

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

INGENIOSPEC, LLC.
Patent Owner.

Patent No. 11,921,355

Inter Partes Review No. IPR2026-00332

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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U.S. Patent No. 7,010,332 to Irvin et al.	EX1009
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Excerpts from P. HOROWITZ AND W. HILL, THE ART OF ELECTRONICS (Cambridge Univ. Press 2nd Ed. 1989)	EX1011
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Excerpts from R. CHABAY AND B. SHERWOOD, MATTER & INTERACTIONS II: ELECTRIC & MAGNETIC INTERACTIONS (John Wiley & Sons, Inc. 2nd Ed. 2007)	EX1013

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Plaintiff's Sept. 19, 2025 Infringement Claim Chart for U.S. Patent No. 11,921,355 in <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867 (W.D. Tex.)	EX1024

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Plaintiff's Responsive Claim Construction Brief, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, ECF No. 51 (W.D. Tex. Feb. 4, 2026)	EX1025 (NEW)
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RESERVED	EX1027 (NEW)
Joint Motion to Stay All Deadlines and Notice of Settlement <i>IngenioSpec, LLC v. Sony Grp. Corp.</i> , No. 2:24-cv-00820-RSP, (E.D. Tex. Oct. 24, 2025), ECF No. 51	EX1028 (NEW)
Joint Motion to Stay All Deadlines and Notice of Settlement, <i>IngenioSpec, LLC v. Bose Corp.</i> , No. 2:24-cv-00822-JRG (E.D. Tex. Mar. 28, 2025), ECF No. 49	EX1029 (NEW)
Dani Kass, <i>WDTX Judge Albright Stepping Down At End Of Summer</i> , Law360, Apr. 21, 2026	EX1030 (NEW)
Order Regarding Austin Division Docket, <i>MOSAID Techs. Inc. v. Infineon Techs. AG</i> , 1:25-cv-00358-ADA (W.D. Tex. Apr. 23, 2026), ECF No. 81	EX1031 (NEW)
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<i>Apple will spend more than \$500 billion in the U.S. over the next four years</i> , Apple Newsroom, Feb. 24, 2025	EX1033 (NEW)
<i>Apple and Corning partner to manufacture 100 percent of iPhone and Apple Watch cover glass in Kentucky</i> , Apple Newsroom, Aug. 6, 2025	EX1034 (NEW)

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<i>Apple accelerates U.S. manufacturing, with Mac mini production coming later this year</i> , Apple Newsroom, Feb. 24, 2026	EX1035 (NEW)
<i>Apple announces expanded partnership with Amkor for advanced silicon packaging in the U.S.</i> , Apple Newsroom, Nov. 30, 2023	EX1036 (NEW)
<i>Apple adds new partners to its American Manufacturing Program</i> , Apple Newsroom, Mar. 26, 2026	EX1037 (NEW)
<i>Apple expands U.S. supply chain with \$500 million commitment to American rare earth magnets</i> , Apple Newsroom, July 15, 2025	EX1038 (NEW)
<i>Apple Manufacturing Academy brings together hundreds of U.S. manufacturers to accelerate AI use in American supply chains</i> , Apple Newsroom, May 5, 2026	EX1039 (NEW)
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Patent Owner's Exhibit List

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Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 1 (W.D. Tex. June 5, 2025)	2001
Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00877, Dkt. No. 1 (W.D. Tex. June 6, 2025)	2002
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)	2003
Scheduling Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 36 (W.D. Tex. Nov. 17, 2025)	2004
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RESERVED	2012
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Exhibit Description	Exhibit #
Declaration of Peter Tong	2015
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Apple Inc. Form 10-K Annual Report (Oct. 31, 2025)	2019
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)	2020
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)	2021

I. INTRODUCTION

Discretionary denial of Apple's Petition should be declined, and the Petition should be referred to the Board for review on the merits. The Director recently designated informative *Tesla, Inc. v. Bulletproof Prop. Mgmt., LLC*, IPR2026-00204, Paper 14 (June 15, 2026) (informative) ("*Bulletproof*"), which declined discretionary denial of seven IPR petitions based on the absence of a firm trial date; material Office error; early patent challenges; and the petitioner's U.S. manufacturing activities. That same fact pattern is present here, including Apple's extensive and expanding domestic manufacturing presence.

