

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*.

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 23–27 (“challenged claims”) of U.S. Patent No. 8,554,196 B2 (Ex. 1001, “the ’196 patent”). Cobblestone Wireless LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Petitioner filed a Motion for Joinder (Paper 8, “Mot.”) seeking to be joined as a party to *T-Mobile USA, Inc. et al. v. Cobblestone Wireless, LLC*, IPR2024-00135 (the “*T-Mobile* IPR”). Patent Owner filed an Opposition to the Motion for Joinder (Paper 10, “Oppn.”)¹ and Petitioner filed a Reply (Paper 11, “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 Patent Owner was “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.” Paper 9. Patent Owner timely filed a short submission titled “Patent Owner’s Response to Petitioner’s Motion for Joinder” in which Patent Owner stated that if Petitioner “does not agree to be bound by” the stipulation in the *T-Mobile* IPR, “Patent Owner takes no position on” Petitioner’s Motion for Joinder. Oppn. 2. Patent Owner was authorized to file only an Opposition, not another paper. *See* Paper 9 (stating that “the parties are not authorized to file any other papers”). We treat Patent Owner’s “Response” (Oppn.) as an Opposition and address arguments to the extent that Patent Owner opposes Petitioner’s Motion for Joinder.

II. BACKGROUND

A. *Real Parties in Interest*

Petitioner identifies Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. as real parties in interest. Pet. 43. Petitioner also states “[o]ut of an abundance of caution and to avoid additional issues associated with real parties-in-interest, Petitioners likewise identify 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 Petitioners’ 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 ’196 patent, the following district court proceedings: *Cobblestone Wireless, LLC v. T-Mobile USA, Inc.*, No. 2:22-cv-00477 (E.D. Tex.); *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.) (referred to herein as the “parallel district court case”). Pet. 43–44; Paper 5, 2. As indicated above, the *T-Mobile* IPR is related because it involves challenges to the same claims of the same patent. Also, Petitioner filed an additional petition on December 18, 2023, challenging the ’196 patent in IPR2024-00318 (“the ’318 IPR”).

C. *The ’196 Patent*

The ’196 patent is titled “Network Coverage by Cycling through Beam Shape Coverage Configurations.” Ex. 1001, code (54). The ’196

patent relates to wireless communication networks populated by devices that include both phone and data functionality. *Id.* at 1:11–13. The '196 patent describes providing coverage to continuous use devices that are actively involved in substantially continuous service with the network including a voice call, a download, or content streaming. *Id.* at 3:45–51. The '196 patent also describes providing coverage to interval use devices, which do not require continuous service. *Id.* at 3:51–54. Instead, service to an interval use device may be postponed and batched while the device is covered by a less capable network and then service is performed when the device is covered by a more capable network. *Id.* at 6:44–56. Exemplary interval services include social networking applications, email, Really Simple Syndication (“RSS”) feeds, map updates, game updates, and sports score updates. *Id.* at 6:59–62.

One embodiment of a method for interval use devices receiving data updates is illustrated in Figure 3. *Id.* at 10:8–9.

