

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

## TABLE OF CONTENTS

I.	Introduction.....	1
II.	Multiple Compelling Reasons Support Merits Review and Institution of Apple’s IPR Petition.....	2
	A. The ’450 Patent is the Product of Material Examination Errors.....	2
	1. The Examiner’s Flawed Search Strategy Focused on Subject Matter Not Required, and Even Excluded, from the Scope of the Challenged Claims .....	3
	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.....	6
	B. Institution Will Narrow the Parallel Litigation and Promote Efficient Use of Resources .....	11
	1. The Board Will Reach a Final Decision Before the District Court Trial.....	11
	2. Apple’s Broad <i>Sotera+</i> Stipulation Will Eliminate Wasteful, Duplicative Efforts.....	12
	3. Holistic Consideration of the <i>Fintiv</i> Factors Favors Referral...	13
III.	Discretionary Denial Would be Inappropriate .....	15
	A. HBCU Fails to Establish Settled Expectations .....	15
	1. The ’450 Patent is Young, Having Issued Just Four Years Before Apple’s Petition.....	15
	2. The German Court’s Invalidation of the EP Counterpart Patent and Related Circumstances Underscore HBCU’s Lack of Settled Expectations.....	15
	B. HBCU’s Allegations of Inconsistent Claim Construction Positions are Unfounded .....	20

IV. Conclusion .....20

**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
- 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)

## 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. 11,089,450 ("the '450 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 '450 Patent. The application for the '450 Patent received limited scrutiny during prosecution, having been allowed without any prior art rejections following a deficient search. Significantly, the Examiner also overlooked highly relevant teachings from the same prior art reference (Tsampalis PCT) that a German court used to find substantially similar claims of a counterpart EP patent invalid. The Applicant then withheld the German court's decision from the Examiner, electing never to cite it in an IDS before allowance.

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 '450 Patent also has not been in force for long, having issued just four 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 '450 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, erroneously contends that Apple could have been challenged the '450 Patent prior to issuance, and baselessly alleges inconsistent claim construction positions when no terms were construed. 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 '450 Patent is the Product of Material Examination Errors**

The '450 Patent stands in a long line of continuations. But as noted in the Petition, substantive examination of the particular claims of the '450 Patent was limited. Pet., 5. The Examiner issued no prior art rejections against any claim before allowance. Nor did the Examiner offer any reasons for allowance. The '450 Patent was effectively rubber stamped to issuance. *See* EX1002, 8-12, 45-49.

More, a review of the file history reveals significant errors resulting from the Examiner's cursory approach. The file history's search notes demonstrate that the Examiner conducted a woefully inadequate search based on irrelevant search queries that never would have located pertinent references like Horvath (EX1004) and

Chatterjee (EX1007). 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. Even more troubling, 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) (reference is warranted where “Petitioner appears to show a material error by the Office”).

**1. The Examiner’s Flawed Search Strategy Focused on Subject Matter Not Required, and Even Excluded, from the Scope of the Challenged Claims**

Office guidelines require examiners to “conduct a thorough search of the prior art.” EX1104 (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.” EX1104, 47.

Here, the Examiner’s search during prosecution of the ’450 Patent fell well short of Office standards. The Examiner issued few search queries at all. Among these few queries, the Examiner relied on keywords that targeted concepts not required, and even *excluded*, by the claims. At the same time, the Examiner omitted keywords relevant to key concepts specifically *encompassed* by the claims. The search was thus doomed to fail from the outset.

To this point, the Examiner formulated just *five* unique keyword queries over the course of prosecution of the ’450 Patent as shown below:

Query L17	Query L31	Query L36	Query L37	Query L47
(message and client and address and packet and switched and WLAN and SMS).clm.	(message AND client AND address AND packet AND switched AND WLAN AND SMS).clm.	(short near2 message near2 service near2 center SMSC) SAME (short near2 message near2 service SMS) SAME (wireless near2 local near2 area near2 network wlan) SAME (subscribers device user) SAME (list\$3 database table)	(short near2 message near2 service near2 center SMSC) SAME (short near2 message near2 service SMS) SAME (wireless near2 local near2 area near2 network wlan)	(message AND client AND address AND packet AND MMS AND WLAN AND SMS AND EMS AND format).clm.

EX1002, 18, 56-57; *generally id.*, 13-18, 52-57.

