

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'S RESPONSE TO PETITIONER'S OBSERVATION
ON CROSS-EXAMINATION OF PATENT OWNER'S
REPLY WITNESS REGIS J. "BUD" BATES**

Patent Owner Focal IP, LLC respectfully submits this response to Petitioner's observations on cross-examination of Patent Owner's reply witness Mr. Bates filed on August 21, 2017 ("Petitioner's Observation").

I. PETITIONER'S OBSERVATION SHOULD BE STRICKEN IN ITS ENTIRETY BASED ON NUMEROUS RULES VIOLATIONS

Petitioner's Observation should be stricken in its entirety because it violates numerous rules. *See Medtronic v. Nuvasive*, IPR2013-00506 (Paper No. 37, Oct. 15, 2014) at p. 3 ("In considering whether a motion for observations, or a response, is improper, the entire motion or response may be dismissed and not considered if there is even one excessively long or argumentative observation or response.").

First, "[a]n observation is not an opportunity to raise new issues, re-argue issues, or to pursue objections." *Id.* at 2. Petitioner violated this rule in nearly every observation, and Petitioner's Observation should be stricken accordingly. *See, e.g.*, observations 4 and 5 where Petitioner attempts to re-argue claim construction of the claimed PSTN tandem switch even though Petitioner's expert already provided a concise construction of this term in paragraph 22 of his declaration identified as exhibit 1045.

Next, "[e]ach observation should not exceed on short paragraph and should not contain arguments." *See Medtronic* at 2. Each of Petitioner's observations improperly includes arguments. Further, many of Petitioner's observations are

excessively long, not short. *See, e.g.*, observation 10, which is 16 lines long.

Further, Petitioner's Observation improperly presents observations of its own witness, not a reply witness as required by the scheduling order. Observation numbers 2, 3, 6, 8, and 10 observe the deposition testimony of Petitioner's own expert, and Petitioner's Observation should be expunged for at least these reasons. *See Seagate Tech. v. Enova Tech. Corp.*, IPR2014-01178 (Paper 45, Oct. 28, 2015), pp. 4-5.

II. RESPONSES TO OBSERVATIONS

1. Response to Observation #1

This testimony is relevant to Mr. Bates' review of certain prior art references where Petitioner only relied on the prior art reference for a single quote or a few small passages where it was not necessary for Mr. Bates to review the entire document. For example, Petitioner's Opposition to the Motion to Amend ("Petitioner's Opposition") relied on 6 lines of prior art reference Elliot identified as Exhibit 1035, which is a 264 page document. *See* Petitioner's Opposition at 17; *see also* Exhibit 1045 ("ForysDec."), ¶¶84-86 which reference a few figures and small snippets of Elliot.

2. Response to Observation #2

This testimony is relevant to whether or not Lamb's purported tandem access controller teaches a connection to an edge switch, which is also referred to as a

central office in certain references. In the same line of questioning observed by Petitioner, Mr. Bates testified that:

16. . . .Q. I'm just asking if you think you could find
17. edge switch if you were given the chance.
18. . . .A. I don't -- I don't know that I can answer that
19. right now. What I do recall from the bulk of what
20. everything is, Lamb uses the term "central office." I
21. don't recall off the top of my head, and I would have to
22. look it over to determine if they used the term "edge
23. switch."

See Exhibit 1048, p. 9, lines 16-23; see also p. 16, lines 4-7 and p. 17, lines 20-22, which supports Patent Owner's positions.

3. Response to Observation #3

As an initial matter, in this observation and many others, Petitioner misstates the testimony of Mr. Bates, which is highlighted by Petitioner's omission of providing quotes of the transcript. In the same line of questioning observed by Petitioner, Mr. Bates testified that:

2. . . .Q. So you're saying that Lamb's TA -- TNS or THS
3. doesn't receive call signaling, that's your opinion?
4. . . .A. What I'm saying is Lamb is defining an edge
5. switch, okay, and it's TNS and THS. The TNS is
6. connected at the central office, the edge switch. The
7. THS is a board of that. They can signal each other.

See Exhibit 1048, p. 16, lines 2-7; see also p. 17, line 10 – p. 18, line 13, which supports Patent Owner's positions.

4. Response to Observation #4

Petitioner's observation is related to the definition of STPs, not to the definition of the claimed PSTN tandem switch. Further, Petitioner misstates the record and attempts to improperly re-argue its claim construction position where Petitioner's construction for the claimed "PSTN tandem switch" is interchangeable with the term "access tandem switch." See ForysDec at ¶55.

5. Response to Observation #5

Petitioner misstates the record and attempts to improperly re-argue its claim construction position where Petitioner's construction for the claimed "PSTN tandem switch" is interchangeable with the term "access tandem switch." See ForysDec at ¶55. Further, Petitioner improperly ended their citation it observed in the middle of an answer by Mr. Bates where Petitioner chopped off the most relevant portion of the answer given by Mr. Bates:

4. however, a POSA would understand that a tandem
5. switch is going to carry voice and not the signaling.
6. As a matter of fact, if I recall correctly, all of
7. the -- or most of the experts in both side of this case
8. have said the same thing.

See Exhibit 1048, p. 25, lines 4-8.

6. Response to Observation #6

Petitioner's observation is related to the definition of STPs, not to the definition of the claimed PSTN tandem switch as it alleges. Further, Petitioner

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