

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 PRELIMINARY RESPONSE
UNDER 35 U.S.C. § 313 AND 37 C.F.R. § 42.107**

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PATENT OWNER'S EXHIBIT LIST

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. § 313 and 37 C.F.R. § 42.107, Patent Owner iScan2D Technologies, LLC submits this Preliminary Response to the Petition for *inter partes* review of U.S. Patent No. 11,664,123 (the “’123 patent”) filed by Apple Inc. This Response is timely filed within three months of the Notice of Filing Date Accorded entered May 26, 2026. For the reasons below, the Petition fails to establish a reasonable likelihood that Petitioner would prevail as to any challenged claim and institution should be denied.

The ’123 patent claims a specific, integrated solution: a wearable activity device that itself generates a “color coded digital scannable media” from its stored wireless pairing information, displays that media, establishes a wireless communications link when a mobile device scans and decodes it, and then communicates the wearable’s own activity-tracking and biometric information to the mobile device over that link. The Petition attacks that invention with combinations that supply, at most, fragments: barcode pairing between general-purpose devices (Bishop, Brown), wearable monitors that communicate over conventional, already-established Bluetooth (LeBoeuf, Weiss), and a color barcode borrowed from a different problem (Ort). No reference, either alone or combined, discloses the claimed device performing the claimed sequence.

Three defects run through every ground. *First*, no asserted reference, and no asserted combination, teaches the claimed invention as an integrated whole: a wearable activity device that generates and displays a color coded digital scannable media responsive to its wireless pairing information, a mobile device that scans and decodes that media to establish the wireless link, and the communication of the wearable's activity/biometric data over the so-established link. That integration was the express basis for allowance. *Second*, the Petition's mappings rest on Petitioner's own concessions and hedges ("to the extent" qualifiers, "at the very least" fallbacks, and conceded gaps) that confirm the missing limitations are supplied by attorney argument rather than prior-art teaching. *Third*, the asserted motivations to combine are hindsight constructs that no rational person of ordinary skill would have pursued. Specifically, the wearable references already used conventional Bluetooth, with simple, standardized pairing, and the Petition offers no evidence-based reason to burden a miniaturized wearable with a camera-scannable color-coded pairing media display to solve a problem that was already solved.

Separately, Patent Owner has requested discretionary denial under 35 U.S.C. § 325(d) in its Brief Requesting Discretionary Denial filed July 21, 2026, which is incorporated herein by reference. The present Response addresses the merits and does not repeat that discretionary briefing, although the prosecution history

discussed below independently confirms that the Office has already considered, and found insufficient, prior art of the same character as that asserted here.

II. BACKGROUND

A. The '123 Patent and the Claimed Invention

The '123 patent issued May 31, 2023, from Application No. 17/181,423. Independent claim 1 recites a “wearable activity device” comprising a display device; at least one of an accelerometer configured to track activity and an embedded bio-metric monitoring sensor; wireless communication circuitry; at least one processor; and a memory device configured to store wireless pairing information. The processor software must: obtain the wireless pairing information from the memory device; “generate a color coded digital scannable media responsive to the wireless pairing information”; control the display device to display that media; “establish, via the wireless communication circuitry, the wireless communications link with the mobile device responsive to the mobile device scanning and decoding the color coded displayed digital scannable media”; generate at least one of activity tracking information and bio-metric information; and “communicate, via the wireless communications link,” that information to the mobile device. Independent claim 11 recites the corresponding method.

The claims thus recite a causal, ordered integration: the color-coded media is generated from the device's own pairing information; the wireless link comes into being responsive to the mobile device's scanning and decoding of that displayed media; and the wearable's own sensor data then travels over that link. Each challenged ground fails to teach that integration.

B. The Prosecution History Confirms the Point of Novelty

The Examiner (Kristy A. Haupt, Art Unit 2876) did not allow these claims lightly. In a Non-Final Rejection dated September 10, 2021, she rejected all then-pending claims, including under 35 U.S.C. § 102 over Karkanias (US 2008/0300109), a Microsoft "Physical Activity Manager" that compresses "activity information into an identifying indicia (e.g., two dimensional barcode) that can be processed (e.g., [s]canned) by a wide array of devices (e.g., mobile phone, personal data assistant)," EX2001, Abstract; generates the "indicia (e.g., barcode)" and "render[s]" it "(e.g., printed, displayed, transmitted)," *id.*, ¶ 56; has "a mobile device (e.g., cell phone) ... employed to scan a barcode," *id.*, ¶ 51; generates a barcode "which incorporates the activity (and physiological) information" and "automatically transfer[s]" that information "into the individual's mobile device (e.g., cell phone, smartphone, personal digital assistant)," *id.*, ¶ 65, "using most any wired or wireless protocol (e.g., Bluetooth, infrared, Wi-Fi)," *id.*, ¶ 77; and discloses

