

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 IPR 2024-00317
Patent No. 8,554,196

**MOTION FOR JOINDER TO
INTER PARTES REVIEW IPR2024-00135**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. (“Petitioners”) respectfully submits this Motion for Joinder (“Motion”) with respect to its Petition (Paper 3) (the “Instant Petition”) filed on December 18, 2023. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners request institution of an *inter partes* review and joinder with the *inter partes* review in *T-Mobile USA, Inc., et al. v. Cobblestone Wireless LLC*, IPR2024-00135 (the “Carriers’ IPR”) in view of the Board’s decision to institute trial on April 30, 2024 (Carriers’ IPR, Paper 10). Counsel for Petitioners has conferred with counsel for Petitioners in the Carriers’ IPR (“Carriers”), and counsel for the Carriers does not object to Petitioners joining IPR2024-00135. Counsel for Petitioner has also conferred with Patent Owner, who likewise does not object to this motion.

Petitioners’ request for joinder is timely under 37 C.F.R. § 42.122(b) as it is submitted no later than one month after the April 30, 2024 institution date of the Carriers’ IPR. This Petition is also substantively identical to the Carriers’ Petition, addressing the same claims, prior art, and grounds for unpatentability that are the subject of the Carriers’ IPR. In addition, Petitioners are willing to follow the Carriers’ IPR Scheduling Order.

Petitioners submit that joinder is appropriate because it will not unduly burden or prejudice the parties to the Carriers’ IPR while efficiently resolving

whether claims 23-27 of the '196 Patent are valid.

II. STATEMENT OF MATERIAL FACTS

1. The '196 Patent recites two materially different sets of claims: (1) claims 1-22, which describe cycling through wide and narrow beam patterns to provide continuous user service or interval service to devices, and (2) claims 23-27, which describe a user device deferring data updates until it is on a more capable network.

2. On December 15 and 16, 2022, Patent Owner brought lawsuits against the Carriers in the Eastern District of Texas: Case Nos. 2:22-cv-00477 (T-Mobile USA *et al.*), 2:22-cv-00474 (AT&T Inc. *et al.*), and 2:22-cv-00478 (Verizon Communications Inc., *et al.*). The complaints alleged that various smartphones, including Petitioners' smartphones, infringed claim 23 of the '196 Patent.

3. On March 13, 2023, Patent Owner served preliminary infringement contentions in the Carriers' cases, asserting claims 23-27 against various smartphones, including Petitioners' smartphones.

4. On June 16, 2023, Patent Owner brought a lawsuit against Petitioners in the Eastern District of Texas: Case No. 2:23-cv-00285. The complaint asserted claim 1 of the '196 Patent against Petitioners' "cellular base stations."

5. On September 28, 2023, Patent Owner served preliminary infringement contentions in Petitioners' case, asserting claims 1-5, 7, 10, 12, 14, 17, 18, 20, and 21 against Petitioners' "4G" and "5G base stations." Patent Owner did not and has not asserted claims 23-27 in Petitioners' case.

6. On November 22, 2023, in IPR2024-00135, the Carriers filed a petition ("Carriers' Petition") for *inter partes* review requesting cancellation of claims 23-27 of the '196 Patent.

7. On December 18, 2023, in the instant case IPR2024-00317, Petitioners filed the Instant Petition as a copycat of the Carriers' Petition, requesting cancellation of claims 23-27 of the '196 Patent.

8. Also on December 18, 2023, Petitioners filed a second Petition for *inter partes* review ("Second Petition") against the '196 Patent (IPR2024-00318), requesting cancellation of claims 1-5, 7, 8, 10, 12, 14, 17, 18, 20, and 21.

9. Patent Owner did not file a preliminary response in the Carriers' IPR.

10. Patent Owner filed a preliminary response in this IPR, but did not argue against the merits of the Instant Petition. Paper 7. Instead, Patent Owner argued that the Instant Petition was an improper parallel petition. *Id.*

11. On March 5, 2024, Patent Owner informed the Carriers that it would no longer assert the '196 Patent in the Carriers' cases.

12. On April 30, 2024, the Board instituted the Carriers' IPR.

13. The Instant Petition and the Carriers' Petition are substantively identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims, using substantially the same evidence and arguments, including the same testimony from the same expert.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers several factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013); Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 76-78.

B. Petitioners' Motion For Joinder Is Timely

This Motion for Joinder is timely because it is filed within one month of the April 30, 2024 institution decision of the Carriers' IPR. 37 C.F.R. § 42.122(b).

Further, the Instant Petition was filed within the one-year bar set forth in 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b).

