

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC. and
SAMSUNG ELECTRONICS CO., LTD.,
Petitioners,

v.

COBBLESTONE WIRELESS, LLC,
Patent Owner.

IPR2024-00318
Patent 8,554,196

PATENT OWNER'S PRELIMINARY SUR-REPLY

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No.	Description
Ex. 2001	Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
Ex. 2002	<i>T-Mobile USA, Inc. et al. v. Cobblestone Wireless, LLC</i> , IPR2024-00135, Paper 1 (IPR Petition) (PTAB Nov. 30, 2023)
Ex. 2003	Federal Court Management Statistics for the Eastern District of Texas through December 2023, <i>available at</i> https://www.uscourts.gov/statistics-reports/federal-court-management-statistics-december-2023
Ex. 2004	<i>Cobblestone Wireless, LLC v. AT&T Servs. Inc. et al.</i> , No. 2:22-cv-00474, Dkt. No. 1 (Complaint for Patent Infringement) (E.D. Tex. Dec. 15, 2022)
Ex. 2005	<i>Cobblestone Wireless, LLC v. AT&T Servs. Inc. et al.</i> , No. 2:22-cv-00474, Dkt. No. 13 (Proof of Service of Summons to AT&T Services Inc.) (E.D. Tex. Dec. 23, 2022)
Ex. 2006	<i>Cobblestone Wireless, LLC v. AT&T Servs. Inc. et al.</i> , No. 2:22-cv-00474, Plaintiff Cobblestone Wireless, LLC's Preliminary Disclosure of Asserted Claims and Infringement Contentions (E.D. Tex., served Mar. 13, 2023)
Ex. 2007	<i>Cobblestone Wireless, LLC v. Cellco P'Ship d/b/a Verizon Wireless</i> , No. 2:22-cv-00478, Plaintiff Cobblestone Wireless, LLC's Preliminary Disclosure of Asserted Claims and Infringement Contentions (E.D. Tex., served Mar. 13, 2023)
Ex. 2008	<i>Cobblestone Wireless, LLC v. T-Mobile USA, Inc.</i> , No. 2:22-cv-00477, Plaintiff Cobblestone Wireless, LLC's Preliminary Disclosure of Asserted Claims and Infringement Contentions (E.D. Tex., served Mar. 13, 2023)
Ex. 2009	<i>Cobblestone Wireless, LLC v. T-Mobile USA, Inc.</i> , No. 2:22-cv-00477 (lead case), Defendants' and Intervenor's Preliminary Invalidity Contentions for U.S. Patent No. 8,554,196 (E.D. Tex., served May 12, 2023)

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Ex. 2010	<i>Cobblestone Wireless, LLC v. Samsung Electronics Co. et al.</i> , No. 2:23-cv-00285, Dkt. No. 30 (Docket Control Order) (E.D. Tex. Oct. 17, 2023)
Ex. 2011	<i>Cobblestone Wireless, LLC v. Samsung Electronics Co. et al.</i> , No. 2:23-cv-00285, Dkt. No. 39 (Order Granting Motion to Amend Docket Control Order) (E.D. Tex. Dec. 29, 2023)
Ex. 2012	<i>Cobblestone Wireless, LLC v. Samsung Electronics Co. et al.</i> , No. 2:23-cv-00285, Dkt. No. 1 (Complaint for Patent Infringement) (E.D. Tex. June 16, 2023)
Ex. 2013	<i>Cobblestone Wireless, LLC v. Samsung Electronics Co. et al.</i> , No. 2:23-cv-00285, Dkt. No. 6 (Proof of Service) (E.D. Tex. June 16, 2023)
Ex. 2014	<i>Samsung Elecs. Am., Inc. et al. v. Cobblestone Wireless, LLC</i> , IPR2024-00319, Paper 3 (IPR Petition) (PTAB Dec. 18, 2023)
Ex. 2015	<i>Samsung Elecs. Am., Inc. et al. v. Cobblestone Wireless, LLC</i> , IPR2024-00315, Paper 3 (IPR Petition) (PTAB Dec. 18, 2023)
Ex. 2016	<i>Samsung Elecs. Am., Inc. et al. v. Cobblestone Wireless, LLC</i> , IPR2024-00317, Paper 3 (IPR Petition) (PTAB Dec. 18, 2023)
Ex. 2017	<i>Samsung Elecs. Am., Inc. et al. v. Cobblestone Wireless, LLC</i> , IPR2024-00316, Paper 3 (IPR Petition) (PTAB Dec. 18, 2023)
Ex. 2018	<i>Cobblestone Wireless, LLC v. Samsung Electronics Co. et al.</i> , No. 2:23-cv-00285, Plaintiff Cobblestone Wireless, LLC’s Preliminary Disclosure of Asserted Claims and Infringement Contentions (E.D. Tex., served Sept. 23, 2023)
Ex. 2019	<i>Cobblestone Wireless, LLC v. Samsung Electronics Co. et al.</i> , No. 2:23-cv-00285, Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc.’s P.R. 3-3 and 3-4 Invalidity Contentions (E.D. Tex., served Dec. 27, 2023)
Ex. 2020	Email from the Board to counsel for Petitioners and Patent Owner, dated May 23, 2024
Ex. 2021	<i>Cobblestone Wireless, LLC v. T-Mobile USA, Inc.</i> , No. 2:22-cv-00477, Dkt. No. 1 (Complaint for Patent Infringement) (E.D. Tex. Dec. 16, 2022)

