

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

FERID ALLANI,
Patent Owner

Inter Partes Review Case No. IPR2025-00856
U.S. Patent No. 8,271,877

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

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I. INTRODUCTION

“No patent holder has a right to an invalid patent, *however long* that patent holder may have enjoyed that right inappropriately.” S. Rep. No. 110-259, at 21 (2008) (emphasis added). The ’877 Patent is a perfect example of why. After issuance, French businessman and Patent Owner Mr. Ferrid Allani (“PO”) waited twelve years to file suit in the US, *after* the ’877 Patent expired and *after* its now expired foreign priority counterpart was invalidated in French invalidity proceedings. Ex. 1034, ¶¶14, 36. During its life, the ’877 Patent was never commercialized. No products were marked with its patent number. No embodiments were ever made utilizing the patented technology. And PO has not identified a single license that it has obtained for the ’877 Patent.

Instead of browsing and selecting content over a network using navigation software and search engines like Internet Explorer™ and Yahoo!™, the purported “invention” of the ’877 Patent localizes part of this process so preliminary searches can be performed on the device itself before selecting an icon to link to a desired webpage. Petition, Paper 1 (“Pet.”), at 1-3. This process was already standardized and well known in the art by the time PO belatedly filed for patent protection. The Petition presents a compelling case of invalidity, showing how HDML standards and

general bookmarking technologies long used in the art accomplished these tasks well before the priority date of the '877 Patent.

The validity of the '877 Patent is further called into question by the fact that its French counterpart was invalidated. Indeed, PO's first lawsuit involving the patented technology was filed in France where PO asserted a French counterpart with similar claims. The Paris Judicial Court looked at PO's invention and decisively concluded it should not be entitled to patent protection.

Undeterred by this invalidity ruling, PO filed suit in the US and now seeks to avoid a second look at his invalid US patent through discretionary denial because he knows the merits are not in his favor. Contrary to what PO argues here, the settled expectation—largely due to the French invalidity ruling and the fact that the '877 Patent was never asserted during its lifetime—is that the challenged '877 Patent is invalid and unenforceable. PO's request for discretionary denial should be denied at least because (1) the Examiner erred by issuing invalid claims that read on known HTML standards and bookmarking technologies that disclose the key limitation in the Challenged Claims the examiner determined was missing from the prior art cited during examination; (2) the French foreign equivalent of the '877 Patent already has been found invalid; (3) the merits are exceedingly strong; (4) there was a settled

expectation of invalidity and unenforceability; and (5) trial in WDTX will likely post-date any FWD by 5 months based on the statistics and either way, there is no overlap in view of Petitioner’s broadened *Sotera+* stipulation.

II. BRIEF FACTUAL SUMMARY

PO first approached Apple regarding a potential license to the ’877 Patent in 2012. But after Apple informed PO that it did not believe it required a license to the ’877 Patent in 2013, PO went silent until, in December 2019, PO sued Apple and Google in France for infringement of related French Patent No. FR 2 803 929 (“FR929”), the French patent the ’877 Patent claims priority to. Ex. 1033, ¶15, 35. In January 2023, the Paris Judicial Court invalidated the claims of FR929. *Id.*, ¶36. Then, on April 18, 2024, the ’877 Patent expired. Months later in June 2024, over a year after the French invalidity ruling, PO decided to sue Apple in the Western District of Texas for allegedly infringing the ’877 Patent. As shown below, the claims of the ’877 Patent are substantially similar to those already invalidated by the Paris Judicial Court.

