

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

**PETITIONER'S RESPONSE TO PATENT OWNERS' UPDATE
REGARDING INTERVENING DEVELOPMENTS AFFECTING
INSTITUTION**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
US Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

TABLE OF CONTENTS

TABLE OF AUTHORITIES	ii
LIST OF EXHIBITS.....	iii

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Amgen v. Hoechst Marion Roussel</i> , 457 F.3d 1293 (Fed. Cir. 2006).....	1
<i>CommScope v. Dali Wireless</i> , IPR2022-01242, Paper 24 (PTAB Feb. 27, 2023)....	2

LIST OF EXHIBITS

Exhibit	Short Name	Description
Ex. 1001	'795 Patent	U.S. Patent No. 9,887,795
Ex. 1002	'795 File History	File History of U.S. Patent No. 9,887,795
Ex. 1003	Prucnal Declaration	Declaration of Dr. Paul Prucnal
Ex. 1004	Prucnal CV	<i>Curriculum Vitae</i> of Dr. Paul Prucnal
Ex. 1005	Agazzi '640	U.S. Patent No. 6,879,640
Ex. 1006	Wei	U.S. Patent No. 6,873,800
Ex. 1007	Gans	U.S. Patent No. 5,388,088
Ex. 1008	Eroz	U.S. Patent No. 7,020,829
Ex. 1009	Agazzi '341	U.S. Patent No. 7,933,341
Ex. 1010	Jiang	U.S. Patent No. 6,665,498
Ex. 1011	Liu	U.S. Patent No. 6,005,694
Ex. 1012	Poplawski	U.S. Patent No. 5,879,173
Ex. 1013	Lavoie	Renaud Lavoie, <i>The Evolution of the Pluggable Module</i> , Broadcast Engineering (2012)
Ex. 1014	SFP MSA	SFF Committee, INF-8074i Specification for SFP (Small Formfactor Pluggable) Transceiver, Rev. 1.0 (May 12, 2001)
Ex. 1015	Leon-Garcia	Alberto Leon-Garcia & Indra Widjaja, <i>Communication Networks Fundamental Concepts and Key Architectures</i> (2000)

Exhibit	Short Name	Description
Ex. 1016	Ramaswami	Rajiv Ramaswami & Kumar Sivarajan, <i>Optical Networks: A Practical Perspective</i> (2d ed. 2002)
Ex. 1017	Senior	John Senior, <i>Optical Fiber Communications: Principles and Practice</i> (1985)
Ex. 1018	Papadias	C. B. Papadias & D. T. M. Slock, <i>On the Decision-Directed Equalization of Constant Modulus Signals</i> , Proceedings of 1994 28th Asilomar Conference on Signals, Systems and Computers, Pacific Grove, CA, USA, pp. 1423-1427, Vol. 2 (1994)
Ex. 1019	Feldman	U.S. Patent No. 6,295,272
Ex. 1020	Martin	Martin P. Clark, <i>Wireless Access Networks: Fixed Wireless Access and WLL Networks—Design and Operation</i> (2000)
Ex. 1021	Wicker	Stephen Wicker & Vijay Bhargava, <i>Reed-Solomon Codes and Their Applications</i> (1994)
Ex. 1022	Richardson	Thomas J. Richardson & Rudiger L. Urbanke, <i>Efficient Encoding of Low-Density Parity-Check Codes</i> , IEEE Transactions on Information Theory, Vol. 47, No. 2, at p. 638 (2001)
Ex. 1023		[reserved]
Ex. 1024		[reserved]
Ex. 1025		[reserved]
Ex. 1026		[reserved]

Exhibit	Short Name	Description
Ex. 1027	DCO	Doc. No. 58, Docket Control Order, <i>NextGen Innovations, LLC v. Fujitsu Network Communications, Inc. et al.</i> , No. 2:22-cv-00307-JRG-RSP (E.D. Tex.) (consolidated cases)
Ex. 1028		[Reserved]
Ex. 1029	Agrawal	Govind P. Agrawal, <i>Fiber-Optic Communication Systems</i> (3d. ed. 2002)
Ex. 1030	Caseload	U.S. District Court – Judicial Caseload Profile (Sept. 2022)
Ex. 1031	795 Patent Infringement Contentions	NextGen’s Infringement Contentions Against Petitioner for the ’795 Patent in <i>NextGen Innovations, LLC v. Nokia of America Corporation et al.</i> , No. 2:22-cv-00309-JRG-RSP (E.D. Tex.)
Ex. 1032	488 Spec	U.S. Provisional Application No. 60/480,488
Ex. 1033	Stevens Declaration	Declaration of M. Scott Stevens dated September 14, 2023
Ex. 1034	Consolidation Order	Consolidation Order, <i>NextGen Innovations, LLC v. Nokia of America Corporation, et al.</i> , No. 2:22-cv-00307-JRG-RSP, Dkt. No. 22
Ex. 1035	Consolidation Order	Consolidation Order, <i>NextGen Innovations, LLC v. Nokia of America Corporation, et al.</i> , No. 2:22-cv-00307-JRG-RSP, Dkt. No. 22
Ex. 1036	Hearing Transcript	<i>Nokia of America Corporation v. Soto et al.</i> , IPR2023-00960, Ex. 2004 (PTAB Aug. 29, 2023)
Ex. 1037		[Reserved]
Ex. 1038		[Reserved]

