

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

INGENIOSPEC, LLC,
Patent Owner.

Patent No. 11,644,693

Inter Partes Review No. IPR2026-00339

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

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Petitioner's Updated Exhibit List

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Defendant's Proposed Claim Constructions in <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867 (W.D. Tex. Dec. 22, 2025)	EX1014

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Excerpts from R. GRAF, MODERN DICTIONARY OF ELECTRONICS (Butterworth-Heinemann 7th Ed. 1999)	EX1016
Bevan Yueh et al., <i>Screening and Management of Adult Hearing Loss in Primary Care: Scientific Review</i> , 289 JOURNAL OF THE AMERICAN MEDICAL ASSOCIATION 1976 (2003).	EX1017
P. Henry et al., <i>Bone Conduction: Anatomy, Physiology, and Communication</i> , Army Research Laboratory, ARL-TR-4138 (May 2007)	EX1018
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Excerpts from L. BAXTER, CAPACITIVE SENSORS: DESIGN AND APPLICATIONS (IEEE Press 1997)	EX1025
Excerpts from P. HOROWITZ AND W. HILL, THE ART OF ELECTRONICS (Cambridge Univ. Press 2nd Ed. 1989)	EX1026
Curriculum Vitae of Dr. Chris Kyriakakis	EX1027
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), Dkt. 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), Dkt. 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), Dkt. No. 81	EX1031 (NEW)
Docket Navigator, Judge Albright Time-to-Trial Statistics for 2025	EX1032 (NEW)
<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)
Compare AirPods models, https://www.apple.com/airpods/compare/	EX1040 (NEW)
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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
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Scheduling Order, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 39 (W.D. Tex. Dec. 5, 2025)	2005
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RESERVED	2007
RESERVED	2008
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Defendant's Proposed Claim Constructions, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867 (W.D. Tex. Dec. 22, 2025)	2011
RESERVED	2012
RESERVED	2013
RESERVED	2014

Exhibit Description	Exhibit #
Declaration of Peter Tong	2015
RESERVED	2016
RESERVED	2017
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)	2018
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
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New Electronics Article (Jan. 8, 2026)	2022
AppleInsider Article (Oct. 25, 2025)	2023
Exhibit B-3 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)	2024
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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) ("*Bulletproof*") (informative), 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. The same considerations are present here, including Apple's extensive and expanding domestic manufacturing presence. Patent Owner neither addresses the *Bulletproof* decision nor disputes these parallels.

First, the *Fintiv* factors favor institution. Judge Albright's announced August 2026 departure leaves the co-pending 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 co-pending litigation, particularly in view of Apple's *Sotera* stipulation. *See Bulletproof*, 2–3.

Second, the '693 patent issued because of material Office error. *See Bulletproof*, 3–4. The Examiner's review was neither robust nor accurate: the application was misclassified to an optics art unit, the Examiner's searches were

limited to eyewear-specific terms with typographical errors, leading to the exclusion of relevant wearable audio and hearing aid art; and the Examiner failed to correctly search the very limitations that he relied on for allowance. These errors are material and further support referral to the Board.

Third, Apple’s challenge is timely: the ’693 patent issued in May 2023, just three years before the Petition. As the Director found in *Shenzhen*, patents that “have not been in force for a significant period of time,” including patents less than four years old, do not support “strong settled expectations that favor discretionary denial.” *Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00438, Paper 10, 2 (July 17, 2025); *Bulletproof*, 4 (no strong settled expectations for patents issued between 2024 and 2025). 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.

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. As in *Bulletproof*, where the Director found that the petitioner’s evidence of U.S. manufacturing “further demonstrates that discretionary denial in these proceedings is not appropriate,” Apple’s domestic manufacturing evidence

supports institution. *Bulletproof*, 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, and Apple’s documentary prior art does not rely on different priority dates for the Petition and the litigation, defeating any “gamesmanship” theory.

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, 18.) 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, 5.) 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, 1–2.) 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; EX1033, 3.) 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 the extent to which 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 ’693 Patent Resulted from Material USPTO Error

The ’693 patent resulted from multiple material Office errors that prevented the Examiner from identifying material prior art. *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.

