

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.

HBCU Messaging US LP,  
Patent Owner

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Case IPR2025-01486  
Patent 8,918,127

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**PETITIONER'S REQUEST FOR DIRECTOR REVIEW OF  
THE DECISION DENYING INSTITUTION**

**LIST OF EXHIBITS**

APPLE-1001	U.S. Patent No. 8,918,127 (“the ’127 Patent”)
APPLE-1002	File History of U.S. Patent No. 8,918,127
APPLE-1003	Expert Declaration of Dr. Patrick Traynor, Ph.D.
APPLE-1004	U.S. Pub. No. 2007/0254681 (“Horvath”)
APPLE-1005	U.S. Pub. No. 2004/0203956 (“Tsampalis”)
APPLE-1006	RESERVED
APPLE-1007	Chatterjee et al., “Instant Messaging and Presence Technologies for College Campuses” IEEE Network, May/June 2005. (“Chatterjee”)
APPLE-1008	U.S. Pub. No. 2005/0243978 (“Son”)
APPLE-1009	UK Pub. No. 2432482 (“Beaumont”)
APPLE-1010	U.S. Patent No. 9,408,077 (“David”)
APPLE-1011	U.S. Patent No. 6,940,844 (“Purkayastha”)
APPLE-1012	U.S. Patent No. 7,702,342 (“Duan”)
APPLE-1013	U.S. Patent No. 8,819,145 (“Gailloux”)
APPLE-1014	U.S. Pub. No. 2006/0286984 (“Bonner”)
APPLE-1015	U.S. Pub. No. 2005/0197142 (“Major”)
APPLE-1016	U.S. Pub. No. 2005/0037762 (“Gurbani”)
APPLE-1017	U.S. Patent No. 9,167,401 (“Helferich”)
APPLE-1018	U.S. Patent No. 6,430,604 (“Ogle”)
APPLE-1019	International Pub. No. WO 2006/029331 (“Henderson”)
APPLE-1020	U.S. Patent No. 7,236,472 (“Lazaridis”)
APPLE-1021	U.S. Patent No. 8,006,190 (“Quoc”)

APPLE-1022	U.S. Patent No. 6,678,524 (“Hansson”)
APPLE-1023	U.S. Pub. No. 2006/0056309 (“Maaniitty”)
APPLE-1024	U.S. Patent No. 7,171,190 (“Ye”)
APPLE-1025	Qi et al., 2004, July. “Multimedia Messaging Service.” Available at <a href="https://www.zte.com.cn/global/about/magazine/zte-communications/2004/1/en_68/162264.html">https://www.zte.com.cn/global/about/magazine/zte-communications/2004/1/en_68/162264.html</a> (“Qi”)
APPLE-1026-1035	RESERVED
APPLE-1036	International Pub. No. WO 2007/052264 (“Agiv”)
APPLE-1037	T-Mobile webpage <a href="https://www.t-mobile.com/home-internet/the-signal/internet-help/the-complete-wifi-history">https://www.t-mobile.com/home-internet/the-signal/internet-help/the-complete-wifi-history</a>
APPLE-1038	U.S. Pub. No. 2010/0009704 (“Fan”)
APPLE-1039	U.S. Pub. No. 2004/0087305 (“Jiang”)
APPLE-1040	U.S. Pub. No. 2007/0178895 (“Bot”)
APPLE-1041	Kumar et al., Special Delivery: An Increase in MMS Adoption, IEEE Potentials (January/February 2009)
APPLE-1042	Brugge, MSS-Multimedia Messaging and MMS-Interconnection, ECC Report 62 (November 2004)
APPLE-1043	U.S. Pub. No. 2008/0176538 (“Terrill”)
APPLE-1044	RFC 3856 – A Presence Event Package for the Session Initiation Protocol (SIP). Available at <a href="https://data-tracker.ietf.org/doc/html/rfc3856">https://data-tracker.ietf.org/doc/html/rfc3856</a> . August 2004
APPLE-1045-1099	RESERVED
APPLE-1100	Complaint, <i>HBCU Messaging US LP v. Apple, Inc. et al.</i> , 1-24-cv-01199 (WDTX) (Oct. 7, 2024)
APPLE-1101	Infringement Charts of the ’127 Patent

