

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. IPR2024-00318

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

PETITIONER'S PRELIMINARY REPLY

Ex.	Description
1001	U.S. Patent No. 8,554,196 (“196 patent”)
1002	File History for U.S. Patent No. 8,554,196
1003	Declaration of Dr. Kevin Almeroth
1004	<i>Curriculum Vitae</i> of Dr. Kevin Almeroth
1005	U.S. Patent Pub. No. 2005/0261028 (“Chitrapu”)
1006	U.S. Patent No. 8,548,525 (“Wong”)
1007	U.S. Patent No. 8,285,291 (“Dinan”)
1008	Patent Owner’s Infringement Contentions in <i>Cobblestone Wireless, LLC v. Samsung Electronics America, Inc., et al.</i> , No. 2:23-cv-00285 (E.D. Tex.) filed June 16, 2023
1009	<i>Cobblestone Wireless, LLC v. Samsung Electronics Co., Ltd.</i> , No. 2:22-cv-00285-JRG-RSP, Dkt. 29-1, Docket Control Order
1010	Complaint for Patent Infringement, <i>Cobblestone Wireless, LLC v. Samsung Electronics America, Inc., et al.</i> , No. 2:23-cv-00285 (E.D. Tex.) filed June 16, 2023
1011	March 5, 2024 email from Jon Ma (Cobblestone counsel) to Michael Deane <i>et al.</i> (Carriers’ counsel) with subject line “Cobblestone v. T-Mobile et al – PR 4-3”

PO's Preliminary Response seeks to blame Petitioners ("Samsung") and real parties-in-interest T-Mobile USA, Inc., *et al.* ("the Carriers") for the three (two of which are identical) currently-pending IPR Petitions challenging the '196 Patent. But the Response ignores that these petitions were all necessitated by PO's litigation strategy of filing two suits six months apart against different parties, asserting materially different claims of the '196 patent against non-overlapping Samsung products. PO's actions create the rare case where Samsung's two Petitions are justified. Indeed, one of the petitions is a copycat, and will be the subject to a motion to join where Samsung will take a secondary role—if Samsung's two petitions were combined, Petitioner would likely argue against joinder because the combined Petition would raise substantially different arguments.

Regardless, Samsung followed the requirements of the TPG and ranked the instant Petition over its Copycat Petition, indicating its preference over the Carriers' Petition as well. Indeed, Samsung explicitly pointed out that the Copycat Petition would be joined to another. There is no basis to exercise discretion to deny as a parallel Petition.

I. THE '196 PATENT

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 use service or interval use service to devices, and (2) claims 23-27, which describe a user device deferring data updates until it is on a more capable network.

II. LITIGATION HISTORY

PO first brought lawsuits against the Carriers in mid-December 2022, asserting the '196 Patent. *See* No. 2:22-cv-00477 (E.D. Tex.), 2:22-cv-00474 (E.D. Tex.), 2:23-cv-00285 (E.D. Tex.). In each of the complaints, PO alleged that certain Samsung smartphones infringed claim 23 of the '196 patent. Then in its infringement contentions, PO asserted claims 23-27, accusing app store functionalities on Samsung's smartphones that deferred updates until the device is on a Wi-Fi network. IPR2024-00135, Exhibit 1008.

Six months later, on June 16, 2023, PO sued Samsung, this time accusing “cellular base stations that support providing network coverage using different types of beams and network” of infringing claim 1. Ex. 1010, ¶¶17-20. PO's infringement contentions would go on to accuse Samsung “4G base stations” and “5G base stations” that support “simultaneous 5G and LTE coverage for a group of devices” of infringing claims 1-6, 7, 10, 12, 14, 17, 18, 20, and 21. Ex. 1008. Notably, PO has **not** asserted claims 23-27 against Samsung. Thus, between the two cases, the asserted claims, accused products, and accused functionalities have no overlap.

On November 22, 2023, the Carriers filed an *inter partes* review Petition (“Carriers’ Petition”) challenging claims 23-27 of the '196 patent as obvious over

Chang, which is an Apple patent that discloses deferral of App Store updates until a device is on a Wi-Fi network. IPR2024-00135, Paper 2. The Carriers identified Samsung as a real party-in-interest. *Id.* PO did not file a preliminary response and also informed the Carriers in March that it will not assert the '196 patent in the Carriers' case. Ex. 1011. The Board instituted on April 30, 2024.

