

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 8–11  
*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 the challenges to claims 1–6 of the ’101 patent. Ex. 3001; Paper 12. Petitioner’s motion was based on 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. Paper 12 (citing Ex. 1108, 38–42).<sup>1</sup> Patent Owner did not file a response to Petitioner’s motion and did 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.”). On November 25, 2025 we granted Petitioner’s motion and entered an Order withdrawing all challenges to claims 1–6 of the ’101 patent. Paper 13. On December 4, 2025 we instituted *inter partes* review of claims 7–12 of the ’101 patent. Paper 14.

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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.

On December 23, 2025, pursuant to our authorization, Petitioner filed a Motion to Withdraw All Challenges to Claims 8–11 of the '101 patent. Paper 16 (“Motion” or “Mot.”). Patent Owner did not file a response to the Motion and does not oppose it. Ex. 1110, 1 (“Patent Owner does not oppose your motion to withdraw the challenges to claims 8-11”).

For the reasons stated in our Order of November 25, 2025, and further stated below, Petitioner’s Motion is granted.

## 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” which already have been withdrawn from this proceeding. Mot. 7; Paper 12. Petitioner’s unopposed Motion correctly recognizes that “the district court’s finding of indefiniteness further implicates claims 8–11 of the '101 Patent, each of which depend on claim 6.” Mot. 7–8. Petitioner’s Motion is intended to “further streamline the Board’s review of the Petition and to make the most efficient use of Board resources.” *Id.* at 8. Petitioner emphasizes that Patent Owner does not oppose the Motion and that limiting the Petition to the challenges to claims 7 and 12 “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.” *Id.* Thus, Petitioner asks the Board to withdraw the challenges to claims 8–11, leaving only challenges to claims 7 and 12 remaining in the Petition. *Id.*

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). As stated by Petitioner, the district court’s order determining the “*list information transmission*

*unit*” limitation recited in independent claims 1 and 6 to be indefinite implicates claims 1–6 and further implicates dependent claims 8–11, each of which depends from claim 6. Therefore, for the reasons stated in the Motion, we determine that Petitioner has demonstrated good cause to issue this Order withdrawing all challenges to claims 8–11 from the Petition in order to administer the proceeding more efficiently and with due regard to conserving Board and party resources, by focusing only on the challenges to claims 7 and 12. Mot. 8 (citing IPR2017-01328, Paper 25; IPR2017-00782, Paper 27; IPR2017-00701, Paper 65; IPR2017- 01355, Paper 22).

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 8–11 of the ’101 patent are withdrawn from consideration.

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Patent 8,230,101 B2

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