wearable activity and physiological monitoring (“haptic braces and/or sensory technologies ... applied to an individual in order to capture the activity information”), *id.*, ¶ 53, and individuals “equipped with physiological sensors,” *id.*, ¶ 64. These are the disclosures the Examiner expressly relied upon, citing Karkanias ¶¶ 31, 40, 56, 64-66, and 77 and Figs. 3-5 (steps 308, 402, 512, 514, 516). EX1002, 0120-0131. She separately rejected the encryption dependent claims (6, 16) over Karkanias in view of Arguello (US 2011/0210170). EX1002, 0120-0131.

The Applicant overcame those rejections by amending the claims to require the “color coded digital scannable media” generated “responsive to the wireless pairing information” and the communication of the wearable’s activity/biometric data over the so-established link. The Examiner then allowed the claims, stating that the prior art “fails to teach or fairly suggest ... in conjunction with all the other limitations of the claims” a device performing that integrated sequence. EX1002, 0160-0162. Brown (US 2011/0081860) and Rao (US 2007/0033068) were before the Examiner on the Applicant’s Information Disclosure Statement. The Applicant filed a Request for Continued Examination on December 19, 2022, for the express purpose of having Brown considered, and the Examiner considered it and again allowed the claims. EX1002, 0207-0211, 0217-0225, 0237-0238.

Patent Owner does not concede that Karkanias teaches any claim limitation. The significance of this history for the merits is comparative: the Office examined a

single reference combining a displayed, mobile-scanned barcode, wireless communication of activity data, and wearable activity monitoring (more of the asserted combination than any single reference Apple now advances) and confirmed that the claims are patentable over it. The Petitioner shifts from saying that the reference “teaches” the feature to saying that a POSA would have “understood,” “adapted,” “implemented,” or “substituted” additional functionality. Brown’s generic “color barcode” becomes a color-as-data encoding scheme only through Dr. Shenoy’s interpretation and, alternatively, through a proposed implementation of Ort. Bishop’s network-addressing and communication-initiation process on Communication Network 108 becomes a mechanism for establishing LeBoeuf’s Bluetooth link, and the wearable devices in LeBoeuf and Weiss are supplied with display, barcode-generation, pairing, and related functionality “as necessary.” See, e.g., EX1003, ¶¶84-96, 196-202, 217-221, 263-268. Those shifts do not show that the references themselves disclose the claimed integrated invention. They identify the very modifications for which Petitioner must provide a reasoned, non-hindsight explanation tied to the prior art rather than to the challenged claims.

The Petition’s multi-reference combinations add nothing material beyond what Karkanias already placed before the Office, and they fail for the same reason: none teaches the color-coded pairing media and integrated data communication that distinguished the claims.

C. The Petition

The Petition asserts the following grounds, all under 35 U.S.C. § 103:

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

All grounds rest on the same two building blocks: (1) a reference in which one device displays a barcode that a second device scans to facilitate communications (Bishop or Brown); and (2) a wearable physiological monitor that communicates data over conventional Bluetooth (LeBoeuf or Weiss), supplemented by Ort (for a color barcode), and Williams and Kovitz (for dependent-claim features). The Petition relies throughout on the declaration of Dr. Prashant Shenoy (EX1003).

III. CLAIM CONSTRUCTION

Claim terms are given their plain and ordinary meaning in light of the specification and prosecution history. Petitioner proposes that “color coded” means “having color other than ‘black-white’ that encodes data.” Pet. 4. For purposes of this Response, Patent Owner applies Petitioner’s construction, under which color itself must encode data (a colored rendering of an otherwise black-and-white symbology does not suffice). As shown below, the Brown-based grounds fail even under Petitioner’s own construction. No other term requires express construction to resolve this Response, and no genuine construction dispute is presented.

IV. LEVEL OF ORDINARY SKILL

For purposes of this Response only, Patent Owner does not contest Petitioner’s articulation of the level of ordinary skill in the art. The Petition fails under its own definition.

