

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc.,
Petitioner,

v.

Cobblestone Wireless LLC,
Patent Owner.

Case IPR2025-01496
Patent 8,891,347

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION**

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PATENT OWNER’S EXHIBIT LIST

No.	Description
Ex. 2001	<i>Cobblestone Wireless LLC v. Apple Inc.</i> , No. 7:24-cv-00232 ADA, Dkt. No. 23 Scheduling Order
Ex. 2002	Motion to Stay before Judge Albright, Docket Navigator
Ex. 2003	Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”
Ex. 2004	Western District of Texas Case Management Statistics
Ex. 2005	<i>Cobblestone Wireless LLC v. Apple Inc.</i> , No. 7:24-cv-00232 ADA, Dkt. No. 7 Proof of Service
Ex. 2006	Cobblestone’s Preliminary Infringement Contentions
Ex. 2007	Apple’s Invalidity Contentions – Ex. A4 (“Hardacker”)
Ex. 2008	Apple’s Invalidity Contentions – Ex. A2 (“Medbo”)
Ex. 2009	Apple’s Invalidity Contentions – Ex. A6 (“Wallace ’467”)
Ex. 2010	Interim Processes for PTAB Workload Management
Ex. 2011	RIN 0651-AD89 Revision to Rules of Practice before the Patent Trial and Appeal Board, Dkt. No. PTO-P02025-0025
Ex. 2012	<i>T-Mobile USA, Inc. et al v. Cobblestone Wireless LLC</i> , IPR2024-00316, Paper 18, (PTAB Jun. 5, 2024)
Ex. 2013	<i>Samsung Electronics America Inc., et al v. Cobblestone Wireless, LLC</i> , IPR2024-00319, Paper 16, (PTAB Jun. 24, 2024)
Ex. 2014	<i>Cobblestone Wireless, LLC v T-Mobile USA, Inc.</i> , Case No. 2:22-00477-JRG-RSP – Subpoena to Apple, Proof of Service
Ex. 2015	<i>Cobblestone Wireless, LLC v T-Mobile USA, Inc.</i> , Case No. 2:22-00477-JRG-RSP – Subpoena to Apple

I. INTRODUCTION

The Director should deny institution of *inter partes* review (“IPR”) of U.S. Patent No. 8,891,347 (“the ’347 Patent”) under his discretion under *Fintiv* and more generally under § 314. Trial against Petitioner is set for seven months prior to the deadline for a Final Written Decision, and the parties have a strong settled expectation of validity of the ’347 Patent. The ’347 Patent issued in 2014 and was known in the industry since at least 2023 when it was first asserted in district court. Moreover, the Patent Office already considered this Patent in two prior IPRs and denied institution on the merits. All of this demonstrates that this Petition should not be instituted.

II. DENIAL OF INSTITUTION UNDER §314 IS WARRANTED.

35 U.S.C. § 314(a) gives the Director discretion to deny institution of IPR due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intrix-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19–21 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”). The Board has set forth six factors for determining whether discretionary denial in light of such parallel litigation is appropriate, and in analyzing them, “takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020)

(precedential) (“*Fintiv I*”); *see also Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7–17 (PTAB May 13, 2020) (informative) (“*Fintiv II*”).

Each of these six *Fintiv* factors weigh in favor of the Board exercising its discretion to deny institution here. For Factor 1, no stay of the parallel district court litigation has been granted or requested, and a stay is unlikely given the advanced stage of the cases. For Factor 2, the district court trial will commence seven months before the deadline for a final written decision in this proceeding. For Factor 3, due to Petitioners’ delay in filing the Petition, the parties and the district court will have significantly invested in the district court proceeding by the time the Board issues its institution decision because the *Markman* hearing will have occurred and fact discovery will be complete. For Factor 4, there is substantial overlap in both the patent claims and art at issue in this proceeding and in the district court, and Petitioner’s stipulation does little to address the concerns of efficiency and inconsistent rulings. For Factor 5, Petitioner is the defendant in the parallel litigations. And for Factor 6, not only did Petitioners unduly delay in filing the Petition, but the Petition fails to present a compelling challenge on the merits. Moreover, the Petition is likely defunct in light of the upcoming rule changes. Each of these factors is addressed in more detail below.

A. *Fintiv* Factor 1: The district court has not granted a stay, nor is there any evidence that a stay will be granted.

In the parallel district court proceeding involving the same claims of the '802 patent, the district court has not granted a stay pending IPR. Further, Petitioner has not requested such a stay, there is no indication the Court will likely grant a stay.

