

# APEX STANDARDS

EP3167669B1 - Oppo v Nokia: Standard Documents as Prior Art & Implications for Inventive Step Assessment

R&D Intelligence R800466  
Oppo v Nokia  
EPO Opposition EP15818478.8  
Unclassified  
15 May 2023

The ongoing dispute between Oppo and Nokia over 5G Standard Essential Patents (SEPs) provides an insightful example of such litigation. This report outlines the dispute's key events, the legal precedents it might set, and its implications for the wider smartphone market and patent litigation practices.

## THE DISPUTE

The dispute commenced in 2021 when Oppo challenged the validity and standard essentiality of several of Nokia's 5G SEPs. Oppo objected to Nokia's SEP rate and resisted German injunctions following a court victory by Nokia. Despite Nokia's attempts to gain leverage in other jurisdictions, the dispute continues.

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| 15 818 478.8  |    |
| CONSOLIDATED LIST - KONSOLIDIERTE LISTE - LISTE RÉCAPITULATIVE                    |    |
| P: Nokia Solutions and Networks Oy  |    |
| D1: Guangdong OPPO Mobile Telecommunications Corp., Ltd.                          |    |
| EPO CITATIONS-ENTGEGENWÄRTIGUNGSZITIERUNGEN                                       |    |
| P   | I  |
| D1  | E1 |
| D2  | E2 |
| D3  | E3 |
| D4  | E4 |
| D5  | E5 |
| D6  | E6 |
| D7  | E7 |

**Oct 12, 2021. Oppo transmitted to EPO the "Consolidated list of opposition documents," encompassing patent literatures considered in mutual reference, and 3GPP TS 23.401 standard, proposed as cumulatively construed prior art.**

The conflict has expanded, with both parties attacking each other's patents, even those not initially in the dispute. Oppo started these challenges earlier, giving them a slight edge in terms of actual invalidation decisions. However, several preliminary opinions favor Nokia's counterattacks on Oppo's patents. Notably, while Oppo uses its patents primarily for defensive purposes, Nokia utilizes patent licensing as a strategic business area. Consequently, any patents Oppo manages to invalidate could affect a significant source of Nokia's revenue.

In October 2022, Susanna Martikainen, Nokia's Chief Licensing Officer, claimed that Oppo infringed on Nokia's patents due to its unwillingness to license, a statement supported by German courts. This led to rulings from the Hague's District Court and China's Supreme People's Court, causing Oppo to halt its sales in Germany.

## LEGAL IMPLICATIONS

In the unfolding patent dispute, Oppo upheld its challenge against Nokia's patents, even as it withdrew from key European markets, including Finland, Germany, Sweden, the UK, and the Netherlands. This step, influenced by high sales costs and ongoing litigation with Nokia, leaves Oppo's German market presence reliant on successful Nokia negotiations, substantial patent fees, or a court ruling in its favor.

The situation took a pivotal turn in March 2022 when the European Patent Office (EPO) ruled in Oppo's favor in a patent dispute involving Nokia's 5G SEP: EP3167669B1, setting precedents in the process. The technology at the heart of the dispute enables a User Equipment (UE) to bypass the establishment of a packet data network connection when connecting to the network and then request a new session setup for additional services. Oppo contended that the primary prior art documents, in conjunction with the teachings of referenced documents, are argued to undermine the inventive step of

