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.,
Petitioner,

v.

COBBLESTONE WIRELESS, LLC,
Patent Owner.

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IPR2024-00317
Patent 8,554,196

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**PATENT OWNER'S PRELIMINARY RESPONSE**

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# PATENT OWNER'S EXHIBIT LIST

| No. | Description |
|---|---|
| Ex. 2001 | *Samsung Electronics Am., Inc. et al. v. Cobblestone Wireless, LLC*, IPR2024-00318, Paper 3 (Petition) (PTAB Dec. 18, 2023) |
| Ex. 2002 | *T-Mobile USA, Inc. et al. v. Cobblestone Wireless, LLC*, IPR2024-00135, Paper 1 (Petition) (PTAB Nov. 22 2023) |
| Ex. 2003 | *Cobblestone Wireless, LLC v. Samsung Electronics Am., Inc. et al.*, No. 2:23-cv-00285-JRG-RSP, Plaintiff Cobblestone Wireless, LLC's Preliminary Disclosure of Asserted Claims and Infringement Contentions (E.D. Tex., served Sept. 28, 2023) |
| Ex. 2004 | Email from Cobblestone's counsel J. Ma to the Carriers' counsel M. Deane, dated March 5, 2024 |

# I. INTRODUCTION

The Board should deny institution of *inter partes* review ("IPR") of U.S. Patent No. 8,554,196 ("the '196 Patent") because this Petition is an improper and unjustified parallel petition. Petitioners offer no persuasive explanation as to why the single invalidity ground of the instant Petition, challenging only five claims, could not have been included in its other petition, particularly when the instant Petition uses just over half of the type-volume limitation permitted. This Petition also challenges only claims that are not asserted in litigation, neither against Petitioners nor their co-real parties-in-interest ("RPIs"). Instituting this Petition is contrary to the Board's guidance and is a strain on both party and Board resources. Institution should be denied.

# II. PETITIONERS DO NOT JUSTIFY THEIR PARALLEL PETITIONS DIRECTED TOWARDS THE '196 PATENT.

Under 35 U.S.C. § 314(a), the Board has discretion to deny institution of IPR. *See, e.g.*, *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018). When a petitioner opts to file two parallel petitions on the same patent, as Petitioner as done here, the Board considers the following guidance in the November 2019 Consolidated Trial Practice Guide ("CTPG"):

> Based on the Board's experience, ***one petition should be sufficient*** to challenge the claims of a patent in most situations. ***Two or more petitions filed against the same patent*** at or about the same time (e.g.,

> before the first preliminary response by the patent owner) may place a ***substantial and unnecessary burden*** on the Board and the patent owner and could raise ***fairness, timing, and efficiency concerns***. In addition, multiple petitions by a petitioner are not necessary in the vast majority of cases. To date, a substantial majority of patents have been challenged with a single petition.

CTPG at 59 (emphases added). If a petitioner opts to file two or more parallel petitions concerning the same patent:

> [That] petitioner should … identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a).

*Id.* at 59-60. However, the CTPG emphasizes that, although there may be "cases [in which] ***two petitions*** by a petitioner may be needed, … this ***should be rare***." *Id.* at 59 (emphases added).

Here, Petitioners[1] have filed two IPR petitions challenging the '196 Patent—IPR2024-00318 challenging claims 1-5, 7, 8, 10, 12, 14, 17, 18, 20, and 21 ("First Petition," Ex. 2001) and the instant Petition challenging claims 23-27 ("Second Petition"). Both petitions were filed on the same date, December 18, 2023. Ex. 2001 at 73-76; Pet. at 45-48. As part of each petition, Petitioners included similar "Ranking of Parallel Petitions" sections, giving the First Petition a ranking of 1 and the Second Petition a ranking of 2. Ex. 2001 at 70; Pet. at 42. To the extent that the Board institutes review of the First Petition, institution of the Second Petition should be denied as an unnecessary parallel petition. Petitioner does not demonstrate that this is a "rare" case where two petitions are appropriate.

First, and critically, the Second Petition uses only about half of the 14,000 word type-volume limitation. Pet. at 47 (indicating a 7,523 word count); 37 C.F.R. § 42.24(a). Although the First Petition indicates a 12,492 word count (Ex. 2001 at 75), only 10,193 of those words are dedicated to addressing the prior art and grounds at issue (*id.* at 5-66). Thus, even if Petitioners would have inserted their materials concerning the First Petition's grounds into the Second Petition, the combined

[1] Petitioners' co-RPIs ("the Carriers") (Pet. at 43) have also filed an additional petition challenging the '196 Patent in IPR2024-00135. Ex. 2002. The instant Petition is a "copycat" of that petition. Pet. at 40.

petition would have had 17,716 words, just a couple thousand words over the word count limit. Moreover, Petitioners chose to include their "Ranking of Parallel Petitions" in the Petition itself, rather than in a separate ranking paper as permitted by the Board. *See* Pet. at 40-43; CTPG at 60 n.3. And in any event, Petitioners would not have needed this section if they would have simply filed one petition on the '196 Patent to begin with. If this section is removed, the word-count for the combined petition would only be 17,211.

