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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. IPR2026-00253
U.S. Patent No. 12,044,901

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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2001	Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 1 (W.D. Tex. June 5, 2025)
2002	Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00877, Dkt. No. 1 (W.D. Tex. June 6, 2025)
2003	Order Granting Joint Motion to Consolidate, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 25 (W.D. Tex. Oct. 14, 2025)
2004	Scheduling Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 36 (W.D. Tex. Nov. 17, 2025)
2005	Scheduling Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 39 (W.D. Tex. Dec. 5, 2025)
2006	Defendant Apple Inc.’s Preliminary Invalidity Contentions, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867 (W.D. Tex. Nov. 21, 2025) (cover pleading)
2007	RESERVED
2008	RESERVED
2009	RESERVED
2010	RESERVED
2011	Defendant’s Proposed Claim Constructions, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867 (W.D. Tex. Dec. 22, 2025)
2012	RESERVED
2013	RESERVED
2014	RESERVED
2015	Declaration of Peter Tong
2016	DocketNavigator Case List for U.S. Patent No. 12,044,901
2017	Exhibit F-4 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)
2018	Defendant’s Reply Claim Construction Brief, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 52 (W.D. Tex. Feb. 18, 2026)
2019	Apple Inc. Form 10-K Annual Report (Oct. 31, 2025)
2020	Claim Construction Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 69 (W.D. Tex. Apr. 6, 2026)

I. INTRODUCTION

In serial fashion, Apple has now challenged five of six patents asserted in the consolidated district court cases, in which the court has set a firm trial date of April 26, 2027, before the Board’s August 13, 2027 statutory deadline for a final written decision here. EX2005 at 1; EX2001 ¶¶ 20-22; EX2002 ¶¶ 20-22; EX2003 at 1; Paper 1 (“Pet.”); IPR2026-00142, Paper 2; IPR2026-00143, Paper 2; IPR2026-00144, Paper 2; IPR2026-00331, Paper 2; IPR2026-00332, Paper 2. The five patents challenged by Apple—U.S. Patent Nos. 8,112,104; 8,582,789; 11,921,355; 12,001,599; and 12,044,901—issued in 2012, 2013, 2024, 2024, and 2024, respectively. *See* EX1001; IPR2026-00142, EX1001; IPR2026-00143, EX1001; IPR2026-00144, EX1001; IPR2026-00331, EX1001. Institution has already been denied for the two oldest patents, the ’104 and ’789 Patents. *See* IPR2026-00142, Paper 10 at 1 (discretionarily denying institution); IPR2026-00144, Paper 9 at 1 (same). The ’599 Patent IPR has been referred for decision on the merits, where institution will likely be denied due to Apple’s failure to address certain claim limitations at all in its petition. *See* IPR2026-00143, Paper 10 at 2; *id.*, Paper 8 (addressing Apple’s failure). And the trailing two petitions against the ’355 Patent were filed only ten days ago.

As explained below, discretionary denial is warranted because efficiency and IngenioSpec’s settled expectations counsel heavily in favor of a jury deciding the

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

II. PATENT OWNER’S SETTLED EXPECTATIONS FAVOR DISCRETIONARY DENIAL

In considering discretion, the Director may address the “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Memorandum, “Interim Processes for PTAB Workload Management,” at 2 (Mar. 26, 2025) (“Interim Processes Memo”). Although the ’901 Patent issued only recently, IngenioSpec has licensed the patent as well as provided actual notice to Apple of the ’901 Patent creating settled expectations despite its recent issuance. Also, the denial of institution for the parallel ’104 and ’789 Patent IPRs as well as the likely denial for the ’599 Patent IPR suggest that institution for the ’901 Patent would be an inefficient use of Board resources.

The challenged patents, including the '901 Patent, have been licensed to third parties, supporting IngenioSpec's settled expectations. EX2015 ¶¶ 2-5; *Alliance Laundry Sys. v. PayRange*, IPR2025-00950, Paper 11 at 3 (P.T.A.B. Sept. 19, 2025) (informative) ("settled expectations favoring Patent Owner" where "Patent Owner presents evidence that it has licensed the challenged patent"); *Hisense v. VideoLabs*, IPR2025-00880, Paper 11 at 2 (P.T.A.B. Oct. 10, 2025) (settled expectations where "the challenged patents have been licensed"). On the flip side, Apple cannot seriously assert that it did not expect enforcement of the '901 Patent, when the '901 Patent was asserted recently in the same district court cases against Samsung, Sony, Bose, and LG identified in Apple's '789 Patent IPR Petition. Compare EX2016 at 1, with IPR2026-00144, Paper 2 at 81.