V. LEGAL STANDARDS

Institution requires “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged.” 35 U.S.C. § 314(a). The burden is on the petitioner, and the petition must identify with particularity where each limitation is taught and articulate a reasoned motivation to combine. *Harmonic*, 815 F.3d at 1363; 37 C.F.R. § 42.104(b). Obviousness requires more than showing that each element existed somewhere in the prior art: the petitioner must show a reason

a person of ordinary skill would have combined the references as claimed, with a reasonable expectation of success, without using the claims as a roadmap. *KSR*, 550 U.S. at 418, 421; *Personal Web*, 848 F.3d at 993-94; *In re NuVasive*, 842 F.3d at 1381-85. Conclusory expert testimony that merely repeats the petition's attorney argument is entitled to little or no weight. 37 C.F.R. § 42.65(a); *Xerox v. Bytemark*, IPR2022-00624, Paper 9 at 15-16 (precedential); *TQ Delta*, 942 F.3d at 1358-59; *ActiveVideo*, 694 F.3d at 1327-28.

VI. ARGUMENT

A. No Ground Supplies the Integrated Invention the Examiner Found Missing — and the Office Has Already Found Richer Art Insufficient

Every challenged claim requires the integrated sequence described above, and no asserted reference performs it. Bishop pairs two general-purpose computing devices and says nothing about a wearable, its sensors, or communicating activity or biometric data. Brown pairs two ordinary Bluetooth devices and likewise says nothing about wearables or biometric data. LeBoeuf and Weiss disclose wearable monitors that communicate over conventional Bluetooth, and the Petition concedes that “LeBoeuf does not teach how to establish such wireless connection,” Pet. 10, and that Weiss “does not teach how to establish this Bluetooth link,” Pet. 49. Ort concerns joining a group communication session. The claimed device that generates a color-coded pairing media, displays it, is paired by the scan, and then transmits its

own activity/biometric data over the resulting link appears nowhere. Rather, it is assembled only in the Petition, from the claims themselves.

The prosecution history independently confirms that combinations of this character do not render the claims obvious. The Office examined Karkanias (one reference that combined a displayed, mobile-scanned activity barcode, wireless communication of activity information, and wearable activity monitors, EX2001, Abstract, ¶¶ 51, 54), rejected the claims over it, and then allowed the claims when the distinguishing limitations were added. EX1002, 0120-0131, 0160-0162. Petitioner's combinations disaggregate the same building blocks across multiple references without supplying what Karkanias lacked. If Bishop-LeBoeuf or Brown-Weiss(-Ort) added anything beyond Karkanias, it would have to be the color-coded pairing media generated responsive to the wireless pairing information and the integrated data communication. As shown below, they do not.

Patent Owner does not concede that Karkanias teaches any limitation of the claims. Rather, the point is comparative. A petition that recombines art no closer to the claims than the art the Office already applied and resolved cannot carry the § 314(a) burden, particularly where the petition never engages the Examiner's stated reasons for allowance. See *Magnum Oil*, 829 F.3d at 1380-81 (the burden lies with petitioner). Further, the Petition completely ignores that fact that the Applicant filed a Request for Continued Examination on December 19, 2022, for the express

purpose of having the Brown reference considered, and the Examiner considered it and again allowed the claims. EX1002, 0207-0211, 0217-0225, 0237-0238.

B. Ground 1 (Bishop + LeBoeuf) Fails as to Every Challenged Claim

1. The combination does not teach a wearable activity device that generates and displays the color coded digital scannable media.

The Petition maps the claimed wearable to LeBoeuf's sensor module and imports the barcode-pairing functionality from Bishop. But Bishop's roles are inverted relative to the claims: Bishop's barcode-displaying device 102 is a general-purpose computing device, and its scanning device 104 is the camera-bearing mobile device. Pet. 14-27; EX1004, ¶¶ 16-23. The Petition thus asks the Board to find that a person of ordinary skill would take a pairing architecture designed for devices with full-size displays and graft it onto a miniaturized, battery-powered, wrist-worn sensor. The Petition never addresses the physical mismatch. Nor can LeBoeuf supply the display: its "visual monitor," EX1005, ¶ 105, is described for displaying physiological data to the wearer, not for generating and rendering a color-coded, camera-readable pairing symbology. Displaying numeric health data and generating a machine-readable color barcode readable by a phone camera are different functions with different display, resolution, and software requirements. The Petition offers no evidence that LeBoeuf's monitor can perform the latter. The Petition's only bridge is the assertion that the adaptation would be "routine software development" with,

