

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

HBCU Messaging US LP,
Patent Owner

Case IPR2025-01488
Patent 11,653,182

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

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APPLE-1001	U.S. Patent No. 11,653,182 (“the ’182 Patent”)
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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”)
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- APPLE-1025 Qi et al., 2004, July. “Multimedia Messaging Service.” Available at https://www.zte.com.cn/global/about/magazine/zte-communications/2004/1/en_68/162264.html (“Qi”)
- APPLE-1026 RFC 3261 – SIP: Session Initiation Protocol. Available at <http://www.faqs.org/rfcs/rfc3261.html>. June 2002.
- APPLE-1027 RESERVED
- APPLE-1028 “How do I sign in to Messenger?” Yahoo! Messenger 6.0. 2004. Available at <https://web.archive.org/web/20040528072514/http://help.yahoo.com/help/us/messenger/win/signin/signin-03.html>
- APPLE-1029 – APPLE-1031 RESERVED
- APPLE-1032 U.S. Pub. No. 2008/0261577 (claiming priority to Provisional App. No. 60/913,187) (“Celik”)
- APPLE-1033 U.S. Provisional App. No. 60/913,187
- APPLE-1034 – APPLE-1035 RESERVED
- APPLE-1036 International Pub. No. WO 2007/052264 (“Agiv”)
- APPLE-1037 T-Mobile webpage <https://www.t-mobile.com/home-internet/the-signal/internet-help/the-complete-wifi-history>
- APPLE-1038 – APPLE1041 RESERVED
- APPLE-1042 U.S. Pub. No. US 2008/0153459 (“Kansal”)
- APPLE-1043 RFC 2778 – A Model for Presence and Instant Messaging. Available at <https://datatracker.ietf.org/doc/html/rfc2778>. February 2000.
- APPLE-1044 RFC 3856 – A Presence Event Package for the Session Initiation Protocol (SIP). Available at <https://datatracker.ietf.org/doc/html/rfc3856>. August 2004.
- APPLE-1045 Trillian Pro v1.0 webpage (“Trillian”)
- APPLE-1046 U.S. Pub. No. 2007/0054627 (“Wormald”)

APPLE-1047 U.S. Pub. No. 2008/0120427 (“Ramanathan”)
APPLE-1048 U.S. Pub. No. 2002/0062345 (“Guedalia”)
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APPLE-1104 Stipulation dated October 31, 2025
APPLE-1105 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-1106 Apple’s Opening Claim Construction Brief, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Sept. 22, 2025)
APPLE-1107 HBCU’s Opening Claim Construction Brief, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Sept. 22, 2025)
APPLE-1108 Apple’s Responsive Claim Construction Brief, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Oct. 24, 2025)

- APPLE-1109 HBCU's Responsive Claim Construction Brief, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Oct. 24, 2025)
- APPLE-1110 Continuity Data for U.S. Application Serial No. 12/452,883
- APPLE-1111 Continuity Data for U.S. Application Serial No. 16/714,113
- APPLE-1112 – APPLE-1114 RESERVED
- APPLE-1115 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-1116 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. 11,653,182 ("the '182 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 '182 Patent. The application for the '182 Patent received limited scrutiny during prosecution, having been allowed as a result of limitations not recited in *three* of the four challenged independent claims and without any prior art rejections. The Examiner also overlooked highly relevant teachings from the same prior art reference (Tsampalis PCT) that a German court used to find similar claims of a counterpart EP patent invalid. The Applicant then withheld the German court's decision from the Examiner during prosecution.

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.

The '182 Patent also has not been in force for long, having issued just over

two years before Apple filed its Petition. HBCU thus lacks strong settled expectations. HBCU's attempts to conjure settled expectations based on a prior German litigation also fail. The '182 Patent did not issue until years later, and only after the counterpart EP patent claims in Germany were invalidated.

HBCU attempts to distract from these facts that strongly support institution. HBCU's brief instead mischaracterizes the German nullity action and erroneously contends that Apple could have been challenged the '182 Patent prior to issuance. The Director should reject these arguments and deny HBCU's request.

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

A. The '182 Patent is the Product of Material Examination Errors

The '182 Patent stands in a long line of continuations. But the substantive examination of the particular claims of the '182 Patent was limited. The Examiner issued no prior art rejections against any claim before allowance. More troubling is the Examiner's reasons for allowance include limitations not recited in *three* of the four issued independent claims. *See* EX1002, 13-20. The '182 Patent was effectively rubber stamped to issuance. *See* EX1002, 13-20, 94-102.

