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Paper 8
Date: August 26, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION,
Petitioner,

v.

ALEXANDER I. SOTO AND WALTER G. SOTO,
Patent Owner.

IPR2023-00960
Patent 8,238,754 B2

Before THU A. DANG, PATRICK M. BOUCHER, and
KEVIN C. TROCK, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Petitioner, Nokia of America Corporation ("Nokia" or "Petitioner"), filed a petition requesting *inter partes* review of claims 1–16 and 18–30 of U.S. Patent No. 8,238,754 B2 ("the '754 patent"). Paper 2. The Petition was accorded a filing date of June 30, 2023. Paper 3.

On July 21, 2023, counsel for Patent Owner, Alexander I. Soto and Walter G. Soto, ("Patent Owner"), filed without prior authorization a Motion to Dismiss, or Alternatively to Vacate Filing Date and Deadlines for Lack of Service. Paper 6 ("Motion").

A conference call with counsel for the parties was held on August 23, 2023, to discuss the status of the case and Patent Owner's unauthorized Motion.

Patent Owner asserts that it did not receive actual service of the Petition until July 20, 2023, and asks that we dismiss the Petition for lack of service or alternatively reset the filing date and all deadlines dependent on the date of actual service. *See* Motion 1, 3.

Petitioner asserts that on June 30, 2023, it attempted to physically serve the Petition at the registered address for U.S. Patent 8,238,754 via UPS Next Day Air, and provided a courtesy service via email of the Petition and all accompanying documents to Patent Owner's counsel of record in the co-pending litigations and three recently filed, related IPRs. *See* Ex. 3001.[1] Petitioner asserts that its records indicate that Patent Owner's counsel downloaded the Petition and all accompanying documents on July 5, 2023. *See id.*

[1] Exhibit 3001 is email correspondence from July 20–25, 2023, with the Board from counsel for the parties.

Petitioner also asserts that on July 19, 2023, it worked to re-effectuate service by re-sending copies of the Petition and documents to all known addresses of Patent Owner, and that these packages were all successfully delivered on July 20, 2023. *Id.* On the conference call, Patent Owner conceded that it received actual service of the Petition on July 20, 2023. *See also* Motion 3.

35 U.S.C. § 312 (a)(5) states that "[a] petition . . . may be considered only if . . . the petitioner provides copies . . . to the patent owner or, if applicable, the designated representative of the patent owner." 37 C.F.R § 42.105 (a) states that "the petitioner must serve the petition and exhibits relied upon in the petition . . . on the patent owner at the correspondence address of record for the subject patent. The petitioner may additionally serve the petition and supporting evidence on the patent owner at any other address known to the petitioner as likely to effect service."

However, 37 C.F.R. §§ 42.20 (a)(b) states that "[r]elief, other than a petition requesting the institution of a trial, must be requested in the form of a motion" and that "[a] motion will not be entered without Board authorization."

Patent Owner did not receive prior authorization from the Board to file its Motion. Nonetheless, the parties agree that actual service of the Petition occurred on July 20, 2023. *See* Motion 3; Ex. 3001. Moreover, during the conference call, Patent Owner agreed that it would not suffer any prejudice if a filing date of July 20, 2023, the date of actual service, was accorded to the Petition.

Accordingly, it is

ORDERED that a Notice of Corrected Filing Date Accorded to the Petition of July 20, 2023, shall be entered; and

FURTHER ORDERED that Patent Owner shall have 21 days from the entry of the Notice of Corrected Filing Date to submit its mandatory notice information; and

FURTHER ORDERED that the deadline for filing a Patent Owner Preliminary Response in the proceeding shall be 3 months from the entry of the Notice of Corrected Filing Date; and

FURTHER ORDERED that Patent Owner's unauthorized Motion to Dismiss, or Alternatively to Vacate Filing Date and Deadlines for Lack of Service is dismissed as moot.

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Nokia of America Corporation
IPR2023-00682, Ex. 1037
Ex. 1037.4