at most, “simple substitution” of components, Pet. 13; EX1003, ¶¶ 86, 95-96 (attorney argument echoed by the declarant, with no supporting analysis). The Petition’s characterization of the proposed combination as a “simple substitution” understates the modifications its own declarant describes. Dr. Shenoy explains that LeBoeuf’s devices would be adapted “as necessary” to implement Bishop’s device-pairing module, screen, image-capture component, processors, memory/storage, image capture and decoding, and communication-initiation functionality. EX1003, ¶¶85-87, 94-96. The relevant question is therefore not whether those individual components were known, but whether the Petition provides a reasoned explanation for why a POSA would have made that coordinated set of changes to LeBoeuf’s wearable to arrive at the claimed system. The Petition does not, and therefore does not carry Petitioner’s burden. 37 C.F.R. § 42.65(a).

2. Bishop does not establish the wireless link “responsive to” the scanning and decoding, as element [1.9] requires.

Element [1.9] requires establishing the wireless communications link “responsive to the mobile device scanning and decoding the color coded displayed digital scannable media.” This is a causal sequence in which the scan begets the link. In Bishop, both devices are already communicatively connected to communication network 108 before any barcode is displayed: the encoded address “identifies device 102 on communication network 108,” and the scanning device’s “communication

initiation request” is transmitted to device 102 over that pre-existing network. EX1004, ¶¶ 17-18, 23-24, 37-44. The scan does not create connectivity. Rather, it conveys an IP address used to send a message across a pre-existing communication network (Bishop's Communication Network 108) that already connects the devices before any color coded digital scannable media is scanned and processed by a mobile device. The Petition papers over this distinction by asserting that in the combined system the link “would be, for instance, a Bluetooth link, as taught by LeBoeuf,” Pet. 27. However, that simply substitutes attorney reconstruction for Bishop's actual architecture. Neither reference teaches the claimed sequence in which the scan of the displayed media is what brings the wireless link into being.

Petitioner's reliance on Bishop's reference to “low-resource devices” does not cure this architectural mismatch or establish that Bishop's pairing architecture was suited for LeBoeuf's wearable biometric monitor. Bishop itself distinguishes between higher-resource computing devices and “low-resource” devices and identifies “low-resource” examples such as traditional set-top boxes and hand-held game consoles. EX1004, ¶15. Bishop does not identify a wrist-worn biometric monitor, physiological sensor module, or comparable wearable device as one of those low-resource embodiments. More importantly, Bishop's low-resource devices remain participants in Bishop's Communication Network 108 architecture. Bishop's encoded address identifies device 102 on Communication Network 108 and enables

other devices on that network to send messages to device 102. EX1004, ¶¶18, 23-24. Thus, Bishop's "low-resource" disclosure concerns available processing and memory resources; it does not show that a self-contained wearable activity device as claimed by the '123 patent can assume Bishop device 102's complete functional role without material modification, and it does not eliminate Bishop's dependence on an operative network path (Bishop's Communication Network 108) before the pairing process is completed. Dr. Shenoy likewise explains that Bishop's address varies based on the protocol used by Communication Network 108 and then separately reasons that Bishop's process could be adapted to Bluetooth because Bluetooth also uses a "pairing" process. EX1003, ¶¶88-90. Bishop does not teach that the optical scan itself bootstraps a previously unestablished wearable-to-mobile Bluetooth link. Petitioner must still explain why a POSA would have selected LeBoeuf's particular wearable sensor architecture for this transformation and converted Bishop's network-addressing and communication-initiation architecture into the mechanism for establishing LeBoeuf's Bluetooth link responsive to the scan, as the claims require.

3. Claim 5 is not taught under either of its alternatives.

Claim 5 requires that the wireless pairing information be "at least one of a MAC address identifier associated with the wireless communication circuitry and an identification identifier associated with the wearable activity device." Bishop

encodes an IP address “or other address depending on the protocol used by communication network 108.” EX1004, ¶¶ 23-24. That is not a MAC address associated with the wireless communication circuitry; and as an address assigned for network routing, it is not an “identification identifier associated with the wearable activity device” under the claim’s second alternative as properly read in light of the specification. The Petition’s answer is that a person of ordinary skill “would have understood, or at least found it obvious,” to use a Bluetooth or MAC address instead, Pet. 20; EX1003, ¶¶ 113-15 — a protocol-level redesign of Bishop’s network-address pairing recast as an assumption, supported only by the declarant’s say-so.

