

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. IPR2024-00319

U.S. Patent No. 8,891,347

PETITIONER'S PRELIMINARY REPLY

Patent Owner’s Preliminary Response (Paper 7) argues that the Board should exercise its discretion to deny because: (1) Petitioners purportedly rely on constructions it disagrees with, and (2) Petitioners and real parties-in-interest T-Mobile USA, Inc., *et al.* (“Carriers”) have filed petitions against the same patent.

Neither argument has merit. The Board has repeatedly held that Petitioners may rely on a claim construction position that it disagrees with, so long as the claim construction relied upon in the Petition is clearly set forth. As to the second issue, Petitioners and the Carriers are different parties with their own interests (and defending lawsuits six months apart due entirely to Patent Owner’s litigation strategy), and neither *General Plastic* nor the TPG justify denial of the Petition.

I. PETITIONERS CAN RELY ON A CLAIM CONSTRUCTION IT DISAGREES WITH

The Petition (Paper 3) (“Pet.”) is clear that it applies the claim terms “path parameter information” and “predistorting” in the same manner as Patent Owner’s district court infringement contentions. *See* Pet. 10-13. Patent Owner contends that, by disagreeing with these constructions, Patent Owner is entitled to the extreme remedy of discretionary denial for failure to satisfy Rule 42.104(b)(3). POPR 7. Patent Owner is incorrect. The Board has repeatedly held that a Petition may rely on a Patent Owner’s construction, even if Petitioner believes it is incorrect.

For example, in *Philip Morris Products, S.A. v. Rai Strategic Holdings, Inc.*, IPR2020-00921, Paper 13 at 42-44 (Aug. 5, 2021), the Board recognized that

“[n]umerous decisions have held that [Section 42.104(b)(3)] does not require a petitioner to express a subjective belief in the correctness of its proffered claim constructions.” Moreover, *Petitioner can “rely[] on claim constructions that it believes are incorrect.”* *Id.* Many other cases reiterate this well-accepted position. *See, e.g., 10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00086, Paper 8 at 17–22 (Apr. 27, 2020); *Google LLC v. AGIS Software Development, LLC*, IPR2018-01085, Paper 10 at 10 (Nov. 19, 2018); *General Electric Co. v. Vestas Wind Sys. A/S*, IPR2018-00928, Paper 9 at 12–17 (Nov. 5, 2018); *Apple, Inc. v. AGIS Software Development, LLC*, IPR2018-00821, Paper 9 at 10 (PTAB Oct. 23, 2018).

Patent Owner extensively relies on *Hologic*, a decision from 2018 that had a dissenting judge and has since been repudiated by the Board. As an initial matter, *Hologic* is distinguishable because there, the Petitioner provided competing claim constructions that it chose not apply—by contrast, Petitioners here present and apply Patent Owner’s construction without providing an alternative construction for the Board to consider. In addition, in *Lewis Machine & Tool Co. v. WHG Properties, LLC*, IPR2020-00373, Paper 6 at 33-34 (July 27, 2020), the Board noted that *Hologic* “is neither informative nor precedential” and that “we are not persuaded that our rules prohibit Petitioner from relying on a claim construction it believes is incorrect.”

Patent Owner’s cases, on the other hand, are inapposite. *Orthopediatrics*, IPR2018-01548, Paper 9, did not involve Petitioner relying on a claim construction

it disagreed with. Instead, Petitioner did not provide any construction of an important means-plus-function term, did not even “set forth Patent Owner’s position in the related District Court litigation,” and did not “address substantively the District Court’s claim construction.” *Id.* at 10-11. Here, Petitioners provided and relied on Patent Owner’s litigation position, no MPF limitations are involved, and there is no District Court construction to consider.

Samsung, IPR2020-00046, Paper 6, involved an MPF limitation where Petitioner urged the Board to find that the limitation lacked corresponding structure. The Board worried that if it instituted and “agree[d] with Petitioner,” the Board “would be put in the position of attempting to apply prior art to claims that might not be amenable to construction.” *Id.* at 10. Thus, the Board denied institution because it could not “ascertain the scope of a claim with reasonable certainty.” *Id.* (quoting *Samsung Elecs. Am., Inc. v. Prisia Eng’g Corp.*, 948 F.3d 1342, 1353 (Fed. Cir. 2020)). Again, this case does not involve MPF terms.

Finally, Patent Owner insists that it does not contend that “any channel state information feedback” satisfies limitation 1.3’s “path parameter information” as Petitioners contend, and instead contends the “infringing products obtain path parameter information for a ‘narrow-beam’ that discloses a single propagation path.” POPR 4-5. Patent Owner’s argument is plainly contradicted by Patent Owner’s infringement contentions for limitation 1.3 which do say nothing about “narrow-

beam” propagation path, but instead broadly accuses a user device “perform[ing] link **channel** state estimation” or that a “UE may be configured to measure CSI-RS [**channel** state information reference signals] and estimate the downlink **channel** state based on the CSI-RS measurements.” Ex. 1015, 6-7.

II. THIS PETITION IS NOT A PARALLEL ONE UNDER THE RULES

Patent Owner also argues the Instant Petition should be denied as an improper parallel petition because the Carriers filed an earlier Petition challenging the same claims. The TPG instructs for parallel petitions that “if **a petitioner** files two or more petitions challenging the same patent, then **the petitioner** should ... identify ... a ranking.” TPG 59-60. This instruction does not state that it applies to a real party-in-interest—and Patent Owner’s citation to the Federal Register that parallel petitions apply to RPIs was to “Changes **Under Consideration**” that have not yet been promulgated. POPR 55.

However, to the extent the Board is inclined to institute only one of the petitions, pursuant to the TPG, Petitioners rank the Instant Petition over the Carriers’ Petition. Petitioners have conferred with the Carriers, and they do not object to this ranking. Moreover, under Patent Owner’s own theory, the Carriers’ Petition is infirm for failure to provide a ranking, whereas the Instant Petition is not.

In addition, if the Board were to proceed with both petitions, the burden could be mitigated by joining or consolidating the proceedings. This would not pose an

extra burden on the Board or Petitioners, as the Instant Petition asserts the same ground as the Carriers' Petition (though adds an additional ground). Patent Owner may argue that it would be required to depose two experts—not true. Patent Owner could choose to depose just one of the experts, and in fact, deposing two experts presents Patent Owner with additional opportunities to obtain favorable admissions.

Finally, the *General Plastic* factors heavily weigh against discretionary denial. Petitioners and the Carriers are not the same or significantly related parties. Both petitions list each other as real parties-in-interest only out of an abundance of caution. However, the parties have separate interests, were sued in separate cases, have separate schedules, have separate counsel, and have separable liability. Specifically, Patent Owner has accused the Carriers of infringement via Ericsson, Nokia, and Samsung base stations, whereas Petitioners' liability is limited to Samsung base stations. *General Plastic* factors 3 through 7 also weigh against institution, since Petitioners filed the Instant Petition only a few weeks after the Carriers' Petition.

Valve Corp. v. Elec. Scripting Products is not applicable as the parties there had a “substantial relationship” because they were codefendants. IPR2019-00062, Paper 11 at 9-10. Here, Petitioners and the Carriers' cases are separated by six months and involve different accused products. Accordingly, Petitioners are entitled to their own petition.

Date: May 20, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on May 20, 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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