

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

HBCU Messaging US LP,
Patent Owner

Case IPR2026-00105
Patent 11,991,600

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

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LIST OF EXHIBITS

APPLE-1001	U.S. Patent No. 11,991,600 (“the ’600 Patent”)
APPLE-1002	File History of U.S. Patent No. 11,991,600
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	U.S. Pub. No. 2002/0173308 (“Dorenbosch”)
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	RESERVED
APPLE-1011	U.S. Patent No. 6,940,844 (“Purkayastha”)
APPLE-1012	U.S. Patent No. 7,702,342 (“Duan”)
APPLE-1013	RESERVED
APPLE-1014	U.S. Pub. No. 2006/0286984 (“Bonner”)
APPLE-1015 – APPLE-1019	RESERVED
APPLE-1020	U.S. Patent No. 7,236,472 (“Lazaridis”)
APPLE-1021 – APPLE-1024	RESERVED
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 – APPLE-1031 RESERVED

APPLE-1032 U.S. Pub. No. US 2008/0261577 (claiming priority to Provisional App. No. 60/913,187) (“Celik”)

APPLE-1033 – APPLE-1036 RESERVED

APPLE-1037 T-Mobile webpage <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. US 2008/0153459 (“Kansal”)

APPLE-1043 – APPLE-1044 RESERVED

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”)

APPLE-1049 RESERVED

APPLE-1050 U.S. Pub. No. 2005/0233737 (“Lin”)

APPLE-1051 U.S. Pub. No. 2008/0176538 (“Terrill”)

APPLE-1052 U.S. Patent No. 9,036,620 (“Procopio”)

APPLE-1053 U.S. Patent. No. 9,467,530 (“Belimpasakis”)

APPLE-1054 U.S. Patent No. 7,069,008 (“Hill”)

APPLE-1055 U.S. Pub. No. 2005/0125547 (“Ahonen”)

APPLE-1056 U.S. Pub. No. 2005/0002407 (“Shaheen”)

APPLE-1057 RESERVED

APPLE-1058 WO 01/41477 (“Lee”)

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APPLE-1061 U.S. Pub. No. 2007/0290787 (“Fiatal”)
APPLE-1062 RESERVED
APPLE-1063 U.S. Pub. No. 2009/0325609 (“Rosen”)
APPLE-1064 U.S. Patent No. 7,117,445 (“Berger”)
APPLE-1065 RFC 3680: A Session Initiation Protocol (SIP) Event Package
for Registrations (March 2004)
APPLE-1066 IMS Share Technote, *available at* https://www.sharetechnote.com/html/Handbook_IMS_SIP_Header_Expire.html
APPLE-1067 U.S. Pub. No. 2006/0036857 (“Hwang”)
APPLE-1068 U.S. Pub. No. 2002/0006793 (“Kun-Szabo”)
APPLE-1069 U.S. Patent No. 6,678,524 (“Hansson”)
APPLE-1070 U.S. Pub. No. 2007/0004461 (“Bathina”)
APPLE-1071 U.S. Pub. No. 2008/0307487 (“Choyi”)
APPLE-1072 U.S. Pub. No. 2008/0310425 (“Nath”)
APPLE-1073 U.S. Pub. No. 2004/0005875 (“Ko”)
APPLE-1074 U.S. Pub. No. 2008/0263137 (“Pattison”)
APPLE-1075 U.S. Pub. No. 2014/0258423 (“Schaedler”)
APPLE-1076 U.S. Pub. No. 2008/0311888 (“Ku”)
APPLE-1077 U.S. Pub. No. 2008/0192770 (“Burrows”)
APPLE-1078 U.S. Pub. No. 2006/0264213 (“Thompson”)
APPLE-1079 – APPLE-1083 RESERVED
APPLE-1084 U.S. Pub. No. 2009/0280779 (“Torres”)
APPLE-1085 U.S. Pub. No. 2009/0220091 (“Howard”)
APPLE-1086 U.S. Pub. No. 2008/0039081 (“Ma”)

APPLE-1087 U.S. Pub. No. 2008/0045214 (“Wen”)

APPLE-1088 U.S. Pub. No. 2006/0185003 (“Laitinen”)

APPLE-1089 – 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 Infringement Charts of the ’600 Patent

APPLE-1102 Stipulation dated November 26, 2025

APPLE-1103 *Apple Inc. v. HBCU Messaging US LP*, IPR2025-01486, Paper 12 (PTAB Jan 9, 2026)

APPLE-1104 RESERVED

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 Claim Construction Order, *HBCU Messaging US LP v. Apple, Inc. et al.*, 1-24-cv-01199 (WDTX) (Jan. 28, 2026)

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 Corrected Discretionary Denial Briefing 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. 11,991,600 ("the '600 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 '600 Patent. The application for the '600 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.