4. The asserted motivation to combine is hindsight, and the expectation of success is unsupported.

The Petition’s motivation (an “intuitive, user-friendly” and “secure” pairing process, Pet. 10-12) does not withstand scrutiny. LeBoeuf’s device already communicates “preferably in an open architecture configuration, such as Bluetooth®,” EX1005, ¶ 101, for which simple, standardized pairing was well established at the relevant time. The Petition never explains why a person of ordinary skill designing a miniaturized wearable sensor would abandon that solved problem in favor of adding a color-coded pairing media display, with its attendant display, power, form-factor, and software costs, merely to accomplish device pairing. The combination makes sense only with the ’123 claims in hand: LeBoeuf is selected for

the wearable-and-biometric-data elements, Bishop for the barcode-pairing elements, and the two are fused precisely at the seam the claims define. That is the roadmap KSR forbids. 550 U.S. at 421; *Personal Web*, 848 F.3d at 993-94. Further, the Petition identifies no evidence that the modified wearable would work, e.g., no analysis of whether a wearable-scale display can render, or a phone camera reliably decode, an HCCB. The “reasonable expectation of success” showing consists of the word “predictable.” That is insufficient. *ActiveVideo*, 694 F.3d at 1327-28.

C. Ground 4A (Brown + Weiss) Fails as to Every Challenged Claim

1. Brown-Weiss does not teach the “color coded digital scannable media” under Petitioner’s own construction.

Under Petitioner’s construction, color itself must encode data. Brown’s disclosure is a conventional barcode (a QR code or Datamatrix) that encodes data in black-and-white modules. EX1006, ¶¶ 36, 75-76. Brown’s single reference to a “color barcode” employing “different color combinations,” EX1006, ¶ 76, does not describe using color to encode distinct data values. Rather, the Petition supplies that meaning through Dr. Shenoy’s hypothetical that “a first color (e.g., blue) would ... represent a first value (e.g., ‘1’),” EX1003, ¶ 219, a reading found nowhere in Brown. The Petition then contends Brown “encompasses” the HCCB because HCCB is a well-known example of a color barcode. EX1003, ¶¶ 219-20. Brown nowhere mentions, cites, or suggests HCCB or any multi-color encoding scheme.

Indeed, the only path from Brown's generic phrase to a four-color, high-density symbology runs through the '123 claims. That is hindsight reconstruction. *KSR*, 550 U.S. at 421.

The Petition's structure confirms the gap. Its fallback (“[a]t the very least, a POSA would have found it obvious to implement such color-coded barcode ... in Brown,” Pet. 61; EX1003, ¶¶ 220-21) concedes doubt about the primary position. Further, the two positions cannot coexist: if Brown already teaches color coding, no substitution is needed; if it does not, replacing Brown's barcode with an HCCB is a redesign of the encoding mechanism, not the “simple substitution” the Petition labels it. Either way, Ground 4A does not establish the limitation.

2. Petitioner concedes Weiss's wearable may lack the claimed display.

Claim 1 requires the wearable activity device to comprise “a display device” that displays the color-coded media. The Petition's own mapping states: “to the extent Weiss's monitoring device's user interface does not include a display device, it would be adapted to implement such display device.” Pet. 54; EX1003, ¶ 205. That is not a teaching. Rather, it is an admission that the structural element may be absent from the reference relied upon for the wearable, cured only by an “adaptation” imported from Brown's ordinary (non-wearable) Bluetooth device. Adding a display that generates a color-coded pairing media to a wearable sensor designed without

one is not a trivial modification, and the Petition offers no evidence of how this non-trivial modification would be done or that it would succeed. An element conceded to be missing and supplied by unexplained adaptation cannot support institution. *Harmonic*, 815 F.3d at 1363.

3. The integration and motivation failures mirror Ground 1.

As with Ground 1, the Petition concedes Weiss “does not teach how to establish this Bluetooth link,” Pet. 49, and Brown is a generic two-device Bluetooth pairing with no wearable, no sensors, and no biometric data. Neither reference teaches a wearable that generates and transmits its own activity/biometric data over a link established by scanning its displayed color-coded media. The motivation showing fails for the same reasons as Ground 1: Weiss already used conventional Bluetooth; Brown’s asserted benefit for devices with “limited processing power” does not address the display, optics, and power burdens the combination actually imposes on the wearable; and the expectation-of-success showing is the unexamined label “predictable.”

