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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

INGENIOSPEC, LLC,
Patent Owner.

Case No. IPR2026-00332
U.S. Patent No. 11,921,355

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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2002	Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00877, Dkt. No. 1 (W.D. Tex. June 6, 2025)
2003	Order Granting Joint Motion to Consolidate, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 25 (W.D. Tex. Oct. 14, 2025)
2004	Scheduling Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 36 (W.D. Tex. Nov. 17, 2025)
2005	Scheduling Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 39 (W.D. Tex. Dec. 5, 2025)
2006	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) (cover pleading)
2007	RESERVED
2008	RESERVED
2009	RESERVED
2010	RESERVED
2011	Defendant’s Proposed Claim Constructions, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867 (W.D. Tex. Dec. 22, 2025)
2012	RESERVED
2013	RESERVED
2014	RESERVED
2015	Declaration of Peter Tong
2016	RESERVED
2017	RESERVED
2018	Defendant’s Reply Claim Construction Brief, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 52 (W.D. Tex. Feb. 18, 2026)
2019	Apple Inc. Form 10-K Annual Report (Oct. 31, 2025)
2020	Claim Construction Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 69 (W.D. Tex. Apr. 6, 2026)
2021	Exhibit C-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)

I. INTRODUCTION

Because the district court will try all issues involved in this IPR almost six months before a final written decision would issue and because Apple has taken inconsistent positions before the Board and the district court on claim construction, institution of this second-ranked Petition should be denied.

Nearly a year after the parallel district court litigation was filed, Apple now submits two Petitions challenging the '355 Patent. Paper 2 (“Pet.”); IPR2026-00331, Paper 2. From November 2025 to April 2026, Apple filed eight IPR challenges to the six patents asserted in the consolidated litigation, where the district court has set a firm trial date of April 26, 2027, well before the Board’s October 7, 2027 statutory deadline for a final written decision here. EX2005 at 1; EX2001 ¶¶ 20-22; EX2002 ¶¶ 20-22; EX2003 at 1; Pet.; IPR2026-00142, Paper 2; IPR2026-00143, Paper 2; IPR2026-00144, Paper 2; IPR2026-00253, Paper 1; IPR2026-00331, Paper 2; IPR2026-00339, Paper 2; IPR2026-00340, Paper 2. Apple has thus ensured that this IPR will be “in *addition* to, not an *alternative* to, the litigation.” *Magnolia Med. Techs. v. Kurin*, IPR2026-00097, Paper 17 at 4 (P.T.A.B. May 14, 2026) (precedential) (emphases in original). Institution has already been discretionarily denied for the two oldest patents, the '104 and '789 Patents, and Director Review has been requested for the '599 Patent institution decision. *See* IPR2026-00142,

Paper 10 at 1; IPR2026-00144, Paper 9 at 1; IPR2024-00143, Paper 14. The remaining IPRs are awaiting discretionary denial or institution decisions.

As explained below, discretionary denial is also warranted because Apple fails to show this second Petition challenging a single, unasserted claim is necessary. Efficiency and IngenioSpec’s settled expectations counsel heavily in favor of a jury deciding the overlapping patentability challenges presented here. The challenged patents have been licensed, and two of them issued some time ago. Moreover, the parallel district court litigation has been progressing since June 2025, will not be stayed, and is set to resolve all the issues raised in this IPR, and more, almost half a year before the Board’s projected final written decision due date. Apple’s narrow stipulation neither eliminates duplication nor mitigates the inconsistency stemming from Apple’s asserting different claim construction positions in the two forums. The Petition also lacks merit. Institution should be denied.