Moreover, the district court would likely not grant a stay pending IPR even if this IPR were instituted, given the late stage of litigation. In the parallel action, the parties have already exchanged final infringement and invalidity contentions, completed claim construction, and fact discovery will conclude a month before the expected institution decision. Ex. 2001 (District Court Scheduling Order). Likewise, trial is currently set for August 3, 2026, more than seven months before a final written decision is expected from this petition. *Id.*

Thus, even if Petitioner were to file a motion for a stay pending this proceeding, it is highly unlikely Judge Albright would grant a stay at this late juncture in the cases. *See, e.g., Smart Mobile Techs. LLC v. Samsung Elecs. Co.*, No. 6:21-CV-00701-ADA, 2023 WL 11999028, at *3 (W.D. Tex. Oct. 24, 2023) (Albright, J.) (denying motion to stay pending IPR, where, when defendants' motion was filed, a claim construction hearing had already occurred, noting "the Court and the Parties have already expended significant resources in furtherance of these proceedings and any future expense that the parties might incur is outweighed by the

delay in filing this Motion.”); *Multimedia Content Mgmt. LLC v. Dish Network L.L.C.*, No. 6:18-CV-00207-ADA, 2019 WL 11706231, at *3 (W.D. Tex. May 30, 2019) (Albright, J.) (same). Moreover, Judge Albright’s rate of granting contested motions to stay pending an IPR is less than 30%, without considering late stage of the case Apple’s motion might be filled in. *See* Ex. 2002 (Grant and denial rate of contested motions to stay by Judge Albright provided by Docket Navigator).

Where the district court litigation has not been stayed, and any stay is speculative and unlikely, allowing this IPR to proceed in parallel would be wasteful and inefficient. Factor 1 weighs against institution.

B. *Fintiv* Factor 2: The district court trial will occur more than seven months before the deadline for a final written decision in this proceeding.

“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv I* at 9.

Here, the deadline for a final written decision in this IPR is March 10, 2027, which may be extended to September 10, 2027, for good cause or in the case of joinder. 37 C.F.R. § 42.100(c). Meanwhile, the district court litigation is set for trial on August 3, 2026. Ex. 2001. Even if the Board relies on the Federal Court Management Statistics for the Western District of Texas, trial will still precede the final written decision. Ex. 2004; Ex. 2003 at 3 (encouraging use of these statistics in

evaluating this factor). Statistically, over the past six years, a civil case in the district reached trial 27.73 months after filing. Ex. 2004 (indicating median times to trial for civil cases for the twelve-month period ending in June for 2020–2025 as 22.4, 23.8, 28.3, 26.4, 32.7, and 32.8). Applied here, that would place trial in January of 2027, still two months prior to the final written decision.

Thus, consistent with historical statistics, the district court trial is set to occur well before the deadline for a final written decision, and possibly more than a year before the deadline if extended. This weighs heavily against institution. *See, e.g., Samsung Elecs. Co. v. Mojo Mobility Inc.*, IPR2023-01094, Paper 11 at 8–9 (PTAB Feb. 9, 2024) (“*Mojo*”) (denying institution when trial was set before the final written decision would issue); *BOE Tech. Grp. Co. v. Element Capital Commercial Co.*, IPR2023-00808, Paper 9 at 21–22 (PTAB Nov. 15, 2023) (“*BOE*”) (same); *Vector Flow, Inc. v. HID Global Corp.*, IPR2023-00353, Paper 8 at 19–20 (PTAB July 17, 2023) (“*Vector Flow*”) (same); *Roku, Inc. v. IOEngine, LLC*, IPR2022-01551, Paper 11 at 10–11 (PTAB May 5, 2023) (“*Roku*”) (same).

Indeed, the Board has denied institution on account of even smaller gaps between the final written decision and trial. *See, e.g., EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (“*EClinicalWorks*”) (finding this factor weighed in favor of discretionary denial and denying institution where “the beginning of the jury trial in the WDTX Cases is

roughly *one or two months* before any final decision would have been due had *inter partes* review been instituted”); *Fintiv II* at 13 (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur *two months* before the deadline for the Board to reach a final written decision); *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 20 at 5–6 (PTAB August 25, 2022) (“*NXP*”) (same).

Because the district court trial is currently set to occur seven months before the earliest deadline for a final written decision in this IPR, current time-to-trial statistics would see trial occur two months before a final written decision, and there is no evidence that trial could occur after final written decision, this factor weighs heavily against institution. *Fintiv II* at 13.

C. *Fintiv* Factor 3: By the time an institution decision is reached, the Court will have held the *Markman* hearing and fact discovery will be completed.

