

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION,
Petitioner

v.

ALEXANDER SOTO AND WALTER SOTO,
Patent Owners

Case: IPR2023-00960

U.S. Patent No. 8,238,754

**PETITIONER'S REPLY TO PATENT OWNERS'
PRELIMINARY RESPONSE**

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Patent Trial and Appeal Board
US Patent and Trademark Office
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LIST OF EXHIBITS

Exhibit	Short Name	Description
Ex. 1001	'754 Patent	U.S. Patent No. 8,238,754
Ex. 1002-1	'754 File History	File History of U.S. Patent No. 8,238,754
Ex. 1002-2	'514 File History	File History of U.S. Patent Application No. 60/886,514
Ex. 1003	Prucnal Declaration	Declaration of Dr. Paul Prucnal
Ex. 1004	Prucnal CV	<i>Curriculum Vitae</i> of Dr. Paul Prucnal
Ex. 1005	Shraga	U.S. Patent No. 6,697,374
Ex. 1006	Wood	U.S. Patent No. 7,088,921
Ex. 1007	Togami	U.S. Patent No. 6,439,918
Ex. 1008	Fujimori	U.S. Patent No. 7,206,366
Ex. 1009	Liu	U.S. Patent No. 6,005,694
Ex. 1010	Starr Declaration	Declaration of Thomas J. J. Starr
Ex. 1011-1	G.984.3 Draft Recommendation	ITU-T Study Group 15, Temporary Document 7, Draft new Recommendation G.984.3 – Transmission Convergence Layer for Gigabit Passive Optical Networks
Ex. 1011-2	Contribution 104	ITU-T Study Group 15, Contribution 104, Draft new Recommendation G.984.3 – Transmission Convergence Layer for Gigabit Passive Optical Networks
Ex. 1012	OKI Article	<i>SFF & SFP Optical Transceivers</i> , OKI Technical Review Issue 190, Vol. 69, No. 2 (April 2002)
Ex. 1013	Ramaswami	Rajiv Ramaswami & Kumar Sivarajan, <i>Optical Networks, A Practical Perspective</i> (2d ed. 2002)

Exhibit	Short Name	Description
Ex. 1014	Kramer IEEE	Glen Kramer & Gerry Pesavento, <i>Ethernet Passive Optical Network (EPON): Building a Next-Generation Optical Access Network</i> , IEEE Communications Magazine (February 2002)
Ex. 1015	Kazi	Khurram Kazi, <i>Optical Networking Standards, A Comprehensive Guide for Professionals</i> (2006)
Ex. 1016	SFP MSA	SFF Committee, INF-8074i Specification for SFP (Small Formfactor Pluggable) Transceiver, Rev. 1.0, May 12, 2001).
Ex. 1017	XFP MSA	10G small form factor pluggable, XFP Revision 4.5 (initial publication March 2002)
Ex. 1018	XENPAK MSA	INF-8474i Specification for Xenpak 10 Gigabit Ethernet Transceiver, Rev. 3.0, September 18, 2002 (publicly announced March 12, 2001)
Ex. 1019	Kramer OSA	Glen Kramer, et al., <i>Supporting differentiated classes of service in Ethernet passive optical networks</i> , Journal of Optical Networking, Vol. 1, Nos. 8 & 9 (August & September 2002)
Ex. 1020	EC&M Article	Small Form Factor Connector Basics by Paul Rosenberg, EC&M.com (Sept. 1, 2001).
Ex. 1021	Going Serial Article	Going Serial in Gigabit Ethernet Designs by Martin Lund, EDN.com (June 20, 2002).
Ex. 1022	G.984.2	ITU-T G.984.2 (03/2003) Gigabit-capable Passive Optical Networks (GPON): Physical Media Dependent (PMD) layer specification
Ex. 1023	G.984.1	ITU-T G.984.1 (03/2003) Gigabit-capable Passive Optical Networks (GPON): General Characteristics
Ex. 1024	ITU-T A.1	ITU-T A.1 (10/2000) Work methods for study groups of the ITU Telecommunication Standardization Sector (ITU-T)

