From:	Stevens, Scott
To:	Director_PTABDecision_Review
Cc:	ptong@raklaw.com; rak_nextgen@raklaw.com; Lee, Irene; Wang, Benjamin; Andrew Weiss; Paul Kroeger; Stevens, Scott; Wroblewski, Karlee; Welch, Matt
Subject:	IPR2023-00681 (Nokia of America Corporation v. Alexander Soto et al.) - Petitioner"s Request for Rehearing by the Director
Date:	Monday, December 4, 2023 6:42:35 PM
Attachments:	011 2023-12-04 Rqst for Rehearing (No. IPR2023-00681 '723).pdf

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Director Vidal,

Petitioner Nokia of America Corporation respectfully notifies the parties and the USPTO of its filing of the attached Request for Rehearing by the Director ("Request"), Paper 11, filed pursuant to 37 C.F.R. § 42.71(d) and the Revised Interim Director Review Process adopted on July 24, 2023, of the decision by the Board denying institution under section 325(d) (Paper 10) in IPR2023-00681.

The Request presents the following issues, listed in order of priority, for which Petitioner seeks review:

1. Whether the Board abused its discretion by focusing its analysis on the similarity of the claim limitations covered by the references, rather than on the references themselves, and by ignoring enumerated material differences in the references along with their impact on the motivation to combine.
2. Whether the Board abused its discretion by relying, in part, on a previously filed and discretionarily denied petition in its institution decision of a subsequent petition.

The first issue violates what was laid out in the Director's recent order in *Wolfspeed* where the Director explained that the Board must address and sufficiently consider material differences, especially when the material differences were not in the combination before the Examiner and are "highly relevant when assessing the obviousness grounds" in the Petition. *Wolfspeed Inc. f/k/a Cree, Inc. v. Trs. of Purdue Univ.*, IPR2022-00761, Paper 13 at 7-8 (PTAB Mar. 30, 2023). The requirement to sufficiently consider material differences is of particular importance in this case given the impact that the material differences have on the motivation to combine analysis, an analysis that appears to have been core to the Examiner allowing the case originally. The second issue is important because the current petition should not be denied simply because a prior petition was denied under section 325(d). Instead, like the Board held in *Sling TV LLC v. Uniloc 2017 LLC*, IPR2019-01270, Paper 11 at 17-20 (PTAB Jan. 9, 2020), "[a]n earlier preliminary consideration by the Board in determining whether to institute a trial is not a sufficient demonstration that the reference was previously considered so as to satisfy *Becton, Dickinson* or the statute." *Id.* at 17-18.

Respectfully submitted,
Scott Stevens

M Scott Stevens
Partner
ALSTON & BIRD
Vantage South End
1120 S. Tryon St., Suite 300
Charlotte, NC 28203
+1 704 444 1025 (O)
Scott.Stevens@alston.com

NOTICE: This e-mail message and all attachments may contain legally privileged and confidential information intended solely for the use of the addressee. If you are not the intended recipient, you are hereby notified that you may not read, copy, distribute or otherwise use this message or its attachments. If you have received this message in error, please notify the sender by email and delete all copies of the message immediately.