

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 IPR2024-00319  
Patent 8,891,347 B2

---

**PATENT OWNER'S AUTHORIZED PRELIMINARY SUR-REPLY**

## TABLE OF CONTENTS

|                                                                             | <b>Page</b> |
|-----------------------------------------------------------------------------|-------------|
| I. THE PETITION DOES NOT MEET THE MINIMUM THRESHOLD<br>FOR INSTITUTION..... | 1           |
| II. PETITIONERS FAIL TO JUSTIFY TWO PARALLEL PETITIONS.....                 | 4           |

Petitioners' Reply confirms that the Petition should be denied because it fails to meet the minimum threshold for institution (§ I), and because Petitioners have not justified maintaining two parallel petitions by two real parties in interest (§ II).

**I. THE PETITION DOES NOT MEET THE MINIMUM THRESHOLD FOR INSTITUTION.**

It is undisputed that the Petition is based solely upon claim constructions that the Petition expressly states are incorrect. POPR, 3-4. Even Patent Owner disagrees with those constructions. POPR, 4-5. As common sense, caselaw, and the Office's policy make clear, a petition under the *Phillips* standard cannot demonstrate a reasonable likelihood of showing unpatentability when all its analysis is based upon constructions it states are incorrect. POPR, 2-12.

Petitioners fail to distinguish directly on point authorities. They do not meaningfully distinguish *Hologic*, where the Board made clear that a "Petitioner does not satisfy Rule 42.104(b)(3) when, in a proceeding applying the *Phillips* claim-construction standard, it 'expressly disagree[s] with its proffered constructions.'" *Hologic, Inc. v. Enzo Life Sciences, Inc.*, IPR2018-00019, Paper 21, 6 (Nov. 28, 2018); *see also* POPR, 6-10 (discussing *Hologic*, *Orthopediatrics*, *Samsung*, and *Netflix*). Petitioners argue that *Hologic* is distinguishable because its petitioner recited alternative constructions that it did not apply. But that is irrelevant. *Hologic* directly addresses the precise issue raised here, based on its petitioner's sole reliance on constructions it denounced in the petition. POPR, 7.

Petitioners also do not address the Office’s guidance in connection with the shift to the *Phillips* standard. There, the Office agreed that the new standard “would prevent parties from taking inconsistent positions” and “[w]ith a uniform application of the *Phillips* standard, patent challengers ... will instead be required to choose a single claim construction that best captures the true meaning of the patent claim ...” POPR, 10 (quoting 83 Fed. Reg. 51,340, 51350 (Oct. 11, 2018)).

What is more, the Petition is based on constructions that ***no one agrees with***. POPR, 4. The Reply (at 3-4) responds that Patent Owner’s IPR interpretation “is plainly contradicted by Patent Owner’s infringement contentions for limitation 1.3 which say nothing about ‘narrow-beam’ propagation path.” But Patent Owner’s infringement contentions clearly explain that the claimed channel estimate of limitation 1[c] is for the first propagation path identified in limitation 1[a] and is a channel estimate based on the first signal of limitation 1[a], which is transmitted “via a narrow-beam antenna to the UE.” Ex. 1015 [Infringement Contentions] 5-6.

Petitioners rely upon a series of inapposite and, in any event, nonprecedential decisions. In *Philip Morris Products, S.A. v. Rai Strategic Holdings, Inc.*, IPR2020-00921, Paper 13 (Aug. 5, 2021) (cited by Reply, 1-2), the petitioner relied upon alternative constructions. IPR2020-00921, Paper 13, 43 (“a petitioner may rely on alternative claim constructions.”); *see also id.*, Paper 6, 31 (POPR explaining “Petitioner’s offer of alternative claim constructions ...”).

Similarly, in *10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00086, Paper 8 (Apr. 27, 2020) (cited by Reply, 2), “[p]etitioner propose[d] alternative claim constructions and present[ed] at least one ground of unpatentability for each construction.” IPR2020-00086, Paper 8, 22; *see also* POPR, 10 (discussing same). *Lewis Machine & Tool Company v. WHG Properties, LLC*, IPR2020-00373, Paper 6 (Jul. 27, 2020) confirms that a petitioner may present “alternative” constructions. *Id.*, 34. This is not controversial. A petitioner may rely upon alternative constructions. *See* POPR, 10-12. What a petitioner may not do, however, is rely *solely* upon constructions it expressly disagrees with in the petition itself.

