UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc.,
Petitioner,

v.

Cobblestone Wireless LLC,
Patent Owner.

Case IPR2025-01497
Patent 7,924,802

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

TABLE OF CONTENTS

I. INTRODUCTION 1

II. DENIAL OF INSTITUTION UNDER §314 IS WARRANTED. 1

A. *Fintiv* Factor 1: The district court has not granted a stay, nor is there any evidence that a stay will be granted. 3

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. 4

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. 6

D. *Fintiv* Factor 4: There is substantial overlap between this IPR and the district court proceeding. 7

E. *Fintiv* Factor 5: Petitioner is a defendant in the district court litigation. 11

F. *Fintiv* Factor 6: Other circumstances weigh strongly against institution, including the weakness of the Petition and Petitioner's delay. 11

III. The PTAB Workload Management Factors Weigh Against Institution 12

A. Prior Adjudication. 14

B. No Changes in the Law Support Reconsideration of Validity. 15

C. The Petition is Particularly Weak and Overly Reliant on Unreliable Expert Testimony. 15

D. The Patent Has Been In Force As Long As The IPR Regime 16

E. Other Considerations Also Favors Denial 18

IV. CONCLUSION 20

TABLE OF AUTHORITIES

Cases

Apple Inc. v. Fintiv, Inc.,
IPR2020-00019, Paper No. 11 (PTAB Mar. 20, 2020) .....*passim*

Apple Inc. v. Fintiv, Inc.,
IPR2020-00019, Paper No. 15 (PTAB May 13, 2020).....2, 6, 11

BOE Tech. Grp. Co. v. Element Capital Commercial Co.,
IPR2023-00808, Paper 9 (PTAB Nov. 15, 2023) 5, 7

Cobblestone Wireless, LLC v. Motorola Mobility LLC,
Case No. 1:24-cv-08726, Dkt. 47 (N.D. Ill. Jun. 16, 2025).....17

Dabico Airport Solutions Inc., v AXA power Aps,
IPR2025-00408, Paper 21 at 3 (P.T.A.B. June 18, 2025).....16

EClinicalWorks, LLC v. Decapolis LLC,
IPR2022-00229, Paper No. 10 (PTAB Apr. 13, 2022).....5, 8

Ingenico Inc. v. IOENGINE, LLC,
136 F.4th 1354 (Fed. Cir. 2025) 9

Multimedia Content Mgmt. LLC v. Dish Network L.L.C.,
No. 6:18-CV-00207-ADA, 2019 WL 11706231 (W.D. Tex. May 30, 2019) 4

NHK Spring Co. v. Intri-Plex Techs., Inc.,
IPR2018-00752, Paper No. 8 (PTAB Sept. 12, 2018) 1

NXP USA, Inc. v. Impinj, Inc.,
PGR2022-00005, Paper 20 (PTAB Aug. 25, 2022).....6

NXP USA, Inc. v. Impinj, Inc.,
PGR2022-00005, Paper No. 17 (PTAB May 2, 2022) 6

Pharaoh Energy Servs., LLC v. Flex-Chem Holding Co.,
IPR2024-00815, Paper 7 (PTAB Sept. 20, 2024).....8

Roku, Inc. v. IOEngine, LLC,
IPR2022-01551, Paper 11 (PTAB May 5, 2023).....5, 7

Samsung Elecs. Co. v. Mojo Mobility Inc.,
IPR2023-01094, Paper 11 (PTAB Feb. 9, 2024).....5, 7

Smart Mobile Techs. LLC v. Samsung Elecs. Co.,
No. 6:21-CV-00701-ADA, 2023 WL 11999028 (W.D. Tex. Oct. 24, 2023).....3

Vector Flow, Inc. v. HID Global Corp.,
IPR2023-00353, Paper 8 (PTAB July 17, 2023) 5, 8

Statutes

35 U.S.C. § 314(a).....1, 20

35 U.S.C. §286 16

Rules

37 C.F.R. § 42.100(c).....4

PATENT OWNER'S EXHIBIT LIST

No.	Description
Ex. 2001	*Cobblestone Wireless LLC v. Apple Inc.,* 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 recission 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	*Cobblestone Wireless LLC v. Apple Inc.,* 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. 2008	Apple's Invalidity Contentions – Appendix 1
Ex. 2009	Interim Processes for PTAB Workload Management
Ex. 2010	RIN 0651-AD89 Revision to Rules of Practice before the Patent Trial and Appeal Board, Dkt. No. PTO-P02025-0025
Ex. 2011	Cobblestone's Preliminary Infringement Contentions, '802 Claim Chart
Ex. 2012	Excerpt from *Qualcomm Incorporated v. Cobblestone Wireless, LLC*, IPR2024-01336, Paper 4, (PTAB Aug. 28, 2024)
Ex. 2013	*Cobblestone Wireless, LLC v Cisco Systems, Inc.*, Case No. 2:23-00454-JRG-RSP, Dkt. 87 (E.D. Tex. May 30, 2025)
Ex. 2014	*Cobblestone Wireless, LLC v Cellco Partnership d/b/a Verizon Wireless*, Case No. 2:23-00382-JRG-RSP – Subpoena to Apple
Ex. 2015	*Cobblestone Wireless, LLC v Cellco Partnership d/b/a Verizon Wireless*, Case No. 2:23-00382-JRG-RSP – Subpoena to Apple, Proof of Service
Ex. 2016	Control No. 90/019,458, Request for *Ex Parte* Reexamination
Ex. 2017	Control No. 90/019,458, Decision Granting *Ex Parte* Reexamination
Ex. 2018	U.S. Patent No. 8,416,879
Ex. 2019	Control No. 90/019,458, Non-Final Office Action