<u>US ’877 Patent</u>	<u>FR929 Patent — INVALID¹</u>
Claim 1. A method for accessing information- or service-providing web sites, from a mobile communication device connected through a	Claim 1. Method for accessing information sources and services on the Web, from a communication device connected via a communication

¹ Ex. 1051, 3.

communication network and provided with a display, comprising:	network to the Internet network, comprising:
a preliminary search for information or service, locally performed within said communication device in different themes and sub-themes within a plurality of successively displayed selection pages, said selection pages being organized in a structure of tree menu and beforehand locally stored within said communication device,	one or more steps of displaying a selection page from a plurality of selection pages organized within a tree-like menu structure and previously stored locally within said communication device, each selection page comprising a set of icons and,
each said selection page comprising a set of icons including one or more direct access icons for directly accessing an information- or service-providing web site and one or more selection icons for locally accessing and displaying another selection page within said structure of tree menu, wherein at least one of said selection pages comprises two or more direct access icons, and a step for emitting on the communication network, in response to a selection of a direct access icon in a selection page being currently displayed, an address of an information- or service-providing web site corresponding to said selected icon,	a step for transmitting on the communication network, in response to a selection of an icon in a selection page being displayed, the address of a source of information corresponding to said selected icon, characterized in that, for each selection page, the set of icons comprises one or more icons for direct access to remote sources of information and one or more selection icons for local access to another selection page within said tree menu structure
said address being locally generated during the display and selection steps and directly accessing said information- or service-providing web site.	said addresses of information sources corresponding to direct access icons being previously stored locally in an address table or base, or generated locally as the viewing and selection stages progress.

III. ARGUMENT

A. Institution of Apple's Petition for *Inter Partes* Review is an Appropriate Use of Board Resources.

1. The Patent Office Erred in a Way Material to Patentability When it Allowed the '877 Patent.

When the Patent Office errs materially in its examination of a patent, “it is an appropriate use of Office resources to review the potential error.” *Microsoft Corp. v. Partec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9 at 3 (PTAB June 12, 2025). The Patent Office erred when it overlooked material prior art during the examination the '877 Patent. To position the claims for allowance, the Examiner was convinced that “nothing in Iki nor its combination with Burke would yield” the “capability to display a page from a web site” recited in all pending claims of the '877 Patent. Ex. 1002 at 489. Regarding Iki, Applicant argued that Iki “fails to describe any means, much less a direct access icon, by which a page of a web site is accessed and displayed.” *Id.* at 491. As for Burke, Applicant argued that because the examiner relied on Burke only to support the obviousness of a separate limitation, Burke “as applied admittedly fails to cure” Iki’s deficiencies. *Id.*

As Apple’s Petition establishes, *Himmel*’s common bookmarking technology expressly discloses the claimed “direct access icons” the examiner found missing in the prior art to justify allowing the '877 Patent. Pet., 26–27 (mapping *Himmel*’s

locally stored “bookmark sets” as sets of “direct access icons”). The examiner did not locate *Himmel* during examination of the ’877 Patent and did not appreciate in its final office action how common stored bookmarks invalidate this purportedly novel concept of a “direct access icon.” Pet., 10. The Examiner was well aware of bookmarking or similar technologies throughout prosecution. *See* Ex. 1002, 170-171 (rejecting “direct access icons” over US 5,933,827 to Cole’s “hotlinks”), 340-341 (rejecting “two or more direct access icons” over US 6,456,303 to Walden’s “HTML” “links”), 383-395 (Japanese Pub. No. 11-259496 “Unified Managing Method of Bookmarks Between Plural Browsers”). However, the Examiner overlooked these bookmarking references in its last office action, including the previous bookmarking references used in prior rejections to teach the claimed “direct access icons.” The Examiner offered its final office action with no bookmarking art despite “direct access icons” still claimed. The oversight of *Himmel* and other bookmarking technology of record in the final office action was an error material to the patentability of the challenged claims.

The Examiner’s error is made even more evident by the fact that the ’877 Patent’s foreign priority patent, FR929, was invalidated by the Paris Judicial Court primarily by WO99/17229 (Kanno), entitled “Image Display **Bookmark System.**”

Ex. 1033, ¶36; Ex. 1044 (PCT Kanno). The U.S. examiner overlooked the importance of bookmarking teachings entirely in its final rejection. This led to the opinion that the prior art lacked the “direct access icons” limitation during examination of the ’877 Patent. As the Director has recognized, “overlooking the teachings of” the prior art “and the combined teachings of” that art establishes “that the Office erred in a manner material to the patentability of the challenged claims[.]”² *Microsoft*, Paper 9 at 3. Thus, “it is an appropriate use of Office resources” to review the examiner’s error during the examination of the ’877 Patent. *Id.*

Apple has Shown the Challenged Claims are Likely Invalid.

