

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 OPPOSITION TO PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL**

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**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)

## I. INTRODUCTION

HBCU's Request for Discretionary Denial should be denied and the Director should proceed to consider the merits of Apple's Petition for *inter partes* review of U.S. Patent No. 8,918,127 ("the '127 Patent"). Under all relevant considerations, institution would make appropriate use of Office resources.

At the outset, referral and institution is warranted to review material errors that arose during original examination of the '127 Patent. The application for the '127 Patent received limited scrutiny during prosecution, as evidenced by the fact that the Examiner allowed claims in a first action before he had even conducted a search on the claim features identified as allowable. The Examiner was also never provided with highly relevant prior art—Tsampalis—that a German court would later use to find substantially similar claims of a counterpart EP patent invalid.

Institution would also promote efficient resolution of the parties' dispute and narrow issues in the parallel district court litigation. A final decision in the IPR is expected at least *four months* before the scheduled trial date. And if instituted, Apple's broad stipulation would substantially mitigate overlap between the IPR and the district court, leaving the parties to address different issues in each forum.

Finally, despite the age of the '127 Patent, institution is warranted because the '127 Patent is just one of seven related patents in the same family that HBCU asserts against Apple in district court. Six of the related patents have not been in

force for long (all between 1.5 – 5 years), and it would be an efficient use of Office resources to institute petitions on all seven patents together, especially considering the overlap in claimed subject matter and prior art applied among the Petitions.

Accordingly, and for each of the reasons discussed herein, Apple respectfully submits that HBCU's request for discretionary denial be denied.

## **II. MULTIPLE COMPELLING REASONS SUPPORT MERITS REVIEW AND INSTITUTION OF APPLE'S IPR PETITION**

### **A. The '127 Patent is the Product of Material Examination Errors**

Original prosecution of the '127 Patent was limited and failed to meet the Office's high standards for a thorough search and examination. The Examiner immediately identified allowable subject matter in his first communication to the Applicant. But the only prior art search that the file history shows to have been conducted before the Examiner identified allowable subject matter was also performed *before* the Applicant filed a preliminary amendment that replaced the original claims of the application. The Examiner's failure to properly search the presented claims led him to miss a range of prior art clearly showing that the feature that formed the basis for allowance was well known before the priority date.

More, the Examiner failed to consider highly relevant prior art that the Applicant would later cite to the Examiner during prosecution of continuations of the '127 Patent, but that was never cited during prosecution of the '127 Patent itself.

This art—WO 2004/061583 (“Tsampalis PCT”, EX2009)—would later be applied by a German court to invalidate similar claims of a counterpart European patent (EP Patent 2 177 072). Apple’s Petition now relies on an equivalent Tsampalis publication (EX1005) to demonstrate obviousness of the Challenged Claims. These errors merit further review and correction through IPR. *Padagis US LLC v. Neurelis Inc.*, IPR2025-00464, Paper 12, 3 (PTAB Jul. 16, 2025) (referral is warranted where “Petitioner appears to show a material error by the Office”).

**1. The Examiner Failed to Conduct a Search for the Claim Feature that Formed the Basis for Allowance, Leading the Examiner to Miss Highly Relevant Prior Art**

Office guidelines require examiners to “conduct a thorough search of the prior art.” EX1111 (MPEP Chapter 900, Rev. E9-11.2013, March 2014), 49; *see also id.*, 53 (“comprehensive search”); 37 C.F.R. § 1.104 (“the examiner shall ... make a thorough investigation of the available prior art”). Here, however, the Examiner’s search fell well short of Office standards. Indeed, the file history contains no indication that the Examiner searched for the relevant claim features at all.

As background, the Examiner issued a communication on September 9, 2014, pursuant to the Applicant’s request to participate in the then-active First Action Interview Pilot Program. EX1002, 63-67 (Examiner’s communication), 137-138 and 142-143 (Applicant’s request). The 9/9/2014 communication was an ab-

breviated action that identified three claims as rejected under §103, but that identified nearly all the dependent claims as allowable. *Id.*, 67.

