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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 PRELIMINARY RESPONSE

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OTHER AUTHORITIES

37 C.F.R. § 42.104	3, 6
35 U.S.C. § 314.....	1, 4

TABLE OF EXHIBITS

Exhibit No.	Description
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

IngenioSpec is a California company that has led innovation in wearable electronic devices for more than a decade. EX2002 ¶¶ 3-4. Its cutting-edge wearable technology seamlessly integrates electronics into the wearable devices to deliver practical solutions that positively transform consumers’ daily lives. *Id.* ¶ 4. Through its patented wearable device technologies, these solutions include health monitoring, hands-free communication, enhanced hearing, and integrated audio and video playback. *Id.* ¶¶ 5, 7-8.

Despite its Petition spanning seven grounds based on a collage of five asserted references to target fifty-nine patent claims, Apple has not met its burden to establish a reasonable likelihood of prevailing on any patent claim. Across all asserted grounds, the Petition fatally omits addressing at least one limitation in every challenged claim. The Petition offers no analysis whether, much less how, the asserted art taught the requirement of “at least partially contained within the head-worn structure” or comparable claim limitations present in every claim. Having omitted a necessary element of the challenged claims from its analysis, the Petition falls well short of meeting the threshold showing required by 35 U.S.C. § 314(a), and institution should be denied.

II. OVERVIEW OF THE '901 PATENT

The '901 Patent is titled “System for Charging Embedded Battery in Wireless Head-Worn Personal Electronic Apparatus.” EX1001 at 1. The '901 Patent generally describes providing “head-worn personal electronic apparatus with electrical components.” *Id.* at 6:57-59. Among other electrical components in the apparatus, the '901 Patent describes, for example, “electrical components [that] can support signal capturing, signal processing, signal transmission, signal display, signal storage and/or power provision”; “electrical components [that] can, for example, be used to provide audio output and/or audio pick-up”; “electrical components [that] may include and/or control one or more sensors to monitor and/or signal the conditions of a user”; and “electrical components [that] may also include and/or control one or more operation indicators to signal operational status of at least some other electrical components.” *Id.* at 7:1-11.

III. LEVEL OF ORDINARY SKILL IN THE ART

For purposes of denying institution and finding that Apple has not met its burden to show a reasonable likelihood of prevailing, IngenioSpec submits that the Board need not determine the level of ordinary skill in the art. *Johnson & Johnson Surgical Vision v. Alcon*, IPR2021-01003, Paper 14 at 9 (P.T.A.B. Nov. 23, 2021) (denying institution: “For our analysis on whether to institute, we need not determine the level of ordinary skill in the art”).

IngenioSpec reserves the right to address the level of ordinary skill in the event the Board institutes trial.

IV. CLAIM CONSTRUCTION IS NOT NECESSARY TO DENY INSTITUTION

Apple asserts in the Petition that “no claim construction is necessary to resolve any issue” in this proceeding. Paper 1 (“Pet.”) at 5. For purposes of denying institution because Apple has not met its burden to show a reasonable likelihood of prevailing, IngenioSpec submits the Board need not construe any terms of the challenged claims. *Realtime Data v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms... that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs. v. Am. Sci. & Eng’g*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

IngenioSpec reserves the right to assert claim construction positions if trial is ordered.

V. THE PETITION FAILS TO MEET ITS BURDEN ON AT LEAST ONE LIMITATION IN EVERY CLAIM IN ALL GROUNDS

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 “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 below, the Petition does not address the requirement of “at least partially contained within the

head-worn structure” or comparable claim limitations, including limitations in all independent Claims 1, 18, 35, 38, and 44 as well as several dependent claims.

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). In addition, 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); *see also In re Magnum Oil Tools Int’l*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (Board is not “free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR”).

Here, because the Petition fails to meet its burden on at least one limitation required by all claims, 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.”).

A. Ground 1 Cannot Prevail (Claims 1-4, 8, 10-11, And 16-17)

Ground 1 cannot prevail because the Petition does not address the limitation “at least partially contained within the head-worn structure” or comparable limitations required by challenged Claims 1-4, 8, 10-11, and 16-17, much less show that they are satisfied. Because the Petition simply fails to address this limitation at all in the cited instances below and because Apple cannot remedy that failure in reply, Apple cannot carry its burden to show invalidity of any challenged claim.