II. THIS SECOND PETITION CHALLENGING THE ’355 PATENT IS UNNECESSARY AND SHOULD BE DENIED

“Petitioner, not Patent Owner, bears the burden to show that an additional petition is ‘necessary.’” *Micron Tech. v. Yangtze Memory Techs. Co.*, IPR2025-00119, Paper 22 at 10 (P.T.A.B. June 4, 2025) (citing Consol. Trial Practice Guide at 59). Apple fails to meet that burden here. This is the second-ranked Petition filed by Apple challenging the ’355 Patent. *See* Paper 3 at 1. Apple asserts that this

Petition “challenges only a single claim, with the remaining 92 claims challenged in the IPR2026-00331 petition” and that “each ground rel[ies] on the same two primary references.” Paper 3 at 3-4. But that only “raises questions as to why both challenges could not have been made in a single Petition.” *Micron Tech.*, IPR2025-00119, Paper 22 at 9. Challenged dependent Claim 55 is not particularly long and includes only 41 words. *See* EX1001 at 117:9-15. Apple also asserts that “the petitions are limited to only those claims asserted in the parallel litigation,” Paper 3 at 4, but Claim 55 is not asserted in the litigation, *see* EX2006 at 2. Apple’s second-ranked Petition here should be denied as an inefficient use of the Board’s and party resources litigating a redundant petition on an unasserted claim. *See Magnolia Med. Techs.*, IPR2026-00097, Paper 17 at 7 (USPTO given discretion in IPRs to ensure “fairness, efficiency, and predictability in patent disputes”).

III. PATENT OWNER’S SETTLED EXPECTATIONS FAVOR DISCRETIONARY DENIAL

In considering discretion, the Director may address the “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Memorandum, “Interim Processes for PTAB Workload Management,” at 2 (Mar. 26, 2025) (“Interim Processes Memo”). Although the ’355 Patent issued only recently, IngenioSpec has licensed the patent as well as provided actual notice to Apple of the ’355 Patent creating settled expectations despite its recent issuance. Also, the denial

of institution for the parallel '104 and '789 Patent IPRs as well as the likely denial of additional IPRs suggest that institution for the '355 Patent would be an inefficient use of Board resources.

The challenged patents, including the '355 Patent, have been licensed to third parties, supporting IngenioSpec's settled expectations. EX2015 ¶¶ 2-7; *Alliance Laundry Sys. v. PayRange*, IPR2025-00950, Paper 11 at 3 (P.T.A.B. Sept. 19, 2025) (informative) ("settled expectations favoring Patent Owner" where "Patent Owner presents evidence that it has licensed the challenged patent"); *Hisense v. VideoLabs*, IPR2025-00880, Paper 11 at 2 (P.T.A.B. Oct. 10, 2025) (settled expectations where "the challenged patents have been licensed").

IngenioSpec also wrote to Apple on June 21, 2024 notifying Apple of its infringement of the '355 Patent before the parallel litigation was filed, EX2015 ¶ 8, which further "favor[s] discretionary denial," *Hisense*, IPR2025-00880, Paper 11 at 2 ("Patent Owner sent Petitioner a notice letter regarding Patent Owner's patent portfolio.").

Considering that institution for the '104 and '789 Patents has already been denied, and that institution for additional IPRs is also likely to be denied, institution on the '355 Patent would be inefficient. While the '355 Patent at issue here "has not been in force as long as the other patents challenged," because the district court will also be considering the validity of the '355 Patent, *see* EX2006 at 41-59, "referring

[this IPR] to the Board would be an inefficient use of Board resources and tips the balance to discretionary denial as to that patent too.” *Amazon.com v. Audio Pod IP*, IPR2025-00768, Paper 15 at 3 (P.T.A.B. Aug. 14, 2025); *see also Nvidia v. Neural AI*, IPR2025-00606, Paper 18 at 2-3 (P.T.A.B. July 31, 2025) (similar: “inefficient use of Board resources and tips the balance to discretionary denial” for patent that “has not been in force for a significant period of time”).

IngenioSpec’s settled expectations favor discretionary denial so that all validity issues can be efficiently resolved by the district court.

IV. THE *FINTIV* FACTORS SUPPORT DISCRETIONARY DENIAL

The Director should also discretionarily deny institution under 35 U.S.C. § 314(a) because none of the *Fintiv* factors supports proceeding with a trial here. *See Apple v. Fintiv*, IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020) (precedential). A jury deciding the overlapping patentability challenges presented here, as well as additional issues, before any Final Written Decision, strongly favors denial.