Further, as noted above, the Examiner overlooked highly relevant teachings from Tsampalis PCT (EX2009)—an equivalent publication of the Tsampalis (EX1005) prior art applied in the Petition—that Germany's highest civil court (the

Federal Court of Justice) applied to invalidate similar claims of counterpart EP Patent 2 177 072. More, the Applicant never cited the German court's invalidation decision ("FCJ Decision," EX2013) to the Examiner, thus depriving the Examiner of material information about Tsampalis PCT. As detailed further below, these events led to an undeserving and erroneous allowance that merit further review and correction by the Office 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 Erroneously Allowed the '182 Patent Even Though Three of the Four Independent Claims Lacked the Limitations that the Examiner Identified as the Basis for Allowance

Office guidelines require examiners to "conduct a thorough search of the prior art." EX1106 (MPEP Chapter 900, Rev. 08.2017, Jan. 2018), 41; *see also id.*, 45 ("comprehensive search"); 37 C.F.R. § 1.104 ("the examiner shall ... make a thorough investigation of the available prior art"). An examiner's duty to thoroughly search the art is not optional, but "must" be performed. *Id.* It requires that the examiner "obtain a thorough understanding of the invention," carefully noting "what the claims do not call for, as well as what they do require." EX1105, 47. Here, the Examiner's reasons for allowance make clear that his consideration of what the claims do and do not call for was clearly deficient.

Where the examiner during original prosecution identifies reasons for allowance not actually recited in the Challenged Claims, there exists material error. *See Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9, (PTAB Jul. 31, 2025) (“*Skullcandy*”); *Activision Blizzard, Inc. v. Milestone Entertainment, LLC*, IPR2025-00708, Paper 11, (PTAB Aug. 14, 2025). For example, in *Skullcandy*, the “patent examiner identified a ‘wherein’ clause listing various structural features of an earbud housing as the reason for allowance of the challenged claims.” *Skullcandy*, 2. “The challenged claims (claims 20 and 21), however, do not recite those features.” *Id.* As a result of this fact alone, the “Decision Referring the Petition to the Board” found a material error. *Id.*

The Examiner of the application leading to the ’182 Patent made the same material error. Specifically, the Notice of Allowance concluded that:

the prior art fails to teach the claimed limitation...wherein at the time the packet switched message is sent, the second receiving mobile phone is not connected to the at least one server, wherein the packet switched message is queued until the second receiving mobile phone connects to the at least one server.... Therefore, the prior art of record either singularly or in combination fails to teach the above claimed limitations for claim 1, 17, 22 and 25 is therefore the reason for allowance.

EX1002, 18-19. However, challenged independent claims 17, 22, and 25 do not recite these limitations. *See* EX1001, 14:23-57, 15:18-59, 15:66-16:46. For the

same reasons that were present in *Skullcandy*, “it is an appropriate use of Board resources to review the potential error.” *Skullcandy*, 2.

2. The Examiner Overlooked Relevant Teachings from the Tsampalis PCT Prior Art That Germany’s Highest Court Previously Applied to Invalidate Similar Claims of a Counterpart EP Patent

The Examiner committed an additional error during prosecution of the ’182 Patent in overlooking highly relevant teachings from WO 2004/061583 (“Tsampalis PCT”, EX2009). HBCU does not dispute that Tsampalis PCT was before the Examiner during prosecution. DD Brief, 3; EX2008. The Applicant in fact cited Tsampalis PCT in an IDS that the Examiner initialed on December 16, 2022. EX1002, 134-35. Beyond initialing the IDS, however, the file history is conspicuously absent of any further treatment of Tsampalis PCT, either by the Examiner or the Applicant. Indeed, the Examiner mailed just a single Office Action during prosecution of the ’182 Patent, and that Office Action includes no mention of Tsampalis PCT at all. EX1002, 94-102. The Notice of Allowance is similarly silent, lacking any reasons for allowance. EX1002, 13-19.

The Examiner’s decision to allow the ’182 Patent over Tsampalis PCT, either on its own or in combination with additional references, was material error because Tsampalis PCT teaches the purportedly core technology at issue in the Challenged Claims. This is evident from the judgment of an independent tribunal that previously relied on Tsampalis’s teachings to invalidate claims similar to those of

the '182 Patent. Specifically, on December 15, 2020, the German Federal Court of Justice issued a decision in a nullity action holding all original claims of a European counterpart of the '182 Patent (EP 2 177 072) invalid over Tsampalis PCT. EX2013, 21 (“The subject-matter of claim 1 was suggested to the skilled person on the basis of K5 [Tsampalis PCT]”); DD Brief, 3 (“substantively identical”).