Factor 3 relates to the “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*” *Fintiv I* at 9 (emphasis added). For example, “if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition,” this factor favors denial. *Id.* at 9–10. “Likewise, district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* at 10.

Here, the *Markman* hearing is complete, and the Court has construed the claims. Ex. 2001 at 3. The *Markman* decision qualifies as a “substantive order.” Fact discovery will also conclude a month prior to any institution decision. *Id.*

These investments by the parties and district court weigh against institution because they ensure that this IPR cannot be an efficient alternative to district court litigation. Panels have found this factor to favor denial when the parallel litigation was at a similarly advanced stage as here. *See, e.g., BOE* at 23–24 (denying institution in part because claim construction was complete and fact discovery was nearly completed); *Roku* at 12 (same); *Mojo* at 9 (same).

Of course, the reason that the district court litigation will be so far along at the time of institution is because Petitioners unduly delayed in filing the Petition. Apple’s Petition comes just over a month before the statutory bar date. *See* Ex. 2005 (Proof of service show Apple served on October 10, 2024). The Petition offers no explanation for either Petitioner’s delay.

Because there has been substantial investment in the parallel proceeding, and Petitioner delayed filing the Petition, Factor 3 weighs heavily against institution.

D. *Fintiv* Factor 4: There is substantial overlap between this IPR and the district court proceeding.

This factor looks at “whether all or some of the claims challenged in the petition are also at issue in district court” and whether the “petition includes the same

or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv I* at 12–13. Here, the challenged and asserted claims are identical, and the prior art relied upon in the Petition and at the district court is substantially overlapping.

First, the Petition challenges claims 1–4, 6, 8–12, 14–17, and 19–23 of the ’802 patent; this covers the claims asserted in the district court action. *Compare* Pet. at 1 *with* Ex. 2006 (infringement contentions asserting claims 19–23); *see also Pharaoh Energy Servs., LLC v. Flex-Chem Holding Co.*, IPR2024-00815, Paper 7 at 13–14 (PTAB Sept. 20, 2024) (denying institution in part because the same claims were challenged at the PTAB and asserted in litigation); *Vector Flow* at 22 (same); *EClinicalWorks* at 12 (same).

Second, all of the references relied upon by the Petition are also relied upon by Apple in the district court. Exs. 2007, 2008, 2009. Apple’s stipulation letter does not sufficiently address the concerns of efficiency and inconsistent rulings. Ex. 1011. In this letter, Apple offers a *Sotera*-type stipulation (not to pursue “the specific grounds asserted in *inter partes* review . . . or any other ground that could have been reasonably raised in this proceeding”) and a further stipulation to “not pursue in the Texas Litigation combination of the prior art asserted in this proceeding (as reproduced in the Appendix below) with any other type of prior art, including unpublished system art, nor will it pursue any unpublished system art corresponding

to the prior art asserted in this proceeding.” *Id.* at 1–2. The appendix lists only the Hardacker, Medbo, and Wallace references. *Id.* at 3. Apple’s stipulations are exceedingly limited.

First, a *Sotera*-type stipulation is easily circumvented because it does not exclude combinations involving “system” art—even system art that corresponds to the prior art asserted in this IPR. *See Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365–66 (Fed. Cir. 2025) (“Thus, IPR estoppel does not preclude a petitioner from asserting the same prior art raised in an IPR in district court, but rather precludes a petitioner from asserting grounds that were raised or reasonably could have been raised during an IPR.”)

Apple’s second stipulation does not solve the problem with system art because Apple imposed too many qualifications. Apple did not agree, for example, not to pursue other system art (that is not directly “corresponding to” Hardacker, Medbo, or Wallace) in combination with other (non-Hardacker, non-Medbo, non-Wallace) prior art and printed publications that could have been raised in this IPR—even if their content is similar or overlapping. *See Ex. 2011* at 18 (proposing stipulations should be more broadly phrased as “not raise grounds of invalidity or unpatentability with respect to the challenged patent under 35 U.S.C. 102 or 103”).

Additionally, Apple hedges its stipulation to just the “Texas Litigation,” but Apple reserves the right to file *ex parte* reexamination requests on the same

references with the same/similar prior art. Ex. 1011 at 1–2; *see* Ex. 2011 at 18 (proposing broader stipulation to affect “any other proceeding”).

