

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner

v.

HBCU MESSAGING US LP,
Patent Owner

IPR2025-01488
U.S. Patent No. 11,653,182

PATENT OWNER'S PRELIMINARY SUR-REPLY

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

TABLE OF AUTHORITIES

Cases

<i>W.L. Gore & Assocs. v. Garlock, Inc.</i> , 842 F.2d 1275 (Fed. Cir. 1988).....	2
--	---

TABLE OF EXHIBITS

Exhibit	Description
2023	January 23, 2026, Markman Hearing Transcript
2024	January 26, 2025, email from Michael Shore to the Court
2025	January 28, 2025, email response from the Court

A. Introduction

Petitioner continues to mischaracterize the record and its own actions with respect to claim construction. Contrary to Petitioner’s statements, its positions here *still* contradict its positions in District Court on at least two claim terms. Indeed, at the recent Markman hearing, even Judge Albright expressed concern about Apple’s inconsistent positions: “Why are you proffering a construction in this case when you did not proffer one at the PTAB?” (Ex. 2023 at 24-25.)

Petitioner now asserts that any problems are mooted by the District Court’s *Markman* ruling. (Reply at 1.) That is false. The District Court recognized that its current “plain and ordinary” ruling for terms relevant here will likely need to be revised later, on a fuller record, because the parties disagree about what that ordinary meaning is. Petitioners know that nothing has been resolved in District Court, and so 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.

B. The District Court’s Constructions of “bearer” and “wherein . . . when” Leave Open Issues that Petitioner Continues to Conceal

The District Court construed two terms relevant here, “bearer” and a series of terms involving the phrase “wherein . . . when.” Petitioner proposed constructions of both these terms at District Court, yet applied no construction here (essentially adopting some “plain and ordinary” meaning in its Petition despite its District Court

proposals). Importantly, while the District Court adopted the “plain and ordinary meaning” *for now*, that does not moot the issue whatsoever.

Instead, both the Court and Parties currently understand that both these terms may require further construction later, because the parties likely dispute what that plain and ordinary meaning is. (*See* Ex. 2024 Email from Shore to Court, “The parties have differing positions on what the plain and ordinary meaning for these four terms should be.”; Ex. 2025 Email from Court, “Judge Albright would like to see more briefing at the summary judgment stage.”)

Inherent in this percolating dispute is the fact that *Petitioner has a specific view of the plain and ordinary meaning of each term*. Yet Petitioner continues to conceal both its view of the plain and ordinary meaning and the more basic fact that these terms are still in dispute. Petitioner cannot now assert that its failures regarding claim construction are mooted when the issues are still live, and even worse when Petitioner retains the flexibility at District Court to assert whatever “ordinary meaning” it wants, while hiding that same position from the Board and Director here.

The use of one construction for purposes of infringement and a different construction for purposes of validity is a fundamental violation of 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) (“having construed the claims one way for determining their validity, it is axiomatic that the claims must be construed in the

same way for infringement”). Yet that is exactly what Petitioner has held open for itself, by retaining an ability to mold the “ordinary” meaning of “bearer” and “wherein . . . when” to its liking in District Court, while ignoring those constraints here.

For these reasons, the Petition should be denied.

Respectfully submitted,

Dated: February 6, 2026

/ Timothy Devlin /
Timothy Devlin, Reg. No. 41,706
DEVLIN LAW FIRM LLC
1526 Gilpin Avenue
Wilmington, DE 19806
Phone: (302) 449-9010
Fax: (302) 353-4251
tdevlin@devlinlawfirm.com

Attorney for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on February 6, 2026, I caused a true and correct copy of **PATENT OWNER'S PRELIMINARY SUR-REPLY** to be served via electronic mail on the following counsel for Petitioner:

LEAD COUNSEL	BACKUP COUNSEL
W. Karl Renner, Reg. No. 41,265 Fish & Richardson P.C. 60 South Sixth St., Suite 3200 Minneapolis, MN 55402 Tel: 202-783-5070 Fax: 877-769-7945 Email: IPR50095-0260IP1@fr.com	David Holt, Reg. No. 65,161 Nicholas Stephens, Reg. No. 74,320 Charlene Thrower, Reg. No. 79,289 Joseph Bauer, Reg. No. 81,218 Fish & Richardson P.C. 60 South Sixth Street Minneapolis, MN 55402 Tel: 202-783-5070 Fax: 877-769-7945 Email: IPR50095-0260IP1@fr.com

/ Timothy Devlin /

Timothy Devlin