

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner

v.

iSCAN2D TECHNOLOGIES, LLC

Patent Owner

Case IPR2026-00316

U.S. Patent No. 11,664,123

**PATENT OWNER'S BRIEF REQUESTING DISCRETIONARY DENIAL
UNDER 35 U.S.C. § 325(d)**

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<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG</i> , IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (“ <i>Becton, Dickinson</i> ”).....	<i>passim</i>
<i>SAS Institute Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018)	16

LIST OF EXHIBITS

Exhibit No.	Description
2001	U.S. Patent Application Publication No. US 2008/0300109 to Karkanias et al.
2002	U.S. Patent Application Publication No. US 2007/0033068 to Rao et al.

I. INTRODUCTION

Pursuant to 35 U.S.C. § 325(d) and the USPTO's Interim Processes for PTAB Workload Management (Mar. 26, 2025), Patent Owner iScan2D Technologies, LLC respectfully requests that the Director exercise discretion to deny institution of IPR2026-00316. This brief is timely filed within two months of the Notice of Filing Date Accorded entered May 26, 2026. It addresses discretionary denial under § 325(d) only and does not waive, and is without prejudice to, the arguments Patent Owner will present in its Preliminary Response.

The Petition should be denied because it asks the Office to reconsider the very prior art and the very argument the Examiner already considered and rejected as a basis for withholding allowance. Each challenged ground is built from two interchangeable building blocks: a reference that displays a barcode encoding pairing data (Bishop or Brown), and a reference disclosing a wearable physiological/activity monitor (LeBoeuf or Weiss); Ground 4B adds Ort to supply a color (HCCB) barcode.

However, the Office already had those teachings before it. During prosecution of the '123 patent, the Examiner rejected the claims over Karkanias — a single reference combining the barcode-generation-and-display and wireless-

activity-communication teachings the Petition assembles from separate references (Bishop/Brown and LeBoeuf/Weiss) — and over barcode-encryption art (Arguello), and allowed them only after the Applicant added the “color coded,” “wireless pairing information,” and integrated data-communication limitations. EX1002, pp. 0120-0130, 0160-0162. Brown and Rao were also of record on the Applicant's IDS and considered. EX1002, pp. 0237-0238. In the related '394 application, the same Examiner made her consideration explicit, recognizing that Brown (US 2011/0081860) “teaches performing Bluetooth pairing between two devices where a first device generates a barcode that encodes the Bluetooth pairing data that is scanned using a camera as a barcode scanner,” and that “[t]he prior art teaches encoding pairing information as color information.” EX1034, p. 185.

Rao (US 2007/0033068), of record, further discloses a wearable, wireless heart-rate sensor that communicates a user's physiological data. The Examiner nonetheless allowed the claims, explaining that the prior art failed to teach or fairly suggest the claimed invention as a whole — in particular, the integrated use of such a barcode-established link to communicate the wearable's activity and biometric data. EX1034, pp. 182-185. The Petition identifies no error in that

determination. It simply relabels the same teachings under new reference names and asks for a different result. That is precisely what § 325(d) forecloses.

II. LEGAL STANDARD

Section 325(d) authorizes the Office to deny institution where “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The Board applies the two-part framework of *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential): (1) whether the same or substantially the same art or arguments previously were presented to the Office; and (2) if so, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims.

The framework is informed by the non-exclusive *Becton, Dickinson* factors: (a) the similarities and material differences between the asserted art and the art involved during examination; (b) the cumulative nature of the asserted art and the art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether it was the basis for a rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which the petitioner relies on the prior art; (e) whether the petitioner

has pointed out sufficiently how the Examiner erred; and (f) the extent to which additional evidence and facts warrant reconsideration. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (precedential in relevant part). Factors (a), (b), and (d) bear on part one; factors (c), (e), and (f) bear on part two. *Advanced Bionics*, Paper 6 at 9-11.

III. BACKGROUND

A. The '123 Patent

The '123 patent (to McKirdy) is directed to a wearable activity device that generates and displays a “color coded digital scannable media” encoding wireless pairing information; a mobile device scans and decodes that media to establish a wireless communications link, over which the wearable then communicates its activity-tracking and/or biometric data. Independent claim 1 recites the device; independent claim 11 recites a corresponding method.

