

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

INGENIOSPEC, LLC.
Patent Owner.

Patent No. 12,044,901

Inter Partes Review No. IPR2026-00253

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

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Petitioner's Updated Exhibit List

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U.S. Patent No. 7,313,423 to Griffin et al.	EX1008
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Joint Motion to Stay All Deadlines and Notice of Settlement, <i>IngenioSpec, LLC v. Bose Corp.</i> , No. 2:24-cv-00822-JRG (E.D. Tex. Mar. 28, 2025), ECF No. 49	EX1017 (NEW)
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<i>Apple will spend more than \$500 billion in the U.S. over the next four years</i> , Apple Newsroom, Feb. 24, 2025	EX1021 (NEW)
<i>Apple and Corning partner to manufacture 100 percent of iPhone and Apple Watch cover glass in Kentucky</i> , Apple Newsroom, Aug. 6, 2025	EX1022 (NEW)
<i>Apple accelerates U.S. manufacturing, with Mac mini production coming later this year</i> , Apple Newsroom, Feb. 24, 2026	EX1023 (NEW)
<i>Apple announces expanded partnership with Amkor for advanced silicon packaging in the U.S.</i> , Apple Newsroom, Nov. 30, 2023	EX1024 (NEW)
<i>Apple adds new partners to its American Manufacturing Program</i> , Apple Newsroom, Mar. 26, 2026	EX1025 (NEW)
<i>Apple expands U.S. supply chain with \$500 million commitment to American rare earth magnets</i> , Apple Newsroom, July 15, 2025	EX1026 (NEW)

Exhibit Description	Exhibit #
<i>Apple Manufacturing Academy brings together hundreds of U.S. manufacturers to accelerate AI use in American supply chains</i> , Apple Newsroom, May 5, 2026	EX1027 (NEW)
Compare AirPods models, https://www.apple.com/airpods/compare/	EX1028 (NEW)
Transcript of April 6, 2026, Markman Hearing, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, ECF No. 71 (W.D. Tex. Apr. 6, 2026)	EX1029 (NEW)

Patent Owner's Exhibit List

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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
Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00877, Dkt. No. 1 (W.D. Tex. June 6, 2025)	2002
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RESERVED	2007
RESERVED	2008
RESERVED	2009
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Declaration of Peter Tong	2015
DocketNavigator Case List for U.S. Patent No. 12,044,901	2016
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)	2017
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Apple Inc. Form 10-K Annual Report (Oct. 31, 2025)	2019
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I. INTRODUCTION

Discretionary denial of Apple's Petition should be declined, and the Petition should be referred to the Board for review on the merits. Patent Owner trivializes Apple's leading role in America's innovation ecosystem, including Apple's historic investment in American manufacturing, workers, suppliers, and innovation—the exact kind of domestic commitment that the recent U.S. Manufacturing Memo linked to the integrity of the patent system. Discretionary denial also is not appropriate due to the '901 patent issuing from material prosecution error, there being no settled expectations of validity, and uncertain trial timing due to the recent upheaval in the parallel district court litigation caused by Judge Albright's imminent departure from the bench. None of these considerations supports denial. Together, they point directly to the PTAB as the most efficient and reliable forum for resolving patentability.

First, institution serves the broader interests reflected in the Director's recent U.S. manufacturing guidance. Apple is an American innovator making historic investments in the U.S. innovation economy, including a recent commitment of more than \$600 billion to domestic manufacturing, component production, training, and infrastructure. Apple's domestic investments and product development depend on a robust patent system that can efficiently remove invalid patents before they disrupt American innovation. Patent Owner's serial

enforcement of its erroneously issued patents is exactly the type of burden that PTAB review is best suited to address.

Second, the '901 patent issued only because of material Office error. The application was misclassified and searched as an optics invention, even though the claims recite no optics limitations. The Examiner then allowed all claims based on a combination of features that no claim actually requires, while overlooking teachings of those same features in the prior art.

Third, Patent Owner has no settled expectations that can justify insulating the '901 patent from review. The patent issued in July 2024, only about eighteen months before the Petition was filed. Patent Owner relies on unidentified licenses and litigation settlements, including for unrelated patents, but does not show how any license created settled expectations in the validity of the challenged claims.

