

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

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

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**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 attacks on the adequacy of prosecution fail. The Examiner had the same substantive Tsampalis reference, as well as multiple other references that were substantively cumulative with Horvath. (Paper 7 at 3-5.) In fact, it was Petitioner that attempted to disguise Tsampalis's citation in original prosecution by citing a *different* Tsampalis family member here. And while Petitioner points to the Examiner's Notice of Allowance as somehow undermining the entire prosecution, all claims of the '182 patent include features not found within Petitioner's asserted prior art. (*See* POPR, Paper No. 9 at 4, 28-33.0)

For that same reason, Petitioner's substantive arguments on Tsampalis fail. As set out in the POPR, Tsampalis lacks multiple features of all claims of the '182 patent, including multiple instances of sending information "representing the phone number" of recipient phones to a specific server. (*Id.* at 11, 18-24, 28-33.)

**Third**, Petitioner's references to invalidation of the German counterpart make no sense. Materials from the German proceedings were before the Examiner in the original prosecution here, the claims naturally include elements and features different from the EP invalidated (and allowed claims). Petitioner's own chart comparing EP '072 claim 1 and '182 claim 1 (Pet. Op. at 6-7) excludes *entire elements* of '182 claim 1, as if those elements do not matter for patentability. Even within elements cited by Petitioner, important features such as "packet switched" are absent from the German claims. (*Id.* at 6.) It is no surprise the claims here were allowed over Tsampalis and other prior art from the German proceedings.

**Fourth**, 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: inadequacy of Apple's Sotera Stipulation and the overlap in efforts between the District Court litigation and the IPR. For all these additional reasons, discretionary denial should be granted.

Respectfully submitted,

Dated: December 24, 2025

/ Timothy Devlin /  
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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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