

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,

Petitioner

v.

FOCAL IP, LLC,

Patent Owner

Case IPR2016-01254
Patent Number: 8,457,113

**PATENT OWNER FOCAL IP, LLC'S MOTION TO EXCLUDE
EVIDENCE UNDER 37 C.F.R. § 42.64**

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner Focal IP, LLC hereby moves to exclude Exhibits 1046, 1047, 1048, 1049, and 1058.

I. PROCEDURAL HISTORY

Petitioner filed a petition for *inter partes* review on June 23, 2016 (Paper No. 2). Patent Owner filed a preliminary response on October 12, 2016 (Paper No. 8), and the Board instituted trial on December 28, 2016 (Paper No. 15). Patent Owner filed a request for rehearing on January 11, 2017 (Paper No. 17), which the Board denied on January 31, 2017 (Paper No. 18). Patent Owner filed its Patent Owner Response on April 3, 2017 (Paper No. 25) accompanied by the Declaration of Regis J. “Bud” Bates (Exhibit 2022). Petitioner filed a reply on June 26, 2017 (Paper No. 28). Patent Owner filed objections to evidence submitted, relied on, or cited by Petitioner in connection with its reply on June 30, 2017 (Paper No. 30). After receiving permission from the Board, Petitioner filed a revised reply on July 11, 2017 (Paper No. 34), including a new exhibit (Exhibit 1058). Petitioner did not submit an expert declaration in connection with its reply. As authorized by the Board, Patent Owner filed a supplemental objection related to the exhibit submitted in connection with Petitioner’s revised reply (Paper No. 36).

II. ARGUMENT

Motions to exclude are authorized by 37 C.F.R. § 42.64(c). “The motion must identify the objections in the record in order and must explain the objections.” 37 C.F.R. § 42.64(c). “A motion to exclude evidence must: (a) Identify where in the record the objection originally was made; (b) Identify where in the record the evidence sought to be excluded was relied upon by an opponent; (c) Address objections to exhibits in numerical order; and (d) Explain each objection.” 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012).

The Federal Rules of Evidence apply in *inter partes* review proceedings. 37 C.F.R. § 42.62(a). Evidence is only admissible if it is relevant. Fed. R. Evid. 402. “Evidence is relevant if: (a) it has any tendency to make a fact more or less probable than it would be without the evidence; and (b) the fact is of consequence in determining the action.” Fed. R. Evid. 401. Even if relevant, evidence may be excluded “if its probative value is substantially outweighed by a danger of one or more of the following: unfair prejudice, confusing the issues, misleading the jury, undue delay, wasting time, or needlessly presenting cumulative evidence.” Fed. R. Evid. 403. In addition, hearsay is not admissible unless otherwise provided by statute, the Federal Rules of Evidence, or another applicable rule. Fed. R. Evid. 802.

A. Exhibit 1046 Should Be Excluded.

Exhibit 1046 is a copy of U.S. Patent No. 6,442,169 to Lewis (“Lewis). Petitioner relies on Lewis as a new prior art reference to support its new and untimely arguments that it was allegedly well-understood to a POSA to interconnect an IP network to the PSTN through a tandem switch. Paper No. 34 at 8-9. Patent Owner objected to Exhibit 1046 in Paper No. 30.

Patent Owner moves to exclude Exhibit 1046 as irrelevant under Rule 402. The Board did not institute trial with respect to Lewis (*see* Paper No. 15 at 29), nor did the petition ever argue that it was well-understood to a POSA to interconnect an IP network to the PSTN through a tandem switch. Petitioner improperly attempts to use Lewis to remedy the deficiencies of the prior art Petitioner relies on in its petition. The trial is limited to the arguments, evidence, and grounds raised in the petition and instituted by the Board. *See* 37 C.F.R. § 42.104(b)(5) (requiring the petitioner to identify *in the petition* the evidence relied on to support the challenge); *id.* § 42.108(a) (“When instituting *inter partes* review, the Board may authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim.”). Because Petitioner failed to timely bring this argument or this evidence in its petition, Lewis is irrelevant under Rule 402.

Further, any probative value is substantially outweighed by the danger of one or more of the following: unfair prejudice, misleading the factfinders, and confusing the issues. Lewis and the untimely argument it allegedly supports were not properly raised in the petition. This evidence should therefore be excluded under Rule 403 to prevent unfair prejudice, misleading of the factfinders, and confusing of the issues.

B. Exhibit 1047 Should Be Excluded.

Exhibit 1047 is a copy of U.S. Patent No. 6,333,931 to LaPier (“LaPier”). Petitioner relies on LaPier as a new prior art reference to support its new and untimely arguments that it was well-understood to a POSA to interconnect an IP network to the PSTN through a tandem switch. Paper No. 34 at 9-10. Patent Owner objected to Exhibit 1046 in Paper No. 30.

Patent Owner moves to exclude Exhibit 1047 as irrelevant under Rule 402. The Board did not institute trial with respect to LaPier (*see* Paper No. 15 at 29), nor did the petition ever argue that it was well-understood to a POSA to interconnect an IP network to the PSTN through a tandem switch. Petitioner improperly attempts to use LaPier to remedy the deficiencies of the prior art Petitioner relies on in its petition. The trial is limited to the arguments, evidence, and grounds raised in the petition and/or instituted by the Board. *See* 37 C.F.R. § 42.104(b)(5) (requiring the

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