In response to the 9/9/2014 communication, the Applicant presented an amended claim set that added a limitation to the independent claims similar to a limitation previously recited in allowable dependent claim 29. This limitation required that “the request sent to the server and the response received from the server do not traverse the cellular core network” and corresponds to Elements [1g]/[11f] of the issued claims. EX1002, 37-49; EX1001, 12:20-22, 13:44-46. Following some minor corrections to the amended claims, the Examiner allowed the application for the '127 Patent on November 12, 2014. EX1002, 3-14.

The Examiner erred both procedurally and in substance in allowing the application based on the Applicant's incorporation of the negative limitation from claim 29, however. In particular, the Examiner never “conduct[ed] a thorough search of the prior art” as required by the MPEP. EX1111, 49. On the contrary, the Examiner appears to have identified claim 29 as allowable (along with almost every other dependent claim) without ever searching for the feature recited in that claim at all. According to the file history, the Examiner conducted just a single prior art search before issuing the 9/9/2014 communication that identified claim 29 as allowable. The search included just three queries:

EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	1	"20020077131"   "20060056309"   "20060167849"   "20090305729"   "20100131858"   "6678524"   "7085812"   "7171190"   "7298714"   "7600031"   "7751536".PN. and java	US-PGPUB; USPAT; USOCR; FPRS; EPC; JPO; DERWENT; IBM_TDB	AND	OFF	2013/04/11 12:24
S1	29	"20020077131"   "20060056309"   "20060167849"   "20090305729"   "20100131858"   "6678524"   "7085812"   "7171190"   "7298714"   "7600031"   "7751536".PN.	US-PGPUB; USPAT; USOCR; FPRS; EPC; JPO; DERWENT; IBM_TDB	AND	OFF	2013/04/11 10:16
S2	11	"8401576".pn.	US-PGPUB; USPAT; USOCR; FPRS; EPC; JPO; DERWENT; IBM_TDB	AND	OFF	2013/04/11 10:24

EAST Search History (Interference)

< This search history is empty >

EX1002, 68. As shown above, the Examiner conducted *no keyword searching* before allowing claim 29. Instead, the Examiner appears to have searched only for specific documents including those that the Applicant had cited in several earlier-submitted information disclosure statements (IDSes). *See* EX1002, 78-80, 83-85, 96-97, 123-134, 177-181, 224-226. The Examiner never looked beyond the specific references of record or references cited in the Applicant's IDSes.

Worse, the time stamps on the queries indicate that the Examiner's search was conducted on April 11, 2013. But the Applicant filed a preliminary amendment on June 7, 2014, that replaced the original claims of the application with an entirely new claim set. *Compare* EX1002, 209-12 (original claims), *with* 125-35 (preliminary amendment claims). None of the original claims that existed when the Examiner searched on April 11, 2013, included the feature identified as allowable in claim 29. *Id.* The Examiner should have performed an updated search before issuing the 9/9/2014 communication, but he never did.

The Examiner’s failure to perform a proper search was not harmless. Rather, the Examiner missed a wealth of prior art that confirms it was well known—and even the conventional practice—to “send[] a request via a packet switched wireless local area network (WLAN) base station to a server” and to “receiv[e] a response from the server via the packet switched WLAN base station” without the request or response “travers[ing] [a] cellular core network” as recited in the allowed claims. For example, an IEEE article from 2003 explicitly disclosed that WLANs and cellular networks were typically distinct from each other and it would have been natural for a request/response that a wireless device sends/receives over a WLAN network not to traverse a cellular core network in most cases. APPLE-1112, 1-3, FIG. 1. According to the article, “[o]nce the user has been successfully authenticated an authorized for network access, the WLAN access network grants the UE access to an IP network. In the simplest case, the IP network is the public Internet, and the user data is *directly routed from the WLAN access network to the Internet*” without traversing the cellular network (*e.g.*, 3GPP network). *Id.*, 5.