Exhibit	Short Name	Description
Ex. 1039	Infinera Case Stayed	<i>NextGen Innovations, LLC v. Infinera Corporation</i> , 2:22-cv-00306 (consolidated in lead case 2:22-cv-00307), Dkt. No. 392 (E.D. Tex. Mar. 21, 2024)
Ex. 1040	Infinera Case Stay Extended	<i>NextGen Innovations, LLC v. Infinera Corporation</i> , 2:22-cv-00306 (consolidated in lead case 2:22-cv-00307), Dkt. No. 411 (E.D. Tex. Mar. 21, 2024)
Ex. 1041	Fujitsu Case Stayed	<i>NextGen Innovations, LLC v. Fujitsu Network Communications, Inc., et al.</i> , 2:22-cv-00307, Dkt. No. 242 (E.D. Tex. Jan. 15, 2024)
Ex. 1042	Fujitsu Case Dismissed	<i>NextGen Innovations, LLC v. Fujitsu Network Communications, Inc., et al.</i> , 2:22-cv-00307, Dkt. No. 339 (E.D. Tex. Mar. 1, 2024)
Ex. 1043	AT&T I Case Motion to Stay	<i>NextGen Innovations, LLC v. AT&T Services, Inc., et al.</i> , 2:22-cv-00308, (consolidated in lead case 2:22-cv-00307), Dkt. No. 406 (E.D. Tex. Mar. 29, 2024)
Ex. 1044	AT&T I Case Stayed	<i>NextGen Innovations, LLC v. AT&T Services, Inc., et al.</i> , 2:22-cv-00308, (consolidated in lead case 2:22-cv-00307), Dkt. No. 407 (E.D. Tex. Mar. 29, 2024)
Ex. 1045	AT&T I Case Stay Extended	<i>NextGen Innovations, LLC v. AT&T Services, Inc., et al.</i> , 2:22-cv-00308, (consolidated in lead case 2:22-cv-00307), Dkt. No. 413 (E.D. Tex. May 2, 2024)
Ex. 1046	Nokia I Case Deconsolidated from Fujitsu Case	<i>NextGen Innovations, LLC v. Nokia of America Corporation et al.</i> , 2:22-cv-00309 (consolidated in lead case 2:23-cv-00637), Dkt. No. 252 (E.D. Tex. Jan. 30, 2024)

Exhibit	Short Name	Description
Ex. 1047	Nokia I Case Consolidated into Nokia II Case	<i>NextGen Innovations, LLC v. Nokia of America Corporation et al.</i> , 2:23-cv-00637, Dkt. No. 15 (E.D. Tex. Jan. 30, 2024)
Ex. 1048	Nokia II Case Scheduling Conference Set	<i>NextGen Innovations, LLC v. Nokia of America Corporation et al.</i> , 2:23-cv-00637, Dkt. No. 17 (E.D. Tex. Apr. 17, 2024)
Ex. 1049	AT&T II Case Stayed	<i>NextGen Innovations, LLC v. AT&T Services, Inc. et al.</i> , 2-23-cv-00263, Dkt. No. 50 (E.D. Tex. Apr. 2, 2024)
Ex. 1050	AT&T II Case Stay Extended	<i>NextGen Innovations, LLC v. AT&T Services, Inc. et al.</i> , 2-23-cv-00263, Dkt. No. 52 (E.D. Tex. May 2, 2024)
Ex. 1051	Cisco Case Stayed	<i>NextGen Innovations, LLC v. Cisco Systems, Inc.</i> , 2-24-cv-00092, Dkt. No. 20 (E.D. Tex. Mar. 21, 2024)
Ex. 1052	Cisco Case Stay Extended	<i>NextGen Innovations, LLC v. Cisco Systems, Inc.</i> , 2-24-cv-00092, Dkt. No. 22 (E.D. Tex. Apr. 17, 2024)
Ex. 1053	Nokia II Complaint	<i>NextGen Innovations, LLC v. Nokia of America Corporation et al.</i> , 2:23-cv-00637, Dkt. No. 1 (E.D. Tex. Dec. 29, 2023)
Ex. 1054	AT&T II Motion to Stay	<i>NextGen Innovations, LLC v. AT&T Services, Inc. et al.</i> , 2-23-cv-00263, Dkt. No. 49 (E.D. Tex. Mar. 29, 2024)
Ex. 1055	Nokia Motion to Deconsolidate/ Consolidate	<i>NextGen Innovations, LLC v. Nokia of America Corporation et al.</i> , 2:22-cv-00309 (consolidated in lead case 2:23-cv-00637), Dkt. No. 241 (E.D. Tex. Jan. 15, 2024)

Exhibit	Short Name	Description
Ex. 1056	--	Email chain between the Parties and the Board regarding filing <i>Fintiv</i> updates (highlighting added)
Ex. 1057	--	Email chain between Parties discussing the substance of an email to the Board requesting permission to file <i>Fintiv</i> updates (highlighting added)
Ex. 1058	--	Excerpted Portion of Dr. Prucnal's Report with all confidential information redacted
Ex. 1059	--	Email from Patent Owner to Board requesting to expunge Petitioner's exhibit with Dr. Prucnal's Report

The Board authorized a *Fintiv* “update with arguments and supporting exhibits”—not reopened substantive briefing. Ex. 1056. Patent Owners violated the Board’s authorization (Ex. 1056) and the Parties’ agreement (Ex. 1057) by expanding the scope of their update beyond *Fintiv* in Sections I and III, which the Board should strike or ignore entirely. Regardless, Patent Owners’ arguments fail.