First, the *Fintiv* factors favor institution. Judge Albright's announced August 2026 departure leaves the litigation in flux months before the scheduled April 2027 trial. No successor judge or case-specific transition plan has been identified. As in *Bulletproof*, where Judge Albright's departure vacated the original trial date, AIA review here would lack significant overlap with the litigation, particularly in view of Apple's *Sotera* stipulation. *See Bulletproof*, 2-3.

Second, the '355 patent issued hastily and because of material Office error. *See Bulletproof*, 3-4. The applicant obtained accelerated allowance under AFCP 2.0 by falsely certifying that its amendments did not broaden any independent claim. In fact, the applicant broadened independent claim 64 by deleting a six-line limitation requiring a being-worn sensor. The Examiner relied on that certification

and limited his updated search to the three hours permitted under AFCP 2.0, which he spent on a web search for eyeglasses-related terms absent from the claims. Prosecution was also marred by misclassification and search errors—strongly supporting referral to the Board.

Third, Apple’s challenge is timely: the ’355 patent issued in March 2024, just two years before the Petition. As the Director found in *Bulletproof*, patents that “have not been in force for a significant period of time,” including patents issued in 2024, do not support “strong settled expectations that favor discretionary denial.” *Bulletproof*, 4. While Patent Owner cites unidentified licenses and settlements, including for unrelated patents, it does not show that any license created settled expectations in the challenged claims. Nor can it claim settled expectations where allowance followed its own false certification to the USPTO.

Fourth, Patent Owner trivializes Apple’s leading role in America’s innovation ecosystem, including Apple’s historic investment in American manufacturing, workers, suppliers, and innovation—the exact kind of domestic commitment that the recent U.S. Manufacturing Memo linked to the integrity of the patent system. Like the petitioner’s manufacturing activities in *Bulletproof*, Apple’s domestic manufacturing supports institution. *Bulletproof*, 4-5.

Patent Owner’s remaining arguments fail. Apple’s Petition is consistent with Apple’s district court constructions and explains how the prior art satisfies them,

defeating Patent Owner's "gamesmanship" theory. Patent Owner's unsupported merits arguments mischaracterize the prior art and ignore the detailed analysis in the Petition and the expert declaration. And the -332 petition addresses claim limitations and prior art absent from the -331 petition, justifying a second petition.

II. ARGUMENT

A. Apple's U.S. Presence and Commitment to U.S. Investment, and Patent Owner's Pattern of Enforcement, Support Institution

Patent Owner's manufacturing argument trivializes Apple's U.S. presence. Apple has made one of the largest private commitments to American innovation and advanced manufacturing in the nation's history. In February 2025, Apple announced its largest-ever U.S. spend commitment: more than \$500 billion over four years—a figure that Apple has since increased to more than \$600 billion. (EX1033, 1-2; EX1034, 1.) That commitment builds on Apple's long history of investing in American innovation and manufacturing, and supports initiatives in AI, silicon engineering, data centers and infrastructure, and R&D. (EX1033, 2-3.)

