

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

INGENIOSPEC, LLC,
Patent Owner.

Patent No. 8,582,789

Inter Partes Review No. IPR2026-00144

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

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. ARGUMENT.....	6
A. The '789 Patent Resulted From Material USPTO Error.....	6
B. Patent Owner Cannot Have Settled Expectations Because it Repeatedly Failed to Protect the Integrity of its Patent	9
C. Petitioner's Settled Expectations of Non-Enforcement Support Institution.....	10
D. Petitioner Does Not Present Inconsistent Claim Construction Positions	11
E. The <i>Fintiv</i> Factors Are Neutral or Favor Institution	12
1. Factor 1: The Likelihood of a Stay Is Neutral	13
2. Factor 2: The Parallel Trial Date Weighs Against Discretionary Denial	13
3. Factor 3: Limited Investment in the Parallel Proceeding Weighs Against Discretionary Denial	16
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.....	17
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	19
F. Additional Factors Support 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)	11, 12
<i>Bio-Rad Lab’ys, Inc. v. Cal. Inst. of Tech.</i> , IPR2024-01451, Paper 11 (Mar. 27, 2025)	17
<i>ClearCorrect Operating, LLC v. Align Tech., Inc.</i> , IPR2025-00814, Paper 14 (Aug. 29, 2025)	5, 16
<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, 3
<i>IOENGINE, LLC v. Roku Inc.</i> , No. 6:21-cv-01296-ADA, ECF No. 306 (W.D. Tex. Sept. 19, 2023)	14, 15
<i>Liberty Energy Servs. LLC v. U.S. Well Servs., LLC</i> , IPR2025-00139, Paper 14 (June 11, 2025)	18
<i>Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH</i> , IPR2025-00318, Paper 9 (June 12, 2025)	2, 3, 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, 15
<i>Realtime Data LLC v. Iancu</i> , 912 F.3d 1368 (Fed. Cir. 2019)	11
<i>Revvo Techs., Inc. v. Cerebrum Sensor Techs. Inc.</i> , IPR2025-00632, Paper 20 (Nov. 3, 2025)	11, 12

<i>Samsung Elecs Co. v. Wilus Inst. of Standards and Tech., Inc.</i> , IPR2025-01043, Paper 11 (Oct. 10, 2025)	9
<i>Sand Revolution II, LLC v. Cont’l Intermodal Grp. – Trucking LLC</i> , IPR2019-01393, Paper 24 (June 16, 2020).....	17
<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)	17
<i>Stingray Grp. Inc. v. Hernandez-Mondragon</i> , IPR2025-00349, Paper 19 (June 13, 2025).....	18
<i>Tesla v. Intellectual Ventures II LLC</i> , IPR2025-00340, Paper 18 (Nov. 5, 2025)	4
<i>In re Zletz</i> , 893 F.2d 319 (Fed. Cir. 1989)	8
<i>W. Digit. Corp. v. Kuster</i> , IPR2020-01391, Paper 10 (Feb. 16, 2021)	13
Other Authorities	
MPEP § 904.01	2, 8

Petitioner's Updated Exhibit List

Exhibit Description	Exhibit #
U.S. Patent No. 8,582,789 to Cheung et al.	EX1001
Prosecution History of U.S. Patent No. 8,582,789	EX1002
Declaration of Dr. Joshua R. Smith	EX1003
Curriculum Vitae of Dr. Joshua R. Smith	EX1004
U.S. Patent No. 5,721,783 to Anderson	EX1005
U.S. Patent No. 7,245,730 to Enzmann	EX1006
U.S. Patent Pub. No. 2004/0170086 to Mayer et al.	EX1007
U.S. Patent No. 7,024,000 to Gabara et al.	EX1008
U.S. Patent No. 6,944,474 to Rader et al.	EX1009
Federal Communications Commission. <i>In the Matter of the Review of the Commission's Rules and Policies Governing the Implementation of the Telecommunications Act of 1996.</i> FCC 02-328, 2002.	EX1010
Excerpts from A. OPPENHEIM ET AL., SIGNALS & SYSTEMS SECOND EDITION (Prentice Hall Inc., 1997)	EX1011
U.S. Patent No. 7,388,962 to Cheung et al.	EX1012
G. KENNEDY ET AL., ELECTRONIC COMMUNICATION SYSTEMS 4TH ED. (Tata McGraw-Hill 1993)	EX1013
Prosecution History of U.S. Patent No. 7,388,962	EX1014 (NEW)
Docket Navigator, Judge Albright Patent Case Time-to-Trial Statistics	EX1015 (NEW)

