

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner

v.

HBCU MESSAGING US LP,
Patent Owner

IPR2025-01486
U.S. Patent No. 8,918,127

**PATENT OWNER'S RESPONSE TO PETITIONER'S REQUEST FOR
DIRECTOR REVIEW OF THE DECISION DENYING INSTITUTION**

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Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.,
IPR2025-00632 (Nov. 3, 2025) passim

W.L. Gore & Assocs. v. Garlock, Inc.,
842 F.2d 1275 (Fed. Cir. 1988)5

TABLE OF EXHIBITS

Exhibit	Description
2032	District Court Litigation, Dkt. 66
2033	District Court Litigation, Dkt. 67
2034	District Court Litigation., Dkt. 74

I. INTRODUCTION

Petitioner’s (“Apple”) entire argument is predicated on a single presumption, that the Director considered information outside the discretionary denial briefing—and contrary to the Director’s own rules—to overturn its previous decision.

Apple’s arguments in seeking to overturn the Director’s decision to grant discretionary denial are based solely on a single Patent Owner’s (“HBCU”) filing, a three-page sur-reply to the Petition (Paper 14 “Petition Sur-Reply”), filed almost 40 days *after* briefing for discretionary denial concluded. There is zero evidence that the Director relied on briefing outside the discretionary denial context, and in any event, Apple’s arguments are unavailing.

Moreover, the fact remains that Apple did apply differing claim constructions in the district court action versus the Petition. Apple seeks to obscure that fundamental fact by standing on (false) procedural arguments. The Director’s decision to discretionarily deny this IPR was proper and should stand.

II. ARGUMENT

A. **Apple’s Reliance on an Unrelated Brief Is Irrelevant to Discretionary Denial**

As an initial matter, Apple’s request should be rejected out of hand given that the entire basis of its request is an unfounded accusation that the Director ignored its own rules by considering a sur-reply unrelated to the discretionary denial briefing. Apple knows that the Director is limited to the discretionary denial

briefing when deciding to deny an IPR but makes the argument anyway. (Paper 16 at 4 (citing the Interim Director Discretionary Process Webpage).) In fact, Apple embraces this rule to seemingly accuse HBCU of intentionally arguing discretionary denial in the Petition Sur-Reply to seek the Director's denial of this IPR. (*Id.*) This absurd proposition has zero support. Yet Apple proceeds as if it were an accepted fact.

Apple's subterfuge includes conflating the briefing itself. Rather than identify the sur-reply as relating to the underlying Petition, as the record reflects, Apple introduces it by saying, "only twelve days prior to the [discretionary denial] Decision, HBCU filed a Sur-Reply." (Paper 16, Pet. Request for Review at 1.) Clearly, Apple intends the Director to presume the sur-reply was somehow errantly directed at the discretionary denial briefing. But that is simply not true.

The discretionary denial briefing is decidedly different from what Apple seeks to portray. HBCU filed its Discretionary Denial Brief on November 10, 2025. (Paper 7.) Apple filed its initial Response on December 9, 2025. (Paper 8.) HBCU replied to the Request for Discretionary Denial on December 24, 2025, (Paper 10), followed by Apple filing its Discretionary Denial Sur-Reply on December 29, 2025, (Paper 11).

After discretionary denial briefing was completed, the Director initially referred this IPR to merits and non-discretionary considerations. (Paper 12.) This

decision was *sua sponte* reversed by the Director on February 18, 2026. (Paper 15.) Importantly, all of the discretionary denial briefing occurred long after the claim construction briefing in the District Court was completed on October 24, 2025. (Exs. 2032, 2033, District Court Litigation, Dkts. 66 and 67.) Apple thus had multiple opportunities to address its claim constructions in the discretionary denial briefing, including having the final say in its sur-reply, but remained silent.

