

December 3, 2020

Scott C. Weidenfeller  
Vice Chief Administrative Patent Judge  
Mail Stop Patent Trial and Appeal Board  
P.O. Box 1450  
Alexandria, VA  
22313-1450

Re: Docket No. PTO-C-2020-0055

Legal Address:  
Nokia Technologies Oy  
Karaportti 3  
02610 Espoo  
Finland  
VAT ID: FI26550449  
  
Business Entity Code  
2655044-9

## I. INTRODUCTION

Nokia supports the ongoing efforts by the United States Patent and Trademark Office (“PTO”) and the Patent Trial and Appeal Board (“PTAB”) to review and improve post-grant proceedings (i.e., *inter partes* review (IPR) and post grant review (PGR)) so as to meet the ultimate goal of providing a quick and cost effective alternative to litigation. As both a petitioner and a patent owner in post-grant proceedings, Nokia supports the PTO’s ongoing efforts to reduce the number of times multiple petitions are instituted against the same patent and increase the number of times that the PTAB does not institute a post-grant proceeding in view of a co-pending action before another tribunal.

## II. CORPORATE OVERVIEW

Nokia<sup>1</sup> is a leading innovator in the telecommunications industry. Nokia has invested nearly \$155 billion in research and development in the past two decades, contributing much of its technology to open standard. As a result, Nokia holds one of the world’s strongest patent portfolios of connectivity technologies with more than 11,000 issued patents in the

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<sup>1</sup> References to Nokia in this section include Nokia Technologies Oy and its parent and affiliates.

United States, and nearly 43,000 worldwide. Nokia offers a comprehensive portfolio of network equipment, software, services and licensing opportunities across the globe. With its commitment to innovation, driven by the award-winning Nokia Bell Labs, Nokia is a leader in the development and deployment of 5G networks. Nokia's communications service provider customers support more than 6.4 billion subscriptions with its radio networks, and its enterprise customers have deployed over 1,300 industrial networks worldwide. Adhering to the highest ethical standards, Nokia transforms how people live, work and communicate.

### III. DISCUSSION

#### A. Serial Petitions

The PTO has requested comments related to (1) whether the PTO should “promulgate a rule with a case-specific analysis, such as generally outlined in *General Plastic, Valve I, Valve II* and their progeny, for deciding whether to institute a petition on claims that have previously been challenged in another petition” and, alternatively, (2) whether “in deciding whether to institute a petition, [] the Office [should] (a) altogether disregard whether the claims have previously been challenged in another petition, or (b) altogether decline to institute if the claims have previously been challenged in another petition.”

Nokia supports the PTO's ongoing efforts to limit petitioners to a single petition per challenged patent. In Nokia's view, *General Plastic* represented a significant improvement in PTAB operation by limiting the circumstances under which a petitioner is permitted to bring a subsequent petition against the same patent. *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, 2017 WL 3917706, at \*7 (PTAB Sept. 6, 2017) (precedential). *Valve I* represented a further improvement when it extended the *General Plastic* factors to a co-defendant. *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, -00063, -00084, 2019 WL 1490575 (PTAB Apr. 2, 2019) (precedential) (*Valve I*). As a result, Nokia supports rulemaking that codifies the case-specific test in *General Plastic* and its progeny.

Nokia, however, believes that there is a particular situation in which the PTAB should deny a petition over and above the factors set forth in *General Plastic*. Specifically, Nokia supports a rule that bars a petitioner, real party in interest, or privy of the petitioner who has filed a previous IPR petition from filing a subsequent petition against that same patent, unless the petitioner is charged with infringement of additional

claims of the patent (in which case a second petition would be limited to the added claims) and provided that the subsequent petition complies with 35 U.S.C §315 and other applicable statutory requirements.

Such a bright line rule provides the petitioner with clear guidance as to when it can bring a serial petition and, at the same time, protects a petitioner from gamesmanship when additional claims are added to the case after the filing of a post-grant proceeding. The rule also benefits the patent owner as it increases certainty as to the scope of the validity case at the PTO and eliminates costly briefing related to serial petitions.

### **B. Parallel Petitions**

The PTO has requested comments related to (3) whether the PTO should “promulgate a rule with a case-specific analysis, such as generally outlined in the Consolidated Trial Practice Guide, for deciding whether to institute more than one petition filed at or about the same time on the same patent” and, alternatively, (4) whether “in deciding whether to institute a petition, [] the Office [should] (a) altogether disregard the number of petitions filed, or (b) altogether decline to institute on more than one petition.”

Nokia believes that parallel petitions likewise can result in costly briefing and gamesmanship and, thus, Nokia again supports rulemaking that limits a petitioner, real party in interest, or privy of the petitioner, to one petition per patent instead of the case-specific analysis outlined in the Consolidated Trial Practice Guide. Understanding that certain patents could not be addressed in a single petition (e.g., based on the number of claims), Nokia would support a rule that allowed for a reasonable increase in the word limit, which would be set by the PTAB on a case-by-case basis, in exchange for higher USPTO fees so as to prevent any prejudice to petitioners and to address any loss of revenue / increased costs to the PTO.

