

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

ADVANCED CODING TECHNOLOGIES LLC,
Patent Owner

Case IPR2025-01103
Patent 8,230,101

**PETITIONER'S MOTION TO WITHDRAW ALL CHALLENGES TO
CLAIMS 1-6 OF U.S. PATENT NO. 8,230,101**

LIST OF EXHIBITS

APPLE-1001	U.S. Patent No. 8,230,101
APPLE-1002	U.S. Patent No. 8,230,101 File History
APPLE-1003	Declaration of Dr. Erez Zadok
APPLE-1004	U.S. Patent Publication No. 2006/0161635 to Lamkin et al. ("Lamkin")
APPLE-1005	U.S. Patent Publication No. 2003/0195924 to Franke et al. ("Franke")
APPLE-1006	U.S. Patent No. 7,219,123 to Fiechter et al. ("Fiechter")
APPLE-1007	U.S. Patent Publication No. 2004/0006606 to Marotta et al. ("Marotta")
APPLE-1008	U.S. Patent Publication No. 2002/0184457 to Yuasa et al. ("Yuasa")
APPLE-1009	U.S. Patent Publication No. 2008/0104219 to Kageyama et al. ("Kageyama")
APPLE-1010	U.S. Patent Publication No. 2006/0184972 to Rafey et al. ("Rafey")
APPLE-1011	U.S. Patent Publication No. 2007/0238471 to Bae et al. ("Bae")
APPLE-1012	International Patent Publication No. WO2006/073040 to Ito et al. with certified English translation ("Ito")
APPLE-1013	U.S. Patent Publication No. 2002/0099952 to Lambert, et. al. ("Lambert")

- APPLE-1014 U.S. Patent Publication No. 2002/0010819 to Dye (“Dye”)
- APPLE-1015 U.S. Patent Publication No. 2004/0220926 to Lamkin (“Lamkin ’926”)
- APPLE-1016 U.S. Patent Publication No. 2005/0281185 to Kawasaki (“Kawasaki”)
- APPLE-1017 Microsoft Computer Dictionary, 5th ed., 2002, excerpts (“Microsoft Computer Dictionary”)
- APPLE-1018 Abraham Silberschatz and Peter B. Galvin, *Operating Systems Concepts*, 4th Edition, 1994, Addison-Wesley Publishing, excerpts (“Silberschatz”)
- APPLE-1019 Andrew S. Tanenbaum, *Computer Networks*, 2nd ed., 1988, excerpts (Tanenbaum)
- APPLE-1020 W. Richard Stevens, *TCP/IP Illustrated Volume 1, The Protocols*, 1994, excerpts (Stevens)
- APPLE-1021 William R. Cheswick & Steven M. Bellovin, *Firewalls and Internet Security, Repelling the Wily Hacker*, 1994, excerpts (Cheswick)
- APPLE-1022 U.S. Patent No. 6,687,846 to Adrangi et al. (“Adrangi”)
- APPLE-1023 U.S. Patent No. 6,487,663 to Jaisimha et al. (“Jaisimha”)
- APPLE-1024 U.S. Patent No. 6,732,365 to Belknap et al. (“Belknap”)
- APPLE-1025 U.S. Patent Publication No. 2008/0060081 to Van Den Heuvel (“VDH”)
- APPLE-1026 Digital Living Network Alliance (DLNA), *Overview and Vision*, White Paper, June 2004 (“DLNA Overview”)

