

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,

Petitioner

v.

FOCAL IP, LLC,

Patent Owner

Case IPR2016-01257
Patent Number: 8,457,113

**PATENT OWNER FOCAL IP, LLC'S CONTINGENT MOTION TO
AMEND CLAIM 143 OF U.S. PATENT NO. 8,457,113**

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TABLE OF AUTHORITIES

Cases:

Nike, Inc. v. Adidas AG,
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Regulations:

37 C.F.R. § 42.121(a)..... 2
37 C.F.R. §42.121(a)(3)..... 2

...

UPDATED LIST OF EXHIBITS

2001	Declaration of Regis J. “Bud” Bates filed with Preliminary Response
2002	Ray Horak, Communications Systems & Networks, (2 nd ed. 2000)
2003	Ray Horak, Webster’s New World Telecom Dictionary (2008)
2004	Ray Horak, Telecommunications and Data Communications (2007)
2005	Prosecution History of U.S. Patent No. 7,764,777 (“777ProsHist”)
2006	Harry Newton, Newton’s Telecom Dictionary, (23 rd ed. 2007)
2007	Declaration of John P. Murphy in Support of Unopposed Motion for <i>Pro Hac Vice</i> Admission
2008	Declaration of Hanna F. Madbak in Support of Unopposed Motion for <i>Pro Hac Vice</i> Admission
2009	Corrected Declaration of Hanna F. Madbak in Support of Unopposed Motion for <i>Pro Hac Vice</i> Admission
2020	Excerpts of Deposition Transcript of Dr. La Porta, Feb. 23, 2017, for IPR2016-01259, -01261, -01262, and 01263 (“La Porta Dep.”)
2021	Deposition Transcript of Mr. Willis, Mar. 1, 2017, for IPR2016-01254 and -01257. (“Willis Dep.”)
2022	Declaration of Regis J. “Bud” Bates in Support of Response (“BatesDec”)
2023	Excerpts of Petition filed in IPR2016-01261 (“-01261 Pet.”)
2024	Excerpts of Petition filed in IPR2016-01254 (“-01254 Pet.”)
2025	Excerpts of Petition filed in IPR2016-01260 (“-01260 Pet.”)
2026	Excerpts of Declaration of Dr. La Porta in support of the Petition, Ex. 1002 of IPR2016-01262 (“La Porta Dec. of IPR2016-01262”)
2027	Excerpts of Declaration of Mr. Willis in support of the Petition, Ex. 1002 of IPR2016-01254 (“Willis Dec. of IPR2016-01254”)
2028	Excerpts of Declaration of Dr. Lavian in support of the Petition, Ex. 1002 of IPR2016-01258 (“Lavian Dec. of IPR2016-01258”)
2029	Excerpts of Deposition Transcript of Dr. Lavian, March 29, 2017, for IPR2016-01256, -01258, and -01260 (“Lavian Dep.”)
2030	Excerpts of Declaration of Dr. Lavian in support of the Petition, Ex. 1002 of IPR2016-01256 (“Lavian Dec. of IPR2016-01256”)
2040	Declaration of Regis J. “Bud” Bates in Support of Motion to Amend (“BatesDec”)

2041	Listing of Section 112 Written Description Support for the Proposed Substitute Claims
2042	Application No. 11/948,965, filed on November 20, 2007 (annotated with line numbers)
2043	Application No. 10/426,279, filed on April 30, 2003 (annotated with line numbers)
2044	Application No. 09/565,565, filed on May 4, 2000 (annotated with line numbers)
2046	U.S. Patent No. 6,381,323 to Schwab, et al. (“Schwab”)
2047	U.S. Patent No. 6,463,145 to O’Neal et al. (“O’Neal”)
2048	U.S. Patent No. 6,683,870 to Archer (“Archer”)
2049	U.S. Patent No. 5,958,016 to Chang et al. (“Chang”)
2050	U.S. Patent No. 6,353,660 to Burger et al. (“Burger”)
2051	U.S. Patent No. 6,798,767 to Alexander et al. (“Alexander”)
2052	PCT Application No. WO 99/14924 to Shtivelman (“Shtivelman”)
2053	U.S. Patent No. 5,809,128 to McMullin (“McMullin”)
2054	U.S. Patent No. 6,445,694 to Swartz (“Swartz”)
2055	An Overview of Signaling System No. 7, Abdi R. Modarressi, and Ronald A. Skoog, April, 1992
2056	U.S. Patent No. 4,646,296 to Bartholet et al. (“Bartholet”)
2057	\$200 Billion Broadband Scandal, Bruce Kushnick, 2006
2058	U.S. Patent No. 6,744,759 to Sidhu et al. (“Sidhu”)
2059	U.S. Patent No. 6,041,325 to Shah et al. (“Shah”)
2060	U.S. Patent No. 5,802,160 to Kugell et al. (“Kugell”)
2061	Karen Kaplan, Can I Put You on Hold? Profits are Calling, Los Angeles Times, February 3, 1997
2062	Redline Comparison of the Proposed Substitute Claims and the Original Claims and Clean Versions of the Proposed Substitute Claims
2063	“Cheat Sheet” listing the various IPRs by docket number, along with the identity of the petitioner, claims at issue, and art at issue
2064	Excerpts of Declaration of Thomas La Porta in Support of Petition for <i>Inter Partes Review</i> of U.S. Patent No. 8,457,113, June 23, 2016, submitted in support of IPR2016-01261
2065	Excerpts of Declaration of Dr. Tal Lavian in Support of Petition for <i>Inter Partes Review</i> of U.S. Patent No. 7,764,777, June 23, 2016, submitted in support of IPR2016-01258
2066	Application No. 12/821,119, filed on June 22, 2010

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