

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

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

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TABLE OF AUTHORITIES

CASES

Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH,
IPR2019-01469, Paper 6 (PTAB Feb. 6, 2020) 3, 6

In-Depth Geophysical Inc. v. ConocoPhillips Co.,
IPR2019-00849, Paper 14 (PTAB Sept. 6, 2019) 2

STATUTES

35 U.S.C. § 314(a) 2

35 U.S.C. § 325(d) 3, 7, 10

37 CFR § 42.105 9

Patent Owner's Exhibit List

Exhibit	Description
2001	Email from PTAB, dated July 20, 2023
2002	Chain of Emails Between Counsel for Nokia and Special Appearance Counsel for Patent Owners, Redacting the Username and Password
2003	Excerpt of JOSEPH W. GLANNON, <i>Civil Procedure, in</i> EXAMPLES & EXPLANATIONS (Aspen Publishers, 6th ed. 2008).
2004	Transcript of August 23, 2023 Teleconference Hearing
2005	U.S. Pat. Pub. No. 2002/0067529 to Yokomoto et al. ("Yokomoto")
2006	U.S. Pat. Pub. No. 2002/0006111 to Akita et al. ("Akita")
2007	U.S. Pat. Pub. No. 2003/0091045 to Choi et al. ("Choi")
2008	U.S. Pat. No. 5,572,349 to Hale et al. ("Hale")
2009	U.S. Pat. Pub. No. 2004/0052274 to Wang et al. ("Wang")
2010	U.S. Pat. No. 7,031,343 to Kuo et al. ("Kuo")
2011	U.S. Pat. No. 6,023,467 to Abdelhamid et al. ("Abdelhamid")
2012	U.S. Pat. No. 6,498,667 to Masucci et al ("Masucci")
2013	U.S. Pat. No. 6,778,339 to Medina et al. ("Medina")
2014	Excerpt of Plaintiff NextGen Innovations, LLC's Responses to Defendants' First Set of Common Interrogatories
2015	U.S. Pat. No. 7,925,162 to Soto et al.

The Board's email authorized this sur-reply. Ex. 3002.

**I. PETITIONER CANNOT CHANGE ITS WAIVER AND OVERLOOK
THE EARLIEST ALLEGED PRIORITY DATE**

Petitioner waived its priority argument by writing, “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. Ex. 1001.**” Petition at 9 (emphasis added). The *earliest* alleged priority date on the cover of **Ex. 1001** is July 3, 2003.¹ The *earliest* alleged priority date **in 2003** is July 3, not October 30. *Id.* Petitioner's waiver references Ex. 1001 (the '754 patent), not its invalidity contentions (Ex. 1035) that were not even submitted with the Petition. The petition assumes the “earliest alleged priority date in 2003,” and Petitioner cannot change this language to “October 30, 2003” on reply. Petition at 9. Any fair reading of the waiver results in a July 3, 2003 priority date.

Petitioner now argues that its waiver is limited to the earliest alleged priority date in the district court litigation, but even this argument fails. The November 3, 2002 infringement contentions (Ex. 1035) identify the *second*-earliest alleged priority date asserted in litigation. Plaintiff's Response to Common Interrogatory #1 from the same case, which Petitioner omits from its Reply to Patent Owner's POPR (“Reply”), alleges the *earliest* priority date of July 3, 2003:

¹ July 3, 2003 is the earliest alleged priority date; “June” is a typo. Reply at 3 n.4.

With respect to the '754 patent, the claimed invention was conceived by the Sotos on or about July 3, 2003, when Provisional Application No. 60/485,514 was filed with the PTO. To the

Ex. 2014 at 6, 8; *see also id.* at 9 (responding with the same answer). Regardless of whether the Board looks to Ex. 1001 or Ex. 2014 (even in view of Ex. 1035), the earliest alleged priority date is July 3, 2003. Exhibit 1038 relates to a different case and is, at best, further evidence of the *second*-earliest alleged priority date.