- APPLE-1102 Stipulation dated October 31, 2025
- APPLE-1103-1104 RESERVED
- APPLE-1105 Apple's Opening Claim Construction Brief, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Sept. 22, 2025)
- APPLE-1106 HBCU's Opening Claim Construction Brief, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Sept. 22, 2025)
- APPLE-1107 Apple's Responsive Claim Construction Brief, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Oct. 24, 2025)
- APPLE-1108 HBCU's Responsive Claim Construction Brief, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Oct. 24, 2025)
- APPLE-1109 Continuity Data for U.S. Application Serial No. 12/452,883
- APPLE-1110 Continuity Data for U.S. Application Serial No. 16/714,113
- APPLE-1111 MPEP Chapter 900: Prior Art, Classification, and Search (Ninth Edition E9R-11.2013) (March 2014), *available at* <https://www.uspto.gov/web/offices/pac/mpep/old/e9r0/mpep-0900.pdf>
- APPLE-1112 Ahmavaara et al., *Interworking Architecture Between 3GPP and WLAN Systems*, Integration of Wireless LAN and 3G Wireless, IEEE Communications Magazine (Nov. 2003)
- APPLE-1113 Excerpts from the File History of U.S. Application Serial No. 14/307,184

- APPLE-1114 Summons in a Civil Action and Certification of Service of Summons and Complaint, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Nov. 5, 2024)
- APPLE-1115 German Federal Court of Justice Decision, *Apple Retail Germany GmbH v. Rembrandt Messaging Technologies, LP*, concerning EP 2 177 072 (Dec. 15, 2020) (Certified English Translation)
- APPLE-1116 Claim Construction Order, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Jan. 28, 2026)
- APPLE-1117 *Markman* Hearing Transcript, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Jan. 23, 2026)

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## I. INTRODUCTION

Petitioner (Apple Inc. or “Apple”) requests Director Review of the February 18, 2026 Decision denying institution of the present proceeding (IPR2025-01486). *See* Paper 15. The Notice of institution denial indicated that “[a]lthough previously referred, this case is now discretionarily denied in view of *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2026) (precedential).” *Id.*, n. 1.

The Decision followed Patent Owner’s (HBCU Messaging US LP or “HBCU”) unfounded contentions of inconsistent claim construction positions between the Petition and parallel litigation on the ’127 Patent. Indeed, only twelve days prior to the Decision, HBCU filed a Sur-Reply (Paper 14) that blatantly mischaracterized the claim construction record in the parallel litigation and offered false statements concerning the same. This led the Director to rely on inaccurate information in resolving whether to terminate. Consequently, the Decision denying institution was based on erroneous findings of material fact or law, and/or amounted to an abuse of discretion, because Apple’s Petition was not inconsistent with its claim construction positions in Court.

This Request demonstrates that Apple’s positions were not inconsistent and that *Revvo* should not have applied. Accordingly, Apple’s Request for Director Review should be granted, the Decision denying institution should be vacated, and the

Petition should be re-referred for consideration on the merits and instituted.

**II. THE DECISION ERRED IN FOLLOWING HBCU’S MISREPRESENTATIONS AND DENYING INSTITUTION UNDER *REVVO* BECAUSE APPLE’S PETITION IS NOT INCONSISTENT WITH ITS CLAIM CONSTRUCTION POSITIONS IN COURT**

Three claim terms from the ’127 Patent were the subject of construction in the parallel litigation: (1) “bearer,” (2) “cellular core network,” and (3) “wherein...when”. *See* APPLE-1116. Contrary to HBCU’s contentions, Apple’s claim construction positions for each of these terms in Court is not inconsistent with their treatment in the Petition. The record thus fails to support denial under *Revvo*. The Decision’s finding otherwise was clear error based on an incomplete and inaccurate record of the District Court proceeding left by HBCU in its Sur-Reply.

**A. “bearer”**

Apple’s treatment of “bearer” in the Petition is consistent with its Court construction. While unacknowledged in HBCU’s briefing, the Petition’s identification of “GPRS” as a “packet switched bearer” for MMS messaging aligns precisely with the explanation in the ’127 Patent that “[t]he packet-switched bearer may be ... GPRS.” Pet., 42-43; APPLE-1001, 2:62-63; *see also id.*, 1:59-61 (“MMS was first introduced in 2.5 generation networks such as GPRS, which provides an Internet Protocol (IP) overlay to the existing GSM networks”). Indeed, Apple’s District Court claim construction briefing cited this same portion of the specification to illustrate how its proposed construction of “bearer” as “a communication channel or

protocol” encompasses each of the examples disclosed in the specification, including GPRS. See APPLE-1107, 9 (“The packet-switched bearer may be ... GPRS” (quoting APPLE-1001, 2:61-3:2)).