- APPLE-1027 UPnP Forum Version 1.0 Approved Standard, *MediaServer:2 Device Template Version 1.01*, Document Version 1.00, May 31, 2006 (“UPnP MediaServer”)
- APPLE-1028-1053 [RESERVED]
- APPLE-1054 “Apple Increases U.S. Commitment to \$600 Billion, Announces American Manufacturing Program,” Apple Newsroom, Apple, 6 Aug. 2025, <https://www.apple.com/newsroom/2025/08/apple-increases-us-commitment-to-600-billion-usd-announces-ambitious-program/>
- APPLE-1055 “Welcome to the Alliance for Open Media,” <https://aomedia.org/about/story/> (last visited Sept. 2, 2025)
- APPLE-1056 “Members,” <https://aomedia.org/about/members/> (last visited Sept. 2, 2025)
- APPLE-1057 ’101 Patent Assignment Abstract of Title for Application 12527777
- APPLE-1058 PTAB Trial Statistics FY22 End of Year Outcome Roundup IPR, PGR, https://www.uspto.gov/sites/default/files/documents/ptab_aia_fy2022_roundup.pdf
- APPLE-1059 Order Granting Stay in *Maxeon Solar PTE. LTD. V. Hanwha Solutions Corp. et al.*, case no. 2:24-CV-00262-JRG (EDTX)
- APPLE-1060 Order Granting Stay in *Cellspin Soft, Inc. v. Bytedance Ltd., et al.*, case no. 2:23-CV-00496-JRG-RSP (EDTX)
- APPLE-1061 Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings, June 21, 2022, *available at* <https://www.uspto.gov/sites/default/files/documents/interim>

[_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf](#)

- APPLE-1062 The Patent Trial and Appeal Board and *Inter Partes* Review, Congressional Research Service, Updated May 28, 2024
- APPLE-1063 Complaint for Patent Infringement, *Advanced Coding Tech's LLC v. Samsung Electronics Co. LTD et al.*, EDTX-2-22-cv-00499 (EDTX December 30, 2022)
- APPLE-1064-1065 [RESERVED]
- APPLE-1066 H.R. Rep. No. 112-98 – America Invents Act, pt. 1, available at <https://www.congress.gov/congressional-report/112th-congress/house-report/98/1> (last accessed on May 27, 2025)
- APPLE-1067 U.S. District Court for the Eastern District of Texas Calendar Events Set for 4/20/2026 for Judge Rodney Gilstrap
- APPLE-1068 Federal Court Management Statistics-Profiles, U.S. District Courts—Combined Civil and Criminal (June 2025), *accessed from* https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0630.2025.pdf
- APPLE-1069 LegalMetric Individual Judge Report for Judge James Rodney Gilstrap Patent Cases December 2011 to January 2025
- APPLE-1070 Docket Navigator Report – Advanced Coding Technologies Litigation History
- APPLE-1071 America Invents Act: Hearing on H.R. 1249 Before the Subcommittee. on Intellectual Property, Competition, & the Internet of the House Committee on the Judiciary, 112th Congress (March 30, 2011)

- APPLE-1072 ACT Addresses in EDTX,
<https://advancedcodingtechnologies.com/about> (last visited September 4, 2025)
- APPLE-1073-1100 [RESERVED]
- APPLE-1101 Complaint for Patent Infringement (August 20, 2024), Case No. 2-24-CV-00687 (EDTX), Document 1
- APPLE-1102 Appendix E-3 to Complaint for Patent Infringement – Claim Chart for U.S. Patent No. 8,230,101 Against Apple HomeKit Secure Video Products
- APPLE-1103 Appendix E-2 to Complaint for Patent Infringement – Claim Chart for U.S. Patent No. 8,230,101 Against Products with HTTP Live Streaming (HLS)
- APPLE-1104 Appendix E-1 to Complaint for Patent Infringement – Claim Chart for U.S. Patent No. 8,230,101 Against Apple Products with iCloud Storage
- APPLE-1105 Interim Process for PTAB Workload Management, Memorandum dated March 26, 2025, downloaded from <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>
- APPLE-1106 Patent Trial and Appeal Board (PTAB) Boardside Chat: Interim processes relating to institution in AIA proceedings, downloaded from https://www.uspto.gov/sites/default/files/documents/boardside_chat_interim_process_for_aia_institution_decisions_.pdf on April 25, 2025
- APPLE-1107 Apple Inc.’s Stipulation
- APPLE-1108 *Markman* order Case No. 2:24-CV-353-JRG, issued on October 10, 2025

APPLE-1109

Email of November 3, 2025 from Joseph Mercadante

Pursuant to the Board’s authorization via email on November 4, 2025, Petitioner Apple Inc. (“Apple”) submits this Motion to Withdraw all challenges to claims 1–6 of U.S. Patent No. 8,230,101 (“the ’101 Patent”).

