

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

COBBLESTONE WIRELESS LLC,
Patent Owner.

IPR2024-00315
Patent 9,094,888 B2

Before BARBARA A. PARVIS, NATHAN A. ENGELS, and
RUSSELL E. CASS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. (“Petitioner”) filed a Petition (Paper 3 (“Pet.”)) requesting *inter partes* review of claims 9, 10, 12, 20, 21, and 23 (“challenged claims”) of U.S. Patent No. 9,094,888 B2 (Ex. 1001, “the ’888 patent”). On March 28, 2024, Cobblestone Wireless LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). On May 7, 2024, Petitioner filed a Motion for Joinder (Paper 11, “Joinder Mot.” or “Motion for Joinder”) seeking to be joined as a party to *T-Mobile USA, Inc. et al. v. Cobblestone Wireless, LLC*, IPR2024-00137 (the “*T-Mobile* IPR”).¹ Petitioner also filed a Motion to Withdraw *Sotera*² Stipulation. Paper 10 (“Mot. Withdraw” or “Motion to Withdraw”). Patent Owner did not file an Opposition to the Motion for Joinder, but Patent Owner filed an Opposition to Petitioner’s Motion to Withdraw. Paper 12 (“Oppn.”). Petitioner filed a Reply to Patent Owner’s Opposition. Paper 13 (“Reply”). We have authority and jurisdiction under 35 U.S.C. §§ 6, 314 and 37 C.F.R. § 42.4.

For the reasons discussed below, we determine institution of *inter partes* review is warranted on the same grounds instituted in the *T-Mobile* IPR, and grant Petitioner’s Motion for Joinder.

¹ Petitioner refers to “IPR2024-00135” in its Petition (Pet. 1), but that *inter partes* review involves a challenge to a different patent. *See T-Mobile USA, Inc. et al. v. Cobblestone Wireless, LLC*, IPR2024-00135, Paper 1, 1. We understand Petitioner to be referring to Case No. “IPR2024-00137.” We deem Petitioner’s reference to the other proceeding a harmless typographical error.

² *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

II. BACKGROUND

A. *Real Parties in Interest*

Petitioner identifies Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. as real parties in interest. Pet. 58. Petitioner also states “[o]ut of an abundance of caution and to avoid additional issues associated with real parties-in-interest, Petitioner likewise identifies T-Mobile USA, Inc., AT&T Services Inc., AT&T Corp., AT&T Mobility LLC, and Cellco Partnership d/b/a Verizon Wireless [(‘Carriers’)] because Petitioner’s products are accused of infringement in their respective patent infringement actions.” *Id.* Patent Owner names itself as the real party in interest. Paper 5, 2.

B. *Related Matters*

Both parties identify, as matters involving or related to the ’888 patent, the following district court proceedings: *Cobblestone Wireless, LLC v. T-Mobile USA, Inc.*, No. 2:22-cv-00477 (E.D. Tex.) (“the Carriers’ parallel district court case”); *Cobblestone Wireless, LLC v. Cellco Partnership d/b/a Verizon Wireless*, No. 2:22-cv-00478 (E.D. Tex.); *Cobblestone Wireless, LLC v. AT&T Inc.*, No. 2:22-cv-00474 (E.D. Tex.); and *Cobblestone Wireless, LLC v. Samsung Electronics Co.*, No. 2:23-cv-00285 (E.D. Tex.) (“Petitioner’s parallel district court case”). Pet. 58; Paper 5, 2. As indicated above, the *T-Mobile* IPR is related because it involves challenges to the same claims of the same patent.

C. *The ’888 Patent*

The ’888 patent is titled “Wireless Device Handoff Between Wireless Networks.” Ex. 1001, code (54). The ’888 patent describes “example methods to be implemented at a first wireless network to handoff a wireless

device to a second wireless network.” *Id.* at 1:38–40. One embodiment of a wireless communication system including two wireless networks is illustrated in Figure 1A. *Id.* at 2:59–60.

