

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE, INC.,  
Petitioner

v.

HBCU MESSAGING US LP,  
Patent Owner

IPR2025-01493  
U.S. Patent No. 11,089,450

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**PATENT OWNER'S AUTHORIZED RESPONSE  
TO DIRECTOR REVIEW REQUEST**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
*Submitted Electronically via P-TACTS*

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## I. INTRODUCTION

In bringing this request, Petitioner (“Apple”) ignores the specific direction given for denying this Petition. The Director specifically referred the subject matter of this Petition to the district court, not to later IPRs. This misunderstanding alone renders Apple’s position meaningless.

Instead, Apple’s arguments appear predicated on the assertion that the Director should consider events occurring *after* the discretionary denial determination. Yet in advancing this proposition, Apple ignores two related denials already in place. Apple’s arguments that the Director must overturn its decision based on the later referrals of IPR2026-00104, -00105, -00107, and -00109 while ignoring the current denials of IPR2025-01486 and -01488 are untenable. That would put the Director in an unworkable position, requiring it to routinely update its decision in light of future events while ignoring present realities.

Tellingly, in offering these nonsensical arguments, Apple relies on unsupported and, frankly, fallacious statements of “fact” that are at best confusing and at worst meant to mislead. On that basis alone, Apple’s request should be denied.

## II. ARGUMENT

### A. The Director Purposely Deferred to the District Court Regarding the Subject Matter of This IPR

Apple argues that this Petition should not have been denied because the Director referred other Petitions to be evaluated on the merits. But this ignores the reason given for denying this Petition and two other similar Petitions. The Director did not merely say that because there are issues similar to the other denied Petitions, this one must also be denied. Instead, the Director made clear that these issues are more appropriately addressed by the district court. (*See* Paper 15 at 1 n.2.) Apple's speculation about the Director's motivation is thus directly contradicted by the actual record of the Director's own decision-making.

Here, the Director specifically referred the subject matter of this Petition to the district court because there are similar issues in the other denied Petitions that are best addressed by the district court. Tellingly, Apple never even mentions that portion of the Director's comment on denial, focusing solely on its own speculation about other denied Petitions. On that basis alone, Apple's request must be denied.

### B. Nothing Has Changed to Overrule the Director's Decision

The Director denied this Petition based on the similarity of issues with IPR2025-01486 and IPR2025-01488, which were also denied. (*See* Paper 16 at 1.) Nothing has changed. IPR2025-01486 and -01488 are still

denied. (*Id.*) And for the reasons stated by the Board, it would still be an inefficient use of Office resources to proceed with this Petition while the district court will be forced to adjudicate these or similar issues. (Paper 15 at 1 n.2.)

For example, Apple has asserted in district court combinations of its IPR art and a variety of system art. (*E.g.*, Ex. 2017, Apple’s Invalidation Contentions.) The district court must thus necessarily address the main art relied upon in this Petition (and the other two denied Petitions). The Director’s basis is exactly correct. Instead of attempting to show why the Director’s decision was flawed, Apple focuses its arguments on decisions made *after* the denial of this Petition. Even if one presumes that the Director will change its mind again on IPR2025-01486 and -01488, the basis for denying *this* Petition—that the issues overlap with those in district court—would remain valid. But as explained in HBCU’s response to those Requests for Director Review, there is absolutely zero support for changing the Director’s decision in those Petitions. (*See generally* IPR2025-01486, Paper 17; IPR2025-01488, Paper 17.)

**C. IPR2026-00104, -00105, -00107, and -00109 Are Irrelevant Here**

Apple’s main argument is that the Director somehow failed in its duty to consider *later* briefing in four other matters. (*See* Paper 16 at 6 (“the Decision [to deny this IPR] 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.”.) The Director's decision on each discretionary denial is appropriately based on the arguments and evidence presented in each respective Petition, not arguments made in unrelated matters presented at a later time.

Apple is correct that the Director did not consider the later referrals for IPR2026-00104, -00105, -00107, and -00109 in issuing its denial for IPR2025-01493, nor should it have. The Director was told about the parallel district court litigation and provided copies of the Complaint (Ex. 2001) and Amended Complaint (Ex. 2015) asserting seven separate patents against Apple. (*See* Paper 7 at 6.) And of course, it is just as likely (arguably more likely) that the Director was aware of the four later Petitions when deciding the first three Petitions.

Moreover, Apple's proposed method for analyzing a request for discretionary denial—relying on subsequent filings in other matters—can only lead to endless recircling around decisions. What Apple proposes is that the Director re-evaluate its decision whenever a (supposed) new fact arises. That would result in Petitioners like Apple seeking reconsideration over every decision the Board makes, again and again.

Apple's reliance on *Padagis US LLC v. Neurelis, Inc.*, is unavailing here. (*See* Paper 16 at 2, 7 (citing *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, 3-4 (PTAB Jul. 16, 2025).) In *Padgis*, the Board referred the

IPRs because the “proceedings raise[d] similar issues to those previously adjudicated in” an *earlier* IPR. (*Padagis*, IPR2025-00464, Paper 12, 2-3.) That is not the situation here, where all the denied Petitions were concurrently filed and only *later* Petitions were referred. Indeed, contrary to Apple’s assertion, these facts support the Director’s decision because those common issues are still undecided, unlike in *Padagis*. Thus, denying this IPR on the grounds that the issues are similar to those in other denied IPRs that will be addressed by the district court is the most prudent action for the Director to take.