1. Apple Products Are Designed and Engineered in the United States and Manufactured with American Components

Patent Owner focuses narrowly on final assembly of AirPods in Asia. (Request, 19-20.) But final assembly is only one stage in a broader innovation and manufacturing ecosystem. For example, the accused AirPods are designed and engineered in the United States and incorporate Apple's U.S.-developed technologies, including Apple silicon such as the H2 chip. (*See, e.g.*, EX1040, 1,

5.) Across its product lines, Apple increasingly relies on components that are made, packaged, or sourced domestically. Apple is the largest customer at TSMC's Fab 21 facility in Arizona, where more than 2,000 workers manufacture Apple chips, and Apple is on track to purchase well over 100 million advanced chips from the Arizona facility in 2026. (EX1033, 5; EX1035, 4.) Apple will also be the first and largest customer of Amkor's new \$2 billion advanced semiconductor packaging facility in Peoria, Arizona, where Apple silicon from the nearby TSMC fab will be packaged. (EX1036, 1-2.) Overall, Apple suppliers manufacture silicon for Apple products in 24 factories across 12 states, including Colorado, Oregon, and Utah, at U.S. companies such as Broadcom, Texas Instruments, Skyworks, and Qorvo. (EX1033, 5.)

Apple is also expanding domestic production of sensors, integrated circuits, magnets, and other components critical to Apple products. Through Apple's American Manufacturing Program, TDK will manufacture sensors for Apple products in the United States for the first time; Bosch and TSMC will produce integrated circuits for sensing hardware at TSMC's facility in Camas, Washington; and Cirrus Logic and GlobalFoundries will establish new semiconductor process technologies in Malta, New York. (EX1037, 1-3.) Apple has also committed \$500 million to buy American-made rare earth magnets from MP Materials' Fort Worth, Texas facility and to establish a rare-earth recycling line in Mountain Pass,

California. (EX1038, 1-3.) These investments will bring lightweight neodymium magnets—commonly used in earbuds and other portable audio devices—into Apple’s domestic supply chain. (EX1038, 2.) Patent Owner’s focus on final assembly ignores these investments in the American technologies and components that make Apple products work.

2. Apple Has Made Historic Commitments to Domestic Manufacturing and Innovation

Apple’s investments extend across a U.S.-anchored network of engineering, component production, suppliers, and advanced manufacturing. Apple is opening a new 250,000-square-foot advanced manufacturing facility in Houston, where Mac mini production will begin in the United States for the first time and AI server production is already ahead of schedule. (EX1035, 1-2.) Apple has committed \$2.5 billion for Corning to produce 100% of the cover glass for iPhone and Apple Watch in Harrodsburg, Kentucky. (EX1034, 1-2.) Apple is also doubling its U.S. Advanced Manufacturing Fund to \$10 billion, supporting projects in 13 states that build local businesses, train workers, and create advanced manufacturing processes and materials for Apple products. (EX1033, 4-5.)

Apple is investing in the workforce and infrastructure needed to sustain those commitments. It launched the Apple Manufacturing Academy in East Lansing, Michigan, the only manufacturing academy of its kind in North America, which has already supported more than 150 American businesses. (EX1039, 2-4.)

Apple is also opening a 20,000-square-foot Advanced Manufacturing Center in Houston to provide hands-on training to students, supplier employees, and businesses of all sizes. (EX1035, 4.) Apple supports more than 2.9 million U.S. jobs, plans to hire approximately 20,000 additional U.S. employees focused on R&D, silicon engineering, software development, and AI, and has nearly doubled its U.S.-based advanced R&D spend over the past five years. (EX1033, 3, 5-6.)

3. The Director’s U.S. Manufacturing Memo Favors Apple, Not Patent Owner

These are precisely the types of “investments in American manufacturing operations” and U.S.-made components that the Director “will consider” under the U.S. Manufacturing Memo. (U.S. Manufacturing Memo, 2-3.) The Memo is not limited to final assembly; it also considers future U.S. manufacturing investment and whether product components are made in the United States. (U.S. Manufacturing Memo, 2-3.) Apple is advancing all those considerations on a historic scale. Patent Owner, by contrast, identifies no sales of any product, no domestic manufacturing, and no meaningful investment in U.S. manufacturing, suppliers, workers, or infrastructure. Its primary business appears to be patent-infringement lawsuits.