Fourth, the *Fintiv* factors favor institution. Judge Albright recently announced he will leave the bench in August 2026, months before the scheduled April 2027 trial; no successor judge has been identified; and no case-specific transition plan exists. The scheduled trial date is thus speculative and in flux, in contrast to the Board's statutory deadlines. PTAB review offers efficiency and certainty that the court cannot be expected to provide during this major transition.

Finally, Apple has not taken inconsistent claim-construction positions. The Petition is consistent with Apple's district court constructions and specifically

identifies how the prior art satisfies them, defeating Patent Owner's "gamesmanship" argument.

II. ARGUMENT

A. Apple's U.S. Presence and Commitment to U.S. Investment, and Patent Owner's Pattern of Enforcement, Support Institution

Patent Owner's manufacturing argument trivializes Apple's U.S. presence. Apple has made one of the largest private commitments to American innovation and advanced manufacturing in the nation's history. In February 2025, Apple announced its largest-ever U.S. spend commitment: more than \$500 billion over four years—a figure that Apple has since increased to more than \$600 billion. (EX1021, 1-2; EX1022, 1.) That commitment builds on Apple's long history of investing in American innovation and manufacturing, and supports initiatives in AI, silicon engineering, data centers and infrastructure, and R&D. (EX1021, 2-3.)

1. Apple Products Are Designed and Engineered in the United States and Manufactured with American Components

Patent Owner focuses narrowly on final assembly of AirPods in Asia. (Request, 18-19.) But final assembly is only one stage in a broader innovation and manufacturing ecosystem. For example, the accused AirPods are designed and engineered in the United States and incorporate Apple's U.S.-developed technologies, including Apple silicon such as the H2 chip. (*See, e.g.*, EX1028, 1, 5.) Across its product lines, Apple increasingly relies on components that are made, packaged, or sourced domestically. Apple is the largest customer at

TSMC's Fab 21 facility in Arizona, where more than 2,000 workers manufacture Apple chips, and Apple is on track to purchase well over 100 million advanced chips from the Arizona facility in 2026. (EX1021, 5; EX1023, 4.) Apple will also be the first and largest customer of Amkor's new \$2 billion advanced semiconductor packaging facility in Peoria, Arizona, where Apple silicon from the nearby TSMC fab will be packaged. (EX1024, 1-2.) Overall, Apple suppliers manufacture silicon for Apple products in 24 factories across 12 states, including Colorado, Oregon, and Utah, at U.S. companies such as Broadcom, Texas Instruments, Skyworks, and Qorvo. (EX1021, 5.)

Apple is also expanding domestic production of sensors, integrated circuits, magnets, and other components critical to Apple products. Through Apple's American Manufacturing Program, TDK will manufacture sensors for Apple products in the United States for the first time; Bosch and TSMC will produce integrated circuits for sensing hardware at TSMC's facility in Camas, Washington; and Cirrus Logic and GlobalFoundries will establish new semiconductor process technologies in Malta, New York. (EX1025, 1-3.) Apple has also committed \$500 million to buy American-made rare earth magnets from MP Materials' Fort Worth, Texas facility and to establish a rare-earth recycling line in Mountain Pass, California. (EX1026, 1-3.) These investments will bring lightweight neodymium magnets—commonly used in earbuds and other portable audio devices—into

Apple's domestic supply chain. (EX1026, 2.) Patent Owner's focus on final assembly ignores these investments in the American technologies and components that make Apple products work.

2. Apple Has Made Historic Commitments to Domestic Manufacturing and Innovation

Apple's investments extend across a U.S.-anchored network of engineering, component production, suppliers, and advanced manufacturing. Apple is opening a new 250,000-square-foot advanced manufacturing facility in Houston, where Mac mini production will begin in the United States for the first time and AI server production is already ahead of schedule. (EX1023, 1-2.) Apple has committed \$2.5 billion for Corning to produce 100% of the cover glass for iPhone and Apple Watch in Harrodsburg, Kentucky. (EX1022, 1-2.) Apple is also doubling its U.S. Advanced Manufacturing Fund to \$10 billion, supporting projects in 13 states that build local businesses, train workers, and create advanced manufacturing processes and materials for Apple products. (EX1021, 4-5.)