Exhibit Description	Exhibit #
Jan. 31, 2025, Order Assigning Business of the Court (W.D. Tex.)	EX1016 (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
Exhibit A-5 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)	2007
RESERVED	2008
RESERVED	2009
RESERVED	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
RESERVED	2012
RESERVED	2013

Exhibit Description	Exhibit
Information Disclosure Statement in Apple Patent Application Listing U.S. Patent Application Publication No. 2004/0208324	2014
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. The '789 patent was compromised by material error during prosecution, as memorialized repeatedly in the prosecution history. Patent Owner knew or should have known of the error, but chose to exploit it rather than protect the integrity of its patent. The Board is in the best position to rectify the error and to stop Patent Owner from perpetuating it through serial multi-district litigation.

The '789 patent was filed in June 2008 as a continuation of U.S. Patent No. 7,388,962 ("the '962 patent," EX1012). The application was allowed following only a single rejection, for non-statutory double patenting over the '962 patent, which the applicant (Patent Owner) promptly overcame by filing a terminal disclaimer. (EX1002, 116-121.) The prosecution history explains the cursory examination: in a Notice of Allowance, the Examiner explained that the claims were allowed because "[t]he limitations claims [sic] in the patent application (7388962) are broader than the scope of the claims in the present application." (EX1002, 176.) That is, the Examiner believed that, since the broader '962 claims were allowable over the prior art, the narrower '789 claims must similarly be allowable. Post-allowance, Patent Owner repeatedly amended its claim set, including by adding additional dependent claims without addressing the

Examiner's reasoning; the Examiner in turn responded to these new and amended claims with additional Notices of Allowance that repeated the same reasoning. (EX1002, 183-190, 216, 224-235, 250, 280-292, 308, 320-335, 348.)

However, the Examiner's assumption of claim scope was plainly incorrect: the '962 claims were in fact *narrower* than the '789 claims, not broader, in that they included multiple limitations that were omitted from the '789 claims. The Examiner could not have adequately evaluated the '789 claims in view of the prior art without an accurate understanding of their scope. *See* MPEP § 904.01 ("The breadth of the claims in the application should always be carefully noted; that is, the examiner should be fully aware of what the claims do *not* call for, as well as what they do require."). This flawed examination was thus material error that goes directly to the patentability of the '789 patent. Patent Owner's Request (Paper 7) fails to account for the error, instead remaining conspicuously silent on the matter—even though the error was expressly identified in the Petition. (Pet., 2-3.)

Discretionary denial is inappropriate because this material error allowed the '789 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 error during prosecution 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.

Discretionary denial is further warranted because Patent Owner knew or should have known of the material error at least by 2011, but chose to stay silent and exploit the error rather than address or correct it. The President of IngenioSpec personally prosecuted both the ’789 patent and the ’962 patent, yet he responded to multiple defective Notices of Allowance by acknowledging them “with gratitude” and adding over 60 new dependent claims rather than flagging the Examiner’s error. (See, e.g., EX1002, 190, 235, 292, 335; EX2015, ¶1.) That same individual provides here that he personally wrote to Petitioner in 2025 to allege infringement of the issued claims that were laden with Examiner error. (EX2015, ¶5.) Instituting the Petition would discourage such conduct, consistent with the USPTO’s role in protecting the integrity of the U.S. patent system.