B. The Prosecution History

The application that led to the '123 patent (App. No. 17/181,423) was filed February 22, 2021. In a Non-Final Rejection dated September 10, 2021, the Examiner rejected all pending claims (then directed to an “exercise device”). She rejected claims 1-5, 7-9, 11-15, and 17-19 under 35 U.S.C. § 102(a)(2) as

anticipated by Karkanias (US 2008/0300109) — mapping the claimed generation and display of a scannable barcode, and its use to establish a link with a mobile device, onto Karkanias's disclosure of an exercise apparatus that generates a barcode that encodes activity information and transfers it to a mobile device. She rejected claims 6 and 16 under § 103 over Karkanias in view of Arguello (US 2011/0210170) for encrypting the data encoded in the barcode, and claims 10 and 20 over Karkanias in view of Hakki (US 2008/0032864). EX1002, 0120-0131 (Non-Final Rejection, mailed Sept. 10, 2021).

To overcome those rejections, the Applicant amended the claims to add, *inter alia*, that the scannable media be a “color coded digital scannable media” generated “responsive to the wireless pairing information,” and that the device “communicate ... the activity tracking information [or] bio-metric information to the mobile device.” The Examiner then allowed the claims. In her Statement of Reasons for Allowance, the Examiner explained that “[t]he prior art of record fails to teach or fairly suggest ... in conjunction with all the other limitations of the claims” a device that generates “a color coded digital scannable media image responsive to the wireless pairing information,” establishes the link “responsive to the mobile device scanning and decoding the color coded displayed digital

scannable media,” and then communicates the “activity tracking information [or] bio-metric information to the mobile device.” EX1002, 0160-0162 (Notice of Allowability, Statement of Reasons for Allowance).

Brown (US 2011/0081860) and Rao (US 2007/0033068) were both listed on the Applicant's Information Disclosure Statement and considered by the Examiner during prosecution of the '123 patent. EX1002, pp. 0237-0238 (List of References Cited by Applicant and Considered by Examiner). The record leaves no doubt that the Examiner in fact considered Brown: the Applicant submitted Brown in an Information Disclosure Statement filed December 19, 2022 — after a Notice of Allowance had already issued — concurrently with a Request for Continued Examination for the express purpose of having that IDS considered. EX1002, pp. 0207-0211. The Examiner did consider it, signing the List of References Cited by Applicant and Considered by Examiner and issuing a further Notice of Allowance on January 23, 2023. EX1002, pp. 0217-0225, 0237-0238. The Office thus affirmatively considered Brown in the very course of allowing the '123 claims.

In the application that led to the related '394 patent in the same family, the same Examiner made her consideration of this art explicit — identifying Brown as teaching camera-scanned, barcode-encoded Bluetooth pairing; identifying Yang

(US 2009/0176451)¹ as teaching the encoding of pairing information as color; and identifying Rao as teaching barcode/RFID-based fitness identification — while allowing for the same reason. EX1034, pp. 177-89. Rao further discloses a person wearing a “wireless enabled wrist sensor 314” that measures heart rate and is “configured to ... wirelessly ... communicate physiological information directly to one or more servers” — i.e., a wearable, wireless physiological/activity monitor that transmits a user's biometric data. EX2002 (Rao) at FIG. 3, ¶¶ [0061].

C. The Asserted Grounds Rely on the Same Building Blocks

The Petition asserts the following grounds:

- **Ground 1** — Bishop in view of LeBoeuf (claims 1-5, 7-15, 17-20);
- **Ground 2** — Bishop-LeBoeuf further in view of Williams (claims 6, 16);
- **Ground 3** — Bishop-LeBoeuf further in view of Kovitz (claims 7-8, 17-18);
- **Ground 4A** — Brown in view of Weiss (claims 1-5, 9-15, 19-20);
- **Ground 4B** — Brown-Weiss further in view of Ort (claims 1-5, 9-15, 19-20);

¹Yang was cited by the Examiner only in the Statement of Reasons for Allowance in the application that led to the '394 patent; it does not appear on any Information Disclosure Statement in this family, and no PTO-892 (Notice of References Cited) issued. The Examiner's Information Disclosure Statement separately lists “Yach” (David Paul Yach, U.S. App. No. 12/810,445) — a different reference that should not be confused with Yang.

- **Grounds 5A & 5B** — Brown-Weiss and Brown-Weiss-Ort further in view of Williams (claims 6, 16);
- **Grounds 6A & 6B** — Brown-Weiss and Brown-Weiss-Ort further in view of Kovitz (claims 7-8, 17-18).

