

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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SAMSUNG ELECTRONICS AMERICA, INC.,

SAMSUNG ELECTRONICS CO., LTD.,

Petitioners,

v.

COBBLESTONE WIRELESS, LLC,

Patent Owner.

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Case No. IPR2024-00315

U.S. Patent No. 9,094,888

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**PETITIONERS' REPLY TO PATENT OWNER'S OPPOSITION TO  
PETITIONERS' MOTION TO WITHDRAW ITS *SOTERA* STIPULATION**

## EXHIBIT LIST

| Ex.       | Description                                                                                                                                                  |
|-----------|--------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1001      | U.S. Patent No. 9,094,888 (“888 Patent”)                                                                                                                     |
| 1002      | Prosecution History for 9,094,888                                                                                                                            |
| 1003      | U.S. Patent Publication No. 2006/0111149A1 (“Chitrapu”)                                                                                                      |
| 1004      | Intentionally Omitted                                                                                                                                        |
| 1005      | Expert Declaration of James Proctor                                                                                                                          |
| 1006      | Expert Declaration of Benoist Sébire on the Prior Art Status of TS 36.300                                                                                    |
| 1007      | IBM International Technical Support Organization, <i>An Introduction to Wireless Communications</i> , 2d ed. (October 1995)                                  |
| 1008      | Taylor, M.S. et al., <i>Internet Mobility: The CDPD Approach</i> (June 11, 1996)                                                                             |
| 1009      | Steele et al., <i>GSM, cdmaOne and 3G Systems</i> (2001)                                                                                                     |
| 1010      | Sesia, S. et al., <i>LTE – The UMTS Long Term Evolution</i> , 2d ed. (2011)                                                                                  |
| 1011      | 3GPP 23.401 V10.3.0 (March 2011)                                                                                                                             |
| 1012      | <i>Cobblestone Wireless, LLC v. T-Mobile USA, Inc.</i> , No. 2:22-cv-00477-JRG-RSP (Lead Case), Dkt. 62, Docket Control Order                                |
| 1013      | Katherine K. Vidal, <i>Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation</i> (June 21, 2022) |
| 1014-1200 | Intentionally Omitted                                                                                                                                        |
| 1201      | 3GPP Partnership Project Description                                                                                                                         |
| 1202      | 3GPP Working Procedures 2022                                                                                                                                 |

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| 1203 | Introducing 3GPP Webpage                                                                                 |
| 1204 | Recommendation for IPv6 in 3GPP Standards (Archived)                                                     |
| 1205 | Myung, H. & Goodman, D., <i>Single Carrier FDMA – A New Air Interface for Long Term Evolution</i> (2008) |
| 1206 | RAN WG2 Homepage                                                                                         |
| 1207 | RAN2 Meeting #73 (Taipei) Participants List                                                              |
| 1208 | 3GPP FAQs (Archived Webpage - 2008)                                                                      |
| 1209 | 3GPP Specifications (Archived Webpage - 2008)                                                            |
| 1210 | 3GPP Homepage (Archived Webpage - 2009)                                                                  |
| 1211 | 3GPP Index of ftp Specs (Archived Webpage - 2008)                                                        |
| 1212 | 3GPP Specification Numbering (Archived Webpage - 2008)                                                   |
| 1213 | 3GPP Specification Series (Archived Webpage - 2008)                                                      |
| 1214 | 3GPP Version Numbering Scheme (Archived Webpage - 2008)                                                  |
| 1215 | Hillebrand, F., ed., <i>GSM and UMTS: The Creation of Global Mobile Communication</i> (2002)             |
| 1216 | 3GPP Partners Webpage                                                                                    |
| 1217 | 3GPP Homepage (Archived Webpage – February 2011)                                                         |
| 1218 | 3GPP Advanced Search (Archived Webpage – March 2011)                                                     |
| 1219 | 3GPP FTP Index (Archived Webpage – 2008)                                                                 |
| 1220 | 3GPP FTP RAN WG (Archived Webpage – 2008)                                                                |
| 1221 | 3GPP FTP TSG_RAN WG2_RL2 (Archived Webpage – 2008)                                                       |
| 1222 | 3GPP FAQs Webpage                                                                                        |
| 1223 | 3GPP TS 36.300 V10.3.0                                                                                   |