The Petition likewise explained how the Horvath-Tsampalis combination renders this claim feature obvious with respect to Element [1g]. Pet., 61-62; (citing EX1004; EX1009; EX1003, ¶88). Tsampalis further explains that the wireless device can send the request and response to any “web server or other server that may contain format capabilities for a plurality devices”—*i.e.*, servers that would not

necessarily require the device to access the cellular core network. EX1005, [0039], FIG. 6. The Examiner neither searched for nor identified any of this prior art. Nor did the Examiner search any other obvious sources of prior art relevant to this feature, such as WiFi/WLAN standards documents (*e.g.*, IEEE standards), cellular standards documents, networking textbooks, IEEE articles, or the like.

The Examiner's actions were problematic for other reasons as well. For example, in the 9/9/2014 communication, the Examiner failed to properly reject claim 29 under §112 for lack of written description support, as the specification never discloses that the inventor was in possession of the *negative* limitation of a request and response *not* traversing a cellular core network. The cellular core network 140 is mentioned twice in the entire specification, never in the context of the negative limitation. EX1001, 1:29-36, 7:17-25, FIG. 1; *Novartis Pharms. Corp. v. Accord Healthcare, Inc.*, 38 F.4<sup>th</sup> 1013, 1017-18 (Fed. Cir. 2022) (“silence will not generally suffice to support a negative limitation”). The Examiner's final search before mailing the Notice of Allowance likewise included just a single, narrow keyword search that did not address the features from claim 29 at all (*e.g.*, no search for cellular core network). And while the Examiner performed another search contemporaneously for related application U.S. Serial No. 14/307,184 the search history shows that the Examiner failed to address concepts such as a “cellular core network” reflected in the negative limitation there as well. EX1113, 85-

87, 118-120.

**2. The Examiner Never Considered the Prior Art Reference (Tsampalis PCT) that a German Court Would Later Apply to Invalidate Similar Claims of a Counterpart EP Patent After the '127 Patent Issued**

As a further consequence of the deficient search, the Examiner failed to identify or consider the teachings of Tsampalis PCT (EX2009).<sup>1</sup> Tsampalis PCT is highly relevant to the patentability of the claims of the '127 Patent. Not only do Apple and Dr. Traynor rely on an equivalent Tsampalis publication (EX1005) in the Petition grounds, but a German court previously relied on Tsampalis PCT to invalidate similar claims of a counterpart European patent in the same family as the '127 Patent. EX2013, 17-23 (12/15/2020 decision of Germany's Federal Court of Justice).<sup>2</sup> The German court's relied on Tsampalis PCT in the context of a nullity action brought by Apple after a previous patent owner asserted the EP counterpart against Apple in Germany in 2015. DD Brief, 5-6.

Notably, although HBCU and its predecessors have cited Tsampalis PCT in later continuation filings in the family, Tsampalis PCT was *never* cited during

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<sup>1</sup> HBCU concedes that Tsampalis PCT “has the exact same substance as the Tsampalis reference [EX1005] asserted in this Petition.” DD Brief, 5.

<sup>2</sup> Tsampalis PCT is identified as Document K5 in the German court decision.

prosecution of the '127 Patent itself. This left the Examiner to allow the '127 Patent in 2014 without having considered Tsampalis PCT. Nor did the Examiner have the benefit of any of the parties' briefing from the German proceeding addressing the relevance of Tsampalis PCT, or of the court decision itself.

In more detail, the EP claims invalidated by Tsampalis PCT and the claims of the '127 Patent are highly similar. The following table highlights overlap between similar limitations of claim 1 of each patent, for example:

EP 2 177 072 Invalidated Claim 1 <sup>3</sup>	'127 Patent Claim 1 Limitations
A <b>method</b> for providing a messaging service on a <b>sender's mobile wireless device</b> in a wireless communications network; the method comprising:	[1pre] A <b>method</b> of providing a messaging service for use in a <b>wireless device of a sender</b> , the method comprising:
the sender's mobile wireless device <b>verifying whether the destination address is capable of receiving the outgoing message via a packet-switched bearer</b> ,	[1b1] determining, by the wireless device of the sender, <b>whether the destination address corresponds to a subscriber of a service for receiving the outgoing message via a packet switched bearer</b>  [1b3] receiving a response from the server via the packet switched WLAN base station, <b>the response providing</b>

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<sup>3</sup> Based on English Translation from Patent Owner's Exhibit 2013. Apple also submits a certified English Translation of the FCJ Decision as Exhibit 1115.

