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571-272-7822

Paper 11
Date: September 5, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLE INC.,
Petitioner,

v.

FERID ALLANI,
Patent Owner.

IPR2025-00856 (Patent 8,271,877 B2)
IPR2025-00857 (Patent 10,943,058 B2)

Before COKE MORGAN STEWART, *Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office*.

DECISION
Referring the Petitions to the Board

Ferid Allani ("Patent Owner") filed a request for discretionary denial (Paper 7, "DD Req.") in the above-captioned cases, and Apple Inc. ("Petitioner") filed an opposition (Paper 8, "DD Opp.").[1]

After considering the parties' arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in this proceeding. This determination is based on the totality of the evidence and arguments the parties have presented.

Some considerations favor discretionary denial. In particular, the projected final written decision due date in the Board proceedings is November 22, 2026. DD Req. 7–8. The district court's scheduled trial date is June 8, 2026. *Id*. As such, it is unlikely that a final written decision in these proceedings will issue before district court trial occurs. The parties offer conflicting time-to-trial statistics that suggest trial could begin as early as August 2026 or as late as April 2027. *Id*. at 8; DD Opp. 17–18. Additionally, there is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial. Further, the parties have made meaningful investment in the district court proceeding. DD Req. 9. For example, the district court has issued a *Markman* order and each party served responses to requests for written discovery. *Id.* Final infringement and invalidity contentions also were due July 24, 2025. *Id.* (citing Ex. 2015). Even though a district court trial date that may occur after a projected final written decision date reduces the possibility of conflicting decisions, that benefit does not outweigh the efficiencies gained by avoiding parallel proceedings in this instance because of the parties' meaningful

[1] Citations are to papers in IPR2025-00856. The parties filed similar papers in IPR2025-00857.

investment in the district court proceeding discussed above. Additionally, the challenged patent in IPR2025-00856 has been in force for thirteen years, creating strong settled expectations for Patent Owner.

Other considerations counsel against discretionary denial. For example, Petitioner acknowledges that it was aware of the challenged patent in IPR2025-00856 in 2012, when Patent Owner first contacted Petitioner about the challenged patent in a letter. DD Opp. 14. Petitioner, however, contends that it "did not expect enforcement" of the patent challenged in IPR2025-00856 because it concluded that it did not require a license to the patent and advised Patent Owner of its position, and because Patent Owner did not assert the challenged patent against Petitioner until eleven years after the parties' discussion about that patent. *Id.*; *cf DataDome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 14, 2–3 (Director Aug. 14, 2025) (Patent Owner asserted the patent two years after the parties' discussion). Additionally, Patent Owner did not assert the challenged patents against Petitioner until after they expired. Under these circumstances, discretionary denial is not appropriate.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are referred to the Board to handle the cases in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *denied*;

FURTHER ORDERD that the Petitions are referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

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