Exhibit	Short Name	Description
Ex. 1025	SG15 Contributions List	List of contributions from Oct. 2003 Geneva, Switzerland Meeting
Ex. 1026	SG15 TD-PLEN List	List of Plenary temporary documents from the Oct. 2003 Geneva, Switzerland Meeting
Ex. 1027	WP1 TD List	List of WP1 temporary documents from Oct. 2003 Geneva, Switzerland Meeting
Ex. 1028	WP1 TD5	Report of Q.2/15 Rapporteur meeting, 13-14 August 2003, Santa Clara, USA
Ex. 1029	TD-58GEN	List of participants at the Oct. 2003 Geneva, Switzerland
Ex. 1030	TD-7PLEN HTML	Webpage printout of The G.984.3 Draft Recommendation page
Ex. 1031	Contribution 104 HTML	Webpage printout of Contribution 104
Ex. 1032	DCO	Doc. No. 58, Docket Control Order, <i>NextGen Innovations, LLC v. Fujitsu Network Communications, Inc. et al.</i> , No. 2:22-cv-00307-JRG-RSP (E.D. Tex.) (consolidated cases)
Ex. 1033	Caseload	U.S. District Court – Judicial Caseload Profile (Sept. 2022)
Ex. 1034	Agilent New Fiber Optic Transceiver	<i>Agilent Technologies' New Fiber Optic Transceivers Offer Industry's Lowest EMI Emissions</i> , Agilent Technologies Inc. (July 10, 2001)
Ex. 1035	Infringement Contentions	Plaintiff NextGen Innovations, LLC's Disclosure of Asserted Claims and Infringement Contentions to the Nokia Defendants, <i>NextGen Innovations, LLC v. Nokia Corp., et al.</i> , No. 2:22-cv-00309-JRG-RSP (E.D. Tex.)
Ex. 1036	Nokia's Motion to Intervene in the AT&T Litigation	Dkt. No. 27, Nokia of America Corporation's Motion to Intervene, <i>NextGen Innovations, LLC v. AT&T Services, Inc., et al.</i> , No. 2:23-cv-00263-JRG-RSP (E.D. Tex.)

Exhibit	Short Name	Description
Ex. 1037	AT&T Litigation DCO	Dkt. No. 23, Docket Control Order, <i>NextGen Innovations, LLC v. AT&T Services, Inc., et al.</i> , No. 2:23-cv-00263- JRG-RSP (E.D. Tex.)
Ex. 1038	AT&T Litigation Infringement Contentions	Plaintiff NextGen Innovations, LLC's Disclosure of Asserted Claims and Infringement Contentions to AT&T, <i>NextGen Innovations, LLC v. AT&T Services, Inc., et al.</i> , No. 2:23-cv-00263- JRG-RSP (E.D. Tex.) (Sept. 13, 2023)

I. INTRODUCTION

Pursuant to the Board’s email dated December 27, 2023, Nokia of America Corporation (“Petitioner” or “Nokia”) submits this Reply to Patent Owners’ Preliminary Response (Paper 14, “POPR”). In its POPR, Patent Owners (1) incorrectly allege that U.S. Patent No. 8,238,754 (the “’754 Patent”) is entitled to a June 3, 2003 priority date, (2) contend that the Petition reargues references substantially similar to, but not the same as, art cited during prosecution of a related patent having materially distinct claims, and (3) urge the Board to deny institution under *Fintiv* without considering the impact a third-party suit and intervention by Nokia has on the timeline of a co-pending district court case. This Reply addresses Patent Owners’ misstatements and assertions.

II. ARGUMENT

A. The ’754 Patent is not entitled to a priority date of June 3, 2003.

Patent Owners’ assertion that the ’754 Patent is entitled to a priority date any earlier than October 30, 2003 is at odds with statements Patent Owners made in the district court and is unsupported. As such, Patent Owners’ arguments fail.

First, Patent Owners admit in the District Court Litigation¹ that they believe

¹ *NextGen Innovations, LLC v. Nokia Corporation, et al.*, Case No. 2:22-cv-00309-JRG (E.D. Tex.) (the “District Court Litigation”).

the '754 Patent is entitled to a priority date of October 30, 2003. On November 3, 2022, in compliance with Eastern District of Texas Patent Rule 3-1(e) (the “Infringement Contentions”), Patent Owners contended that the '754 Patent and its asserted claims were entitled to a priority date of October 30, 2003. Ex. 1035 at 6.²

E. Patent Rule 3-1(e): Priority Dates

The Asserted Claims of the '181, '723, and '795 patent are entitled to priority dates of June 10, 2003.