Apple’s Petition presents robust challenges to the Challenged Claims of the ’877 Patent. The Petition presents two grounds of unpatentability that, together, confirm the Challenged Claims are invalid as obvious. Pet., 4 (identifying grounds).

² The Director’s statements were made in response to arguments under § 325(d) and *Advanced Bionics*, *Microsoft*, Paper 9 at 3. The Director’s rationale is equally applicable here. The examiner did not locate *Himmel* during examination, and *Himmel* discloses the limitation of the Challenged Claims the examiner found lacking in the prior art before it. That error exists regardless of whether Apple’s Petition presents grounds of unpatentability based on prior art before the PTO during examination.

For both grounds, the Petition specifies, with supporting expert testimony, where each element of each claim is found in the prior art. *See generally* Pet., 13–62. And Petitioner’s proposed grounds rely on known standards and fundamentally similar bookmarking technology that led the invalidity of the ’877 Patent’s foreign counterpart. The Petition presents detailed, specific reasons, again with supporting expert testimony, showing why a POSITA would have been motivated to combine the prior art as proposed and would have had a reasonable expectation of success in making the proposed combination. Pet., 28–29, 31–34, 37–42, 52, 54–56, 60–61. In short, the merits of Apple’s unpatentability challenge are strong.

PO’s arguments to the contrary are few and contradict settled precedent and the factual record. First, PO faults the Petition for not alleging any anticipatory prior art. *DD Request*, 15. That has no relevance to the analysis. A Petitioner is permitted to raise challenges under *either* § 102 or § 103 and IPR proceedings are routinely instituted, and claims cancelled, based only on § 103 challenges. *See, e.g., Dish Network LLC v. Entropic Commc’ns, LLC*, IPR2024-00373, Paper 43 2–3, 11–12 (PTAB July 22, 2025). Nor has the Federal Circuit ever noted a “preferential ranking” for invalidity challenges, and to do so here would be to ignore this longstanding approach. Moreover, the discretionary denial analysis focuses only on

the merits of the unpatentability challenge presented in the Petition. *Interim Memo*, 2. To Apple’s knowledge, the Director has never held, or even suggested, that the merits of a challenge are weak, or that discretionary denial is appropriate, simply because the Petition did not advance a § 102 challenge.

Second, PO alleges that Apple’s reliance “on nearly 124 pages of expert testimony” also shows Apple’s challenge is not compelling. *DD Request*, 15, 17–18. As a threshold failing, PO’s argument can be rejected because PO “does not identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art.” *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 12 at 2 (PTAB June 27, 2025); *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 2 (PTAB June 6, 2025) (same); *DD Request*, 15.

Moreover, detailed and evidence-supported expert declarations are encouraged, not discouraged, by the Board. *See Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00032, Paper 11 at 39 (PTAB May 19, 2025) (characterizing the 278 page expert declaration’s support of “his extensive explanations...with citations to dozens of pieces of objective evidence” as “a feature, not a bug of his testimony[]” and “applaud[ing]” the expert and Petitioner for “leav[ing] virtually none of the

substance of his testimony unsupported by objective evidence.”). Extensive, well-supported expert declarations, like Dr. Bederson’s declaration here, weigh *against* discretionary denial, not for it. *See iRhythm*, Paper 10 at 2 (Petitioner’s “rel[iance] on its expert to explain the background knowledge of a [POSITA]” and the expert’s “citations to evidence in support of his statements in the required manner” “weigh[] against discretionary denial”); *see also GD Energy Prods., LLC v. Kerr Machine Co.*, PGR2025-00031, Paper 11 at 2 (PTAB June 25, 2025) (same).

Apple’s Petition and Dr. Bederson’s supporting expert declaration establish that the Challenged Claims should be held unpatentable as obvious. The merits of Apple’s challenge are strong, and PO has identified no holes in Apple’s mappings or flaws in Apple’s obviousness rationales. This factor weighs strongly against discretionary denial.