While not identical, the EP claims invalidated by Tsampalis PCT and the claims of the '182 Patent contain substantial overlap. The following table highlights overlap between similar limitations of claim 1 of each patent, for example:

EP 2 177 072 Invalidated Claim 1 ¹	'182 Patent Claim 1 Limitations
A method for providing a messaging service on a sender's mobile wireless device in a wireless communications network ; the method comprising:	[1a] a sending mobile phone that transmits short message service (SMS) messages via a cellular network and packet switched messages via a packet switched message service (PSMS)
the sender's mobile wireless device verifying whether the destination address is capable of receiving the outgoing message via a packet-switched bearer,	[1e] the at least one server, in response to receipt of the first information, sends a first response to the sending mobile phone when the phone number of the first receiving mobile phone is not identified as a subscriber of the PSMS; [1i] the at least one server, in response to receipt of the second information

¹ Based on English Translation from Patent Owner’s Exhibit 2013. Apple also submits a certified English Translation of the FCJ Decision as Exhibit 1116.

	<p>and conditioned on the phone number of the second receiving mobile phone being identified as a subscriber of the PSMS and the second receiving mobile phone having an active status with the PSMS, sends a second response to the sending mobile phone</p>
<p>wherein the step of verifying the destination address involves sending an address verification request to the message server; wherein the verification request is sent to the message server (170) via base station (180) and the Internet (160) using a WPAN or WLAN;</p>	<p>[1d] the sending mobile phone sends first information representing the phone number of the first receiving mobile phone to the at least one server;</p> <p>[1h] the sending mobile phone sends second information representing the phone number of the second receiving mobile phone to the at least one server;</p>
<p>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, 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.</p>	<p>[1f] after the first response is received by the sending mobile phone, the sending mobile phone sends the first message as an SMS message to the first receiving mobile phone;</p> <p>[1j1] after the second response is received by the sending mobile phone, the sending mobile phone sends the second message as a packet switched message, via a wireless local area network (WLAN) and the PSMS, to the second receiving mobile phone,</p>

EX1001, 12:21-13:7; 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., 38-48; EX1003, ¶¶79-95

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 in any independent claim of the ’182 Patent, and it therefore does nothing to support the Examiner’s decision to allow the ’182 Patent over Tsampalis PCT. Specifically, the EP claims were amended to include a limitation that required “check[ing] whether the destination message queue length has not exceeded a predetermined maximum length.” EX2013, 27-29. The independent claims of the ’182 Patent are not limited to require this or any similar feature. *See* EX1001, 12:21-13:7. Whether Tsampalis or any other reference discloses the feature is therefore irrelevant to patentability of a vast majority of claims of the ’182 Patent. In short, the Examiner’s failure to recognize Tsampalis’s teachings of a sending mobile device that, like claim 1 of the ’182 Patent, sends a request and receives a response to determine whether the intended recipient of a message is a subscriber of packet-switched messaging service was clear error.

Notably, *it was the Applicant’s own failure to cite the FCJ Decision that likely contributed to the Examiner’s oversight of Tsampalis PCT.* The FCJ Decision was released on December 15, 2020, *i.e.*, more than two years before the ’182

Patent was allowed on March 29, 2023. EX2013; EX1002, 13. Despite ample opportunity, the Applicant never brought the FCJ Decision to the Examiner's attention during prosecution. *See* EX1001, Cover; EX1002, 25-27, 133-136. The Examiner thus allowed the application for the '182 Patent over the cited art of record, including Tsampalis PCT, with no evidenced knowledge of the German court's finding that similar claims of the EP counterpart patent were obvious over Tsampalis PCT. The failure to cite the FCJ Decision also raises questions about the Applicant's compliance with its duty of disclosure under 37 C.F.R. § 1.56.

