UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD
YMAX CORPORATION,
Petitioner
V.
FOCAL IP, LLC,
Patent Owner
<del></del>
Case IPR2016-01258 Patent Number: 7,764,777 B2

# PATENT OWNER FOCAL IP, LLC'S RESPONSE TO PETITION FOR INTER PARTES REVIEW



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### TABLE OF AUTHORITIES

### **Cases:**

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Align Tech., Inc. v. ITC, 771 F.3d 1317 (Fed. Cir. 2014)	12
Belden, Inc. v. Berk-Tek LLC, 805 F.3d 1064 (Fed. Cir. 2015)	11
Bicon, Inc. v. Straumann Co., 441 F.3d 945 (Fed. Cir. 2006)	39
Biogen, Inc. v. Berlex Labs., Inc., 318 F.3d 1132 (Fed. Cir. 2003)	20-21
Chi. Bd. Options Exch., Inc. v. Int'l Secs. Exch., LLC, 677 F.3d 1361 (Fed. Cir. 2014)	18-19, 37
City of Arlington v. FCC, 133 Sup. Ct. 1863 (2013)	13
Cuozzo Speed Techs., Inc. v. Lee, 136 S.Ct. 2131 (2016)	11-12



Dell, Inc. v. Acceleron, LLC, 818 F.3d 1293 (Fed. Cir. 2016)	12-13
Edmund Optics, Inc. v. Semrock, Inc., Case IPR2014-00599, Paper 72 (PTAB Sept. 16, 2015)	17
Epistar Corp. v. Int'l Trade Comm'n, 556 F.3d 1321 (Fed. Cir. 2009)	19-20
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GE Lighting Solutions, LLC v. AgiLight, Inc., 750 F.3d 1304 (Fed. Cir. 2014)	36
Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966)	16
Hakim v. Cannon Avent Group, PLC, 479 F.3d 1313 (Fed. Cir. 2007)	33
Honeywell Int'l, Inc. v. ITT Indus., Inc., 452 F.3d 1312 (Fed. Cir. 2006)	19-21
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