

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

ADVANCED CODING TECHNOLOGIES LLC,  
Patent Owner.

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IPR2025-01103  
Patent 8,230,101 B2

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Before THU A. DANG, RUSSELL E. CASS, and BRIAN P. MURPHY,  
*Administrative Patent Judges.*

MURPHY, *Administrative Patent Judge.*

ORDER

Conduct of the Proceeding: Withdrawing All Challenges to Claims 1–6  
*37 C.F.R. §§ 42.5(a)*

## I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. § 311 requesting institution of *inter partes* review of claims 1–12 of U.S. Patent No. 8,230,101 B2 (Ex. 1001, “the ’101 patent”). Paper 2 (“Pet.”). Advanced Coding Technologies LLC. (“Patent Owner”) timely filed a Request for Discretionary Denial of Institution and a Patent Owner Preliminary Response. Paper 6; Paper 9 (“Prelim. Resp.”). On October 17, 2025, the Deputy Director of the Office denied Patent Owner’s request for discretionary denial and referred the Petition to the Board for a decision on institution. Paper 11.

On November 10, 2025, pursuant to our authorization, Petitioner filed a Motion to Withdraw all Challenges to Claims 1–6 of the ’101 patent. Ex. 3001 (authorization email); Paper 12 (“Motion” or “Mot.”). Petitioner moves to withdraw all challenges to claims 1–6 of the ’101 patent in view of a claim construction order, entered in a related district court proceeding, that determined a claim limitation in independent claims 1 and 6 to be indefinite pursuant to 35 U.S.C. § 112 ¶ 6. Mot. 7–9 (citing Ex. 1108, 38–42).<sup>1</sup> Patent Owner did not file a response to the Motion and does not oppose it. Ex. 1109, 2 (“we do not oppose a motion to withdraw the challenges to claims 1-6”); *see* Ex. 3001 (“Any response or opposition from Patent Owner must be filed within one week from the entry date of the Motion to Withdraw.”).

For the reasons given below, Petitioner’s Motion is granted.

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<sup>1</sup> Petitioner is not a party to the related litigation, captioned *Advanced Coding Technologies LLC v. Google LLC*, Case No. 2:24- cv-00353-JRG (E.D. Tex.), in which the claim construction order was entered. We recognize that Petitioner promptly brought the district court’s *Markman* order to our attention once Petitioner learned of the order. Mot. 9. Patent Owner does not assert otherwise.

## II. DISCUSSION

Petitioner’s Motion states that the district court’s determination, that the “*list information transmission unit*” limitation recited in claims 1 and 6 of the ’101 patent is indefinite, “implicates claims 1–6 of the ’101 Patent but does not implicate claims 7–12 of the ’101 Patent.” Mot. 7. Petitioner’s unopposed Motion is intended to “streamline the Board’s review of the Petition and to make the most efficient use of Board resources.” *Id.* at 7–8. Thus, Petitioner asks the Board to consider “only the challenges to claims 7-12” and order the withdrawal of all challenges to claims 1–6 in the Petition. *Id.* at 8–9.

Our rules authorize the Board to “determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.” 37 C.F.R. § 42.5(a). The district court’s order determining the “*list information transmission unit*” limitation recited in independent claims 1 and 6 to be indefinite certainly implicates claims 1–6. There also appears to be agreement by the parties that claims 7–12 are not so implicated by the district court’s ruling. Mot. 7. Therefore, we issue this non-final Order withdrawing all challenges to claims 1–6 from the Petition in order to administer the proceeding more efficiently and with due regard to conserving Board and party resources. *Id.* at 8 (citing IPR2019-00510, Paper 21, 2 (PTAB July 22, 2020) (granting a petitioner’s unopposed motion to withdraw the challenges to one of two claims challenged in the petition); *see also Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2024-01252, Paper 27, 2 (PTAB Apr. 17, 2025) (Director Review) (informative) (IPR institution denied because challenged patent claims had been invalidated by district court as claiming patent ineligible subject matter under 35 U.S.C. § 101).

Accordingly, for the reasons given above, we grant Petitioner's Motion.

### III. ORDER

ORDERED that Petitioner's Motion is GRANTED and all challenges to claims 1–6 of the '101 patent are withdrawn from consideration.

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