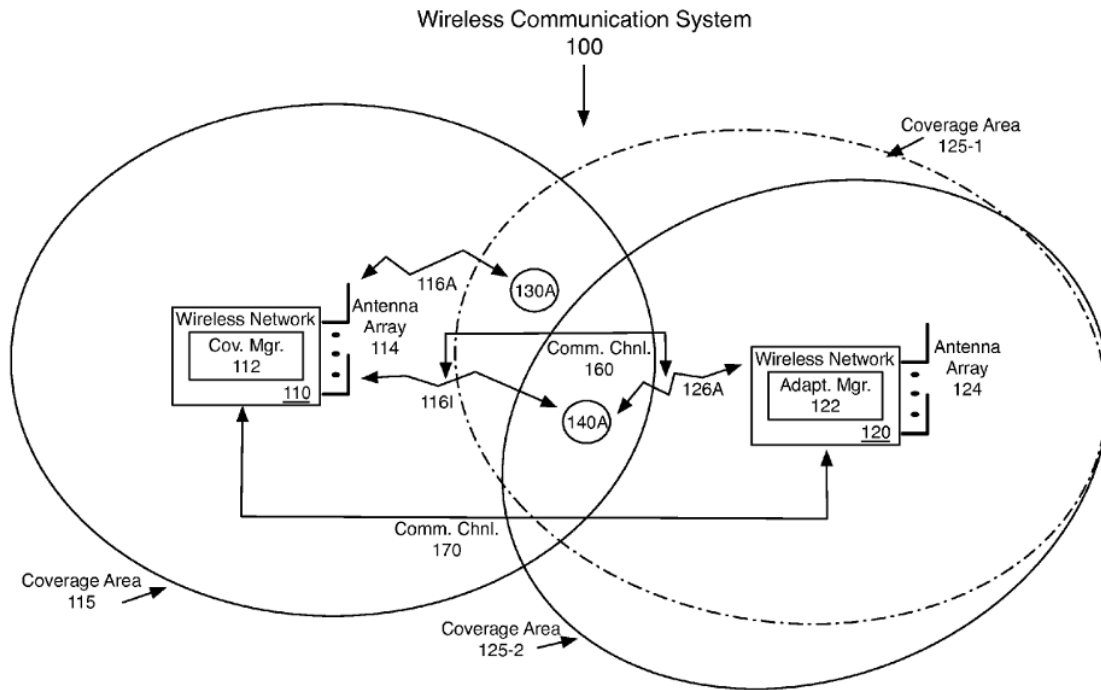


FIG. 1A

Figure 1A, above, illustrates wireless communication system 100 that includes wireless networks 110 and 120. *Id.* at 4:1–2. As shown in Figure 1A, wireless network 110 includes coverage manager 112 and antenna array 114. *Id.* at 4:2–4. Wireless network 120 includes adaption manager 122 and antenna array 124. *Id.* at 4:4–6.

Wireless network 110 has a coverage area indicated in Figure 1A as coverage area 115. *Id.* at 4:6–8. Antenna array 124 of wireless network 120 is adaptable via beamforming to enable wireless network 120 to have variable coverage areas shown in Figure 1A as coverage area 125-1 and coverage area 125-2. *Id.* at 4:8–12. As a result of the variable coverage areas, wireless device 130A is within past coverage area 125-1, but outside

of current coverage area 125-2. *Id.* at 5:35–38. Thus, although wireless device 130A is not currently covered by wireless network 120, past coverage area 125-1 indicates that network 120 may be capable of providing coverage. *Id.* at 5:38–41.