The Director previously referred Apple's petitions on three related patents in the '600 Patent family. *See* IPR2025-01486, -01488, -01493. The present Petition cites overlapping prior art and raises similar issues to those in the earlier-referred petitions. Instituting all of Apple's petitions in this family would promote efficient resolution of these issues at the PTAB and would narrow the parties' dispute in the parallel district court litigation. This is especially the case here where a final decision in this IPR is expected at least two months *before* the scheduled trial date.

And if instituted, Apple's broad stipulation would substantially mitigate overlap between the IPR and the district court.

The '600 Patent also has not been in force for long, having issued just 1.5 years before the filing of Apple's Petition. HBCU thus lacks settled expectations. HBCU's attempts to conjure settled expectations based on a prior German litigation also fail. The '600 Patent did not issue until years later, and only after the counterpart claims in Germany were invalidated.

For each of the reasons described herein, the Petition should be referred.

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

A. The '600 Patent is the Product of Material Examination Errors

The '600 Patent stands in a long line of continuations. But the substantive examination of the particular claims of the '600 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* APPLE-1002, 61-62. The '600 Patent was effectively rubber stamped to issuance. *See* APPLE-1002, 55-65, 161-167.

As discussed further below, the '600 Patent's quick allowance was the result of material examination errors 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 warranted where “Petitioner appears to show a material error by the Office”).

1. The Examiner Erroneously Allowed the '600 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.” APPLE-1105 (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.” APPLE-1105, 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 ’600 Patent made the same material error. Specifically, the Notice of Allowance concluded that:

the prior art of record either singularly or in proper combination fails to teach wherein a packet switched message service (PSMS) is used to send the third message to the third receiving mobile phone; the PSMS is a service for sending and receiving packet switched messages other than SMS, enhanced message service (EMS) and multimedia message service (MMS) messages; ***wherein a same messaging client on the sending mobile phone performs at least the retrieving, the sending, the receiving, the automatically selecting, the formatting and the transmitting for each of the first, second and third iterations.***

APPLE-1002, 61-62. However, challenged independent claims 13, 21 and 29 do not recite these limitations. *See* APPLE-1001, 13:53-14:33, 15:10-64, 16:33-17:22. In fact, the Applicant pointed out this error to the Examiner in an Amendment After Notice of Allowance dated November 17, 2023, but the Examiner never corrected the error. *See* APPLE-1002, 51-52 (“it was discovered that the Allowable Subject Matter section of pages 3 to 4 recites claim elements of claim 1”). 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 ’600 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. Corr. DD Brief, 3; EX2008. The Applicant in fact cited Tsampalis PCT in an IDS that the Examiner initialed on August 4, 2023. APPLE-1002, 221-225; EX2008. 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 ’600 Patent, and that Office Action includes no mention of Tsampalis PCT at all. APPLE-1002, 161-167.

The Examiner’s decision to allow the ’600 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 ’600 Patent. On December 15, 2020, the German Federal Court of Justice is-

sued a decision in a nullity action holding all original claims of a European counterpart of the '600 Patent (EP 2 177 072) invalid over Tsampalis PCT. EX2012, 23 (“The subject-matter of claim 1 was suggested to the skilled person on the basis of K5 [Tsampalis PCT]”).

While not identical, the EP claims invalidated by Tsampalis PCT and the claims of the '600 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	'600 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:	[1pre2] a sending mobile phone that transmits short message service (SMS) messages and non-SMS based packet switched messages ...
the sender's mobile wireless device verifying whether the destination address is capable of receiving the outgoing message via a packet-switched bearer ,	[1b] sending information representing at least the phone number of the receiving mobile phone ; [1c] receiving a response to the sending of the information; [1d1] based at least in part on the response, automatically selecting a bearer for the message , [1g3] during the second iteration, a second message is sent to a second receiving mobile phone using the

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

	<p>packet-switched message bearer supported by the cellular connection; and</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>[1b] sending information representing at least the phone number of the receiving mobile phone; [1c] receiving a response to the sending of the information; [1d1] based at least in part on the response, automatically selecting a bearer for the message,</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 formatting, transmitting, by the sending mobile phone using the selected bearer, the message, to the receiving mobile phone; [1g2] during the first iteration, a first message is sent to a first receiving mobile phone using the SMS bearer; [1g4] during the third iteration, a third message is sent to a third receiving mobile phone using the packet-switched message bearer supported by the WLAN connection;</p>

APPLE-1001, 12:20-13:3; EX2012, 8-9.

