UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION,
Petitioner,

v.

ALEXANDER SOTO AND WALTER SOTO,
Patent Owners.

Case IPR2023-00680
U.S. Patent No. 9,887,795

PATENT OWNERS' SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNERS' PRELIMINARY RESPONSE

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TABLE OF AUTHORITIES

CASES

Apple Inc. v. Fintiv, Inc.,
IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) 1, 5

Applications in Internet Time, LLC v. RPX Corp.,
897 F.3d 1336 (Fed. Cir. 2018) 5

STATUTES

35 U.S.C. § 315 5

Patent Owners' Exhibit List

Exhibit	Description
2001	Public file history of application 11/772,187
2002	Public file history of application 12/512,968
2003	U.S. Pub. No. 2007/0031153 to Aronson et al.
2004	U.S. Pub. No. 2002/0181895 to Gilliland et al.
2005	U.S. Pub. No. 2001/0035997 to Agazzi ("Agazzi '997")
2006	Comparison of Excerpted Figures from Agazzi '997 (Ex. 2005) and Agazzi '341 (Ex. 1009)
2007	Email chain from Petitioner's counsel to Patent Owners' counsel.
2008	Public file history of Patent 10,263,723
2009	Public file history of Patent 10,771,181
2010	Chain of Emails Between Counsel for Nokia and Special Appearance Counsel for Patent Owners, Redacting the Username and Password, Exhibit from *Nokia of Am. Corp. v. Alexander Soto and Walter Soto*, IPR2023-00960.
2011	Chain of emails between Infinera's counsel and Patent Owners' counsel regarding discovery, Exhibit from Infinera Corp. v. Alexander Soto and Walter Soto, IPR2023-00834.

The Board's September 7, 2023 email authorized this sur-reply to Paper 8.

I. THE *FINTIV* FACTORS WARRANT DENIAL

Petitioner offers no reply to Patent Owners' arguments regarding *Fintiv* factors 1 (likelihood of stay), 4 (overlap of issues), or 5 (overlapping parties). Petitioner's arguments about factors 2, 3 and 6 do not change that denial under *Fintiv* is warranted. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 13-14 (PTAB Mar. 20, 2020) (precedential).

A. *Fintiv* Factor 2, Proximity of Trial, Favors Denial Because The Timing of The Notice of Filing Date Accorded Did Not Change The Final Written Decision's Issuance Months After District Court Trial

Petitioner's argument ignores the actual factor, which is a straightforward comparison of deadlines. *Fintiv* at 9. Trial in the underlying litigation is set for May 2024. Whether the Final Written Decision is expected on November 16, 2024 or September 15, 2024 is immaterial because both dates are many months after trial, favoring denial of the Petition. Petitioner chose to wait seven months after the litigation started before filing its Petition. If Petitioner wanted this factor to weigh in its favor, it could have filed its Petition earlier.

B. *Fintiv* Factor 3 Favors Denial Because Institution Will Impose Needless Duplicative Expenses

Fintiv factor 3 is "investment in the parallel proceeding by the court and parties." *Fintiv* at 9. "This investment factor is related to the trial date factor, in that

more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs." *Id.* at 9–10.

For reasons related to the previous factor, the parties will invest significant resources in reaching trial, and instituting review will only cause the parties to expend duplicative costs in reaching a Final Written Decision that will not issue until months after both parties will have expended significant costs to complete trial and post-trial briefing. This wasteful duplication is, but did not need to be, a result of Petitioner's choice of filing its petition seven months after the lawsuit. This factor therefore favors denying the Petition.

C. Petitioner's Carefully Drafted Declaration Does Not Resolve Patent Owners' Factor 6 (Merits And Other Considerations) Argument

Petitioner's Reply does not change that this factor supports denial. Petitioner remains silent about indemnity and duty to defend obligations that exist with others, including its current co-defendants, and the evidence shows that Petitioner intentionally shields this type of information from the Board's view. *See* Ex. 2007 at 1 (asking about indemnity), 2 (Petitioner reminding Patent Owners that litigation evidence adverse to Petitioner about issues such as indemnity "cannot be used in the PTAB proceeding under the Protective Order" without consent).