HBCU attempts to distract from the failure to cite the FCJ Decision by asserting that “the previous patent owner submitted all that art [from the German nullity proceeding]—as well as Apple's argumentative submissions summarizing the art—to the USPTO in further ongoing prosecution of the '182 Patent *family*.” DD Brief, 5 (emphasis added). But whether additional documents were later cited in *family* members of the '182 Patent does not cure the material error that occurred during prosecution of the '182 Patent itself. Likewise, HBCU's citation of Exhibit 2014—*i.e.*, Apple's letter initiating the German nullity proceeding—to support its assertion that “all patents issued in the family since that time—including the '182 Patent at issue—were allowed over the Tsampalis PCT, as well as ... arguments submitted by Apple in Germany” is misleading. DD Brief, 6. Exhibit 2014, which

includes arguments based on Tsampalis PCT, was *never cited* to the Examiner during prosecution of the '182 Patent. Only four documents from the German litigation were cited to the Examiner of the '182 Patent, all of which were dated years before the FCJ Decision. EX1002, 134-135. None included Exhibit 2014.

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 '182 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.

EX1104. 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 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). And as noted above with respect to Factor 2, a final written decision will issue four months *before* the scheduled trial date, which “reduc[es] the concern of...significant duplication of efforts resulting from two proceedings operating in parallel.” *Intel*, Paper 14 at 2.

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. EX1115. 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. 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 as here (Factor 5), this factor alone does not favor denial, particularly where the Petition demonstrates strong merits of unpatentability. Factor 5 is *neutral*.

Factor 6 (Merits and Other Considerations)—As set forth in the Petition, the ’182 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 ’182 Patent without conducting an adequate search or even recognizing the pertinence of the prior art of record during examination—including Tsampalis PCT—that the German court had already found rendered similar claims of the counterpart EP patent obvious. *Supra*, §II.A.

Because the Petition presents a strong, clear, and concise path to unpatentability, institution serves the interests of judicial economy by efficiently disposing of invalid claims at the USPTO, rather than consuming the substantial resources of a district court jury trial. 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. The '182 Patent is Young, Having Issued Just Four Years Before Apple's Petition

HBCU fails to show that it has settled expectations in the '182 Patent. It does not. The '182 Patent issued in May 2023, just over two years before Apple's Petition was filed in August 2025. HBCU presumptively lacks strong settled expectations on a young patent like the '182. *Samsung Electronics Co., Ltd., v. Wilus Institute of Standards*, IPR2025-00935, Paper 12 at 2-3 (Sept. 26, 2025) (finding that patent issued in 2021 “has not been in force for a significant period of time” and thus “Patent Owner has not developed strong settled expectations that favor discretionary denial”).

2. The German Court's Invalidation of the EP Counterpart Patent and Related Circumstances Underscore HBCU's Lack of 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 against the '182 Patent. DD Brief, 11. These arguments are but a misleading attempt to evade review of a young patent that HBCU only recently acquired. Indeed, HBCU's narratives do not withstand scrutiny for the reasons addressed below.

First, Apple did not (and could not have) “waited eleven years after issuance” to file this IPR. Again, the ’182 Patent issued in May 2023—just two years before Apple filed its Petition in this IPR. EX1001, Cover. HBCU thus has its facts wrong. Likewise, Apple could not have delayed “ten years after initiation of the German proceedings” in 2015 because the ’182 Patent did not exist at that time. It would not issue for another eight years.

Second, the ’182 Patent issued two-and-a-half years *after* the German court found similar claims of the counterpart EP patent invalid over Tsampalis PCT on December 15, 2020. EX2013; *supra*, §II.A.2. HBCU’s brief never explains why it should be credited with settled expectations on a patent that was granted with similar claims to those of a patent in the same family that were already declared finally invalid after thorough consideration of the patent and prior art by an independent tribunal. It should not.

Following the German FCJ Decision, it was reasonable for Apple and the public to expect that the ’182 Patent was similarly issued with invalid claims that did not present a legitimate monopoly of the claimed subject matter. The Applicant’s failure to cite the FCJ Decision to the Examiner underscores that the Examiner’s evaluation of the claims and prior art was incomplete. *Supra*, §II.A. The Office has repeatedly explained that prior invalidity findings on similar claims of related patents weigh against denial. *Padagis*, IPR2025-00464, Paper 12 at 2-3

(determining that prior invalidity decision on a related patent weighs against discretionary denial); *Nintendo Co., LTD et al., v. Resonant Systems*, IPR2025-00680, Paper 18 at 3 (PTAB August 14, 2025) (same).

Third, HBCU's assumption that the '182 Patent was readily challengeable before HBCU initiated its district court action against Apple in October 2024 ignores the context of HBCU's (and the prior patent owner'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 '182 Patent family. *See* EX1110 (continuity data for ancestor of the '182 Patent).