Thus, Patent Owners have not engaged in any bait-and-switch tactics as alleged in the Reply. Petitioner bears responsibility for overlooking both the earliest alleged 2003 priority date on the cover of the '754 Patent and the earliest alleged priority date asserted in Exhibit 2014 from litigation.

Petitioner's cases about the Patent Owners' burden of proving priority do not apply here because the Petition assumes the "earliest alleged priority date in 2003" of July 3, 2003 and waived any argument for a later priority date. Petition at 9. Petitioner's cases about the burden of proving priority are irrelevant here because none of Petitioner's cases address this fact pattern. Paper 15 at 4–5 (citing cases). Petitioner bears the burden of demonstrating a likelihood of success under 35 U.S.C. § 314(a), which it cannot do for Ground II without proving up prior art. *In-Depth Geophysical Inc. v. ConocoPhillips Co.*, IPR2019-00849, Paper 14 at 13 ("Petitioners bear the burden to show a reasonable likelihood that the reference is [prior art]") (Sept. 6, 2019) (informative). Extending Petitioner's cases as further

requiring Patent Owners to prove up priority even when the issue is waved would make waivers meaningless and erroneously shift the burden of proof.

Patent Owners are unfairly prejudiced by Petitioner's attempt to change its Petition because Patent Owners' Preliminary Response is based on the argument actually made by the Petition (adopting the earliest alleged priority date of July 3, 2003). Patent Owners did not have the opportunity to address Petitioner's new argument regarding an October 30, 2003 priority date and its impact on other arguments in the Preliminary Response, including with respect to Ground II. And Patent Owners cannot do so in this sur-reply that is limited to 10 pages and for which no expert reports may be submitted. Ex. 3002. Reinterpreting Petitioner's waiver now would put Patent Owners in a procedurally unfair position.

II. PETITIONER CANNOT DISTINGUISH THE ART UNDER 325(D)

A. Petitioner Fails to Apply *Advanced Bionics*

Petitioner invites legal error by arguing that just because Shraga and Togami were not used in a rejection, "[t]his fact alone is sufficient to avoid denial under 325(d)." Paper 15 at 6. This fails to comply with **both** prongs of the *Advanced Bionics* analysis. The first prong asks not only if Petitioner brings the *same* art, but also **substantially similar** art **or arguments** were previously presented to the Office. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 6, 2020) (precedential). The second prong further

considers, *even if* the same or similar art or arguments were presented, whether the PTO erred. *Id.* As the POPR demonstrates, Examiner Li considered a mountain of cumulative art and similar arguments, and Examiner Li made no errors in examination. POPR at 35–70.

B. Petitioner Fails to Meaningfully Distinguish the Cited References

Petitioner cannot meaningfully distinguish the cited references (Akita, Yokomoto, Choi, Hale, Medina, Wang, Kuo, Abdelhamid, or Masucci) from Shraga. Petitioner only attempts to distinguish one reference, Yokomoto, but these differences either do not exist or have no effect. Paper 15 at 7. Shraga’s similarities to Akita, Choi, Hale, Medina, Wang, Kuo, Abdelhamid, and Masucci remain uncontested. For this reason alone, the Petition should not be instituted.

Additionally, Petitioner’s arguments regarding Yokomoto are insufficient. Petitioner argues that, unlike Shraga, Yokomoto makes no mention of “start times” and “lengths of time.” Paper 15 at 7. But Petitioner fails to explain how Yokomoto and Shraga are different. Petitioner relies on Shraga for teaching “that downstream signals are sent in the form of frames comprised of timeslots. . . . Shraga allocates timeslots within which each ONT is permitted to transmit upstream signals.” Petition at 12. Yokomoto similarly teaches “supervisory control information regarding which time slots are used for transmitting the STM signals, in sending out the PON upstream transmission frame.” Ex. 2005 at [0109]; *see also id.* at [0107], [0110],

[0113]–[0120] (further describing “time slots”). Yokomoto shows that its downstream frames similarly include “time slots of fixed lengths” for the later PON upstream transmission frames. *Id.* at Fig. 7, [0067]. It remains unclear how Shraga’s timeslots are different from Yokomoto timeslots. *See also* POPR at 49 (discussing Akita’s similar teachings of timings), 50–52 (discussing Choi’s similar teachings about timings), 53–54 (discussing Hale’s similar teachings about timings), 55–56 (discussing Wang’s similar teachings about timings), 57–58 (discussing Abdelhamid’s similar teachings about timings), 59–60 (discussing Masucci’s similar teachings about timings).