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. *See* Pet., 21-53; APPLE-1003, ¶¶48-98.

HBCU attempts to brush aside Tsampalis PCT and the FCJ Decision by noting that “amended claims were upheld as valid by Germany’s highest court.” Corr.

DD Brief, 3-4. 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.” EX2012, 29. None of independent claims 1, 13, 21 or 29 of the ’600 Patent is limited to require this or any similar feature. *See* APPLE-1001, 12:20-13:3, 13:53-14:33, 15:10-64, 16:33-17:22.

Whether Tsampalis or any other reference discloses the feature is therefore irrelevant to patentability of many claims of the ’600 Patent. The Examiner’s failure to recognize Tsampalis’s teachings of a sending mobile device that, like the ’600 claims, 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 very likely contributed to the Examiner’s oversight of Tsampalis PCT*. The FCJ Decision was released on December 15, 2020, *i.e.*, years before the ’600 Patent was allowed on March 29, 2023. EX2012; APPLE-1002, 55. Despite ample opportunity, the Applicant never brought the FCJ Decision to the Examiner’s attention during prosecution. *See* APPLE-1001, Cover; APPLE-1002, 233-237. The Examiner thus allowed the application for the ’600 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 ruled obvious

over Tsampalis PCT. The Applicant's failure to cite the FCJ Decision raises serious questions about the Applicant's compliance with its duty of disclosure under § 1.56.

HBCU attempts to distract from this failure to cite the FCJ Decision by asserting that “the previous patent owner submitted that art [from the German nullity proceeding] to the USPTO in further ongoing prosecution of the '600 patent *family*.” Corr. DD Brief, 3 (emphasis added). But whether additional documents were later cited in *family* members of the '600 Patent does not cure the error made during prosecution of the '600 Patent itself. Likewise, HBCU's citation of Exhibit 2013—*i.e.*, Apple's letter initiating the German nullity proceeding—to support its assertion that “all U.S. patents issued in the family since that time—including the '600 Patent at issue—were allowed over the Tsampalis PCT, as well as other prior art submitted by Apple in Germany” is misleading. Corr. DD Brief, 4. Exhibit 2013, which includes arguments based on Tsampalis PCT, was *never cited* to the Examiner during prosecution of the '600 Patent. Only four documents from the German litigation were cited to the Examiner of the '600 Patent, all of which were dated years before the FCJ Decision. APPLE-1002, 233-237. None included Exhibits 2012 or 2013.

B. Institution Will Narrow the Parallel Litigation and Promote Efficient Use of Resources

As discussed above, the Board has already referred three petitions filed

against three patent family members for consideration on the merits. *See* APPLE-1103 (referring IPR2025-01486, -01488, -01493). The prior art and claim language of this petition significantly overlap with those three petitions, and “it is an efficient use of Board resources to address the related patent[s],” especially where similar issues are presented. *See Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper No. 12, 3-4 (PTAB Jul. 16, 2025). The following additional factors further demonstrate the efficiency of also referring this petition.

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. EX2015, 4. The Final Written Decision (FWD) in this IPR is expected by early May 2027—more than two months *before* the trial. Institution will therefore promote efficient resolution of validity issues for the '600 Patent well before trial.

Two months is not “slightly after” the expected FWD, as HBCU alleges. Corr. 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 final written decision due date was similarly months *before*

the scheduled trial date in the W.D. Tex., 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.

1. *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. AP-PL-1102. 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).

2. *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 more than two months *before* trial. Factor 2 *favours referral*.