Also notable, HBCU’s District Court claim construction proposal explicitly identifies “GPRS” as a “bearer.” See APPLE-1106, 1 (HBCU construing “bearer” as “[a] protocol running on a channel for transmitting data including SS7, GSM SS7, HSDPA, WCDMA, CDMA2000, **GPRS**, Bluetooth, Wifi, WiMax, or any other WPAN, WLAN, or WWAN wireless data transfer protocol.”). Apple’s Petition thus addresses “bearer” consistent with the District Court claim construction proposals of both parties, and the absence of dispute over this term’s meaning rendered unnecessary a formal claim construction for this term in the Petition. *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“claim terms need only be construed to the extent necessary to resolve the controversy”) (cited in Pet.,5).

HBCU blatantly mischaracterized events in Court by falsely alleging that the parties have an ongoing dispute over “bearer” that may require the Court to re-construct the term at a later stage of the proceeding. Sur-Reply, 1 (“[The Court’s] current ‘plain and ordinary’ ruling will likely need to be revisited later, on a fuller record, because the parties disagree about what that ordinary meaning is.”), 3 (“[B]oth the Court and Parties currently understand that both these terms may require further construction later”). HBCU omits that, immediately after the *Markman* hearing,

“*[t]he parties propose[d] the Court construe [bearer] to have its ‘plain and ordinary meaning.’*” EX2030 (emphasis added); *see also* EX2031. Acknowledging the joint proposal, *the Court then ordered that “bearer” be given its plain and ordinary meaning*, specifically noting that this construction was “*final*.” APPLE-1116 (emphasis added). Now resolved as consistent with the Petition, “bearer” is not relevant to institution of this IPR.

HBCU’s gamesmanship is prominent. Its Motion for Discretionary Denial never identified Apple’s or HBCU’s specific claim construction that supposedly created tension between the Court and PTAB. Apple nonetheless provided this information in its Opposition briefing to inform the Director of Apple’s constructions and to explain why formal constructions were unnecessary in the Petition under *Wellman*. Opp. 20 (citing APPLE-1105, -1106, -1107, -1108 (claim construction briefing)). HBCU then raised new allegations of inconsistencies in the POPR, contrary to the Director’s instruction that “[t]he petitioner and the patent owner *should not* present discretionary considerations in the petition or the Patent Owner Preliminary Response (POPR), respectively.” Interim Director Discretionary Process Webpage, <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (emphasis added); POPR, 23-24.

Still, the claim construction briefing that Apple submitted with its Opposition reveals that Apple’s focus in Court was offering an alternative construction for

“bearer” consistent with plain meaning, to counter HBCU’s attempts to construe bearer in a manner that was likely to both lead to confusion and improperly exclude disclosed embodiments. APPLE-1106, 13 (“HBCU Messaging’s construction is [] unnecessarily verbose. There is no good reason to present jurors with 12 examples of messaging protocols.”), 4 (HBCU’s “construction of ‘bearer’ inexplicably replaces [] one simple word with 31 more complicated words”). But throughout its briefing in the IPR, HBCU ignores that HBCU—not Apple—identified “bearer” as a term requiring construction in Court. *See* APPLE-1123; APPLE-1124. Indeed, but for HBCU’s actions, Apple explained to the Court that a construction should not have been necessary for this term:

[O]n this term [bearer], Apple did provide a construction to the extent it was helpful to the Court. ***But this was not a term that we had thought needed construction. ... [I]t’s been our position that one of skill in the art would understand this, have a plain and ordinary meaning to it.*** It’s a bearer.

APPLE-1117, 46-47 (emphasis added); *see also id.*, 43 (“We also think that it is consistent with the plain meaning.”). Thus, Apple’s Court construction has always been consistent with its PTAB construction. HBCU conveniently ignored these facts in the Sur-Reply.