Ultimately, Apple asserts that the decision to deny the IPR “was clear error based on an incomplete and inaccurate record of the District Court proceeding left by HBCU in its Sur-Reply.” (Paper 16 at 2.) This reference to the “Sur-Reply,” not the discretionary denial briefing again wrongly presumes that the Director would violate its own rules by considering this non-discretionary denial brief in its decision. On that basis alone, Apple’s request should be summarily denied.

B. Denial Is Appropriate for at Least the Same Reasons IPR No. 2025-1493 Was Denied

Although there is no opinion attached to the denial decision, the Director cites to *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025) (precedential). (Paper 15 at 1 fn. 1.) From this, Apple presumes that the claim construction issue *alone* is why discretionary denial was ultimately granted. But this supposition is contradicted by another denial in a related IPR issued at the same time.

Specifically, the Director also issued discretionary denials for two related IPRs: IPR2025-1488 (which is also being challenged by Apple in Director Review) and IPR2025-1493 (for which Apple is not asking for Director Review). Unlike the other two IPR denials, the Director stated that the reason for denying IPR2025-1493 was, “because intrinsically similar issues [to those in IPR2025-1486 and -1488], where the involved patents are in the same family, will be addressed by the district court.” (IPR2025-1486, Paper 15 at 1 fn. 2 (Feb. 18, 2026).)

Apple’s decision not to challenge the Director’s denial for IPR2025-1493 is telling. There are no claim terms being construed for any of the claims in the ’450 patent. (District Court Case, Dkt. 74 at 1-4.) If the Director denied institution for IPR2025-1493, for a patent in which there are *no* claim construction terms at issue, for “intrinsically similar issues” as the two patents Apple is challenging, claim construction clearly cannot be the reason for denial. The same is, of course, true for this Petition, in which multiple issues of validity (for example) may be addressed in both forums.

C. HBCU Accurately Reported the Claim Construction Issues in Its Petition Sur-Reply

Even considering, for argument’s sake, that the Director improperly relied on the Petition Sur-Reply, denial *is* appropriate in view of *Revvo*. As set forth below, Apple knew HBCU’s proposed constructions, as well as its own, well in

advance of filing its Petition, and still offered differing constructions of key terms before the District Court and the Board. (*See* Exs. 2032, 2033).

Importantly, Apple chose to remain silent about the different constructions during the entire discretionary denial briefing process. Apple’s approach violates the most basic principles of patent law and of simple fairness. *W.L. Gore & Assocs. v. Garlock, Inc.*, 842 F.2d 1275, 1279 (Fed. Cir. 1988) (holding claims ought to be construed the same way when determining validity and infringement); *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 4 (Director Nov. 3, 2025) (precedential) (“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.”).

To the extent that the Director’s decision granting discretionary denial was based on claim construction issues, HBCU stands by its representations of the claim construction process in the District Court. There is no denying the fact that Apple offered no constructions for any terms in any of its Petitions while simultaneously offering constructions—or arguments of indefiniteness—for multiple terms.

The fact that Apple was not successful in convincing the District Court to adopt its narrower proposed constructions at the District Court does not absolve it of attempting to game the system and obtain broader constructions here. Apple’s

suggestion of “no harm, no foul” flies directly in the face of the *Revvo* decision. *Revvo Techs.*, IPR2025-00632, Paper 20 at 4 (“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.”).

1. “bearer”

Contrary to its “plain and ordinary” construction in the Petition, Apple proposed its own construction in the district court action, specifically: “[a] communication channel or protocol.” (Ex. 2034, District Court Litigation. Dkt. 74 at 1.)

Apple leans on the fact that HBCU, not Apple, originally proposed the term for construction. (Paper 16 at 6.) But this is of no matter, since Apple then ***proposed its own construction*** rather than assert “plain and ordinary meaning” or “no construction,” as it asserted in this IPR. It makes no difference which party originally suggested that the term be construed; the reality is that Apple chose to offer its own construction in district court while asserting no construction here.

Apple attempts to explain away its differing construction by asserting that its construction *is* the plain and ordinary meaning, but that is obviously false, and it is outrageous for Apple to argue otherwise. An assertion of “no construction necessary” means exactly that—the words of the claim are to be applied as is.

