

Filed on behalf of IngenioSpec, LLC
By: Douglas R. Wilson
Michelle E. Armond
Joseph Li
Monica Arnold
ARMOND WILSON LLP
4685 MacArthur Court, Suite 390
Newport Beach, CA 92660
Telephone: (949) 932-0778
Email: ipr@armondwilson.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

INGENIOSPEC, LLC,
Patent Owner.

Case No. IPR2026-00340
U.S. Patent No. 11,644,693

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	THIS SECOND PETITION CHALLENGING THE '693 PATENT IS UNNECESSARY AND SHOULD BE DENIED	2
III.	PATENT OWNER’S SETTLED EXPECTATIONS FAVOR DISCRETIONARY DENIAL	3
IV.	THE <i>FINTIV</i> FACTORS SUPPORT DISCRETIONARY DENIAL	5
1.	Factor 1: Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.....	6
2.	Factor 2: The proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.....	7
3.	Factor 3: Investment in the parallel proceeding by the court and the parties.	8
4.	Factor 4: Overlap between issues raised in the petition and in the parallel proceeding.	9
5.	Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party.	12
6.	Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits.....	12
7.	None Of The <i>Fintiv</i> Factors Supports Institution.....	14
V.	PETITIONER’S INCONSISTENT POSITIONS WARRANT DISCRETIONARY DENIAL	14
VI.	APPLE IDENTIFIED NO MATERIAL ERROR WARRANTING IPR	17
VII.	APPLE’S MANUFACTURING ABROAD WEIGHS AGAINST INSTITUTION.....	19
VIII.	APPLE CANNOT JUSTIFY USE OF BOARD RESOURCES.....	20
IX.	CONCLUSION	20

TABLE OF AUTHORITIES

<i>Advanced Micro Devices v. Concurrent Ventures</i> , IPR2025-00223, Paper 9 (P.T.A.B. June 12, 2025).....	8
<i>Alliance Laundry Sys. v. PayRange</i> , IPR2025-00950, Paper 11 (P.T.A.B. Sept. 19, 2025)	4
<i>Alpinestars v. Dainese</i> , IPR2025-00750, Paper 17 (P.T.A.B. Feb. 9, 2026)	13
<i>Amazon.com v. Audio Pod IP</i> , IPR2025-00768, Paper 15 (P.T.A.B. Aug. 14, 2025)	5
<i>Apple v. Fintiv</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020).....	5
<i>Belden v. CommScope</i> , IPR2025-00833, Paper 13 (P.T.A.B. Sept. 12, 2025)	18
<i>Cipla v. Gilead Scis.</i> , IPR2025-00033, Paper 22 (P.T.A.B. May 15, 2025).....	8
<i>Dabico Airport Sols. v. AXA Power</i> , IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025).....	20
<i>Edge Networking Sys. v. Microsoft</i> , No. 1:24-cv-00215-ADA, Dkt. 63 (W.D. Tex. Nov. 21, 2025)	6
<i>Full-Metal-Power v. InFocus Downhole Sols.</i> , IPR2025-00391, Paper 14 (P.T.A.B. June 25, 2025).....	6, 7
<i>Google v. AGIS Software Dev.</i> , IPR2020-00870, Paper 16 (P.T.A.B. Nov. 25, 2020)	11
<i>Hisense v. VideoLabs</i> , IPR2025-00880, Paper 11 (P.T.A.B. Oct. 10, 2025)	4
<i>Intellectual Ventures v. Hewlett Packard Enterp.</i> , No. 6:21-cv-00596-ADA, 2022 WL 22870184 (W.D. Tex. Dec. 22, 2022).....	6