Apple is investing in the workforce and infrastructure needed to sustain those commitments. It launched the Apple Manufacturing Academy in East Lansing, Michigan, the only manufacturing academy of its kind in North America, which has already supported more than 150 American businesses. (EX1027, 2-4.) Apple is also opening a 20,000-square-foot Advanced Manufacturing Center in Houston to provide hands-on training to students, supplier employees, and

businesses of all sizes. (EX1023, 4.) Apple supports more than 2.9 million U.S. jobs, plans to hire approximately 20,000 additional U.S. employees focused on R&D, silicon engineering, software development, and AI, and has nearly doubled its U.S.-based advanced R&D spend over the past five years. (EX1021, 3, 5-6.)

3. The Director’s U.S. Manufacturing Memo Favors Apple, Not Patent Owner

These are precisely the types of “investments in American manufacturing operations” and U.S.-made components that the Director “will consider” under the U.S. Manufacturing Memo. (U.S. Manufacturing Memo, 2-3.) The Memo is not limited to final assembly; it also considers future U.S. manufacturing investment and the extent to which product components are made in the United States. (U.S. Manufacturing Memo, 2-3.) Apple is advancing all those considerations on a historic scale. Patent Owner, by contrast, identifies no sales of any product, no domestic manufacturing, and no meaningful investment in U.S. manufacturing, suppliers, workers, or infrastructure. Its primary business appears to be patent-infringement lawsuits.

4. Patent Owner’s Enforcement Pattern Supports Institution

Apple’s U.S. manufacturing, supplier, infrastructure, R&D, and workforce initiatives depend on a robust patent system that can efficiently weed out invalid patents before they disrupt domestic innovation and investment. Patent Owner threatens to do just that, by serially asserting its erroneously issued patents against

unrelated defendants in multiple district courts and the ITC, typically resolving cases before validity is adjudicated. This pattern demands a check on the asserted patents, and relying on the district court to perform that role would be especially impractical here: Judge Albright is leaving the bench, no successor judge has been assigned, and there is no specific plan for how the litigation will proceed. Patent Owner's enforcement campaign thus presents "persuasive reasons why the Office should review the challenged patent." *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21, 3 (June 18, 2025) (informative). The Board—not shifting district-court proceedings—is best positioned to test the '901 patent's validity and protect the integrity of the patent system that underpins Apple's commitment to the American innovation economy.

B. The '901 Patent Resulted from Material USPTO Error

The '901 patent issued only after a series of material Office errors. Discretionary denial is inappropriate because these errors allowed the '901 patent to issue with claims taught by the prior art. *See Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, 3 (June 12, 2025).

1. The Application Was Incorrectly Classified and Searched

The Office's errors began before substantive examination. The USPTO misclassified the application as Optics, even though none of the '901 patent's claims recites any optics elements. Patent Owner does not dispute this

misclassification and argued in the district court that any attempt to import optics embodiments into the claims would be “improper[]”. (EX1013, 9.)

Based on this misclassification, the application was routed to the Optics art unit (2872); assigned an Examiner from that unit; and classified for prior art searches as an optical system under G02B and G02C. (*See* EX1001, (58).) The misclassification constrained the POSITA’s perspective to the Optics field, and accordingly, the Examiner limited many searches by optics-related terms (such as eyeglasses) not found in the claims. (*See, e.g.*, EX1002, 221-291.)

These errors caused the Examiner to miss key prior art, including Irvin, Zadesky, and Clapper. Patent Owner overstates the difficulty of finding those references: they relate directly to the claim terms, including the same limitations the Examiner relied on to find patentability, and were thus obvious search areas for a reasonably focused examination. For example, although Patent Owner claims the Examiner would have needed an “extraordinarily broad” search to locate Zadesky, the reference—titled “Touch Pad Handheld Device”—appears within the first three pages of Google Patents results when simply searching for the claim terms *touch surface* and filtering by the application’s claimed priority date. (Request, 16-17.) The Examiner performed dozens of Google Patents searches in 2024 while examining the ’901 patent, and specifically believed the claimed touch-sensitive surface to be novel, yet failed to use basic search terms—apparently neglecting

even to search for the word “touch”—and ordinary search filters that would have led directly to material prior art. (*See, e.g.*, EX1002, 221-291, 990.)