IngenioSpec also wrote to Apple on June 21, 2024 identifying the '901 Patent application, which issued as the '901 Patent a month later, and again on April 9, 2025 notifying Apple of its infringement of the '901 Patent before the parallel litigation was filed, EX2015 ¶ 6, which further "favor[s] discretionary denial," *Hisense*, IPR2025-00880, Paper 11 at 2 ("Patent Owner sent Petitioner a notice letter regarding Patent Owner's patent portfolio.").

Considering that institution for the '104 and '789 Patents has already been denied, and that institution for the '599 Patent is also likely to be denied, institution on the '901 Patent would be inefficient. While the '901 Patent at issue here "has not

been in force as long as the other patents challenged,” because the district court will also be considering the validity of the ’901 Patent, *see* EX2006 at 89-106, “referring [this IPR] to the Board would be an inefficient use of Board resources and tips the balance to discretionary denial as to that patent too.” *Amazon.com v. Audio Pod IP*, IPR2025-00768, Paper 15 at 3 (P.T.A.B. Aug. 14, 2025); *see also Nvidia v. Neural AI*, IPR2025-00606, Paper 18 at 2-3 (P.T.A.B. July 31, 2025) (similar: “inefficient use of Board resources and tips the balance to discretionary denial” for patent that “has not been in force for a significant period of time”).

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

III. THE *FINTIV* FACTORS SUPPORT DISCRETIONARY DENIAL

The Director should also discretionarily deny institution under 35 U.S.C. § 314(a) because none of the *Fintiv* factors supports proceeding with a trial here. *See Apple v. Fintiv*, IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020) (precedential). “[T]he... *Fintiv* factors... are used to assess whether instituting Patent Office review would be an inefficient use of resources given parallel district court proceedings.” *Intel v. VLSI Tech.*, No. 2021-1614, 2021 WL 5968443, at *1 (Fed. Cir. May 5, 2021). A jury deciding the overlapping patentability challenges presented here, as well as additional issues, before any Final Written Decision, strongly favors denial.

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

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

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

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

The co-pending litigation in Texas is scheduled for trial on April 26, 2027, almost *four months before* the August 13, 2027 statutory deadline for a Final

Written Decision in this IPR. EX2005 at 1. The earlier district court trial date tips factor 2 strongly in favor of discretionary denial. *See, e.g., Full-Metal-Power*, IPR2025-00391, Paper 14 at 2 (denying institution where the district court’s scheduled trial date was just a few weeks before the projected final written decision due date); *Cerence Operating*, IPR2025-00458, Paper 14 at 2 (same where trial date was roughly four months before the final written decision deadline); *NXP USA v. Redstone Logics*, IPR2025-00485, Paper 11 at 2 (P.T.A.B. July 10, 2025) (ditto for trial date less than three months before the final written decision).

To the extent Apple argues that “the district court scheduled trial date and the projected final written decision due date are in close proximity,” that further supports “[e]xercising discretion to deny the petition in this case” to “reduce[] the inefficiencies and burdens on the parties to maintain two parallel proceedings.” *Shenzen Tuozhu Tech. v. Stratasyss*, IPR2025-00354, Paper 11 at 2 (P.T.A.B. June 12, 2025). Further, to the extent Apple speculates that “time-to-trial statistics” could suggest “a district court trial date that occurs after a projected final written decision date,” that also “does not outweigh the efficiencies gained by avoiding parallel proceedings in this instance because of the parties’ meaningful investment in the district court proceeding.” *Advanced Micro Devices v. Concurrent Ventures*, IPR2025-00223, Paper 9 at 2 (P.T.A.B. June 12, 2025). There is substantial meaningful investment here as discussed for factor 3 below.

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

The co-pending district court case has been moving forward since June 2025. Infringement and invalidity contentions have been exchanged, and the district court has already held a *Markman* hearing and issued a claim construction order. EX2004 at 2-5; EX2005 at 1; EX2020 at 1.