Coverage manager 112 is configured to determine whether wireless device 130A is capable of being covered by wireless network 120. *Id.* at 6:1–4. It may be determined that wireless device 130A and/or wireless network 110 would benefit from the handoff of wireless device 130A to wireless network 120. *Id.* at 6:6–9. For example, wireless device 130A may obtain a stronger signal from wireless network 120 or wireless device 130A may be moving towards wireless network 120 and away from wireless network 110. *Id.* at 6:9–16. Coverage manager 112 transmits a handoff request to wireless network 120. *Id.* at 6:21–24. Adaption manager 122 of wireless network 120 receives the handoff request and determines whether to adapt antenna array 124 to facilitate coverage of wireless device 130A. *Id.* at 6:26–30. If a determination is made to adapt antenna array 124, adaption manager 122 transmits a confirmation to indicate acceptance of the handoff request. *Id.* at 6:30–33. The coverage area for wireless network 120 is now similar to coverage area 125-1 and wireless device 130A is then handed off from wireless network 110 to wireless network 120. *Id.* at 6:33–37.

D. Illustrative Claim

Petitioner challenges claims 9, 10, 12, 20, 21, and 23 of the '888 patent. Pet. 1. Claims 9 and 20 are the only independent challenged claims. Claims 10 and 12 depend directly from claim 9 and claims 21 and 23 depend directly from claim 20. Independent claims 9 and 20, reproduced below, are illustrative of the claimed subject matter.

9. [9.p³] A method implemented at a first wireless network for a mobile wireless device handoff between a second wireless network and the first wireless network, the method comprising:

- [9.a] receiving a handoff request from the second wireless network, the handoff request based, at least in part, on a determination by the second wireless network that the wireless device is not currently covered by the first wireless network but is capable of being covered by the first wireless network;
- [9.b] based, at least in part, on the handoff request, adapting one or more beams of an antenna array to facilitate coverage of the wireless device by the first wireless network; and
- [9.c] transmitting a confirmation from the first wireless network to the second wireless network to indicate acceptance of the handoff request, wherein the wireless device is handed off from the second wireless network to the first wireless network.

Ex. 1001, 18:30–49.

20. [20.p] A system for a wireless device handoff between a first wireless network and a second wireless network, the system comprising:

- [20.a] an antenna array configured to generate one or more adaptable beams to modify a coverage area for the first wireless network; and
- [20.b] an adaption manager having logic, the logic configured to:
 - [20.c] receive a handoff request from the second wireless network, the handoff request based, at least in part, on a determination by the second wireless network that the wireless device is capable of being covered by the first wireless network,
 - [20.d] cause a beam from among the one or more adaptable beams to be adapted in order to enable the wireless device to be covered by the first wireless network, and

³ Herein we use Petitioner's designations for the elements of claims 9 and 20. Pet. 26–47, 52–55.

[20.e] transmit a confirmation to the second wireless network to indicate acceptance of the handoff request, wherein the wireless device is handed off from the second wireless network to the first wireless network.

Ex. 1001, 19:59–20:10.

E. Evidence

Petitioner relies on the prior art references in the table below.

Name	Reference	Exhibit
Chitrapu	US 2006/0111149 A1, filed Dec. 22, 2005, published May 25, 2006	1003
TS 36.300	3rd Generation Partnership Project (3GPP); Technical Specification (TS) 36.300 V10.3.0	1223

Petitioner also relies on the Declaration of Mr. James A. Proctor (Ex. 1005) to support its contentions that the challenged claims are unpatentable. Patent Owner does not rely on declarant testimony at this early stage in the proceeding.

F. Asserted Grounds

Petitioner asserts that the challenged claims of the '888 patent are unpatentable based on the ground in the table below (Pet. 3):

Claims Challenged	35 U.S.C. § ⁴	Reference/Basis
9, 10, 12, 20, 21, 23	103(a)	Chitrapu, TS 36.300

⁴ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the challenged claims of the '888 patent have an apparent effective filing date before March 16, 2013, the pre-AIA version of § 103 applies.

