

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 SUR-REPLY TO PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL**

**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)

HBCU's Reply raises issues beyond the scope of authorized briefing, after requesting such briefing without first conferring with Apple. *See* EX3101 (request limited to addressing "the full search history undertaken by the [] Examiner[]"). Still, even if considered, HBCU's arguments are not compelling.

To start, HBCU extends by misrepresenting Office policy in arguing that "Petitioner's material error arguments should have been made within the Petition itself." PO Reply, 1. In its "Interim Director Discretionary Process Webpage" (available at <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>), the Office addresses this very question by indicating that "[t]he petitioner and the patent owner should **not** present discretionary considerations in the petition or the [POPR], respectively." *Id.*, §I.C. "A petitioner should raise any discretionary issues in its opposition ..., including issues relating to 35 U.S.C. § 325(d)." *Id.*, §III.A. Apple's briefing rightly adheres to this policy.

Then, strikingly, just three lines of HBCU's Reply address the specific issue requested and authorized for briefing, *i.e.*, "the full search history undertaken by the [] Examiner[]." PO Reply, 1; EX3101. But this is not surprising because there was nothing new to add about the Examiner's search beyond what Apple already addressed in the Opposition. Indeed, HBCU cites just a single page from the file history in connection with the search (EX1002, p. 24), which page lists only a handful of queries—including just *one* prior-art keyword query—that the Examiner entered

days before mailing the Notice of Allowance. PO Reply, 1. Apple’s Opposition *already addressed* this search, however. Specifically, the Opposition explained why that final search did not cure the Examiner’s original error in failing to conduct a search on the claims entered by preliminary amendment *before allowing claim 29* and before the applicant accepted the allowable subject matter. Pet. Op., 7 (“The Examiner’s final search before mailing the Notice of Allowance ... did not address the features from claim 29 at all (*e.g.*, no search for cellular core network).”).

HBCU’s remaining arguments are similarly unavailing. *See* Reply, 2. For example, HBCU falsely asserts that “the Examiner had the substantive Tsampalis reference.” PO Reply, 2. But the file history shows that HBCU *never* cited Tsampalis (or Tsampalis PCT) to the Examiner during prosecution. Pet. Op., 8-11. This further undermines any basis for settled expectations, especially since similar claims would later be found invalid over Tsampalis in Germany. *Id.*; EX2013.

Finally, HBCU’s conclusory assertion that Apple’s broader-than-*Sotera* stipulation is inadequate ignores that the district court trial is scheduled months earlier than the expected final written decision in this IPR. PO Reply, 2. HBCU also fails to point to any filings from or positions taken in district court that actually undermine the stipulation’s ability to fully assuage any concerns of overlap between the proceedings. *Id.*; DD Brief, 16-17.

Respectfully submitted,

Dated: December 29, 2025

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**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on December 29, 2025, a complete and entire copy of this Petitioner's Sur-Reply to Patent Owner's Request for Discretionary Denial was provided by email to the Patent Owner by serving the correspondence email address of record as follows:

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