

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 REPLY IN SUPPORT OF ITS BRIEF REQUESTING
DISCRETIONARY DENIAL UNDER 35 U.S.C. § 325(d)**

I. INTRODUCTION

Petitioner asserts that the Examiner's claimed error "was caused by the applicant's post-notice of allowance amendment changing the preamble from 'exercise device' to 'wearable activity device,'" and that two "abbreviated searches caused the Examiner to miss relevant teachings in the prior art." Opp., 4-5. That account cannot be reconciled with Petitioner's own exhibit. Wearable subject matter was expressly claimed months before the amendment Petitioner blames; the Opposition omits an earlier search that was not confined to stationary exercise equipment; prosecution was formally reopened twice under 37 C.F.R. § 1.114; the post-amendment searches were directed to the precise combination Petitioner says was overlooked; and the Examiner issued three separate substantive allowances. Petitioner's causal premise fails.

II. WEARABLE SUBJECT MATTER WAS CLAIMED BEFORE THE AMENDMENT PETITIONER IDENTIFIES AS THE CAUSE

In the amendment filed on March 10, 2022 (before any Notice of Allowance), claim 2 recited that "the exercise machine is at least one of a cardio exercise machine, a wearable activity device, a wearable health monitoring device, and a strength exercise machine." EX1002, 148. Independent claim 1 simultaneously

required “at least one of an accelerometer configured to track activity and an embedded bio-metric monitoring sensor,” together with wireless communication circuitry “configured to establish a wireless communications link with a mobile device.” *Id.*, at 147.

The later amendment filed on September 6, 2022 (EX1002, 179-186) did not introduce wearable subject matter into prosecution. It relocated language already in the claims (claim 2) into the preamble of independent claim 1. *Id.*, 180-181. Petitioner's assertion that this amendment “caused” the Examiner to overlook wearable prior art is therefore unsupportable on the face of EX1002, because the Examiner had been examining claims expressly directed to a wearable activity device and a wearable health monitoring device (with activity and bio-metric sensing) well before she first allowed them.

III. THE OPPOSITION OMITTS THE MAY 19, 2022 SEARCH

Petitioner asserts that the Examiner's “early searches were directed to stationary exercise equipment, using terms such as ‘treadmill,’ ‘rowing,’ ‘elliptical,’ etc.” and that, after the September 6, 2022 Amendment, “the Examiner performed a cursory search directed to ‘wearable[s]’ that lasted a total of 9 minutes, and after another RCE, performed another search that lasted a total of 14 minutes. Opp., 4-5.

However, on May 19, 2022 (before the first allowance, and not mentioned in Petitioner's Opposition) the Examiner ran queries combining "smart\$1 phone," "mobile," "tablet," and "pda" with "bar\$1 code," "barcode," "imag\$4," "scan\$4," "read\$4," and "camera," and with "health" and "monitor." EX1002, 171. The same session ran "(accelerometer AND biometric AND mobile AND device).clm." *Id.*

IV. PROSECUTION WAS REOPENED TWICE, AND EACH REOPENING YIELDED A TARGETED SEARCH AND A SUBSTANTIVE ALLOWANCE

Petitioner's narrative treats the "wearable" amendment as a post-allowance edit followed by cursory review. The record describes a different series of events.

The Examiner first allowed claims 1-20 in response to the March 10, 2022 amendment, finding that the prior art "fails to teach or fairly suggest ... in conjunction with all the other limitations of the claims" the recited device. EX1002, 161-163. Patent Owner then filed a Request for Continued Examination on September 6, 2022, and prosecution was reopened under 37 C.F.R. § 1.114. *Id.*, 192.

The Examiner then searched the amended claims directly. On September 12, 2022 she ran "(wearable WITH (fitness activity)) WITH display AND accelerometer AND biometric AND ((pair pairing paired connect\$3) WITH wireless) AND (mobile ADJ (phone device)) AND ((communicat\$4 transfer\$4 send\$3) WITH

(biometric activity) WITH (mobile ADJ (phone device))).” EX1002, 203-204. That query is the combination Petitioner contends she failed to investigate. She then allowed the claims a second time on substantive grounds on September 19, 2022. *Id.*, 192-195.

Patent Owner then filed a second Request for Continued Examination on December 19, 2022, with an Information Disclosure Statement, and prosecution was again reopened under 37 C.F.R. § 1.114. *Id.*, 222. The Examiner did not rely on her earlier work. She searched again on January 4, 2023, running “(wearable WITH (fitness activity)) WITH display AND accelerometer AND biometric AND ((pair pairing paired connect\$3) WITH wireless).” *Id.*, 233. She then allowed the claims a third time on January 23, 2023. *Id.*, 222-225.

V. THE EXAMINER’S STATED REASONS FOR ALLOWANCE WAS THE CLAIMED COMBINATION

Petitioner supplies its own explanation for the allowance: abbreviated searching. The Examiner supplied her actual reasons for allowance. After the second reopening, she concluded that “[t]he prior art of record fails to provide sufficient teaching or motivation to one of ordinary skill in the art to provide the additionally recited features of these claims in the combinations as claimed.” EX1002, 224. That is a substantive determination about the claimed combination, reached after three

searches, two reopenings, and three allowances. It is not, as Petitioner asserts, a failure to locate wearable devices.

VI. CONCLUSION

Petitioner's single causal assertion (that the applicant's amendment produced the claimed material error) is contradicted by the very exhibit Petitioner cites. Petitioner advanced that explanation as the reason the Examiner erred. Because the record Petitioner cites does not support the explanation, the assertion warrants no weight. For at least the reasons set forth above, Patent Owner respectfully requests that the Director exercise discretion to deny institution.

Date: September 3, 2026

Respectfully submitted,

By: /René A. Vazquez/

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Counsel for Patent Owner

CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on September 3, 2026, a copy of the foregoing **Patent Owner's Reply in Support of its Brief Requesting Discretionary Denial Under 35 U.S.C. § 325(d)** was served by electronic mail on the following:

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