B. PO’s Remaining Arguments Do Not Justify Discretionary Denial.

The alleged settled expectations of the ’877 Patent do not favor discretionary denial.

(a) Apple had a settled expectation of “invalidity” for the ’877 Patent.

The ’877 Patent is “highly vulnerable to invalidation[,]” thereby “tip[ping] the balance against discretionary denial.” *POSCO Co., Ltd. v. ArcelorMittal*, IPR2025-00370, Paper 10 at 2–3 (PTAB June 25, 2025). This is not reasonably in dispute

because invalidity proceedings already have been successful against the '877 Patent's foreign counterpart. In 2019, and prior to the US lawsuit, PO sued Apple in France, alleging infringement of the '877 Patent's foreign counterpart, FR929. Any purported "settled expectations" that existed about the validity of PO's invention was eliminated in that proceeding. There, Apple invalidated the FR929 Patent in view of WO99/17229 (Kanno) (Ex. 1044), U.S. Patent No. 5,877,765 (Microsoft) (Ex. 1049), and U.S. Patent No. 5,963,964 (Nielsen/Sun) (Ex. 1050), among others, each of which are directed to bookmarking technology.³ Thus, the fact that the foreign priority FR929 Patent, which presents substantially similar claims to the '877

³ Unlike the as-issued claims of FR929, the '877 Patent claims require a "mobile" communication device accessing a "website." None of the prior art at issue in the French proceeding taught these well-known concepts and the prior art generally was related to desktop applications, not mobile applications. The French claims were subsequently limited and reissued to include those concepts. Ex. 1033, ¶38. For this reason, Petitioner's challenge does not rely on the art used before the French Patent Office but, instead, relies on mobile HDML and similar bookmarking technologies to prove these were not patentable features that were added to FR929.

Patent (as shown above) and shares a common specification, was previously deemed unpatentable over similar technology that teaches the purportedly novel concepts defined by the applicant “tips the balance against discretionary denial.” *POSCO*, Paper 10 at 3. Further, as explained *infra*, PO waited for over a decade after Apple informed PO that it did not believe it required a license to the ’877 Patent and after the ’877 Patent expired. Apple therefore had a settled expectation the ’877 Patent would not be enforced and had no basis to pursue an earlier IPR.

Moreover, PO should have no settled expectation that the ’877 Patent is valid because patents *in this family* are regularly invalidated or rejected by Patent Courts across the world:

Patent / Application	Status
FR929	Invalidated by Paris Judicial Court
EPO1247212	Refused in 2012; Appeal rejected in 2012
EPO2204749	Refused in 2020; Appeal rejected in 2020
JP2003535388A	Refused in 2011
JP2015199306	Refused in 2017
IN350933	Denied in 2002 ⁴

⁴ This patent was ultimately granted after the India Supreme Court reinterpreted a statute, issuing in 2020, 6 months before expiration.

Ex. 1045. Each of these patents and applications claim priority to the same common French application FR1990016704 as the '877 Patent (and French priority FR929 patent), and were either invalidated in post-grant proceedings or rejected by the patent office during prosecution. Based on the French invalidity ruling and PO's other familial rejections, Apple rightfully expected the '877 Patent was invalid, particularly after PO's silence for over a decade after negotiations in 2013.

(b) Apple did not expect enforcement of the '877 Patent.

PO's failure to assert the '877 Patent nearly 13 years ago, and only after the '877 Patent expired, created a settled expectation for Apple that PO would not enforce the '877 Patent. The Director has recognized that "[t]here may be persuasive reasons why the Board should review challenged claims several years after their issuance date." *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2 (PTAB June 26, 2025). "For example...a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner's particular technology space, if at all." *Id.* at 2–3. Similarly, where a patent owner lets a patent expire before asserting it against a petitioner, the petitioner reasonably "expected non-enforcement" of that patent, negating any settled expectations in the asserted patent. *See Globus Med., Inc. v. Spinelogik, Inc.*,

IPR2025-00225, Paper 8 at 2 (PTAB June 12, 2025). Each of these persuasive reasons exists here. As such, it is an appropriate use of Board resources to review the challenged claims of the '877 Patent.

