

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Qualcomm Incorporated
Petitioner,

v.

Cobblestone Wireless LLC
Patent Owner.

Case IPR2024-01336
Patent 7,924,802

**MOTION FOR JOINDER UNDER
35 U.S.C. § 325(c) AND 37 C.F.R. § 42.222(b)
TO RELATED *INTER PARTES* REVIEW IPR2024-00606**

TABLE OF CONTENTS

I.	STATEMENT OF THE PRECISE RELIEF REQUESTED.....	1
II.	STATEMENT OF REASONS FOR THE PRECISE RELIEF REQUESTED.....	2
A.	Legal Standard.....	2
B.	Petitioner’s Motion for Joinder is Timely.....	3
C.	Each Factor Weighs in Favor of Joinder.....	3
1.	Joinder is Appropriate.....	3
2.	Petitioner Proposes No New Grounds of Unpatentability.....	5
3.	Joinder Will Not Unduly Burden or Negatively Impact the Samsung IPR Trial Schedule	5
4.	Procedures to Simplify Briefing and Discovery	5
III.	<i>GENERAL PLASTIC</i> IS INAPPLICABLE	6
IV.	CONCLUSION.....	9

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Qualcomm Incorporated (“Qualcomm” or “Petitioner”) respectfully submits this Motion for Joinder, together with its Petition for *Inter Partes* Review of U.S. Patent No. 7,924,802 (“the ’802 Patent”) (IPR2024-01336 (“the Qualcomm Petition”)) filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Samsung Electronics America, Inc. v. Cobblestone Wireless, LLC*, IPR2024-00606 (“the Samsung IPR”).

The Qualcomm Petition is substantially the same as the petition filed in the Samsung IPR: it involves the same patent, the same claims, the same grounds of unpatentability, and the same evidence as the Samsung IPR. As discussed below, if joined, Qualcomm will assume an “understudy” role and will not take an active role in the *inter partes* review proceeding unless Samsung ceases to participate in the instituted IPR.

The instant Petition also relies on the declaration of Kevin C. Almeroth, Ph.D., which is substantively the same as Dr. Almeroth’s declaration in the Samsung IPR. Thus, the proposed joinder will neither unduly complicate the Samsung IPR nor delay its schedule. As such, the joinder will promote judicial efficiency in determining patentability in the Samsung IPR without prejudice to Patent Owner.

Finally, this Motion for Joinder, and accompanying Petition, are timely because they are filed less than one month after a decision instituting trial in the Samsung IPR. 37 C.F.R. § 42.122(b) (“no later than one month after the institution date of any *inter partes* review for which joinder is requested.”).

Accordingly, Qualcomm respectfully requests that the Board grant this Motion for Joinder.

II. STATEMENT OF REASONS FOR THE PRECISE RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board’s decision instituting an original *inter partes* review. *See* 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013).

B. Petitioner's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed prior to the Board's institution decision, *i.e.*, less than one month after a decision instituting trial in the Samsung IPR. 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor of Joinder

Here, each of the four factors considered by the Board weighs in favor of joinder. Specifically, the Qualcomm Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Petition in the Samsung IPR. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an “understudy” role. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

Accordingly, joinder is appropriate.

1. Joinder is Appropriate

Joinder is appropriate because Qualcomm's Petition does not raise any new grounds of unpatentability and does “not present issues that might complicate or delay” the Samsung IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 (PTAB July 9, 2014). Qualcomm's Petition is substantively identical to the petition in the Samsung IPR, challenging the same claims of the '802 Patent on the same grounds based on the same prior art and relying on the same expert testimony. Indeed, the Qualcomm Petition contains only minor

differences related to formalities of a different party filing the petition. Further, to simplify this proceeding, and minimize the impact on the original proceeding, the Qualcomm Petition relies on the same Declarant as the Samsung IPR (Dr. Kevin C. Almeroth). Joinder would, therefore, have little, if any, impact on the Samsung IPR, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on any party or the PTAB, as detailed below. Thus, joinder will allow for efficient and economical review of the challenged claims of the '802 Patent. *See, e.g., Dell Inc. v. Alacritech, Inc.*, IPR2018-01307, Paper No. 8 (PTAB Jan. 11, 2019) (granting motion for joinder where the petition challenged the same claims on the same grounds); *Oracle America Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that “joining Oracle’s identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board”). The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016). Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Samsung IPR so that the Board can efficiently resolve all grounds in both the Qualcomm Petition and Samsung IPR in a single proceeding without prejudice to Patent Owner.

2. Petitioner Proposes No New Grounds of Unpatentability

The Qualcomm Petition does not assert any new grounds of unpatentability. It challenges the same claims (claims 1-4, 6-10, 13, 14, 17, and 21-25) of the '802 Patent based on the same arguments and analysis, prior art, evidence, and nine grounds of unpatentability as the Samsung IPR. In addition, Qualcomm filed a substantively identical expert declaration of Samsung's expert.