The Asserted Claims of the '754 patent are entitled to priority dates of October 30, 2003.

In the year since its original assertion, Patent Owners have made no attempt to notify Petitioner, in the District Court Litigation or otherwise, that they believed the claims of the '754 Patent were entitled to a priority date any earlier than October 30, 2003. Patent Owners even maintained their assertion that the earliest entitled priority date is October 30, 2003, *well after* the filing of this Petition in infringement contentions served on September 13, 2023, in another litigation involving the '754

² It was not foreseeable at the time of filing to address the priority date further in the Petition because Patent Owner previously admitted that its earliest priority date was October 30, 2003. Petitioner has attached, as Ex. 1035 and Ex. 1038, Patent Owners' contentions regarding priority.

Patent³—“[t]he Asserted Claims of the ’754 patent are entitled to priority dates of October 30, 2003.” Ex. 1038 at 5. Petitioner has spent countless hours and resources investigating the validity of the ’754 Patent based on Patent Owners’ assertion; Patent Owners now attempt an ill-supported bait-and-switch without notifying the Board of its prior positions or explaining such a fundamental change in position. Only now, after seeing the strength of Petitioner’s references, do Patent Owners appear to backtrack their previously asserted, and relied-on, priority date.

Moreover, Patent Owners mis-contextualize quotes from the Petition in an attempt to argue that Petitioner somehow agrees or “admits” to the ’754 Patent’s entitlement to a priority date of July 3, 2003.⁴ In a feeble attempt to convince the Board of their assertion, Patent Owners even go so far as to state that Petitioner’s

³ *NextGen Innovations, LLC v. AT&T Services, Inc. et al.*, Case No. 2:23-cv-00263 (E.D. Tex.) (“the AT&T Litigation”).

⁴ Patent Owners themselves erroneously claim that they are entitled to a priority date of June 3, 2003 throughout the POPR. Patent Owners are mistaken. U.S. Provisional App. No. 60/485,072 (the “July Provisional”) referenced in the POPR was filed on July 3, 2003, not June 3, 2003. Ex. 1001 at (60). Regardless of this apparent typo, which Patent Owners fail to correct throughout their POPR, the ’754 Patent is entitled to no priority date earlier than October 30, 2003.

October 30, 2003 date “appears to be a typo” (POPR at 8), a completely unfounded statement—Patent Owners are aware that this date is not a typo, as it is the date they themselves cited as the priority date of the ’754 Patent in their own Infringement Contentions. Ex. 1035 at 6. In light of this misrepresentation, Petitioner believes it is necessary to clarify to the Board that Petitioner ***does not*** agree that the ’754 Patent is entitled to a priority date of July 3, 2003 (or June 3, 2003).⁵ As is obvious from the Petition, any reference Petitioner makes to the “earliest alleged priority date in 2003” is a reference to the October 30, 2003 date: the filing date of October Provisional, to which the ’754 Patent purports to claim priority. The Petition does not, at any point, reference the July 3, 2003 date or the July Provisional.

Second, Patent Owners have not shown that the ’754 Patent is entitled to a July 3, 2003 priority date. Patent claims “are not entitled to an earlier priority date merely because the patentee claims priority.” *Nat. Alts. Int’l, Inc. v. Iancu*, 904 F.3d 1375, 1380 (Fed. Cir. 2018) (quoting *In re NTP, Inc.*, 654 F.3d 1268, 1276 (Fed. Cir. 2011)). Rather, “for a patent’s claims to be entitled to an earlier priority date, the patentee *must demonstrate* that the claims meet the requirements of 35 U.S.C. §120.”

⁵ Petitioner also does not “admit,” as Patent Owners claim (POPR at 9), that any of the references cited in its petition are not prior art. As stated in its Petition, Petitioner believes that each of the references cited as prior art are properly prior art.