1. Factor 1: Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.

Neither party has sought a stay, and there is no evidence that the district court would stay its case if this IPR were instituted. Indeed, even if instituted, Judge Albright rarely stays cases where only a subset of asserted patent claims is subject

to IPR, which would be the case here where Apple’s IPR challenges to two patents have already been denied. *See, e.g., Edge Networking Sys. v. Microsoft*, No. 1:24-cv-00215-ADA, Dkt. 63 at 1-2 (W.D. Tex. Nov. 21, 2025) (denying motion to stay where only a subset of asserted patent claims “are subject to the pending IPR challenge”). Moreover, given the advanced stage of the district court case already and much more so by the time any post-institution motion to stay would be brought, the likelihood of a stay being granted is even more diminished. *See, e.g., Intellectual Ventures v. Hewlett Packard Enterp.*, No. 6:21-cv-00596-ADA, 2022 WL 22870184, at *3 (W.D. Tex. Dec. 22, 2022) (“The advanced stage of the proceedings weighs against granting a stay.”).

Fintiv factor 1 thus favors denial or is neutral. *See, e.g., Samsung Elecs. v. Cerence Operating*, IPR2025-00458, Paper 14 at 2 (P.T.A.B. June 25, 2025) (discretionary denial where “there is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial”); *Full-Metal-Power v. InFocus Downhole Sols.*, IPR2025-00391, Paper 14 at 2 (P.T.A.B. June 25, 2025) (same).

2. Factor 2: The proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.

The co-pending litigation in Texas is scheduled for trial on April 26, 2027, almost *six months before* the October 7, 2027 statutory deadline for a Final Written

Decision in this IPR. EX2005 at 1. The earlier district court trial date tips factor 2 strongly in favor of discretionary denial. *See, e.g., Full-Metal-Power*, IPR2025-00391, Paper 14 at 2 (denying institution where the district court’s scheduled trial date was just a few weeks before the projected final written decision due date); *Cerence Operating*, IPR2025-00458, Paper 14 at 2 (same where trial date was roughly four months before the final written decision deadline); *NXP USA v. Redstone Logics*, IPR2025-00485, Paper 11 at 2 (P.T.A.B. July 10, 2025) (ditto for trial date less than three months before the final written decision).

To the extent Apple argues that “the district court scheduled trial date and the projected final written decision due date are in close proximity,” that further supports “[e]xercising discretion to deny the petition in this case” to “reduce[] the inefficiencies and burdens on the parties to maintain two parallel proceedings.” *Shenzen Tuozhu Tech. v. Stratasyss*, IPR2025-00354, Paper 11 at 2 (P.T.A.B. June 12, 2025). Indeed, by waiting so long to file these IPRs, Apple has confirmed that it wants its IPRs to proceed “in parallel with litigation to gain litigation leverage.” *Magnolia Med. Techs.*, IPR2026-00097, Paper 17 at 3. Further, to the extent Apple speculates that “time-to-trial statistics” could suggest “a district court trial date that occurs after a projected final written decision date,” that also “does not outweigh the efficiencies gained by avoiding parallel proceedings in this instance because of the parties’ meaningful investment in the district court proceeding.” *Advanced Micro*

Devices v. Concurrent Ventures, IPR2025-00223, Paper 9 at 2 (P.T.A.B. June 12, 2025). There is substantial meaningful investment here as discussed for factor 3 below. Finally, to the extent Apple speculates that the district court trial may be delayed due to Judge Albright’s anticipated retirement, that speculation should also be rejected. *See, e.g., Cipla v. Gilead Scis.*, IPR2025-00033, Paper 22 at 10 (P.T.A.B. May 15, 2025) (assertion regarding a “later trial date” is “merely speculative, and we decline to guess what the district court might do”).

3. Factor 3: Investment in the parallel proceeding by the court and the parties.

The co-pending district court case has been moving forward since June 2025. Infringement and invalidity contentions have been exchanged, and the district court has already held a *Markman* hearing and issued a claim construction order. EX2004 at 2-5; EX2005 at 1; EX2020 at 1.