On October 10, 2025, a *Markman* order issued in Patent Owner’s litigation with Google LLC, captioned as Case No. 2:24-CV-353-JRG. APPLE-1108. In the *Markman* order, the district court determined that, with respect to the ’101 Patent, the term “a list information transmission unit adapted to respond to a list presentation request for the held digital contents of the server device for media from the network player by transmitting list information to the network player, wherein the list information lists the digital contents left in the internal storage device and the digital contents transferred from the internal storage device to the network storage device and stored in the network storage device, and wherein the list information maintains a tree structure of the digital contents in the internal storage device before transferring the digital contents to the network storage device” is governed by 35 U.S.C. § 112, ¶ 6 and indefinite as lacking corresponding structure. *Id.*, 38–42.

The district court’s finding of indefiniteness implicates claims 1–6 of the ’101 Patent but does not implicate claims 7–12 of the ’101 Patent, which do not include the relevant claim term or any other term that has been identified as subject to 35 U.S.C. § 112, ¶ 6 or potentially subject to 35 U.S.C. § 112, ¶ 6. In an effort to streamline the Board’s review of the Petition and to make the most efficient use of

Board resources, Petitioner moves to withdraw its challenges to claims 1–6, leaving only challenges to claims 7–12 in the Petition.

With this motion, Petitioner asks the Board to consider within the Petition only the challenges to claims 7-12 and to disregard the challenges to claims 1-6 for at least the following reasons. First, in the e-mail from Patent Owner’s counsel on November 3, 2025, Patent Owner has stated that it does “not oppose a motion to withdraw the challenges to claims 1–6.” APPLE-1109. Second, limiting the proceeding to challenges other than those to claims 1–6 promotes efficient use of the resources of the Board, streamlines the issues under consideration, and saves expense, time and resources for the parties and Board. Third, the Board has regularly withdrawn challenges to claims within prior petitions. *See, e.g.*, IPR2017-01328, Paper 25; IPR2017-00782, Paper 27; IPR2017-00701, Paper 65; IPR2017- 01355, Paper 22.

In IPR2019-00510, the Board granted a similar request by Petitioner to remove challenges to a claim from the Petition as if the claim were never challenged. IPR2019-00510, Paper 21 at 1 (“On May 15, 2020, Petitioner filed an unopposed request to withdraw the challenges set forth in the Petition with respect to claim 18. Ex. 3001. In essence, Petitioner requests removal of the challenges to claim 18 from the Petition as if claim 18 was never challenged. *Id.* We *grant* Petitioner’s request.”). In that case, the challenged claim had been found indefinite in co-pending litigation

and it was therefore deemed most efficient for the Board to move forward with only the challenge to the remaining claim that had not been found indefinite. IPR2019-00510, Ex. 3001; Paper 17 at 5 (“I would like to ask a question about claim 18, before we get started. I’m under the impression that there was a recent federal circuit decision on claim 18, and in that decision, they affirm the district court’s determination that claim 18 is indefinite.”). For reasons similar to those justifying requested changes in IPR2019-00510, Petitioner asks the Board to streamline the present review, withdraw the challenges to claims 1–6, and grant institution of claims 7–12 that lack the indefiniteness issue identified by the district court.

Moreover, good cause exists to limit the Petition as requested because the *Markman* order issued well after the Petition was filed. Specifically, the Petition in IPR2025-01103 was filed on June 4, 2025, and the *Markman* order issued months later on October 10, 2025. Because Petitioner was not a party to the litigation in which the indefiniteness finding was made, Petitioner did not immediately receive a copy of the *Markman* order. However, upon learning of the order, Petitioner promptly brought it to the attention of Patent Owner and the Board while requesting withdrawal of the challenges to the indefinite claims. Accordingly, consistent with Board goals, Petitioner acted efficiently to conserve resources of the parties and the Board by requesting withdrawal of challenges to claims 1–6 as soon as Petitioner learned that those claims had been found indefinite.

For the foregoing reasons, Petitioner respectfully requests that the Board remove claims 1–6 of the '101 Patent from this *inter partes* review proceeding and limit the institution decision to claims 7–12.

Respectfully submitted,

Dated: November 10, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on November 10, 2025, a complete and entire copy of this Petitioner's Motion to Withdraw all challenges to claims 1-6 of U.S. Patent No. 8,230,101 and Accompanying Exhibits were provided by email to the Patent Owner by serving the correspondence email address of record as follows:

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