on the edges of the orbitals—structural portions of the audio device—and that the audio device is laid on a charging cradle so those contacts electrically connect to corresponding cradle contacts. (Pet., 18-21.) Thus, the Petition relied on Jannard's disclosure that the power contacts are components of the audio device, integrated into structural portions of that device, and used to recharge the device's battery. That showing addresses why the claimed electrical connector is "at least partially in the wireless wearable device."

The same is true for the other challenged components. The Petition maps the claimed speaker to Jannard's disclosures that the wireless wearable audio

device includes speakers. (Pet., 17-18.) It maps the rechargeable battery to Jannard's power module included in the device. (Pet., 28-30.) It maps the microphone to Jannard's disclosure that the device includes a microphone. (Pet., 30.) These are not omissions: they are element-by-element showings that the claimed components are at least partially in the device.

The Griffin grounds are equally clear. For example, the Petition identifies Griffin's second communication module as the wireless wearable device and maps the claimed electrical connector to charging terminals 56 of that module. (Pet., 70-75.) The Petition includes an annotated figure showing charging terminals 56a and 56b at least partially in the module. (Pet., 72-73.) It also maps the rechargeable battery, speaker, microphone, and background-noise microphone to components of the same second communication module. (Pet., 75-84.) Patent Owner's assertion that Apple "entirely fails to address" the locational limitation does not address any of these showings and is thus not credible.

B. The Director's Institution Decision Confirms The Petition's Sufficiency

The Director instituted after reviewing the merits and determining that Apple had shown a reasonable likelihood of prevailing with respect to at least one challenged claim. (Paper 13, 2.) The Director thus rejected Patent Owner's argument that every ground failed to address the "at least partially in" limitations. Patent Owner's Request does not identify any overlooked evidence or legal error in

that determination. It simply repeats the same rejected attorney argument from its Discretionary Denial Request and Preliminary Response.

At most, Patent Owner disagrees with Apple's showing. But disagreement with the merits is not a basis to vacate institution. Patent Owner will have a full opportunity during trial to submit evidence, cross-examine Dr. Smith, and argue that the prior art does not meet the limitations. Director Review is not a mechanism for relitigating the institution based on the same arguments already considered.

C. Patent Owner's Authorities Do Not Apply

Patent Owner relies on *Unified Patents v. SMTM Technologies* for the proposition that institution is improper where a petitioner "entirely fails to address" a claim limitation. (Request, 6-7 (citing *Unified Patents Inc. v. SMTM Techs. LLC*, IPR2019-00434, Paper 6 (July 30, 2019).) But Apple did not fail to address the challenged limitations at all. As discussed above and in Apple's Opposition, the Petition specifically identified the relevant prior art components, explained their role, and showed their placement in the wearable devices.

Nor does *Xerox v. Bytemark* support Patent Owner. *Xerox* discounted the petitioner's expert's testimony because it merely repeated conclusory assertions in the petition without additional reasoning or support. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (Aug. 24, 2022) ("*Xerox*") (precedential). Here, the

Petition and Dr. Smith's declaration provide detailed technical analysis supported by citations to the evidentiary record. For example, Ground 1 explains, with Dr. Smith's support, how Jannard's power contacts combine with Burson's spring-loaded charging contacts; how Burson teaches coupling via spring force; and why a POSITA would have been motivated to apply Burson's charging cradle teachings to Jannard. (Pet., 21-28; EX1003, ¶¶49-59.) Dr. Smith's analysis includes technical reasoning regarding spring-loaded contacts, contact alignment, charging reliability, and the benefits of allowing a user to place a headset in a cradle without fumbling with a plug. (EX1003, ¶¶49-59.) These are hardly the kind of bare, unsupported assertions criticized in *Xerox*.

The Petition adheres closely to Dr. Smith's technical testimony, which provides close expert support for the Petition's analysis. Patent Owner does not substantively rebut that testimony in its Request or in its Preliminary Response. To the extent Patent Owner disputes Dr. Smith's opinions, it may test them at deposition.

IV. PATENT OWNER'S BROADER ARGUMENTS DO NOT WARRANT REVIEW

Patent Owner's references to other IPR proceedings are irrelevant. The Director's decisions on other patents and other records do not show error here. If anything, they indicate that the Director evaluated Apple's petitions on an individualized, case-by-case basis.

Nor does Patent Owner identify any policy reason to disturb institution. The '599 patent issued recently after a prosecution that Apple has shown was materially flawed. (Paper 9, 4-8.) The Petition presents detailed prior art grounds based on references that the Examiner did not apply in any rejection. (Pet., 6-7.) Institution therefore serves a core function of the PTAB: protecting the integrity of the patent system by reviewing erroneously issued patents.

Patent Owner's Request instead seeks to transform Director Review into a second preliminary response. But Director Review is not warranted merely because Patent Owner disagrees with the Director's institution determination. Patent Owner will have the opportunity to develop its merits arguments at trial.

V. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Director should decline to disturb the Decision on Institution.

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IPR2026-00143

Patent No. 12,001,599

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

I hereby certify that the attached AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST 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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