Based on the “meaningful investment in the district court proceeding,” *Fintiv* factor 3 weighs in favor of discretionary denial. *Advanced Micro Devices*, IPR2025-00223, Paper 9 at 2 (denying institution where “the parties have exchanged infringement and invalidity contentions” and “a *Markman* hearing is scheduled to occur before the due date for an institution decision”); *see also NXP*, IPR2025-00485, Paper 11 at 2 (“meaningful investment” where “the district court has held a *Markman* hearing”).

4. Factor 4: Overlap between issues raised in the petition and in the parallel proceeding.

Apple’s invalidity contentions in the district court litigation purport to “incorporate[]... by reference all... *inter partes* review proceedings involving the ’355 Patent.” EX2006 at 48. As a result of that incorporation, Apple challenges the same Claim 55 of the ’355 Patent based on at least the identical Irvin and Anderson references.¹ Compare EX2006 at 42-43, with Pet. at 5-6; see also EX2006 at 2, 48. Thus, “the patentability disputes before the [district court] will resolve all or substantially all of the patentability disputes between the parties.” *SK Innovation v. LG Chem*, IPR2020-00991, Paper 14 at 16 (P.T.A.B. Nov. 30, 2020) (citation omitted); see also *Code200 v. Luminati Networks*, IPR2020-01266, Paper 18 at 10 (P.T.A.B. Dec. 23, 2020) (factor “strongly favors” denial notwithstanding that “the Petition challenges four claims that are not asserted in the Texas Litigation”).

The district court litigation will also resolve issues beyond those in the IPR. Apple’s Petition is confined to whether “Claim 55 is unpatentable... as obvious, in view of the prior art.” Pet. at 5. That issue is subsumed in the co-pending litigation. See, e.g., EX2006 at 41-43, 48. In addition to obviousness under 35 U.S.C. § 103,

¹ Apple also filed a separate Petition challenging Claims 1-54, 57-72, 75-82, 85-92, and 95-100 of the ’355 Patent. See IPR2026-00331, Paper 2 at 5-6.

in the district court litigation, Apple asserts invalidity theories under §§ 101, 102, and 112, including written description and *Alice* challenges at least for independent Claim 17, from which Claim 55 depends. *See* EX2006 at 41-59. As explained in Section V below, Apple’s positions in the district court are inconsistent with those taken in this IPR. Instituting IPR would not simplify the dispute and would instead force the parties and tribunals to litigate in two forums simultaneously over overlapping facts and evidence, risking potentially inconsistent outcomes.

Apple proffers a narrow stipulation, *see* Paper 7 at 1, but its stipulation “does not ensure that these IPR proceedings would be a ‘true alternative’ to the district court proceeding.” *Motorola Sols. v. Stellar*, IPR2024-01205, Paper 19 at 3-4 (P.T.A.B. Mar. 28, 2025) (granting Director Review and denying institution). Apple’s extensive use of the asserted IPR art with other types of art in the district court to avoid estoppel from this IPR and its parallel ’355 Patent IPR renders its limited stipulation meaningless. *See* EX2006 at 43-48 (identifying “prior art apparatuses/systems”); EX2021 at 1-3 (identifying dozens of “Digital Hearing Aids,” “Receivers,” and “Transmitters” that allegedly “would have been obvious to combine... with one or more of” “Anderson,” “Bodley,” “Zadesky,” “Nemirovski,” and “Irvin,” which are EX1010, EX1005, EX1006, EX1007, and EX1009, respectively). Indeed, “Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these

proceedings with unpublished system prior art, which Petitioner’s stipulation” would not moot, at least as to independent Claim 17. *Motorola Sols.*, IPR2024-01205, Paper 19 at 4; *Shenzen Tuozhu*, IPR2025-00354, Paper 11 at 2; *see also* Interim Director Discretionary Process § I.D. (“Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained in an AIA proceeding will be limited.”).

Fintiv factor 4 weighs in favor of denial.

5. Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party.

Factor 5 also supports denial of institution. Apple is both the Petitioner here and the defendant in the parallel Texas litigation.

6. Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits.