Next, Petitioner argues that Yokomoto further fails to teach “ranging, establishing new clients, and assigning network identification addresses,” but the Reply fails to tie these actions to the challenged independent claims. Thus, these differences (if they exist) are irrelevant.

In conclusion, the Yokomoto example selected by Petitioner has no meaningful distinction over Shraga, and Shraga’s cumulative disclosure with Akita, Choi, Hale, Medina, Wang, Kuo, Abdelhamid, and Masucci remain uncontested.

C. Minor Differences Between the ’754 Patent and ’162 Patent Have No Effect Because Examiner Li Considered the Prior Art

Petitioner appears to mistakenly believe that the Examiner erred by not considering the cited references during examination of the ’754 Patent due to

differences between the '754 Patent and the '162 Patent. This argument lacks factual support because it is contradicted by the file history of the '754 Patent.

The reply makes two incorrect assumptions: “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 access networks,” and “it would be error by the Examiner to not have considered the cited references.” Paper 15 at 8. The cited references (Akita, Yokomoto, Choi, Hale, Medina, Wang, Kuo, Abdelhamid, Masucci) are all explicitly listed on the cover of the '754 Patent as cited references. Ex. 1001, cover; POPR at 45. Examiner Li explicitly signed off on these references a second time when examining the claims of the '754 Patent (Ex. 1002-1 at 23-25; Ex. 1001 at Cover) after previously considering them when examining the application that issued as the '162 Patent. Ex. 2015 at Cover. Any allegation that Examiner Li failed to consider these references when examining the application for the '754 Patent is untrue.

D. Petitioner Makes No Effort to Address the Second “Error” Prong

Petitioner does not muster any rebuttal to part two of the *Advanced Bionics* analysis—whether the USPTO erred (except for baselessly alleging that Examiner Li did not consider the cited references listed on the cover of the '754 Patent). Even after considering Petitioner’s Reply, nothing suggests that Examiner Li erred when allowing the claims because the prior art lacked the claimed control module in a

pluggable optical transceiver module. POPR at 66–67; Paper 15 at 6–9. At minimum, part two of the *Advanced Bionics* analysis warrants denial.

E. The Ground II Arguments Are Redundant

The POPR did not limit its § 325(d) analysis to just Ground I. The same § 325(d) arguments for Ground I apply to Ground II because, as noted in the POPR, “Ground II arguments ... generally cite back to Ground I for the corresponding argument,” except for details of timing and protocol. POPR at 28. Thus, the same § 325(d) arguments apply. The G.984.3 Draft Recommendation and Contribution 104 are, at best, cumulative of the numerous other secondary references that Examiner Li considered for timing and protocol, such as Akita (*see* POPR at 49), Choi (*see* POPR at 49–52), Hale (*see* POPR at 52–54), Wang (*see* POPR at 55–56), Abdelhamid (*see* POPR at 57–58), and Masucci (*see* POPR at 59–60).

More importantly, neither G.984.3 Draft Recommendation nor Contribution 104 address the critical lack of a control module in a pluggable optical transceiver—thus there is no USPTO error possibly addressed by the G.984.3 Draft Recommendation or Contribution 104. And, even if they did, neither G.984.3 Draft Recommendation nor Contribution 104 qualify as prior art, so the Board need not address these references at all.