PO first contacted Apple about the '877 Patent via a letter on November 2, 2012. Ex. 1034, ¶ 52. After numerous communications, PO and representatives from Apple met on June 27, 2013, to discuss what PO characterizes as “a potential business arrangement concerning the '877 Patent.” *Id.* Following that meeting, however, Apple reviewed the '877 Patent, concluded that it did not require a license, and advised PO that it was not interested in taking a license to the '877 Patent. *Id.* Over the almost 11 years that followed, Apple did not hear from the PO again regarding the '877 Patent. During that time, the PO also took actions indicating to Apple that PO would not enforce the '877 Patent. For example, the '058 Patent (i.e., the Challenged Patent in Apple's IPR2025-00857) issued on March 9, 2021. Ex. 1034, ¶ 16. Yet the PO never contacted Apple to allege that it required a license to the '058 Patent like PO did for the '877 Patent. Moreover, while PO *had* sued Apple in France on the '877 Patent's (and the '058 Patent's) foreign priority patent in 2019, Ex. 1034, ¶ 54, PO did not bring a corresponding suit against Apple in the United States alleging infringement of the '877 Patent or the '058 Patent at that time. Then,

both the '877 and '058 Patent expired. Ex. 1034, ¶¶ 14, 17. From Apple's perspective, the PO's failure to contact Apple after the issuance of the '058 Patent, the PO's assertion of the '877 Patent's foreign counterpart patent, but not the '877 or '058 Patents, the French invalidity proceeding, and the expiration of both the '877 and '058 Patents indicated that this matter was closed. PO's actions (and inactions) made clear he had no intention of asserting the '877 Patent or the '058 Patent. But, nearly three months after the '058 Patent's expiration and two months after the '877 Patent's expiration, PO filed its Complaint alleging Apple infringes the '877 and '058 Patents. *See generally* Ex. 1034.

PO's 11-year silence and failure to bring suit before expiration—against Apple or anyone else—alleging infringement of the '877 Patent even *after* Apple informed PO in 2013 that it did not believe Apple required a license to the '877 Patent and after PO sued Apple in France led Apple to “expect[] non-enforcement” of the '877 Patent. This negates any settled expectations the '877 Patent may have otherwise accrued. *See Globus*, Paper 8 at 2 (concluding discretionary denial is inappropriate despite the claims being in force for almost 8 years because the Petitioner “expected non-enforcement of the challenged patent” after the PO let the

challenged patent expire)⁵. Further, the lack of commercialization of any technology embodying the '877 Patent weighs heavily against PO's case. *Intel*, Paper 12 at 2–3 (explaining that a patent not being “commercialized, asserted, marked, licensed, or otherwise applied in a petitioner's particular technology space, if at all” are “persuasive reasons why the Board should review challenged claims several years after their issuance date”).

The *Fintiv* Factors Favor Institution.

(c) Judge Albright's Median Time to Trial is 34 Months, Consistent with District-Wide Statistics.

The underlying litigation is pending before Judge Albright in the Western District of Texas. The USPTO's March 24, 2025, Guidance on the Recission of the Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation states that “in applying *Fintiv*, the Board may consider any evidence that the parties make of record that bears on the proximity of the district court's trial date[.]” *Guidance*, at 3. Viewed collectively, the median time

⁵ Likewise, Ex. 1045 shows that *all* of PO's familial patents are inactive, either from non-payment of maintenance fees, post-grant invalidity proceedings, rejections in prosecution, or natural term expiration. Petitioner expected non-enforcement of the challenged patent.

from filing to trial in patent cases before Judge Albright is ~34 months, consistent with the district-wide time to trial statistics. Applying that time period to the parallel litigation, the final written decision in this proceeding is due 5 months prior to when the parallel litigation will go to trial. *Fintiv* Factor 2, therefore, weighs against discretionary denial.