No.	Description
Ex. 2022	<i>Cobblestone Wireless, LLC v. Cellco P'ship d/b/a/ Verizon Wireless</i> , No. 2:22-cv-00478, Dkt. No. 1 (Complaint for Patent Infringement) (E.D. Tex. Dec. 16, 2022)

It is undisputed Petitioner Samsung Electronics Co., Ltd. is an RPI in an IPR proceeding filed by T-Mobile, AT&T, and Verizon (“the Carriers”) shortly before the instant Petition, challenging the same patent challenged here. It is also undisputed Petitioners could have included the content of this Petition in that earlier petition. Even on reply, Petitioners still offer no coherent explanation for why they did not do so. Rather, they attempt to shift the blame to Patent Owner, but Patent Owner has done nothing that required Petitioners and their co-RPIs to file *three* petitions on the same patent. The instant Petition should be denied as an unjustified parallel petition.

I. It is undisputed Samsung Electronics Co., Ltd. is an RPI in an earlier-filed proceeding challenging the same patent, and Petitioners intend to move to join that proceeding.

Petitioners do not and cannot dispute Samsung Electronics Co., Ltd. is an RPI in an instituted IPR proceeding on the same patent, IPR2024-00135—what is referred to as the First Petition in the POPR. Reply 3. Petitioners have also “indicated and now intend[] to use the[ir] Copycat Petition [in IPR2024-00317] to move for joinder” in that earlier filed proceeding—the Copycat Petition is referred to as the Third Petition in the POPR. *Id.* 1. The Board granted leave for Samsung to file this motion; Patent Owner does not oppose it. Ex. 2020, 1.

II. It is undisputed Petitioners could have included the content of the instant Petition in the First Petition.

As explained in the POPR, “even if Petitioners are correct that the Challenged

Claims in the [instant] Second Petition are materially different than the Challenged claims in the First and Third Petitions, Petitioners still have not justified multiple petitions here and particularly not why the instant Second Petition is necessary.” POPR 34 (cleaned up). In particular, Patent Owner pointed out word count limitations would not have prevented Petitioners and their co-RPIs from filing a single petition addressing the claims challenged in all three petitions. *Id.* 34-35. On reply, Petitioners admit “*the equivalent of the parties filing one combined Petition ... would fit within the word count*” requirements. Reply 5 (emphasis added).

III. Patent Owner has done nothing that required multiple petitions from Petitioners and their co-RPIs.

Left with no viable explanation for their failure to comply with the Board’s guidance on parallel petitions, Petitioners attempt to shift the blame to Patent Owner, claiming that “PO’s litigation strategy of filing two suits six months apart against different parties” “necessitated” multiple petitions. *Id.* 1. A quick examination of the timeline of events reveals this is not so:

- December 15-16, 2022: Cobblestone files suit against the Carriers, alleging among other things, infringement of the ’196 Patent. Exs. 2004, 2021, 2022.
- March 13, 2023: Patent Owner serves infringement contentions in the Carrier cases, asserting claims 23-27. Ex. 2006, 1; Ex. 2007, 1; Ex. 2008, 1.
- June 16, 2023: Patent Owner files suit against the Samsung Petitioners,

alleging among other things, infringement of the '196 Patent. Ex. 2012.