Apple Inc. v. IngenioSpec, LLC
U.S. Patent No. 11,644,693 – IPR2026-00340

<i>Magnolia Med. Techs. v. Kurin,</i> IPR2026-00097, Paper 17 (P.T.A.B. May 14, 2026).....	1, 3, 8, 15, 17
<i>Motorola Sols. v. Stellar,</i> IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025).....	10, 11
<i>Nvidia v. Neural AI,</i> IPR2025-00606, Paper 18 (P.T.A.B. July 31, 2025)	5
<i>NXP USA v. Redstone Logics,</i> IPR2025-00485, Paper 11 (P.T.A.B. July 10, 2025).....	7, 9
<i>Revvo Techs. v. Cerebrum Sensor Techs.,</i> IPR2025-00632, Paper 20 (P.T.A.B. Nov. 3, 2025)	15
<i>Revvo Techs. v. Cerebrum Sensor Techs.,</i> IPR2025-00632, Paper 36 (P.T.A.B. Jan. 26, 2026).....	16
<i>Samsung Elecs. v. Cerence Operating,</i> IPR2025-00458, Paper 14 (P.T.A.B. June 25, 2025).....	6, 7
<i>Samsung Elecs. v. VB Assets,</i> IPR2025-00870, Paper 11 (P.T.A.B. Oct. 10, 2025)	20
<i>Shenzen Tuozhu Tech. v. Stratasys,</i> IPR2025-00354, Paper 11 (P.T.A.B. June 12, 2025).....	7, 11
<i>SK Innovation v. LG Chem,</i> IPR2020-00991, Paper 14 (P.T.A.B. Nov. 30, 2020)	9
<i>Sun Pharms. Indus. v. Nivagen Pharms.,</i> IPR2025-00893, Paper 18 (P.T.A.B. Sept. 19, 2025).....	16
<i>TikTok v. NTECH Props., I</i> PR2024-01339, Paper 9 (P.T.A.B. Feb. 25, 2025)	14
<i>Xerox v. Bytemark,</i> IPR2022-00624, Paper 9 (P.T.A.B. Aug. 24, 2022)	13, 14

OTHER AUTHORITIES

35 U.S.C. § 314	5, 14
Interim Director Discretionary Process § I.D.	11
Memorandum, “Additional Discretionary Institution Considerations – U.S. Manufacturing and Small Business Use of AIA Proceedings,” (Mar. 11, 2026).	19
Memorandum, “Interim Processes for PTAB Workload Management” (Mar. 26, 2025)	4, 12

TABLE OF EXHIBITS

Exhibit No.	Description
2001	Complaint, <i>IngenioSpec, LLC v. Apple Inc.</i> , Case No. 1:25-cv-00867, Dkt. No. 1 (W.D. Tex. June 5, 2025)
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	RESERVED
2022	RESERVED
2023	RESERVED

Apple Inc. v. IngenioSpec, LLC
U.S. Patent No. 11,644,693 – IPR2026-00340

Exhibit No.	Description
2024	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)

I. INTRODUCTION

Because the district court will try all issues involved in this IPR 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 and other issues, 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 '693 Patent. Paper 2 ("Pet."); IPR2026-00339, 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 November 1, 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; IPR2026-00332, Paper 2; IPR2026-00339, 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 six additional claims 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, 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 and other positions in the two forums. The Petition also lacks merit. Institution should be denied.

II. THIS SECOND PETITION CHALLENGING THE ’693 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 ’693 Patent. *See* Paper 3 at 1. Apple asserts that this

Petition “challenges only six claims, with the remaining 67 claims challenged in IPR2026-00339” and that “each ground rel[ies] on the same primary reference.” 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. As Apple admits, the six challenged claims are “dependent claims that depend from claims challenged in IPR2026-00339.” Paper 3 at 3 n.1. Apple attempts to justify its resort to a second petition by asserting that “the asserted claims alone comprise approximately 4,500 words—roughly one third of the 14,000-word limit for a single petition.” *Id.* at 3. But Apple omits that it did not recite the claim language in its IPR2026-00339 petition, instead resorting to an appendix. *See, e.g.*, IPR2026-00339, Paper 2 at 11-98, 102-21 (claims appendix). Apple’s second-ranked Petition here should be denied as an inefficient use of Board and party resources litigating incremental challenges to dependent claims that could have been included in a single petition. *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”). The ’693 Patent issued over three years ago, and IngenioSpec has licensed the patent as well as provided actual notice to Apple creating settled expectations. 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 ’693 Patent would be an inefficient use of Board resources.

The challenged patents, including the ’693 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 ’693 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 '693 Patent would be inefficient. While the '693 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 '693 Patent, *see* EX2006 at 21-41, “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. *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, *six months before* the November 1, 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,” the six-month gap between the district court trial and the final written decision deadline only 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 nearly three months ago. 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 ’693 Patent.” EX2006 at 28. In this IPR, Apple challenges the same Claims 26, 52-53, and 72-74 of the ’693 Patent based on at least the identical Anderson, Nemirovski, and Irvin references.¹ *Compare* EX2006 at 22-23, *with* Pet. at 5-6; *see also* EX2006 at 2, 28. 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).

¹ Apple also filed a separate Petition challenging Claims 1-25, 27-38, 42-51, 54-71, and 75-76 of the ’693 Patent. *See* IPR2026-00339, Paper 2 at 5-7.