On October 11, 2024, Judge Albright entered a scheduling order setting trial for June 8, 2026. Ex. 2008. However, Judge Albright’s busy docket is regularly the cause of trial re-scheduling. *See e.g., AlmondNet, Inc. et al. v. Amazon.com Inc. et al.*, 6-21-cv-00898, Dkt. 235 (delaying trial from February 5, 2024 to June 10, 2024—docket entry stating “trial date of 2/5 cannot be maintained due to the Court’s schedule”); Dkt. 238 (Order) (Ex. 1048); *IOEngine, LLC v. Roku Inc.*, 6:21-cv-01296 Dkt. 309 (Judge Albright explaining that due to trial date conflicts, “it makes more sense” to move the October 16, 2023 trial setting to the spring of 2024 because of the Court’s trial schedule) (Ex. 1047).

This is borne out by the most recent statistics for the Western District of Texas, which shows the median time from filing to trial for Judge Albright’s cases was 34.1 months, just above the median time from Filing to Trial in civil cases filed in the Western District of Texas: 33.4 months. Ex.1046. Accordingly, based on both

Judge Albright’s and the Western District’s median time to trial, the trial in the parallel proceeding here is projected to take place around April 2027—10 months after the currently scheduled trial date and five months after a FWD.

Given Judge Albright’s alignment of his time-to-trial statistics with those of the Western District overall, the evidence shows there is “a high likelihood” that the final written decision in this case will issue months before trial in the parallel district court litigation. *See iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 2 (PTAB June 6, 2025) (finding a high likelihood of a stay where the Petitioner cited specific, recent cases from its Judge regularly granting stays under similar circumstances). Thus, *Fintiv* Factor 2 weighs against discretionary denial.

(d) Apple’s Broadened *Sotera*+ Stipulation Mitigates Any Remaining Overlap Concerns Between this IPR and the Litigation.

To mitigate the possibility that there will be overlap between the issues in this proceeding and the parallel litigation, Apple filed a broadened *Sotera*+ stipulation. If the PTAB institutes this proceeding, Apple’s stipulation precludes it from pursuing in the parallel litigation against the claims challenged in this IPR:

(i) the specific grounds raised in [this IPR], (ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e., any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed

publications), or (iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in [this IPR], as reflected in the table summarizing the Statutory Grounds for Challenges on page 4 of the Petition.

Ex. 1043, 1. Thus, Apple’s stipulation negates *any* concern that any issue before the Board in this proceeding will be relitigated in the parallel proceeding. *Fintiv* Factor 4, therefore, weighs strongly against discretionary denial. *See, e.g., Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217 Paper 9 at 2 (PTAB June 13, 2025) (finding that Tesla’s broad *Sotera+* stipulation “counsel[s] against discretionary denial”).

PO nonetheless contends that *Fintiv* Factor 4 favors discretionary denial because Apple’s broadened *Sotera+* stipulation “has several deficiencies.” *DD Request*, 12. PO’s contention lacks merit. First, PO argues that “Petitioner has not specified what grounds it could have reasonably raised under §§ 102 or 103[.]” *Id.* at 12–13. Such specification is unnecessary. What grounds Apple could have reasonably raised in this proceeding is dictated by 35 U.S.C. § 315(e)(2), the scope of which is well-established under controlling law. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365–67 (Fed. Cir. 2025). Thus, Apple’s stipulation is not deficient for failing to specify the specific grounds that fall under the “reasonably raised” stipulation.

Second, PO argues that “Petitioner has not asserted any ground based on a combination of system prior art and the references asserted as part of a ground in the instant IPR.” *DD Request*, 13. But that Apple has not presented any such grounds itself weighs against discretionary denial. Apple’s stipulation further confirms that it would not attempt to amend its invalidity contentions to assert any such grounds in the parallel proceeding.

Finally, PO argues that “Petitioner has not specified what system art prior art theories it has asserted in the district court litigation are coextensive with the prior art it has presented to the Board.” *Id.* Again, PO’s argument lacks merit. Apple’s stipulation states that it will not pursue system art theories that are *coextensive with* the prior art Apple has presented to the Board. Thus, in this case, Apple’s stipulation precludes it from relying on any systems in the parallel litigation that are commercial embodiments of any of *Himmel*, *King*, or *Boyle*. Pet., 4.