The Sur-Reply also fails to acknowledge that Apple’s proposed Court construction was *broad*er than HBCU’s. Both parties agreed in Court that a “bearer” encompasses communication or messaging “protocols” such as GPRS, which Apple mapped in the Petition. APPLE-1105, 12-13; APPLE-1117, 37:14-39:19, 43:6-14. The parties’ dispute in Court centered over whether the full scope of “bearer” further encompassed “channels” apart from the protocols used for messaging over channels. *Id.* Apple contended that “bearer” encompassed both protocols and channels; HBCU sought to limit “bearer” to protocols only. *Id.*; *see also* APPLE-1116.

HBCU’s allegations of gamesmanship are plainly unfounded in this context, especially as Apple never proposed that “bearer” should be construed narrowly in Court in any way that would have excluded Apple’s prior art mappings in the Petition. The Petition instead mapped a prior art protocol (GPRS) to the claimed “bearer” in a manner that not only aligned with Apple’s proposed Court construction, but that also satisfied HBCU’s narrower construction and using a protocol that was explicitly identified as a “bearer” in the specification of the ’127 Patent. These facts implicate none of the concerns over inconsistencies, inefficiencies, or unfairness expressed in *Revvo*. *See Revvo* at 4 (“The Board’s claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums. ... To that end, the rules discourage petitioners from seeking broader constructions at the Board to support a patentability challenge

while seeking narrower constructions in litigation to avoid infringement liability.”).

Likewise, HBCU’s citation in the Sur-Reply to the *W.L. Gore* case to insinuate that Apple committed “a fundamental violation of the most basic principles of patent law and of simple fairness” by “us[ing] of one construction for purposes of infringement and a different construction for purposes of validity” is inapt here. Sur-Reply, 2. Again, Apple’s treatment of “bearer” in the IPR aligned with both parties’ proposed constructions in Court and with the ’127 Patent specification.

**B. “cellular core network”**

Similarly, Apple’s treatment of “cellular core network” in the Petition is not inconsistent with its construction in Court. *Compare* APPLE-1105, 13 (Apple proposing “A network connecting cellular base stations.”), *with* Pet., 60 (citing multiple corroborating exhibits (APPLE-1011, APPLE-1014, and APPLE-1015) to demonstrate that Horvath’s circuit services network 104 includes a network connecting cellular base stations). Here also, HBCU, not Apple, identified “cellular core network” as a term requiring construction. *See* APPLE-2029. And similarly, Apple’s claim construction briefing highlighted the flaws in HBCU’s overly narrow construction in a manner consistent with the meaning advanced in the Petition, including citing to a technical dictionary that reflects the plain and ordinary meaning of the term. APPLE-1105, 13 (“Apple does, however, object to HBCU Messaging’s baseless importation of numerous limitations that complicate rather than elucidate the term’s

meaning”), 4, 15 (citing Newton’s Telecom Dictionary).

As with its arguments over “bearer,” HBCU’s contention that Apple sought an unfair advantage through its proposed construction in Court does not match up to reality. Again, HBCU proposed the *narrower* construction in Court; Apple’s was *broader*. See APPLE-1106, 10-14 (HBCU relying on prosecution disclaimer to propose limiting “cellular core network” to “[o]ne or more entities responsible for: maintaining a database of subscriber information for a cellular network, for example, a home location register (HLR) and/or a home subscriber server (HSS); providing access to a short message service center (SMSC) or multimedia message (MMS) server; and providing Internet access to one or more mobile devices via at least mobile operator base stations.”). Accordingly, the concerns animating *Revvo* where a “petitioner[] ... seek[s] broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability” do not apply here, particularly where Apple proposed a broader construction in Court and mapped the art not inconsistent with that construction in the Petition. *Revvo*, 4.

Importantly, Apple also brought its construction of “cellular core network” to the Director’s attention at its first opportunity for briefing after *Revvo* was released and made precedential. Opp., 20 (citing claim construction briefing APPLE-1105, -1106, -1107, -1108). Apple did this proactively even though HBCU elected not to

submit the parties' constructions in its Motion for Discretionary Denial. Regardless, Apple's proposed construction is no longer relevant because the Court adopted HBCU's proposal as its "final" construction in the *Markman* Order. APPLE-1116, 2. Apple's Preliminary Reply (Paper 13) explains how the Petition's prior art combination still meets the "cellular core network" limitations of the Challenged Claims even under HBCU's construction as the Court adopted. Reply, 2-3. The Petition grounds thus remain viable even if the Board construes "cellular core network" in the same manner as the Court.