The “strength of the unpatentability challenge” may also be considered in deciding whether to exercise discretion to deny institution. Interim Processes Memo at 2. Here, Apple’s facially-deficient Petition supports denying institution.

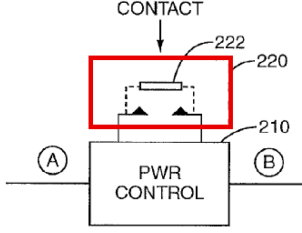
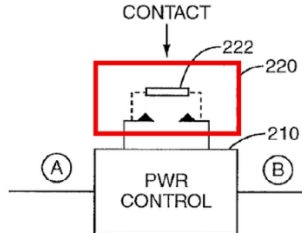
First, the Petition does not address at least one limitation in the sole challenged claim and thus on its face fails to satisfy 37 C.F.R. § 42.104(b)(4), requiring that “[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon” *See* Pet. at 6 (asserting that it has

satisfied the rule). For example, the Petition simply fails to address the Claim 55[A] requirement of a Hall effect detector “at least partially contained within the head-worn personal electronic apparatus.” *See id.* at 37-39. The Petition’s failure to address this requirement at all means Apple cannot sustain its burden on Claim 55, and institution should be denied. *See, e.g., Unified Patents v. SMTM Techs.*, IPR2019-00434, Paper 6 at 19 (P.T.A.B. July 30, 2019) (no reasonable likelihood of success where “Petitioner entirely fails to address [claim] limitation”).

Second, the Petition’s proposed modification of Anderson’s discrete, invisible in-ear hearing aid by attaching Lynch’s large, visible ALD Cap on top of the user’s head along with Anderson’s *remote* processing unit (RPU), *see* Pet. at 30, solves no problem and defeats Anderson’s main goal of providing an earpiece that “is extremely small, can be hidden from view in the ear canal if desired, and allows complete freedom of movement when a primary two-way link to the RPU is used,” EX1010 at 2:32-35. The Petition’s proposed modification boils down to its assertion that “Anderson’s RPU would be worn on the user’s head... via Lynch’s ALD Cap mounted on top of headset 21.” Pet. at 30. This modification “lack[s] rational underpinning” and would make Anderson “unsuitable for its intended purpose”: to create an “extremely small” earpiece that “can be hidden from view in the ear canal” and that “allows complete freedom of movement.” EX1010 at 2:32-35; *Alpinestars v. Dainese*, IPR2025-00750, Paper 17 at 3-4 (P.T.A.B. Feb. 9, 2026) (denying

rehearing request regarding denial of institution: “[W]e determined that replacing EP’536’s envelopes with CN’180’s airbag ‘would have made EP’536’s invention unsuitable for its intended purpose: providing a protective garment with “adaptive thermal insulation.””). The Petition relies on the combination of Anderson and Lynch (with other references) in the sole ground, *see* Pet. at 6, and thus Apple’s baseless proposed modification is fatal to the entire Petition.

Third, the Petition is supported by an expert declaration from Apple’s expert, Dr. Kyriakakis, that essentially “repeats, *verbatim*, the conclusory assertion[s] for which it is offered to support.” *Xerox v. Bytemark*, IPR2022-00624, Paper 9 at 15 (P.T.A.B. Aug. 24, 2022) (precedential) (denying institution); *compare* Pet. at 37-39, *with* EX1003 ¶¶ 415-18. Dr. Kyriakakis’ parroting almost verbatim Apple’s Petition, as shown in the illustrative snapshot below, confirms the Petition’s weakness. *See, e.g., Xerox*, IPR2022-00624, Paper 9 at 15-17; *TikTok v. NTECH Props.*, IPR2024-01339, Paper 9 at 16 (P.T.A.B. Feb. 25, 2025) (“Petitioner fails to establish a reasonable likelihood of” prevailing where its expert “testimony repeats, almost verbatim, the language in the Petition without any further explanation or supporting reasoning or evidence.”).

