From:	Director_PTABDecision_Review
To:	ptong@raklaw.com; Stevens, Scott; Director_PTABDecision_Review
Cc:	rak_nextgen@raklaw.com; ilee@raklaw.com; Wang, Benjamin; Andrew Weiss; Paul Kroeger; Wroblewski, Karlee
Subject:	RE: IPR2023-00682 (Nokia of America Corporation v. Alexander Soto et al.) - Petitioner"s Second Request for Rehearing by the Director
Date:	Monday, November 4, 2024 7:54:54 AM

Counsel,

Thank you for your email. Your request to file a response to the pending Director Review Request is denied at this time. *See* Director Review Process, available at https://www.uspto.gov/patents/ptab/decisions/director-review-process, Section 5.A.ii.b ("Director Review decisions are generally made based on the existing record, without the need for responsive or *amici curiae* briefing. Responsive or *amici curiae* briefing may only be submitted if requested by the Director."). If the Director determines that briefing is necessary, counsel will be informed.

Your email and this response will be entered into the public record. *See id*. at Section 3.G ("All communications will be entered into the record of the proceeding.").

Thank you.

From: ptong@raklaw.com <ptong@raklaw.com>
Sent: Monday, September 23, 2024 4:28 PM
To: Stevens, Scott <Scott.Stevens@alston.com>; Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: rak_nextgen@raklaw.com; ilee@raklaw.com; Wang, Benjamin <bwang@raklaw.com>; Andrew Weiss <aweiss@raklaw.com>; Paul Kroeger <pkroeger@raklaw.com>; Wroblewski, Karlee <Karlee.Wroblewski@alston.com>
Subject: Re: IPR2023-00682 (Nokia of America Corporation v. Alexander Soto et al.) - Petitioner's Second Request for Rehearing by the Director

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Director Vidal,

Patent Owner objects to Petitioner's second request for rehearing by the director as unauthorized under 37 C.F.R. § 42.71(d). This section provides that "A party dissatisfied with a decision may file **a single request** for rehearing without prior authorization from the Board." (emphasis added). It does not authorize a request for a second rehearing by the director after a second institution denial of the same petition, as Nokia has done here. It should be denied.

Petitioner's email below raising issues #1 and #2 also fails to comply with the requirement from the Revised Interim Director Review Process (3)(A), which requires that the Petitioner concurrently email the director and file a request for rehearing, where the email must contain "a priority-ranked list of the issues for which the party seeks review." The as-filed request for rehearing (Paper 29) raises four issues under headings A-D, but the email to the director below identifies only issues #1 and #2 below.

The first issue about "integrated optoelectronics" was argued in the initial briefing, argued again during the first petition for review, and addressed by the Board on remand, so this is Petitioner's third bite at the issue. The Board explicitly found that the examiner had three references with integrated

optoelectronics (Agazzi ’997, Gilliland, and Aronson), so the technology is nothing new to the USPTO. This type of factual extensively developed factual question is unworthy of the director’s attention.

The second question is also unworthy of review because 325(d) speaks for itself and explicitly authorizes the Board to deny a petition when “the same **or substantially the same prior art** or arguments were previously presented to the Office.” (emphasis added). The Board extensively explained the deficiencies with both the Agazzi ’640 and Agazzi ’341 prior art underlying all asserted grounds, so the part of the request asserting that the Board acted “without individually evaluating and explaining its basis for denying institution with respect to each asserted ground” is without basis.

Should director review be granted a second time, Patent Owner requests permission to file a responsive brief of equal length to Petitioner’s request for rehearing as was previously granted in Paper 13.

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From: Stevens, Scott <Scott.Stevens@alston.com>
Date: Friday, August 30, 2024 at 5:29 PM
To: Director_PTABDecision_Review@uspto.gov <Director_PTABDecision_Review@uspto.gov>
Cc: rak_nextgen@raklaw.com <RAK_NextGen@raklaw.com>, ilee@raklaw.com <ilee@raklaw.com>, Wang, Benjamin <bwang@raklaw.com>, Andrew Weiss <aweiss@raklaw.com>, Paul Kroeger <pkroeger@raklaw.com>, Wroblewski, Karlee <Karlee.Wroblewski@alston.com>, ptong@raklaw.com <ptong@raklaw.com>
Subject: IPR2023-00682 (Nokia of America Corporation v. Alexander Soto et al.) - Petitioner's Second Request for Rehearing by the Director

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 *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 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).

Respectfully submitted,
Scott Stevens

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