I. INTRODUCTION

The Director should deny institution of *inter partes* review ("IPR") of U.S. Patent No. 7,924,802 ("the '802 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 '802 Patent. The '802 has been in effect since 2011 and known in the industry since at least 2023 when it was first asserted in district court. Moreover, the Patent Office is already examining this patent in IPR2024-01336 to which Apple should be considered a real party-in-interest and in an EPR. 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. Intri-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, largely due to Petitioners' delay in filing the Petition, there will be much investment by the parties and the district court—by the time the Board issues its institution decision, the *Markman* hearings 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 it will do so or that it would be granted.

Moreover, the facts here indicate that it is unlikely that the district court would 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. 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.

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. While this is faster than the timeframe of the Federal Court Management Statistics for the Western District of Texas, even considering this time to trial, trial will still be earlier than the final written decision. *See* Ex. 2003

at 3 (encouraging use of these statistics in evaluating this factor). Those statistics indicate that, over the past six years, a civil case in the district was brought to 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. 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* hearings is complete and the Court has construed the claims. Ex. 2001. The *Markman* decision clearly 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. This favors discretionary denial, and 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 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, 6–10, 13, 17, 21, and 23 of the '802 patent; this differs from the claims currently asserted in the district court actions by only three dependent claims. *Compare* Pet. at 1 *with* Ex. 2006 (infringement contentions asserting the same claims); *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 (identifying Rofougaran and Shearer). Apple's stipulation letter does not sufficiently address the concerns of efficiency and inconsistent rulings. Ex. 1017. 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 Rofougaran and Shearer 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" Rofougaran or Shearer) in combination with other (non-Rofougaran, non-Shearer) prior art and printed publications that could have been raised in this IPR—even if their content is similar or overlapping. *See* Ex. 2010 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. 1013 at 1–2; *see* Ex. 2010 at 18 (proposing broader stipulation to affect "any other proceeding").

Also, Apple's stipulation is limited to Apple only. Ex. 1013 at 1–2; *see* Ex. 2010 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.

Petitioners 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. 2009, 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 no stipulation, so any instituted IPR could not be maintained. *See* Ex. 2010 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. 2009 at 2–3.

These considerations weigh strongly in favor of a discretionary denial. This is the fifth serial challenge against this patent. Three of the previously four have been settled, showing the parties' expectation that the patent in question is valid. Given this and the age of the patent, granted in 2011, 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, there is both an IPR and EPR ahead of this petition in line. Given Apple should be considered a real party-in-interest to the IPR and this petition is largely repetitive of the EPR, there is no basis for the Board to expend its resources on this sixth challenge. Institution should be denied under these factors.

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. 2009 at 2. Here, two other patentability challenges are pending and scheduled to be completed well before any final written decision could be reached in this case.

First, Apple challenges the patentability of the asserted claims in the district court. This challenge covers the exact same prior art as raised by the instant Petition. Exs. 2007, 2008. This is in addition to Apple's other validity challenges in district court, which will be adjudicated before a final written decision, as noted *Supra* § III.B.

Second, IPR2024-01336, instituted March 7, 2025 is expected to conclude March 7, 2026, just before any institution decision is made on the merits of this Petition. While the IPR2024-01336 petition was filed by Qualcomm, naming Cisco as a real party-in-interest, it is clear from the circumstances that Apple is the reason Qualcomm has maintained the IPR. In particular, Cobblestone has not asserted infringement by Qualcomm in a district court. Rather, Qualcomm provides components are material in the infringement of others (like Apple and Cisco). *See e.g.* Ex. 2011. When IPR2024-01136 was filed, Qualcomm's infringement was on behalf of its ***then*** real party-in-interest, Cisco. Ex. 2012. However, Cisco has now taken a license to the '802 Patent. Ex. 2013. Now, Qualcomm's only real interest in

maintaining its IPR is on behalf of its new, unlisted real party-in-interest, Apple, whose infringement is based in part on Qualcomm components. *See e.g.* Ex. 2011. Because Apple's infringement is the primary motivation for Qualcomm's IPR, it will reach a final written decision before any can be reached in this case.[1]

In light of two earlier validity challenges associated with Apple, both scheduled to complete prior to this IPR there is little basis for the Patent Office to expend its limited resources on the instant challenge.