- September 23, 2023: Patent Owner serves infringement contentions on Samsung, asserting claims 1-5, 7, 10, 12, 14, 17, 18, 20, and 21. Ex. 2018, 2.
- November 22, 2023: The Carriers file the First Petition, naming Samsung Electronics Co., Ltd. as an RPI and challenging claims 23-27. Ex. 2002, 3, 6.
- December 18, 2023: Samsung files (a) the instant Second Petition, naming the Carriers as RPIs and challenging claims 1-5, 7, 8, 10, 12, 14, 17, 18, 20, and 21 (Pet. 3, 71), and (b) the Third Petition, again naming the Carriers as RPIs and challenging claims 23-27 (Ex. 2016, 3, 43).

The Samsung Petitioners do not dispute this timeline of events. *See* Reply 2-3. They were thus admittedly aware of the claims asserted against them in litigation well before their co-RPIs filed the First Petition. Indeed, the Samsung Petitioners admit, as they must, that Patent Owner's infringement contentions setting out the exact claims that would be at issue in the case against them were served *before* (more than a month before) the Carriers filed the First Petition. *Id.* 4.

Rather than coordinating with their co-RPIs and filing a single petition challenging all claims addressed in the First, Second, and Third Petitions, the Samsung Petitioners and the Carriers opted to unnecessarily duplicate proceedings, placing strain on Board resources and burdening Patent Owner. This is particularly egregious here where the Samsung Petitioners admit on reply that all of the

challenges could have been raised within the confines of one petition (*Id.* 5), and offer no coherent explanation for why they and their co-RPIs did not do so.

IV. The Board’s parallel petitions guidance applies equally to petitioners and their RPIs.

In their Reply, Petitioners imply that the Board’s parallel petitions guidance in the Consolidated Trial Practice Guide (“CTPG”) applies only to petitioners and not to their RPIs. *Id.* 5. This is incorrect. Although the CTPG does not explicitly mention RPIs in its discussion of parallel petitions, recent legislative history makes clear that the Board has discretion to deny institution when “more than one petition is filed by the *same petitioner (or privy or real party in interest with a petitioner)* at the same time as the first filed petition or up until the filing of the preliminary response in the first filed proceeding (‘parallel petitions’).” 88 Fed. Reg. 24503, 24506. Patent Owner cited and quoted this legislative history in its preliminary response (POPR at 31), and Petitioners failed to address it on reply.

Patent Owner also explained in its preliminary response (*id.*) that the policy expressed in this legislative history comports with what the Federal Circuit has recognized as one of the purposes of the AIA: to “prevent *not only petitioners, but also real parties in interest*, from requesting or maintaining alternative administrative attacks on any ground that the petitioner raised or reasonable could have raised during [an] inter parties review.” *Applications in Internet Time, LLC v.*

RPX Corp., 897 F.3d 1336, 1349 (Fed. Cir. 2018) (cleaned up). Similarly, both the IPR time bar and estoppel statutes apply equally to petitioners and their RPIs. 35 U.S.C. § 315(b) (The clock for the IPR time-bar begins when “***the petitioner, real party in interest***, or privy of the petitioner ***is served with a complaint*** alleging infringement of the patent.”) (emphases added); 35 U.S.C. §§ 315(e)(1)-(2) (“The ***petitioner in an inter partes review*** ... that results in a final written decision ..., ***or the real party in interest or privy of the petitioner***, may not [request or maintain a proceeding before the Office]/[assert in a civil action] ... any ground that the petitioner raised or reasonably could have raised during that inter partes review.”) (emphases added).

The same reasoning and policy implications apply to the Board’s parallel petitions guidance—Patent Owner “should not be forced to defend ... attacks on the same or related grounds by a party that is so closely related to the original petitioner as to qualify as a real party in interest.” *See SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 at 20 (PTAB Oct. 6, 2020) (precedential).

The Board should exercise its discretion and deny institution of the Petition, which was filed less than one-month after Petitioners’ RPIs filed the First Petition on the same patent. Critically, Petitioners not only admit they could have included the challenges of the instant Petition in that First Petition, but they also provide no cognizable reason for why they did not do so.

Date: May 28, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on May 28, 2024, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioners:

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