III. ANALYSIS

A. *Petitioner's Motion to Withdraw and Discretionary Denial Arguments*

Petitioner states that it “respectfully submit[s] this Motion to Withdraw [its] conditional *Sotera* Stipulation (Paper 8) filed on May 7, 2024, and to replace it with the *Sand Revolution* stipulation made by Petitioners and real parties-in-interest (the ‘Carriers’) in *T-Mobile USA, Inc., et al. v. Cobblestone Wireless LLC*, IPR2024-00137.” Mot. Withdraw 1; *see* IPR2024-00137, Paper 1 at 62 (presenting *Sand Revolution* stipulation). Petitioner’s *Sotera* stipulation was filed on May 7, 2024 in response to issues raised in Patent Owner’s Preliminary Response. Paper 7. Petitioner argues that its stipulation is “a unilateral, conditional offer between Petitioner[] and the Board,” but Petitioner acknowledges that, as set forth in its stipulation, if trial is instituted, “Petitioner will forego its right to pursue *in the parallel litigation* the same grounds or any grounds it could reasonably have raised.” Mot. Withdraw 3 (emphasis added).

Patent Owner argues in its Opposition that we have “no jurisdiction or authority” to grant Petitioner’s Motion to Withdraw and “no authority allows for withdrawing a stipulation.” Oppn. 2. Patent Owner also argues that “allowing [for] stipulation withdrawals would result in bad policy.” *Id.*

Regarding the first argument, Patent Owner states that it “filed a copy” of Petitioner’s “*Sotera* stipulation in the district court proceeding.” *Id.* at 1. Patent Owner argues “[e]nforcement of this stipulation at trial is within the jurisdiction and power of the Court, not” the Board, and Petitioner must file a motion with the district court. *Id.* Patent Owner’s argument does not address that Petitioner filed its stipulation in the instant proceeding. Paper 8. Patent Owner does not present persuasive argument or authority that

prohibits our authorizing Petitioner's withdrawal of its stipulation from the instant proceeding.

Patent Owner also argues that granting Petitioner's Motion to Withdraw "can potentially open the door to all sorts of unusual circumstances that will create unnecessary work for the Patent Office." Oppn. 4. Patent Owner, however, does not provide persuasive argument that our authorizing Petitioner's withdrawal of its stipulation from the instant proceeding would prejudice Patent Owner or burden the Board.

We "may determine a proper course of conduct in a proceeding for any situation not specifically covered by this [Part 42] and may enter non-final orders to administer the proceeding." 37 C.F.R. § 42.5.⁵ Petitioner's Motion to Withdraw was filed prior to our consideration of Petitioner's *Sotera* stipulation, and therefore this is not a case where the Board has invested effort or made rulings based on that stipulation. Additionally, Patent Owner does not argue persuasively that it is prejudiced by Petitioner's withdrawal of its *Sotera* stipulation and agreement to be bound by the Carriers' *Sand Revolution* stipulation in the instant proceeding. Moreover, allowing Petitioner to replace its *Sotera* stipulation with the Carriers' *Sand Revolution* stipulation will place the Petitioner and the Carriers in the same posture in the joined IPR proceedings. For these reasons, we grant Petitioner's request to the extent that we authorize Petitioner's withdrawal of its *Sotera* stipulation from the instant proceeding in favor of the Carriers' *Sand Revolution* stipulation. As a result, we consider the parties'

⁵ Petitioner also directs our attention to a proceeding in which a determination was made that a petitioner had effectively withdrawn its stipulation. *LG Electronics, Inc., v. Constellation Designs, LLC*, IPR2023-00228, Paper 10, 11 n. 3.

discretionary denial arguments in light of the Carriers' *Sand Revolution* stipulation without considering Petitioner's prior *Sotera* stipulation.

Our ruling concerning Petitioner's stipulation is limited to this IPR proceeding, over which we have jurisdiction. We make no determination or representation here regarding how a district court, including the one in parallel district-court case, will treat the withdrawal of Petitioner's *Sotera* stipulation and replacement with the Carriers' *Sand Revolution* stipulation.

