

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

HBCU Messaging US LP,
Patent Owner

Case IPR2025-01493
Patent 11,089,450

**PETITIONER'S REQUEST FOR DIRECTOR REVIEW OF
THE DECISION DENYING INSTITUTION**

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 (“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
- 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
- APPLE-1111 – APPLE-1113 RESERVED
- 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)
- APPLE-1116 Claim Construction Order, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Jan. 28, 2026)

TABLE OF CONTENTS

I. INTRODUCTION1

II. STATEMENT OF FACTS2

 A. The Present Petition is One of Seven Apple Filed on Seven Related HBCU Patents2

 B. The Discretionary Factors Strongly Favor Referral, as Indicated by the Director’s Initial Referral Decision.....3

 C. The Director Later Reversed the Initial Referral and Discretionarily Denied the Present Petition for Efficiency Due to its Relationship with a Pair of Other Petitions Denied Under *Revvo*.....4

 D. The Director Recently Referred Apple’s Four Other Related Petitions and Apple filed Requests for Director Review of the First Two Related Petitions Denied Under *Revvo*6

III. ARGUMENT6

 A. The Decision Discretionarily Denying the Present Petition was Premature and Based on an Erroneous Finding that Board Review of the Present Petition Would Necessarily Yield Inefficiencies with the District Court Proceeding.....6

IV. CONCLUSION.....7

I. INTRODUCTION

Petitioner (Apple Inc. or “Apple”) requests Director Review of the February 18, 2026 Decision discretionarily denying institution of the present proceeding (IPR2025-01493). *See* Paper 15.

The Decision denying institution in this case was not the result of any defect in the Petition or any discretionary factors that would have compelled denial of this case alone. On the contrary, the discretionary factors strongly favored referral, as indicated by the Director’s initial decision to refer the Petition. *See* Paper 12. The denial in this case instead followed the Director’s decision denying’s Apple’s petitions on a pair of related patents under *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (Squires November 3, 2025) (precedential). Specifically, the Director concluded that “[i]t is not an efficient use of Office resources to maintain [this] proceeding at the Board in view of the discretionary denials of IPR2025-01486 and IPR2025-01488, because intrinsically similar issues, where the involved patents are in the same family, will be addressed by the district court.” *Id.*

As this Request demonstrates, however, the Director’s finding that “intrinsically similar issues ... will be addressed by the district court” was premature. Indeed, the Decision cited just two of Apple’s six other petitions on HBCU’s related patents, but four other of Apple’s petitions have since been referred. *See* Paper 15

of IPR2026-00104, -00105, -00107, and -00109. The Director has thus determined that *five* of Apple's seven petitions on HBCU's related patents do not warrant discretionary denial under *Revvo*. Apple has also filed requests for Director Review of the denials in IPR2025-01486 and -01488. Considering the relationship of the patents and overlapping prior art applied across the petitions, Board review of the present Petition presents the most efficient path for resolving patentability of the patent challenged in this proceeding (*i.e.*, U.S. Patent No. 11,089,450 ("the '450 Patent")). *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, 3-4 (PTAB Jul. 16, 2025) ("[I]t is an efficient use of Board resources to address [] related patent[s].").

For each of the reasons addressed herein, Apple's Request for Director Review should be granted, the Decision denying institution should be vacated, and the Petition should be re-referred for consideration on the merits and instituted.

II. STATEMENT OF FACTS

A. The Present Petition is One of Seven Apple Filed on Seven Related HBCU Patents

The '450 Patent is one of seven petitions Apple filed on related patents in the same family that HBCU asserts against Apple in *HBCU Messaging U.S. LP v. Apple, Inc. et al.*, 1-24-cv-01199 (W.D. Tex.). *See* APPLE-1100. Beyond the present Petition, Apple filed petitions on related patents in IPR2026-00104, -00105, -00107, and -00109 and IPR2025-01486 and -01488. All seven petitions apply overlapping

prior art, including the Horvath (APPLE-1004) and Tsampalis (APPLE-1005) references, against at least partially overlapping subject matter.

Importantly, this Petition, like the four that were just referred, suffers no on-going claim construction issues. Indeed, the claim construction order in the parallel proceeding does not construe any terms in this patent, and neither party proposed any term of the '450 Patent for construction in the litigation. *See* APPLE-1116 (claim construction order construing no terms of the '450 Patent); *see also* APPLE-1105 through -1108 (*Markman* briefing addressing no terms of the '450 Patent). Thus, although the Decision acknowledged the relation of this Petition to petitions filed in IPR2025-01486 and -01488 (*see* Paper 15, 1 n.2), this Petition more closely mirrors those in the -00104, -00105, -00107, and -00109 proceedings.

B. The Discretionary Factors Strongly Favor Referral, as Indicated by the Director's Initial Referral Decision

Apple's Opposition to HBCU's Discretionary Denial Brief presented a compelling case for referral. *See* Paper 8. Among other things, the Opposition detailed material examination errors stemming from the applicant's failure to cite a nullity decision from the German Federal Court of Justice invalidating similar claims of a counterpart European patent. *Id.*, 2-10. The Opposition further explained that, if instituted, the Board's final written decision would be expected months before trial in the parallel litigation. *Id.*, 11-15. The challenged patent also is young (~4 years

old at the time the Petition was filed). and this young age together with the German court's earlier invalidity determination confirm that HBCU lacks settled expectations in the patent. *Id.*, 15-20. These facts, along with others addressed in the parties' discretionary denial briefing, culminated in a decision from the Director on January 9, 2026 referring the Petition for merits review. *See* Paper 12.