Each query is facially problematic. Queries L17 and L31, for example, each require a “client,” but (unlike the claims of certain family members), the claims of the ’450 Patent neither recite nor require a “client.” EX1001, 11:57-12:20. Every one of the queries likewise requires a “WLAN” or “wLAN,” but only a few dependent claims refer to a “WLAN” at all. These queries would not have returned a host of pertinent references like Horvath (EX1004) that are highly relevant to all claims of the ’450 Patent simply because the references do not use the term

“WLAN,” even as WLAN is not required by the claims<sup>1</sup>

Compounding these problems, query L47 requires the terms “MMS” and “EMS,” but the MMS and EMS message formats are specifically *excluded* from the scope of claims of the ’450 Patent. While claim element [1f] does refer to MMS and EMS formats, it does so in the context of a *negative* limitation that defines not what the “message format” is, but instead what the message format “is not.” See EX1001, 12:15-18 (“wherein the message format is not” SMS, MMS, or EMS). The Examiner’s search for documents containing MMS and EMS terms would likely return highly irrelevant results. At the same time, the Examiner issued no queries for contemplated message formats that fall squarely within the scope of the claims. For example, the ’450 Patent identifies “Mobile Instant Messaging (MIM)” as a popular packet-switched message format in a preferred embodiment, but the Examiner never searched for any documents that referenced MIM (or even just “instant messaging” or “IM”). EX1002, 13-18, 52-57; EX1001, 1:66-2:5, 3:3-11, 10:41-59. The Examiner thus failed to identify such relevant references as Horvath (EX1004) and Chatterjee (EX1007) that each describe instant

---

<sup>1</sup> Ironically, Horvath *does* disclose a WLAN by another name (“802.11” network), but the Examiner’s search queries failed to employ such common synonyms.

EX1004, [0024].

messaging and related packet-switched services.

The Examiner's deficient search was not harmless. As discussed above, the Examiner's sparse and non-sensical queries led him to miss key references like Horvath, Chatterjee, and others applied in the Petition, that together with Tsampalis (EX1005) (discussed further below), disclose every limitation of the Challenged Claims. Pet., 1-2.

**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**

Beyond the deficient search, the Examiner committed an additional error 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 March 11, 2021. EX1002, 60. 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 '450 Patent, and that Office Action includes no mention of Tsampalis PCT at all. EX1002, 45-49. The Notice of Allowance is similarly silent, lacking any reasons for allowance. EX1002, 8-12.

The Examiner’s decision to allow the ’450 Patent over Tsampalis PCT, either on its own or in combination with additional references, amounted to 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 ’450 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 ’450 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 ’450 Patent are highly similar. The following table highlights overlap between similar limitations of claim 1 of each patent, for example:

EP 2 177 072 Invalidated Claim 1 <sup>2</sup>	'450 Patent Claim 1 Limitations
A <b>method</b> for providing a messaging service on a sender's mobile wireless	[1pre] A <b>method</b> comprising:

---

<sup>2</sup> Based on English Translation from Patent Owner’s Exhibit 2013. Apple also submits a certified English Translation of the FCJ Decision as Exhibit 1115.

<p>device in a wireless communications network; the method comprising:</p>	
<p>the sender's mobile wireless device <b>verifying whether the destination address is capable of receiving the outgoing message via a packet-switched bearer,</b></p>	<p>[1c] transmitting, by the first mobile wireless device, after the subscribing, a request including at least information corresponding to at least one mobile phone number of the second mobile wireless device, to <b>determine whether the second mobile wireless device corresponds to a subscriber of the service [for transmitting and receiving packet-switched messages];</b></p> <p>[1d] receiving, by the first mobile wireless device, a response to the request <b>indicating that the second mobile wireless device corresponds to a subscriber of the service;</b></p>
<p>wherein the step of verifying the destination address involves <b>sending an address verification request to the message server;</b> 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>[1c] <b>transmitting,</b> by the first mobile wireless device, after the subscribing, <b>a request</b> including at least information corresponding to at least one mobile phone number of the second mobile wireless device, <b>to determine whether the second mobile wireless device corresponds to a subscriber of the service;</b></p>
<p><b>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,</b> but otherwise, the sender's mobile wireless device automatically</p>	<p>[1e] <b>formatting a second message in accordance with a message format of the service,</b> subsequent to the subscribing and <b>based at least in part on the response;</b></p>

sending the outgoing message to the recipient's mobile wireless device at the destination address via an SMS bearer.	
--	--

EX1001, 11:58-12:20; 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., 31-39; EX1003, ¶¶72-79.

