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Subject: IPR2023-00682 (Nokia of America Corporation v. Alexander Soto et al.) - Petitioner's Request for Rehearing by the Director
Date: Monday, December 4, 2023 6:43:19 PM
Attachments: [011 2023-12-04 Rqt for Rehearing \(No. IPR2023-00682 '181\).pdf](#)

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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 IPR2023-00682.

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

IPR2023-00682
Ex. 3100

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