3. Joinder Will Not Unduly Burden or Negatively Impact the Samsung IPR Trial Schedule

Because the Qualcomm Petition does not raise any new grounds of unpatentability, and because a Scheduling Order is not yet established for the Samsung IPR, joinder should not impact the schedule of the Samsung IPR. *See LG v. Memory Integrity, LLC*, IPR2015-01353, Paper 11, at 6 (PTAB Oct. 5, 2015) (granting IPR and joinder where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]”). Qualcomm will adhere to the Scheduling Order for the Samsung IPR. As discussed further below, Qualcomm is willing to limit its participation in this proceedings to that of an “understudy.” In the event that the Samsung IPR is terminated with respect to Samsung, then Qualcomm does intend to “step into the shoes” of the dismissed petitioner and materially participate in the joined proceedings.

Accordingly, for the reasons stated above, joinder of Qualcomm to the Samsung IPR will not affect the Board's ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

4. Procedures to Simplify Briefing and Discovery

As an "understudy," Qualcomm agrees that, if joined, Qualcomm will abide by the following procedures so long as Samsung remains an active party, as previously approved by the Board in other joinder circumstances:

(a) all filings by Qualcomm in the joined proceeding will be consolidated with the filings of Samsung, unless a filing solely concerns issues that do not involve Samsung;

(b) Qualcomm shall not be permitted to raise any new grounds not instituted by the Board in the Samsung IPR, or introduce any argument not already introduced by Samsung; and

(c) with regard to taking of testimony, Qualcomm will abide by 37 C.F.R. § 42.53 or any agreement between Patent Owner and Samsung.

See Mylan Pharms. Inc. v. Novartis AG, IPR2015-00268, Paper 17, at 5–6 (PTAB Apr. 10, 2015) (finding these limitations "consistent with the 'understudy' role that Petitioner agrees to assume, as well as Petitioner's assertion that its presence would not require introducing any additional arguments, briefing, or discovery.").

Qualcomm is willing to abide by any additional conditions the Board deems appropriate.

III. *GENERAL PLASTIC*

In *General Plastic*, the Board set forth a series of seven factors that may be analyzed for “follow-on” petitions to help conserve the finite resources of the Board. *See General Plastic Industries Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i). Petitioner respectfully submits that the *General Plastic* analysis is not applicable here since Qualcomm and Samsung submitted separate, independent petitions. Qualcomm merely seeks to join the Samsung IPR and does not present any new grounds.

The *General Plastic* factors are intended to filter out those follow-on IPRs that are fundamentally unfair to the Patent Owner (e.g., gamesmanship/abuse of process by the Petitioner) and to promote the efficiency of the *inter partes* review process. The Board however, also “recognize[s] that there may be circumstances where multiple petitions by the same petitioner against the same claims of a patent should be permitted.” *General Plastic* paper 19, p.18. This is one of those circumstances.

This is not a “follow-on” petition as the GP analysis contemplates, but rather a near identical “copycat” of the first filed Samsung petition, which Qualcomm filed expeditiously upon Cobblestone/Samsung’s notice that “[a]n agreement in principle to settle the parties’ disputes is imminent.” Ex. 1028. Qualcomm—whose exposure may not be limited to its customer Cisco—filed this “copycat” petition, rather than

a new petition, to conserve the Board’s resources. The Petition’s grounds and arguments have not been changed/updated subsequent to the POPRs in the respective Samsung or Cisco IPRs. The *General Plastic* analysis, while “not exhaustive,” is nonetheless addressed below.

Cisco (an RPI in the current Petition) previously filed IPR2024-00707 challenging claims 1-9, without any involvement from Qualcomm, whereas this Petition and the Samsung IPR seek review of claims 1-4, 6-10, 13, 14, 17, and 21-25. (Factor 1).

Qualcomm could not have benefitted from the POPRs in the Samsung and Cisco IPRs because it is “copycat” of a petition filed—without Qualcomm’s involvement—before the POPRs were filed, and no institution decisions have been issued. (Factors 2 and 3).

This Petition is filed shortly after Petitioner became aware of above-mentioned agreement in principle, Ex. 1028, about six and five months, respectively after the filing of the Samsung and Cisco IPRs, which were filed without Qualcomm’s knowledge or involvement. (Factors 4 and 5).

Rather than file a new petition, Qualcomm filed this copycat Petition, which introduces nothing more than the identical grounds and evidence presented in the Samsung IPR, to conserve the Board’s resources. Additionally, Petitioner has

agreed to take an understudy role and adhere to the Samsung IPR Scheduling Order.
(Factors 6 and 7).

IV. CONCLUSION

For the foregoing reasons, Qualcomm respectfully requests that its Petition for *Inter Partes* Review of U.S. Patent No. 7,924,802 be granted and that the proceedings be joined with IPR2024-00606.

Date: August 28, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 28th day of August, 2024, I caused to be served a true and correct copy of PETITIONER'S MOTION FOR JOINDER UNDER 37 C.F.R. §§ 42.22 AND 42.122(b) by FedEx on the following:

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A courtesy copy of this Petition was also served upon litigation counsel for Patent Owner via email, as follows:

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