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

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

Apple’s invalidity contentions in the district court litigation purport to “incorporate[]... by reference all... *inter partes* review proceedings involving the ’901 Patent.” EX2006 at 100. In this IPR, Apple challenges the same Claims 1-59 of the ’901 Patent based on the substantively identical Jannard, Zadesky, and Irvin

references.¹ *Compare* EX2006 at 90-91, *with* Pet. at 5-6; *see also* EX2006 at 2, 100. Thus, “the patentability disputes before the [district court] will resolve all or substantially all of the patentability disputes between the parties.” *SK Innovation v. LG Chem*, IPR2020-00991, Paper 14 at 16 (P.T.A.B. Nov. 30, 2020) (citation omitted); *see also Code200 v. Luminati Networks*, IPR2020-01266, Paper 18 at 10 (P.T.A.B. Dec. 23, 2020) (factor “strongly favors” denial notwithstanding that “the Petition challenges four claims that are not asserted in the Texas Litigation”).

The district court litigation will also resolve issues beyond those in the IPR. Apple’s Petition is confined to whether the ’901 Patent “claims are unpatentable... as obvious, in view of the prior art.” Pet. at 5. Those issues are subsumed in the co-pending litigation. *See, e.g.*, EX2006 at 89-94. In addition to obviousness under 35 U.S.C. § 103, in the district court litigation, Apple asserts invalidity theories under §§ 102 and 112, including written description challenges. *See* EX2006 at 89-106. As explained in Section IV below, Apple’s positions in the district court are inconsistent with those taken in this IPR. Instituting IPR would not simplify the dispute and would instead force the parties and tribunals to litigate in two forums

¹ Apple’s invalidity contentions, apart from their incorporation of the ’901 Patent Petition, rely on U.S. Patent No. 8,482,488 to Jannard. EX2006 at 90. The Petition’s Jannard reference is a continuation of the ’488 Patent, EX1004 at 1.

simultaneously over overlapping facts and evidence, risking potentially inconsistent outcomes.

Apple proffers a narrow stipulation, *see* Paper 6 at 1, but its stipulation “does not ensure that these IPR proceedings would be a ‘true alternative’ to the district court proceeding.” *Motorola Sols. v. Stellar*, IPR2024-01205, Paper 19 at 3-4 (P.T.A.B. Mar. 28, 2025) (granting Director Review and denying institution). Apple’s extensive use of the asserted IPR art with other types of art in the district court to avoid estoppel renders its limited stipulation meaningless. *See* EX2006 at 94-100 (identifying “prior art apparatuses/systems”); EX2017 at 1 (identifying the “Jabra BT800 system” that allegedly “would have been obvious to combine... with one or more of” “Irvin ’332” and “Zadesky ’230,” which are EX1006 and EX1005, respectively). Indeed, “Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation” would not moot. *Motorola Sols.*, IPR2024-01205, Paper 19 at 4; *Shenzen Tuozhu*, IPR2025-00354, Paper 11 at 2; *see also* Interim Director Discretionary Process § I.D. (“Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained in an AIA proceeding will be limited.”).

Fintiv factor 4 weighs in favor of denial.

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

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

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

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

First, the Petition does not address at least one limitation in every challenged claim in each of the Petition’s seven grounds and thus on its face fails to satisfy 37 C.F.R. § 42.104(b)(4), requiring that “[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon” *See* Pet. at 6 (asserting that “Petitioner ... specif[ies] how and where the prior art satisfies each limitation of each challenged claim, as required by 37 C.F.R. § 42.104(b)(4)”). As identified in the bullet-point list below, the Petition simply fails to address the requirement of “at least partially contained within the head-worn structure” or comparable claim limitations for the following labeled limitations, which include limitations in all independent Claims 1, 18, 35, 38, and 44 as well as numerous dependent claims. For example, in Ground 1, the Petition never addresses

the Claim 1[G] requirement of wireless communication circuitry “at least partially contained within the head-worn structure.” *See* Pet. at 19-20, 103. Ground 2 (Claims 5-7) and Ground 7 (Claims 51-55) are not identified below, but the challenged dependent claims in those grounds fail at least because they depend from independent Claim 1 or 44 challenged in Grounds 1 and 3, respectively.