Petitioner construes “color coded” as “having color other than black-white that encodes data,” and relies on the same declarant, Dr. Prashant Shenoy (EX1003), throughout. Every ground is built from the same two building blocks — a reference that displays a barcode encoding pairing data and a reference disclosing a wearable physiological/activity monitor — and the grounds directed to the dependent claims add only further barcode-pairing references (Williams and Kovitz) for narrow, conventional features, as addressed in § IV.B below.

IV. ARGUMENT

Both prongs of *Advanced Bionics* are satisfied, and the *Becton, Dickinson* factors weigh decisively in favor of denial.

A. Part One: The Same or Substantially the Same Art and Arguments Were Previously Presented to the Office

- 1. The office already rejected these claims over Karkanias — a single reference combining both building blocks the Petition assembles from two.**

The most striking confirmation that the Office already weighed the Petition's theory is that it rejected these very claims over a single reference embodying both of the building blocks the Petition now assembles from two references each. In a Non-Final Rejection dated September 10, 2021, the Examiner rejected the independent claims under 35 U.S.C. § 102 over Karkanias (US 2008/0300109) — a “Physical Activity Manager” that (i) compresses “activity information into an identifying indicia (e.g., two dimensional barcode)” that is “rendered (e.g., printed, displayed, transmitted)” and that a “mobile device (e.g., cell phone) can be employed to scan,” and (ii) communicates that activity information “wirelessly.” EX2001 (Karkanias), Abstract, ¶ 51; EX1002, 0120-0131. Karkanias thus discloses, in one reference, both the generation and display of a scannable barcode read by a mobile device — the teaching the Petition draws from Bishop and Brown — and the wireless communication of a user's activity information — the teaching it draws from LeBoeuf and Weiss. Karkanias also discloses the use of wearable activity monitors. *See* EX2001, ¶¶ 51 (“haptic brace”), 54 (“haptic braces and/or sensory technologies can be applied to an individual in order to capture activity information”).

That the Office not only had this art, but affirmatively applied it in a rejection, places this case at the core of § 325(d). *See Becton, Dickinson* factor (c) (weighing “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for a rejection”). The Examiner separately rejected the encryption dependent claims (6 and 16) under § 103 over Karkanias in view of Arguello (US 2011/0210170) — the very “encryption” feature the Petition now supplies through Williams (Grounds 2, 5A, 5B). EX1002, 0120-0131. The claims issued only after the Applicant amended them to add the “color coded” media, the “wireless pairing information,” and the integrated data-communication limitations. Patent Owner does not concede that Karkanias teaches the claimed invention — it does not — but that is the point. The Petition's multi-reference combinations are cumulative of a single reference the Office already evaluated to the point of rejection and then allowed the claims over. Bishop and Brown are cumulative of Karkanias' barcode teaching; LeBoeuf and Weiss are cumulative of its activity-communication teaching; and Williams is cumulative of Arguello. The Office has already performed — and resolved — the very analysis the Petition asks it to repeat.

2. Brown was before the Office and was expressly considered.

Brown is the cornerstone of the Brown-based grounds (Grounds 4A and 4B), and it was indisputably before the Office. Brown was listed on the Applicant's Information Disclosure Statement and considered by the Examiner during prosecution of the '123 patent, EX1002, pp. 0237-0238, and the same Examiner expressly evaluated Brown in the related '394 application, recognizing that Brown “teaches performing Bluetooth pairing between two devices where a first device generates a barcode that encodes the Bluetooth pairing data that is scanned using a camera as a barcode scanner.” EX1034, p. 185. Apple now builds its entire Brown-Weiss(-Ort) theory on that very teaching.

Indeed, Petitioner's own declarant, Dr. Shenoy, underscores Brown's centrality, relying on it throughout — including at EX1003, ¶¶ 88-89 (citing Brown, EX1006, ¶¶ 47, 49) — yet neither the Petition nor Dr. Shenoy so much as acknowledges that Brown was before the Examiner and considered during prosecution of the '123 patent. There is no closer case for “the same ... prior art ... previously ... presented to the Office.” 35 U.S.C. § 325(d).