	<b>an indication of whether the destination address corresponds to a subscriber of the service;</b>
wherein the step of verifying the destination address involves <b>sending an address verification request to the message server</b> ; wherein the verification request is sent to the message server (170) via base station (180) and the Internet (160) using a WPAN or WLAN;	[1b2] <b>by sending a request</b> via a packet switched wireless local area network (WLAN) base station <b>to a server</b> ;
<b>in the event verification is affirmative, the sender's mobile wireless device then automatically sending the outgoing message to the recipient's mobile wireless device at the destination address via the packet-switched bearer</b> , but otherwise, the sender's mobile wireless device automatically sending the outgoing message to the recipient's mobile wireless device at the destination address via an SMS bearer.	[1c1]-[1c2] selecting, by the wireless device of the sender, a transmission mode from the plurality of transmission modes, <b>wherein the wireless device of the sender selects the first transmission mode when the indication corresponds to a subscriber of the service</b> ,

EX1001, 1:44-12:22; EX2013, 6-7.

Much like the German court, the Petition relies on Tsampalis in relevant part to demonstrate the obviousness of multiple limitations of the Challenged Claims, including those shown in the table above. Pet., 30-56; EX1003, ¶¶53-82.

HBCU attempts to brush Tsampalis PCT and the FCJ Decision aside by noting that “amended claims were upheld as valid by Germany’s highest court.” DD Brief, 5. But HBCU fails to mention that the feature that secured validity of the

amended EP claims is not recited in any claim of the '127 Patent. Specifically, the EP claims were amended to require “check[ing] whether the destination message queue length has not exceeded a predetermined maximum length.” EX2013, 27-29. No claim of the '127 Patent includes this feature. EX1001, 11:44-14:45.

In light of these errors, Office resources would be well spent, and the public's interest would be well served, by referral and institution of Apple's petition.

**B. Institution Will Narrow the Parallel Litigation and Promote Efficient Use of Resources**

**1. The Board Will Reach a Final Decision Before the District Court Trial**

Trial in the parallel district court litigation is scheduled for July 12, 2027. EX2016, 4. The Final Written Decision (FWD) in this IPR is expected by early March 2027—four months *before* the trial. Institution will therefore promote efficient resolution of validity issues for the '127 Patent well before trial.

Four months is not “slightly after” the expected FWD, as HBCU alleges. DD Brief, 13-14. HBCU's citation to the Office's decision in *Samsung Electronics Co. Ltd., et al. v. VB Assets, LLC*, IPR2025-00870, Paper 11 (P.T.A.B. Oct. 10, 2025) (“*Samsung*”) is entirely inapposite, because the projected final written decision due date was five months *after* the scheduled trial date in that case. *See Samsung*, Paper 11 at 2. Far more consistent with the facts in this case is *Intel Corp. v. General Video, LLC*, IPR2025-01036, Paper 14 (PTAB Oct. 17, 2025) (“*Intel*”), in

which the projected final written decision due date was three months *before* the scheduled trial date in the Western District of Texas—one month less than here—and the Board concluded that these facts “reduc[e] the concern of inconsistent outcomes or significant duplication of efforts resulting from two proceedings operating in parallel.” *Intel*, Paper 14 at 2.

**2. Apple’s Broad *Sotera*+ Stipulation Will Eliminate Wasteful, Duplicative Efforts**

Apple has filed a broad stipulation that mitigates concerns over duplicative efforts. If the Director institutes IPR, the stipulation commits Apple to not pursue in the parallel litigation any invalidity ground based on prior art patents or printed publications that were raised or reasonably could have been raised in the IPR.