| Oppo v. Nokia   |   |   |  |  |
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| EPO Opposition (Invalidation)   |   |   |  |  |
| In the aftermath of the oral proceedings conducted on March 5 <sup>th</sup> , 2023, the EPO, pursuant to its authority, decided to revoke the patent grant previously accorded. Furthermore, the amendments proposed by Nokia to the claims were rejected. This decision was made in line with the provisions of Article 181(3)(b) of the European Patent Convention (EPC). |   |   |  |  |
| Opposed Patent  | Prior Art   | Prior Art   | Prior Art  |  |
| EP3167669B1 (Appl. EP15818478.8) Nokia Priority: 2015-07-08 Published: 2021-03-10 Independent Claims of   | W02012108199A2 Priority: 2012-01-20 Published: 2012-07-26 Research in Motion  | W02014053990A1 Priority: 2013-10-01 Published: 2014-04-10 Renesas Mobile  | EP2713664A1 Priority: 2012-09-28 Published: 2014-04-02 Alcatel Lucent  | Charting   |
| 1 receiving, by a network node, a request type from a user equipment  | receiving, by a first network element, a request for contexts message from a second network element   | transmit a message comprising first data indicating a request for attachment to the network   | transmitting an evolved packet data system attach request message to said network node   | All patents discuss receiving a request from a user equipment. The request may contain different information.  |
| the request type indicates at least one type of service required by the user equipment  | whether at least one of the one or more contexts provides connectivity between the UE and the IP gateway for user plane traffic   | the first data includes an indication that the user equipment supports establishing a packet data connection  | evolved packet data system attach request message encoding an indication that said user equipment requires to remain attached to said network node even without a packet data network connection   | All patents discuss that the request contains an indication of the type of connection/service required by the user equipment.  |
| using the received request type to make determinations regarding a provision of services to the user equipment  | determining, by the first network element, that at least one of the one or more contexts provides connectivity between the UE and the IP gateway for user plane traffic | responsive to receipt of a message comprising second data indicating an acceptance of the request for attachment to the network, selectively configure the user equipment to one of a registered state without a packet data connection and a registered state with a packet data connection in dependence on the second data | determining that said user equipment requires to remain attached to said network node even without a packet data network connection between said user equipment and said network   | All patents discuss making a determination based on the received request. The specific determination and its impact on the user equipment or network varies across patents.  |
| establishing a user equipment context according to the determinations made using the received request type  | deactivating, by the first network element, the at least one of the one or more contexts, subject to one or more conditions   | register the user equipment on the wireless network; either establish or not establish a packet data connection for the user equipment in dependence on the first data  | when it is determined that at least one packet data network connection is required between said user equipment and said network node, initiating an evolved packet data system attach procedure to establish said at least one packet data network connection  | All patents discuss taking action based on the determination made, such as establishing or deactivating a connection, or registering the user equipment on the network. The specific action depends on the request and the determination made.   |
| 6 receiving means for receiving a request type from a user equipment, wherein the request type indicates at least one type of service required by the user equipment from the network   | receiving, by a first network element, a request for contexts message from a second network element   | transmit a message comprising first data indicating a request for attachment to the network   | transmitting an evolved packet data system attach request message to said network node   | All patents discuss a receiving mechanism or process to get a request or data from user equipment (UE). Nuance: '669 focuses on the type of service requested. '199 discusses a request for contexts, while '664 talks about an attach request.  |
| using means for using the received request type to make determinations regarding a provision of services to the user equipment  | determining, by the first network element, that at least one of the one or more contexts provides connectivity between the UE and the IP gateway for user plane traffic | the processor arranged to, when in an unregistered state: transmit a message comprising first data indicating a request for attachment to the network, wherein the first data includes an indication that the user equipment supports registration without establishing a packet data connection                              | determining that said user equipment requires to remain attached to said network node even without a packet data network connection between said user equipment and said network   | All patents discuss a determination or decision-making process based on the received request. Nuance: '668 involves decisions about service provisions, '199 about connectivity contexts, '990 about registration without packet data connection, and '664 about the need for the UE to remain attached without a packet network connection.             |
| establishing means for establishing a user equipment context according to the determinations made using the received request type   | deactivating, by the first network element, the at least one of the one or more contexts, subject to one or more conditions   | selectively configure the user equipment to one of a registered state without a packet data connection and a registered state with a packet data network connection in dependence on the second data  | on receipt of an evolved packet data system attach request message from said network node encoding an indication that said user equipment may remain attached to said network node even without a packet data network connection, terminating an evolved packet data system attach procedure without establishing a packet data network connection | All patents discuss a process or action taken based on the determination made from the received request. Nuance: '669 establishes a context, '199 deactivates contexts, '990 configures the UE to a registered state with/without packet data connection, and '664 terminates an attach procedure without establishing a packet data network connection. |

**Mar 5, 2023. The result of EPO Opposition Proceedings.** '669 presents a system for managing diverse user equipment (UE) requests in a network, specifically focusing on the allocation of radio resources and scheduling methods based on the type of service. It implies a process of receiving a request, determining its context, and setting a UE context. However, '199, '990 and '664 all delve into related concepts and mechanisms that could be considered prior art against '669, as they describe similar processes of receiving requests, making decisions, and taking actions. '199 details a method in a communication network where a first network element receives a request, determines its context, and deactivates the context accordingly. This illustrates the prior knowledge of processing a UE request, deciding based on the request, and taking subsequent actions, mirroring the process in '669. '990 defines an apparatus for configuring a UE for data transmission over a wireless network. It involves transmitting a request for network attachment, and then selectively configuring the UE based on received data, showing that the concept of determining and configuring a system based on a received request preexisted. '664 elaborates a method for a UE to stay attached to a network node without a packet data network connection. It entails determining the UE's need to stay attached and sending an attach request message to the network node, signifying that the process of determining based on a UE's requirements and transmitting a request was already established. Therefore, these three patents collectively suggest that '669's procedure—receiving a service request from a UE, determining based on the request, and setting a UE context—is not novel but a combination of processes previously described in prior art. They serve as arguments against the patentability of the system outlined in '669.

the claims. These referenced documents align the proposed methods with the 3GPP LTE legacy procedure, intending to improve the Attach request and/or Packet Data Network (PDN) Connectivity procedure to accommodate more registered devices. It is contended that a person skilled in the field would implement these methods to ensure compatibility with standardized procedures. The EPO's Opposition Court ruled that the 3GPP standard: TS 23.401, can be admitted as prior non-patent literature art, as they establish standardized procedures in

telecommunications. Consequently, any method or technology aiming to be compatible with these standards would arguably be influenced by the knowledge contained within these documents, leading to lack an inventive step due to the combination of primary prior art documents with referenced documents outlining the 3GPP LTE procedures.

This case could establish a precedent for future patent disputes, underscoring the importance of industry standards as prior art evidence and the integration of

teachings from secondary documents. It highlights the need for a genuine inventive step beyond mere standard compatibility. It can influence disputes where novelty and inventiveness are challenged by a combination of disclosures from various prior art documents, considering the knowledge available to a skilled individual at the patent application time, including standard documents such as in this verdict.

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