

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

TOPWIRE LLC
Patent Owner

Case No. IPR2026-00303
U.S. Patent No. 9,859,202

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

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I. INTRODUCTION

On May 28, 2026, Petitioner filed a broad *Sotera*-plus stipulation eliminating all IPR-eligible grounds and any system art based on the same evidence presented here. Paper 7 at 1. Patent Owner’s reply does not show that the stipulation is too narrow or too late.

II. ARGUMENT

A. Petitioner’s *Sotera*-Plus Stipulation Eliminates Overlap

Petitioner’s broad stipulation eliminates every category of overlapping invalidity ground. It bars “the specific grounds [asserted in IPR2026-00303],” “any other ground that was raised or could have been reasonably raised in an IPR,” and “any product or system that is ‘based on the same evidence presented’ in this IPR.” Paper 7 at 1. That is even broader than the type of stipulation *Sotera* held “mitigates any concerns of duplicative efforts” and ensures IPR is a “true alternative” to litigation. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential).

Patent Owner alleges that the stipulation is “unclear [as to] what specific combinations” are precluded. Paper 10 at 3. But Petitioner cited *SAP America, Inc. v. Cyandia, Inc.* precisely to address that concern: if review is instituted, Petitioner will not advance any invalidity challenge in the district court that relies on (1) any combination that is purely based on patents and printed publications and (2) any

system art that is based on the same evidence as the prior art relied upon in the IPR—namely the teachings of Chen, Sun, Wu, and Furuta guised as system art. Paper 7 at 1; IPR2024-01496, Paper 13 at 9 (PTAB Apr. 7, 2025). This broad stipulation ensures that no duplication of effort exists between the IPR and the district court.

Patent Owner argues that the Board has denied institution with similarly worded stipulations. Paper 10 at 3. But none of those decisions even remotely discuss the stipulations as a basis for discretionary denial. In *Hisense USA Corp. v. Light Guide Innovations LLC*, the case was discretionarily denied in a summary notice without a detailed explanation. See IPR2025-01538, Paper 9 (Director Jan. 16, 2026). In *Samsung Elecs. Co., Ltd. et al. v. GenghisComm Holdings, LLC*, the Board discretionarily denied institution based on the trial date and a lack of evidence of a stay. IPR2025-00899, Paper 10 at 2 (PTAB Sept. 26, 2025). In *TankLogix, LLC v. SitePro, Inc.*, the Director discretionarily denied institution primarily because three of the four references were already considered by the examiner during original prosecution. See IPR2025-00761, Paper 10 at 2-3 (Director Sept. 3, 2025). No authority supports denial based on Petitioner’s stipulation here.

B. The Stipulation’s Timing Does Not Support Discretionary Denial

Patent Owner’s timing argument is also without merit. At the outset, Patent Owner has now filed a three-page Reply addressing the stipulation, eliminating any claim of prejudice. Paper 10.

Second, Patent Owner attempts to downplay the *Wybotics* holding by arguing that “[n]o such facts [demonstrating that the Office materially erred during prosecution] are present here.” Paper 10 at 2. But Petitioner already demonstrated how the Office materially erred during prosecution in Petitioner’s Opposition brief. *See* Paper 8 at 4–7.

Finally, Patent Owner’s reliance on *Samsung Elecs. Co., Ltd. v. Netlist, Inc.* is misplaced. There, a parallel ITC case—scheduled to precede the final written decision—was ongoing and the stipulation was “ineffective because it does not bind Petitioner’s co-respondents.” IPR2026-00018, Paper 20 at 3 (Director Apr. 28, 2026). Here, there is no scheduled trial date and Apple is the only named defendant in the parallel district court litigation.¹

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Director review the Petition on the merits based on a holistic assessment of all evidence.

¹ TopWire initiated another lawsuit against Samsung and Samsung filed IPR2026-00324 challenging the same ’202 Patent. TopWire concedes that Samsung already filed a stipulation in that IPR as well. Paper 10 at 1.

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Sur-Reply to Request for Discretionary Denial

Dated: June 26, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on June 26, 2026 a complete copy of the foregoing **Petitioner's Sur-Reply to Patent Owner's Discretionary Denial Brief** was served on counsel of record for the Patent Owner by filing the documents through P-TACTS and by sending via electronic mail to the following addresses:

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Dated: June 26, 2026

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