**C. "wherein ... when"**

HBCU's arguments over the "wherein ... when" terms are similarly deficient.<sup>1</sup>

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<sup>1</sup> "wherein ... when" is a shorthand for four limitations recited in claims of the '127 and '182 patents that each similarly describe an action ("wherein") and a condition ("when") for the action. The parties and the Court have addressed "wherein ... when" only in the context of these four limitations of the '127 and '182 patents. See APPLE-1105, 6 (Apple's opening claim construction brief); APPLE-1116, 2-4 (*Markman* Order addressing "wherein...when" for '127 and '182 patents). *No claims asserted from the other five patents in Court includes a "wherein ... when" limitation subject to the Court's construction.* Apple's challenges to the asserted claims in related petitions on those five patents are therefore not impacted

Because the Petition’s prior art combination addresses the conditional relationship articulated in Apple’s proposed construction in Court, there is no divergence between Apple’s treatment of “wherein ... when” at the PTAB and Apple’s construction in Court. *See* APPLE-1105, 6-10; APPLE-1117, 23:20-24; Pet., 55-61.

In the Sur-Reply, HBCU argues that “nothing absolves Petitioner from its failure to seek claim construction here or to at least make the Board and Director aware of its differing positions.” Sur-Reply, 1. Not so. HBCU disregards critical facts.

First, because the Petition applied art consistent with Apple’s proposed construction in Court (and therefore also consistent with HBCU’s broader position), there was no need to formally construe “wherein...when” in the Petition under *Wellman*. *See* Pet., 5.

Second, the contention that Apple “fail[ed] ... to at least make the Board and the Director aware of its differing positions” is false. As discussed above, Apple’s Opposition brief (Paper 8)—*i.e.*, Apple’s first opportunity for briefing following release of *Revvo*—expressly acknowledged that “the parties identified several terms for construction in district court” and cited each party’s claim construction briefing. Opp., p. 20 (citing APPLE-1105, -1106, -1107, -1108). By contrast, HBCU elected

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by “wherein...when” constructions. *See* IPR2025-01493, IPR2026-00104, IPR2026-00105, IPR2026-00107, and IPR2026-00109.

*not* to submit the parties' specific claim construction proposals from Court with its Motion for Discretionary Denial. Apple thus went beyond what was necessary to respond to HBCU's arguments to inform the Director of its positions in Court and to explain why formal constructions were unnecessary in the Petition under *Wellman*. Opp., p. 20. This is exactly what *Revvo* calls for. *See Revvo*, 3-4 ("Although the Board's trial rules do not necessarily prohibit petitioners from taking inconsistent claim construction positions before the Board and a district court, when a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted.") (internal quotations omitted).

Third, HBCU's criticisms are not applicable in view of more recent developments in Court. For example, Apple agreed before the Decision denying institution to maintain plain and ordinary meaning for "wherein...when" in Court, not inconsistent with the Petition. *See* EX2030. Although HBCU notes that the parties expressed disagreement over the plain and ordinary meaning in an email to the Court following the *Markman* hearing, it is still the case that the Court proceeded to "order plain and ordinary meaning for the 'wherein...when' terms at this stage." EX2031; APPLE-1116.

For avoidance of doubt, however, and in an effort to moot the parties' earlier dispute, unless the Court requests further clarification from the parties or if HBCU

itself seeks further construction, *Apple certifies that it will apply the plain and ordinary meaning of the “wherein...when” terms in the district court litigation*, consistent with the Court’s recent Order. Apple’s treatment of “wherein...when” in this IPR has been and will remain consistent with the Court’s construction if IPR is instituted.

### **III. CONCLUSION**

As noted by the initial referral, other discretionary factors strongly favor referral of the Petition for the reasons addressed in Apple’s Opposition briefing, such that the PTAB remains the best forum to adjudicate patentability of HBCU’s patents. *See Paper 12.*

Accordingly, and for each of the reasons addressed herein, Apple respectfully requests that Apple's request for Director Review be granted, that the Director's decision denying institution be vacated, and the Petition be referred and instituted on the merits.

Respectfully submitted,

Dated: March 10, 2026

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**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on March 10, 2026, a complete and entire copy of this Petitioner's Request for Director Review of the Decision Denying Institution and Exhibit APPLE-1117 were provided by email to the Patent Owner by serving the correspondence email address of record as follows:

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