

Declaration of Dean Willis
Petition for *Inter Partes* Review of Patent No. 8,457,113

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Cisco Systems, Inc.
Petitioner

v.

Focal IP LLC,
Patent Owner

Patent No. 8,457,113 B2
Filing Date: Jun 22, 2010
Issue Date: Jun. 4, 2013

BRANCH CALLING AND CALLER ID BASED CALL ROUTING
TELEPHONE FEATURES

**DECLARATION OF DEAN WILLIS IN SUPPORT OF PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 8,457,113**

Inter Partes Review No. 2016-01257

Declaration of Dean Willis

Petition for *Inter Partes* Review of Patent No. 8,457,113

1. I, Dean Willis, declare as follows:

2. I have personal knowledge of the facts stated in this declaration, and could and would testify to these facts under oath if called upon to do so.

I. INTRODUCTION AND QUALIFICATIONS

A. Engagement Overview

3. I have been retained by counsel for Cisco Systems, Inc. (Petitioner) in this case as an expert in the relevant art. I am being compensated for my work at the rate of \$300 per hour. No part of my compensation is contingent upon the outcome of this petition.

4. I was asked to study U.S. Patent No. 8,457,113 (“the ’113 patent”), its prosecution history, and the prior art and to render opinions on the validity or invalidity of the claims of the ’113 patent in light of the teachings of the prior art, as understood by a person of ordinary skill in the art in the 1999 to 2000 time frame. I understand that the claims being challenged in the Petition are claims 38, 65, 143 – 147, 149, 150, 163, and 176 – 178 (“the Petitioned Claims”) of the ’113 patent.

B. Summary of Opinions

5. After studying the ’113 patent, its file history, and the prior art, and considering the subject matter of the claims of the ’113 patent in light of the state of the art in the area of telephony in circuit-switched and packet-switched networks in the 1999 and 2000 time frame, I reached the conclusions discussed herein.

6. In light of these general conclusions, and as explained in more detail

throughout this declaration, it is therefore my opinion that each of the Petitioned Claims of the '113 patent addressed in this declaration were invalid as obvious in the 1999 and 2000 time frame in light of the knowledge of skill in the art at that time and the teachings, suggestions, and motivations present in the prior art. This declaration, and the conclusions and opinions herein, provide support for two Petitions for *Inter Partes* Review (“IPR”) of the '113 patent filed by Petitioner. “Petition 1” asserts obviousness Grounds 1-4 against claims 65 and 38 of the '113 patent. “Petition 2” asserts the same obviousness Grounds 1-3 presented in Petition 1 against claims 143-147, 149, 150, 163, and 176-178 of the '113 patent, but does not assert Ground 4. I have reviewed the Petitions in their entirety as well as the corresponding exhibits. Given the overlap in the technology, prior art, and exhibits between the two Petitions, and in the interest of efficiency and ease of reference, I prepared a single Declaration in support of both Petitions. The only difference between the two declarations is the numbering system used for the exhibits, i.e., Ex. 10XX for the first petition is the same as exhibit Ex. 11XX for the second petition.

C. Qualifications and Experience

7. My educational background includes a Bachelor of Science in Computer Science from Texas A&M University (1986), and a Master of Computer Science from Texas A&M University (1994). During both educational periods, I was employed by the Energy Systems Lab of the Texas Engineering Extension

Service to develop networked applications and communications infrastructure. My Master's thesis focused on computer-supported collaboration, and my research included experimentation with Voice over Internet Protocol (VoIP) systems.

8. My career has included the design, implementation and sale of many network and communications components and systems, with a primary focus on VoIP and Real Time Communications (RTC). I have also been active in the development of the industry standards upon which most commercial VoIP systems are based. I chaired the Session Initiation Protocol (SIP, the most common VoIP protocol) working group of the Internet Engineering Task Force (IETF) for its entire ten-year run, was a board member of the Open Mobile Alliance (OMA), and active in both the of the Third Generation Partnership Projects (3GPP and 3GPP2) that defined the Internet Multimedia Subsystem (IMS) on top of SIP to be the standard architecture for VoIP in mobile phone systems. IMS is just now being widely deployed for "High Def Voice" and "Voice over Long Term Evolution (VoLTE)" by major US mobile carriers including AT&T, Verizon, Sprint, and T-Mobile.

9. My first startup company, Paronet, provided network consulting, design, and operational services to many customers in the US and Europe. As a working consultant, I gained wide exposure to the underlying technology and operational systems. Paronet was bought by Sprint in 1996, and I spent the next

two years designing data networks for Sprint, including work on Sprint's early VoIP systems.

10. In 1998, I joined one of Paranet's former customers, MCI Communications, as the Advisory Engineer responsible for research and development of VoIP systems, and was instrumental in bringing MCI's first VoIP products and services to market.

11. Following MCI's merger with WorldCom, I joined my second startup, VoIP software pioneer DynamicSoft, Inc. in 2000. As the Vice President of Network Engineering and Fellow, I led the professional services team that designed and integrated networks for DynamicSoft's customers, including Level 3, Net2Fone, and Vonage. I also managed the patent team, and acted as the principal editor and in-house agent for DynamicSoft's patent filings. Further, I developed an expert team that led the development of VoIP standards across the industry. The members of that team currently occupy a number of key positions within the IETF.

12. Cisco acquired DynamicSoft in 2004, and I continued to develop VoIP systems and services for Cisco and supporting VoIP and Internet standards development organizations. I left Cisco in 2006, and have since that time been primarily engaged in design and consulting services relating to VoIP. My client list includes (directly or through counsel) Alcatel-Lucent, Apple, British Telecom, Cisco, Level 3 Communications, Metaswitch, Siemens, Rockstar, XConnect, and

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