4. Patent Owner’s Enforcement Pattern Supports Institution

Apple’s U.S. manufacturing, supplier, infrastructure, R&D, and workforce initiatives depend on a robust patent system that can efficiently weed out invalid

patents before they disrupt domestic innovation and investment. Patent Owner threatens that system by serially asserting its patents against unrelated defendants in multiple venues—typically settling before they can be found invalid. This pattern warrants Board review, especially because the litigation presents practical obstacles to efficient review: Judge Albright is leaving the bench, no successor judge has been assigned, and there is no specific plan for how the litigation will proceed. Patent Owner’s enforcement campaign thus presents “persuasive reasons why the Office should review the challenged patent.” *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21, 3 (June 18, 2025) (informative).

B. The ’355 Patent Resulted from Material USPTO Error

The ’355 patent—allowed in just eight months with one hundred claims—resulted from multiple material Office errors. *See Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, 3 (June 12, 2025). In *Bulletproof*, the Director noted the examiner’s oversights of the prior art and concluded that “the Office erred in a manner material to the patentability of the claims.” *Bulletproof*, 3-4. The same analysis supports referral here, and with greater force, because allowance followed Patent Owner’s false certification.

1. The ’355 Patent Was Allowed Based on a False Certification

Patent Owner requested streamlined prosecution under the USPTO’s AFCP 2.0 program, and provided the required certification that its amendment “does not

broaden the scope of the independent claim in any aspect.” (EX1002, 1013.) But its certification was indisputably false: the amendment broadened the only amended independent claim—claim 64—by striking a limitation requiring a sensor “configured to sense data indicative of whether the head-worn personal electronic apparatus is being worn by the user.” (EX1002, 1051-1079.)

Patent Owner downplays the false certification as a “minor technicality.” (Request, 18.) Not so. The Examiner relied on the false certification to grant the AFCP 2.0 request, limiting his updated search to three hours—which he spent on a web search for optics and eyeglasses terms found nowhere in the claims. (EX1002, 1084, 1088-1133.) This represents material error: the Examiner neglected his duty to “verify that the AFCP 2.0 submission is compliant,” even though it plainly was not, and compromised his prior art search. (EX1002, 1013.)

The false certification had practical consequences. Patent Owner filed the AFCP 2.0 request in December 2023, only 19 months before the patent's July 2025 expiration. Under AFCP 2.0, the patent issued in March 2024. Without it, the finally-rejected application would have lapsed without an appeal or an RCE; it would have issued later, if at all, and possibly not before expiration. Patent Owner's president then sent demand letters just three months later, in June 2024, exploiting the improperly accelerated issuance. (EX2015, 18.)

2. The Application Was Misclassified and Searched as an Optics Invention

The application was assigned to Art Unit 2872—an optics art unit—and the Examiner's classification-based searches were dominated by optics and eyewear classifications, including G02C subclasses for spectacles and eyeglasses.

(EX1002, 729-730, 796-839.) But the '355 patent claims personal electronic apparatuses with speakers that output customized audio; no claim recites an optical component. (EX1001, 110:14-124:21.) Additionally, challenged claim 55 recites a Hall effect detector, which is a magnetic sensor, not an optical component.

Patent Owner does not dispute the misclassification, and instead only disputes that “a different classification would have led to a different outcome.” (Request, 17.)

But the outcome is apparent: the optics classification steered the Examiner away from wearable audio, hearing aid, and Hall effect prior art, including Anderson, Lynch, and Horowitz, that renders the challenged claim obvious.

3. The Examiner's Searches Were Error-Filled and Improperly Limited to Eyeglasses

The Examiner's keyword searches repeatedly used eyeglasses-specific terms, such as “eyewear\$4” and “glasses\$4”, combined with structural eyewear terms like “frame,” “temple,” and “bridge”. (*See, e.g.*, EX1002, 652-659, 1202-1209, 1253-1263.) His web searches followed the same pattern, limiting queries to optical terms like “electric eyeglasses,” “audio smart glasses,” and “Electric Goggles”;

eyewear parts such as temples and frames; and eye-specific terms such as “ophthalmic.” (EX1002, 379-440, 1088-1133.) The entire three-hour AFCP 2.0 search window was spent on these stray web searches. (EX1002, 1088-1133.)