D. Ground 4B (Brown + Weiss + Ort) Fails as to Every Challenged Claim

Ground 4B adds Ort “to the extent that Brown’s color barcode is not *color coded* as claimed.” Pet. 74 (emphasis in original). That conditional is an admission

that Ground 4A likely fails the color limitation. Ground 4B then fails on its own terms.

Ort discloses displaying an HCCB “visual tag” to join devices to a group communication session (a meeting-style, multi-device session), not device-to-device Bluetooth pairing between a wearable and a phone, and not the subsequent communication of the wearable’s biometric data. EX1008, Abstract, ¶¶ 6, 20-23. A person of ordinary skill seeking to pair a wearable biometric monitor with a smartphone had no reason to consult a session-joining system that is described by Ort . The Petition’s only rationale (the “higher data density” of HCCBs) identifies no need in Brown-Weiss, whose pairing payload (a MAC address and PIN) is small, and ignores the color-display and color-accurate-decoding burdens an HCCB imposes on a wearable. The need for a third reference to supply a single claim element, deployed through an expressly conditional ground, is itself evidence of hindsight assembly. Even with Ort, the combination still does not teach the integrated sequence: Ort changes the type of digitally rendered scannable media, not the absence of the claimed wearable-to-mobile data communication over the scan-established link.

E. The Dependent-Claim Grounds (2, 3, 5A/5B, 6A/6B) Fall With the Base Combinations and Add Nothing

Grounds 2, 3, 5A/5B, and 6A/6B depend entirely on the Bishop-LeBoeuf and Brown-Weiss(-Ort) base combinations addressed above and fail with them. Williams is invoked only for the encryption limitation of claims 6 and 16, and the Petition concedes “encryption was a well-known technique” a person of ordinary skill “would have readily understood how to implement,” Pet. 42-43. An admittedly conventional feature that does not cure any defect in the base combinations.

Kovitz is invoked only for the “wearable activity device information” limitations of claims 7-8 and 17-18. Even there, the Petition contends Bishop already discloses the information, Pet. 44-46, confirming Kovitz’s marginality. Neither reference touches the integrated data-communication limitations on which every independent claim stands.

F. The Shenoy Declaration Cannot Fill the Gaps

The Petition’s gap-filling rests on the declaration of Dr. Shenoy (EX1003), which in the critical passages restates the Petition’s attorney argument and appends the labels “routine,” “simple substitution,” and “predictable results” without underlying technical analysis. The Board gives such testimony little or no weight. 37 C.F.R. § 42.65(a); *Xerox v. Bytemark*, Paper 9 at 15-16; *TQ Delta*, 942 F.3d at 1358-59. The deficiency is most evident on the modifications on which every ground depends: adapting a miniaturized, battery-powered wearable to generate and display

a color-coded scannable media that a phone camera can reliably detect and decode. The Petition and declaration offer no dimensions, no display specifications, no power analysis, no scanning-distance or lighting analysis. Indeed, it offers nothing beyond the assertion that it could be done. A petition may not fill claim gaps with an expert's say-so, *Magnum Oil*, 829 F.3d at 1380, and an unsupported assertion cannot carry Petitioner's burden at institution.

G. Discretionary Denial Under § 325(d) Independently Warrants Denial

Patent Owner's Brief Requesting Discretionary Denial under 35 U.S.C. § 325(d), filed July 21, 2026, is incorporated by reference. As set forth there, the same or substantially the same prior art and arguments were previously presented to the Office, and Petitioner has not shown material error. *Advanced Bionics*, Paper 6 at 8-9; *Becton, Dickinson*, Paper 8 at 17-18. Whether or not the Director exercises discretion, the merits deficiencies addressed above independently require denial under § 314(a).

VII. CONCLUSION

For the foregoing reasons, the Petition does not establish a reasonable likelihood that Petitioner would prevail as to any challenged claim of the '123 patent, and Patent Owner respectfully requests that the Board deny institution of IPR2026-00316 in its entirety.

Date: August 26, 2026

Respectfully submitted,

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CERTIFICATION OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(b)(1) and (d), the undersigned certifies that the foregoing Patent Owner's Preliminary Response contains 4,452 words, exclusive of the table of contents, table of authorities, listing of exhibits, certificates, and this certification, as counted by the word-processing system used to prepare it, and therefore complies with the 14,000-word limit of 37 C.F.R. § 42.24(b)(2).

Dated: August 26, 2026

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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 August 26, 2026, a copy of the foregoing **Patent Owner's Preliminary Response** was served by electronic mail on the following:

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