HBCU's arguments across its discretionary denial briefs assume that Apple should be responsible for chasing every continuation that HBCU files and the Examiner rubber stamps, 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 not realistic or practical, especially where HBCU offers no reason why the '182 Patent would have warranted any special attention amongst the web of continuation filings.

To the extent there has been any gamesmanship at all, it has been at the hands of HBCU, not Apple. Indeed, the '182 Patent is the thirteenth continuation in the family, but only the tenth patent to issue. EX1111 (continuity data). HBCU

or the prior patent owner inexplicably filed and voluntarily *abandoned* three consecutive applications in the priority chain before ultimately resuming prosecution of parent U.S. Appl. No. 16/897,161, thereby delaying prosecution of the '182 Patent family by nearly *five years* from the time the prior patent issued in 2014. *Id.* Apple could not have speculated what HBCU's prosecution strategy was in this context. HBCU has only more recently aggressively pursued continuation filings to issuance. *Id.*

Fourth, HBCU's and the prior patent owner's delayed assertion of the '182 Patent family in the United States for years during its infringement action against Apple in Germany (starting in 2015) and for years after the counterpart EP patent was found invalid (2020-2024) further negates HBCU's claims to settled expectations. HBCU already had issued patents in the family in the United States before the German litigation commenced in 2015. But HBCU sat on these patents for years as the parties litigated in Germany, and longer still after the FCJ Decision found the EP patent claims invalid. Apple's settled expectations that the '182 Patent family was invalid accrued during this time. HBCU then elected to bring a serial litigation against Apple years later (October 2024) where it finally asserted patents like U.S. Patent 9,918,127 (issued December 2014) that presumably could have been brought years earlier. EX1100. HBCU should not be rewarded for its haphazard, serial litigation campaign.

Fifth, HBCU’s allegation that Apple had discussed “the patents in suit in the parallel District Court litigation, including the ’182 patent” with the previous patent owner back in 2016 is false. DD Brief, 8. The ’182 Patent did not issue until May 2023, so there could not have been any discussion about the ’182 patent seven years earlier. HBCU cites no evidence that Apple was aware of the ’182 Patent before September 2024 when HBCU purportedly “sent a letter to Apple specifically identifying the ’182 patent and other U.S. patents in the same family.” *Id.* The letter was sent just one month before HBCU filed its district court complaint in the U.S. District Court for the Western District of Texas. *See* EX1100.

Sixth, and finally, HBCU’s attempt to analogize the present facts to those of *iRhythm, Inc. v. Welch Ally, Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025) (“*iRhythm*”) fails. DD Brief, 11-12. In *iRhythm*, then-Acting Director Stewart determined that the patent owner’s “settled expectations favor denial of institution” where the petitioner had cited in 2013 “the then-pending application that issued as the challenged patent in an Information Disclosure Statement ... in its own patent application.” *iRhythm*, 3. *iRhythm* thus involved a 13-year old patent of which the petitioner was aware for at least 12 years before filing its IPR petition. Here, by contrast, the ’182 patent is young (just over 2.5 years old). And HBCU presents no evidence that Apple was aware of the ’182 patent before September 2024. The HBCU patents that Apple allegedly cited in IDSes of its own patents are family

members (not the '182 Patent) that Apple could not possibly have cited before 2021, when the earliest of Apple's patents were filed. Besides, HBCU's position would effectively penalize parties for the mere citation of references in an IDS. This is an untenable policy position that would not serve the principles underlying the Office's duty of disclosure to which all applicants for patents are subject.

B. HBCU's Allegations of Inconsistent Claim Construction Positions 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") (internal quotations omitted)). Although the parties identified several terms for construction in the district court litigation, HBCU has identified no inconsistency between Apple's analysis in the IPRs and its claim construction positions in district court. See EX1106; EX1107, EX1108, EX1109. Apple instead respectfully submits that it was unnecessary under *Wellman* to formally construe these same claim terms in

the Petition because the claims would be rendered obvious by the Petition grounds under any reasonable constructions, including Apple's district court constructions, which were generally offered for different reasons. EX1106, 13 ("While only HBCU Messaging identified 'cellular core network' as a term needing construction, Apple does not oppose construing it to help jurors understand its meaning.").

IV. CONCLUSION

Petitioner respectfully requests that the Director proceed to consider the Petition on the merits.

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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