The Request fails to make a convincing case for discretionary denial. For example, Patent Owner argues for settled expectations in the ’789 patent’s validity,

including based on its President's 2025 correspondence to Apple. (Request, 2-3; EX2015, ¶5.) But any expectations of validity were unreasonable, because Patent Owner knew of material prosecution error since at least 2011, yet repeatedly failed to flag the error for the Office, seek reexamination or reissue, or otherwise protect the integrity of its patent. Patent Owner's actions invite scrutiny of the '789 patent, not deference to it. Moreover, 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 selectively targeted dozens of other technology companies. Apple's settled expectations based on this history further cut against discretionary denial.

Patent Owner is additionally mistaken with respect to claim construction. (Request, 11-12.) In the district court, Apple proposed that the preamble of claim 13 is limiting, and that "input signals" should be construed as "signals input to the audio system." (EX2011, 1.) This proposal is consistent with the Petition, which showed how the claims are satisfied by the prior art regardless of whether the preambles are limiting, and under any reasonable construction, including Apple's district court proposal. (Pet., 4, 6 n.1.) Petitioner's approach promotes predictability and certainty, consistent with the Director's guidance in *Tesla*, by demonstrating that the claims are unpatentable unconditionally. *Tesla v.*

Intellectual Ventures II LLC, IPR2025-00340, Paper 18, 3-4 (Nov. 5, 2025) (informative).

Further, 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 litigation before Judge Albright, the scheduled trial date leads the Final Written Decision by only about five weeks, far less than in *ClearCorrect*; and Judge Albright’s time-to-trial statistics (including a median time to trial of 43 months for patent cases in 2025) indicate 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 '789 Patent Resulted From Material USPTO Error

The '789 patent was the product of clear material error committed by the USPTO. The Examiner significantly misunderstood the scope of the '789 patent claims; she relied on her misunderstanding in examining and allowing the '789 patent; and she repeatedly memorialized her misunderstanding in a series of Notices of Allowance, as Patent Owner continued to insert additional dependent claims after the initial allowance. (EX1002, 176, 216, 250, 308, 348.)

For example, in the Notices of Allowance, under “Reasons for Allowance,” the Examiner provided her basis for allowing the '789 claims:

The following is an examiner’s statement of reasons for allowance:

The limitations claims [sic] in the patent application (7388962) are broader than the scope of the claims in the present application.

(EX1002, 176, 216, 250, 308, 348.)

The Examiner provided no other reasons for allowance, other than broadly stating, without explanation, that “the prior art of records [sic] fails” to teach the limitations of claim 1. (EX1002, 176, 216, 250, 308, 348.)

But the claims of the '962 patent were *not* broader than the '789 claims. To illustrate, the chart below compares claim 1 of the '789 patent against the broadest claim (claim 1) of the '962 patent:

'789 Patent, Claim 1	'962 Patent, Claim 1
A hearing enhancement system for a user, comprising:	A hearing enhancement system for a user, comprising:
an audio system configured to receive input signals for broadcasting, and configured to up-convert the received input signals into up-converted signals to be wirelessly transmitted;	an interface unit that has a directional speaker and a microphone; wherein
a wireless receiver configured to wirelessly receive the up-converted signals;	the microphone receives input audio signals, which are transformed into ultrasonic signals,
a down-converter configured to down-convert the received up-converted signals into down-converted signals;	the speaker transmits the ultrasonic signals,
a modifier configured to modify the down-converted signals into modified signals based on at least one hearing characteristic of the user to enhance the hearing of the user; and	at least a portion of the ultrasonic signals is transformed into output audio signals in air,
a speaker configured to generate audio output signals from the modified signals for the user.	a portion of the output audio signals is amplified more than another portion to enhance the hearing of the user, and
	wherein the directional speaker is configured to be spaced apart from at least one of the ears of the user so that at least a portion of the ultrasonic signals is transformed into output audio signals outside the at least one of the ears of the user, to be received by the at least one of the ears of the user.

