

Filed: November 14, 2025

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.

MYPORT TECHNOLOGIES, INC.,  
Patent Owner.

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IPR2025-01465  
Patent 10,721,066

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**PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

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**EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Description</b>
2001	October 13, 2020, letter from Patent Owner to Petitioner
2002	Three subsequent letters dated January 12, 2021, March 19, 2021, and April 19, 2021, exchanged between Patent Owner and Petitioner
2003	Parallel Litigation at ECF Nos. 37 and 38
2004	Patent Owner's original complaint filed against Petitioner dated December 6, 2024, in Parallel Litigation

## I. INTRODUCTION

On September 9, 2025, Apple filed its Petition for *inter partes* review directed to U.S. Patent No. 10,721,066 (“the ’066 Patent”) (EX-1001) challenging claims 6–17 as unpatentable for obviousness under 35 U.S.C. § 103. Pursuant to the Director’s March 26, 2025, memorandum regarding Interim Processes for PTAB Workload Management (“PTAB Memo”), Patent Owner MyPort Technologies, Inc. (“MyPort”) requests that the Director exercise his discretion and deny institution of the Petition filed by Apple.

First, the settled expectations of the parties favor discretionary denial. The ’066 Patent issued on July 21, 2020, with claims directed to speech and image recognition—a technology area that Apple has actively developed and used for many years. Relatedly, on October 13, 2020, MyPort sent Apple a letter notifying Apple of its infringement, which included claim charts showing how multiple Apple products infringe the ’066 Patent claims. Apple acknowledged receipt of this letter and responded on January 12, 2021, explaining that it reviewed the patent and claim chart, and argued for its non-infringement. The parties exchanged more letters over the next few months. Despite Apple’s knowledge of the ’066 Patent since at least October 13, 2020, it took no steps to challenge the ’066 Patent until after the patent expired and over five years after the patent issued. Apple’s lack of diligence is also compounded given that it waited over nine months after

MyPort filed its complaint in district court to submit the instant Petition. The expiration of the '066 Patent further supports the Patent Owner's settled expectations.

Second, the Petition challenges claims 6–17 of the '066 Patent, the same patent and claims asserted in the parallel district court litigation in *MyPort Techs., Inc. v. Apple, Inc.*, No. 1-24-cv-01337 (D. Del. Dec. 6, 2024) (“Parallel Litigation”). In the Parallel Litigation, Petitioner Apple successfully moved to dismiss the count asserting the '066 Patent on the basis that all claims are invalid under 35 U.S.C. § 101. EX-2003. MyPort has since filed a motion for leave to file an amended complaint with additional facts to show that the claims recite eligible subject matter, and should not be ruled invalid under Section 101. At time of submission of this Brief, MyPort's motion for leave to amend is still pending.<sup>1</sup> The court's decision finding the '066 Patent claims invalid under § 101 weighs in favor of denying institution. *See, e.g., Google LLC v. Sandpiper CDN, LLC*, IPR2025-

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<sup>1</sup> In its proposed amended complaint in the Parallel Litigation, Patent Owner alleges infringement against Apple of the '066 Patent, and two related patents: U.S. Patent Nos. 9,832,017 (“the '017 Patent”) and 10,237,067 (“the '067 Patent”). Petitioner Apple seeks *inter partes* review of these three patents. *See* IPR2025-01464, -01465, -01466.

00846, -00952, Paper 10 (PTAB Oct. 10, 2025); *Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2024-01252, Paper 27; IPR2024-01253, Paper 22 (PTAB Apr. 17, 2025).

The remaining factors outlined in the PTAB Memo and *Fintiv* factors, including reducing the potential for duplicative efforts and inconsistent results, favor discretionary denial.

For all these reasons, and as explained more fully below, the Director should exercise his discretion to deny institution.

## **II. FACTUAL BACKGROUND**

The '066 Patent issued on July 21, 2020. *See generally* EX-1001. The sole inventor and current owner of the '066 Patent is Michael Malone, an individual inventor who founded MyPort and still owns 100% of MyPort.

