

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRIGHT HOUSE NETWORKS, LLC
WIDOPENWEST FINANCE, LLC
KNOLOGY OF FLORIDA, INC.
BIRCH COMMUNICATIONS, INC.

Petitioner

v.

FOCAL IP, LLC,

Patent Owner

Case IPR2016-01259
Patent Number: 8,155,298

**PATENT OWNER FOCAL IP, LLC'S MOTION TO EXCLUDE
EVIDENCE UNDER 37 C.F.R. § 42.64**

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner Focal IP, LLC hereby moves to exclude Exhibits 1158, 1161, and portions of Exhibit 1165.

I. PROCEDURAL HISTORY

Petitioners filed a petition for *inter partes* review on June 23, 2016 (Paper No. 1). Patent Owner filed a preliminary response on October 26, 2016 (Paper No. 11), and Petitioners filed a reply to Patent Owner's preliminary response on November 11, 2016 (Paper No. 17). The Board instituted trial on December 19, 2016 (Paper No. 23). Patent Owner filed a request for rehearing on January 3, 2017 (Paper No. 25), which the Board denied on January 24, 2017 (Paper No. 27). Patent Owner filed its Patent Owner Response on April 3, 2017 (Paper No. 33) accompanied by the Declaration of Regis J. "Bud" Bates (Exhibit 2022). Petitioners filed a reply on June 26, 2017 (Paper No. 35). Patent Owner filed objections to evidence submitted, relied on, or cited by Petitioners in connection with their reply on June 30, 2017 (Paper No. 38).

II. ARGUMENT

Motions to exclude are authorized by 37 C.F.R. § 42.64(c). "The motion must identify the objections in the record in order and must explain the objections." 37 C.F.R. § 42.64(c). "A motion to exclude evidence must: (a) Identify where in the record the objection originally was made; (b) Identify where in the record the evidence sought to be excluded was relied upon by an opponent; (c) Address

objections to exhibits in numerical order; and (d) Explain each objection.” 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012).

The Federal Rules of Evidence apply in *inter partes* review proceedings. 37 C.F.R. § 42.62(a). Evidence is only admissible if it is relevant. Fed. R. Evid. 402. “Evidence is relevant if: (a) it has any tendency to make a fact more or less probable than it would be without the evidence; and (b) the fact is of consequence in determining the action.” Fed. R. Evid. 401. Even if relevant, evidence may be excluded “if its probative value is substantially outweighed by a danger of one or more of the following: unfair prejudice, confusing the issues, misleading the jury, undue delay, wasting time, or needlessly presenting cumulative evidence.” Fed. R. Evid. 403.

A. Exhibit 1158 Should Be Excluded.

Exhibit 1158 is a copy of U.S. Patent No. 6,333,931 to LaPier (“LaPier”). Petitioners rely on LaPier as a new prior art reference to support their new and untimely arguments that it was well-understood to a POSA to interconnect an IP network to the PSTN through a tandem switch. Paper No. 35 at 9-10. Patent Owner objected to Exhibit 1158 in Paper No. 38.

Patent Owner moves to exclude Exhibit 1158 as irrelevant under Rule 402. The Board did not institute trial with respect to LaPier (*ee* Paper No. 23 at 15), nor did the petition ever argue that it was well-understood to a POSA to interconnect an

IP network to the PSTN through a tandem switch. Petitioners improperly attempt to use LaPier to remedy the deficiencies of the prior art Petitioners rely on in their petition. The trial is limited to the arguments, evidence, and grounds raised in the petition and instituted by the Board. *See* 37 C.F.R. § 42.104(b)(5) (requiring the petitioner to identify *in the petition* the evidence relied on to support the challenge); *id.* § 42.108(a) (“When instituting *inter partes* review, the Board may authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim.”). Because Petitioners failed to timely bring this argument or this evidence in their petition, LaPier is irrelevant.

Further, any probative value is substantially outweighed by the danger of one or more of the following: unfair prejudice, misleading the factfinders, and confusing the issues. LaPier and the untimely argument it allegedly supports were not properly raised in the petition. This evidence should therefore be excluded under Rule 403 to prevent unfair prejudice, misleading of the factfinders, and confusing of the issues.

B. Portions of Exhibit 1165 Should Be Excluded.

Exhibit 1165 is the Expert Declaration of Thomas F. La Porta that Petitioners submitted in connection with their reply. Patent Owner objected to portions of Exhibit 1165 in Paper No. 38.

Patent Owner moves to exclude paragraphs 35-37 and 42-44¹ and all other paragraphs of Exhibit 1165 to the extent they rely, directly or indirectly, on the new arguments concerning Lewis and LaPier as irrelevant under Rules 402 and 403. As discussed above and below, Lewis and LaPier are irrelevant. Accordingly, Dr. La Porta's testimony regarding these new arguments and Lewis and LaPier is similarly irrelevant, and should be excluded.

D. Exhibit 1166 Should Be Excluded.

Exhibit 1166 is a copy of U.S. Patent No. 6,442,169 to Lewis ("Lewis). Petitioners rely on Lewis as a new prior art reference to support their new and untimely arguments that it was well-understood to a POSA to interconnect an IP network to the PSTN through a tandem switch. Paper No. 35 at 8-9. Patent Owner objected to Exhibit 1166 in Paper No. 38.

¹ Petitioners rely on paragraphs 35-37 and 42-44 on pages 8-12 of their reply (Paper No. 35).

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