2. The Examiner Allowed the Claims Based on Unclaimed Subject Matter

More critically, the Examiner compounded the Office’s initial errors by applying the prior art to the wrong limitations. The Examiner hastily allowed the ’901 patent after only one art-based rejection, finding independent claims 1, 19, 40, 43, and 49¹ patentable based on an assertedly missing combination of features:

The prior art taken either singly or in combination fails to anticipate or fairly suggest a system further comprising:

wherein a touch sensitive surface at least partially contained within the head-worn structure and configured to sense a touch input associated with the user; wherein a sensor at least partially contained within the head-worn structure and configured to capture data; the electronic circuitry being configured to process at least the data captured by the sensor, and the electronic circuitry being configured to determine whether the head-worn structure is being worn by a user based on at least the processed sensor data,

as claimed; recited together in combination with the totality of particular features/limitations recited therein.

(EX1002, 990 (emphasis added), 502-523.)

The Examiner allowed the remaining claims solely based on their dependency

¹ The claims identified here and in the Notice of Allowance refer to the claims as numbered in the applicant’s February 13, 2024, Office Action response; the claims were renumbered prior to issuance, and independent claims 1, 19, 40, 43, and 49 now correspond to independent claims 1, 18, 35, 38, and 44 of the issued patent.

from the independent claims, without addressing any individually. (EX1002, 990.)

This was material error. No claim recites the features that “together in combination” formed the Examiner’s basis for allowance. Claim 1 recites a touch-sensitive surface, but not circuitry configured to determine whether the device is being worn. Claim 19 recites a sensor and circuitry configured to process captured data, but not a touch sensitive surface. Claim 43 recites a touch-sensitive surface and motion detector, but not circuitry configured to determine whether the device is being worn. And claims 40 and 49 recite neither a touch-sensitive surface nor such circuitry. (EX1002, 697-714; EX1001.)

The Examiner thus allowed all 59 claims because the prior art supposedly lacked a combination the claims do not require. Allowing the claims based on unclaimed subject matter was material error that goes directly to patentability.

3. The Examiner Overlooked the Prior Art’s Teachings

The Examiner committed further error by overlooking what the prior art actually taught. The Notice of Allowance stated that the closest prior art, Spitzer and Kallman, failed to teach a touch-sensitive surface and a sensor within the head-worn structure. (EX1002, 990.) But Kallman expressly discloses those features:

As is suggested by FIG. 4, switches S1, S2 disposed within eyewire 58 are operable by manual gripping pressure on frame F ... to actuate lens driver 30 via control logic 28 responsive to closure of one or both switches. ... Also within the invention, switches S1 and S2 may be implemented more conventionally, e.g. electronic, e.g. touch-sensitive, or electromechanical, e.g. microswitch, devices may be used.

(EX1014, 16:16-32.)

The Examiner cited Kallman in the only art rejection and specifically discussed its Figure 4 embodiment. (EX1002, 514-516.) But he overlooked that in this embodiment,

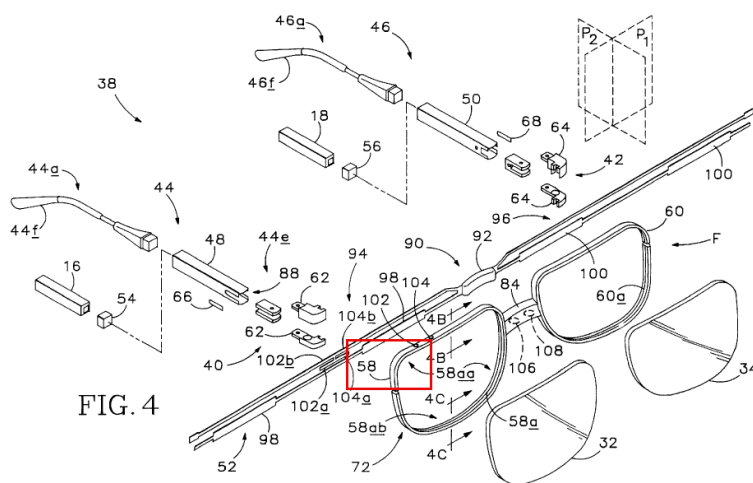


FIG. 4

(EX1014, FIG. 4 (annotated).)

