

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLE INC.,  
Petitioner,

v.

ADVANCED CODING TECHNOLOGIES LLC,  
Patent Owner.

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IPR2025-01070 (Patent 9,042,448 B2)  
IPR2025-01103 (Patent 8,230,101 B2)  
IPR2025-01158 (Patent 10,218,995 B2)

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Before COKE MORGAN STEWART, *Deputy Under Secretary of  
Commerce for Intellectual Property and Deputy Director of the United  
States Patent and Trademark Office.*

DECISION

Referring the Petition in IPR2025-01103 to the Board and Denying  
Institution of *Inter Partes* Review in IPR2025-01070 and IPR2025-01158

IPR2025-01070 (Patent 9,042,448 B2)  
IPR2025-01103 (Patent 8,230,101 B2)  
IPR2025-01158 (Patent 10,218,995 B2)

Advanced Coding Technologies LLC (“Patent Owner”) filed a request for discretionary denial (Paper 6, “DD Req.”) in the above-captioned cases, Apple Inc. (“Petitioner”) filed an opposition (Paper 8, “DD Opp.”).<sup>1</sup>

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in IPR2025-01103 but is appropriate in IPR2025-01070 and IPR2025-01158. This determination is based on the totality of the evidence and arguments the parties have presented.

IPR2025-01070 and IPR2025-01158 present essentially the same discretionary considerations as those presented in IPR2025-00983, IPR2025-00984, and IPR2025-00991. *See, e.g., Apple Inc. v. Advanced Coding Techs. LLC*, IPR2025-00983, Paper 10 (Director Oct. 3, 2025) (granting Patent Owner’s request for discretionary denial). Accordingly, that analysis is incorporated here. *Id.* at 2–3.

IPR2025-01103 presents different circumstances. Petitioner provides persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims. In particular, during prosecution, the patent examiner issued an office action rejecting the independent claims, and separately rejecting dependent claims 6 and 7 as obvious over a combination of art including Fiechter.<sup>2</sup> Ex. 1002, 111–113. The applicant subsequently submitted an amendment to the independent claims, and did not address the rejection of dependent claims 6 and 7 over Fietcher. *Id.* at 84–92. The patent examiner then issued a final office action, again rejecting the

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<sup>1</sup> Citations are to papers in IPR2025-01070. The parties filed similar papers in IPR2025-01103 and IPR2025-01158.

<sup>2</sup> US 7,219,123 B2, issued May 15, 2007. (Ex. 1006).

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independent claims, but not addressing the patentability of dependent claims 6 and 7. *Id.* at 63–78. The applicant responded with a request for continued examination, noting that dependent claims 6 and 7 were not rejected in the final office action, and, accordingly, among other things, incorporated the subject matter of claim 6 and 7 into independent claims 1 and 8. *Id.* at 46–56. The independent claims were then allowed without any discussion of the prior rejection of the subject matter of claims 6 and 7, which appears to have been the basis for the allowance of the claims. *Id.* at 11–19. Accordingly, as Petitioner persuasively argues, the Office appears to have erred in a manner material to the patentability of the challenged claims by first rejecting claims 6 and 7 over *Fletcher*, but then subsequently allowing claims that include the subject matter of those claims without again addressing the patentability of the claimed subject matter in view of *Fletcher*. DD Opp. 5–15; *see* Pet. 4.

Although certain arguments are highlighted above, the determinations in this Decision are based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions in IPR2025-01070 and IPR2025-01158 are denied under 35 U.S.C. §314(a), and the Petition in IPR2025-01103 is referred to the Board to handle the case in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner’s requests for discretionary denial in IPR2025-01070 and IPR2025-01158 are *granted*;

FURTHER ORDERED that the Petitions in IPR2025-01070 and IPR2025-01158 are *denied* and no trial is instituted;

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ORDERED that Patent Owner's request for discretionary denial in IPR2025-01103 is *denied*;

FURTHER ORDERED that the Petition in IPR2025-01103 is referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of the decision to deny Patent Owner's request for discretionary denial in IPR2025-01103 until the Board issues a decision on institution.

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