

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 REPLY IN SUPPORT OF
MOTION TO EXCLUDE EVIDENCE UNDER 37 C.F.R. § 42.64**

Patent Owner's motion to exclude should be granted. Petitioner uses Lewis and LaPier to improperly raise new issues. In addition, Petitioner has not explained why the Related IPR Exhibits are relevant and not hearsay. Lewis, LaPier, and the Related IPR Exhibits should therefore be excluded.

I. Lewis and LaPier Should be Excluded

As an initial matter, the Board should disregard Petitioner's arguments regarding Lewis and LaPier because Petitioner's opposition impermissibly argues the merits of the case. Instead of merely stating why it believes that Lewis and LaPier are relevant to the instituted grounds, Petitioner's opposition includes substantial argument regarding the merits of the case. *See* Paper No. 45 at 4-6. Motions to exclude (and their corresponding oppositions) are not the proper place for substantive arguments. *See Liberty Mutual Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00002, Paper No. 66 at 62 (P.T.A.B. Jan. 23, 2014) ("While a motion to exclude may raise issues related to admissibility of evidence, it is not an opportunity to file a sur-reply . . ."). The Board should therefore ignore Petitioner's arguments.

Moreover, Lewis and LaPier are not relevant to the issues raised in the petition and the grounds instituted by the Board. Petitioner argues that its petition explains that "a POSA would understand that Burger and Archer discloses a server/processor coupled to a PSTN tandem switch in PSTN." Paper No. 45 at 4. Petitioner further argues that Lewis and LaPier were necessary to rebut Mr. Bates's opinion that

“[p]rior to the date of the invention . . . a POSA would understand that any prior art disclosing an edge device external to the PSTN must access the PSTN through an edge switch first, not a tandem switch.” Paper No. 45 at 5 (emphasis added).

Petitioner claims that the Reply Exhibits demonstrate what a POSA would have understood in May 2000. *See id.* at 2-3. But there is no evidence that Lewis and LaPier were even known to the public at that time and could have been considered by a POSA or anyone else not employed by the assignees. Lewis claims a priority date of November 20, 1998, and LaPier claims a priority date of December 28, 1998. Assuming both of these patents (or related applications) were published 18 months after their respective priority dates, they would have been published *after* the priority date of the '113 Patent. Given the testimony that Petitioner would like to rebut with the Reply Exhibits concerns Mr. Bates testifying about the knowledge of a POSA *as of the '113 Patent's priority date*, these Exhibits are wholly deficient because a POSA would not have known about these patents at that time.¹

¹ Patent Owner understands that while the Reply Exhibits may be prior art to the '113 Patent under 35 U.S.C. § 102, that is not the proper focus. Petitioner attempts to use these Exhibits to show what the knowledge of a POSA would have been at the time the '113 Patent was filed, and for a POSA to have been informed by these Exhibits, they would need to have been publicly available at that time.

Although a complete discussion of the technical aspects of Lewis and LaPier is outside the scope of this reply, Patent Owner disputes that Lewis and LaPier show an edge device external to the PSTN that accesses the PSTN directly through a tandem switch. Petitioner's spin of Lewis and LaPier simply emphasizes the deficiencies of the art cited in the original petition. Indeed, Burger and Archer, two of Petitioner's primary references, do not even mention tandem switches. It is these deficiencies that Petitioner seeks to cure with Lewis and LaPier, not any statements by Mr. Bates.

In summary, instead of merely using the new exhibits to elaborate on its positions raised in the petition, as the Board held was proper in *Ford Motor Co. v. Paice LLC*, Petitioner is using Lewis and LaPier to impermissibly add new arguments that it did not make in its petition.² IPR2014-00579, Paper No. 45 at 30 (P.T.A.B. Sep. 28, 2015) ("In its reply, Ford merely elaborated on an initial position raised in its Petition and presented evidence in direct rebuttal to Paice's Response."). The Board should therefore exclude Lewis and LaPier.

² Petitioner's argument is also belied by its argument in reply that Burger and Archer disclose connecting to the PSTN through a tandem switch. Paper No. 28 at 6-7. If Petitioner believes this is true, it is unclear why it also relies on Lewis and LaPier unless it uses them as the basis for additional grounds of unpatentability.

II. Exhibits 1048, 1049 and 1058 Should Be Excluded

The Board should also exclude Exhibits 1048, 1049, and 1058 (which Petitioner refers to as “the Related IPR Exhibits”). Petitioner argues that these exhibits are admissible for two reasons. First, Petitioner argues that the PTAB has already decided that testimony from allegedly related proceedings is admissible. *See* Paper No. 45 at 7-8 (citing *Edmund Optics, Inc. v. Semrock, Inc.*, IPR2014-00583, Paper No. 50 at 16 (P.T.A.B. Sep. 9, 2015)). Second, Petitioner argues that Patent Owner also relied on evidence from other proceedings. Neither argument supports the admissibility of Exhibits 1048, 1049, and 1058 here.

Petitioner argues that *Edmund Optics* dictates that Exhibits 1048, 1049, and 1058 are admissible in this case. Petitioner mischaracterizes the holding in *Edmund Optics*. In *Edmund Optics*, the petitioner sought to exclude its expert’s declaration and deposition testimony from another IPR proceeding. *Edmund Optics*, Paper No. 50 at 16-18. Despite denying the motion to exclude, the Board did *not* hold that the testimony was relevant or not hearsay. *Id.* Indeed, the Board questioned the relevancy of the testimony and stated that it was affording the testimony little weight. *Id.* Thus, contrary to Petitioner’s argument, *Edmund Optics* does not support the admissibility of Exhibits 1048, 1049, and 1058.

Petitioner overplays the similarity of the co-pending IPRs. While there are some similarities, Petitioner has not disputed that the co-pending IPRs involve

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