III. THE FINTIV FACTORS STILL FAVOR DENIAL

A. The AT&T Litigation Does Not Affect the *Fintiv* Analysis

Nokia’s argument about the AT&T Litigation makes no sense. If AT&T wanted to know the outcome of Nokia’s invalidity argument against the ’754 Patent, then AT&T would prefer to look to the District Court trial set for May 6, 2024, where Nokia expects to make the same arguments using nearly identical² prior art. Ex. 1032 at 1. A final written decision from this IPR on January 20, 2025 based on nearly identical art—well after the Nokia trial outcome—would no longer interest AT&T.³ Instituting review would still result in a Final Written Decision that arrives well after trial and well after patent expiration.

² Nokia’s invalidity theory for trial relies on Pat. 6,697,374 to Shruga and Pat. **7,066,746** to Togami, which is a continuation-in-part of Pat. **6,439,918** to Togami asserted in this IPR. Shruga plus Nokia’s trial-version of Togami (Pat. 7,066,746) is practically the same as addressed in the Petition but not “the specific combination of prior art references set forth in the grounds presented in this Petition,” and therefore escapes Petitioner’s crafty stipulation. Petition at 85.

³ A motion to consolidate *NextGen Innovations, LLC v. Nokia of Am. Corp.*, 2:22-cv-00309 (E.D. Tex. Aug. 9, 2022) with *NextGen Innovations, LLC v. Nokia of Am. Corp.*, 2:23-cv-00637 (E.D. Tex. Dec. 29, 2023) is pending.

B. The *Fintiv* Factors Favor Denial Regardless of Nokia's Fault

Nokia, not Patent Owners, controlled and bears the sole responsibility for untimely service. 37 CFR § 42.105 assigns the burden of service to Petitioner. When Nokia's package was returned to sender on July 7, 2003, Nokia failed to act because its counsel was on vacation. Ex. 2004 at 4:15-19, 11:10-13. Nokia then refused to re-serve the petition and frivolously refused to reset the service date to July 20, 2023 during the parties' meet-and-confers until the Board held a hearing, where Nokia then changed its position agreed to the same relief that Nokia previously opposed. *Id.* at 14:18-15:14. Nokia bears sole responsibility for every service-related delay.

Regardless of Nokia's fault, the fact remains: the Final Written Decision is not expected until after trial and after patent expiration. Instituting review would still merely result in a Final Written Decision that arrives well after trial and well after patent expiration. *Fintiv* favors discretionary denial.

IV. AT&T IS A REAL PARTY-IN-INTEREST

When filing its Petition, Nokia failed to disclose AT&T as a real party-in-interest. Petition at 88. In view of Petitioner's new revelations that "Nokia supplies a substantial number, if not all, of accused products to AT&T," and that Nokia has intervened to defend AT&T in the AT&T Litigation against allegations of infringement of the '754 Patent, the Board should deem AT&T a real party-in-interest. Paper 15 at 9-10. The overlapping financial interest and legal responsibility

for infringement of the '754 Patent is clear: the AT&T Litigation involves the same product made by Nokia and sold to AT&T, with Nokia directly intervening on behalf of AT&T in the litigation. This is for public disclosure. This IPR remains unaffected by the 1-year IPR bar.

V. CONCLUSION

Every aspect of this case warrants denial. Ground I lacks merit for a missing claim element. Ground II lacks merit because the references fail to qualify as prior art under Petitioner's own Petition argument. A section 325(d) denial is warranted because Petitioner fails to differentiate the cited references and makes no effort to identify any USPTO error (aside from baselessly alleging that the Examiner did not consider the cited references). Finally, a *Fintiv* denial is warranted because the Final Written Decision is not expected until after trial and after patent expiration.

Respectfully submitted,

Dated: January 22, 2024

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owners' Sur-Reply to Petitioner's Reply to Patent Owners' Preliminary Response is 10 pages or less, excluding table of contents, table of authorities, certificate of service, signature block, this certificate, or table, which is in compliance with the Board's email approval on December 27, 2023.

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on January 22, 2024, by filing this document through the P-TACTS system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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