

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

LIST OF EXHIBITS

| | |
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| 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)

HBCU's Reply raises issues beyond the scope of authorized briefing, after requesting such briefing without first conferring with Apple. *See* EX3101 (request limited to addressing "the full search history undertaken by the [] Examiner[]"). Still, even if considered, HBCU's arguments are not compelling.

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

Then, strikingly, just five lines of HBCU's Reply address the specific issue requested and authorized for briefing, *i.e.*, "the full search history undertaken by the [] Examiner[]." PO Reply, 1; EX3101. But this is not surprising because there was nothing new or relevant to add about the Examiner's search beyond what Apple already addressed in the Opposition. To this point, HBCU provides just a single citation to pages 18 and 56-57 of the file history (EX1002), but these are the exact same pages Apple already cited in the Opposition. *See* Pet. Op., 4. In other words, HBCU

identified no searches that the Opposition did not already address. And tellingly, on substance, HBCU never denies that the Examiner formulated only a handful of keyword queries during the entire course of prosecution, or that those queries were misguided for each of the reasons detailed in the Opposition. *See* Pet. Op., 3-6. The fact that the Examiner issued other non-prior art interference queries and classification queries, *e.g.*, to combine with and thus further limit the keyword queries, does not speak to or cure the underlying search deficiencies raised in the Opposition. *Id.*

HBCU's remaining arguments are similarly unavailing. *See* PO Reply, 2. HBCU conspicuously fails to cite any evidence that it cited the German court's decision in the earlier nullity action (EX2013) to the Examiner. Pet. Op., 6-11. This failure should be dispositive, as it demonstrates HBCU's bad faith in prosecution. As explained in the Opposition, the '450 Patent is young and HBCU's flurry of continuation filings completely undermines its claim to settled expectations, especially where it consistently failed to cite the German court's decision. *Id.*, 16-17.

Finally, HBCU's conclusory assertion that Apple's broader-than-*Sotera* stipulation is inadequate ignores that the district court trial is scheduled months earlier than the expected final written decision in this IPR. PO Reply, 2. HBCU also fails to point to any filings from or positions taken in district court that actually undermine the stipulation's ability to fully assuage any concerns of overlap between the proceedings. *Id.*; DD Brief, 16-17.

Respectfully submitted,

Dated: December 29, 2025

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CERTIFICATE OF SERVICE

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

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