Kallman’s eyewear frame includes touch-sensitive switches disposed within the eyewire and configured to sense the user’s touch—one of the very features he later identified as patentable.

The same Examiner eventually noticed Kallman’s disclosure more than a year later, relying on the “touch-sensitive” switches to reject a continuation of the ’901 patent—indicating his prior ’901 allowance over Kallman was an oversight, not a considered patentability determination. (EX1015, 496.)

C. Settled Expectations Favor the Petitioner, Not the Patent Owner

Patent Owner’s settled-expectations argument fails at the threshold. The ’901 patent issued in July 2024—roughly eighteen months before the Petition was filed. (EX1001.) Patent Owner identifies no Board decision holding that such recently issued claims create settled expectations against review. Its cited cases involved materially different facts. In *Hisense*, the claims had been in force for

more than eleven years. *Hisense USA Corp. v. VideoLabs, Inc.*, IPR2025-00880, Paper 11, 2 (Oct. 10, 2025). And in *Alliance Laundry*, the patents had been in force for more than four years and had survived serial PTAB challenges. *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950, Paper 11, 3 (Sept. 19, 2025). This case involves neither old claims nor serial petitions. To the contrary, the Board has regularly declined to find strong settled expectations even for claims years older than those challenged here. *See, e.g., Microsoft Corp. v. Edge Networking Sys., LLC*, IPR2025-00617, Paper 12, 2 (July 31, 2025).

Patent Owner’s reliance on licensing—including for unrelated patents—fares no better. (*See* EX2015, 1-2.) The Request does not identify any license specific to the challenged claims, describe the circumstances of any license, or explain how any license created settled expectations in the ’901 patent’s validity. Patent Owner’s declarant states only that “[t]he ’901 Patent has been licensed 26 times,” without identifying the licenses, their scopes, their dates, or whether they predated issuance. (EX2015, 1.) Licenses to claims that did not yet exist, for instance, cannot create settled expectations in the validity of those claims. And to the extent Patent Owner relies on 2025 litigation settlements reached before validity could be adjudicated, those agreements show only compromise—not any expectation that the recently issued claims are valid. (*See* EX1016; EX1017.)

If anything, settled expectations favor Apple. Patent Owner’s enforcement

history gave Apple reason not to expect enforcement of the '901 patent family against it. In 2024, Patent Owner asserted related patents—including the parent of the '901 patent—against several large technology companies, but not Apple. From 2023 through 2025, Patent Owner pursued three ITC investigations against numerous technology companies, again without naming Apple. Patent Owner's affiliate, IpVenture, Inc., has followed a similar pattern for decades—asserting patents against large technology companies while not targeting Apple. When Patent Owner did sue Apple, on U.S. Patent No. 8,112,104, it was months after suing other technology companies—and only after that patent had already expired.

That history cuts against discretionary denial. In *Allani*, the Board found discretionary denial “not appropriate” where the petitioner “did not expect enforcement” of the challenged patent. *See Apple Inc. v. Allani*, IPR2025-00856, Paper 11, 2-3 (Sep. 5, 2025) (informative). The same reasoning applies here. Patent Owner cannot manufacture settled expectations from a recently issued patent, unidentified licenses, and shifting enforcement strategies.

D. *Fintiv* Favors Institution in View of Judge Albright's Departure

Judge Albright will leave the bench in August 2026 and therefore cannot preside over the trial he scheduled for April 2027. Even before that announcement, trial dates before Judge Albright were unpredictable and subject to rescheduling. Now, with no successor judge identified and no case-specific transition plan in

place, Patent Owner’s reliance on the existing trial date is complete speculation. The uncertainty and inefficiency created by the transition underscores why the Board should institute the Petition.

1. Factor 1: The Likelihood of a Stay Is Neutral or Weighs Against Discretionary Denial

Patent Owner suggests that a stay before Judge Albright is unlikely. (Request, 5.) 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). Judge Albright’s departure makes speculation even less appropriate. No successor judge has been identified, and that judge may be more receptive to a stay as a case-management tool, particularly upon inheriting Judge Albright’s patent docket. Factor 1 is therefore neutral or weighs against discretionary denial.