It must also be noted that these four referred IPRs (IPR2026-00104, -00105, -00107, and -00109) still have to be considered on the merits of their respective petitions. And those merits warrant denial. Contrary to Apple’s statements that the four Petitions recently referred suffer no ongoing claim construction issues, claim construction remains an ongoing issue for each and every one of these IPRs. (Paper 16 at 3.)

Indeed, Apple makes this and similar assertions throughout its Brief. (*E.g.*, Paper 16 at 5 (“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.”).) Each of these assertions is false for the many reasons set forth in Patent Owner’s Preliminary Responses and other papers. (*See generally* IPR2025-01486, Paper 9; IPR2025-01488, Paper 9; IPR2025-01493,

Paper 9; IPR2026-00104, Paper 9; IPR2026-00105, Paper 9; IPR2026-00107, Paper 9; IPR2026-00109, Paper 11.)

In short, the district court is holding open at least one claim term, and Apple's shifting positions with respect to others demonstrate that: (1) Markman is still an open issue in the district court case, and (2) Apple cannot be trusted to maintain consistent positions across the two sets of proceedings. This Petition should remain denied.

**D. Apple Is Improperly Trying to Adjudicate the Denial of the Other Two IPRs Here**

Apple's claim of HBCU's "gamesmanship" is not only disingenuous but hypocritical. (*See generally* Paper 16 at 4-5.) Having taken HBCU to task for something it did *not* do, then doing exactly the same thing, Apple cannot, in good faith, ask the Director to reconsider its earlier denial decision.

Apple attempts to imply that the Director ignored its own rules by considering a line of briefing unrelated to the Discretionary Denial briefing. Calling HBCU's arguments baseless and improper, Apple makes the absurd claim that HBCU made discretionary arguments in its POPR, which "inspired additional briefing from both parties on the issue." (Paper 16 at 4-5.) Apple alleges—with no basis whatsoever—that HBCU devised a scheme to have additional briefing in its POPR so that the Director could review the three-page brief and in the twelve days between the briefing and denial decision, deny this and the other two

previously filed Petitions. (*See id.* at 5; *see also* IPR2025-01486, Paper 17 at 2; IPR2025-01488, Paper 17 at 2.)

While entertaining, this fantasy is completely false and completely irrelevant to the issues presented here. If there is any relevance to Apple’s argument at all, it is relevant to Apple’s conduct. Apple is doing exactly what it accuses HBCU of doing: improperly making discretionary decision arguments in unrelated briefing. Here, Apple seems to argue for the denial for IPR2025-01486 and -01488 under the guise of briefing about this separate Petition, while at the same time pointing to discretionary decisions in later Petitions as a basis to deny this one.

In fact, Apple is flat wrong when it accuses the Director of impropriety. A decision on discretionary denial may consider the petition, the POPR, and the evidence cited therein. (*See* Paper 16 at 4 n. 1 (*citing* Interim Director Discretionary Process, <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (A decision on discretionary denial may include “consider[ation of] the petition, the POPR and the evidence cited therein.”)).) Thus, contrary to Apple’s presumption, the Director may rely on briefs it claims are beyond the scope of the Director’s review for discretionary denial.

**E. Apple’s Recitation of the Facts Is Misleading and Inaccurate**

It must be noted that while Apple’s entire argument section covers less than a page, the lion’s share of Apple’s brief is taken up with self-serving, unsupported

“facts” that are more argumentative than accurate. (*See* Paper 16 at 2-6.) Apple does not even bother to rely on most of this information when making its single page of arguments.

For example, Apple asserts that “Apple’s Opposition to HBCU’s Discretionary Denial Brief presented a compelling case for referral.” (*See* Paper 16 at 3.) Yet the Board still denied the IPR, for the sound reason that similar issues would be addressed by the district court. (Paper 15, 1 n.2).

Likewise, Apple’s claim that “[t]he Director has, thus, determined that five of Apple’s seven petitions on HBCU’s related patents do not warrant discretionary denial under *Revvo*” is flatly wrong. (Paper 16 at 2.) Of the seven IPRs filed, three have been denied.

More importantly, as explained above, the four IPRs referred by the Director suffer the same claim construction problems as the two IPRs that were denied. Thus, contrary to Apple’s assertion the four referred IPRs *do* have ongoing claim construction issues and are not like this IPR. (Paper 16 at 3.)

Additionally, Apple claims that “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.” (Paper 16 at 3.) Apple offers *zero facts* to support this statement. Likewise, Apple asserts that HBCU’s arguments in the other two

denied Petitions are misleading yet provides zero evidence that the statements are anything other than the truth. (Paper 16 at 5.) Apple's finger-pointing should be rejected, and the Director should maintain denial for the sound reasons set forth in its prior Order.

### III. CONCLUSION

For the reasons set forth above, the Petition denial should be maintained.

Respectfully submitted,

Dated: March 30, 2026

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**CERTIFICATE OF SERVICE**

I hereby certify that on March 30, 2026, I caused a true and correct copy of  
**PATENT OWNER'S AUTHORIZED RESPONSE TO DIRECTOR  
REVIEW REQUEST** to be served via electronic mail on the following counsel  
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