### **C. Proceedings in Other Tribunals**

The PTO has requested comments related to (5) whether the PTO should “promulgate a rule with a case-specific analysis, such as generally outlined in *Fintiv* and its progeny, for deciding whether to institute a petition on a patent that is or has been subject to other proceedings in a U.S. district court or the ITC” and, alternatively, (6) whether “in deciding whether to institute a petition on a patent that is or has been subject to other proceedings in district court or the ITC, should the Office (a) alto-

gether disregard such other proceedings, or (b) altogether decline to institute if the patent that is or has been subject to such other proceedings, unless the district court or the ITC has indicated that it will stay the action.”

Nokia applauds the *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495 (PTAB Mar. 20, 2020) (precedential) and *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, 2018 WL 4373643 (PTAB Sept. 12, 2018) (precedential) decisions as they represent a commitment to post grant proceedings as an alternative to litigation. Nokia, however, believes that the PTO should take further steps to ensure that a party that avails itself of the PTO, does not get two bites at the invalidity apple.

First, and with respect to ITC proceedings, Nokia supports the recent PTO decisions denying institution when an ITC initial determination is to be issued before a final written decision. *See e.g., Comcast Cable Commc 'ns, LLC v. Rovi Guides, Inc.*, IPR2020-00800, -00801, -00802, Paper 10 (PTAB Oct. 22, 2020); *Garmin International, Inc. et al v. Koninklijke Philips NV*, Paper 11 (PTAB Oct. 27, 2020). Nokia favors rule-making whereby the PTAB shall exercise its discretion to deny institution of an IPR in instances where the ITC initial determination is scheduled to be issued before any PTAB final written decisions and when the respondent is pursuing invalidity under Sections 102 and 103 at the ITC, unless the invalidity argument at the ITC is only based on allegations that the claimed invention was in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention. Nokia believes that such a rule is necessary given the speed at which ITC proceedings occur and the fact that the ITC does not generally stay proceedings in view of a co-pending PTAB action.

Adoption of such a rule would also eliminate confusing and contradictory results, such as seemed to occur in the *Cisco/Arista* matter, where the ITC entered an exclusion order after finding an asserted patent infringed and not invalid, and PTAB later invalidated the claims of the same patent. *Certain Network Devices, Related Software & Components Thereof*, Inv. No. 337-TA-945; *Arista Networks, Inc. v. Cisco Systems, Inc.*, IPR2016-00303 (May 25, 2017). If the respondent believes that the ITC reached an incorrect decision on validity, the proper next step should be at the Court of Appeals for the Federal Circuit, not in a parallel co-pending proceeding before the PTAB.

Second, and with respect to district court proceedings, Nokia favors codifying a version of the multi-factor *Fintiv* test. The PTO was correct to focus on “overlap between the issues raised in the petition and in the parallel proceeding.” However, Nokia believes that the Board should reconsider how it analyzes the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 13 (PTAB May 13, 2020) (informative) (“We generally take courts’ trial schedules at face value absent some strong evidence to the contrary.”). Because trial schedules are much less certain in many district courts, Nokia believes that the PTO should consider the current schedule along with local rules, propensity to stay, average time to trial, and other case-specific facts when evaluating this *Fintiv* factor.

Nokia believes that its proposals strike the appropriate balance because a defendant/respondent in a district court or ITC proceeding that opts to file an IPR has tools at its disposal to guarantee, if desired, that the PTAB is the forum that will decide validity under Sections 102 and/or 103. These tools include moving for a stay or withdrawing validity challenges under Sections 102 and 103 from the other parallel proceedings. Nokia believes that its proposals seek to promote balance in the various estoppel provisions in the statute that already, for example, prevent a petitioner / defendant from pursuing validity challenges it raised or reasonably could have raised before the PTAB in an ITC or district court action once the challenged claims have been deemed not unpatentable by the PTAB.

#### **D. Other Considerations**

The PTO has requested comments related to (7) whether “there [are] any other modifications the Office should make in its approach to serial and parallel AIA petitions, proceedings in other tribunals, or other use of discretion in deciding whether to institute an AIA trial.”

Nokia appreciates the efforts by the PTO with respect to 35 U.S.C. §325(d). Specifically, Nokia supports case-specific analysis of whether the same or substantially the same art or arguments were previously presented to the PTO. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph).

While Nokia would support rulemaking in line with the tests outlined in *Advanced Bionics* and *Becton, Dickinson*, Nokia believes there should be an absolute bar against institution when the same or substantially the same art or arguments had previously been addressed in a decision by the PTAB in connection with a post-grant proceeding. Nokia believes that once a patent owner has successfully contested the applicability of the same or substantially the same art or arguments to its claims in connection with a post-grant proceeding, that the patent owner should not have to revisit the same art or arguments in a subsequent post-grant proceeding.

#### IV. CONCLUSION

Nokia thanks the Director and the PTAB for seeking comments on discretionary denials. Nokia appreciates the opportunity to comment and looks forward to participating in further reform in the near future.