C. Every Factor Weighs In Favor Of Joinder.

All four factors considered by the Board weigh in favor of joinder. Specifically, the Instant Petition does not present any new grounds of unpatentability; it is substantively identical to the Carriers' Petition¹. Further, 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 the Carriers are terminated from the proceeding. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate here.

The Board routinely grants motions for joinder in view of pending litigations involving the same patent and the same parties. *See, e.g., Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00224, Paper 10 at 2-7 (PTAB April 6, 2020) (granting motion for joinder of a Instant Petition in view of co-pending lawsuit); *Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 2-13 (PTAB May 30, 2019) (same); *Celltrion, Inc.*

¹ Indeed, for the most part, the Instant petition is a word-for-word copy of the Carriers' Petition; changes were made only in a few instance to account for the different parties and different positioning of the parties.

v. Genentech, Inc., IPR2018-01019, Paper 11 at 2-15 (PTAB Oct. 30, 2018) (same); *Huawei Device Co., Ltd. v. Uniloc Luxembourg S.A.*, IPR2017-02090, Paper 9 at 2-12 (PTAB March 6, 2018) (same); *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-02063, Paper 25 at 4-8 (PTAB Feb. 21, 2018) (same); *General Motors LLC v. Neo Wireless LLC*, IPR2023-00963, Paper 10 at 2-20 (PTAB Dec. 6, 2023) (same); *T-Mobile USA, Inc. v. Dali Wireless, Inc.*, IPR2023-00830, Paper 7 at 2-11 (PTAB Oct. 11, 2023) (same); *Cooler Master Co., Ltd. v. Asektek Danmark A/S*, IPR2023-00667, Paper 6 at 2-13 (PTAB Aug. 28, 2023) (same).

Even though the Challenged Claims in the Instant Petition and the Carriers' IPR have never been asserted against Petitioners, Patent Owner have alleged, and could allege in the future, that Petitioners' products infringed the Challenged Claims.

1. Joinder Is Appropriate With The Carriers' IPR.

Joinder with the Carriers' IPR is appropriate because the Instant Petition involves the same patent, challenges the same claims, relies on the same testimony from the same expert, and is based on the same grounds and combinations of prior art submitted in the Carriers Petition. The Instant Petition is substantively identical to the Carriers Petition, containing only minor differences unrelated to the merits of the proposed grounds. There are no changes to the facts, citations, evidence, or arguments presented in the Instant Petition in relation to the grounds of the Carriers Petition. Because these proceedings are substantively identical, good cause exists

for joining this proceeding with the Carriers' IPR so that the Board can efficiently resolve all grounds in both the Copycat and Carriers Petitions in a single proceeding. Moreover, the Carriers Petition presents compelling unpatentability challenges, resolving the merits of the Carriers Petition is in the interest of justice, and joinder is appropriate in such circumstances. *Code200 v. Bright Data Ltd.*, IPR2022-00861, Paper 19 at 39.

2. Petitioners Propose No New Grounds Of Unpatentability.

The Instant Petition does not present any new grounds of unpatentability. The Instant Petition is substantively identical to the Carriers Petition. The Instant Petition presents the unpatentability of the same claims of the same patent in the same way as the Carriers Petition. The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted) (emphasis original); *see also STMicroelectronics, Inc. v. Lone Star Silicon Innovations, LLC*, IPR2018-00436, Paper 7 at 5 (PTAB May 4, 2018) (granting joinder and reasoning, “[w]e rely in particular, on Petitioner’s representation that its Petition is ‘substantially identical’...challenges the same claims based on the same prior art and the same grounds of unpatentability....”).

3. Joinder Will Not Unduly Burden Or Negatively Impact The Carriers' IPR Trial Schedule.

Because the Instant Petition is substantively identical to the Carriers Petition, with the same grounds applied to the same claims as instituted by the Board, there are no new issues for Patent Owner to address. Indeed, Patent Owner does not object to this motion. Due to the same issues being presented in the Carriers Petition, Patent Owner will not be required to present any additional responses or arguments. *LG v. Memory Integrity, LLC*, IPR2015-01353, Paper 11, at 6 (Oct. 5, 2015) (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR].”); *see also id.*, Paper 4 at 5–7.

The Patent Owner Response will also not be negatively impacted because the issues presented in the Carriers Petition are identical to the issues presented in the Instant Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Carriers Petition. Also, because the Instant Petition relies on the same expert and a substantively identical declaration, only a single deposition is needed for the proposed joined proceeding.

Joinder of this proceeding with the Carriers' IPR would not unduly burden or negatively impact the trial schedule in any meaningful way. Further, even if a small

adjustment of the trial schedule were necessary, this is already provided for in the rules and is a routine undertaking by parties in IPR proceedings. *See* 37 C.F.R. § 42.100(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough of a reason to deny joining the present Instant Petition with the Carriers' IPR.