Pet. at 37-39 Ground 1, Claim 55[A]	Kyriakakis Decl. ¶¶ 416-18 Ground 1, Claim 55[A]
This element is met. (EX1003, ¶416.) In combination with Anderson and Lynch, Irvin teaches that electronic circuitry processes data received from contact sensor 220 (e.g., a contact switch activated by the application of force) to enable or disable the headset's electronic circuitry based on whether the headset is being worn:  FIG. 4C (EX1009, 4:3-10, 4:39-49, 6:20-33, FIG. 4C (annotated); EX1003, ¶¶256, 416.) Irvin's communications circuit 230 transitions between states based on whether the contact sensor 220 indicates a stimulus (e.g., that force has been applied to the contact switch). (EX1009, 8:11-9:39; FIG. 6, FIG. 7; EX1003, ¶257.) The POSITA would have understood that in the combination, the electronic circuitry would be implemented by Anderson's RPU (e.g., DSP 645) and/or earpiece (e.g., ASIC 845), at least because Anderson discloses these components as configured to interface with sensors. (EX1010, 24:23-26; EX1003, ¶257.) In the combination of Anderson, Lynch, and Irvin with Horowitz, Irvin's contact sensor 220 would be implemented in the combined apparatus using a Hall effect switch as disclosed by Horowitz. (EX1003, ¶417.) The POSITA would have been motivated to make the combination as described above. (EX1003, ¶417.) As Horowitz discloses, the Hall effect switch is a magnetically operated solid-state switch that can be advantageously used in place of a mechanical switch such as the contact switch disclosed in Irvin. (EX1011, 576-577; EX1009, 6:3-10, FIG. 4C; EX1003, ¶417.) Because the Hall effect sensor operates based on the principles of the well-known Hall effect, The POSITA would have understood the Hall effect switch to comprise a Hall effect detector for detecting a voltage generated in the switch by the Hall effect, i.e., by the presence of an electrical current in a magnetic field. (See EX1013, 709-713; EX1003, ¶418.) The POSITA would similarly have understood the Hall effect switch to capture data associated with a magnetic characteristic, e.g., the voltage produced as a function of the applied magnetic field, as characterized by the Hall effect. (See EX1013, 709-713; EX1003, ¶418.)	416. This element is met as described for claim 14. That is, in combination with Anderson and Lynch, Irvin teaches that electronic circuitry processes data received from contact sensor 220 in the combined apparatus (e.g., a contact switch activated by the application of force) to enable or disable the headset's electronic circuitry based on whether the headset is being worn, as shown in FIG. 4C:  FIG. 4C (EX1009, 4:3-10, 4:39-49, 6:20-33, FIG. 4C (annotated).) 417. In the combination of Anderson, Lynch, and Irvin with Horowitz as described in Section XIV.B, Irvin's contact sensor 220 would be implemented in the combined apparatus using a Hall effect switch as disclosed by Horowitz. The POSITA would have been motivated to make the combination as described in Section XIV.B. As Horowitz discloses, the Hall effect switch is a magnetically operated solid-state switch that can be advantageously used in place of a mechanical switch such as the contact switch disclosed in Irvin. (EX1011, 576-577; EX1009, 6:3-10, FIG. 4C.) 418. Because the Hall effect sensor operates based on the principles of the well-known Hall effect, The POSITA would have understood the Hall effect switch to comprise a Hall effect detector for detecting a voltage generated in the switch by the Hall effect, i.e., by the presence of an electrical current in a magnetic field. (See EX1013, 709-713.) The POSITA would similarly understand the Hall effect switch to capture data associated with a magnetic characteristic, e.g., the voltage produced as a function of the applied magnetic field, as characterized by the Hall effect. (See EX1013, 709-713.)

7. None Of The *Fintiv* Factors Supports Institution

The weight of the *Fintiv* factors supports the Director exercising its discretion to deny review under Section 314(a), thereby conserving Board and party resources and preventing duplicative proceedings evaluating the same invalidity challenges against the same patent. None of the six *Fintiv* factors supports institution here.

