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Paper 23
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRIGHT HOUSE NETWORKS, LLC,
WIDEOPEN WEST FINANCE, LLC, KNOLOGY OF FLORIDA, INC.,
and BIRCH COMMUNICATIONS, INC.,
Petitioner,

v.

FOCAL IP, LLC,
Patent Owner.

Case IPR2016-01259
Patent 8,155,298 B2

Before SALLY C. MEDLEY, JONI Y. CHANG, and
BARBARA A. PARVIS, *Administrative Patent Judges.*

CHANG, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Bright House Networks, LLC, WideOpen West Finance, LLC, Knology of Florida, Inc., and Birch Communications, Inc. (collectively, "Petitioner") filed a Petition requesting an *inter partes* review of claim 20 of U.S. Patent No. 8,155,298 B2 (Ex. 1101, "the '298 patent") and a Declaration of Thomas F. La Porta, Ph.D. (Ex. 1102). Paper 1 ("Pet."). Focal IP, LLC ("Patent Owner") filed a Preliminary Response and a Declaration of Mr. Regis J. Bates Jr. (Ex. 2001). Paper 11 ("Prelim. Resp."). Pursuant to our prior authorization, Petitioner filed a Reply to the Preliminary Response. Paper 17 ("Reply").

For the reasons that follow, we institute an *inter partes* review pursuant to 35 U.S.C. § 314, as to claim 20 of the '298 patent.

A. Related Matters

The parties indicate that the '298 patent is involved in *Patent Asset Licensing LLC v. Bright House Networks, LLC*, No. 3:15-cv-00742-J-32MCR (M.D. Fla.), and identify other related proceedings. Pet. 4–5; Paper 7, 2–3. There are other petitions challenging the '298 patent (IPR2016-01256 and IPR2016-01263) and two related patents: (1) U.S. Patent No. 7,764,777 B2 (Ex. 1106, "the '777 patent"), which issued from a divisional application of the '298 patent's parent application; and (2) U.S. Patent No. 8,457,113 B2 (Ex. 1107, "the '113 patent"), which issued from a continuation application of the '298 patent.

B. The '298 Patent

The '298 patent is directed to a system for allowing a subscriber to select telephone service features. Ex. 1101, 1:20–23. Figure 1 of the '298 patent is reproduced below (with annotations).