But the claims are not limited to eyeglasses. They recite a “head-worn personal electronic apparatus” that potentially encompasses headsets, caps, and other head-worn devices. By limiting his searches to eyewear art, the Examiner failed to search the claims’ full scope and missed relevant non-eyewear prior art, including Anderson and Lynch. Further, the Examiner apparently did not search for “Hall” or “Hall effect,” even though claim 55 recites a Hall effect detector.

The Examiner’s search strings also repeatedly included typographical errors—*e.g.*, *spetacul\$4* instead of *spectacul\$4*, and *eyegalss\$4* instead of *eyeglass\$4*—that artificially limited the search results to these misspellings. Those errors appeared in dozens of queries as the Examiner pasted the same erroneous terms into new searches. (*See, e.g.*, EX1002, 652-659, 1202-1209, 1253-1263.)

These errors are material and support PTAB review. The misclassification, defective prior art searches, and improper AFCP 2.0 treatment collectively show that the Examiner did not examine the full claim scope against the relevant art.

C. Settled Expectations Favor the Petitioner, Not the Patent Owner

The ’355 patent issued in March 2024—just over two years before the Petition was filed. (EX1001.) In *Bulletproof*, the Director found that because the

“challenged patents have not been in force for a significant period of time (all challenged patents issued between 2024 and 2025),” the patent owner had “not developed strong settled expectations that favor discretionary denial.” *Bulletproof*,

4. The same is true here—the ’355 patent issued squarely within the same timeframe. Patent Owner’s cases are materially different: *Hisense* involved claims in force for more than eleven years, and *Alliance Laundry* involved patents in force for more than four years that had survived serial PTAB challenges.

Hisense USA Corp. v. VideoLabs, Inc., IPR2025-00880, Paper 11, 2 (Oct. 10, 2025); *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950, Paper 11, 3 (Sept. 19, 2025). This case involves neither old claims nor serial petitions.

Patent Owner’s reliance on licensing—including for unrelated patents—fares no better. (*See* EX2015, 1-2.) The Request does not identify any license specific to the challenged claims, describe the circumstances of any license, or explain how any license created settled expectations in the ’355 patent’s validity. Patent Owner’s declarant states only that “[t]he ’355 Patent has been licensed 26 times,” without identifying the licenses, scopes, or dates, or whether they predated issuance. (EX2015, 2.) Licenses to future claims, for instance, cannot create settled expectations in those claims’ validity. Nor can litigation settlements that were reached before any validity determination. (*See* EX1028; EX1029.)

If anything, settled expectations favor Apple. Patent Owner’s conduct gave

Apple reason *not* to expect enforcement of the '355 patent. In 2024, Patent Owner asserted related patents against several large technology companies, but not Apple. From 2023 through 2025, it pursued three ITC investigations against numerous technology companies, again omitting Apple. Patent Owner's affiliate has followed a similar pattern for decades—asserting patents against large technology companies without targeting Apple. When Patent Owner did sue Apple, on U.S. Patent No. 8,112,104, it did so months after suing others and only after expiration.

That history cuts against discretionary denial. In *Allani*, the Board found discretionary denial “not appropriate” where, as here, the petitioner “did not expect enforcement” of the challenged patent. *See Apple Inc. v. Allani*, IPR2025-00856, Paper 11, 2-3 (Sep. 5, 2025) (informative).

