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To: [Wroblewski, Karlee](#); [Trials](#)
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Subject: RE: IPR2023-00960: Leave to File Reply and Sur-Reply to POPR
Date: Wednesday, December 27, 2023 2:52:29 PM

Counsel,

From the Board –

Petitioner's request for additional briefing has been approved. Petitioner may file a Preliminary Reply limited to addressing Patent Owners' assertions in the Preliminary Response concerning (1) concerning the priority date of the '754 Patent, (2) discretionary denial under 35 U.S.C. § 325(d), and (3) discretionary denial under *Fintiv*. Petitioner's Preliminary Reply is limited to 10 pages and is due 14 days from the date of the Board's email. Patent Owner may file a Preliminary Sur-reply responding to the arguments raised by Petitioner in its Preliminary Reply. Patent Owner's Preliminary Sur-reply is limited to 10 pages and is due 14 days after Petitioner's Preliminary Reply is filed.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Wroblewski, Karlee <Karlee.Wroblewski@alston.com>
Sent: Friday, December 22, 2023 3:46 PM
To: Trials <Trials@USPTO.GOV>
Cc: [ptong@raklaw.com](#); [rak_nextgen@raklaw.com](#); [Stevens, Scott](#) <Scott.Stevens@alston.com>; [Welch, Matt](#) <Matt.Welch@alston.com>; [Nokia22-309](#) <Nokia22-309@alston.com>
Subject: IPR2023-00960: Leave to File Reply and Sur-Reply to POPR

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Dear Board,

Pursuant to 37 C.F.R. § 42.108(c), Petitioner Nokia of America Corporation requests permission to file a reply to Patent Owner's Preliminary Response in IPR2023-00960. Specifically, Petitioner seeks leave to address (1) Patent Owners' assertions regarding the priority date the '754 Patent, and (2) the discretionary denial issues raised under 35 U.S.C. § 325(d), and (3) considerations under *Fintiv*. Petitioner respectfully requests a Reply that is 10 pages and that the Reply be due 14 days after authorization is provided for the Reply.

Petitioner and Patent Owner met and conferred with the following outcomes:

Opposed:

- Petitioner's position is that it did not waive any arguments regarding priority date as Petitioner asserted that the earliest alleged priority date is October 30, 2003. Petition at 8. Patent Owner's contention in District Court litigation that "the Asserted Claims of the '754 patent are entitled to priority dates of October 30, 2003." Petitioner could not have foreseen Patent Owner's challenge that the priority date is "June 3, 2003" (POPR at 8) in view of the Patent Owner's previous admissions regarding the priority date. Petitioner additionally requests permission to file two documents evidencing Patent Owner's positions with respect to the priority date.
- Patent Owner opposes further argument about the priority date because unlike in District Court where the

issue is disputed, here Patent Owner waived the priority date dispute including any reply or hearing about what is the “earliest” priority date on page 9 of the Petition: “for purposes of this Petition, no determination as to intervening priority need be made; all the prior art relied upon herein is prior art to the earliest alleged priority date in 2003.” Thus, Petitioner waved its challenge to the earliest priority date listed on the face of the challenged Patent. Patent Owner opposes the filing of additional evidence related to the priority date.

Agreed: With respect to issues (2) and (3), the Parties conferred and agree that Patent Owner does not oppose as long as the Reply and Sur-Reply would not be used to A) propose any new combinations or motivations to combine, B) recharacterize or modify its existing combination and motivations to combine, or C) otherwise use the §325(d) or *Fintiv* section to address the merits or deficiencies of the § 103 argument raised on pages 9-28 of the POPR.

Agreed: Patent Owner does not oppose the 10 pages of length or 14-day deadline, and Petitioner does not oppose Patent Owner’s request for a Sur-Reply of equal length and for a response period of equal length to any Reply authorized for Petitioner. No further expert reports or declarations will be submitted.

Should the Board request a conference call, the Parties are available on January 2 after 2 pm Eastern, anytime on January 3, or anytime on January 5.

Regards,
Karlee

Karlee N. Wroblewski
Associate

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