Factor 3 (Investment)—Investment in the district court proceeding remains low. 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. EX2015, 3. 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 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 in advance of the §315(b) statutory bar, and HBCU fails to demonstrate any gamesmanship in Apple’s filing strategy. APPLE-1115. 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 ’600 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 ’600 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 ’600 Patent is Young, Having Issued Just Four Years Before Apple’s Petition

HBCU fails to show that it has settled expectations in the ’600 Patent. It does not. The ’600 Patent issued in May 2024, just about 1.5 years before Apple’s Petition was filed in November 2025. HBCU presumptively lacks strong settled

expectations on a young patent like the '600. *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 waiting “ten years after initiation of the German proceedings” and “years after discussions with previous patent owner” to bring an IPR challenge against the '600 Patent. Corr. DD Brief, 8. These arguments are but a misguided attempt to evade review of a young patent that HBCU only recently acquired. HBCU’s narrative does not withstand scrutiny for multiple reasons addressed below.

First, Apple did not (and could not have) delayed “ten years after initiation of the German proceedings” to file this IPR. Again, the '600 Patent issued in May 2024—just 1.5 years before Apple filed its Petition in this IPR. APPLE-1001, Cover. By contrast, the German proceedings were initiated in 2015—eight years before the '600 Patent would issue. HBCU simply has its facts wrong.

Second, the '600 Patent issued 2.5 years *after* the German court found similar claims of the counterpart EP patent invalid over Tsampalis PCT on December

15, 2020. EX2015; *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 court's decision, the validity of subsequently issued claims directed to similar features, like those in the '600 Patent, was suspect—especially where the independent claims of the '600 Patent do not even recite the additional features that the German court eventually accepted. The Applicant's failure to cite the German court's decision to the Examiner underscores that the Examiner's evaluation of the claims and prior art was incomplete. *Supra*, §II.A.2. 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 '600 Patent was readily challengeable before HBCU served its district court complaint against Apple in November 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 '600

Patent family. *See* APPLE-1110 (continuity data for ancestor of the '600 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 '600 Patent would have warranted any unique 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, HBCU or the prior patent owner inexplicably filed and voluntarily *abandoned* three consecutive applications in the priority chain before ultimately resuming prosecution of the family, thereby delaying issuance of subsequent applications (including the application for the '600 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 '600 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 German court found the EP patent claims invalid. Apple's settled expectations that the '600 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. APPLE-1100. HBCU should not be rewarded for its haphazard, serial litigation campaign.

Fifth, HBCU fails to explain how Apple's alleged discussions with the previous patent owner in 2016 regarding "other members in the same family as the '600 Patent" is relevant. Corr. DD Brief, 6. It is not. The '600 Patent did not issue until May 2024; there could not have been any discussion about the '600 Patent itself five years earlier. HBCU also cites no evidence that Apple was aware of the '600 Patent before September 2024 when HBCU purportedly "sent a letter to Apple specifically identifying the '600 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, and two months before serving the complaint. *See* APPLE-1100; APPLE-1115, 2.

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. Corr. DD Brief, 8-10. 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 ’600 Patent is young (just over 1.5 years old). And HBCU presents no evidence that Apple was aware of the ’600 Patent before September 2024. The HBCU patents that Apple allegedly cited in IDSes of its own patents are family members (not the ’600 Patent) that Apple could not possibly have cited before 2021, when the earliest of Apple’s patents were filed. Corr. DD. Brief, 2-3. Besides, HBCU’s position would 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.

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.” Corr. DD

Brief, 4-5 (emphasis omitted). Not so. The Petition provided 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., 4 (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”)).

Although the parties identified several terms for construction in district court, HBCU has identified no instance in which Apple’s application of the prior art was inconsistent with any construction proposed in district court. *See* APPLE-1106; APPLE-1107, APPLE-1108, APPLE-1109. Apple instead respectfully submits that it was unnecessary under *Wellman* to construe these same claim terms in the Petition because the claims would be rendered obvious under any reasonable construction, including Apple’s district court constructions.

Regardless, HBCU’s arguments have been rendered moot by the district court’s recent claim construction order. *See* APPLE-1120. The order holds that all disputed terms related to the ’600 Patent should be given their plain and ordinary meaning. *See* APPLE-1120, 1-4 (addressing the terms “bearer” and “cellular core network”). The Director has explained that, “in the generally rare instances where diverging constructions are advanced before two different tribunals, a party may

proffer a different, broader construction before the Board when the district court already has rejected petitioner's narrower construction." *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 36 at 4 (PTAB Jan. 26, 2026). The Court's constructions are consistent with the positions taken in the IPR, and therefore there is no divergence.

IV. CONCLUSION

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

Respectfully submitted,

Dated: February 17, 2026

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on February 16, 2026, 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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