D. *Fintiv* Favors Institution in View of Judge Albright's Departure

Judge Albright will leave the bench in August 2026 and therefore cannot preside over the trial he scheduled for April 2027. Even before that announcement, trial dates before Judge Albright were unpredictable and subject to rescheduling. Now, with no successor judge identified and no case-specific transition plan in place, Patent Owner's reliance on the existing trial date is complete speculation. As in *Bulletproof*, where the Director found that the “absence of a scheduled trial date” in view of Judge Albright's departure reduced “the concern of inconsistent outcomes or significant duplication of efforts,” the uncertain posture of the district

court here counsels against discretionary denial. *Bulletproof*, 2-3.

1. Factor 1: The Likelihood of a Stay Is Neutral or Weighs Against Discretionary Denial

Patent Owner suggests that a stay before Judge Albright is unlikely. (Request, 5-6.) But the Board has previously “decline[d] to speculate on the likelihood of Judge Albright entering a stay after institution,” finding this factor neutral. *See W. Digit. Corp. v. Kuster*, IPR2020-01391, Paper 10, 8-9 (Feb. 16, 2021). Judge Albright’s departure makes speculation even less appropriate. No successor judge has been identified, and that judge may be more receptive to a stay as a case-management tool, particularly upon inheriting Judge Albright’s patent docket. Factor 1 is therefore neutral or weighs against discretionary denial.

2. Factor 2: The Scheduled Trial Date Cannot Hold and Weighs Strongly Against Discretionary Denial

Factor 2 weighs strongly against discretionary denial. Judge Albright scheduled trial for April 26, 2027, but will leave the bench in August 2026—eight months earlier—and no case-specific transition plan exists. (EX2005; EX1030.) The scheduled trial date therefore provides no reliable basis for denying institution.

A successor judge will need to assume this case; learn the record and technology; manage inherited docket conflicts; and decide whether to keep, modify, or vacate the existing schedule. That transition may require new briefing, hearings, and other procedures that are likely to delay or reset portions of the case.

Indeed, Judge Albright has already vacated hearings, conferences, and trial dates in other patent cases because of the potential for future conflicts. (*See* EX1031, 1.)

Even before Judge Albright’s departure, his patent trial dates were susceptible to slippage, given his heavy caseload. *See Motion Offense, LLC v. Google LLC*, No. 6:21-cv-00514-ADA, ECF No. 68 (W.D. Tex. June 10, 2022); *IOENGINE, LLC v. Roku Inc.*, No. 6:21-cv-01296-ADA, ECF No. 306 (W.D. Tex. Sept. 19, 2023). The Board has recognized this reality and declined discretionary denial where “time-to-trial statistics suggest[ed] that the trial will not begin until” after the expected Final Written Decision—even though Judge Albright had scheduled trial six months before that date. *ClearCorrect Operating, LLC v. Align Tech., Inc.*, IPR2025-00814, Paper 14, 2 (Aug. 29, 2025).

This case is stronger than *ClearCorrect*. Here, the scheduled trial date is six months before the projected Final Written Decision, as in *ClearCorrect*, and is unlikely to hold. Judge Albright’s median time to trial expanded to 43 months in 2025. (EX1032.) Applying that median here places trial in January 2029—well after the Board’s expected October 2027 Final Written Decision. (*See* March 24, 2025, USPTO Memorandum, 3 (describing median time-to-trial statistics as a *Fintiv* consideration).) Judge Albright’s departure only increases the likely delay.

Institution would provide the parties, the district court, and the public a stable and efficient path to resolving the patentability. Factor 2 therefore weighs

heavily against discretionary denial.

3. Factor 3: The Investment in Parallel Proceeding Weighs Against Discretionary Denial

The parties and court have not invested enough in the litigation to justify discretionary denial. Although infringement and invalidity contentions have been exchanged and a claim-construction order has been issued, fact discovery just opened in April 2026; and expert reports, the close of discovery, depositions, dispositive motions, pretrial disclosures, and trial are all scheduled after Judge Albright’s departure in August. (EX2005; EX2020.)