The '066 Patent arises from pioneering technology directed to the use of speech and image recognition to create searchable “context tags.” At the time of the invention of the '066 Patent, there were problems with a digital media device, such as a smartphone, having the ability to store many media files, including that it was difficult and time-consuming to manually describe and index every media file. EX-1001 at 2:43–60. The patented inventions solved these problems by, among other things, conceiving of the use of data converters to process, convert, and store the audio and image information into a text-based searchable file as a context tag,

while using speech recognition and image recognition, such as artificial intelligence and/or machine learning, for storage and search retrieval. *Id.* at 3:22–52.

On October 20, 2020, MyPort sent a notice letter to Apple informing Apple about its infringement of the '066 Patent (as well as Apple's infringement of the related '017 and '067 Patents,) including attaching claim charts. EX-2001; EX-2002. MyPort also filed suit against Apple's competitor, Samsung, alleging infringement of the '066 Patent. *See MyPort, Inc. v. Samsung Elecs. Co., Ltd. et al.*, No. 2-22-cv-00114 (E.D. Tex. Apr. 15, 2022).

### **III. THE DIRECTOR SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 314**

The PTAB Memo and 35 U.S.C. § 314(a) gives the Director discretion to deny institution of an IPR. The PTAB Memo includes a non-exhaustive list of considerations that may be raised in discretionary briefing:

1. Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
2. Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
3. The strength of the unpatentability challenge;
4. The extent of the petition's reliance on expert testimony;

5. Settled expectations of the parties, such as the length of time the claims have been in force;
6. Compelling economic, public health, or national security interests; and
7. Any other considerations bearing on the Director's discretion.

PTAB Memo at 2–3.

In evaluating these factors, the Director’s decision should be based on “a holistic review of the facts and circumstances.” *See* USPTO, *Interim Directory Discretionary Process*, <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (last visited Oct. 31, 2025). The factors shown below favor denial of the Petition.

**A. The Settled Expectations of the Patent Owner Favor Discretionary Denial**

Patent Owner has developed strong settled expectations. The ’066 Patent issued on July 21, 2020, over five years ago; and the two related challenged patents (*i.e.*, the ’017 and ’067 Patents) have been in force for over eight and six years, respectively. *See* EX-1001 in IPR2025-01464, -01465, -01466. As the Director has routinely held since the onset of the bifurcated discretionary process, settled expectations of the parties, such as the length of time the claims have been in force, favors discretionary denial. *See, e.g., Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12, 2 (PTAB July 31, 2025) (“the challenged patent has been in force for over six years, creating strong settled expectations”); *Intel Corp. v. Advanced*

*Cluster Sys., Inc.*, IPR2025-00795, Paper 13, 2 (PTAB Aug. 14, 2025) (“the challenged patent has been in force for approximately six years, creating settled expectations for Patent Owner.”).

Moreover, demonstrating that a Petitioner has long been aware of a challenged patent but delayed challenging its validity further supports settled expectations. *IRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10, 3 (PTAB June 6, 2025). In *IRhythm*, the Board noted:

Patent Owner argues that because one of the patents has been in force since as early as 2012 and Petitioner was aware of it as early as 2013—having cited the then pending application that issued as the challenged patent in an Information Disclosure Statement Petitioner filed in its own patent application—settled expectations favor denial of institution...Patent Owner’s argument is persuasive. Petitioner’s awareness of Patent Owner’s applications and failure to seek early review of the patents favors denial and outweighs the above-discussed considerations. *Id.*

*Id.*

Here, Petitioner Apple has been aware of the ’066 Patent since at least as early as October 13, 2020. EX-2001. Apple cannot claim that it did not receive this letter, since Apple responded to the letter with alleged non-infringement arguments and engaged in subsequent communications with the Patent Owner dated January 21, 2021, March 19, 2021, and April 19, 2021. EX-2002. Despite being aware of

the '066 Patent as early as October 2020, Apple failed to initiate review (either *inter partes* or *ex parte*) of the '066 Patent until now. Indeed, the argument here is stronger than in *IRhythm* because here, the Patent Owner put Apple directly on notice, rather than relying only on the Petitioner's knowledge as evidenced through an IDS.