Petitioners also cite a series of cases arising under the old BRI standard. *See Apple, Inc. v. AGIS Software Development, LLC*, IPR2018-00821, Paper 9 (PTAB Oct. 23, 2018); *Google LLC v. AGIS Software Development, LLC*, IPR2018-01085, Paper 10 (Nov. 19, 2018); *General Electric Co. v. Vestas Wind Sys. A/S*, IPR2018-00928, Paper 9, 11 (Nov. 5, 2018). Where different forums apply different claim construction standards, that may, naturally, result in different claim constructions. But that rationale vanishes when the claim construction standards were harmonized, and a “Petitioner does not satisfy Rule 42.104(b)(3) *when, in a proceeding applying the Phillips claim-construction standard*, it ‘expressly disagree[s] with its proffered constructions.’” IPR2018-00019, Paper 21, 6.

In sum, Petitioners rely solely upon a claim construction that it and Patent

Owner *both* expressly disagree with. This is indisputably not permitted under the Office's guidance and the POPR's cited caselaw. Petitioners' cases, by contrast, are readily distinguishable. Consequently, institution should be denied

## **II. PETITIONERS FAIL TO JUSTIFY TWO PARALLEL PETITIONS.**

The Reply also fails to justify why Petitioners and their RPIs should maintain two parallel petitions challenging the same claims. POPR, 53-61. Petitioners do not dispute that they and their RPIs filed largely duplicative petitions, attacking the same claims. Petitioners do not dispute that this would be an improper parallel petition if the same Petitioners had filed both.

Petitioners, however, argue that the Office policy against parallel petitioning does not apply to those filed by real parties 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." Reply, 4. But the portion of the Federal Register cited by Patent Owner discusses the "Background," not potential changes under consideration. POPR, 55 (citing 88 Fed. Reg. 24503, 24506 (Apr. 21, 2023)). There, the Office clarifies that the policy against parallel petitioning applies to petitions filed by real parties in interest. *Id.* Of course, this is also consistent with the Office's policy of considering any relationship between petitioners who file serial petitions. CTPG, 57.

And, again, the AIA was crafted 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 reasonably could have raised during that inter partes review.’” *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1349 (Fed. Cir. 2018); *SharkNinja Operating LLC v. IRobot Corp.*, IPR2020-00734, Paper 11, 20 (Oct. 6, 2020) (precedential) (“We understand that ‘[patent owners] should not be forced to defend later ... administrative 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.’”) (quoting *AIT*, 897 F.3d at 1350); *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 (Oct. 2, 2020) (“[T]he purpose of the RPI provision in IPRs was to protect patent holders from multiple petitions.”) (citing *AIT*, 1349-1350).

Petitioners argue that both petitions can be instituted and consolidated without posing “an extra burden on the Board or Petitioners.” Reply, 4-5. But Patent Owner will have to depose two experts, and address potentially two petitioner replies with potentially inconsistent positions. The Reply’s (at 5) characterization of this duplication of effort and burden as “opportunities to obtain favorable admissions” has no basis in any authority.

Finally, the Reply (at 5) presents a *General Plastics* analysis that is inapplicable here since the petitions at issue are parallel petitions. CTPG, 59.

Respectfully submitted,

          / Kenneth J. Weatherwax /          

Kenneth J. Weatherwax, Reg. No. 54,528  
Nathan Lowenstein, *pro hac vice* motion to  
be filed  
Parham Hendifar, Reg. No. 71,470  
LOWENSTEIN & WEATHERWAX LLP

Date: May 30, 2024

## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the following documents were served by electronic service, by consent between the parties (Pet. at 74), on the date signed below:

### **PATENT OWNER'S AUTHORIZED PRELIMINARY SUR-REPLY**

The names and address of the parties being served are as follows:

jimglass@quinnemanuel.com (James M. Glass)  
quincylu@quinnemanuel.com (Quincy Lu)  
jasonwiliams@quinnemanuel.com (Jason Williams)

Respectfully submitted,

/ Keith Moore /

---

Date: May 30, 2024