That is what Apple did in its Petition. In contrast, offering *any* construction necessarily proposes to substitute new words for the words of the claim when analyzing infringement or validity. That is what Apple did in district court. The two are not the same. Nor did Apple ever (not in district court, not here) offer any evidence that its proposed construction in district court equated to any “plain and ordinary” meaning. Apple is thus wrong both legally and factually.

Apple maintained its proposed construction for “bearer” throughout the claim construction briefing in district court and through the entire remaining *Markman* process. It was only after Judge Albright hinted that he might rule against Apple on the term and asked the parties to see if they could resolve the outstanding constructions, that Apple agreed to “plain and ordinary meaning.” (See Ex. 2034, District Court Litigation Dkt. 74 at 1 (noting the parties’ “Initial proposed construction” and its “Post-Markman Proposal”).)

Ultimately, the Court accepted the parties’ agreed-upon approach of giving the term its plain and ordinary meaning, while acknowledging the parties *initially* proposed different constructions. (*Id.*) Even then, the *Markman* ruling may well be temporary, given that at least one other term will require further arguments as the case proceeds. (Ex. 2031, Jan. 28, 2026, Email from Anna Schmit, District Court Law Clerk (“Thank you for this clarifying email. Judge Albright would like to see more briefing at the summary judgment stage and has ordered plain and

ordinary meaning for the ‘wherein. . . when’ terms at this stage. A claim construction order is forthcoming.”.) Given the parties’ apparent difference over the meaning of “bearer,” it would not be surprising if Apple were later to reassert its previous construction or even a new construction for “bearer,” which HBCU and the district court will then have to address. This is the exact circumstance that *Revvo* appropriately seeks to avoid, and Apple’s inconsistencies require denial of the institution.

Apple makes other arguments to the effect that its proposed construction in district court was broader than HBCU’s. But this also is a smokescreen. The issue is not Apple’s proposal versus HBCU’s proposal; it is *Apple’s differing positions in the two forums*. Every attempt by Apple to distract from its own fundamental failure to simply be consistent only serves to highlight its unfair approach.

2. “wherein . . . when”

Apple initially argues that it applied art consistent with Apple’s proposed construction in Court, therefore Apple did not run afoul of *Revvo*. (Paper 16 at 10.) But this argument is false on its face. Apple’s proposed construction would require a result to *always* be true in light of a given condition, but it never analyzes every single word of each prior art reference to *negate* other potential options occurring under the given condition.

More importantly, Apple says nothing about what the district court ultimately decided, which is to defer decision on this term until later in the case. Specifically, although Judge Albright provisionally held that the term should obtain its plain and ordinary meaning, he also asked that the parties provide more briefing on what the plain and ordinary meaning of this term is at the summary judgment stage. (Ex. 2031, Jan. 28, 2026, Email from Anna Schmit, District Court Law Clerk (“Judge Albright would like to see more briefing at the summary judgment stage and has ordered plain and ordinary meaning for the ‘wherein. . . when’ terms at this stage.”).) Thus, not only does Apple’s past position in district court differ from its position here but, it may yet (and likely will) do so in the future.

Apple’s assertion that “it will apply the plain and ordinary meaning of the ‘wherein . . .when’ terms in the district court litigation” is meaningless here. (Paper 16 at 12.) Judge Albright will not make a final decision on the meaning until summary judgment, which is set to begin in April 2027. Apple’s proposed construction in district court bore no resemblance to anything like “plain and ordinary” meaning, and its refusal to simply concede the whole point reflects that it will indeed try to subtly or not-so-subtly alter that meaning going forward.

Moreover, contrary to Apple’s assertion, it did *not* notify the Director about claim construction in this IPR. (*See* Paper 16 at 10.) To expect the Director to

recognize that four additional IPRs—filed almost three months later—somehow address the same claim construction issues is a bridge too far. Indeed, Apple neglects to explain that the oppositions Apple refers to were filed *the day before* the Director denied this IPR, and so obviously were not part of the denial decision here.