Petitioner's lack of diligence in filing its Petition even after the Parallel Proceeding was initiated further supports discretionary denial. Patent Owner asserted the '066 Patent against Apple in the Parallel Proceeding on December 6, 2024. EX-2004. Yet Apple waited over nine months after the start of the proceeding (from December 6, 2024, to September 9, 2025) to file its Petition.

Further, the expiration of the '066 Patent favors denial. *See, e.g., Omnivision Tech., Inc. v. RE Secured Networks LLC*, IPR2025-01019, Paper 14, 2 (PTAB Oct. 10, 2025) ("In particular, the challenged patent has been in force for approximately twenty years and is now expired, creating strong settled expectations for Patent Owner."). Proceeding with an IPR on an expired patent is an inefficient use of the Board's and the parties' resources. While there is a claim for past damages attributable to infringing the patent in district court litigation, the nature of that dispute does not justify expending the Board's resources on instituting review of the Petition.

Unlike other cases that have denied discretionary denial where the subject patent was expired, MyPort notified Apple of its infringement and has always owned the '066 Patent. *See, e.g., Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00226, Paper 8, 2 (PTAB June 12, 2025) (“As in Globus, while Patent Owner presents no evidence that Google was aware of the '517 patent before it was asserted against Google in 2024, a reasonable party would not expect a patent that expired in 2023 to be highly likely to be asserted in a litigation to preclude Google’s challenge here.”). *Id.* at 12–13; *see also Google LLC v. Sandpiper CDN, LLC*, IPR2025-00806, Paper 13, n.3 (PTAB Sept. 12, 2025) (“Patent Owner did not acquire the challenged patents until after they expired.”). Apple had no legitimate expectation that the '066 Patent would not be enforced against it, especially considering that MyPort notified Apple of the '066 Patent at least by October 13, 2020—well before the '066 Patent’s expiration date of September 29, 2023—and MyPort previously litigated the '066 Patent against Samsung, Apple’s competitor.

Because Apple has had knowledge of the '066 Patent since at least October 13, 2020 (but has delayed challenging its validity), MyPort has settled expectations of the '066 Patent’s validity. Considering these settled expectations, the Board should decline institution on this basis alone.

## **B. The Merits of the Petition are Weak**

The merits of the Petition are also weak. Apple presents two challenged grounds, both based on obviousness: (i) Spatharis and Manjunath; and (ii) Fuller and Jain. Pet. at 7. As Patent Owner will explain in further detail in its preliminary response, each independent claim expressly requires the “data capture device” to capture both location and time information. EX-1001, claims 6 and 13. Petitioner relies on Spatharis and Fuller to satisfy this limitation. The Petition, however, fails to any single “data capture device” that captures both location and time information in either Spatharis or Fuller. Specifically, for Ground 1, there is no disclosure in Spatharis regarding any specific device that would capture location and time information. Indeed, the Petition does not even attempt to identify any such specific device. *See generally* Pet. at 25–26. Additionally, to prevail in this IPR, the Petition was required to point to a single “data capture device” that captures both types of information. The Petition, however, never even claims that any single device would capture both location and time information. *Id.*

Lastly, the motivations to combine rely on Petitioner’s contentions that the Spatharis and Manjunath references are analogous art and purportedly relate to the same field or goal. Pet. at 10–13. The law is clear, however, that simply being in the same field or endeavor or having the same goal do not by themselves establish a reason to combine references. *William Wesley Carnes, Sr., Inc. v. Seaboard Int’l*

*Inc.*, IPR2019-00133, Paper 10, 17–18 (PTAB May 8, 2019) (“statement[s] of similarity, however, do[] not constitute an articulated reasoning with rational underpinning as to why a POSITA would combine elements of one reference with another, and why a POSITA would modify the teachings of the references to arrive at the claimed invention”) (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)). These deficiencies are compounded by Petitioner’s reliance on conclusory expert testimony, as discussed below. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15–17 (PTAB Aug. 24, 2022) (precedential) (according “little weight” to declaration testimony that contains a verbatim restatement of a petitioner’s conclusory assertions without additional supporting evidence or reasoning); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340–41 (Fed. Cir. 2020) (affirming Board decision giving no weight to expert testimony that “merely repeat[ed] Petitioner’s argument, nearly verbatim, without citation to the basis for his testimony”).