- Ground 1 (Claims 1-4, 8, 10-11, and 16-17): Claims 1[G], 1[H], 10[A], 11[A], 17[A]. *See* Pet. at 19-22, 28-29, 31-32.
- Ground 3 (Claims 12-15, 18-27, 32-39, 41-45, 47-50, and 59): 18[H], 18[J], 18[K], 33[A], 35[H], 35[J], 35[K], 37[A], 38[D], 38[I], 38[J], 38[K], 44[D], 44[H], 44[I], 44[L]. *See* Pet. at 57-61, 66, 68-73, 75-76.
- Ground 4 (Claims 28-31 and 56-58): 56[A]. *See* Pet. at 82-83.
- Ground 5 (Claim 9): 9[B]. *See* Pet. at 91-93.
- Ground 6 (Claims 40 and 46): 40[B], 46[B]. *See* Pet. at 93-94.

IPR may not be instituted “unless... the information presented in the petition... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). And the Board’s “determination regarding institution” must be “based on what the Petition actually presented and not what it could have reasonably contained had it been reformulated.” *Securus Techs. v. Global Tel*Link Corp.*, IPR2016-00267, Paper 10 at 5 (P.T.A.B. Sept. 12, 2016). Thus, the Petition’s failure

to address the above limitations at all means Apple cannot sustain its burden on any claim, and institution should be denied. *See, e.g., 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”); *see also Jiawei Tech. (HK) v. Richmond*, IPR2014-00937, Paper 24 at 5 (P.T.A.B. Feb. 6, 2015) (denying request for rehearing regarding denial of institution: “Petitioner’s complaints about our analysis do not undo Petitioner’s failure to address the claim language in the Petition.”).

Second, the Petition is supported by an expert declaration that essentially “repeats, *verbatim*, the conclusory assertion[s] for which it is offered to support.” *Xerox v. Bytemark*, IPR2022-00624, Paper 9 at 15 (P.T.A.B. Aug. 24, 2022) (precedential) (denying institution). Apple’s expert, Dr. Smith, largely repeats word for word the text of the Petition. *Compare* Pet. at 6-100, *with* EX1003 ¶¶ 29-296. Dr. Smith’s parroting almost verbatim Apple’s Petition, as shown in the illustrative snapshot below, confirms the Petition’s weakness. *See, e.g., Xerox*, IPR2022-00624, Paper 9 at 15-17 (declining to institute IPR where expert declaration “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support”); *TikTok v. NTECH Props.*, IPR2024-01339, Paper 9 at 16 (P.T.A.B. Feb. 25, 2025) (“Petitioner fails to establish a reasonable likelihood of” prevailing where its expert “testimony

repeats, almost verbatim, the language in the Petition without any further explanation or supporting reasoning or evidence.”).

Pet. at 29 Ground 1, Claim 11[A]	Smith Decl. ¶ 65 Ground 1, Claim 11[A]
Jannard’s audio device 10D can include a light sensor, which the POSITA would understand to describe a sensor in the audio device configured to detect light (<i>i.e.</i> , radiation). (EX1004, 35:4-10; EX1003, ¶65.) Additionally, power from a power source (<i>i.e.</i> , rechargeable battery) is distributed to the components of the audio device, which include the device’s sensors; the POSITA would thus understand that the light sensor is operatively connected to the power source. (EX1004, 44:39-49, FIG. 22; EX1003, ¶65.)	65. Jannard describes that audio device 10D can include a light sensor, which the POSITA would understand to describe a sensor in the audio device configured to detect light (<i>i.e.</i> , radiation). (EX1004, 35:4-10.) Additionally, power from a power source (<i>i.e.</i> , rechargeable battery) is distributed to the components of the audio device, which include the device’s sensors; the POSITA would thus understand that the light sensor is operatively connected to the power source. (EX1004, 44:39-49, FIG. 22.)

7. None Of The *Fintiv* Factors Supports Institution

The weight of the *Fintiv* factors supports the Director exercising its discretion to deny review under Section 314(a), thereby conserving Board and party resources and preventing duplicative proceedings evaluating the same invalidity challenges against the same patent. None of the six *Fintiv* factors supports institution here.

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

Board “rules discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability.” *Revvo Techs. v. Cerebrum Sensor Techs.*, IPR2025-00632, Paper 20 at 4 (P.T.A.B. Nov. 3, 2025) (precedential). That is precisely what Apple has done here: Apple asserts that “[t]he Board *should not*

construe any of the claim terms” in the IPR, Pet. at 4 (emphasis added), while simultaneously proposing in the district court that

- limitations reciting a “head-worn” apparatus or device in Claims 1-7, 9-10, 12-15, 18, 20-21, 25-28, 30-31, 35, 38-50, 53-54, and 56-58 be construed as “electronic eyewear or headwear,” EX2011 at 1, and
- limitations reciting a “speaker... proximate to” an ear, a first ear, or a second ear in Claims 1 and 35 be construed as a “speaker... near” an ear, a first ear, or a second ear, EX2011 at 1-2.

