

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.

IPR2024-00317
Patent 8,554,196 B2

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

PARVIS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Cobblestone Wireless, LLC (“Patent Owner”) is the owner of U.S. Patent 8,554,196 B2 (“the ’196 patent”). Paper 5, 1.¹ On November 22, 2023, T-Mobile USA, Inc., AT&T Services Inc., AT&T Mobility LLC, AT&T Corporation, and Cellco Partnership d/b/a Verizon Wireless filed a petition for *inter partes* review challenging the patentability of claims 23–27 of the ’196 patent in *T-Mobile USA, Inc. et al. v. Cobblestone Wireless, LLC*, IPR2024-00135 (“the ’135 IPR”). On December 18, 2023, Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. (collectively, “Petitioner”) filed a Petition for *inter partes* review challenging the patentability of claims 23–27 of the ’196 patent. Paper 3. In its Petition, Petitioner indicated that it intended “to move for joinder” if the ’135 IPR is instituted. Paper 3, 1. Patent Owner filed a Preliminary Response in the instant case on March 28, 2024. Paper 7. We instituted review in the ’135 IPR on April 30, 2024. Petitioner filed a Motion for Joinder in the instant case to join IPR2024-00317 to IPR2024-00135 on May 28, 2024. Paper 8.

On May 28, 2024, Petitioner emailed the Board (Ex. 3001) in accordance with Board guidance. *See Consolidated Trial Practice Guide* (“Consolidated Practice Guide”)² at 76 (“party who files a motion for joinder should arrange a conference call with the panel, petitioner, and patent owner of the first proceeding within five business days of filing the motion.”); *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019). On May 29, 2024, Petitioner indicated that it contacted Patent Owner prior to filing the Motion,

¹ Herein citations are to papers and exhibits in the instant proceeding, unless otherwise noted.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

and that “Patent Owner does not oppose joinder subject to Petitioners taking an ‘understudy’ role and not requesting changes to the scheduling order.”

Ex. 3001. Petitioner indicated that it agreed to both of Patent Owner’s conditions. *Id.*

On June 5, 2024, Judges Parvis and Cass conducted a conference call with counsel for both parties to discuss whether Patent Owner planned to file an Opposition to Petitioner’s Motion and, if so, to set a briefing schedule. During the call, Patent Owner indicated that it did not oppose Petitioner’s Motion, but Patent Owner requested that the Board hold Petitioner to the same stipulation made by T-Mobile USA, Inc., AT&T Services Inc., AT&T Mobility LLC, AT&T Corporation, and Cellco Partnership d/b/a Verizon Wireless in the ’135 IPR. *See* the ’135 IPR, Paper 1, 45.³ Petitioner opposed Patent Owner’s request.

Having heard the parties’ respective arguments, the Board determined further briefing would be helpful on the issue of whether Petitioner’s Motion for Joinder should be denied because Petitioner does not agree to the same stipulation made in the ’135 IPR. During the call, we authorized Patent Owner to file an Opposition to Petitioner’s Motion for Joinder of no more than five (5) pages by June 10, 2024 and limited to the issue of whether Petitioner’s Motion for Joinder should be denied because Petitioner does not

³ In the ’135 IPR, the stipulation agreed to is “if instituted, Petitioners stipulate that they will not pursue invalidity against the asserted claims in the district court using the specific combination of prior art references set forth in Ground 1 presented in this Petition for purposes of establishing obviousness (i.e., obviousness in light of Chang).” *See* the ’135 IPR Paper 1, 45 (citing *Sand Revolution II LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 11-12 (PTAB June 16, 2020)).

agree to the same stipulation made in the '135 IPR. We also authorized Petitioner to file a Reply of no more than five (5) pages by June 13, 2024 and limited to responding to Patent Owner's Opposition.

ORDER

Accordingly, it is:

ORDERED that Patent Owner is authorized to file an opposition to Petitioner's motion to join IPR2024-00317 to IPR2024-00135 of no more than five (5) pages by June 10, 2024 and limited to the issue of whether Petitioner's Motion for Joinder should be denied because Petitioner does not agree to the same stipulation made in the '135 IPR;

FURTHER ORDERED that Petitioner is authorized to file a reply of no more than five (5) pages by June 13, 2024 and limited to responding to Patent Owner's opposition;

FURTHER ORDERED that the parties are not authorized to file any other papers including no sur-replies are authorized at this time.

IPR2024-00317
Patent 8,554,196 B2

FOR PETITIONER:

James Glass
Quincy Lu
QUINN EMANUEL URQUHART & SULLIVAN, LLP
jimglass@quinnemanuel.com
quincylu@quinnemanuel.com

FOR PATENT OWNER:

Reza Mirzaie
Amy Hayden
Neil Rubin
Qi Tong
RUSS AUGUST & KABAT
rmirzaie@raklaw.com
ahayden@raklaw.com
nrubin@raklaw.com
ptong@raklaw.com