In sum, Apple’s broadened *Sotera*+ stipulation clearly informs PO and the Court of the invalidity grounds it will not pursue in the parallel litigation. The language of Apple’s stipulation is also consistent with other *Sotera* and *Sotera*+ stipulations the Board and the Director have found mitigate the risk of overlap and weigh against discretionary denial. *See, e.g., Tesla*, Paper 9 at 2; *Samsung Elecs.*

Am., Inc. v. Collision Commc'ns, Inc., IPR2025-00011, Paper 12 at 22 (PTAB Apr. 28, 2025) (“Petitioner’s broad stipulation mitigates certain concerns of duplicative efforts...as well as concerns of potentially conflicting decisions”). *Fintiv* Factor 4 strongly weighs against discretionary denial. *Id.*

IV. CONCLUSION

For at least these reasons, Apple respectfully requests the Board deny PO’s request for discretionary denial.

Respectfully submitted,

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COUNSEL FOR PETITIONER

APPENDIX OF EXHIBITS

Exhibit 1001	U.S. Patent No. 8,271,877 (“’877 Patent”)
Exhibit 1002	File History of the ’877 Patent (the “’877 File History”)
Exhibit 1003	Declaration of Dr. Ben Bederson (“Dec.”)
Exhibit 1004	U.S. Patent No. 6,119,155 to Rossmann et al. (“Rossmann”)
Exhibit 1005	U.S. Patent No. 6,037,934 to Himmel et al. (“Himmel”)
Exhibit 1006	U.S. Patent No. 6,353,839 to King et al. (“King”)
Exhibit 1007	U.S. Patent No. 6,138,158 to Boyle et al. (“Boyle”)
Exhibit 1008	<i>Intentionally Left Blank</i>
Exhibit 1009	U.S. Patent Publication No. 2001/0044299 to Sandegren (“Sandegren”)
Exhibit 1010	David Pogue, <u>Palm Pilot: The Ultimate Guide</u> , O’Reilly and Associates, Inc. (1998) (“Pogue”)
Exhibit 1011	Martin Skegg and Michael Oliveria-Salac inspect the tiny tools of global communication, The Independent, Newspapers.com, London, Greater London, England (May 8, 1999) (“The Independent”)
Exhibit 1012	Nokia Mobile Phones, User’s Guide, 9352062 Issue 2, (1999) (“Nokia”)
Exhibit 1013	U.S. Patent No. 6,363,419 to Martin, Jr. et al. (“Martin, Jr.”)
Exhibit 1014	HDML 2.0 Specification, (April 11, 1997) (“HDML Spec”)
Exhibit 1015	Mark Brown, et al., <u>Special Edition Using Netscape 2</u> , Que, (1995) (“Brown”)
Exhibit 1016	Douglas A. Downing, Ph.D, et al., <u>Dictionary of Computer and Internet Terms, Tenth Edition</u> , Barron’s Educational Series, Inc., (2009) (“Barron’s 2009”)
Exhibit 1017	Hy Bender, et al., <u>Dummies 101: The Internet for Windows 98</u> , IDG Books Worldwide, (1998) (“Bender”)
Exhibit 1018	U.S. Patent No. 6,718,310 to Fuisz et al. (“Fuisz et al.”)
Exhibit 1019	U.S. Patent No. 6,338,050 to Conklin et al. (“Conklin et al.”)
Exhibit 1020	Benjamin B. Bederson, et al., A Zooming Web Browser (1996) (“Bederson”)
Exhibit 1021	Ron R. Hightower, et al., PadPrints: Graphical Multiscale Web Histories, UIST (1998) (“Hightower”)