As to the meaning of “proximate,” Apple further argued in the district court that it excludes “inside” the ear. EX2018 at 9 (“None of these terms mean ‘inside.’”).

Apple’s inconsistent claim construction positions are exactly the type of gamesmanship the Office has discouraged, including in a recent informative decision discretionarily denying institution where the petitioner argued in the IPR “that the term ‘composition’ should be given its plain and ordinary meaning, whereas in the parallel proceeding Petitioner asserted that the term ‘composition’ was narrower than its plain and ordinary meaning.” *Sun Pharms. Indus. v. Nivagen Pharms.*, IPR2025-00893, Paper 18 at 2-3 (P.T.A.B. Sept. 19, 2025) (informative). Apple’s inconsistent claim constructions between the two forums warrants denial of its Petition. *See, e.g., Sun Pharms.*, IPR2025-00893, Paper 18 at 3 (discretionary denial where the petitioner “advanced a narrow construction in district court and

advances a broader construction in its Petition”); *Revvo Techs. v. Cerebrum Sensor Techs.*, IPR2025-00632, Paper 36 at 4 (P.T.A.B. Jan. 26, 2026) (“The appropriate course of action... is to deny institution” where petitioner “raise[s] different claim constructions in the two forums.”).

Further, the district court recently issued a claim construction order adopting Apple’s proposed construction for the “head-worn” apparatus or device limitations as “electronic eyewear or headwear,” EX2020 at 2-3, contradicting Apple’s “no claim construction is necessary” approach here, Pet. at 5. Denial of institution is appropriate for this additional reason.

V. APPLE IDENTIFIED NO MATERIAL ERROR WARRANTING IPR

Despite conceding that the examiner considered “hundreds of references,” Apple claims that the “Examiner’s prior art search was deficient for being underinclusive and tainted by errors in the search classification and queries.” Pet. at 2. Apple’s claims of error are unsupported and meritless.

Apple first refers to “several defects in the search process, including the application’s unduly narrow classification for search purposes as an optical system under G02B and G02C” and a “classification G02J... identified on the face of the patent.” Pet. at 3 & n.3. But Apple’s conclusory assertion provides no explanation why the application’s classification was unduly narrow, much less proves material error stemming therefrom during examination. Indeed, Apple never explains what

classification should have been used for search purposes, and it never shows how a different classification would have led to a different outcome. *See* Pet. at 3-4. Nor does Apple cite any authority that an allegedly narrow classification can be the basis for a Patent Office error warranting institution.

Apple next asserts that “the Examiner’s unsound search methodology,” which was allegedly “directed narrowly to optical systems,” led it to find the claims “allowable for reciting a touch-sensitive surface, a sensor configured to capture data, and electronic circuitry configured to determine whether the head-worn device is being worn.” Pet. at 3-4. But Apple never addresses the examiner’s hundreds of pages of countless search terms, including many that are not limited to “optical systems.” *See, e.g.*, EX1002 at 221-291, 334-489, 729-958; *see also, e.g., id.* at 227 (“earphone seating hearing aid automatic self”), 229 (“hearing aid temple temples microphone housing”), 232 (“temple tip electrical members engageable”), 236 (“clothing speaker article enclosure pin”), 241 (“tubing transducer sound housing section”), 251 (“head computing device mountable computing capacitance state”). Apple additionally overlooks the USPC classification searches in class 381 for “Electrical Audio Signal Processing Systems and Devices.” *See* EX1001 at 2 (Field 58).

