

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 IPR2025-01488  
Patent 11,653,182

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**PETITIONER'S SUR-REPLY TO PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL**

**LIST OF EXHIBITS**

APPLE-1001	U.S. Patent No. 11,089,450 (the “450 Patent”)
APPLE-1002	File History of U.S. Patent No. 11,089,450
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 – APPLE-1015	RESERVED
APPLE-1016	U.S. Pub. No. 2005/0037762 to Gurbani et al. (“Gurbani”)
APPLE-1017	U.S. Patent No. 9,167,401 to Helferich (“Helferich”)
APPLE-1018	RESERVED
APPLE-1019	International Pub. No. WO 2006/029331 (“Henderson”)

- APPLE-1020 U.S. Patent No. 7,236,472 (“Lazaridis”)
- APPLE-1021 – APPLE-1024 RESERVED
- APPLE-1025 Qi et al., “Multimedia Messaging Service” (July 2004), *available at* [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) (“Qi”)
- APPLE-1026 – APPLE-1036 RESERVED
- APPLE-1037 T-Mobile webpage, *available at* <https://www.t-mobile.com/home-internet/the-signal/internet-help/the-complete-wifi-history>
- APPLE-1038 – APPLE-1041 RESERVED
- APPLE-1042 U.S. Pub. No. 2008/0153459 (“Kansal”)
- APPLE-1043 RESERVED
- APPLE-1044 U.S. Pub. No. 2007/0030824 (“Ribaudó”)
- APPLE-1045 U.S. Pub. No. 2005/0233737 (“Lin”)
- APPLE-1046 U.S. Pub. No. 2008/0176538 (“Terrill”)
- APPLE-1047 IMS Share Technote, *available at* [https://www.sharetechnote.com/html/Handbook\\_IMS\\_SIP\\_Header\\_Expire.html](https://www.sharetechnote.com/html/Handbook_IMS_SIP_Header_Expire.html)
- APPLE-1048 RFC 3680: A Session Initiation Protocol (SIP) Event Package for Registrations (March 2004)
- APPLE-1049 U.S. Patent No. 7,472,163 (“Ben-Yoseph”)
- APPLE-1050 RFC 2778: A Model for Presence and Instant Messaging (February 2000)
- APPLE-1051 U.S. Pub. No. 2008/0090597 (“Celik”)
- APPLE-1052 U.S. Pub. No. 2006/0168204 (“Appelman”)

- APPLE-1053 RFC 3261: SIP: Session Initiation Protocol (June 2002)
- APPLE-1054 U.S. Pub. No. 2008/0034043 (“Gandhi”)
- APPLE-1055 Subramanya et al., Mobile Communications—An Overview, IEEE Potentials (2005)
- APPLE-1056 RFC 3856: A Presence Event Package for the Session Initiation Protocol (SIP)
- APPLE-1057 – APPLE-1099 RESERVED
- APPLE-1100 Complaint, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Oct. 7, 2024)
- APPLE-1101 HBCU’s Infringement Charts for the ’450 Patent, *HBCU Messaging U.S. LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Oct. 7, 2024)
- APPLE-1102 Declaration of June Ann Munford
- APPLE-1103 Stipulation dated October 31, 2025
- APPLE-1104 MPEP Chapter 900: Prior Art, Classification, and Search (Rev. 08.2017) (January 2018), *available at* <https://www.uspto.gov/web/offices/pac/mpep/old/e9r08-2017/mpep-0900.pdf>
- 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

HBCU's Reply raises issues beyond the scope of authorized briefing, after requesting such briefing without first conferring with Apple. *See* EX3101 (request limited to addressing alleged “mischaracteriz[ation] [of] the analysis addressed by the Examiner”). Still, even if considered, HBCU's arguments are not compelling.

To start, HBCU extends by misrepresenting Office policy in arguing that “Petitioner's material error arguments should have been made within the Petition itself.” PO Reply, 1. In its “Interim Director Discretionary Process Webpage” (available at <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>), the Office addresses this very question by indicating that “[t]he petitioner and the patent owner should **not** present discretionary considerations in the petition or the [POPR], respectively.” *Id.*, §I.C. “A petitioner should raise any discretionary issues in its opposition ..., including issues relating to 35 U.S.C. § 325(d).” *Id.*, §III.A. Apple's briefing rightly adheres to this policy.

Similarly, while HBCU's merits arguments about the teachings of Tsampalis should be the focus of the POPR and not this discretionary denial briefing, they are also demonstratively false. In addressing Limitations [1c] and [1d], the Petition cited to Tsampalis's clear disclosures when explaining that “Tsampalis teaches that an ‘active message’ being composed by a user of the sending mobile phone contains a ‘recipient ID’ received from the user, e.g., a phone number,” and that this recipient ID is sent to a server as part of a request for capabilities information. Pet. 40, 43-

44. In other words, the Petition directly addressed the “multiple instances of sending information ‘representing the phone number’ of recipient phones to a specific server. *See* PO Reply, 2. And, contrary to HBCU’s unfounded accusation, Apple has never argued Tsampalis was not available to the Examiner, nor does HBCU cite any part of the petition supporting its position. PO Reply, 1.

As to the actual issues of discretion, HBCU’s bald allegations are each contrary to the record evidence. *See* PO Reply, 2. HBCU conspicuously fails to cite any evidence in the prosecution history that it provided the Examiner the German court’s decision in the earlier nullity action (EX2013). Pet. Op., 5-6. This failure should be dispositive, as it demonstrates HBCU’s bad faith in prosecuting its U.S. patents. As explained in the Opposition, the ’182 Patent is young and HBCU’s flurry of continuation filings completely undermines its claim to settled expectations, especially where it consistently failed to cite the German court’s decision. *Id.*, 16-17.

Finally, HBCU’s conclusory argument that Apple’s broader-than-*Sotera* stipulation is inadequate fails to point to any filings from or positions taken in the parallel litigation that actually undermine the stipulation’s ability to fully assuage possible concerns of overlap between the proceedings. PO Reply, 2; *see* DD Brief, 16-17. That Apple has set forth invalidity arguments in the parallel litigation is necessary at least until the Director decides to institute, and even then, HBCU points to no invalidity arguments that overlap with the prior art raised in the IPR petitions.

Respectfully submitted,

Dated: December 29, 2025

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**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on December 29, 2025, a complete and entire copy of this Petitioner's Sur-Reply to Patent Owner's Request for Discretionary Denial were provided by email to the Patent Owner by serving the correspondence email address of record as follows:

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