The Preliminary Reply establishes substantial circumstantial evidence that unidentified real parties in interest exist. Petitioner jointly prepared and served invalidity contentions with its co-defendants, something it chose to do, and which has nothing to do with the litigation being consolidated. The Petition is based on the same grounds, evidence, and arguments presented in these jointly developed contentions. Petitioner then deployed wasteful tactics to evade and delay relevant real party in interest discovery, taking positions that made it apparent it was withholding relevant discovery. Initially, Nokia withheld the requested discovery by arguing that the requested discovery "is not relevant," (Ex. 2007 at 4) even though it is relevant to both the litigation and the Petition. Petitioner then changed tact to argue that it would withhold production of such information until the last day permitted by the district court (and well after the deadline for the Preliminary Response). *Id.* at 3. When asked to clarify its reason for later refusing production at all, Petitioner again changed its position, again asserting irrelevance. *Id.* at 1. Other co-defendants have suggested that relevant information exists but is shielded by privilege. Ex. 2011 at 1 (co-defendant Infinera refused to produce the requested information because it would "encroach on applicable privileges").

Now that Petitioner's litigation tactics have been exposed as detrimental to its interests, Petitioner has changes strategies yet again, submitting a carefully worded attorney declaration that is notable for what it lacks. It is not a declaration from the

most knowledgeable person at Petitioner itself, meaning the declaration only reflects information that the declarant (Petitioner's counsel) personally knew about (Ex. 1033 ¶ 1), but not information that the declarant did not seek to know (or even know to seek). It ignores key factual issues, such as indemnity agreements. And, though it is a declaration from its counsel, the declaration is silent on the actions of Petitioner's counsel and does not explain how the IPR Petition is independent when prior art and arguments from its co-defendants' joint prior art searching, charting, and invalidity contentions made their way into the Petition. Indeed, circumstantial evidence (*e.g.*, joint invalidity contentions, Infinera's invocation of privilege) suggests that such coordination existed and may be on-going. The declaration and Reply also do not explain why Petitioner spent months refusing to provide the requested real party in interest information if no such information existed.[1]

[1] This is not the only time that Petitioner has withheld relevant information from the Board. In IPR2023-00960, Petitioner refused to inform the board about its failure of service. Ex. 2010 at 1–2. Petitioner wanted to maintain its original filing date regardless of its veracity of its representations to the Board. *Id.* at 1. Only after Patent Owners were forced to raise this issue with the Board did Petitioner finally admit that service had failed and drop its argument about maintaining the original filing date despite failure of service. Ex. 1035 at 9:26–10:14, 14:16–15:10.

Petitioner's continued evasiveness about real party in interest issues supports denying the Petition. Petitioner's refusal to address likely indemnity issues is also important. Indemnity obligations may establish privity sufficient to create a real party in interest relationship and impose estoppel. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1362 (Fed. Cir. 2018) (concurring) ("For example, non-party preclusion could apply between an indemnitor and an indemnitee, or between an insurer and an insured on the basis that such relationships form privity"). Petitioner's arguments about the bar date of its co-defendants is irrelevant. The real party in interest issue arises in the context of Petitioner's attempt to avoid statutory estoppel under the final *Fintiv* factor, not under the context of the 35 U.S.C. § 315 time bar.

Petitioner's tactics of delay and evasion should be held against it, especially in view of its weak stipulation that makes no mention of real parties in interest (Petition at 73), a stipulation it still has not entered into in the litigation. One of the other defendants will likely argue the same references at trial, making the Board's work duplicative.

For these reasons, as well as the reasons expressed in Patent Owners' Preliminary reply, institution should be denied.

Respectfully submitted,

Dated: September 21, 2023

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owners' Sur-Reply to Petitioner's Reply to Patent Owners' Preliminary Response is 5 pages or less, excluding table of contents, table of authorities, certificate of service, signature block, this certificate, or table, which is in compliance with the Board's email approval on September 7, 2023.

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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 September 21, 2023, by filing this document through the P-TACTS system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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