For at least these reasons, the Petition fails to make a *prima facie* case of obviousness. The weaknesses of the Petition counsel against institution.

### **C. The Petition Relies Heavily on Expert Testimony**

The Director also considers the “extent of the petition’s reliance on expert testimony.” PTAB Memo at 2. The FAQs further explain:

While the Board may consider expert testimony, as a matter of efficiency, extensive reliance on expert testimony and/or reasonable

disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court. The statute and our reviewing court require that petitions be based on prior art patents and printed publications. As the judges have technical and legal expertise, it is not necessary for an expert to explain every aspect of the prior art. It is most helpful if an expert is providing focused testimony, for example to provide helpful context or to explain terms of art. The failure to provide focused expert testimony may weigh against institution.

USPTO, *Interim Processes for Workload Management FAQs*,

<https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> at Q.22 (last visited Oct. 31, 2025).

This factor favors denial because the expert testimony relied on by Petitioner is not focused. Specifically, the Petition relies on the Polish Declaration, which is substantively 85 pages long. EX-1003. Indeed, the Petition relies on the Polish Declaration extensively, citing to it throughout the Petition approximately one-hundred eighty times. Further, the Petition relies on cursory (though lengthy) expert testimony for almost every cited claim limitation and every Ground, rather than providing a focused expert declaration addressing the limitations for which expert testimony is necessary. *See generally* EX-1003.

## **D. The Other PTAB Memo and *Fintiv* Factors Weigh Against Institution**

### **1. Other PTAB Memo Factors**

Another factor includes “[w]hether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims.” PTAB Memo at 2. Though the Board granted institution in a previous IPR regarding the ’066 Patent, the parties settled prior to final written decision. *See Samsung Elecs. Co., Ltd. v. MyPort, Inc.*, IPR2023-00023, Paper 42 (PTAB Feb. 16, 2024). Further, there have been no changes in the law or new precedent issued after issuance of the claims that may affect patentability.

### **2. *Fintiv* Factor 1**

*Fintiv* Factor 1 looks to “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 5–6 (PTAB Mar. 20, 2020) (“*Fintiv P*”) (outlining factors for discretionary denial). Here, MyPort filed the original complaint in the Parallel Litigation on December 6, 2024. EX-2004. The case has since been pending before Judge Wolson in the District of Delaware. Though the district court has dismissed the complaint (EX-2003), and the parties are currently briefing Patent Owner’s motion for leave to amend, Apple did not move to stay the proceedings prior to the dismissal and has not moved to stay the proceedings. Because the Board ordinarily “will not attempt to predict” how a district court will

proceed if a stay has not been granted (*see, e.g., Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24, 7 (PTAB June 16, 2020)), there is no reason to suggest that the district court will issue a stay, even if Apple were to file a request for one.

### **3. *Fintiv* Factors 2–3**

*Fintiv* Factor 2 looks to the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision” while *Fintiv* Factor 3 looks to the “amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv I* at 5–6, 9.

In the Parallel Litigation, there has been no trial date or scheduling order issued by the Court. The lack of a scheduled trial date, however, should not prevent discretionary denial. For example, in *Hisense USA v. VideoLabs*, IPR2025-00880, -00881, -00882, -00883, Paper 11, 2 (PTAB Oct. 10, 2025), the Board discretionarily denied *inter partes* review even though “no trial date” had been set in the parallel proceeding and “it is likely that a final written decision will issue before the district trial occurs.” *See also Astera Mfg. Ltd. et al. v. ElectraLED, Inc.*, IPR2025-01022, Paper 12, 2 (PTAB Oct. 10, 2025) (denying institution where “there is no indication that a trial date has been set” and “it is likely that a final written decision in this proceeding will issue before district court trial occurs”).