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| 1224 | 3GPP FTP TS 36.300 Directory Listing                                                                                                             |
| 1225 | 3GPP FTP TS 36.300 (Archived Webpage - 2014)                                                                                                     |
| 1226 | RP-110855, Report of 3GPP TSG RAN meeting #51                                                                                                    |
| 1227 | 3GPP Specification by Series                                                                                                                     |
| 1228 | 3GPP Directory Listing of Final Specifications After RAN#51                                                                                      |
| 1229 | <i>Curriculum Vitae</i> of James Proctor                                                                                                         |
| 1230 | <i>Cobblestone Wireless, LLC v. Samsung Electronics Co., Ltd.</i> , No. 2:22-cv-00285-JRG-RSP, Dkt. 29-1, Docket Control Order                   |
| 1231 | <i>Cobblestone Wireless, LLC v. Samsung Electronics Co., Ltd.</i> , No. 2:22-cv-00285-JRG-RSP, Dkt. 55, Plaintiff's Notice of Sotera Stipulation |

Patent Owner has done everything it can to manufacture a dispute here. **Two days** after the parties’ telephonic conference with the Board, **Patent Owner** filed a “Notice of *Sotera* Stipulation” with the District Court, including a copy of Petitioners’ stipulation. It did so without there being any need or request for such notice in the District Court. In the notice itself, Patent Owner admits that “[o]ther than filing a copy of the stipulation in the record, ***no other relief*** is sought by [Patent Owner] at this time.” Ex. 1231 at 2. Patent Owner, however, did not inform the Court that institution was still pending or that, just days earlier, the Board had authorized the parties to brief whether Petitioners could withdraw the stipulation. The sole purpose of Patent Owner’s filing was to serve as a bootstrap for its argument that the Board lacks jurisdiction. But there is no District Court ruling here that would or could divest the Board of jurisdiction. Rather, Patent Owner attempts to rely on its own unsolicited filing. Its arguments are plainly without merit.

To make matters worse, the Response relies almost exclusively on a single case to support its jurisdictional argument—*Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274 (Fed. Cir. 2023). Patent Owner argues that this case decided “whether a District Court, not the PTAB, correctly enforced a *Sotera* stipulation.” Opp. 3. That case, however, had ***nothing to do*** with a *Sotera* stipulation or who enforced it. Indeed, the IPR in that case instituted in 2016, ***years before*** the Board’s decisions

in *Fintiv* and *Sotera*. *Ironburg* is a decision about the IPR estoppel under 35 USC § 315(e), not about *Sotera* stipulations.

Finally, Patent Owner’s ominous warnings about the Constitution and separation of powers cannot be reconciled with its argument in IPR2024-00317 that it would be “appropriate” for ***the Board alone*** to require Petitioners to be “bound by the Carrier’s *Sand Revolution* stipulation” when Petitioners had made no such stipulation. IPR2024-00317, Paper 10 at 2.

The fact that Patent Owner resorts to procedural gamesmanship and mischaracterizing the applicable law is telling. So too is the fact that, on the merits, Patent Owner completely ignores the primary point in Petitioners’ brief, that Petitioners’ stipulation is conditioned on institution and thus not in effect. The Board should allow Petitioners to replace its *Sotera* stipulation with the Carriers’ *Sand Revolution*-style stipulation. To be clear, Petitioners motion for joinder is not contingent on this motion.

## **I. THE BOARD HAS JURISDICTION**

Petitioners’ *Sotera* stipulation is a promise by Petitioners ***to the Board*** that does not involve the District Court or the Patent Owner unless and until the Board institutes this proceeding. The *Sotera* stipulation is a creation of the Board and has the effect of removing ***the Board’s discretion*** to deny under *Fintiv*. Patent Owner simply ignores the conditional nature of the *Sotera* stipulation.

First, Patent Owner contends it is the District Court that has the jurisdiction to enforce the *Sotera* stipulation, not the Board. Patent Owner ignores, however, that there is nothing to enforce until there has been an institution. Petitioners' *Sotera* stipulation is clear on its face that it is a *conditional* promise to forego seeking certain prior art, "***if the Board institutes.***" Paper 8. Thus, there is nothing for the District Court to enforce and the proper forum to seek modification is the Board—as plainly recognized by Patent Owner's own filing before the District Court seeking "no other relief." Ex. 1231 at 2. Patent Owner fails to address this point at all, and does not even attempt to distinguish the decision Petitioner cited in its brief.