EX1102. But Apple’s stipulation does not stop there. The stipulation extends *beyond Sotera* to further waive “any other ground based on a combination of any prior art reference asserted as the basis of a ground in the instituted IPR with any system prior art,” thereby avoiding duplicative effort and inefficiencies even if the litigation is not stayed upon institution. *Id.*; *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Pap. 19, at 4 (PTAB Mar. 28, 2025).

**3. Holistic Consideration of the *Fintiv* Factors Favors Referral**

As discussed below, a holistic weighing of the *Fintiv* factors favors referral. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Pap. 11 (Mar. 20, 2020) (precedential).

**Factor 1 (Stay)**—Because no motion to stay has been filed, the outcome of such a motion cannot be inferred, nor the existence of a stay known. *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Pap. 24, at 7 (June 16, 2020) (informative). Factor 1 is therefore *neutral*.

**Factor 2 (Trial Date)**—As discussed above, the Board’s final written decision will issue four months *before* trial. Factor 2 therefore *favours referral*.

**Factor 3 (Investment)**—Investment in the district court proceeding remains low. The *Markman* hearing has not yet happened and will not have happened before the Director is likely to determine whether to refer this Petition for merits consideration. APPLE-2016, 3. Fact discovery will not close until October 6, 2026, and expert reports are not due until November 10, 2026—both well after an institution decision is due in this case. *Id.* These facts weigh strongly against discretionary denial, especially as IPRs can inform ongoing litigation. *See, e.g., CrowdStrike Inc. v. Webroot, Inc.*, IPR2023-00126, Pap. 9, at 10 (PTAB May 5, 2023) (early-stage investment weighs against denial).

Apple’s Petition was also timely filed months before the §315(b) statutory bar, and HBCU fails to demonstrate any evidence of gamesmanship in any perceived delay of filing. EX1114. Apple instead worked diligently to challenge all *two hundred* claims included in the *seven* asserted patents asserted by HBCU in the parallel litigation. These petitions cite extensive contemporaneous evidence

that HBCU claimed well-known features. Apple's IPRs promote efficiency by addressing related patents cohesively. Factor 3 therefore *favours referral*.

**Factor 4 (Overlap)**—As discussed above, Apple's broad stipulation eliminates overlap between the IPR and the parallel litigation. Factor 4 *favours referral*.

**Factor 5 (Parties)**—While the parties in the parallel litigation are the same (Factor 5), this factor alone does not favor denial, particularly where, as here, the Petition demonstrates strong merits of unpatentability. Factor 5 is *neutral*.

**Factor 6 (Merits and Other Considerations)**—As set forth in the Petition, the '127 Patent claims are plainly unpatentable over the prior art. The claims are directed to a predictable collection of conventional features for messaging from a wireless device. As discussed above, the Examiner rubber-stamped the Applicant's claims for the '127 Patent without conducting a search or considering highly pertinent prior art including Tsampalis PCT. Factor 6 therefore *favours referral*.

As discussed above, each *Fintiv* factor is either neutral or favors referral, and thus, all *Fintiv* factors weigh against denial on discretion.

### **III. DISCRETIONARY DENIAL WOULD BE INAPPROPRIATE**

#### **A. HBCU Fails to Establish Settled Expectations**

##### **1. HBCU Asserts Mostly Young Patents in the '127 Patent Family**

In the parallel litigation against Apple, HBCU asserts seven related patents, all in the same family as the '127 Patent. APPLE-1100. All seven patents include the '127 Patent's disclosure and their claims include similar features. *Id.*

Additionally, in recent years, HBCU and the prior patent owner have aggressively pursued continuation filings in the '127 Patent family. *See* EX1109 (continuity data showing 25 continuations in the family, of which 17 have been filed since 2020). Consequently, six of the seven related patents asserted by HBCU in the parallel litigation have only issued in the last 1½ - 5 years.<sup>4</sup> APPLE-1100.