The district court litigation will also resolve issues beyond those in the IPR. Apple’s Petition is confined to whether a subset of ’693 Patent “claims are unpatentable... as obvious, in view of the prior art.” Pet. at 5. Those issues are subsumed in the co-pending litigation. *See, e.g.*, EX2006 at 21-24. In addition to obviousness under 35 U.S.C. § 103, in the district court litigation, Apple asserts invalidity theories under §§ 101, 102, and 112, including written description and *Alice* challenges. *See id.* at 21-41. 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 renders its limited stipulation meaningless. *See* EX2006 at 24-28 (identifying “prior art apparatuses/systems”); EX2024 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,”

“Nemirovski,” and “Irvin,” which are EX1004, EX1005, and EX1007, 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. *Motorola Sols.*, IPR2024-01205, Paper 19 at 4; *Shenzen Tuoazhu*, 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.”).

Additionally, Apple’s narrow stipulation is ambiguous in restricting Apple from pursuing a different set of validity challenges against the same patent in a different forum. In particular, in the district court, Apple challenges the ’693 Patent’s priority date, resulting in the availability of additional prior art that would not be available in this IPR based on the asserted priority date here. *Compare* Pet. at 2 (“For purposes of this Petition only, a priority date of July 28, 2004 is assumed.”), *with* EX2006 at 107 (asserting that the ’693 Patent is “only entitled to a priority date as early as September 24, 2021”). Thus, Apple’s stipulation rings hollow. *See, e.g., Google v. AGIS Software Dev.*, IPR2020-00870, Paper 16 at 15-16 (P.T.A.B. Nov. 25, 2020) (denying institution and discounting petitioner’s stipulation where it

“expressly preserves the right to make arguments regarding the priority date of Patent Owner’s asserted patents in the parallel District Court proceeding”).

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’s proposed combination of Anderson’s embodiments is unsupported. In its discussion of Claim 24, the Petition proposes “combin[ing] headset 21 and its earpiece 22 with the full-featured FIG. 1 embodiment.” Pet. at 16. More specifically, the Petition asserts that one of skill in the art “would have been motivated to use the headset” of Anderson’s limited-feature embodiment “instead of the [completely-in-the-canal] housing” of Anderson’s full-featured embodiment. Pet. at 15. This proposed combination 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.” EX1004 at 2:32-35. Indeed, in describing the “[d]esirable features” of the full-featured embodiment, Anderson expressly states: “The earpiece is preferably smaller than the head of a cotton swab so as to be hidden from view for the majority of users. FIG. 1 depicts an earpiece 10 that provides the desired CIC form factor.” EX1004 at 6:48, 6:57-60. The Petition’s proposed combination “lack[s] rational underpinning” and would make Anderson’s full-featured embodiment “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.” EX1004 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.””). Because each of challenged Claims 26, 52-53, and 72-74 depend from Claim 24, Apple’s baseless proposed modification is fatal to the entire Petition.

Second, 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 10-12, 22-28, 37-44, 48-53, with EX1003 ¶¶ 221-241, 337-355. 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 28 Ground 1, Claim 53[B]	Kyriakakis Decl. ¶ 241 Ground 1, Claim 53[B]
Anderson discloses that a user can provide voice commands, which are “received as audio signals” by the head-worn earpiece and transmitted to the RPU (EX1004, 25:15-30; EX1003, ¶241.) The POSITA would have understood the audio signals to be picked up by the microphones, which are the components of the earpiece that receive audio signals. (EX1004, 5:3-6, 6:8-15, 22:62-23:5; EX1003, ¶241.) The voice commands cause the RPU to “initiate actions” of the earpiece such as changing hearing aid parameter settings (<i>e.g.</i> , volume). (EX1004, 25:22-27; EX1003, ¶241.)	241. Anderson discloses that a user can provide voice commands, which are “received as audio signals” by the head-worn earpiece and transmitted to the RPU (EX1004, 25:15-30.) The POSITA would have understood the audio signals to be picked up by the microphones, which are the components of the earpiece that receive audio signals. (EX1004, 5:3-6, 6:8-15, 22:62-23:5.) The voice commands cause the RPU to “initiate actions” such as changing hearing aid parameter settings (<i>e.g.</i> , volume). (EX1004, 25:22-27.)

