

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 AUTHORIZED REPLY TO
PETITIONER'S DISCRETIONARY DENIAL OPPOSITION**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Submitted Electronically via PTAB E2E

I. INSTITUTION IS NOT PROPER UNDER § 325(D)

Petitioner's response to Patent Owner's request for a discretionary denial should be rejected *first* because its arguments come too late. Petitioner's material error arguments should have been made within the Petition itself. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8-9 (P.T.A.B. Feb. 13, 2020) (Petitioner bears the burden "to make a showing of material error" under §325); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17-18 (P.T.A.B. Dec. 15, 2017). Indeed, the six *Becton* factors "should be read broadly . . . to apply to any situation in which a petition relies on the same or substantially the same art or arguments previously presented to the Office." *Id.* at 10. That is exactly the case here, as set forth within Patent Owner's Discretionary Denial Brief. (Paper 7 at 3-5.)

Second, Petitioner's untimely arguments are factually wrong. The Examiner conducted a second, more extensive keyword search beyond the one cited by Petitioner. (*See* Ex. 1002 at 24.)

Third, Petitioner failed to explain why those search results were supposedly inadequate. This is especially true given that Petitioner provides zero information on how the Examiner surveyed the various search results and selected art to apply.

Fourth, Petitioner is also silent on why the references before the original Examiner were supposedly "inadequate." As set forth in Patent Owner's

Discretionary Denial Brief, the Examiner had the substantive Tsampalis reference, as well as multiple other references that were substantively cumulative with Horvath. (Paper 7 at 3-5.) Nothing whatsoever suggests that the Examiner failed to perform a thorough analysis that found the claims patentable for the same reasons Petitioner's asserted art likewise fails here.

Fifth, Petitioner's references to invalidation of the European counterpart make no sense. The claims here include elements and features different from the European invalidated (and allowed claims), and multiple patents within the same family have been granted *after* the German nullity proceedings and *over* materials and art from those same German proceedings. (*See, e.g.*, U.S. Patent Nos. 11,089,450 and 11,653,182.)

Sixth, Apple's grumbling that a *multi-trillion dollar company* could not be bothered to track "two dozen" U.S. family patents issuing during active German proceedings is absurd. Burying one's head does not negate settled expectations.

Finally, Petitioner's Reply fails to address multiple factors of Patent Owner's Discretionary Denial Brief, including the inadequacy of Apple's *Sotera* Stipulation, the full effect of the European litigation, the full overlap in efforts between the District Court litigation and the IPR, and the settled expectation that come with the *eleven years* the patent has been in effect. For all these additional reasons, discretionary denial should be granted.

Respectfully submitted,

Dated: December 24, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on December 24, 2025, I caused a true and correct copy of **PATENT OWNER’S REPLY TO DISCRETIONARY DENIAL** to be served via electronic mail on the following counsel for Petitioner:

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