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 IPR2023-00681
U.S. Patent No. 10,263,723

PATENT OWNERS' REBUTTAL BRIEF ON ALL INTERVENING DEVELOPMENTS AFFECTING INSTITUTION

TABLE OF AUTHORITIES

CASES

CommScope Techs. LLC v. Dali Wireless, Inc.,
IPR2022-01242, Paper 24 (PTAB Feb. 27, 2023) 1

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	Reserved
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.
2012	Chain of emails providing authorization from the Board for supplemental arguments and exhibits
2013	Consolidation Order from *NextGen Innovations, LLC v. Nokia of Am. Corp.*, 2:23-cv-00637-JRG-RSP (E.D. Tex. Jan 30, 2024)
2014	Order for Scheduling Conference from *NextGen Innovations, LLC v. Nokia of Am. Corp.*, 2:23-cv-00637-JRG-RSP (E.D. Tex. Apr. 17, 2024)
2015	Memorandum Regarding: *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation*

2016	Joint Motion to Stay All Deadlines and Notice of Resolution (with AT&T) from *NextGen Innovations, LLC v. Fujitsu Network Communications, Inc.*, No. 2:22-cv-00307-JRG-RSP (E.D. Tex. Mar. 29, 2024)
2017	Chain of emails between counsel for the parties, with Patent Owner seeking permission to file excerpts of expert report and Petitioner denying permission.
2018	U.S. Pat. No. 7,206,366 to Fujimori et al.
2019	Chain of emails between counsel for Patent Owners and counsel for Nokia regarding extensions in view of settlement in IPR2023-00960.
2020	Copy of "AMP Schematic, 'Plug Assembly, 64 Position, Self-Retained, Action Pin, Champ-Lok'" submitted as non-patent literature in the Sept. 4, 2017 IDS in App. 15/095,137 (corresponding to Patent 9,887,795).

Petitioner's Fintiv analysis is flawed. For factor 2 (proximity to trial), **Paper 24** from *CommScope Techs. LLC v. Dali Wireless, Inc.* is not precedential (only Paper 23 is). IPR2022-01242, Paper 24 at 52 (PTAB Feb. 27, 2023). The Board specifically authorized this briefing to consider, not ignore, the changed circumstances. If anything, *CommScope* suggests that the Board should consider updates in "anomalous" situations like this case. Petitioner ignores that institution decision deadline is September 27, 2024, which sets the Final Written Decision deadline around approximately September 27, 2025. Paper 19 at 2.

Petitioner's other arguments should also not be persuasive. Petitioner's argument regarding *Fintiv* factor 3 analysis completely ignores the past 1.5 years of investment in litigation already incurred, work that includes tasks up through opening expert reports. Consolidation into *Nokia II* does not reverse this work.

Petitioner's argument for *Fintiv* Factor 6 does not address the issue of the contradictory opinion of its expert in litigation even though Petitioner was aware of this issue. *See* Ex. 2017. The contradictory expert opinion on the lack of enablement undercuts the expert's obviousness arguments.

Finally, Petitioner inaccurately describes the Director's decision as finding that the Board's discretional denial was substantively inappropriate. Instead, the Director merely remanded on the procedural ground that the "Board did not sufficiently explain its findings." Paper 18 at 2–3, 8. The Board's original findings

remain appropriate, and the Director's decision can be addressed with the following two additional explanations.

First, the Board could clarify that applying Wei's PCB board halve-and-stack technique to a 64- or 128-pin Agazzi system does not make it fit in Wei's 20-pin SFP module (with only 4 pins dedicated to data). *See* Ex. 1006 at Figs. 4B, 4C; Ex. 2020 (64-pin connector considered by examiner). Petitioner's argument remains substantially similar to the Brede plus pluggable prior art references considered by the examiner because it is not obvious how to fit a 64-pin prior art device into the SFP module limitations. *See* Ex. 1024 at 70 (arguing "one male 64 pin AMP champ connector is larger than an SFP"); Paper 14 at 3 (summarizing allowance). Making this similarity express will address the Director's remand.

Second, the Board could also clarify that the use of integrated circuits was already considered, and that the use of an integrated circuit similarly does not change the incompatibly large pin count of the Agazzi systems. Paper 6 at 46, 50 (citing Aronson, Ex. 2003). At best, Aronson is evidence that **one** pathway in an IC is compatible with a pluggable module. Ex. 2003, Fig. 3. The Agazzi systems, which have 16 parallel pathways, are too big, too hot, and too power hungry to fit. The Petition does not address this issue at all. Tellingly, Petitioner ignores these problems in both Paper 16 and Paper 21 even after the Board authorized Patent Owner's "broader" request for briefing on "any" intervening developments. Ex. 2012.

Respectfully submitted,

Dated: May 15, 2024

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Paper is 2 pages or less, excluding table of contents, table of authorities, certificate of service, signature block, this certificate, or table, which is in compliance with Exhibit 2012.

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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 May 15, 2024, 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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