1. 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, 1228–1229, 608–650.) But the '693 patent claims personal electronic apparatuses with speakers that output customized audio; no claim recites an optical component. (EX1001, 109:60–118:51.) Patent Owner does not dispute the misclassification, and instead only disputes that “a different classification would have led to a different outcome.” (Request, 16.) But the outcome is apparent: the optics classification steered the Examiner away from wearable audio and hearing aid prior art, including Anderson, that renders the claims obvious.

2. The Examiner’s Searches Were Error-Filled and Improperly Limited to Eyewear

The Examiner’s keyword searches repeatedly used eyewear-specific terms, such as “eyewear\$4” and “glasses\$4”, combined with structural eyewear terms like “frame,” “temple,” and “bridge”. (*See, e.g.*, EX1002, 387–393, 401–407, 591–593, 599–606, 652–654, 925–927, 980–987, 1318–1325, 1369–1371, 1432–1440.) His web searches followed the same pattern, limiting queries to optical terms like “electric eyeglasses,” “audio smart glasses,” and “ski goggles”; eyewear parts such as temples, frames, and hinges; and eye-specific terms such as “ophthalmic.” (EX1002, 505–510, 803, 821, 713–714, 804.)

But the claims are not limited to eyewear and do not include the above limitations. They recite a “personal audio system” comprising a pair of ear buds, or a head-worn wearable electronic device 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.

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. Those errors appeared in dozens of queries as the Examiner copied and pasted the same erroneous terms into new searches. (*See, e.g.*, EX1002, 387–393, 401–407, 456, 591–593, 599–606, 652–654, 761–767, 872–879, 925–927, 980–987, 1318–1325, 1432–1440.) References containing, *e.g.*, the correctly spelled “spectacle” or “eyeglass” were potentially overlooked by these defective queries.

3. The Examiner Failed to Search the Alleged Point of Novelty

The Examiner compounded his errors by allowing the claims based on untested limitations. The Examiner initially rejected claims 1–3 as anticipated by Swab, but withdrew that rejection after the applicant amended the claims to recite storing a hearing profile that “characterizes hearing impairment,” and producing “customized audio output signals” to compensate for the hearing impairment. (EX1002, 353–358, 580–587, 776–781.) The Examiner's Notice of Allowance identified Swab as the single closest prior art, but concluded that it failed to teach those added limitations. (EX1002, 786–791.)

The Examiner’s search history, however, shows no meaningful investigation of those limitations. After the applicant’s December 1, 2022 amendment, the Examiner “update[d]” his earlier search; but only a small fraction of his search queries related to hearing aids or impairments or were otherwise directed to the added limitations. (EX1002, 796, 799–987.) Even his few searches on that subject were restricted by unclaimed eyewear features (*e.g.*, frame, temple) and clerical errors (*e.g.*, “spetac\$4”). (*See, e.g.*, EX1002, 805–806, 831–832, 975.) And the Examiner’s patent searches on the subject were inexplicably directed to references from before the 1950s. (EX1002, 805–806.) That cursory inquiry, on the purported point of novelty, helps explain why the Examiner stopped at Swab and did not arrive at the prior art of the Petition.

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

Patent Owner’s settled expectations argument fails at the threshold. The ’693 patent issued in May 2023—just three years before the Petition was filed. (EX1001.) In *Shenzhen*, the Director found that the patents “have not been in force for a significant period of time,” including patents issued between 2020 and 2024, and do not support “strong settled expectations that favor discretionary denial.” *Shenzhen*, 2; *Bulletproof*, 4. The same is true here—the ’693 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 (Sep. 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 ’693 patent’s validity. Patent Owner’s declarant states only that “[t]he ’693 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 enforcement history gave Apple reason *not* to expect enforcement of the ’693 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, IpVenture, Inc., 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 that patent expired.

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.) 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 (W.D. Tex. June 10, 2022), Dkt. No. 68;

IOENGINE, LLC v. Roku Inc., No. 6:21-cv-01296-ADA (W.D. Tex. Sep. 19, 2023), Dkt. No. 306. 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 November 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.