300

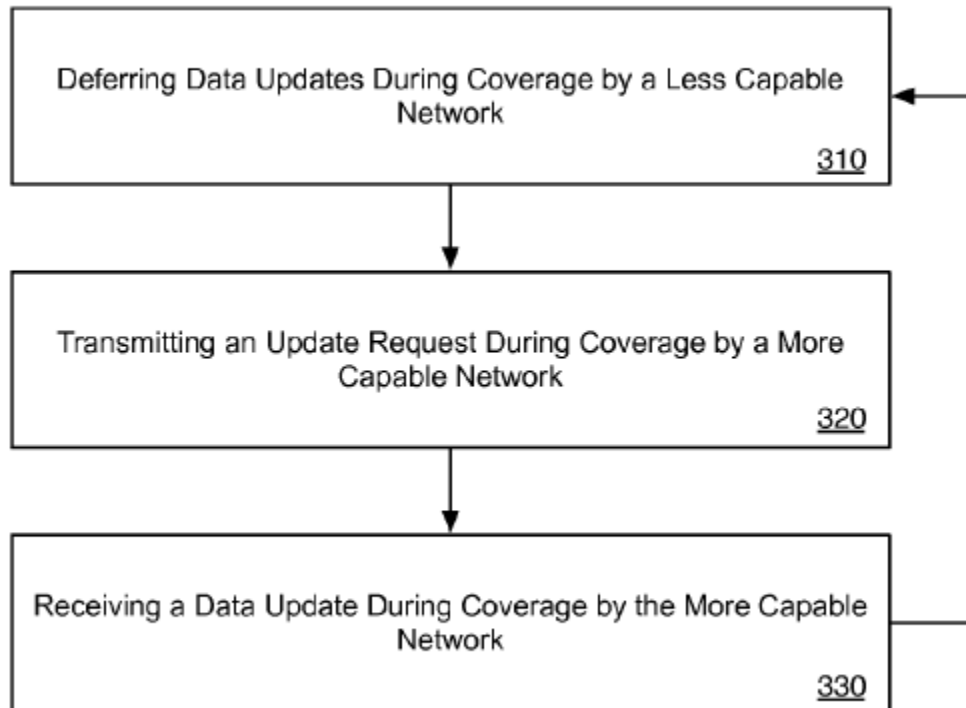


Fig. 3

Figure 3, above, illustrates method 300 for an interval use device to receive data updates.

At block 310, an interval use device defers data updates for intermittent use applications while covered by a less capable network. *Id.* at 10:23–26. At block 320, the interval use device detects coverage by a more capable network and transmits an update request. *Id.* at 10:65–11:1. At block 330, the interval use device receives a data update over the network in response to the transmitted data update request. *Id.* at 11:9–13.

D. Illustrative Claim

Petitioner challenges claims 23–27 of the '196 patent. Pet. 3. Claim 23 is the only independent challenged claim. Claims 24–27 depend directly

from claim 23. Independent claim 23, reproduced below, is illustrative of the claimed subject matter.

23. [23.0²] A method for a device to receive data updates comprising:

[23.1] cycling over time through an update sequence that includes:

[23.2] deferring, during coverage by a first network, data updates for the device;

[23.3] transmitting a data update request in response to coverage by a second network, wherein the second network is a more capable network than the first network; and

[23.4] receiving, during the second coverage configuration, a data update.

Ex. 1001, 22:21–31.

E. Evidence

Petitioner relies on the patent reference in the table below.

Name	Reference	Exhibit
Chang	US 9,830,642 B2, filed June 28, 2011, issued Nov. 28, 2017	1004

Petitioner also relies on the Declaration of Mr. James A. Proctor (Ex. 1003) 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 '196 patent are unpatentable based on the ground in the table below (Pet. 3):

² Herein we use Petitioner's designations for the elements of claim 23. Pet. 16–33.

Claims Challenged	35 U.S.C. § ³	Reference/Basis
23–27	103(a)	Chang

III. ANALYSIS

A. Discretionary Denial Argument

Patent Owner asserts “[t]o the extent that the Board institutes review of the First Petition, institution of the Second Petition should be denied as an unnecessary parallel petition.” Prelim. Resp. 3. We denied institution in the first ranked proceeding. *See Samsung Electronics America, Inc., v. Cobblestone Wireless LLC*, IPR2024-00318, Paper 11 (PTAB June 21, 2024).

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 grounds on which we instituted review in the *T-Mobile* IPR. *Compare* Pet. 3, 12–39, *with T-Mobile* IPR, Paper 1, 6, 16–41. Indeed, Petitioner contends that “the grounds of challenge in this Petition are a ‘copycat’ of the Petition filed in *T-Mobile USA, Inc. et al. v. Cobblestone Wireless, LLC*, IPR2024-00135” and the “expert declaration filed in this proceeding is substantively identical to the expert declaration in IPR2024-00135 and signed by the same expert.” *Id.* at 1.

³ 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 ’196 patent have an apparent effective filing date before March 16, 2013, the pre-AIA version of § 103 applies.

We instituted *inter partes* review of claims 23–27 of the ’196 Patent on April 30, 2024, based on the petition filed in the *T-Mobile* IPR. *T-Mobile* IPR, Paper 10. 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 ’196 patent is unpatentable. *See id.* Accordingly, we find the Petition warrants institution of *inter partes* review of all challenged claims on all grounds raised in the Petition.

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 76.⁴

⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Petitioner argues joinder is appropriate in this proceeding because “[a]ll four factors considered by the Board weigh in favor of 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.* Petitioner further argues “the briefing and discovery will be simplified by resolving all issues in a single proceeding.” *Id.*

As indicated above, Patent Owner was “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.” Paper 9, 4. Patent Owner filed a “Response” (Oppn. 1) which we treat as an Opposition, and we address arguments to the extent that Patent Owner opposes Petitioner’s Motion for Joinder. In its Opposition, Patent Owner states

[I]f Samsung does not agree to be bound by Carriers’ *Sand Revolution* stipulation as a result of joinder, then Patent Owner takes no position on [Petitioner’s] motion for Joinder (Paper 8). Petitioner respectfully requests that the Board independently consider the following:

1. Whether joinder is appropriate in view of the facts, and
2. Whether the PTAB, the District Court, or a combination of both the PTAB and the District Court have authority to decide whether Petitioner will be bound by the Carriers’ stipulation as a result of joinder.