V. PETITIONER’S INCONSISTENT CLAIM CONSTRUCTION POSITIONS WARRANT DISCRETIONARY DENIAL

Board “rules discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability.” *Revvo Techs. v. Cerebrum Sensor Techs.*, IPR2025-00632, Paper 20 at 4 (P.T.A.B. Nov. 3, 2025) (precedential); *see also Magnolia Med. Techs.*, IPR2026-00097, Paper 17 at 8 (“Permitting different claim construction positions before a district court and the Board without sufficient explanation detracts from the Office’s goal of providing greater predictability and certainty in the patent system.”). That is precisely what Apple has done here: Apple asserts that “[t]he Board ***should not construe*** any of the claim terms” in the IPR, Pet. at 4 (emphasis added), while simultaneously proposing in the district court that

- limitations reciting a “head-worn” apparatus in independent Claim 17, from which Claim 55 depends, be construed as “electronic eyewear or headwear,” EX2011 at 1; Pet. at 4, and

- limitations reciting a “speaker... proximate to an ear of a user” in independent Claim 17, from which Claim 55 depends, be construed as a “speaker... near an ear of the user,” EX2011 at 1-2; Pet at 4.

As to the meaning of “proximate,” Apple further argued in the district court that it excludes “inside” the ear. EX2018 at 9 (“None of these terms mean ‘inside.’”). Although Claim 55 is not expressly identified in Apple’s claim construction materials, because it depends from Claim 17, EX1001 at 117:9-10, these constructions directly impact the scope of Claim 55.

Apple’s inconsistent claim construction positions are exactly the type of gamesmanship the Office has discouraged, including in a recent informative decision discretionarily denying institution where the petitioner argued in the IPR “that the term ‘composition’ should be given its plain and ordinary meaning, whereas in the parallel proceeding Petitioner asserted that the term ‘composition’ was narrower than its plain and ordinary meaning.” *Sun Pharms. Indus. v. Nivagen Pharms.*, IPR2025-00893, Paper 18 at 2-3 (P.T.A.B. Sept. 19, 2025) (informative). Apple’s inconsistent claim constructions between the two forums warrant denial of its Petition. *See, e.g., id.* at 3 (discretionary denial where the petitioner “advanced a narrow construction in district court and advances a broader construction in its Petition”); *Revvo Techs. v. Cerebrum Sensor Techs.*, IPR2025-00632, Paper 36 at 4

(P.T.A.B. Jan. 26, 2026) (“The appropriate course of action... is to deny institution” where petitioner “raise[s] different claim constructions in the two forums.”).

Further, the district court’s claim construction order adopted Apple’s proposed construction for “head-worn” apparatus as “electronic eyewear or headwear,” EX2020 at 2-3, contradicting Apple’s “no claim construction is necessary” approach here, Pet. at 5. Denial of institution is appropriate for this additional reason.

VI. APPLE IDENTIFIED NO MATERIAL ERROR WARRANTING IPR

Apple asserts in conclusory fashion that “[t]he application was misclassified as an optical system, the Examiner’s search was limited to select embodiments, and the Examiner repeatedly included typographical errors in search terms.” Pet. at 2. Apple provides no further explanation about these alleged issues, much less proves material error stemming therefrom during examination. For example, Apple never explains what classification should have been used for search purposes, and it never shows how a different classification would have led to a different outcome. *See* Pet. at 2-3. Nor does Apple cite any authority that any of these alleged issues can be the basis for a Patent Office error warranting institution.

Despite taking issue with the examiner’s search, Apple never addresses the examiner’s *hundreds of pages* of countless search terms, including many that are not limited to optical systems. *See, e.g.,* EX1002 at 379-440, 478-668, 733-978, 1088-1174, 1200-1442; *see also, e.g., id.* at 383 (“radiation crystal impedance

spectral ranges exciter”), 384 (“earphone seating hearing aid automatic self”), 394 (“signal patrons audio output signal frequency”), 397 (“hearing aid temple temples microphone housing”), 398 (“clothing speaker article enclosure pin”), 404 (“tubing transducer sound housing section”). Apple additionally overlooks the USPC classification searches in class 381 for “Electrical Audio Signal Processing Systems and Devices.” *See* EX1001 at 2 (Field 58). Further still, the cited art listed on the ’355 Patent itself shows the examiner considered a substantial number of references beyond optical systems. *See, e.g.*, EX1001 at 2-4 (US 5,694,475 A titled “Acoustically transparent earphones”; US 2002/0081982 A1 titled “Portable ear devices”; US 7,787,647 B2 titled “Portable system for programming hearing aids”; US 8,009,849 B2 titled “Aided ear bud”; US 2003/0045283 A1 titled “Bluetooth enabled hearing aid”).