For example, as to Claim 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, or the Claim 1[H] requirement of at least one conductive element “at least partially included within the head-worn structure,” *see* Pet. at 21-22.

The Petition also never addresses the “at least partially contained within the head-worn structure” requirement in several dependent claims, including in Claims 10[A], 11[A], and 17[A]. *See* Pet. at 28-29, 31-32.

Apple’s failure to address these claim limitations at all cannot be remedied after institution. The Board cannot “adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR.” *Magnum Oil*

Tools, 829 F.3d at 1381. Nor can Apple make a new “meaningfully distinct contention” in reply to fill in gaps in its Petition or exceed the proper scope of reply. *See* 37 C.F.R. §§ 42.23(b), 42.104(b)(4); *Ariosa Diagnostics v. Verinata Health*, 805 F.3d 1359, 1367-68 (Fed. Cir. 2015) (“The Board must make judgments about whether a Petition identified the specific evidence relied on in a Reply and when a Reply contention crosses the line from the responsive to the new.”).

Because the Petition does not address at least one limitation in every claim challenged, Ground 1 fails, and Apple cannot prevail on Ground 1.

B. Ground 2 Cannot Prevail (Claims 5-7)

The Ground 2 challenges to dependent Claims 5-7 fall with the Ground 1 challenges to Claims 1 and 2 from which Claims 5-7 depend. As explained, Ground 1 fails. *Supra* § V.A. Thus, Ground 2 also fails. *Ubiquiti v. Intellectual Ventures*, IPR2024-01290, Paper 9 at 32 (P.T.A.B. Mar. 7, 2025) (“Because each of the dependent claims incorporates the limitations of the independent claim from which it depends, Petitioner has also necessarily failed to demonstrate a reasonable likelihood that these claims are unpatentable over the prior art.”).

Apple cannot prevail on Ground 2.

C. Ground 3 Cannot Prevail (Claims 12-15, 18-27, 32-39, 41-45, 47-50, And 59)

The Ground 3 challenges to dependent Claims 12-15 fall with the Ground 1 challenge to Claim 1 from which Claims 12-15 depend. As explained, Ground 1 fails. *Supra* § V.A. Thus, the Ground 3 challenges to Claims 12-15 also fail. *Ubiquiti*, IPR2024-01290, Paper 9 at 32 (petitioner necessarily fails to show unpatentability of dependent claims by failing to show unpatentability of independent claim from which they depend).

The Ground 3 challenges to Claims 18-27, 32-39, 41-45, 47-50, and 59 fail because the Petition fails to address the Claims 18[H], 18[J], 18[K], 35[H], 35[J], 35[K], 38[D], 38[I], 38[J], 38[K], 44[D], 44[H], 44[I], and 44[L] requirements of “at least partially contained within the head-worn structure” or comparable limitations. For example:

- as to independent Claim 18, the Petition never addresses the Claim 18[H] requirement of electronic circuitry “contained within the head-worn structure,” the Claim 18[J] requirement of wireless communication circuitry “at least partially contained within the head-worn structure,” and the Claim 18[K] requirement of at least one conductive element “at least partially included within the head-worn structure,” *see* Pet. at 57-61;

- as to independent Claim 35, the Petition never addresses the Claim 35[H] requirement of electronic circuitry “contained within the head-worn structure,” the Claim 35[J] requirement of wireless communication circuitry “at least partially contained within the head-worn structure,” and the Claim 35[K] requirement of at least one conductive element “at least partially included within the head-worn structure,” *see* Pet. at 68;
- as to independent Claim 38, the Petition never addresses the Claims 38[D] and 38[J] requirements of a motion sensor and wireless communication circuitry, respectively, that are “at least partially contained within the head-worn structure,” the Claim 38[I] requirement of electronic circuitry “contained within the head-worn structure,” and the Claim 38[K] requirement of at least one conductive element “at least partially included within the head-worn structure,” *see* Pet. at 72-73; and
- as to independent Claim 44, the Petition never addresses the Claims 44[D] and 44[I] requirements of a motion sensor and wireless communication circuitry, respectively, that are “at least partially contained within the head-worn structure,” the Claim 44[H] requirement of electronic circuitry “contained within the head-worn structure,” and the Claim 44[L] requirement of at least one conductive element “at least partially included within the head-worn structure,” *see* Pet. at 75-76.