This factor weighs against exercising discretion to deny institution where “much more work remains [in the litigation], including, expert reports, expert discovery, expert depositions, and pretrial motions and disclosures.” *See Bio-Rad Lab’ys, Inc. v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11, 10 (Mar. 27, 2025). Because the most substantive invalidity work remains ahead—and may be delayed indefinitely by judicial reassignment—Factor 3 weighs against denial.

4. Factor 4: The Overlap Between the Petition and Parallel Proceeding Weighs Strongly Against Discretionary Denial Because Apple Agreed to a *Sotera* Stipulation

This factor weighs strongly against discretionary denial. Apple’s *Sotera* stipulation limits the potential overlap between this proceeding and the parallel litigation. (Paper 7.) Patent Owner minimizes the impact of the stipulation because of Apple’s supposedly “extensive” use of IPR prior art in the district court

to “avoid estoppel.” (Request, 9-11.) But it only points to two references (Anderson, Irvin) from Apple’s preliminary invalidity contentions, out of dozens cited in those contentions, that are also found in the -332 petition. (Request, 9-11.) Under the stipulation, those references would at most play a secondary role in combination with system prior art (*e.g.*, Phonak Claro) that could not have been raised in the IPR and does not correspond to any of its prior art. (EX2006, 41-48.)

That limited use does not show any attempt to avoid estoppel. Apple’s *Sotera* stipulation “weighs strongly in favor of not exercising discretion to deny institution” because it “mitigates any concerns of duplicative efforts between the district court and the Board.” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 19 (Dec. 1, 2020); *see also Liberty Energy Servs., LLC v. U.S. Well Servs., LLC*, IPR2025-00139, Paper 14, 13-14 (June 11, 2025).

5. Factor 5: Whether the Parties Are the Same Is Neutral

The parties before the Board in this proceeding and in the parallel district court litigation are the same. Where the parties are identical, the Board has held that this factor is “neutral or, at most, weighing slightly in favor of exercising discretion to deny institution.” *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, 16 (Oct. 21, 2020).

6. Factor 6: Other Considerations, Including the Strength of the Petition, Weigh Against Discretionary Denial

Factor 6 weighs against discretionary denial. Supported closely by expert

testimony, the Petition demonstrates that claim 55 is obvious based on prior art not presented or considered during prosecution. Patent Owner disputes that a POSITA would have combined Anderson and Lynch as in the Petition. (Request, 12-13.) But the Petition's rationale is straightforward: a POSITA considering Anderson would have faced the problem of "easily misplaced" hearing aid components, but found Anderson's solution to that problem to be insufficient. (Pet., 13-14; EX1003, ¶¶46-49.) The POSITA would have solved the problem by mounting Anderson's RPU using Lynch's ALD Cap—an accessory designed to mount hearing aid components on the wearer's head. (Pet., 13-20; EX1003, ¶¶46-61.)

Patent Owner ignores the Petition and the references' express teachings. Anderson's headset 21 (an over-the-head headset) and behind-the-ear unit are not an in-ear earpiece "hidden from view in the ear canal"; Anderson's RPU is "worn by" the user, just as in the Lynch combination; and the combination uses both for their intended purposes to solve Anderson's misplaced-components problem. (Pet., 13-20; EX1003, ¶¶46-61; EX1010, 1:6-10; EX1008, 1:17-2:23.)

Patent Owner's attorney argument that the Petition fails to address a Hall effect detector "at least partially contained within the head-worn personal electronic apparatus" again ignores the Petition. (Request, 11-12.) As the Petition explained with expert support, the detector would be implemented "in the combined apparatus" and used "in place of" the apparatus's contact sensor 220.

(Pet., 37-39; EX1003, ¶¶257, 417-418.) These evidence-based, expert-supported explanations demonstrate the Petition’s merits and favor institution.

Judge Albright’s departure is also an “other circumstance[]” bearing on the *Fintiv* analysis. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 14-16 (Mar. 20, 2020) (precedential). Any district court efficiency is compromised because the presiding judge will leave before trial, no successor judge is known, and the future schedule is unsettled. That uncertainty is compounded by the scope of the litigation, which involves six patents and hundreds of asserted claims.