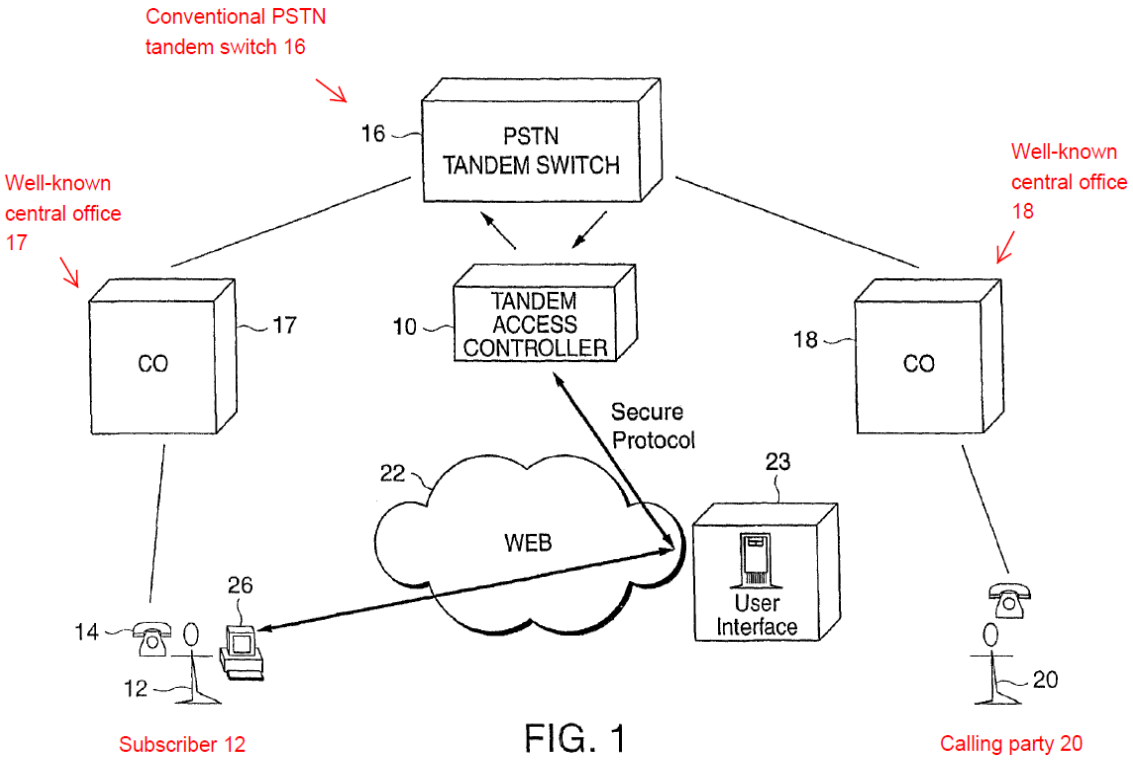

FIG. 1

Annotated Figure 1 illustrates tandem access controller 10 connected to conventional PSTN tandem switch 16. *Id.* at 4:60–64. According to the '298 patent, "[d]etails of the operation of the existing phone network," including directing of phone calls by "existing" PSTN tandem switch 16 to central offices 17, 18 are further described in a publication incorporated by reference, as well as "numerous books describing the PSTN." *Id.* at 4:60–5:4.

The call flow in the network illustrated in Figure 1 with tandem access controller 10 remains the same as that in a conventional network, "except that additional 3rd-party features are applied to the call." *Id.* More specifically, in the network illustrated in Figure 1, a call from calling party 20 to subscriber's phone 14 is directed to tandem access controller 10, which places a second call, subject to 3rd party control information to subscriber 12. *Id.* at 5:5–20. The second call is placed "to the subscriber's 'private' phone number," without terminating the first call. *Id.* When subscriber 12 answers the call, tandem access controller 10 connects the first call to the second call so as to connect calling party 20 to subscriber 12. *Id.*

Figure 1 also shows web server 23 within World Wide Web 22, which is connected to tandem access controller 10. *Id.* at Fig. 1. Subscriber 12 specifies 3rd-party call control features via web server 23 and these features are then relayed via World Wide Web 22 to tandem access controller 10. *Id.* at 5:33–41.

C. Challenged Claim

Petitioner challenges only claim 20 of the '298 patent in this proceeding. Claim 20 is reproduced below.

> 20. A method of providing a user interaction system to enable users to control routing of one or more communications between a calling party and a called party through user input, the user interaction system comprising a web server coupled to a controller with access to at least two communication networks, wherein at least one of the networks is a packet network configured to support voice over IP ("VOIP"), and the second network is coupled to a switching facility of a network comprising edge switches for routing calls from and to users

within a local geographic area and switching facilities for routing calls to other edge switches or other switching facilities local or in other geographic areas, comprising the steps of:

providing a website for the users to view features associated with the routing of the one or more communications;

facilitating certain of the users to sign up to become subscribers of the communication networks through the entry of user personal data through the website;

granting access to authorized ones of the users;

providing a menu of available features, via the website, for the users to make feature selections;

processing of feature selections into control criteria;

receiving and storing the control criteria in a database associated with the server, the controller, or both;

receiving a communication request at the controller, from the calling party to an intended called party;

upon receiving the communication request, utilizing the controller to retrieve at least a portion of the control criteria relating to the user to determine a possible route for the one or more communications from the calling party; and

executing the control criteria to facilitate the routing of the one or more communications across at least one of the at least two networks.

Ex. 1101, 14:60–15:28.

D. Prior Art Relied Upon

Petitioner relies upon the following prior art references:

Archer	US 6,683,870 B1	Jan. 27, 2004 (filed on Jun. 25, 1998)	(Ex. 1103)
Chang	US 5,958,016	Sept. 28, 1999	(Ex. 1104)
Swartz	US 6,445,694 B1	Sep. 3, 2002	(Ex. 1105)

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