On December 18, 2023, Samsung filed two IPR Petitions challenging the '196 patent. In IPR2024-00317, Samsung filed a Petition that was a copycat of the Carriers' Petition ("Copycat Petition"), challenging claims 23-27 as obvious over Chang for the same reasons. Samsung indicated and now intends to use the Copycat Petition to move for joinder. IPR2024-00317, Paper 3 at 41; *see also* Pet. 69.

In the instant case, Samsung filed a Petition ("Instant Petition") against the claims asserted against Samsung, relying on materially different prior art. In accordance with the requirements of the Trial Practice Guide, Samsung explained why PO's actions necessitated two Petitions and ranked the Instant Petition over the Copycat Petition. Pet. 69-71.

III. ANALYSIS

The Trial Practice Guide cautions against parallel petitions because they "may place a substantial and unnecessary burden on the Board." TPG at 59. However, "the Board recognizes that there may be circumstances in which more than one petition may be necessary." *Id.*

This is the rare case where Samsung was justified in bringing two Petitions as they were necessitated by PO's litigation tactics. Between the two litigations brought six months apart, it was PO's decision to assert two sets of materially different claims against two different, non-overlapping sets of Samsung products. It is understandable that, with trial looming, the Carriers brought an earlier Petition only challenging the claims asserted against them, especially since the claims against Samsung were only asserted ***one month*** before the Carriers' Petition. Ex. 1008.

Samsung was therefore left with little choice but to file two separate Petitions: (1) the Instant Petition in order to challenge claims uniquely asserted against Samsung, and (2) the Copycat Petition to join the Carriers' Petition and preserve Samsung's rights if the Carriers settled with PO, a particularly salient concern now that PO is no longer asserting the '196 patent against the Carriers.

Forcing Samsung to file only one Petition (or none at all as PO urges) would simply reward PO's gamesmanship while greatly prejudicing Samsung and future Petitioners. Indeed, if Samsung filed a single, combined Petition, Patent Owner would likely argue against joinder with the Carriers' Petition because of the new challenged claims and new art. *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."). Yet given the duplicative issues with the Carriers' Petition, a combined Petition might itself be denied under *General*

Plastic. IPR2016-01357, Paper 19 at 17 (“Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.”).

But if Samsung proceeded with the Instant Petition without a Copycat Petition, then it could not challenge claims that have been asserted against Samsung’s products (and could still be asserted in the future) if the Carriers settled.

By contrast, there is no “substantial and unnecessary burden” if the Board proceeds with all three Petitions. The two identical Petitions would be joined, creating no additional burden. The Instant Petition is likewise not a “substantial and unnecessary burden” because it challenges materially different claims with different art. Any burden from multiple proceedings (which was caused by PO’s dilatory tactics) can be mitigated via consolidation—the equivalent of the parties filing one combined Petition, which PO has admitted would fit within the word count and not result in an excessive number of issues that burdened the Board. POPR 35-36.

In the event the Board is inclined to only institute one of Samsung’s Petitions, then the Board should proceed with the Instant Petition as Samsung indicated pursuant to the TPG. Pet. 42. The TPG does not require that Samsung also rank the Carriers’ Petition. TPG 60 (“[I]f **a petitioner** files two or more petitions challenging the same patent, then **the petitioner** should... identify... a ranking ...”). Regardless, it was eminently clear that Samsung ranked the Instant Petition over the others. There is therefore no basis to deny the Instant Petition as a parallel Petition.

Date: May 14, 2024

Respectfully submitted,

By: /s/ James M. Glass
James M. Glass

Counsel for Petitioners

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on May 14, 2024, true and correct copies of the foregoing document were served in its entirety on the following parties via Electronic Mail

rmirzaie@raklaw.com
rak_cobblestone@raklaw.com
ahayden@raklaw.com
nrubin@raklaw.com
ptong@raklaw.com

Date: May 14, 2024

By: /s/ James M. Glass
James Glass
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Avenue, 22nd Floor
New York, NY 10010
Tel: (212) 849-7000
Fax: (212) 849-7100

Counsel for Petitioners