Patent Owner asserts we should exercise our discretion to deny the Petition under 35 U.S.C. § 314(a) because, according to Patent Owner, each of the "six *Fintiv*^[6] factors weigh[s] in favor of the Board exercising its discretion to deny institution here." Prelim. Resp. 24. Patent Owner's arguments are substantively similar to those presented in the *T-Mobile* IPR and differ in that Patent Owner bases its analysis on two district court cases, including the Carriers' parallel district court case that Patent Owner raised in the *T-Mobile* IPR and Petitioner's parallel district-court case. Prelim. Resp. 23–43.

We start by considering Patent Owner's arguments based on the Carriers' parallel district-court case. The arguments and facts are substantively the same as those presented in the *T-Mobile* IPR, except Petitioner here is not a defendant in the Carriers' parallel district-court case. In the *T-Mobile* IPR, we found that factor 1 is neutral, factors 2, 3, and 5 weigh in favor of exercising discretion to deny institution, and factor 4 weighs marginally against exercising discretion to deny institution. *T-Mobile*

⁶ See *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*").

IPR, Paper 15, 10–14. Because Petitioner in the instant proceeding is not a defendant in the Carriers’ parallel district-court case, we find that factor 5 weighs against exercising discretion to deny institution in the instant proceeding. Regarding the other factors, for the same reasons discussed in the decision to institute in the *T-Mobile* IPR, we find that factor 1 is neutral, factors 2 and 3 weigh in favor of exercising discretion to deny institution, and factor 4 weighs marginally against exercising discretion to deny institution. *T-Mobile* IPR, Paper 15, 10–14.

We turn to Patent Owner’s arguments based on the Petitioner’s parallel district-court case. Our analysis of factors 1 and 4 is the same as that presented in the *T-Mobile* IPR because no stay has been requested in Petitioner’s parallel district-court case and Petitioner has agreed to be bound by the same stipulation submitted in the *T-Mobile* IPR. Joinder Mot. 1. Based on the facts presented by the parties, including the May 5, 2025 trial date, we find that factors 2, 3, and 5 weigh marginally in favor of exercising discretion to deny institution.

Taking “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review” (*Fintiv*, Paper 11, 6), we conclude that the evidence of record and our analysis of factors 1–5 relating to both district-court cases favors exercising our discretion to deny institution of an *inter partes* review. Regarding factor 6, for the reasons discussed in our institution decision in the *T-Mobile* IPR, we determine, on this preliminary record, that the merits here are compelling.

Accordingly, we decline to exercise our discretion to deny institution under 35 U.S.C. § 314(a).

B. Institution of Inter Partes Review

The Petition in this proceeding asserts the same grounds of unpatentability as the ones on which we instituted review in the *T-Mobile* IPR. *Compare* Pet. 3, 21–56, with *T-Mobile* IPR, Paper 1, 6, 25–60. Indeed, Petitioner contends that “the grounds of challenge in this Petition are a ‘copycat’ of the Petition filed in” the *T-Mobile* IPR and the “expert declaration filed in this proceeding is substantively identical to the expert declaration in” the *T-Mobile* IPR and is “signed by the same expert.” *Id.* at 1. Patent Owner states that its arguments on the merits in its Preliminary Response “are likewise ‘copycat’ of the merits arguments Patent Owner presented in its preliminary response in IPR2024-00137.” Prelim. Resp. 1 n.1.

We instituted *inter partes* review of claims 9, 10, 12, 20, 21, and 23 of the ’888 Patent on May 22, 2024, based on the petition filed in the *T-Mobile* IPR after consideration of all arguments and evidence presented by the parties including Patent Owner’s arguments in its Preliminary Response. *T-Mobile* IPR, Paper 15. For the same reasons discussed in the Decision on Institution in the *T-Mobile* IPR, we find Petitioner has demonstrated a reasonable likelihood of showing at least one claim of the ’888 patent is unpatentable. *See id.* Accordingly, we find the Petition warrants institution of *inter partes* review of all challenged claims on all grounds raised.