3. “cellular core network”

This final term might be even more problematic for Apple, to the point that in a separate IPR proceeding (IPR2026-00105 for U.S. Pat. No. 11,991,600) Apple finally offered to drop its challenge to any claims that recite the term “cellular core network” after fighting for months to obtain its preferred construction. (IPR2026-00105, Paper 12, Reply at 4 (“Apple hereby officially withdraws its challenge to claims 5 and 16 to moot this issue and thereby simplify the case.”).) Despite that, Apple here maintains its challenge to claims reciting a “cellular core network.”

Incredibly, Apple asserts that its treatment of “cellular core network” in the Petition is consistent with its construction in the District Court. In Apple’s Petition, it offered no construction. But in district court, Apple asserted that “cellular core network” should be construed as “A network connecting cellular base stations.” (Ex. 2033, District Court Litigation, Dkt. 67 at 7.)

Notably, in its opening claim construction brief, Apple relied on the intrinsic evidence from the patent specification to justify its construction, not technical

dictionaries or other evidence that might suggest its proposed district court construction aligned with the plain and ordinary meaning. (Ex. 1105 at 11-12.) In fact, nowhere in any of its district court claim construction briefing does Apple assert its construction constitutes the plain and ordinary meaning, only pointing to the fact that a dictionary defines “core network”—not the term at issue—as “the backbone of a carrier network.” (*Id.* at 12.) Not even Apple’s proposed construction, “a network connecting cellular base stations,” uses this supposed “plain and ordinary” language. (EX 1116 at 2.)

Ultimately, the District Court adopted HBCU’s proposed construction, which was based on the patentees’ lexicography, not the plain and ordinary meaning. (Ex. 2034, District Court Litigation Dkt. 74 at 2.) Although the construction for this term is final, that does not change the fact that Apple filed its Petition *knowing* it proposed *different* constructions to the district court for this and other terms. More to the point, Apple’s Petition is still based on the plain and ordinary meaning of the term, not the lexicographic construction applied by the district court.

This is exactly what the Board in *Revvo* explained it was seeking to avoid. It does not matter that the District Court ultimately adopted HBCU’s construction. (*Revvo Techs., Inc.*, IPR2025-00632, Paper 20 at 4.) “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.” (*Id.*) Further, it does not matter whether Apple now “accepts” HBCU’s or the District Court’s construction; that construction is different from the construction Apple proposes here. (*Id.* at 5 (“Simply noting that the petitioner is adopting the patent owner’s claim construction proposals from district court, however, is not a sufficient reason for advancing different positions in the two forums.”).)

Here again, Apple asserts that HBCU first identified the term for construction. (Paper 16 at 7.) But as before, this fact is meaningless. The relevant point is that Apple proposed a construction for the term, rather than relying on the plain and ordinary meaning.

Even after making the absurd accusation that HBCU was somehow trying to direct the Director’s attention to an improper Petition sur-reply to change the denial decision, Apple is doing the same. Apple asserts that its “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.” (Paper 16 at 9.) In this way, Apple seeks to conflate its substantive Petition Reply with the Discretionary Denial briefing. This doublespeak should be seen for what it is: an improper attempt to salvage its IPR by referencing briefing outside the scope of the Discretionary Denial issues.

Ultimately, the Director was correct to exercise discretion and deny institution of the IPR in light of *Revvo*. For all the reasons above and previously stated in HBCU's discretionary denial briefing, Apple's claim construction inconsistencies between district court and its Petition fall squarely under *Revvo*. This is exactly the situation *Revvo* was meant to avoid: inconsistencies between forums and disincentivizing different constructions without justification or explanation.

III. CONCLUSION

For the reasons set forth above, the denial of institution should be maintained.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on March 18, 2026, I caused a true and correct copy of **PATENT OWNER’S RESPONSE TO REQUEST FOR REVIEW** to be served via electronic mail on the following counsel for Petitioner:

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