

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NOKIA OF AMERICA CORPORATION,

Petitioner

v.

ALEXANDER SOTO AND WALTER SOTO,

Patent Owners

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Case: IPR2023-00681

U.S. Patent No. 10,263,723

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

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US Patent and Trademark Office  
PO Box 1450  
Alexandria, Virginia 22313-1450

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**LIST OF EXHIBITS**

| <b>Exhibit</b> | <b>Short Name</b>   | <b>Description</b>                                                                                                   |
|----------------|---------------------|----------------------------------------------------------------------------------------------------------------------|
| Ex. 1001       | '723 Patent         | U.S. Patent No. 10,263,723                                                                                           |
| Ex. 1002       | '723 File History   | File History of U.S. Patent No. 10,263,723                                                                           |
| 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       |                     | [Reserved]                                                                                                           |
| 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 |                   | [Reserved]                                                                                                                                                                                                                                       |
| Ex. 1023 | '795 Patent       | U.S. Patent No. 9,887,795                                                                                                                                                                                                                        |
| Ex. 1024 | '795 File History | File History of U.S. Patent No. 9,887,795                                                                                                                                                                                                        |
| Ex. 1025 |                   | [reserved]                                                                                                                                                                                                                                       |
| Ex. 1026 |                   | [reserved]                                                                                                                                                                                                                                       |
| 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)                                                                   |

| Exhibit  | Short Name                          | Description                                                                                                                                                                                        |
|----------|-------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Ex. 1028 |                                     | [Reserved]                                                                                                                                                                                         |
| Ex. 1029 |                                     | [Reserved]                                                                                                                                                                                         |
| Ex. 1030 | Caseload                            | U.S. District Court – Judicial Caseload Profile (Sept. 2022)                                                                                                                                       |
| Ex. 1031 | 723 Patent Infringement Contentions | NextGen’s Infringement Contentions Against Petitioner for the ’723 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 | Samueli                             | Henry Samueli, Jeffrey Putnam, Mehdi Hatamian, <i>QAM-Based Transceiver Solutions for Full-Duplex Gigabit Ethernet Over 4 Pairs of UTP-5 Cable</i> , Broadcom Corporation Presentation (Nov. 1996) |
| Ex. 1034 | Stevens Declaration                 | Declaration of M. Scott Stevens dated September 14, 2023                                                                                                                                           |
| Ex. 1035 | Consolidation Order                 | NextGen Innovations, LLC v. Fujitsu Network Communications, et al., No. 2:22-cv-00307-JRG-RSP (lead case), Dkt. No. 22 (E.D. Tex. Oct. 21, 2022)                                                   |
| Ex. 1036 | Hearing Transcript                  | Nokia of America Corporation v. Soto et al., IPR2023-00960, Ex. 2004 (PTAB Aug. 29, 2023)                                                                                                          |
| Ex. 1037 | PTAB Order                          | Nokia of America Corporation v. Soto et al., IPR2023-00960, Paper 8 (PTAB Aug. 26, 2023)                                                                                                           |
| 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&amp;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&amp;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&amp;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&amp;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&amp;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&amp;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 ’723 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, 44; 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, 11, 44. 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 /  
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**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:

| <b>Lead Counsel</b>                                                                                                                                                                                                 | <b>Back-Up Counsel</b>                                                                                                                                                                                                                                                                                                                 |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
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