

IN THE 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 No. IPR2024-00317

U.S. Patent No. 8,554,196

**PETITIONERS' REPLY TO PATENT OWNER'S RESPONSE TO
MOTION FOR JOINDER**

I. THE MOTION FOR JOINDER IS UNOPPOSED

Following a telephonic hearing between the parties and the Board, the Board authorized “Patent Owner to file an Opposition to Petitioner’s Motion for Joinder ... 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.” Paper 9 at 3-4.

Patent Owner filed a “Response” to the Motion for Joinder which does not oppose the motion. Instead, since Petitioners “do not agree to be bound by Carriers’ *Sand Revolution* stipulation as a result of joinder,” Patent Owner “takes no position on Samsung’s motion for Joinder (Paper 8).” Paper 10 at 2. Patent Owner merely requests that the Board “independently consider” whether joinder is appropriate and whether the Board and/or the District Court “have authority to decide whether Petitioner will be bound by the Carriers’ stipulation as a result of joinder,” and to “make clear that the Board’s decision was made without the benefit of hearing opposing argument, so the decision should have no precedential value.” *Id.* at 2-3.¹

¹ As the Board correctly noted on the conference call, whether a decision has “precedential value” is by authority of the Director, who has promulgated a “Standard Operating Procedure” involving “an Advisory Committee and PTAB Executive Management” for “evaluat[ing] decisions nominated for precedential or informative designation.” Standard Operating Procedure 2 (Revision 11), Designation or De-Designation of Decisions as Precedential or Informative (July 24, 2023) at 1.

Because Patent Owner does not oppose the Motion for Joinder and does not present any facts or arguments that are relevant to the factors for considering joinder, the Board should grant the motion for the reasons explained in Petitioners' Motion.

II. PETITIONERS CANNOT BE FORCED TO ADHERE TO ANOTHER PARTY'S "STIPULATION"

There is also no reason, and this Board, respectfully, has no authority, to force Petitioners to be bound by the Carriers' *Sand Revolution*-style stipulation.

First, the purpose of a *Sand Revolution*-style stipulation is to give the Board some assurance that, under *Fintiv* Factor 4, the issues in the IPR proceeding will not completely overlap with issues presented in the District Court. However, Patent Owner has not raised any *Fintiv* challenge, either in this proceeding or the Carriers' proceeding, and confirmed on the telephonic conference that it does not intend to raise any such challenge. Thus, there is no purpose to a *Sand Revolution*-style stipulation at this juncture, and there is no prejudice to Patent Owner.

Second, a prior art stipulation like the one in *Sand Revolution* is a conditional **stipulation** between Petitioner and the Board. By its own terms, a "stipulation" cannot be coerced. Patent Owner provides no authority that authorizes either the Board or the District Court to force Petitioners to "stipulate" to another party's statement and forego its right to present a full invalidity case in the district court. The Carriers are not the same as the Petitioners—they are different parties,

represented by different counsel, and have different interests at stake—especially since the '196 Patent is not asserted against the Carriers.

Third, forcing Petitioners to adopt the Carriers' stipulation would be highly prejudicial to Petitioners. The Carriers' stipulation currently has no effect because the '196 Patent is no longer being asserted in the Carriers' litigation. By contrast, Patent Owner continues to assert the '196 Patent against Petitioners. Although Patent Owner has not asserted against Samsung the claims at issue in this proceeding (claims 23-27 of the '196 Patent), Patent Owner has previously asserted those claims against Samsung products and there is no guarantee that Patent Owner will not do so in the future. *See* IPR2024-00135, Ex. 1008 (accusing Samsung smartphones of infringing claims 23-27).

In addition, the Carriers' stipulation is not on its face limited to the challenged claims in the Carriers' IPR, *i.e.* claims 23-27. *See* IPR2024-00135, Paper 1 at 45 (“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).”) (emphasis added). As a result, if Petitioners were forced to adopt the language of this stipulation, it would appear to cover asserted claims that are ***not*** being challenged in this proceeding, *i.e.* claims 1-5, 7, 10, 12, 14, 17, 18, 20, and 21.

Fourth, Patent Owner’s suggestion that a forced stipulation is appropriate because it would make Petitioners and the Carriers have “substantively identical” petitions is at complete odds with Patent Owner’s opposition to Petitioners’ motion in IPR2024-00315 to replace its *Sotera* stipulation for the Carriers’ *Sand Revolution*-style stipulation. In that case, Patent Owner has taken the position that Petitioners should **not** be permitted to modify its stipulation prior to it coming into effect. This is plainly inconsistent with Patent Owner’s suggestion here that the Board force Petitioners into making a stipulation.

Finally, Patent Owner’s request that the Board “make clear that [its] decision was made without the benefit of hearing opposing argument, so the decision should have no precedential value,” should be denied. As the Board recognized during the telephonic conference, it is not up to the panel as to whether its decision be given “precedential value”—it is, instead, the authority of the Director. The Director has stated that such decisions will be made and informed by the “Standard Operating Procedure” involving “an Advisory Committee and PTAB Executive Management” for “evaluat[ing] decisions nominated for precedential or informative designation.” Standard Operating Procedure 2 (Revision 11), Designation or De-Designation of Decisions as Precedential or Informative (July 24, 2023) at 1. Moreover, as the Director made clear, it is “the authority of the Director to designate or de-designate decisions as precedential or informative.” *Id.* Any suggestion that the panel can

force the actions of the Director is constitutionally infirm. *See United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021) (“The Constitution therefore forbids the enforcement of statutory restrictions on the Director that insulate the decisions of APJs from his direction and supervision.”).

For these reasons, the motion to join should be granted and Petitioners should not be bound by the Carriers’ *Sand Revolution*-style stipulation.

Date: June 13, 2024

Respectfully submitted,

By: /s/ James M. Glass

James M. Glass

Counsel for Petitioners

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on June 13, 2024, true and correct copies of the foregoing document were served in its entirety on the following parties via Electronic Mail

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