C. The Director Later Reversed the Initial Referral and Discretionarily Denied the Present Petition for Efficiency Due to its Relationship with a Pair of Other Petitions Denied Under *Revvo*

Despite a strong case for referral, HBCU's gamesmanship led the Director to prematurely reverse the initial referral decision. Even after raising vague allegations of inconsistent claim construction positions in its discretionary denial brief, HBCU continued to press for discretionary denial under *Revvo* in its POPRs both in this proceeding and the two related proceedings that were aligned in schedule (*i.e.*, IPR2025-01486 and -01488). *See* Paper 9 (IPR2025-01486), 23-24; Paper 9 (IPR2025-01488), 27-28; Paper 9 (IPR2025-01493), 25-26. HBCU's arguments were not only baseless but also improper, as the rules are clear that discretionary arguments are not to be made in the POPR. *See* Interim Director Discretionary Process Webpage¹ ("The petitioner and the patent owner ***should not*** present discretionary considerations in the petition or the Patent Owner Preliminary Response (POPR),

¹ <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>

respectively.”) (emphasis added).

HBCU’s belated *Revvo* arguments inspired additional briefing from both parties on the issue, but those arguments were misleading. For instance, HBCU baldly asserted that the assertion in the Petition that “no claim term requires construction ... conflicts[] ... with Petitioner’s contention in the parallel district court litigation, in which Petitioner identified multiple terms[] ... that it asserts require construction.” POPR, 25. In fact, however, neither party proposed any claim term for construction from the ’450 Patent and the Court construed no claims from the ’450 Patent in its *Markman Order*. See APPLE-1105, -1106, -1107, -1108, -1116. HBCU’s assertion was simply false.

HBCU’s misleading arguments in both this proceeding and in IPR2025-01486 and -01488 led the Director to deny the first three of Apple’s petitions on HBCU’s related patents in an Order dated February 18, 2026. Paper 15, n. 1. Specifically, as noted above, the Director faulted just two of Apple’s petitions under *Revvo*, but found no claim construction issues in either the present Petition or Apple’s four other recently referred petitions. The Director nonetheless determined that “it is not an efficient use of Office resources to maintain [this] proceeding at the Board in view of the discretionary denials of IPR2025-01486 and IPR2025-01488, because intrinsically similar issues, where the involved patents are in the same family, will be addressed by the district court.” *Id.*, n. 2.

D. The Director Recently Referred Apple’s Four Other Related Petitions and Apple filed Requests for Director Review of the First Two Related Petitions Denied Under *Revvo*

Following the Director’s decision to discretionarily deny IPR2025-01486, -01488, and -01493, Apple filed requests for Director Review on March 10, 2026 addressing HBCU’s misleading arguments and explaining why *Revvo* should not have applied in the -01486 and -01488 proceedings. The parties also submitted additional briefing on *Revvo* in IPR2026-00104, -00105, -00107, and -00109. With this briefing in hand, the Director issued a decision referring Apple’s latter four petitions on HBCU’s related patents. *See* Paper 15 of IPR2026-00104, -00105, -00107, and -00109.

III. ARGUMENT

A. The Decision Discretionarily Denying the Present Petition was Premature and Based on an Erroneous Finding that Board Review of the Present Petition Would Necessarily Yield Inefficiencies with the District Court Proceeding

The Director’s determination that “it is not an efficient use of Office resources to maintain [this] proceeding at the Board” was premature. Paper 15, n. 2. Indeed, the Decision cited the denials of IPR2025-01486 and -01488, but the Decision was made before the Director had the opportunity to consider Apple’s other petitions on HBCU’s related patents in IPR2026-00104, -00105, -00107, and -00109. These latter four petitions have since been referred.

Because at least five of Apple's seven petitions do not implicate claim construction issues under *Revvo*, and the Director has recently referred four of the petitions, the reasoning underlying denial of the present Petition no longer applies. The Board will review Apple's petitions on related patents if the petitions pass merits review, leaving the Board as the most efficient forum to review overlapping issues in the present proceeding. *See Padagis*, IPR2025-00464, Paper 12, at 3-4 (“[I]t is an efficient use of Board resources to address [] related patent[s].”). The Director likewise has the opportunity to refer and institute the two other denied proceedings in IPR2025-01486 and -01488 if Apple's requests for Director Review are granted. If the Director institutes any of Apple's petitions on HBCU's related patents, referral and institution of the present Petition on the '450 Patent would likewise be appropriate here.

IV. CONCLUSION

Apple respectfully requests that the request for Director Review be granted, that the Director's decision denying institution be vacated, and the Petition be referred and instituted on the merits.

Respectfully submitted,

Dated: March 20, 2026

/W. Karl Renner/

W. Karl Renner, Reg. No. 41,265

David Holt, Reg. No. 65,161

Nicholas Stephens, Reg. No. 74,320

Fish & Richardson P.C.

60 South Sixth Street

Minneapolis, MN 55402

T: 202-783-5070

F: 877-769-7945

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on March 20, 2026, a complete and entire copy of this Petitioner's Request for Director Review of the Decision Denying Institution was provided by email to the Patent Owner by serving the correspondence email address of record as follows:

Timothy Devlin, Reg. No. 41,706
Neil Benchell (*pro hac vice* forthcoming)
DEVLIN LAW FIRM LLC
1526 Gilpin Avenue
Wilmington, DE 19806
Phone: (302) 449-9010
Fax: (302) 353-4251
tdevlin@devlinlawfirm.com
nbenchell@devlinlawfirm.com
dflitparas@devlinlawfirm.com

/Crena Pacheco/

Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
pacheco@fr.com