

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner

v.

iSCAN2D TECHNOLOGIES, LLC

Patent Owner

Case IPR2026-00317

U.S. Patent No. 12,230,394

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

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<i>Advanced Avionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) (“ <i>Advanced Bionics</i> ”).....	<i>passim</i>
<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)	14

LIST OF EXHIBITS

Exhibit No.	Description
2001	U.S. Patent Application Publication No. US 2007/0033068 to Rao et al.
2002	File History of U.S. Patent No. 11,664,123
2003	U.S. Patent Application Publication No. US 2008/0300109 to Karkanias 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 IPR2026-00317. 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 3B adds Ort to supply a color (HCCB) barcode.

However, the Office already had those teachings before it. In the Notice of Allowability, the Examiner expressly recognized 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,” that Yang (US 2009/0176451) “teaches encoding pairing information as color information ... to establish wireless communication,” and that Rao (US 2007/0033068) teaches barcode-based identification for exercise machines. EX1002, p. 185-88. 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, and — because the '394 claims are written from the mobile device's perspective — the mobile-side generation of an “optical scanning user interface” to detect the wearable's color-coded media and the receipt and display of that data. 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 '394 Patent

The '394 patent (to McKirdy) claims the same family invention from the mobile device's perspective. Independent claim 1 recites a mobile device with a camera sensor that generates an “optical scanning user interface,” detects a “color coded digital scannable media” displayed by an external wearable activity tracking device, optically obtains and processes the wireless pairing information, establishes a wireless communications link, and then receives and displays the wearable's activity/biometric data. Independent claim 11 recites a system encompassing both the wearable side and the mobile side.

B. The Prosecution History

The '394 patent (Application No. 18/320,937, filed May 19, 2023) was allowed without any rejection. In the Notice of Allowability dated September 5, 2024, the Examiner entered only an Examiner's Amendment correcting claim dependencies and issued a Statement of Reasons for Allowance. EX1002, 181-89.

In the Conclusion section of that statement, the Examiner identified pertinent prior art “made of record and not relied upon,” expressly citing: Brown for camera-scanned, barcode-encoded Bluetooth pairing; Yang (US 2009/0176451) for encoding pairing information as color to establish wireless communication; and

Rao for barcode/RFID-based identification of fitness members to retrieve their exercise programs and workout goals. *Id.* at 185-88. The Examiner concluded these references “are different from applicant's claimed invention in that the prior art fails to teach” the full claimed mobile device and system. *Id.* Brown and Rao were also listed on the Information Disclosure Statement the Examiner considered. *Id.* at 6.

Significantly, Rao discloses more than barcode-based identification: it 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 activity/biometric monitor of the very kind the Petition supplies through LeBoeuf and Weiss. EX2001 at FIG. 3, ¶¶ [0061], [0062].

This examination did not occur in isolation. The '394 patent is a direct continuation of the '123 patent (Application No. 17/181,423) — it shares the '123 patent's specification and was examined by the same Examiner (Kristy A. Haupt). EX1001 ('394 patent), Related U.S. Application Data (“Continuation of application No. 17/181,423 ... now Pat. No. 11,664,123”); EX2002 ('123 patent file history). The prosecution of the parent '123 patent is therefore part of this

family's examination history — including the same Examiner's rejection of the parent claims over Karkanias, addressed in § IV.A.2 below.

C. The Asserted Grounds Rely on the Same Building Blocks

The Petition asserts the following grounds:

- **Ground 1** — Bishop in view of LeBoeuf (claims 1-3, 5-8, 11-14, 16-18);
- **Ground 2** — Bishop-LeBoeuf further in view of Williams (claims 4, 9, 10, 15, 19, 20);
- **Ground 3A** — Brown in view of Weiss (claims 1-8, 11-18);
- **Ground 3B** — Brown-Weiss further in view of Ort (claims 1-8, 11-18);
- **Ground 4B** — Brown-Weiss further in view of Ort (claims 1-5, 9-15, 19-20);
- **Grounds 4A & 4B** — Brown-Weiss and Brown-Weiss-Ort further in view of Williams (claims 9-10, 19-20).

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 a further barcode-pairing reference (Williams) 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. Brown was before the Office and was expressly considered.

