UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YMAX CORPORATION,

Petitioner

v.

FOCAL IP, LLC,

Patent Owner

Case IPR2016-01260 Patent Number: 8,457,113

PATENT OWNER FOCAL IP, LLC'S CONTINGENT MOTION TO AMEND CLAIM 1 OF U.S. PATENT NO. 8,457,113

TABLE OF CONTENTS

I.	INTRODUCTION1				
II.	II. CLAIM LISTING				
III.	SCO	PE OF THE PROPOSED SUBSTITUTE CLAIM2			
IV.	SUPF	PORT FOR THE SUBSTITUTE CLAIM			
V.	CLAIM	I CONSTRUCTIONS			
	A.	Tandem Switch5			
	B.	Call Request7			
VI.	THE	SUBSTITUTE CLAIM IS PATENTABLE8			
	A.	The Level of Ordinary Skill in the Art8			
	B.	State of the Art as of the Priority Date			
VII	. SUM	MARY OF THE PROPOSED SUBSTITUTE CLAIM12			
VII	I. DIST	INCTIONS OVER THE ART13			
	А.	Scope of the Art and Deficiencies of the Art			
IX.	THE	SUBSTITUTE CLAIM IS NOT OBVIOUSNESS			

Case IPR2016-01260 Patent 8,457,113

TABLE OF AUTHORITIES

Cases:

Nike, Inc. v. Adidas AG, 812 F.3d 1326 (Fed. Cir. 2016)	
Regulations:	
37 C.F.R. § 42.121(a)	2
37 C.F.R. §42.121(a)(3)	2

Case IPR2016-01260 Patent 8,457,113

UPDATED LIST OF EXHIBITS

2001	Declaration of Regis J. "Bud" Bates filed with Preliminary
	Response
2002	Ray Horak, Communications Systems & Networks, (2 nd ed. 2000)
2003	Ray Horak, Webster's New World Telecom Dictionary (2008)
2004	Ray Horak, Telecommunications and Data Communications
	(2007)
2005	Prosecution History of U.S. Patent No. 7,764,777
	("'777ProsHist")
2006	Harry Newton, Newton's Telecom Dictionary, (23rd ed. 2007)
2007	Declaration of John P. Murphy in Support of Unopposed Motion
	for Pro Hac Vice Admission
2008	Declaration of Hanna F. Madbak in Support of Unopposed Motion
	for Pro Hac Vice Admission
2009	Corrected Declaration of Hanna F. Madbak in Support of
	Unopposed Motion for Pro Hac Vice Admission
2020	Excerpts of Deposition Transcript of Dr. La Porta, Feb. 23, 2017,
	for IPR2016-01259, -01261, -01262, and 01263 ("La Porta Dep.")
2021	Excerpts of Deposition Transcript of Mr. Willis, Mar. 1, 2017, for
	IPR2016-01254 and -01257. ("Willis Dep.")
2022	Declaration of Regis J. "Bud" Bates in Support of Response
	("BatesDec")
2023	Excerpts of Petition filed in IPR2016-01261 ("-01261 Pet.")
2024	Excerpts of Petition filed in IPR2016-01254 ("-01254 Pet.")
2025	Excerpts of Petition filed in IPR2016-01260 ("-01260 Pet.")
2026	Excerpts of Declaration of Dr. La Porta in support of the Petition,
	Ex. 1002 of IPR2016-01262 ("La Porta Dec. of IPR2016-01262")
2027	Excerpts of Declaration of Mr. Willis in support of the Petition,
	Ex. 1002 of IPR2016-01254 ("Willis Dec. of IPR2016-01254")
2028	Excerpts of Declaration of Dr. Lavian in support of the Petition,
	Ex. 1002 of IPR2016-01258 ("Lavian Dec. of IPR2016-01258")
2029	Deposition Transcript of Dr. Lavian, March 29, 2017, for
	IPR2016-01256, -01258, and -01260 ("Lavian Dep.")

iv

2030	Excerpts of Declaration of Dr. Lavian in support of the Petition,
20.40	Ex. 1002 of IPR2016-01256 ("Lavian Dec. of IPR2016-01256")
2040	Declaration of Regis J. "Bud" Bates in Support of Motion to
	Amend ("BatesDec")
2041	Listing of Section 112 Written Description Support for the
	Proposed Substitute Claims
2042	Application No. 11/948,965, filed on November 20, 2007
	(annotated with line numbers)
2043	Application No. 10/426,279, filed on April 30, 2003 (annotated
	with line numbers)
2044	Application No. 09/565,565, filed on May 4, 2000 (annotated with
	line numbers)
2046	U.S. Patent No. 6,381,323 to Schwab, et al. ("Schwab")
2047	U.S. Patent No. 6,463,145 to O'Neal et al. ("O'Neal")
2048	U.S. Patent No. 6,683,870 to Archer ("Archer")
2049	U.S. Patent No. 5,958,016 to Chang et al. ("Chang")
2050	U.S. Patent No. 6,353,660 to Burger et al. ("Burger")
2051	U.S. Patent No. 6,798,767 to Alexander et al. ("Alexander")
2052	PCT Application No. WO 99/14924 to Shtivelman ("Shtivelman")
2053	
-	U.S. Patent No. 5,809,128 to McMullin ("McMullin")
2054	U.S. Patent No. 6,445,694 to Swartz ("Swartz")
2055	An Overview of Signaling System No. 7, Abdi R. Modarressi, and
2056	Ronald A. Skoog, April, 1992
2056	U.S. Patent No. 4,646,296 to Bartholet et al. ("Bartholet")
2057	\$200 Billion Broadband Scandal, Bruce Kushnick, 2006
2058	U.S. Patent No. 6,744,759 to Sidhu et al. ("Sidhu")
2059	U.S. Patent No. 6,041,325 to Shah et al. ("Shah")
2060	U.S. Patent No. 5,802,160 to Kugell et al. ("Kugell")
2061	Karen Kaplan, Can I Put You on Hold? Profits are Calling, Los
	Angeles Times, February 3, 1997
2062	Redline Comparison of the Proposed Substitute Claims and the
	Original Claims and Clean Versions of the Proposed Substitute
	Claims

DOCKET A L A R M



Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.