The contrast is stark: the district court schedule is uncertain, while the Board’s timeline is fixed by statute. Institution would provide the parties, the court, and the public a stable and efficient path to resolving the patentability dispute. Factor 2 therefore weighs heavily against discretionary denial.

3. Factor 3: The Investment in the 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's, Inc. v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11, 10 (Mar. 27, 2025). Because the most substantive 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 the 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, 8–10.) But it only points to six references (Anderson, Nemirovski, Eaton, Irvin, Bodley, Zadesky) from Apple's preliminary invalidity contentions, out of dozens cited in those contentions, that are also found in the Petition. (Request, 8–10.) In the district court, 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, 21–28.) That limited use does not show any attempt to avoid estoppel.

Patent Owner alleges that, in the litigation, Apple asserts a priority date of September 24, 2021, thus “resulting in the availability of additional prior art that would not be available in this IPR” based on the July 28, 2004, priority date assumed in the Petition. (Request, 10–11.) But as discussed in Section II.E *infra*, all of Apple’s documentary prior art relies on the same priority date and prior art legal standard in the Petition and the litigation for the ’693 patent. Even if it did not, Apple’s *Sotera* stipulation extends to *any ground* that reasonably could have been raised in this proceeding, and does not depend on any priority date asserted in the litigation. (Paper 7.) Such stipulations “weigh[] strongly” against discretionary denial by “mitigat[ing] 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). Patent Owner’s reliance on *Google*, in which the petitioner expressly made its stipulation conditional on its priority date arguments in the district court, is thus inapplicable. *Google LLC v. AGIS Software Dev., LLC*, IPR2020-00870, Paper 16, 15 (Nov. 25, 2020).

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. But that fact does not support denial where, as here, the other *Fintiv* considerations favor institution. 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 67 of the patent’s 76 claims are obvious over multiple grounds based on prior art not presented or considered during prosecution. The Board has already instituted *inter partes* review of two patents asserted by Patent Owner in the same litigation. IPR2026-00143, Paper 13 (May 15, 2026); IPR2026-00253, Paper 13 (July 21, 2026). Three additional petitions presenting similar references, grounds, and examiner errors challenging the related ’355 patent (IPR2026-00331, IPR2026-00332) and the same ’693 patent (IPR2026-00340) are pending. Coordinated review of related patents promotes efficiency and consistency. *See Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, 3–4 (July 16, 2025) (informative).

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. Because the Petition challenges the asserted claims of the '693 patent and presents strong unpatentability grounds, Board review can materially streamline the litigation.

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 Positions or 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 '693 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." (EX1014, 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.” (EX1042, 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 Anderson’s electronic headset 21 and earpiece 22 are head-worn because, *e.g.*, they include a headband that rests on the user’s head for support. (Pet., 25.) Further, the Petition explains that each speaker is “wearable near (and thus proximate to) its respective ear” when the headset is worn; and the Petition does not rely on any speaker as being both proximate to an ear and inside the ear. (Pet., 26–27.) These mappings directly track Apple’s district court proposals, and the Petition does not rely on broader or different constructions than those Apple advanced in the district court.

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.

Patent Owner further alleges that, in the litigation, Apple asserts a priority date of September 24, 2021, which is later than the July 2004 priority date assumed for this proceeding; and further assumes that Apple applies AIA law based on the 2021 date. (Request, 15.) But in Apple’s invalidity contentions for the ’693 patent, all asserted patents and printed publications qualify as prior art based on the July 2004 priority date, and only pre-AIA law is applied. (EX1043, 1–3; EX1044, 1–3; EX1045, 1–4.) This is the same priority date and the prior art legal standard that Apple applies in the Petition.

In any event, the Petition’s prior art and arguments—and Dr. Kyriakakis’s analysis—would apply equally under AIA law or under a later priority date, as Patent Owner does not dispute. (Pet., 6; EX1003, ¶25.) Thus, even if Apple’s positions on the ’693 priority date were different, it would not raise concerns of misleading a tribunal or seeking a litigation advantage, as cautioned against in *Magnolia Medical. Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17, 4 (May 14, 2026) (precedential).

IPR2026-00339

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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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