Brown is the cornerstone of the Brown-based grounds (Grounds 3A and 3B), and it was squarely before the Examiner. Brown was listed on the Information Disclosure Statement the Examiner considered (EX1002, p. 6), and she did more than merely have it of record — she affirmatively identified and cited Brown by name in the Reasons for Allowance, 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.” EX1002, p. 185. Apple now rests its entire Brown-Weiss(-Ort) theory on that very teaching. Where, as here, the petitioner relies on the precise reference the Examiner cited in allowing the claims, there is no closer case for “the same ...

prior art ... previously ... presented to the Office.” 35 U.S.C. § 325(d). Part one of *Advanced Bionics* is plainly satisfied.

2. The same Examiner already rejected the parent ’123 patent claims over Karkanias — a single reference combining both building blocks the Petition assembles from two.

Because the ’394 patent is a continuation of the ’123 patent — same specification, same Examiner — the Office's examination of the parent application bears directly on § 325(d) here. And in that examination the Office did more than have the Petition's art of record: it rejected the parent 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 parent 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.” EX2003 (Karkanias), Abstract, ¶ 51; EX2002, pp. 248-259, Non-Final Rejection (Sept. 10, 2021). Karkanias thus discloses, in one reference, both the barcode-generation-and-display teaching the Petition draws

from Bishop and Brown and the wireless-communication-of-activity-data teaching it draws from LeBoeuf and Weiss.

The Examiner separately rejected the parent's encryption dependent claims under § 103 over Karkanias in view of Arguello (US 2011/0210170) — the very “encryption” feature the Petition supplies through Williams. EX2002 pp. 248-259. The claims of this family issued only after amendments adding the “color coded” media, the “wireless pairing information,” and the integrated data-communication limitations. *See Becton, Dickinson* factor (c) (weighing whether the asserted art “was the basis for a rejection”). Patent Owner does not concede that Karkanias teaches the '394 claims — it does not, and the '394 claims add mobile-side limitations (a camera and an “optical scanning user interface” that detects the wearable's media and then receives and displays its data) that were not even at issue in the parent rejection. But for § 325(d) the point holds: the Petition's multi-reference combinations are cumulative of a single reference the same Examiner already applied in a rejection within this very family. Bishop and Brown are cumulative of Karkanias' barcode teaching and activity-communication teaching; LeBoeuf and Weiss are cumulative of its activity-communication teaching; and Williams is cumulative of Arguello.

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 (Yang). *See Becton, Dickinson* factors (a)-(b). Bishop was not necessary to put either concept before the Office; it is cumulative of references the Examiner expressly identified. Likewise, the Ort-based ground (Ground 3B) adds only an HCCB color barcode — the same “encoding pairing information as color” concept the Examiner already had before it via Yang, 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). The color-barcode subject matter the Petition

emphasizes through Bishop's HCCB and Ort was therefore before the Office through Brown as well.

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

The Petition's wearable-monitor references — LeBoeuf (Ground 1) and Weiss (Grounds 3A-3B) — were not themselves before the Examiner, but they are cumulative of Rao, which was. 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 '394 Patent, EX1002, p. 6, 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. EX2001 at FIG. 3, ¶¶ [0061], [0062]. Because LeBoeuf and Weiss are cumulative of Rao, 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 (Yang), and a wearable, wireless physiological monitor that communicates a user's biometric data within a barcode-identified fitness system (Rao), 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, 4A and 4B — do not change the § 325(d) analysis. If anything, they reinforce it. Each adds only

Williams 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 only for narrow dependent limitations (including that the pairing information be “encrypted,” claims 19-20), and concedes that “encryption was a well-known technique” a POSA “would have readily understood how to implement.” Petition at 97. 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).

Critically, Williams does not touch the limitations the Examiner found dispositive — a mobile device that generates an optical scanning user interface, detects the wearable's color-coded media, establishes the link, and then receives and displays the wearable's activity/biometric data. Williams is directed only to encrypting and formatting 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 cited the references that disclose them (Brown, Yang, 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 “fails to teach” a mobile device that generates an “optical scanning user interface,” detects via its camera the color-coded media displayed by the external wearable, establishes the link, and then “Receive[s] ... activity related information and bio-

metric information generated by the ... wearable” and “Display[s]” it. EX1002, 185-88. 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, Yang, 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 IPR2026-00317 in its entirety.

Date: July 21, 2026

Respectfully submitted,

By: /René A. Vazquez/

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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

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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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