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 ’450 Patent, and it therefore does nothing to support the Examiner’s decision to allow the ’450 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 ’450 Patent are not limited to require this or any similar feature. *See* EX1001, 11:58-12:20. Whether Tsampalis or any other reference discloses the feature is therefore irrelevant to patentability of a vast majority of claims of the ’450 Patent. In short, the Examiner’s failure to recognize Tsampalis’s teachings of a sending mobile device that, like claim 1 of the ’450 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 half a year before the '450 Patent was allowed on June 28, 2021. EX2013; EX1002, 8. Despite ample opportunity, the Applicant never brought the FCJ Decision to the Examiner's attention during prosecution. *See* EX1001, Cover; EX1002, 58-78. The Examiner thus allowed the application for the '450 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 Applicant's failure to cite the FCJ Decision also raises serious 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 '450 Patent *family*.” DD Brief, 5 (emphasis added). But whether additional documents were later cited in *family* members of the '450 Patent does not cure the material error that occurred during prosecution of the '450 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 ’450 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 ’450 Patent. Only four documents from the German litigation were cited to the Examiner of the ’450 Patent, all of which were dated years before the FCJ Decision. EX1002, 61. 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 ’450 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 deci-

sion 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.

EX1103. 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. EX1114. 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. Apple’s IPRs promote efficiency by addressing related patents cohesively. 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 (Factor 5), this factor alone does not favor denial, particularly where, as here, the Petition demonstrates strong merits of unpatentability. Factor 5 is *neutral*.

**Factor 6 (Merits and Other Considerations)**—As set forth in the Petition, the ’450 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 ’450 Patent without conducting an adequate search or even recognizing the pertinence of the prior art of record during examination including Tsampalis PCT. 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 '450 Patent is Young, Having Issued Just Four Years Before Apple's Petition**

HBCU fails to show that it has settled expectations in the '450 Patent. It does not. The '450 Patent issued in August 2021, just four years before Apple's Petition was filed in August 2025. HBCU presumptively lacks strong settled expectations on a young patent like the '450. *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 '450 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 ’450 Patent issued in August 2021—just four 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 ’450 Patent did not exist at that time. It would not issue for another six years.

*Second*, the ’450 Patent issued eight months *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 by an independent tribunal. It should not.

Following the German FCJ Decision, it was reasonable for Apple and the public to expect that the ’450 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 '450 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 '450 Patent family. *See* EX1109 (continuity data for ancestor of the '450 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 '450 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 '450 Patent is the fifth continuation in the family, but only the third patent to issue. EX1110 (continuity data for the '450 Pa-

tent). HBCU or the prior patent owner inexplicably filed and voluntarily *abandoned* three consecutive applications in the priority chain before ultimately resuming prosecution of the '450 Patent, thereby delaying issuance of the '450 Patent by nearly *seven 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 '450 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 '450 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 '450 patent" with the previous patent owner back in 2016 is false. DD Brief, 8. The '450 Patent did not issue until August 2021, so there could not have been any discussion about the '450 patent five years earlier. HBCU cites no evidence that Apple was aware of the '450 Patent before September 2024 when HBCU purportedly "sent a letter to Apple specifically identifying the '450 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 '450 patent is young (just over 4 years old). And HBCU presents no evidence that Apple was aware of the '450 patent before September 2024. The HBCU patents that Apple allegedly cited in IDSes of its own patents are family members (not the '450 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's assertions 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" are false. DD Brief, 7 (emphasis in original). Neither party has proposed any term of the '450 Patent for construction in the district court, and there is therefore no possibility of inconsistent claim construction positions. *See* EX1105; EX1106, EX1107, EX1108.

**IV. CONCLUSION**

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

Respectfully submitted,

Dated: December 10, 2025

/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 December 10, 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:

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](mailto:tdevlin@devlinlawfirm.com)  
[nbenchell@devlinlawfirm.com](mailto:nbenchell@devlinlawfirm.com)  
[dlflitparas@devlinlawfirm.com](mailto:dlflitparas@devlinlawfirm.com)

/Crena Pacheco/

Crena Pacheco  
Fish & Richardson P.C.  
60 South Sixth Street, Suite 3200  
Minneapolis, MN 55402  
[pacheco@fr.com](mailto:pacheco@fr.com)