4. Procedures To Simplify Briefing And Discovery

The Carriers Petition and the Instant Petition present substantively identical grounds of rejection, including the same prior art combinations against the same claims. Additionally, Petitioners explicitly agree to take an “understudy” role, as described by the Board:

“(a) all filings by [Petitioner] in the joined proceeding [will] be consolidated with [the filings of the petitioner in the Carriers' IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Carriers' IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Carriers' IPR], or introduce any argument or discovery not already introduced by [the petitioner in the Carriers' IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Carriers' IPR] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Carriers' IPR] alone under either 37 C.F.R. § 42.53 or any

agreement between [Patent Owner] and [the petitioner in the Carriers' IPR].”

See IPR2014-00550, Paper 38 at 5 (Apr. 10, 2015).

Petitioners will assume the primary role only if the Carriers cease to participate in the Carriers' IPR. Counsel for Petitioners has conferred with counsel for the Carriers, and the Carriers do not object to Petitioners joining IPR2024-00135 in an “understudy” role. By Petitioners accepting an “understudy” role, Patent Owner and Petitioners can comply with the current trial schedule and avoid any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that may result due to joinder. *See, e.g., Garmin Int'l, Inc. v. Philips North Am. LLC*, IPR2020-00910, Paper 8 at 45, 47-50 (PTAB Nov. 19, 2020) (granting joinder where petitioners agreed to accept an “understudy” role); *STMicroelectronics*, IPR2018-00436, Paper 7 at 5 (similar).

IV. GENERAL PLASTIC IS INAPPLICABLE AND FAVORS INSTITUTION

In *General Plastic*, the Board set forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the Board. In the current motion, Petitioners merely seek to join the Carriers' proceeding in an understudy rule and does not present any new grounds. The PTAB has previously found that such circumstances “effectively neutralize[]” a *General Plastic* analysis. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21,

2018) (instituting a joinder Instant Petition where petitioner agreed to assume a passive understudy role, and noting such circumstances “effectively neutraliz[es] the *General Plastic* factors”); *see also Celltrion, Inc. v. Genentech, Inc.*, IPR2019-01019, Paper 11 at 10 (PTAB Oct. 30, 2018) (noting the joinder motion “effectively obviates any concerns of serial harassment and unnecessary expenditures of resources”) and *Code200*, Vidal Remand (Paper 18) (finding roadmapping and other *General Plastic* concerns generally inapplicable or of limited relevance when a motion for joinder presents a Instant Petition).

Prior to the Petition in the instant case, Petitioners had not previously filed a Petition seeking *inter partes* review of the ’196 Patent. Petitioners do note that on the same day that it filed the Instant Petition, Petitioners filed a Second Petition challenging different claims of the ’196 Patent. Thus, the *General Plastic* factors counsel against discretionary denial, *i.e.*, in favor of instituting the present IPR and joining it with the Carriers’ IPR. *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i); *cf. Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (precedential) (denying motion for joinder and denying Instant Petition because Petitioner has previously filed a Petition challenging same claims and patent).

V. THERE IS NO REASON TO DENY THIS PETITION AS A PARALLEL PETITION

Patent Owner has argued in its Preliminary Response that the Instant Petition should be denied as an improper parallel petition under the TPG, because Petitioners also filed a Second Petition challenging a different set of claims of the '196 Patent. Paper 7. Patent Owner has since informed Petitioners that they do not oppose this motion. Therefore, Patent Owner's concerns appear to have been resolved.

Regardless, as discussed above, if the Instant Petition is joined to the Carriers' IPR, it would not place a "substantial and unnecessary burden on the Board" and would not "raise fairness, timing, and efficiency concerns" (TPG at 59), because the issues raised in the Instant Petition are identical to those raised in the Carriers' Petition and, if joined, they will be resolved in the same proceeding.

Patent Owner also admonishes Petitioners for not presenting a combined Petition. Paper 7 at 4-6. However, a combined Petition not be able to join the Carriers' IPR. *See Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1333 (Fed. Cir. 2020) ("The clear and unambiguous text of § 315(c) ... does not authorize the joinder of new issues."). This would have prejudiced Samsung had the Carriers settled with Patent Owner and sought dismissal of the Carriers' IPR—a particularly salient concern given that Patent Owner is no longer asserting the '196 Patent against the Carriers. Paper 7 at 5; *see also* 5 n.2 (suggesting the Carriers' IPR

may be dismissed “in view of the case narrowing in the litigation against the [Carriers]”).

VI. CONCLUSION

For the foregoing reasons, Petitioners respectfully request the Board grant Petitioners’ Petition and Motion for Joinder with the Carriers’ IPR.

Date: May 28, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that on May 28, 2024 the foregoing document was served via email on the following counsel of record:

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