(EX1001; EX1012.)

Even a cursory review reveals that these claims are substantially different in scope: many elements of '962 claim 1 are nowhere to be found in '789 claim 1. For example, '962 claim 1 recites an *interface unit*; a *microphone that receives input audio signals, which are transformed into ultrasonic signals*; and that *at least a portion of the ultrasonic signals is transformed into output audio signals in air*. And '962 claim 1 recites a speaker that must be *directional*; *transmit the ultrasonic signals*; and have a particular spatial configuration with respect to the user's ears. But '789 claim 1 does not include any of these limitations. Notably, the '962 patent was allowed based in part on the limitation that *at least a portion of the ultrasonic signals is transformed into output audio signals in air*; yet that limitation is absent from '789 claim 1. (EX1014, 47 (adopting applicant's 9/7/2007 response as the reasons for allowance), 93-95.)

As the Examiner indicated repeatedly, she allowed the application based on her assumption that the '962 claims were broader than the '789 claims. (EX1002, 176, 216, 250, 308, 348.) The Examiner's reliance on this demonstrably false premise stopped her from fully and properly examining the '789 claims. Without an accurate understanding of claim scope, the Examiner could not have evaluated the broadest reasonable interpretation of the claims, and compared the claims to the prior art under that interpretation, as required. *See* MPEP § 904.01; *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) ("During patent examination the pending

claims must be interpreted as broadly as their terms reasonably allow.”). An examination based on the correct claim scope would have shown—as in the Petition—that the claims are obvious in view of the prior art. This defect in prosecution was thus material error that goes directly to the patentability of the ’789 patent 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).

B. Patent Owner Cannot Have Settled Expectations Because it Repeatedly Failed to Protect the Integrity of its Patent

Patent Owner argues for settled expectations in the ’789 patent’s validity. But any such expectations were unreasonable because Patent Owner repeatedly failed to protect the integrity of its patent. Patent Owner knew or should have known by at least 2011 that the ’789 patent’s examination had been tainted by material Office error: it was the President of IngenioSpec himself who personally prosecuted both the ’962 claims and the ’789 claims before the USPTO, and repeatedly acknowledged the ’789 patent’s defective Notices of Allowance “with gratitude.” (EX1002, 190, 235, 292, 335; EX1014, 80-99; EX2015, ¶1.) Yet Patent Owner did nothing to address or correct the error. For example, Patent Owner never sought reexamination or reissue of the ’789 patent. And despite being encouraged in five Notices of Allowance to submit “[a]ny comments considered necessary,” Patent Owner consistently declined to call attention to the

Examiner's misunderstanding of the claim scope, even though Patent Owner elected to submit numerous other post-allowance remarks. (EX1002, 177, 190, 205, 217, 235, 251, 292, 309, 335, 349.) Instead, Patent Owner capitalized on the Examiner's error by repeatedly adding new dependent claims—more than 60 in total—after allowance. (EX1002, 224-235, 280-292, 320-335.) Patent Owner could have had no reasonable expectation of validity under these circumstances.

C. Petitioner's Settled Expectations of Non-Enforcement Support Institution

Rather, 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, Patent Owner asserted the '789 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 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. 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. 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” for 13-year-old patent where the petitioner “did not expect enforcement” of the patent).

D. 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). But here, there are no “alternative positions” presented. In the district court proceeding, for the ’789 patent, Apple proposed only that the preamble of claim 13 is limiting; and that “input signals” should be construed as “signals input to the audio system.” (EX2011, 1.) In the Petition, Apple did not propose any claim construction for any claim term in the IPR proceeding; and Apple took no position at all as to whether any claim terms were limiting. The reason is that, as Federal Circuit has ruled, the Board need only construe the claim terms as necessary to resolve the controversy at hand. (Pet., 4.) *See also Realtime Data LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019).