Apple also alleges “a defective request under the since-discontinued After Final Consideration Pilot 2.0 (AFCP 2.0) program.” Pet. at 2. Again, Apple cites no authority that a minor technicality relating to an AFCP request provides a basis for a Patent Office error warranting institution. *See* Pet. at 2-3. Apple asserts only that the applicant allegedly “broadened” an independent claim, Pet. at 2, but it does not allege that the examiner erred in allowing any claims due to that alleged broadening amendment, much less explain how it did so.

Apple establishes no error, let alone material error, with the examiner’s search methodology warranting institution. *See, e.g., Belden v. CommScope*, IPR2025-00833, Paper 13 at 3 (P.T.A.B. Sept. 12, 2025) (discretionary denial: “Petitioner does not sufficiently address why this search was inadequate.”).

VII. APPLE’S MANUFACTURING ABROAD WEIGHS AGAINST INSTITUTION

“[W]hether the petitioner is a small business that has been sued for infringement of the patent at issue” and “the extent to which any products accused of infringement in a parallel proceeding are manufactured in the United States” also favor denying institution. Memorandum, “Additional Discretionary Institution Considerations – U.S. Manufacturing and Small Business Use of AIA Proceedings,” at 2 (Mar. 11, 2026) (“U.S. Manufacturing Memo”).

Apple is a large publicly-traded company with approximately 166,000 full-time employees as of 2025. EX2019 at 7. In the district court litigation, Apple’s AirPods and AirPods Pro are accused of infringing the ’355 Patent. EX2001 ¶ 43. Those accused products, like the majority of Apple’s products, are manufactured outside of the United States. EX2019 at 11 (“The Company relies... on partners primarily located in Asia, for final assembly of substantially all of the Company’s hardware products.”); *see also id.* at 49 (“Substantially all of [Apple’s] hardware products are manufactured by outsourcing partners that are located [outside the

U.S.].”). Apple’s statements in “public financial disclosures that [it does] not have a significant, existing manufacturing presence in the United States” further support denying institution here. U.S. Manufacturing Memo at 2.

VIII. APPLE CANNOT JUSTIFY USE OF BOARD RESOURCES

Institution would not be an appropriate or efficient use of Board resources here, and there is a significant risk of conflicting decisions with the co-pending litigation where the same parties have already committed substantial resources toward resolving a broader array of issues in the district court. Absent “persuasive reasons why the Office should review the challenged patent... the Office is disinclined to disturb the settled expectations of Patent Owner.” *Dabico Airport Sols. v. AXA Power*, IPR2025-00408, Paper 21 at 3 (P.T.A.B. June 18, 2025) (informative). Indeed, “addressing all of the challenged patents in the district court proceeding would be ‘the fastest and most efficient resolution of the Parties’ many disputes” particularly given “there are six patents at issue in the parallel district court proceeding” and “institution was denied” as to two patents and is likely to be denied for additional patents challenged in other IPRs by Petitioner. *Samsung Elecs. v. VB Assets*, IPR2025-00870, Paper 11 at 2-3 (P.T.A.B. Oct. 10, 2025); *supra* § I.

IX. CONCLUSION

The Director should discretionarily deny institution, allowing all validity issues to be efficiently resolved by the district court.

Apple Inc. v. IngenioSpec, LLC
U.S. Patent No. 11,921,355 – IPR2026-00332

ARMOND WILSON LLP

Dated: June 8, 2026

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a true copy of the foregoing **PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL** and **EXHIBITS 2001-2006, 2011, 2015, and 2018-2021** are being served electronically on June 8, 2026 to the following lead and backup counsel for Petitioner to the following email addresses:

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