HBCU's claim to settled expectations based on the age of the '127 Patent (issued December 23, 2014) conveniently ignores its concurrent assertion of claims directed to similar subject matter from six other patents in the same family that have not been in force for long (less than six years). Accounting for the asserted family members, HBCU lacks strong settled expectations because a vast majority of the related claims at issue in the family are new. *Samsung Electronics Co., Ltd., v. Wilus Institute of Standards*, IPR2025-00935, Paper 12 at 2-3 (Sept. 26, 2025) (patents issued in 2021 “ha[ve] not been in force for a significant period of time”).

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<sup>4</sup> U.S. Pat. 11,991,601 issued 5/21/2024; U.S. Pat. 11,991,600 issued 5/21/2024; U.S. Pat. 11,653,183 issued 5/16/2023; U.S. Pat. 11,653,182 issued 5/16/2023; U.S. Pat. 11,089,450 issued 8/10/2021; U.S. Pat. 11,012,827 issued 5/18/2021.

Moreover, exercising discretion to deny Apple’s petition on the ’127 Patent based on its age alone risks a highly inefficient result that would separate this challenge from those against HBCU’s younger patents.<sup>5</sup> Indeed, Apple has applied the same base references (Horvath (EX1004) and Tsampalis (EX1005)) in each proceeding, and the claims from each patent contain overlapping features. *Activision Blizzard, Inc. v. Milestone Entertainment, LLC*, IPR2025-00708, Paper 11 at 2-3 (Aug. 14, 2025) (referring petition on 12-year old patent together with petitions on 3-year old patents because “it is an efficient use of Board resources to address the [12-year old patent] as well”); *Padagis* IPR2025-00464, Paper 12 at 3-4 (“efficient use of Board resources to address the related [11-year old] patent as well”).

**2. The German Court’s Invalidation of the Counterpart EP Patent and HBCU’s Delayed Assertion of the ’127 Patent Negate HBCU’s Claims to Settled Expectations**

HBCU criticizes Apple for allegedly “wait[ing] eleven years after issuance, ten years after initiation of the German proceedings, [and] years after discussions with previous patent owner” to bring an IPR challenge. DD Brief, 11. These critiques do not hold up to scrutiny, however. HBCU ignores critical facts that only serve to diminish and refute its claim to settled expectations.

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<sup>5</sup> See IPR2026-00109, IPR2026-00107, IPR2026-00105, IPR2026-00104, IPR2025-01493, IPR2025-01488.

*First*, the '127 Patent was just a year old when the prior patent owner sued Apple based on the counterpart EP patent in Germany. DD Brief, 5. Litigation in Germany continued for years, even as HBCU and its predecessors sat on their rights and withheld assertion of the '127 Patent in the United States. Importantly, during this time, the patent owner filed multiple continuations but struggled to obtain issued patents from these filings. Three straight continuations of the '127 Patent filed between 2014 and 2018 were *abandoned*. See EX1110 (continuity data). The German nullity proceeding then culminated with the Federal Court of Justice finding on December 15, 2020, that the claims of the counterpart EP patent were invalid over Tsampalis PCT. EX2013, 17-28; *supra*, §II.A.2.

Apple's settled expectations that the '127 Patent and its family were invalid accrued both before and after the German nullity action concluded. Considering that the prior patent owner was abandoning applications at the USPTO for years in the timeframe leading up to the court's decision, and that the nullity action ultimately concluded with the original claims of the foreign counterpart being declared invalid, it was reasonable to expect that the '127 Patent lacked valid claims. The Office has repeatedly explained that prior unpatentability findings on related patents weigh against denial. *Padagis*, IPR2025-00464, Paper 12 at 2-3 (prior unpatentability decision on a related patent weighs against discretionary denial); *Nintendo Co., v. Resonant Systems*, IPR2025-00680, Paper 18 at 3 (Aug. 14, 2025).