Petitioners offer no explanation for why they could not have reduced the type-volume by just over three thousand words, such as by removing or streamlining background information or the formatting of Mandatory Notices, to comply with the Board's regulations and guidance that situations requiring multiple petitions "should be rare." *Id.* at 59. Indeed, Petitioners do not allege that "the patent owner has asserted a large number of claims in litigation or [that] there is a dispute about priority date requiring arguments under multiple prior art references." *Id.* As noted above, the two petitions were filed the same day, so Petitioners knew of the prior art reference utilized in the Second Petition when it filed the First Petition, further supporting that Petitioners could have included this single additional ground in the First Petition, but chose not to in favor of burdening the Board and Patent Owner with unnecessary parallel proceedings.

The First and Second Petitions do indeed challenge different claim sets and use different prior art. *Compare* Ex. 2001 at 1, 3 (challenging claims 1-5, 7, 8, 10, 12, 14, 17, 18, 20, and 21 as obvious over Chitrapu, Wang, and/or Dinan) *with* Pet. at 3 (challenging claims 23-27 as obvious over Chang). But even so, and even if Petitioners are correct that "[t]he Challenged Claims [in the Second Petition] are materially different than the Challenged claims in the [First] Petition," Petitioners still have not justified multiple petitions here and particularly not why the instant Second Petition is necessary, particular in view of the word count issue addressed immediately above. *See* Pet. at 42-43.

In addition, as Petitioners admit, "Patent Owner has not asserted Claims 23-27 in the parallel district court litigation against Petitioners." *Id.* at 41; *see also* Ex. 2003 at 2. And although Petitioners claim that "Patent Owner has alleged that Petitioners' products infringe those claims in litigations against T-Mobile, AT&T and Verizon (the 'Carriers')," Patent Owner has dropped those claims from the litigation against the Carriers.[2] Ex. 2004 at 1. Thus, the only unique challenges

[2] To the extent Petitioners argue that institution should not be denied because they are simply seeking joinder to their co-RPI's proceeding, and thus this Petition will not consume additional Board resources, that other petition may not be instituted. And even if so, it may no longer be pending at the time of the institution decision in

presented in the Second Petition are for five claims—claims 23-27, none of which is asserted in district court litigation—against Petitioners or their co-RPIs. "[T]he mere fact that each petition addresses a different claim [set] is insufficient to justify two petitions," and this particularly true when none of the claims from one of the claim sets is even asserted against Petitioners. *See Google LLC v. Uniloc 2017 LLC*, IPR2020-00448, Paper 11 at 7 (PTAB July 9, 2020) (noting that, as here, the claims at issue were no longer asserted in litigation against petitioner); *see also, e.g.*, *Apple, Inc. v. Spier Techs. Ltd.*, IPR2023-00543, Paper 8 at 10 (PTAB Aug. 8, 2023) (denying institution of a second petition in part because the second petition addressed only claims not asserted in the co-pending litigation); *Samsung Elecs. Co. v. Lynk Labs, Inc.*, IPR2022-00150, Paper 15 at 8, 10-11 (PTAB July 5, 2022) (same); *Microsoft v. Uniloc 2017 LLC*, IPR2019-01470, Paper 7 at 10, 13 (PTAB Feb. 11, 2020) (same).

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this proceeding, especially in view of the case narrowing in the litigation against the co-RPIs. Thus, in that circumstance, there would not be anything for this Petition to join. Moreover, joinder does not alleviate the burden Patent Owner would face if, after joinder, the proceeding was terminated as to the Carriers; Patent Owner would be left to proceed against Petitioners in that proceeding, even though Petitioners never justified its parallel petitions in the first place.

Finally, in the First Petition, Petitioners claim that "there are few overlapping issues that would warrant conservation of Board resources." Ex. 2001 at 68. Setting aside that this appears to be by Petitioners' design, this argument flies in the face of the guidance in the CTPG that such parallel petitions are rarely needed and "may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, riming, and efficiency concerns." CTPG at 59. Indeed, that parallel petitions may not have overlapping claims or art does not negate the fact that, for example, the parties will need to draft, and the Board will need to review and hear argument on, two sets of briefing rather than one, and that Patent Owner's expert will need to draft two expert declarations and be deposed twice. In addition, Petitioners use different experts for the two petitions, negating the ability to potentially have a consolidated expert deposition. *See* Ex. 2001 at v (relying on Dr. Kevin Almeroth); Pet. at iii (relying on Mr. James Proctor).

In sum, the Board should exercise its discretion to deny institution of the instant Second Petition. If Petitioners wanted to include the claims and grounds in this petition, they could have and should have done so in the First Petition. And Petitioners provide no persuasive explanation for why they did not do so.

## III. CONCLUSION

Patent Owner respectfully requests that the Board deny institution of the Petition as an unjustified parallel petition.

Date: March 28, 2024

Respectfully submitted,

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**CERTIFICATION REGARDING WORD COUNT**

Pursuant to 37 C.F.R. §42.24(d), Patent Owner certifies that there are 2,083 words in the paper excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

Date: March 28, 2024

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**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))**

The undersigned hereby certifies that the above document was served on March 28, 2024, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioners:

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