Exhibit 1022	Douglas Downing, Ph.D., et al., <u>Dictionary of Computer and Internet Terms</u> , Fifth Edition, Barron's Business Guides, (1996) (" <i>Barron's 1996</i> ")
Exhibit 1023	Donald Spencer, <u>Webster's New World Dictionary of Computer Terms</u> , Fifth Edition, Macmillan General Reference (1994) (" <i>Spencer</i> ")
Exhibit 1024	U.S. Patent No. 6,237,080 to Mäkinen (" <i>Mäkinen</i> ")
Exhibit 1025	U.S. Patent No. 5,781,909 to Logan, et al. (" <i>Logan</i> ")
Exhibit 1026	<i>Intentionally Left Blank</i>
Exhibit 1027	<i>Intentionally Left Blank</i>
Exhibit 1028	<i>Intentionally Left Blank</i>
Exhibit 1029	U.S. Patent No. 6,456,303 to Walden, et al. (" <i>Walden</i> ")
Exhibit 1030	U.S. Patent No. 5,809,415 to Rossmann (" <i>Rossmann Parent</i> ")
Exhibit 1031	U.S. Patent No. 6,182,010 to Berstis (" <i>Berstis</i> ")
Exhibit 1032	U.S. Patent No. 10,943,058 to Allani (" <i>'058 Patent</i> ")
Exhibit 1033	File History of the '058 Patent (the " <i>'058 File History</i> ")
Exhibit 1034	<i>FERID ALLANI vs. APPLE, INC.</i> , Case No. 6:24-cv-00304-ADA (WDTX, Dkt. No. 1) (" <i>Complaint</i> ")
Exhibit 1035	<i>FERID ALLANI vs. APPLE, INC.</i> , Case No. 6:24-cv-00304-ADA Plaintiff's Preliminary Infringement Contentions with Exhibit (" <i>Plaintiff's Preliminary Infringement Contentions</i> ")
Exhibit 1036	<i>FERID ALLANI vs. APPLE, INC.</i> , Case No. 6:24-cv-00304-ADA (WDTX, Dkt. No. 21) (" <i>Apple Opening Markman Brief</i> ")
Exhibit 1037	<i>FERID ALLANI vs. APPLE, INC.</i> , Case No. 6:24-cv-00304-ADA (WDTX, Dkt. No. 18) (" <i>Scheduling Order</i> ")
Exhibit 1038	U.S. Patent No. 6,526,424 to Kanno, et al. (" <i>Kanno</i> ")
Exhibit 1039	U.S. Patent No. 6,169,897 to Kariya (" <i>Kariya</i> ")
Exhibit 1040	<i>FERID ALLANI vs. APPLE, INC.</i> , Case No. 6:24-cv-00304-ADA (WDTX, Dkt. No. 23) (" <i>Responsive Claim Construction Brief</i> ")
Exhibit 1041	<i>FERID ALLANI vs. APPLE, INC.</i> , Case No. 6:24-cv-00304-ADA (WDTX, Dkt. No. 24) (" <i>Reply Claim Construction Brief</i> ")
Exhibit 1042	<i>FERID ALLANI vs. APPLE, INC.</i> , Case No. 6:24-cv-00304-ADA (WDTX, Dkt. No. 25) (" <i>Surreply Claim Construction Brief</i> ")
Exhibit 1043	Petitioner Apple Inc.'s Notice of Broadened Sotera Plus Stipulation

Exhibit 1044	International Publication No. WO99/17229 to Kanno, Fujitsu Limited April 8, 1999
Exhibit 1045	Legal Status of Patent Family of FR2803929
Exhibit 1046	United States District Courts — National Judicial Caseload Profile
Exhibit 1047	Pretrial Conference Transcript <i>Ioengine, LLC v. Roku Inc.</i> Case No. 6:21-cv-1296, U.S. Dist. Ct. (W.D. Tex)
Exhibit 1048	Order Cancelling Jury Selection and Trial, <i>Almondnet, Inc. v. Amazon.com, Inc.</i> , Case No. 6:21-cv-00898-ADA, U.S. Dist. Ct., (W.D. Tex)
Exhibit 1049	U.S. Patent No. 5,877,765 to Dickman, et al.
Exhibit 1050	U.S. Patent No. 5,963,964 to Nielsen
Exhibit 1051	Conclusions D’Intimes No 2, RG: 23/01389

**CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.105**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105, the undersigned certifies that on August 22, 2025 August 22, 2025, a complete and entire copy of this *Opposition to Patent Owner's Request for Discretionary Denial* was served by emailing counsel of record for Patent Owner:

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BY: /s/ Adam P. Seitz
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