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. 2009 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. 2009 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

[1] Qualcomm should be considered a real party-in-interest in this IPR as well. Patent Owner will address this issue in its Patent Owner's Preliminary Response because naming all real parties-in-interest is a requirement for institution, not a discretionary factor. 35 U.S.C. § 312 (a petition "may be considered only if ... the petition identifies all real parties in interest").

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. 2009. 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 '802 Patent has been in force since April 2011, was published in 2009, and was filed in 2008. Ex. 1001 at 1. Given the '802 Patent 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 '802 Patent not having been challenged in any way for the first dozen years of its life 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[2] challenge to the validity of the '802

[2] Unified Patents has filed an EPR against the '802 Patent. However, Unified Patents does not practice any claim and has not been accused of infringement. Rather it seems that Unified Patents filed the EPR on behalf of its member, Cisco, who subsequently took a license.

Patent not involving Apple has resulted in the challenger taking a license. *See* IPR2024-00606, Paper 20 (Samsung settled); IPR2024-00707, Paper 33 (HP and Cisco settled); IPR2024-00946, Paper 12 (AT&T, Verizon, Ericsson, Nokia, and T-Mobile settled); *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, HP, Cisco, 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 '802 Patent is valid.

Further, Apple itself has affirmatively known of the '802 Patent since May of 2024. Cobblestone served Apple a subpoena regarding and mentioning the '802 Patent in a prior action against Verizon even naming certain Apple products as accused products. *See* Ex. 2014, 2015 at 16–17. Apple knew of the '802 Patent and its relevance to its products nearly a year and a half 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 '802 Patent is valid.

E. Other Considerations Also Favors Denial

In addition to Apple's Petition being a waste of Board resources because both the district court trial and the Qualcomm IPR final written decision will occur well before any Final Written Decision in this petition and that there are strong settled expectations of validity, the Patent Office is already considering almost identical grounds as those raised in the petition. Instituting this IPR would thus not see the Office review a new challenge, only change the procedural posture of that challenge. This is not an adequate basis for the Board to expend additional resources.

In addition to Apple's own validity challenge in district court and Qualcomm's IPR challenge to which Apple appears to be closely associated, Unified Patents filed a Request for *Ex Parte* Reexamination ("EPR") on March 26, 2024. Ex. 2016. An EPR was ordered as a result on June 13, 2024. Ex. 2017.

Both the IPR Petition and the EPR challenge independent claims based on Rofougaran.[3] Here, Apple argues that the Rofougaran Patent Application Publication (Ex. 1004, hereinafter "Rofougaran Publication") renders claims 1–4, 6–10, 13, 17, 21, 23 of the '802 Patent obvious. Pet. 1. Apple also argues that Rofougaran Publication in view Shearer Patent No. 7,742,388 (Ex. 1005) renders

[3] While the IPR Petition also challenges independent claim 1 (and its dependents) based on Rofougaran, independent claim 1 has similar or corresponding limitations to independent claims 10 and 17.

claims 9, 23 obvious. Pet., 1. The Request for EPR similarly challenged, *inter alia*, claims 10–13, 17–22 as anticipated and/or obvious over the U.S. Patent 8,416,879 (Ex. 2018, hereinafter "Rofougaran Patent"). Ex. 2016 at 14 (summarizing reexamination grounds). The Request for EPR also challenged claim 23 as obvious based on the Rofougaran Patent in view of Shearer. *Id*.

The Rofougaran Patent relied upon in the EPR issued from the same application that published as the Rofougaran Publication at issue in this IPR. *See* Ex. 2018 at 1 (identifying its prior patent application publication as U.S. 2007/0127590). Not surprisingly, the two references have substantially identical disclosures. *Compare generally* Ex. 1004 (Rofougaran Publication), *with* Ex. 2005 (Rofougaran Patent).

Furthermore, the Petition in the IPR and the Non-Final Office Action in the Reexamination rely on almost identical disclosures from the two Rofougaran references. For example, the IPR Petition relies primarily on Rofougaran Figures 2 and 7 for the alleged disclosure of all limitations of claim 10. *See, e.g.*, Pet. at 36, 38, 40, 42, 44, 46, 51, 58. In fact, the Petition reproduces some version or annotation of Rofougaran Figures 2 and 7 at least nine times in connection with its claim 10 discussion. *Id*. Similarly, the Reexamination Non-Final Office Action primarily relies on Rofougaran Figures 2 and 7 in its discussion of claim 10, producing those figures at least 18 times in those discussions. Ex. 2019 at 35-63.

Because the Office is already considering a materially similar challenge to the '802 Patent, there is no reason for this Petition to be instituted.

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

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 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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