3. The barcode-pairing and color-pairing teachings of Bishop and Ort are cumulative of art the Office already evaluated.

The Bishop-based ground (Ground 1) rests on Bishop's disclosure of displaying a Microsoft High Capacity Color Barcode (HCCB) that encodes a

device address for a second device to scan and decode in order to establish communications. That is the same teaching the Office already evaluated: barcode-encoded pairing data scanned by a camera (Brown) and encoding pairing information as color (Brown). *See Becton, Dickinson* factors (a)-(b). Bishop was not necessary to put either concept before the Office. Rather, it is cumulative of references the Examiner expressly identified. Likewise, the Ort-based ground (Ground 4B) adds only an HCCB color barcode — the same “encoding pairing information as color” concept the Examiner already had before it via Yang (in the application that led to the related ‘394 patent), and a well-known commercial barcode format. Petitioner's own reliance on Ort is expressly conditional (“to the extent that Brown's color barcode is not color coded as claimed”), confirming that Ort supplies nothing the Office had not already considered. Indeed, Brown itself — which was before the Examiner and considered — expressly refers to a “color barcode” employing “different color combinations” (EX1006, ¶76). Thus, the color-barcode subject matter the Petition emphasizes through Bishop's HCCB and Ort was before the Office through Brown as well.

- 4. The wearable-monitor references (LeBoeuf and Weiss) are cumulative of Rao and Karkanias, which were before the Office.**

The Petition's wearable-monitor references — LeBoeuf (Ground 1) and Weiss (Grounds 4A-4B) — were not themselves before the Examiner, but they are cumulative of Rao and Karkanias, which were. The Petition relies on LeBoeuf and Weiss for nothing more than a wearable device bearing physiological/activity sensors that wirelessly communicates the user's data to a companion device. That precise teaching was before the Examiner in Rao, which was listed on the Applicant's Information Disclosure Statement and considered during prosecution of the '123 Patent, EX1002, p. 0237-0238, and which discloses a “wireless enabled wrist sensor 314” worn by the user that measures heart rate and is “configured to ... wirelessly ... communicate physiological information directly to one or more servers,” in a fitness system that also identifies members by barcode/RFID. EX2002 (Rao) at FIG. 3, ¶¶ [0026], [0061]. In addition, as discussed *supra* in Section IV.A.1., Karkanias also discloses the use of wearable activity monitors. Because LeBoeuf and Weiss are cumulative of Rao and Karkanias, substituting them changes nothing for the § 325(d) analysis. *See Becton, Dickinson* factors (a)-(b).

- 5. The Petition advances the same argument the Examiner already considered and rejected.**

Part one is satisfied not only by overlapping art but by overlapping *arguments*. 35 U.S.C. § 325(d). The Petition's central thesis is that it would have been obvious to combine barcode/color-barcode pairing with a wearable physiological monitor so that the wearable's data is communicated over the resulting link. That is the precise combination the Examiner weighed: the Examiner had before her barcode pairing scanned by a camera (Brown), color-encoded pairing (Brown and Yang ('394 patent)), and a wearable, wireless physiological monitor that communicates a user's biometric data within a barcode-identified fitness system (Rao, Karkanias), and concluded the claims were nonetheless allowable because the prior art did not teach the claimed invention as a whole. *See Becton, Dickinson* factor (d). The overlap between the Petition's argument and the Examiner's evaluation is complete.

B. The Grounds Directed to the Dependent Claims Are Equally Subject to § 325(d)

The Petition's remaining grounds — Grounds 2, 3, 5A, 5B, 6A, and 6B — do not change the § 325(d) analysis. If anything, they reinforce it. Each adds only Williams or Kovitz to a base combination addressed above, and applies that reference solely to a narrow dependent-claim feature.

Williams (US 2010/0012715) is itself a barcode-based Bluetooth-pairing reference. It discloses encoding “wireless pairing information, for example a device address and PIN number” in a displayed barcode image that a second device captures and decodes to establish a Bluetooth connection — materially the same teaching as Brown, which the Examiner expressly cited by name. The Petition invokes Williams (Grounds 2, 5A, 5B) only for the dependent limitation that the pairing information be “encrypted” (claims 6 and 16), and concedes that “encryption was a well-known technique” a POSA “would have readily understood how to implement.” Petition at 43. A cumulative barcode-pairing reference deployed for an admittedly conventional feature presents neither new art nor a new argument that escapes § 325(d). *See Becton, Dickinson* factors (a)-(b).