On balance, the *Fintiv* factors weigh against discretionary denial. No factor supports denial on this record. *See CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00289, Paper 7, 17 (July 21, 2023).

E. Apple Does Not Present Inconsistent Claim Constructions

Patent Owner’s claim construction argument fails because Apple has not taken inconsistent positions. In *Revvo*, the Director explained that when a petitioner advances “alternative positions” before the Board and the district court, it should explain why those positions are warranted. *Revvo Techs., Inc. v. Cerebrum Sensor Techs. Inc.*, IPR2025-00632, Paper 20, 3-4 (Nov. 3, 2025) (“*Revvo*”) (precedential). That concern is absent here.

For the ’355 patent, Apple proposed that the district court construe “head-worn personal electronic apparatus” as “electronic eyewear or headwear”; and a

speaker “proximate to an ear of the user” as a speaker “near an ear of the user.” (EX1012, 1-2.) The court adopted Apple’s “electronic eyewear or headwear” construction, and confirmed on the record that “proximate” means “near” but excludes standalone in-ear devices. (EX2020; EX1041, 56:22-59:11.) Patent Owner did not argue Apple’s constructions were too broad. It argued the opposite: that the claims encompass devices worn on “any part of the head” and speakers positioned “at, near, or at least partially within the ear.” (EX1025, 8-10, 14-16.)

Apple’s Petition is consistent. *See Terumo BCT Inc. v. Haemonetics Corp.*, IPR2025-01374, Paper 20, 3-4 (May 12, 2026) (informative). It applies prior art satisfying the district court’s constructions and the undisputed claim scope. For example, the Petition explains that the combined Anderson/Lynch apparatus is “electronic headwear worn on the user’s head,” and is head-worn “because the ALD Cap attaches to the top of the user’s head for support.” (Pet., 15-16.) Further, each speaker is “positioned near (and thus proximate to) its respective ear” when the headset is worn, and the Petition does not rely on any speaker being inside the ear. (Pet., 23.) These mappings directly track Apple’s proposals in the district court, and the Petition does not rely on broader or different constructions.

The Board need only construe claim terms when necessary to resolve the controversy. *Realtime Data LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019). Because the prior art meets the challenged limitations under Apple’s constructions,

Patent Owner’s broader view, and any reasonable interpretation, no construction is needed. Apple’s IPR and district court positions thus agree—confirming no “gamesmanship” and providing “greater predictability and certainty.” *Revvo*, 2-5.

F. A Second Petition is Necessitated by the ’355 Patent’s Exceptionally Large Number of Claims

Patent Owner speculates that all 93 challenged claims could have fit in one petition. But the two petitions here are materially different and structured for efficient review. (*See* Paper 3.) Apple addressed 92 of the 93 challenged claims in the -331 petition, using nearly all of the allotted word limit. The -332 petition addresses only claim 55, but relies on a new reference (Horowitz) to meet a claim limitation (Hall effect detector) not found in the other 92 claims.¹ The two petitions thus challenge different claims, prior art combinations, and technical issues. Patent Owner’s cited case is inapposite: the two petitions there involved far fewer claims (15 vs. 93), challenged the same claims, and did not raise “separate technological issue[s.]”. *Micron Tech. v. Yangtze Memory Techs. Co.*, IPR2025-00119, Paper 22, 7-10 (June 4, 2025). Apple’s approach instead follows the Trial Practice Guide, which recognizes that “more than one petition may be necessary” when an exceptional number of claims demands it. (CTPG, II.D.2.)

¹ Patent Owner disputes whether claim 55 was formally asserted in the litigation; but Patent Owner indicated in correspondence that it intended to assert claim 55, necessitating its challenge here.

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Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL was served on the below date via e-mail (by agreement) to the following counsel of record for the Patent Owner:

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