

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
SAMSUNG ELECTRONICS CO., LTD.,

Petitioners,

v.

COBBLESTONE WIRELESS, LLC,

Patent Owner.

Case IPR2024-00315
Patent No. 9,094,888

PETITIONERS' MOTION TO WITHDRAW *SOTERA* STIPULATION

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. (“Petitioners”) respectfully submit this Motion to Withdraw their conditional *Sotera* Stipulation (Paper 8) filed on May 7, 2024, and to replace it with the stipulation made by Petitioners and real parties-in-interest (the “Carriers”) in *T-Mobile USA, Inc., et al. v. Cobblestone Wireless LLC*, IPR2024-00137. This replacement stipulation will state, just as the Carriers’ did, that, if this proceeding is instituted, Petitioners “will not pursue invalidity against the asserted claims in the district court using the specific combination of prior art references set forth in the grounds presented in this Petition for purposes of establishing obviousness.” See Carriers’ IPR, Paper 1 at 62.¹ Petitioners bring this motion because, despite only presenting a *Sand Revolution*-style stipulation, the Carriers’ IPR presented a compelling, meritorious case that overcame the other *Fintiv* factors. It would therefore be illogical for Petitioners to be subject to a broader stipulation than the RPI Carriers’ if they become co-Petitioners in the joined proceeding. Petitioners’ motion is appropriate because the *Sotera* stipulation was conditioned on the institution of this

¹ Counsel for Petitioners has conferred with the Carriers and they do not object to this motion.

proceeding, which has not yet occurred—the stipulation expressly states that Petitioners will not raise in the litigation prior art it raises here or reasonably could have raised “*if the Board institutes inter partes* review in this proceeding.” Moreover, there is no prejudice to Patent Owner here. As it conceded during the June 5 hearing, Patent Owner has addressed *Fintiv* in its Preliminary Response, and no further *Fintiv* briefing will be required if this motion is granted.

II. STATEMENT OF MATERIAL FACTS

1. On December 15 and 16, 2022, Patent Owner brought lawsuits against the Carriers in the Eastern District of Texas. On June 16, 2023, Patent Owner brought a lawsuit against Petitioners in the Eastern District of Texas.

2. On November 22, 2023, in IPR2024-00137, the Carriers filed a petition for *inter partes* review against the ’888 Patent. The Carriers stipulated that if their IPR were instituted, they would “not pursue invalidity against the asserted claims in the district court using the specific combination of prior art references set forth in the grounds presented in this Petition for purposes of establishing obviousness.” Carriers’ IPR, Paper 1 at 62.

3. On December 18, 2023, Petitioners filed the instant Petition, which is substantively identical to the Carriers’ Petition.

4. On May 7, 2024, Petitioners filed a *Sotera* stipulation in the instant proceeding, stipulating that “if the Board institutes *inter partes* review in this

proceeding, IPR2024-00315, then Petitioners will not pursue in the parallel litigation, *Cobblestone Wireless, LLC v. Samsung Electronics Co., Ltd. et al.*, No. 2:23-cv-00285 (E.D. Tex.), the same grounds in the Petition (Paper 3) or any grounds that could have reasonably been raised before the Board.” Paper 8.

5. On May 22, 2024, the Board instituted the Carriers’ IPR. Carriers’ IPR, Paper 15. In its Institution Decision, the Board declined to exercise its discretion to deny under *Fintiv* finding that, despite three factors weighing in favor of discretionary denial and the Carriers’ *Sand Revolution* stipulation weighing “marginally against discretionary denial,” the Petition “presents a compelling, meritorious challenge for independent claim 9.” *Id.* at 14-16.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

The Board should grant Petitioners’ motion because: (1) Petitioners’ *Sotera* stipulation is a unilateral, conditional offer between Petitioners and the Board, and the condition has not yet been met, (2) granting the motion would place no additional burden on the Board, and (3) there is no prejudice to Patent Owner.

First, the *Sotera* stipulation is expressly conditioned on institution. Paper 8 (“**[I]f** the Board institutes *inter partes* review in this proceeding ...). Petitioners’ conditional *Sotera* stipulation is a unilateral offer to the Board that, if the Board institutes the Petition, Petitioner will forego its right to pursue in the parallel litigation the same grounds or any grounds it could reasonably have raised. Because

the conditional offer has not yet been accepted, just like any other unilateral offer, it may be unilaterally withdrawn. *Shuey v. United States*, 92 U.S. 73, 76-77 (1876) (“Like any other offer of a contract, it might, therefore, be withdrawn before rights had accrued under it”). If the Board does not allow withdrawals of prior art stipulations, the stipulation would be binding as of its filing date.² This would be contrary to the Director’s mandate to “strike[] a balance among the competing concerns of avoiding potentially conflicting outcomes, avoiding overburdening patent owners, and ***strengthening the patent system by eliminating patents that are not robust and reliable.***” Director’s June 21, 2022 Memorandum at 5.

In addition, there is no authority that forbids a Petitioner from withdrawing a *Sotera* stipulation before institution. To the contrary, in one proceeding, the Board expressly recognized that the Petitioner could “effectively withdraw[] this stipulation by asserting that they are basing their invalidity arguments” contrary to the stipulation. IPR2023-00228, Paper 10 at 11 n.3.

Second, withdrawal would pose no burden to the Board. As Patent Owner admits, the *Fintiv* issue has been fully briefed. Moreover, the Board has already decided that the Carriers’ IPR presents a particularly “compelling, meritorious

² At the telephonic hearing, Patent Owner expressly proposed that Petitioners cannot withdraw its stipulation because it is binding on the date of filing.

challenge” that warrants institution despite the fact that the Carriers’ district court trial will decide similar issues of invalidity *eight* months before the Board’s Final Written Decision. Carriers’ IPR, Paper 15 at 14-16. And the calculus in this proceeding presents a more compelling case: Petitioners’ trial date of May 5 will be *less than a month* before the Board’s Final Written Decision in the Carriers’ IPR.

Third, there would be no prejudice to Patent Owner. Petitioners’ stipulation is a unilateral offer to the Board, conditioned on institution. Patent Owner had no say in how or whether Petitioner makes this offer. Thus, granting this motion would simply place Patent Owner in the same position as it is in the Carriers’ IPR. And since Patent Owner must already bear the cost of defending against the Carriers’ invalidity case in the litigation, there would be little cost to defending against Petitioners’ invalidity case, especially where the prior art overlaps. Moreover, the burden of multiple litigations is entirely of Patent Owner’s making: Patent Owner deliberately chose to file its complaints six months apart and deliberately chooses not to move to consolidate the cases.

Finally, Patent Owner’s opposition to withdrawal is plainly inconsistent with its request in IPR2024-00317 to require Petitioners, who filed no stipulation at all in that case, to be bound by the Carriers’ *Sand Revolution*-style stipulation in IPR2024-00135. See IPR2024-00317, Paper 9 at 3. Patent Owner cannot credibly argue that consistency is necessary in one case but not here.

Date: June 10, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that on June 10, 2024 the foregoing document was served via email on the following counsel of record:

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Dated: June 10, 2024

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