Id. (emphasis added). Accordingly, claims are not entitled to priority under §120 at least until the patent owner *proves* entitlement to the Board. *Id.*; *see also PowerOasis Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1305-06 (Fed. Cir. 2008); *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327-29 (Fed. Cir. 2008).

Patent Owners' Preliminary Response does not even attempt to demonstrate or prove that the '754 Patent is entitled to a priority date of July 3, 2003 under 35 U.S.C. §120, relying only on the fact that the '754 Patent facially claims priority to a July provisional. Patent Owners also failed to address the addition of substantial new matter "through a preliminary amendment on March [8], 2011, despite the application's designation as a continuation and not a continuation-in-part." Paper 2 at 9, FN 2. Together, Patent Owners failed to meet their burden of production.

Patent Owners failed to make the requisite showing because they cannot demonstrate written description for the claims of the '754 Patent are found in the July Provisional. Paper 2 at 9. For example, the claims describe a control module contained in a pluggable, MSA-compliant form factor capable of performing the MAC and TC-Layer functionalities of an ONT/ONU (Ex. 1001 at cls. 1, 3-4, 9-14, 16, 18, 20-21, 25-28, 30) as described in the October Provisional but not described in the July Provisional (*see id.* at 14:65-15:51). As another example, the '754 Patent explicitly claims a device operating in a *passive optical network*. *See, e.g., id.* at cls. 1, 18. None of the material described in the July Provisional so much as references

a passive optical network and is instead directed to “local area networks” generally. *See, e.g., id.* at 3:10-5:5 (describing embodiments of the invention). Thus, Patent Owners have not shown that the ’754 Patent is entitled to a July 3, 2003 priority date.

B. The Prior Art References Were Not Previously Considered

First, as discussed in the Petition (Paper 2 at 82), neither Shraga, nor Shraga in combination with Togami, was before the Examiner during the examination of the ’754 Patent. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at *7-8 (PTAB Feb. 13, 2020) (precedential) (“Under §325(d), the art and arguments must have been previously presented to the Office.”). As such, Shraga or Togami were never used as the basis for any rejection. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17 (PTAB Dec. 15, 2017) (precedential) (considering “whether the prior art was the basis for rejection” in deciding whether to deny under §325(d)). This fact alone is sufficient to avoid denial under §325(d).

Second, the Examiner did not address any references that would be cumulative to Shraga, or Shraga in combination with Togami, during the original examination of the ’754 Patent. Paper 2 at 82. Admitting as much, Patent Owners cite (across 29 pages of their POPR) distinct references addressed in the prosecution history of U.S. Patent No. 7,925,162 (the “’162 Patent) (alternatively, U.S. Patent App. No. 10/886,514) as alleged evidence that “substantially similar” art was

previously presented to and cited by the Examiner of the '754 Patent. Patent Owners' arguments fail, as there are key differences between the references used in this Petition and the art cited by the Examiner.

For example, Patent Owners allege Shrags is cumulative of the Yokomoto reference. Yokomoto, however, discloses only the mere structure of a passive optical network and ONU components and contains no mention of critical teachings found in Shrags, such as the "start times" and "lengths of time" limitations. *See, e.g.*, Paper 2 at 27-30, 37-38. Yokomoto further fails to disclose functions of ranging, establishing new clients, and assigning network identification addresses—important limitations described in Shrags. *See, e.g., id.* at 42-45. The additional references discussed by Patent Owners contain similar critical deficiencies and, thus, the references presented in this Petition are not cumulative of art cited by the Examiner.

Third, the '162 Patent and the '754 Patent are directed to materially different subject matter: the '162 Patent's claims apply to a LAN and no other access networks and therefore contrast with the claims of the '754 Patent, which apply instead to broadband access networks. Paper 2 at 82-83. This distinction between the claims is material because Patent Owners were able to overcome the Examiner's rejections in the '162 Patent only by stating that the art cited by the Examiner (for example, Modiano and Wang) "devotes considerable discussion to wide area networks (WANs)" and that "[a]pplicants respectfully traverse the Examiner's unsupported

assertion that an OLT is equivalent to Applicants' network manager and . . . that an ONU is equivalent to Applicants' network client adapter." Ex. 1002-2 at 197, 310-11. Further distinguishing, Patent Owners stated that "OLTs and ONUs in the art are associated with fiber WAN or fiber access networks," not LANs. *Id.* As such, the cited references were addressed only in the context of the claims of the '162 Patent, directed to LANs, and not the '754 Patent, directed to other access networks.

