

Opposition to PO's Motion to Amend
Case IPR2016-01257
U.S. Patent No. 8,457,113

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,
v.
FOCAL IP, LLC,
Patent Owner ("PO")

Case IPR2016-01257
Patent 8,457,113 B2

**PETITIONER'S OPPOSITION TO PATENT OWNER'S CONTINGENT
MOTION TO AMEND**

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PETITIONER'S EXHIBIT LIST

Exhibit Number	Document
1101	U.S. Patent No. 8,457,113 (“the ’113 Patent”)
1102	Declaration of Dean Willis
1103	U.S. Patent No. 6,353,660 to Burger
1104	U.S. Patent No. 6,683,870 to Archer
1105	U.S. Patent No. 5,958,016 to Chang
1106	U.S. Patent No. 6,798,767 to Alexander
1107	File history of U.S. Patent No. 8,457,113
1108	File history of U.S. Patent No. 7,764,777
1146	U.S. Patent No. 6,442,169 to Lewis
1147	U.S. Patent No. 6,633,931 to LaPier
1148	May 8, 2017 Transcript of Deposition of Regis “Bud” Bates
1149	May 9, 2017 Transcript of Deposition of Regis “Bud” Bates
1150	March 1, 2017 Transcript of Deposition of Mr. Willis in IPR2016-01254, IPR2016-01257
1151	U.S. Patent No. 5,164,879 (<i>Honeywell v. ITT</i>)
1152	U.S. Patent No. 6,618,707 (<i>Chi. Bd. Options</i>)
1153	U.S. Patent No. 4,893,306 (<i>Telcordia Techs.</i>)
1154	U.S. Patent No. 7,764,777 to Wood
1155	U.S. Patent No. 8,115,298 to Wood
1156	Expert Declaration of Dr. Thomas F. La Porta for IPR 2016-01259, -01261, -01262, and -01263
1157	Expert Declaration of Dr. Thomas F. La Porta ISO Petitioner’s Opposition to PO’s Motion to Amend
1158	CV of Dr. Thomas F. La Porta
1159	U.S. Patent No. 6,574,328 to Wood
1160	U.S. Patent No. 7,324,635 to Wood
2019	Deposition Transcript of Dr. La Porta, Feb. 24, 2017, for IPR 2016-01259, -01261, -01262, and -01263

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Exhibit Number	Document
2020	Deposition Transcript of Dr. La Porta, Feb. 23, 2017, for IPR 2016-01259, -01261, -01262, and -01263
2022	Declaration of Regis J. "Bud" Bates in Support of Patent Owner's Response
2040	Declaration of Regis J. "Bud" Bates in Support of PO's Contingent Motion to Amend in IPR2016-01261

I. INTRODUCTION

PO proposes substituting new Claim 184 for original Claim 143. PO has not made the required showing that Claim 184 is patentable over the cited art, and cannot show that Claim 184 is patentable over newly cited U.S. Patent No. 6,442,169 to Lewis (“Lewis”) (EX1146) and U.S. Patent No. 6,633,931 to LaPier (“LaPier”) (EX1147). Accordingly, the Motion should be denied.

II. SUMMARY OF THE UNPATENTABILITY GROUNDS

The Board instituted the present trial on the following grounds:

Ground 1: Claims 143-147, 149, 150, 163, and 176-178 are obvious over Burger (EX1104) in view of the knowledge of a POSA;

Ground 2: Claims 143-147, 149, 150, 163, and 176-178 are obvious over Burger in view of Alexander (EX1106); and

Ground 3: Claims 143-147, 149, 150, 163, and 176-178 are obvious over Archer (EX1104) in view of the knowledge of a POSA.

In its Response, PO asserted that the references do not disclose “a controller” or “web-enabled processing system” because:

- There is no disclosure of a call processing system coupled to a switching facility/tandem switch because the reference’s gateways are edge devices not switching facilities (and thus necessarily connected to a PSTN edge switch).

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