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

PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.108(c)

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List of Exhibits Cited in this Reply

Exhibit Number	Document
1001	U.S. Patent No. 8,155,298 (“the ’298 patent)
1002	Expert Declaration of Dr. Thomas La Porta
1003	U.S. Patent No. 6,683,870 to Archer (“Archer”)
1004	U.S. Patent No. 5,958,016 to Chang *et al.* (“Chang”)
1008	File history of U.S. Patent No. 8,155,298
1010	File history of U.S. Patent No. 7,764,777
1153	Supplemental Expert Declaration of Dr. Thomas La Porta (“TLP”)
1154	U.S. Patent No. 6,574,328
1155	U.S. Patent No. 7,324,635

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I. INTRODUCTION

Pursuant to the Board's order of November 1, 2016, Petitioners respectfully submit this Reply to address Patent Owner's arguments concerning disclaimer of claim scope in its Preliminary Response.

Patent Owner's Preliminary Response is an improper attempt to retroactively narrow the scope of a claim term ("switching facility") that Applicant introduced three years after it filed the related '777 patent and ten years after it filed the earliest patent to which the '777 patent claims priority. However, Applicant clearly intended this term to be interpreted broadly when it introduced this new claim term in an amendment and concurrently provided a definition with enumerated examples. Now, more than six years later, Patent Owner asks the Board to ignore the previously provided definition and enumerated examples and instead rely on a specification (presented years earlier) and arguments (presented months before the claim term was introduced by amendment) to find that Applicant disclaimed the broad scope that would otherwise be given to this claim term. Even if the Board considers Applicant's "disclaimer" evidence, which it should not, it does not contain the requisite *clear and unmistakable* disavowal of claim scope asserted by Patent Owner. As a result, the Board should accept the definition of the term "switching facility" that the Applicant provided during

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prosecution when it introduced this term—"any point in the switching fabric of converging networks."

II. APPLICANT DID NOT CLEARLY AND UNMISTAKABLY DISAVOW THE CLAIM SCOPE ASSERTED BY PATENT OWNER

A. Patent Owner Must Show a Clear and Unmistakable Disclaimer

The Federal Circuit has explained that the standard for finding a disclaimer of claim scope is "exacting." *GE Lighting Solutions, LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1309 (Fed. Cir. 2014). Disavowal does not arise merely by criticizing a particular embodiment that is encompassed in the plain meaning of a claim term. *See Epistar Corp. v. Int'l Trade Comm'n*, 566 F.3d 1321, 1335 (Fed. Cir. 2009). Nor is it enough that all the embodiments of the invention disclosed in the specification contain a particular limitation. *Thorner v. Sony Computer Ent. Am.* LLC, 669 F.3d 1362, 1366 (Fed. Cir. 2012). Rather, a disclaimer of claim scope must be "***clear and unmistakable***." *Id.* at 1366-67 (emphasis added); *see also Openwave Systems, Inc. v. Apple Inc.*, 808 F.3d 509, 513 (Fed. Cir. 2015).

B. Applicant Introduced and Broadly Defined "Switching Facilities" During the Prosecution of the '777 Patent

The first time that "switching facilities" appears anywhere in the intrinsic record of the '298 patent, or of any of the patents in its family, is February 16, 2010, when Applicant introduced it in response to a Final Office Action during prosecution of the related '777 patent. EX. 1010, 66, 68-80, 84-88; TLP, ¶14;

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