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 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 5 (emphasis added), while simultaneously proposing in the district court that

- limitations reciting a “head-worn” device in Claims 26, 52-53, and 72-73 be construed as “electronic eyewear or headwear,” EX2011 at 1; Pet. at 4, and
- limitations reciting “speaker[s]... proximate to” an ear, a first ear, or a second ear in Claim 24, from which Claims 26 and 52-53 depend, and Claim 42, from which Claims 52-53 depend, 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.’”).

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 the “head-worn” device limitations 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 in view of Apple’s inconsistent claim construction positions.

Apple is also inconsistent with its reliance on AIA and pre-AIA laws. For this IPR, Apple challenges patent validity under pre-AIA 35 U.S.C. § 103, *see* Pet. at 6, whereas Apple’s asserted district court priority date of September 24, 2021, *see supra* § IV.4, means Apple apparently is also challenging validity under the AIA in the litigation. Thus, Apple attacks the ’693 Patent using its fully claimed priority

date in this IPR and a different, limited priority date in the district court. Its inconsistent applicable law and priority date positions further warrant denying institution. *See, e.g., Magnolia Med. Techs.*, IPR2026-00097, Paper 17 at 4.

VI. APPLE IDENTIFIED NO MATERIAL ERROR WARRANTING IPR

Despite conceding that the examiner considered “hundreds of references,” Apple claims that the “Examiner’s prior art search was deficient for being underinclusive and tainted by errors in the search classification and queries.” Pet. at 2. Apple’s claims of error are unsupported and meritless.

Apple first refers to “multiple defects in the search process, including the application’s unduly narrow classification for search purposes as an optical system under G02C.” Pet. at 2. But Apple’s conclusory assertion provides no explanation why the application’s classification was unduly narrow, much less proves material error stemming therefrom during examination. Indeed, 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 an allegedly narrow classification can be the basis for a Patent Office error warranting institution. Apple also overlooks that the ’693 Patent’s field of classification search included G02B and the USPC classification searches in class 381 for “Electrical Audio Signal Processing Systems and Devices.” *See* EX1001 at 1 (Field 58).

Apple next asserts that “the Examiner’s unsound search methodology” was allegedly “directed to optical systems.” Pet. at 2-3. But Apple never addresses the examiner’s *hundreds of pages* of countless search terms, including many that are not limited to “optical systems,” and the PE2E similarity searches. *See, e.g.*, EX1002 at 387-551, 591-740, 761-767, 799-847, 867-992, 1232-1291, 1314-1446; *see also, e.g., id.* at 505 (“speaker audio device audio wearable wireless wireless audio”), 515 (“hearing aid temple temples microphone housing”), 522 (“audio interface wearer signal audio support”), 525 (“radiation output electronic circuit recited monitoring”), 530 (“ear transducer wearer insert sound”), 532 (“portable access access unit general purpose data media device”), 534 (“battery hearing aid case sound frame”). Further still, the cited art listed on the ’693 Patent itself shows the examiner considered a substantial number of references beyond optical systems. *See, e.g.*, EX1001 at 2-3 (US 5,694,475 A titled “Acoustically transparent earphones”; US 2002/0081982 A1 titled “Portable ear devices”).

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

Additional discretionary denial considerations, such as “whether 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,” 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, AirPods Pro, and iPhones are accused of infringing the ’693 Patent. EX2001 ¶ 34. 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 primarily in China mainland, India, Japan, South Korea, Taiwan and Vietnam.”). 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. 11,644,693 – IPR2026-00340

ARMOND WILSON LLP

Dated: June 30, 2026

By: /Douglas R. Wilson/
Douglas R. Wilson (Reg. No. 54,542)
Michelle E. Armond (Reg. No. 53,954)
Joseph Li (Reg. No. 74,998)
Monica Arnold (Reg. 77,262)
Attorneys for IngenioSpec, LLC

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, 2018-2020, and 2024** are being served electronically on June 30, 2026 to the following lead and backup counsel for Petitioner to the following email addresses:

Alex S. Yap
AYap@mofo.com

Mehran Arjomand
MArjomand@mofo.com

Bryan Blumenkopf
BBlumen@mofo.com

Apple-IngenioSpec-IPR@mofo.com

ARMOND WILSON LLP

Dated: June 30, 2026

By: /Douglas R. Wilson/
Douglas R. Wilson (Reg. No. 54,542)
Michelle E. Armond (Reg. No. 53,954)
Joseph Li (Reg. No. 74,998)
Monica Arnold (Reg. 77,262)
Attorneys for IngenioSpec, LLC