

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Bright House Networks, LLC,
WideOpenWest Finance, LLC,
Knology of Florida, Inc.
Birch Communications, Inc.
Petitioners

v.

Focal IP, LLC,
Patent Owner

Case No. IPR2016-01259
U.S. Patent No. 8,155,298

PETITIONERS' OPPOSITION TO MOTION TO EXCLUDE

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TABLE OF AUTHORITIES

Cases

Ford Motor Co. v. Paice LLC & The Abell Foundation, Inc., IPR2014-00579,
Paper 45 at p. 29-30 (PTAB Sept. 28, 2015)..... 2, 4-5, 7

Rules and Regulations

37 C.F.R. § 42.23(b)1, 2

Patent Owner's Motion to Exclude should be denied because it fundamentally misapplies the law regarding replies. The very purpose of a petitioner's reply is to respond to the arguments in a patent owner's response. 37 C.F.R. § 42.23(b). As Petitioners repeatedly explained in their Reply (Paper 35) and during the July 6, 2017 conference call with the Board, and as the Petitioners identified in their Responsive Listing of Support Showing Reply Arguments are Proper (Paper 42) ("Responsive Listing"), the disputed exhibits (i.e., those which Patent Owner moves to exclude) and related arguments were included in the Reply to rebut Patent Owner's Response. Specifically, the new exhibits demonstrate that Patent Owner's arguments in the Response regarding the state of the art in May 2000 lack factual support and are simply inaccurate.

Patent Owner's Motion now seeks to substantially modify the rule regarding the proper scope of replies to hold that anything that directly rebuts arguments in a response is nevertheless improper if it was not included in the Petition. That is simply not the law, and such an approach would effectively nullify the utility and purpose of a reply brief.

I. LEGAL STANDARD GOVERNING REPLIES

Patent Owner's challenges to Exhibits 1166, 1158, and related portions of Exhibit 1165, (the "Reply Exhibits") are based on the mere fact that they were submitted with the Reply and not the Petition. Such arguments are not a sufficient

basis for excluding these exhibits because Petitioners *are* permitted to submit additional evidence that is responsive to arguments raised in a patent owner response – “[t]he very nature of a reply is to rebut the patent owner’s response.” *Ford Motor Co. v. Paice LLC & The Abell Foundation, Inc.*, IPR2014-00579, Paper 45 at p. 29-30 (PTAB Sept. 28, 2015) (*citing* 37 C.F.R. § 42.23(b)). In fact, the Board has found that “[t]he need to rely on new evidence may not arise until a particular point has been raised in the patent owner response. Much depends on the specific arguments made in the patent owner response.” *Id.* “The mere fact that a petitioner submits rebuttal testimony that relies on new evidence not previously identified in the petition does not suffice to establish its impropriety.” *Id.*

II. THE REPLY EXHIBITS DIRECTLY REBUT PATENT OWNER’S RESPONSE

Patent Owner’s arguments in its Motion to Exclude fail to address that the Reply Exhibits were submitted *only* to rebut new arguments in Patent Owner’s Response and not to change or supplement the two instituted Grounds. Patent Owner’s Response, and the accompanying declaration of its expert (Mr. Bates), relied on two arguments premised on unsupported factual assertions. Reply, 1-2. In response to this first argument, Petitioner submitted Reply Exhibits 1166 and 1158 which show that a POSA *did in fact* know how to connect to the PSTN through a tandem switch—which directly rebuts the testimony of Patent Owner’s expert. The need for these Reply Exhibits arose only *after* Patent Owner filed its

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