Kovitz (U.S. 8,823,494) is likewise a barcode-based device-pairing reference. It discloses optically capturing a barcode that encodes “network addresses” and device software/utilization information to “initiate automatic Bluetooth pairing.” EX1021. The Petition invokes Kovitz (Grounds 3, 6A, 6B) only for the dependent limitation that the pairing information comprise “wearable activity device information” (claims 7-8 and 17-18) — and even there contends that Bishop already discloses such information. Petition at 43-46, 78-80. Kovitz is

again cumulative of the barcode-pairing teaching the Office considered and is directed to a peripheral feature.

Critically, none of these tertiary references touches the limitations the Examiner found dispositive — the integrated communication of the wearable's activity/biometric data over the link established by scanning and decoding the displayed color-coded media. They address only encryption and the content of the pairing payload. Because institution is all-or-nothing, *see SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), and because every ground depends on the same base combination that fails § 325(d) and adds only cumulative pairing art for conventional features, the Petition should be denied in its entirety.

C. Part Two: Petitioner Has Not Shown the Office Materially Erred

Because the same or substantially the same art and arguments were presented, the Petition may proceed only if Petitioner demonstrates that the Office erred in a manner material to patentability. *Advanced Bionics*, Paper 6 at 8-9. Petitioner cannot make that showing.

The Examiner's allowance did not rest on any failure to appreciate barcode pairing, camera-based scanning, color encoding, or wearable wireless physiological monitoring. To the contrary, the Examiner expressly recognized each

of those teachings and acknowledged the references that disclose them (Brown, Karkanias and Rao). *See Becton, Dickinson* factor (c). The allowance rested instead on the absence of the claimed invention as an integrated whole: the prior art of record “fail[ed] to teach or fairly suggest ... in conjunction with all the other limitations of the claims” a device that generates a color-coded scannable media responsive to the wireless pairing information and communicates its activity/biometric data over the link established by scanning and decoding that displayed media. EX1002, pp. 0161-0162 [’123 Statement of Reasons for Allowance]; *see also* EX1034, 182-85. Nothing in the Petition identifies an error in that reasoning. The Petition does not contend the Examiner overlooked a reference, misread a disclosure, or misapprehended a teaching. Rather, the Petition contends only that the same teachings, recombined and supplemented with cumulative wearable-monitor and color-barcode references, should yield a different obviousness conclusion. Mere disagreement with the Examiner's ultimate conclusion is not a showing of material error. *See Advanced Bionics*, Paper 6 at 9; *Becton, Dickinson* factors (e)-(f).

Nor does Petitioner present meaningful new evidence warranting reconsideration. *Becton, Dickinson* factor (f). The Petition relies on attorney

argument and the declaration of Dr. Shenoy, which largely restates the Petition and offers conclusory assertions that the necessary modifications were “routine” or a “simple substitution.” Conclusory expert testimony of that kind does not constitute the kind of new technical evidence that justifies a second review of art the Office already considered. *See Becton, Dickinson* factor (f).

D. The *Becton Dickinson* Factors Favor Denial

Factors (a), (b), and (d) favor denial because the asserted art and arguments are cumulative of, and overlap entirely with, the barcode-pairing and color-pairing teachings the Office evaluated (Brown, Karkanias, Rao), together with cumulative wearable-monitor art. Factors (c), (e), and (f) favor denial because the Examiner affirmatively considered and cited the dispositive teachings, articulated a specific reason for allowance, and Petitioner has neither shown how that reasoning was erroneous nor presented new evidence warranting reconsideration. On balance, the factors strongly support discretionary denial.

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion under 35 U.S.C. § 325(d) to deny institution of IPR2026-00316 in its entirety.

Brief in Support of Discretionary Denial

Case IPR2026-00316
U.S. Patent 11,664,123

Date: July 21, 2026

Respectfully submitted,

By: /René A. Vazquez/

René A. Vazquez (Lead Counsel)

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Counsel for Patent Owner

CERTIFICATION OF COMPLIANCE

Pursuant to the Interim Processes for PTAB Workload Management, the undersigned certifies that this **Brief in Support of Discretionary Denial Under 35 U.S.C. § 325(d)** does not exceed the 20-page limit applicable to such briefs, exclusive of the cover page, table of contents, table of authorities, signature block, and certificates.

Dated: July 21, 2026

/René A. Vazquez/
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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on July 21, 2026, a copy of the foregoing **Brief in Support of Discretionary Denial Under 35 U.S.C. § 325(d)** was served by electronic mail on the following:

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