Patent Owner instead relies heavily on *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274, 1298 (Fed. Cir. 2023). But *Ironburg* has nothing to do with *Sotera* stipulations, as even the most cursory review of that decision reveals. Indeed, the IPR proceeding in *Ironburg* was instituted in 2016 and completed in 2017, ***years before*** the Board's decisions in *Fintiv* and *Sotera*. Undeterred by this fact, Patent Owner falsely characterizes *Ironburg* as a "ruling on whether a District Court, not the PTAB, correctly enforced a *Sotera* stipulation." Opp. 3. But a simple word search would have indicated that the decision never mentions *Sotera*. Rather, *Ironburg* is a well-known decision on estoppel under 35 USC § 315(e). The decision found Patent Owners have the burden of establishing that a Defendant "reasonably could have raised" asserted art during the IPR in dealing with estoppel based on a

final written decision—not based on a stipulation conditioned on institution. *Ironburg*, 64 F.4th at 1297-98. It says nothing about the Board’s authority and certainly did not rule on *Sotera*, as Patent Owner misrepresents to this Board. Opp. 3 (arguing that *Ironburg* held that “Samsung must file a motion before Judge Gilstrap” to modify a *Sotera* stipulation, that the Board cannot “enforce[] a *Sotera* stipulation,” and that the Board “is not the proper forum.”).

*Second*, Patent Owner also incorrectly argues that “[t]he proper process for giving effect to stipulations is to file them with the District Court.” Opp. 2. The effect of a stipulation is to alter the Board’s *Fintiv* analysis—in the case of a *Sotera* stipulation, to remove the question entirely from the Board’s discretion. Thus, the proper process is to make the stipulation ***before the Board***. It is ***the Board*** that gives effect to the stipulation and the Board has historically done so regardless of its form—whether it is made in a Petition, or through a separate filing, or through email, or filing it before the District Court and informing the Board. As mentioned above, it is a conditional stipulation between Petitioner and the Board—unless and until there is institution, the conditional stipulation does not involve Patent Owner or the District Court. Patent Owner cannot change the very nature of the stipulation by unilaterally attaching it to a “notice” filed with the District Court.

*Third*, through Patent Owner’s filing “sitting on Judge Gilstrap’s docket” that sought “no other relief,” Patent Owner now attempts to strip the Board’s jurisdiction

and authority over the management of its own docket. The instant motion is a request to withdraw the *Sotera* stipulation filed before the Board and to replace it with another stipulation filed with the Board in IPR2024-00137. The Board has the authority to manage its own docket and “expunge any paper.” 37 C.F.R. § 42.7(a). Under “separation of powers,” a mere notice of the stipulation to the District Court cannot have any effect on the Board’s authority. Patent Owner’s melodramatic warning that a ruling here could be a “Constitutional violation” is supported only by Patent Owner’s gamesmanship and misleading acts, and not supported by any case law.

*Fourth*, Patent Owner argues that a stipulation is “binding without consideration.” Reply 3. This however, defeats the entire purpose of a *Sotera* stipulation. If the stipulation were binding the moment it were filed, it would apply ***even if*** the petition were denied institution—which is plainly not the case. Nor could a Petitioner modify an earlier, narrower stipulation to a *Sotera* stipulation, which is a common practice.

## **II. CONCLUSION**

Given Patent Owner’s conduct here, the Board would be justified in disregarding its arguments, none of which addresses the central question before the Board of whether a stipulation conditioned on institution can be modified before the Board renders its institution decision.

Date: June 18, 2024

Respectfully submitted,

By: /s/ James M. Glass  
James M. Glass

*Counsel for Petitioners*

## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on June 18, 2024, true and correct copies of the foregoing document were served in its entirety on the following parties via Electronic Mail

rmirzaie@raklaw.com  
rak\_cobblestone@raklaw.com  
ahayden@raklaw.com  
nrubin@raklaw.com  
ptong@raklaw.com

Date: June 18, 2024

By: /s/ James M. Glass

James Glass  
QUINN EMANUEL URQUHART  
& SULLIVAN, LLP  
51 Madison Avenue, 22<sup>nd</sup> Floor  
New York, NY 10010  
Tel: (212) 849-7000  
Fax: (212) 849-7100

*Counsel for Petitioners*