Section I: Dr. Prucnal’s report—and Patent Owners’ falsehood about its contents—is irrelevant to *Fintiv*. Whether claims are fully enabled is a different legal inquiry than whether the claims are obvious. *Amgen v. Hoechst Marion Roussel*, 457 F.3d 1293, 1308 (Fed. Cir. 2006) (“[N]on-enablement does not preclude a finding of obviousness.”). Moreover, Dr. Prucnal *never* states that the claimed invention is “impossible-to-build,” per Patent Owners’ repeated lie to the Board. *Compare* Paper 22, 2, with Ex. 1058; *see also* Paper 16, 4-5 (“Patent Owners again misrepresent Petitioner’s argument: Petitioner does not assert that any combination was *impossible*, but instead that the *inventors* of the ’795 Patent failed to properly enable the small-form pluggable described in the claims.”). Despite Patent Owners’ ever-changing desire to submit or expunge this report (Ex. 1059; Paper 22, 1-2), Petitioner resubmits it with the (allegedly) confidential inventor testimony redacted. Ex. 1058.

Section II: Patent Owner is simply wrong that the “litigation remains effectively on the eve of trial for the patent-at-issue.” Paper 22, 3. No trial is even set, and trial will not occur until at least a year after the latest possible institution

decision. And significant work remains once expert discovery resumes in mid-to-late 2025. As noted in Petitioner’s update, the Board assesses the *original* statutory institution deadline when analyzing the *Fintiv* factors. *CommScope v. Dali Wireless*, IPR2022-01242, Paper 24 at 52 (PTAB Feb. 27, 2023). Also, when a patent will expire has no bearing on *Fintiv*. And Patent Owners’ unsupported assertion that Petitioner is circumventing its “if instituted” stipulation is without merit—there is no institution yet. Petitioner fully stands by the stipulation it made in its Petition.

Section III: This section is irrelevant to *Fintiv*. And Patent Owners’ attack on the motivation to combine ignores the Petition, which explains how the stacking technique in Wei teaches a POSITA “how to package larger transceiver modules into a pluggable SFP package.” Paper 1, 11-12, 40-41; Paper 11, 1-3, 14-15; Ex. 1006, 2:28-35, Figs. 1-5. Moreover, Petitioner never argued, nor do the claims require, that the *entire line card* in Agazzi ’640 or Agazzi ’341 must be packaged in a pluggable form factor. Instead, Petitioner stated that a “POSITA would have been motivated to combine the transceiver module of Agazzi [’640/’321] with the pluggable form factor of Wei” Paper 1, 12, 40. Patent Owners’ line card size, number of parallel paths, power, and pin arguments, therefore, are red herrings because they are only relevant to the entire Agazzi line card—a concept not relevant to (and not required by) the obviousness count advanced here by Petitioner.

Date: May 15, 2024

By: / M. Scott Stevens /
M. Scott Stevens, Reg. No. 54,762

CERTIFICATE OF SERVICE

The undersigned certifies that Petitioner served a copy of the foregoing PETITIONER'S RESPONSE TO PATENT OWNERS' UPDATE REGARDING INTERVENING DEVELOPMENTS AFFECTING INSTITUTION by filing this document through the P-TACTS Filing System as well as sending a copy via electronic service (as agreed by counsel for Patent Owners) on the following:

Lead Counsel	Back-Up Counsel
Qi (Peter) Tong Reg. No. 74,292 Russ August & Kabat 4925 Greenville Avenue, Suite 200 Dallas, TX 75206 Phone: (310) 826-7474 Fax: (310) 826-6991 ptong@raklaw.com rak_nextgen@raklaw.com	Irene Y Lee (Reg. No. 54,259) Benjamin T. Wang Andrew D. Weiss Paul A. Kroeger Russ August & Kabat 12424 Wilshire Blvd., 12th Fl. Los Angeles, CA 90025 Phone: (310) 826-7474 Fax: (310) 826-6991 ilee@raklaw.com bwang@raklaw.com aweiss@raklaw.com pkroeger@raklaw.com rak_nextgen@raklaw.com

Date: May 15, 2024

By: / M. Scott Stevens /
M. Scott Stevens
Reg. No. 54,762
ALSTON & BIRD LLP
Vantage South End
1120 South Tryon Street, Suite 300
Charlotte, NC 28203-6818
Phone: 704.444.1025
Email: scott.stevens@alston.com

Attorney for Petitioner