Moreover, the reasons Patent Owners articulated to distinguish the '162 Patent from the cited references (*i.e.*, that the references are directed to access networks, and OLTs and ONUs, while the patent is directed to LANs), are the very points that distinguish the '754 Patent from the '162 Patent. Even if the references used then and now were similar, which they are not, it would be error by the Examiner to not have considered the cited references given the differences in the claims. Thus, based on Patent Owners' own admission that the claims of the '162 Patent and the '754 Patent are materially different, the fact that similar references were not addressed in an Office Action by the Examiner in the context of the subject matter of the '754 Patent, the Board should not deny based on §325(d).

Regardless, Patent Owners make no assertion in their POPR that the G.984.3 Draft Recommendation/Contribution 104, or references containing substantially similar disclosures, were presented to Examiner during prosecution. Thus, Patent Owners' arguments regarding §325(d) are inapplicable to Ground 2. In view of the

strength of the Petition, the fact that none of the references cited in the Petition were before the Examiner, and, at worst, in view of Ground 2 not being challenged under §325(d) at all, interests of efficient administration of the Office and integrity of the patent system support institution on all grounds.

C. The Board should not deny institution under *Fintiv*.

Nokia maintains that the *Fintiv* factors do not weigh in favor of denial. Nokia diligently prepared and filed its petition on June 30, 2023. As the Board is aware, Patent Owners challenged service of the petition because (to no fault of Nokia) UPS failed to deliver the Petition and accompanying documents to the address of record until July 20, 2023, even though Patent Owners' counsel was served with the Petition and accompanying documents on June 30, 2023 and chose to download those materials no later than July 5, 2023. Following a call with the Board to resolve Patent Owners' service dispute and upon agreement, the filing date accorded was pushed back another month to July 20, 2023, with an expected institution decision date of February 26, 2024. Paper 8 at 4. These factors were out of Petitioner's control and should not impact an institution decision on a timely filed Petition.

Additionally, new facts have emerged since the filing of this Petition that weigh against a *Fintiv* denial. On June 1, 2023, Patent Owners filed suit against AT&T alleging patent infringement of the '754 Patent, asserting all of the Challenged Claims. *See* the AT&T Litigation, Dkt. No. 1. Nokia has since moved

unopposed to intervene in the AT&T Litigation, as Nokia supplies a substantial number, if not all, of accused products to AT&T. Ex. 1036 at 1-2. Nokia expects its unopposed motion to be granted. Importantly, the AT&T Litigation is not expected to go to trial until February 2025 at the earliest (Ex. 1037 at 1) and the typical 21-month timeline for trials in the Eastern District of Texas estimates an actual trial date of March 2025, mitigating Patent Owners' concerns that the institution of this Petition would be "a waste of everyone's resources and will not benefit anyone." POPR at 75. On the contrary, a Final Written Decision on the Petition will have a significant impact on the AT&T Litigation, including potentially absolving infringement allegations against the Nokia-supplied products at issue, prior to the trial date. Moreover, the AT&T Litigation is still in its early stages: invalidity contentions were only recently served on November 9, 2023 and the *Markman* hearing is not scheduled until August 22, 2024. Thus, these facts weigh heavily against discretionary denial under *Fintiv*.

III. CONCLUSION

Petitioner respectfully requests that the Board grant institution.

Date: January 10, 2024

By: /M. Scott Stevens/
M. Scott Stevens
Reg. No. 54,762

CERTIFICATE OF SERVICE

The undersigned certifies that Petitioner served a copy of the foregoing PETITIONER’S REPLY TO PATENT OWNERS’ PRELIMINARY RESPONSE and supporting Exhibits 1035–1038 by filing this document through the P-TACTS Filing System as well as sending a copy via electronic service (as agreed by counsel for Patent Owners) on the following:

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Date: January 10, 2024

By: /M. Scott Stevens/ (Reg. No. 54,762)