The Petition also never addresses the “at least partially contained within the head-worn structure” requirement in dependent Claims 33[A] and 37[A]. *See* Pet. at 66, 69-71.

Apple cannot prevail on Ground 3.

D. Ground 4 Cannot Prevail (Claims 28-31 And 56-58)

The Ground 4 challenges to dependent Claims 28-31 and 56-58 fall with the Ground 3 challenges to claims from which they depend. As explained, Ground 3 fails. *Supra* § V.C. Thus, Ground 4 also fails. *Ubiquiti*, IPR2024-01290, Paper 9 at 32 (petitioner necessarily fails to show unpatentability of dependent claims by failing to show unpatentability of independent claim from which they depend).

The Ground 4 challenges to Claims 56-58 also fail because the Petition fails to address the Claim 56[A] requirement of a force sensor “at least partially contained within the head-worn structure.” *See* Pet. at 82-83.

Apple cannot prevail on Ground 4.

E. Ground 5 Cannot Prevail (Claim 9)

The Ground 5 challenge to dependent Claim 9 falls with the Ground 1 challenge to Claim 1 from which Claim 9 depends. As explained, Ground 1 fails. *Supra* § V.A. Thus, Ground 5 also fails. *Ubiquiti*, IPR2024-01290, Paper 9 at 32 (petitioner necessarily fails to show unpatentability of dependent claims by failing to show unpatentability of independent claim from which they depend).

The Ground 5 challenge to Claim 9 independently fails because the Petition fails to address the Claim 9[B] requirement of at least one magnetic element “at least partially contained within the head-worn structure.” *See* Pet. at 91-93.

Apple cannot prevail on Ground 5.

F. Ground 6 Cannot Prevail (Claims 40 And 46)

The Ground 6 challenges to dependent Claims 40 and 46 fall with the Ground 3 challenges to claims from which they depend. As explained, Ground 3 fails. *Supra* § V.C. Thus, Ground 6 also fails. *Ubiquiti*, IPR2024-01290, Paper 9 at 32 (petitioner necessarily fails to show unpatentability of dependent claims by failing to show unpatentability of independent claim from which they depend).

The Ground 6 challenges to Claims 40 and 46 independently fail because the Petition fails to address the Claims 40[B] and 46[B] requirement of at least one magnetic element “at least partially contained within the head-worn structure.” *See* Pet. at 93-94.

Apple cannot prevail on Ground 6.

G. Ground 7 Cannot Prevail (Claims 51-55)

The Ground 7 challenges to dependent Claims 51-55 fall with the Ground 3 challenges to Claims 44 and 45 from which Claims 51-55 depend. As explained, Ground 3 fails. *Supra* § V.C. Thus, Ground 7 also fails. *Ubiquiti*, IPR2024-01290, Paper 9 at 32 (petitioner necessarily fails to show unpatentability of dependent

claims by failing to show unpatentability of independent claim from which they depend).

Apple cannot prevail on Ground 7.

VI. PETITIONER’S VERBATIM EXPERT DECLARATION SUPPORTS DENYING INSTITUTION

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). With respect to the Petition’s failure to address at least one limitation in every claim as discussed in Section V above, even if Apple could rely on its expert declaration for arguments not made in the Petition (it cannot), Apple’s expert, Dr. Smith, largely repeats word for word the text of the Petition and thus fails to remedy any of the deficiencies identified above. *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 and supports denying institution. *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.)

VII. CONCLUSION

For any of these reasons, the Board should deny institution of the Petition.

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** exclusive of the parts exempted as provided in 37 C.F.R. § 42.24, contains 2,537 words and therefore complies with the type-volume limitations of 37 C.F.R. § 42.24.

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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 PRELIMINARY RESPONSE** is being served electronically on May 13, 2026 to the following lead and backup counsel for Petitioner to the following email addresses:

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