*Second*, HBCU's assumption the '127 Patent was readily challengeable before HBCU initiated its district court action against Apple in October 2024 ignores the context of HBCU's aggressive continuation practice in the years since the 2020 German court decision. HBCU's voluminous filings have resulted in the issuance of nearly *two dozen* patents in the '127 Patent family, most in just the last 4-5 years after the EP claims were found invalid. *See* EX1109. HBCU's arguments across its discretionary denial briefs assume that Apple is responsible for challenging every one of HBCU's filings, even as HBCU continues to file even more continuations, forcing the parties and the Office to spend inordinate resources examining and re-examining every one of HBCU's applications. That is simply unrealistic.

*Third*, HBCU offers no explanation why alleged discussions between Apple and its predecessor contribute to its settled expectations. DD Brief, 8. It does not. Even under HBCU's telling, Apple informed HBCU's predecessor in 2016 that its products did not infringe. EX1100, ¶106. If Apple was incorrect, the patent owner could have brought suit on the '127 Patent for years. But it did not. HBCU and its predecessor instead continued to file and abandon applications in the United States, even as the nullity action proceeded in Germany and the EP patent claims were found invalid. This does not support strong settled expectations.

*Fifth*, and finally, HBCU's attempt to analogize this case to *iRhythm, Inc. v. Welch Ally, Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025) ("*iRhythm*")

fails. DD Brief, 11-12. In *iRhythm*, the then-Acting Director determined that the patent owner’s “settled expectations favor denial of institution” where the petitioner had cited “the then-pending application that issued as the challenged patent in an Information Disclosure Statement ... in its own patent application.” *iRhythm*, 3. Here, by contrast, the HBCU patents that Apple allegedly cited in IDSes of its own patents do not even include the ’127 Patent. HBCU’s overly broad interpretation of *iRhythm* would inappropriately penalize parties for the mere citation of references in an IDS, frustrating parties’ ability to comply with the duty of disclosure.

**3. Regardless of any Settled Expectations, Denial Would be Inappropriate Due to the Material Errors in Prosecution**

Even if HBCU were credited with settled expectations, those expectations are nullified by other circumstances described herein that weigh strongly in favor of referral—including the material errors that arose during prosecution as described in detail above. *Supra*, § II.A. In *Anthony v. ControlTec, Inc.*, the Office concluded that “challenged patents ... in force for approximately eighteen and seventeen years” did not support discretionary denial because “Petitioner appears to show a material error by the Office.” IPR2025-00559, Paper 12 at 2 (July 16, 2025). Here, the ’127 Patent is just eleven years sold—*i.e.*, more than six years younger than the patents at-issue in *Anthony*, and thus, material error in examination of the ’127 Patent warrants “Office resources to review the [] error.” *Id.*

**B. HBCU’s Claim Construction Allegations are Unfounded**

HBCU asserts without basis that “Apple ignores ... every single one of its claim construction proposals in the Petition” and that “institution would serve only to allow ... Apple to actively contradict itself in claim construction.” DD Brief, 7 (emphasis omitted). Not so. The Petition specifically stated that “[a]ll claim terms should be construed according to the *Phillips* standard,” but observed that “no formal constructions are presently necessary *for purposes of demonstrating obviousness of the Challenged Claims.*” Pet., 5 (emphasis added) (citing *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”)). Although the parties identified several terms for construction in district court, HBCU has identified no inconsistency in Apple’s positions. *See* EX1105; EX1106, EX1107, EX1108. Apple instead respectfully submits that it was unnecessary under *Wellman* to construe these same claim terms in the Petition because the claims would be rendered obvious under any reasonable construction, including Apple’s district court constructions, which were generally offered for different reasons. EX1105, 13 (“While only HBCU ... identified ‘cellular core network’ as a term needing construction, Apple does not oppose construing it to help jurors understand ...”).

**IV. CONCLUSION**

Apple respectfully requests referral and institution of the present Petition.

Respectfully submitted,

Dated: December 9, 2025

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**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on December 9, 2025, a complete and entire copy of this Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and Accompanying Exhibits were provided by email to the Patent Owner by serving the correspondence email address of record as follows:

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