Also, Apple’s stipulation is limited to Apple only. Ex. 1011 at 1–2; *see* Ex. 2011 at 18 (proposing broader stipulation to affect “petitioner and any real party in interest or privity”). Apple is known to cooperate with or fund third parties like Unified Patents to file *ex parte* reexamination requests without directly naming Apple. Apple’s stipulations bind only Apple and do not foreswear privity through Unified Patents or other entities. Apple may just fund Unified Patents to file an *ex parte* reexamination using the same/similar prior art.

Further, Apple’s assurances not to “pursue” certain prior art will result in little or no meaningful efficiency gains due to the late stage of the litigation, because opening expert reports will be due before an institution decision can be reached. Ex. 2001. Apple will have prepared its expert position on invalidity and Patent Owner will be forced to prepare its rebuttal position, scheduled for just over two weeks after the institution decision is due. *Id.* Given that Apple will not give up its district court assertion until after institution is not later reversed, however long that may be, it is highly likely the Parties will not be able to treat these combinations as dropped until near trial and will likely raise related dispositive motions to the district court.

In short, the Petition challenges the same patent claims that are asserted in the parallel litigation, and Petitioner relies on substantially overlapping prior art at the

district court. This raises substantial “concerns of inefficiency and the possibility of conflicting decisions,” weighing against institution. *See Fintiv I* at 12.

E. *Fintiv* Factor 5: Petitioner is a defendant in the district court litigation.

Petitioner is the defendant in the parallel litigation. *See* Exs. 2001, 2005; *see, e.g., Fintiv II* at 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”).

F. *Fintiv* Factor 6: Other circumstances weigh strongly against institution, including the weakness of the Petition and Petitioner’s delay.

This factor looks at “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv I* at 9. This factor also weighs heavily against institution.

First, the merits of this Petition suffer from significant weaknesses and gaps in proof, as discussed Patent Owner’s upcoming Preliminary Response. Thus, the Petition fails to present a “compelling unpatentability challenge” and fails to establish a reasonable likelihood of success.

Second, many of the other relevant considerations identified by the Interim Processes for PTAB Workload Management memorandum, Ex. 2010, weigh against institution. *See Infa* § III.

Last, should the proposed rule change regarding § 42.108 be adopted, any instituted IPR would not be maintained for long. First, as noted above, Apple has

made only a limited stipulation, so any instituted IPR could not be maintained. *See* Ex. 2011 at 22 (“*Inter partes* review shall not be instituted or maintained unless each petitioner files a stipulation with the Board ... state that if a trial is instituted, the petitioner and any real party in interest or privy of the petitioner will not raise grounds of invalidity or unpatentability with respect to the challenged patent under 35 U.S.C. 102 or 103 in any other proceeding”). Second, as noted above, the parallel district court litigation is more likely than not to address Apple’s validity challenges prior to the due date for final written decision, as such even if instituted this IPR could not be maintained. *See id.* at 23. Because it is likely that even if otherwise instituted, this IPR could not be maintained for similar reasons as discussed under *Fintiv*, institution should be denied.

These factors demonstrate and reinforce that efficiency and system integrity considerations weigh overwhelmingly in favor of a discretionary denial here.

III. The PTAB Workload Management Factors Weigh Against Institution

Consistent with and in addition to the factors identified in *Fintiv*, the Interim Processes for PTAB Workload Management Memorandum (“Workload Memo”) provides enumerates seven relevant considerations (“Workload Management Factors”):

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;

- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenged;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

Ex. 2010 at 2-3.

These considerations weigh strongly in favor of a discretionary denial. This is the third IPR filed against this patent. *See* Ex. 2012, Ex. 2013 (both denying institution). Each of these have been settled, showing the parties' expectation that the patent in question is valid. Given this and the age of the patent, granted in 2014, there is a strong settled expectation that the patent is valid and need not be challenged before the PTAB yet again. And in any case, Apple has known of this patent and its relevance to Apple's products since 2023 but did not bring a challenge for more than two years. Taken together, this petition does not represent a good use of the Board's resources and institution should be denied.

A. Prior Adjudication

The first consideration asks “whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims.” Ex. 2010 at 2. Here, the board has already addressed the merits of two IPR challenges, IPR2024-00316 and IPR2024-00319, and Apple’s own district court validity challenge is scheduled to complete before any Final Written Decision.

First, the Board has already made merits decisions on two prior IPR challenges, one touching on the art relied upon by Apple’s petition. Ex. 2012 (IPR2024-00136, Paper 18 (Denying Institution)), Ex. 2013 (IPR2024-00139, Paper 16 (Denying Institution)). In both IPRs, the petitioners failed to show Sesia disclosed or rendered obvious the “path parameter information” or “predistored” limitations based on claim construction issues. Ex. 2012 at 24, 26; Ex. 2013 at 23, 25. Despite this, Apple’s petition relies on Sesia to “corroborate” its obviousness position regarding Claim 21’s further limitation of “path parameter information.” Pet. at 83-84. Thus, although a merits decision at the institution stage is not a final decision, Apple has used it to roadmap its use of at least Sesia and should weigh against institution.

