

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.

GINKO LLC,
Patent Owner.

IPR2025-01388
Patent 11,025,573 B1

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

Apple Inc. (“Petitioner”) filed a petition requesting review of claims 1, 3, 4, 6–12, 14, and 15 of U.S. Patent No. 11,025,573 (“the ’573 patent”). Paper 1 (“Petition” or “Pet.”). Ginko LLC filed a preliminary response. Paper 10. After considering the arguments presented and the record, and in view of all relevant considerations, denial of institution was appropriate in this proceeding. *See* Paper 13 (“Notice”), 2. This determination was based on the totality of the evidence and arguments presented, only a select portion of which I discuss in the following opinion identified as forthcoming in the Notice. *See id.*

As explained below, Petitioner does not sufficiently show that the asserted prior art discloses the subject matter of the challenged claims. Petitioner first asserts that independent claim 10 is unpatentable as obvious over U.S. Patent No. 8,380,796 (Ex. 1004, “Robertson”). Pet. 2, 5–28. Claim 10 recites, in part, “receiving, from the user device of the user, a request for the user to become a contact with the potential contact.” Ex. 1001, 18:12–13. Claim 10 further recites “the request comprising a first permission setting.” *Id.* at 18:15. Petitioner contends that Robertson discloses this limitation. Pet. 15. Petitioner explains that, according to Robertson, “[t]he users are presented with GUI 600 [illustrated in Figure 9] that allows each user to set permission settings for the other user that defines the types of information each user can see about the other user.” *Id.* at 15. According to Petitioner, as shown in GUI 600, “the first user selected permission levels 600-6, 600-10, 600-12, and 600-14 for the second user John Doe.” *Id.* at 16. Petitioner asserts that “[t]he selected permission levels define a *first permission setting* for the second user.” *Id.* at 16.

Petitioner’s arguments are not persuasive. Petitioner fails to show that Robertson discloses that the request to become a contact with a potential contact includes a first permission level for the potential contact. In other words, Petitioner does not establish that any of the cited passages in Robertson disclose that the request includes a first permission setting. *See* Pet. 15–17 (citing Robertson, 7:42–45, 7:55–58, 8:10–17, 8:23–24, Fig. 9). In particular, each passage is silent as to when the permission levels are set. At most, Robertson discloses specifying permissions after contact has been established. *See* Robertson, 7:50–53. But Petitioner fails to account for the claim requirement that the first permission level is part of the request to establish contact. “In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). Furthermore, Petitioner must explain with particularity how the prior art would have rendered the challenged claims unpatentable. 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104(b)(4) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”). “The IPR petition, thus, must provide an understandable explanation of the element-by-element specifics of the patentability challenges, including the identification of particular portions of prior art on which the petitioner is relying.” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1001 (Fed. Cir. 2023).

The remainder of Petitioner's challenges suffer from similar deficiencies throughout. *See, e.g.* Pet. 37–38 (failing to show that Ahuja (Ex. 1005) discloses that the request to become a contact includes a permission setting), 53, 68–69.

Accordingly, it is:

ORDERED that the Petition is *denied*, and no trial is instituted.

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