C. Motion for Joinder

Joinder in *inter partes* reviews is governed by 35 U.S.C. § 315(c), which states:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311

that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

To ensure the just, speedy, and inexpensive resolution of every proceeding, a motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013); Consolidated Trial Practice Guide at 76.⁷

Petitioner argues joinder is appropriate in this proceeding because “[a]ll four factors considered by the Board weigh in favor of joinder.” Joinder Mot. 6. Petitioner argues “the Instant Petition does not present any new grounds of unpatentability” and “it is substantively identical to” the *T-Mobile* IPR Petition. *Id.* Petitioner also argues “joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical, and Petitioner will accept an ‘understudy’ role unless and until” all Carriers are terminated from the proceeding. *Id.* at 6–7. Petitioner further argues “the briefing and discovery will be simplified by resolving all issues in a single proceeding.” *Id.* at 7.

Upon consideration of the parties’ arguments and cited supporting evidence, we are persuaded that Petitioner has met its burden to show that it is appropriate under these circumstances to join Petitioner to the *T-Mobile* IPR. Petitioner timely filed its Motion for Joinder within one month after

⁷ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

institution of trial in the *T-Mobile* IPR, as required by 37 C.F.R. § 42.122(b). Petitioner challenges the same claims that are challenged in the *T-Mobile* IPR on the same grounds using the same prior art and evidence. *See, e.g.,* Joinder Mot. 1, 6–7; *compare* Pet. 3, 12–39, with *T-Mobile* IPR, Paper 1, 6, 16–41. Petitioner states it will take an “understudy” role in the *T-Mobile* IPR and only assume a primary role should all Carriers cease participation in the *T-Mobile* IPR. *See* Joinder Mot. 6. Petitioner further asserts that joinder will have little to no impact on the trial schedule for the *T-Mobile* IPR and will simplify briefing and discovery. *See* Joinder Mot. 6, 9–11. Accordingly, joinder to the *T-Mobile* IPR would further the goals of a just, speedy, and inexpensive resolution of Petitioner’s challenge. *See* 37 C.F.R. § 42.1(b). Therefore, for the reasons given, we grant Petitioner’s Motion for Joinder and join Petitioner to the *T-Mobile* IPR.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314, an *inter partes* review of claims 9, 10, 12, 20, 21, and 23 of the ’888 patent is hereby instituted on all grounds stated in the Petition;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this Decision;

FURTHER ORDERED that the Motion for Joinder with IPR2024-00137 is granted, and Petitioner is joined as petitioners in IPR2024-00137;

FURTHER ORDERED that the Petitioner’s Motion to Withdraw its *Sotera* Stipulation (Paper 10) is granted to the extent that we authorize Petitioner’s withdrawal of its *Sotera* stipulation (Paper 8) from the instant

proceeding and treat Petitioner as being bound by the Carriers' *Sand Revolution* stipulation in IPR2024-00137, but we make no determination regarding the effectiveness of withdrawal of the stipulation in any case pending in a district court;

FURTHER ORDERED that Petitioner's role in IPR2024-00137 shall be limited as stated by Petitioner in the Motion for Joinder unless and until T-Mobile USA, Inc., AT&T Services Inc., AT&T Mobility LLC, AT&T Corporation, Cellco Partnership d/b/a Verizon Wireless, Nokia of America Corporation, and Ericsson Inc. cease to participate in IPR2024-00137;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2024-00137 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order in IPR2024-00137, and any modifications thereto, shall govern the schedule of the joined proceeding;

FURTHER ORDERED that all further filings shall be made in IPR2024-00137;

FURTHER ORDERED that the case caption in IPR2024-00137 shall be changed to reflect joinder of Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. as petitioners in accordance with the attached example;

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2024-00137; and

FURTHER ORDERED that the instant proceeding is terminated under 37 C.F.R. § 42.72.

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CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
NOKIA OF AMERICA CORPORATION, ERICSSON INC.,
SAMSUNG ELECTRONICS AMERICA, INC., and
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v.

COBBLESTONE WIRELESS LLC,
Patent Owner.

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⁸ Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. were joined as petitioners in this proceeding based on a petition and motion for joinder filed in IPR2024-00315, which were granted.