Oppn. 2–3.

Petitioner states in its Reply to Patent Owner's Opposition "[t]here is also no reason, and this Board, respectfully, has no authority, to force Petitioners to be bound by the Carriers' *Sand Revolution*-style stipulation." Reply 2. Petitioner argues "the purpose of a *Sand Revolution*-style stipulation is to give the Board some assurance that, under *Fintiv* Factor 4,^[5] the issues in the IPR proceeding will not completely overlap with issues presented in the District Court." *Id.* Petitioner further argues "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." *Id.*

We start with the first of Patent Owner's arguments, which is that we should consider "[w]hether joinder is appropriate in view of the facts." Oppn. 2. Patent Owner states if "Petitioner will be bound by the Carrier's *Sand Revolution* stipulation in the Carrier's IPR2024-00135," then "Patent Owner agrees that joinder is appropriate." *Id.* Further, Patent Owner states that "if [Petitioner] does not agree to be bound by [the] Carriers' *Sand Revolution* stipulation as a result of joinder, then Patent Owner takes no position on Samsung's motion for Joinder." *Id.* Thus, Patent Owner does not argue that joinder is inappropriate; Patent Owner only disputes whether Petitioner should be bound by the Carriers' stipulation if joinder is granted.

Consistent with Petitioner's argument (*see, e.g.*, Reply 2), however, Patent Owner has not argued in the instant proceeding or in the *T-Mobile* IPR that we should exercise discretion and deny institution on the basis of a parallel district court proceeding. As we discuss below, we find that the

⁵ *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*").

factors set forth in the Trial Practice Guide favor granting Petitioner's Motion. We make our finding without the need to consider any stipulation.

We turn to Patent Owner's second argument, which is that we should consider "[w]hether the PTAB, the District Court, or a combination of both the PTAB and the District Court have authority to decide whether Petitioner will be bound by the Carriers' stipulation as a result of joinder." Oppn. 3. Based on the record before us, as discussed further below, we determine that joinder is appropriate in this case in the absence of a stipulation by Petitioner.⁶

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 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.,* 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* 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* Mot. 6, 9–11. Accordingly, joinder to the *T-*

⁶ Patent Owner has not presented persuasive argument that we should or have authority to bind Petitioner in any district court proceeding, and we discern no reason or authority based on the current record to make such a determination.

Mobile IPR would result in the 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. At this stage of the proceeding and on this record, we do not require Petitioner to agree to be bound in the instant *inter partes* review or in IPR2024-00135 by the stipulation filed in the *T-Mobile* IPR as a condition of our granting the Motion for Joinder with IPR2024-00135, and joining Petitioner as a petitioner in IPR2024-00135.

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 23–27 of the '196 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 IPR2024-00135 is granted, and Petitioner is joined as a petitioner in IPR2024-00135;

FURTHER ORDERED that Petitioner's role in IPR2024-00135 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, and Cellco Partnership d/b/a Verizon Wireless ceases to participate in IPR2024-00135;

FURTHER ORDERED that, at this stage of the proceeding, Petitioner is not required to agree to be bound in the instant *inter partes* review or in

IPR2024-00135 by the stipulation filed in the *T-Mobile* IPR as a condition of our granting the Motion for Joinder with IPR2024-00135, and joining Petitioner as a petitioner in IPR2024-00135;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2024-00135 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order in IPR2024-00135, and any modifications thereto, shall govern the schedule of the joined proceeding;

FURTHER ORDERED that all further filings shall be made in IPR2024-00135;

FURTHER ORDERED that the case caption in IPR2024-00135 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 IPR2024-00135; and

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE USA, INC., AT&T SERVICES INC.,
AT&T MOBILITY LLC, AT&T CORPORATION,
CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
SAMSUNG ELECTRONICS AMERICA, INC. and
SAMSUNG ELECTRONICS CO., LTD.,⁷
Petitioner,

v.

COBBLESTONE WIRELESS LLC,
Patent Owner.

IPR2024-00135
Patent 8,554,196 B2

⁷ 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 IPR2024-00317, which were granted.