The Board need not construe “input signals,” nor determine whether the preamble of claim 13 is limiting, because the Petition showed how each claim element (including preambles) are met by the prior art regardless. (*See* Pet., 6 n.1

(“Petitioner also shows how each claim preamble is satisfied, but does not concede that any preamble is limiting for any ground in the Petition.”).) For example, the Petition addressed the preamble of claim 13 with reference to its discussion of the preamble and element [A] of claim 1. (Pet., 28.) There, the Petition showed how the elements of the preamble are met by Anderson, including under Apple’s proposed construction of “input signals.” (Pet., 8-11.) With respect to “input signals,” the Petition explained: “Anderson discloses an audio system that receives sounds from the ambient environment, *i.e.*, input signals.” (Pet., 8.) That is, the input signals are input to Anderson’s audio system. Because the Petition showed how the elements are satisfied under Apple’s district court position, there is no potential “gamesmanship” with respect to the claims. *See Revvo*, 2-3.

E. 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, 4.) 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.) 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-0514-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. (EX1015.) 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. (EX1015, 1.) Based on this data, trial in the parallel district court

litigation 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. (EX1015, 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. (EX1015.) 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. (EX1016, 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. Even though Judge Albright had scheduled trial for a date six months before the Final Written Decision date, “the time-to-trial statistics suggest that the trial will not begin until” after the expected date of the Final Written Decision.

ClearCorrect, 2. This case is even more persuasive: trial is currently set for only about five weeks before the expected date of the Final Written Decision, and 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 the 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 '789 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’ys, 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 events remain 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, 8.) But Patent Owner can only point to three references (Anderson, Enzmann, Mayer) from Apple’s preliminary invalidity contentions, out

of dozens cited in those contentions, that are also found in the '789 Petition. (Request, 6-8.) In the district court, under the stipulation, those references would play at most a secondary role in combination with the prior art systems identified in the preliminary contentions. None of these systems could have been raised in the IPR, and none corresponds to any of the IPR's prior art. (EX2006, 6-13.)

This limited inclusion of Anderson, Enzmann, and Mayer 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).

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 '789 patent's validity. The Petition, supported closely by the expert testimony of Dr. Joshua R. Smith, demonstrates that all claims are obvious in view of the prior art. These grounds apply prior art references that were not presented to or considered by the Examiner during prosecution. In the Request, Patent Owner declines to engage with the merits of the Petition. (*See* Request, 9-10.)

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”).

F. Additional Factors Support Institution

As described above and in the Petition, persuasive reasons exist here for the Board to review the validity of the '789 patent. *See Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21, 3 (June 18, 2025) (designated informative) (“[t]here may be persuasive reasons why the Office should review the challenged patent” and “disturb the settled expectations of Patent Owner”). Patent

Owner's conduct with respect to its patents presents additional justification. Patent Owner has elected to enforce its patents in serial fashion by suing unrelated defendants, including Petitioner, 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. And here, Patent Owner asserts a patent with known prosecution defects that Patent Owner repeatedly failed to address or correct.

This pattern, in which Patent Owner continues to exploit its 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 '789 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.

IPR2026-00144

Dated: March 3, 2026

By: /Alex S. Yap/
Alex S. Yap
Registration No. 60,609
MORRISON & FOERSTER LLP
707 Wilshire Boulevard, Suite 6000
Los Angeles, CA 90017
Tel: (213) 892-5688
Fax: (213) 892-5454
Email: AYap@mofo.com

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:

Douglas R. Wilson (Reg. No. 54,542)
doug.wilson@armondwilson.com

Michelle E. Armond (Reg. No. 53,954)
michelle.armond@armondwilson.com

Joseph Li (Reg. No. 74,998)
josepher.li@armondwilson.com

Monica Arnold (Reg. 77,262)
monica.arnold@armondwilson.com

ipr@armondwilson.com

Dated: March 3, 2026

By: /Bryan Blumenkopf/
Bryan Blumenkopf