2. Factor 2: The Scheduled Trial Date Cannot Hold and Weighs Strongly Against Discretionary Denial

Factor 2 weighs strongly against discretionary denial. Judge Albright scheduled trial for April 26, 2027, but will leave the bench in August 2026—eight months earlier—and no case-specific transition plan exists. (EX2005; EX1018.) The scheduled trial date therefore provides no reliable basis for denying institution.

A successor judge will need to assume this case; learn the record and technology; manage inherited docket conflicts; and decide whether to keep,

modify, or vacate the existing schedule. That transition may require new briefing, hearings, and other procedures that are likely to delay or reset portions of the case. Indeed, Judge Albright has already vacated hearings, conferences, and trial dates in other patent cases because of the potential for future conflicts. (*See* EX1019, 1.)

Even before Judge Albright’s departure, his patent trial dates were susceptible to slippage, given his heavy caseload. *See Motion Offense, LLC v. Google LLC*, No. 6:21-cv-00514-ADA, ECF No. 68 (W.D. Tex. June 10, 2022); *IOENGINE, LLC v. Roku Inc.*, No. 6:21-cv-01296-ADA, ECF No. 306 (W.D. Tex. Sept. 19, 2023). The Board has recognized this reality and declined discretionary denial where “time-to-trial statistics suggest[ed] that the trial will not begin until” after the expected Final Written Decision—even though Judge Albright had scheduled trial six months before that date. *ClearCorrect Operating, LLC v. Align Tech., Inc.*, IPR2025-00814, Paper 14, 2 (Aug. 29, 2025).

This case is stronger than *ClearCorrect*. Here, the scheduled trial date is only four months before the projected Final Written Decision and is unlikely to hold. Judge Albright’s median time to trial expanded to 43 months in 2025. (EX1020.) Applying that median here places trial in January 2029—well after the Board’s expected August 2027 Final Written Decision. (*See* March 24, 2025, USPTO Memorandum, 3 (describing median time-to-trial statistics as a *Fintiv* consideration).) Judge Albright’s departure only increases the likelihood of delay.

The contrast is stark: the district court schedule is uncertain, while the Board’s timeline is fixed by statute. Institution would provide the parties, the district court, and the public a stable and efficient path to resolving the patentability. Factor 2 therefore weighs heavily against discretionary denial.

3. Factor 3: The Investment in Parallel Proceeding Weighs Against Discretionary Denial

The parties and court have not invested enough in the litigation to justify discretionary denial. Although preliminary contentions have been exchanged and the court has issued a claim-construction order, fact discovery just opened in April 2026, and the most significant events remain ahead. Expert reports, the close of discovery, depositions, dispositive motions, pretrial disclosures, and trial are all scheduled after Judge Albright’s departure in August. (EX2005; EX2020.)

This factor weighs against exercising discretion to deny institution where “much more work remains [in the litigation], including, expert reports, expert discovery, expert depositions, and pretrial motions and disclosures.” *See Bio-Rad Lab’s, Inc. v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11, 10 (Mar. 27, 2025). Because the most substantive invalidity work remains ahead—and may be delayed indefinitely by judicial reassignment—Factor 3 weighs against denial.

4. Factor 4: The Overlap Between the Petition and Parallel Proceeding Weighs Strongly Against Discretionary Denial Because Apple Agreed to a *Sotera* Stipulation

This factor weighs strongly against discretionary denial. Apple entered a

Sotera stipulation to limit the potential overlap between this proceeding and the parallel litigation. (Paper 6.) 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, 9.) But Patent Owner can only point to three references (Jannard, Zadesky, Irvin) from Apple’s preliminary invalidity contentions, out of dozens cited in those contentions, that are also found in the ’901 Petition. (Request, 9.) In the district court, under the stipulation, those references would at most play a secondary role in combination with system prior art (*e.g.*, Jabra FreeSpeak) that could not have been raised in the IPR and does not correspond to any of the Petition’s prior art. (EX2006, 89-100.)

