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Subject: IPR2023-00682 (Nokia of America Corporation v. Alexander Soto et al.) - Petitioner's Second Request for Rehearing by the Director
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Attachments: [2024-08-30 Petitioner's Second Request for Rehearing IPR2023-00682.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 29, 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 on remand under section 325(d) (Paper 26) 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 erroneously rejecting the enumerated differences in the references along with their impact on the motivation to combine (or lack thereof) as not material when the applicant, to obtain allowance, distinguished the then cited art based on the lack of "integrated optoelectronics" and this allegedly missing feature was specifically identified in the Petition as being present in the newly identified references.
2. Despite neither Party asserting a primary reference cited in the IPR "was involved during examination," whether the Board can deny Institution under 35 USC 325(d) without individually evaluating and explaining its basis for denying institution with respect to each asserted ground.

The Board again denied institution despite the fact that the cited references were not previously considered by the Office. The first issue is at odds with the Director Review Decision (Paper 18) and violates what was laid out in the Director's recent order in *Wolfsped* 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. *Wolfsped 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 that the enumerated material difference is what Applicant argued distinguished its claims during prosecution. The second issue is important because the Director Review Decision in this matter required the Board to "sufficiently explain its findings." But the Board declined the Director's guidance with regard to at least one ground as it decided to lump both primary references Agazzi '640 and Agazzi '341 together, despite the references themselves being unrelated and materially different. Denial without the requisite analysis of each of the grounds is inappropriate under section 325(d).

IPR2023-00682
Ex. 3103

Respectfully submitted,
Scott Stevens

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