Apple criticizes the examiner’s search for being too narrow to uncover Irvin (EX1006), Zadesky (EX1005), and Clapper (EX1010), Pet. at 3-4, but Apple does

not explain why the examiner reasonably should have searched in the narrow subclasses that would have been required to find those references. For example, the examiner's search would have had to have been extraordinarily broad to encompass Zadesky. *See* EX1005 at 1 (entitled, "Touch Pad Handheld Device"). Zadesky is in international class G09G 5/00, EX1005 at 1 (Field 51), which is entitled, "Arrangements or Circuits for Control of Indicating Devices Using Static Means to Present Variable Information": "Control arrangements or circuits for visual indicators common to cathode-ray tube indicators and other visual indicators...." Similarly, Clapper is in international class H01R 11/30, EX1010 at 1 (Field 51), which is entitled, "Electrically-Conductive Connections; Structural Associations of a Plurality of Mutually-Insulated Electrical Connecting Elements; Coupling Devices; Current Collectors": "End pieces held in contact by a magnet." Finally, Irvin is in international classes H04B 1/38 and H04M 1/00, EX1006 at 1 (Field 51), which are entitled, "Transmission": "Transceivers..." and "Telephonic Communication": "Substation equipment, e.g., for use by subscribers....," respectively. Apple has no reasonable basis to contend, nor does it, that the examiner should have searched in all these narrowly tailored classes for each individual component of the claimed subject matter.

Apple cites pages 221-291 of the EX1002 file history, Pet. at 3, but never addresses the examiner's "PE2E" searches, which included both detailed keyword

searches *and* similarity searches using the claim language, among other searches. *See, e.g.*, EX1002 at 334-489, 729-890.

Apple establishes no error, let alone material error, with the examiner’s search methodology warranting institution. *See, e.g., Belden v. CommScope*, IPR2025-00833, Paper 13 at 3 (P.T.A.B. Sept. 12, 2025) (discretionary denial: “Petitioner does not sufficiently address why this search was inadequate.”).

VI. APPLE’S MANUFACTURING ABROAD WEIGHS AGAINST INSTITUTION

Additional discretionary denial considerations, such as “whether the petitioner is a small business that has been sued for infringement of the patent at issue” and “the extent to which any products accused of infringement in a parallel proceeding are manufactured in the United States,” favor denying institution. Memorandum, “Additional Discretionary Institution Considerations – U.S. Manufacturing and Small Business Use of AIA Proceedings,” at 2 (Mar. 11, 2026) (“U.S. Manufacturing Memo”).

Apple is a large publicly-traded company with approximately 166,000 full-time employees as of 2025. EX2019 at 7. In the district court litigation, Apple’s AirPods and AirPods Pro are accused of infringing the ’901 Patent. EX2002 ¶ 43. Those accused products, like the majority of Apple’s products, are manufactured outside of the United States. EX2019 at 11 (“The Company relies... on partners

primarily located in Asia, for final assembly of substantially all of the Company’s hardware products.”); *see also id.* at 49 (“Substantially all of [Apple’s] hardware products are manufactured by outsourcing partners that are located primarily in China mainland, India, Japan, South Korea, Taiwan and Vietnam.”). Apple’s statements in “public financial disclosures that [it does] not have a significant, existing manufacturing presence in the United States” further supports denying institution here. U.S. Manufacturing Memo at 2.

VII. APPLE CANNOT JUSTIFY USE OF BOARD RESOURCES

Institution would not be an appropriate or efficient use of Board resources here, and there is a significant risk of conflicting decisions with the co-pending litigation where the same parties have already committed substantial resources toward resolving a broader array of issues in the district court, including those presented in Apple’s Petition and the validity of five other patents-in-suit, one of which Apple has not challenged in IPR as of this filing. Absent “persuasive reasons why the Office should review the challenged patent... the Office is disinclined to disturb the settled expectations of Patent Owner.” *Dabico Airport Sols. v. AXA Power*, IPR2025-00408, Paper 21 at 3 (P.T.A.B. June 18, 2025) (informative).

The Board’s institutional policy weighs heavily in favor of discretionary denial where, as here, efficiency gains are nonexistent and the parallel litigation already subsumes all or substantially all issues, and more. Indeed, “addressing all

of the challenged patents in the district court proceeding would be ‘the fastest and most efficient resolution of the Parties’ many disputes’” particularly given “there are six patents at issue in the parallel district court proceeding” and “institution was denied” as to two patents and is likely to be denied for at least a third patent challenged in other IPRs by Petitioner. *Samsung Elecs. v. VB Assets*, IPR2025-00870, Paper 11 at 2-3 (P.T.A.B. Oct. 10, 2025); *supra* § I.

VIII. CONCLUSION

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

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Dated: April 13, 2026

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a true copy of the foregoing **PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL** and **EXHIBITS 2001-2006, 2011, and 2015-2020** are being served electronically on April 13, 2026 to the following lead and backup counsel for Petitioner to the following email addresses:

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