That limited use does not show any attempt to avoid estoppel. Apple’s *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); *see also Liberty Energy Servs., LLC v. U.S. Well Servs., LLC*, IPR2025-00139, Paper 14, 13-14 (June 11, 2025).

5. Factor 5: Whether the Parties Are the Same Is Neutral

The parties before the Board in this proceeding and in the parallel district court litigation are the same. But that fact does not support denial where, as here, the other *Fintiv* considerations favor institution. Where the parties are identical,

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. Supported closely by expert testimony, the Petition demonstrates that all claims are obvious over multiple grounds based on prior art not presented or considered during prosecution.

Patent Owner incorrectly asserts, without any support, that the Petition “does not address” limitations requiring components “at least partially contained within the head-worn structure”, such as the wireless communication circuitry recited in claim 1[G]. (Request, 10-11.) The Petition specifically addresses those limitations with citations to the prior art and expert testimony. (*See, e.g.*, Pet., 9-23, 28-29, 31-32, 57-61, 66-76, 82-83, 91-94.) For claim 1[G], for example, the Petition explains that Jannard’s audio device is a head-worn structure with a data port that includes the wireless communication circuitry. (Pet., 10-12, 19-20.) Patent Owner repeats the same attorney argument for two dozen more claim elements, each time ignoring the Petition’s actual mapping. That does not reveal a merits weakness; it underscores the Petition’s detailed, evidence-based showing of unpatentability.

Judge Albright’s departure is also an “other circumstance[]” bearing on the *Fintiv* analysis. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 14-16 (Mar.

20, 2020) (precedential). Any district-court efficiency is compromised because the presiding judge will leave before trial, no successor judge is known, and the future schedule is unsettled. That uncertainty is compounded by the scope of the litigation, which involves six patents and hundreds of asserted claims. Because the Petition challenges all asserted claims of the '901 patent and presents strong unpatentability grounds, Board review can materially streamline the litigation.

On balance, the *Fintiv* factors weigh against discretionary denial. No factor supports denial on this record. Discretionary denial is therefore unwarranted. *See CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00289, Paper 7, 17 (July 21, 2023).

E. Apple Does Not Present Inconsistent Claim Constructions

Patent Owner's claim construction argument fails because Apple has not taken inconsistent positions. In *Revvo*, the Director explained that when a petitioner advances "alternative positions" before the Board and the district court, it should explain why those positions are warranted. *Revvo Techs., Inc. v. Cerebrum Sensor Techs. Inc.*, IPR2025-00632, Paper 20, 3-4 (Nov. 3, 2025) ("*Revvo*") (precedential). That concern is absent here.

For the '901 patent, Apple proposed that the district court construe "head-worn personal electronic apparatus" as "electronic eyewear or headwear"; and a speaker "proximate to an ear of the user" as a speaker "near an ear of the user." (EX2011, 1-2.) The court adopted Apple's "electronic eyewear or headwear"

construction, and confirmed on the record that “proximate” means “near” but excludes standalone in-ear devices. (EX2020; EX1029, 56:22-59:11.) Patent Owner did not argue Apple’s constructions were too broad. It argued the opposite: that the claims encompass devices worn on “any part of the head” and speakers positioned “at, near, or at least partially within the ear.” (EX1013, 8-10, 14-16.)

The Petition is consistent with Apple’s asserted district court position. *See Terumo BCT Inc. v. Haemonetics Corp.*, IPR2025-01374, Paper 20, 3-4 (May 12, 2026) (informative). It applies prior art satisfying the district court’s constructions and the undisputed claim scope. For example, the Petition explains that Jannard’s audio device is a “head-worn personal electronic apparatus” because it is electronic “eyewear,” and that its speakers are “proximate to” the ears because they are positioned “near the ears.” (Pet., 10-14.) Thus, the Petition does not rely on a broader or different construction than Apple advanced in the district court.

The Board need only construe claim terms when necessary to resolve the controversy. *Realtime Data LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019). Because the prior art meets the challenged limitations under Apple’s constructions, Patent Owner’s broader view, and any reasonable interpretation, no construction is needed. Apple’s IPR and district court positions thus agree—confirming no “gamesmanship” and providing “greater predictability and certainty.” *Revvo*, 2-5.

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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:

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