Further, MyPort filed its complaint on December 6, 2024, and the parties have spent considerable time briefing Petitioner’s motion to dismiss based upon ineligible subject matter, and the subsequent motion for leave to amend.

#### 4. *Fintiv* Factor 4

*Fintiv* Factor 4 looks to “whether all or some of the claims challenged in the petition are also at issue in district court” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv I* at 12–13. In short, this factor evaluates “concerns of inefficiency and the possibility of conflicting decisions” when substantially identical prior art is submitted in both the district court and the IPR proceeding. *Id.* at 12. Here, the District Court has dismissed the complaint based upon ineligible subject matter. EX-2003. Should MyPort be afforded an opportunity to file an amended complaint, the challenged claims (*i.e.*, claims 6–17) cover all asserted claims (*i.e.*, claims 6–17).

Though Petitioner has filed a *Sotera* stipulation (Paper 6), this stipulation does not prevent Petitioner from relying on the same prior art in district court in support of combinations involving non-printed publication art, *e.g.*, prior art based on public use or an on sale-bar. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365–66 (Fed. Cir. 2025) (“IPR estoppel does not preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a

ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.”). Similarly, the Sotera stipulation does not prevent Petitioner from relying on system art that embodies the teachings of the printed publications it relies upon in its Petition.

#### **5. *Fintiv* Factor 5**

*Fintiv* Factor 5 looks to “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv I* at 5–6. Here, the Petitioner and the defendant in the Parallel Litigation are the same party (Apple), so “this factor weighs in favor of discretionary denial.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 15 (PTAB May 13, 2020) (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”). Accordingly, *Fintiv* Factor 5 weighs in favor of exercising discretionary denial.

#### **6. *Fintiv* Factor 6**

Other circumstances impact the Board’s exercise of discretion, particularly here, where in the Parallel Litigation, Petitioner successfully moved to dismiss the complaint asserting the ’066 Patent on the basis that all claims are invalid under 35 U.S.C. § 101. EX-2003. Patent Owner has filed a motion for leave to file an amended complaint, which is still pending before the Court. The Court’s decision already dismissing the Complaint based on ineligible subject matter, as it stands

now, is a factor to deny institution. *See Google v. Sandpiper*, Paper 10 at 2 (PTAB Oct. 10, 2025) (denying institution of *inter partes* review “[b]ecause the challenged claims have already been found to be invalid under § 101, it is not an efficient use of Board resources to review them for patentability under other grounds”); *Hulu v. Piranha Media*, Papers 22, 27 (PTAB Apr. 17, 2025). The PTAB denies institution on this basis even where the district court’s § 101 decision is or will be subject to appeal (*see id.*) and should do so here even though the district court provided leave to amend Patent Owner’s complaint after finding the claims invalid.

Lastly, Petitioner Apple is one of the most prolific patent-infringement defendants. While Patent Owner is not advocating for a bar based on all *inter partes* review petitions filed by Apple, in the circumstances here, this factor on balance favors denial of institution as Apple does not need to tax the resources of the Patent Office to offload its invalidity defenses or reduce its litigation costs. The Office’s limited resources are better used elsewhere.

#### **IV. CONCLUSION**

For the reasons stated above, Patent Owner respectfully requests discretionary denial of the Petition.

Dated: November 14, 2025

Respectfully submitted,

/John Lord/

John Lord (Reg. No. 56,562)

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**CERTIFICATE UNDER 37 C.F.R. § 42.24**

Under the provision of 37 C.F.R. § 42.24, the undersigned hereby certifies that the foregoing **PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** complies with the 20-page limit requirement allowed under the Interim Director Discretionary Process for discretionary denial briefs filed after September 1, 2025. See Interim Director Discretionary Process (II)(C)(iii) (<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>).

Dated: November 14, 2025

Respectfully Submitted,

*/John Lord/*

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John Lord (Reg. No. 56,562)

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on November 14, 2025, a true and correct copy of the foregoing was served via electronic mail upon the attorneys of record for Petitioner at the following addresses:

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Dated: November 14, 2025

Respectfully submitted,

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John Lord (Reg. No. 56,562)