Second, Apple challenges the patentability of the asserted claims in the district court using the exact same prior art as raised by the instant Petition. Exs. 2007, 2008,

2009. Apple’s validity challenge based on the same art should be adjudicated at trial, well before a final written decision, as noted *Supra* § II.B.

In light of an earlier validity challenge by Apple and a merits decision Apple is using to roadmap, this factor weighs against institution.

B. No Changes in the Law Support Reconsideration of Validity

The second consideration asks “whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability.” Ex. 2010 at 2. No such changes exist. This weighs against institution.

C. The Petition is Particularly Weak and Overly Reliant on Unreliable Expert Testimony.

The third and fourth consideration tests the “strength of the unpatentability challenge” and the “extent of the petition’s reliance on expert testimony.” Ex. 2010 at 2. Here, as explained in Patent Owner’s upcoming Preliminary Response, Apple’s unpatentability challenge has severe facial flaws, many related to its reliance on expert testimony. Because the merits of the Petition do not warrant institution without heavy reliance on an unreliable expert declaration, these considerations favor discretionary denial.

D. The Patent Has Been In Force As Long As The IPR Regime

This consideration looks to the “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Ex. 2010. While there is no bright-line rule here, “in general, the longer the patent has been in force, the more settled

expectations should be.” *Dabico Airport Solutions Inc., v AXA power Aps*, IPR2025-00408, Paper 21 at 3. In particular, this aligns with the six-year bar on recovery in 35 U.S.C. § 286. *Id.* Here, the ’347 Patent issued in November 2014, was published in 2013, and was filed in 2011 before the passage of the AIA. Ex. 1001 at 1. Given the ’347 Patent’s filing predates the entire IPR regime by several months, Patent Owner’s expectation is and has been, that no IPR challenge would be made and none would be successful. Likewise, the ’347 Patent was not challenged in any way for the just shy of the first decade of its life, this likewise creates a strong settled expectation of validity.

Moreover, beyond the age of the Patent, it has been licensed by most of the industry. Indeed, every IPR and district court challenge to the validity of the ’347 Patent not involving Apple has resulted in the challenger taking a license. *See* IPR2024-00319, Paper 21 (Granting a Joint Motion to Terminate due to settlement); *Cobblestone Wireless, LLC v. T-Mobile USA, Inc.*, Case No. 2:22-cv-00477, Dkt. 224 (E.D. Tex Oct. 17, 2024) (granting motion to dismiss by Cobblestone, T-Mobile, AT&T, Verizon, Nokia, and Ericsson where “the parties represent that the above-captioned cases have all been resolved...”); *Cobblestone Wireless, LLC v. Motorola Mobility LLC*, Case No. 1:24-cv-08726, Dkt. 47 (N.D. Ill. Jun. 16, 2025) (the parties “have resolved Plaintiff’s claims for relief against Defendant in this case”). Taking a license, even in the form of a settlement, evidences an expectation of validity of

the underlying patent. Given Samsung, AT&T, Verizon, Ericsson, Nokia, T-Mobile, and Motorola represent the majority of the cellular telecommunications industry and have all taken a license, the logical conclusion is the industry as a whole, including Apple, expects the '347 Patent is valid.

Further, Apple itself has affirmatively known of the '347 Patent since July of 2023. Cobblestone served Apple a subpoena regarding and mentioning the '347 Patent in a prior action against T-Mobile even naming certain Apple products as accused products. *See* Ex. 2014, 2015 at 4–5. Apple knew of the '347 Patent and its relevance to its products more than two years before bringing this petition. In that time, Cobblestone reasonably expected no such challenge would be made.

Given the age of the patent and the acceptance of it as valid by the majority of the industry, the parties have a strong settled expectation that the '347 Patent is valid.

IV. CONCLUSION

Patent Owner respectfully requests that the Director exercise his discretion under Section 314(a) to deny institution. First, the Director should exercise his discretion under Section 314(a) to deny institution because of the status of the co-pending lawsuits in light of Petitioner's delay in filing the Petition. Second, the Director should exercise his discretion more generally under Section 314(a) to deny institution because the Petition does not present a compelling basis for institution.

Date: November 10, 2025

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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 November 10, 2025, 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 Petitioner:

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