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
U.S. Patent No. 8,457,113

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

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I. INTRODUCTION

Pursuant to the Board's oral ruling during the October 21, 2016 teleconference with the parties, Petitioner respectfully submits this Reply to address Patent Owner's arguments concerning disclaimer of claim scope.

Claim 1 of the '113 patent uses the phrase "switching facility" several times, including in the limitation "the call processing system coupled to at least one switching facility of the telecommunications network." Patent Owner argues that the applicants disclaimed call processing systems (controllers) that are connected to edge switches. It further argues that the construction of "switching facility" should therefore exclude edge switches, notwithstanding the phrase's plain meaning of "any switch in the communication network." *See* Prelim. Resp. at 2, 14–43; Petition at 20-21.

However, to effectuate a disclaimer of claim scope, the disavowal in the specification or prosecution history must be "clear and unmistakable." *Thorner v. Sony Computer Ent. Am. LLC*, 669 F.3d 1362, 1366-67 (Fed. Cir. 2012). The specification here expressly discloses two embodiments. The first describes the controller as merely "connected to the PSTN," without restriction regarding the connection. It is only the second (albeit preferred) embodiment that more narrowly

specifies that the controller is "connected internally to the PSTN," that is, "[c]onnect[ed] directly to the PSTN tandem switch…." Ex. 1001 at 3:28-40.

Likewise, although the applicants argued in the prosecution history that their architecture differs from that in Schwab where calls are routed via an edge switch, in their very next breath, applicants define "switching facilities" in a footnote to broadly encompass "***Any point in the switching fabric*** of converging networks, also referred to in industry as a signal transfer point (STP), signal control point (SCP), session border controller (SBC), gateway, access tandem, class 4 switch, wire center, toll office, toll center, ***PSTN switching center***, intercarrier connection point, trunk gateway, ***hybrid switch***, ***etc***." Ex. 2005 at 81-82, 82 n.1 (emphases added). That broad definition with its open-ended list of examples that include a "hybrid switch" (which is a combination class 4/tandem ***and class 5/edge switch***) is contrary to a "clear and unmistakable" disclaimer of edge switches.

Because applicants chose to use the broad phrase "switching facility" in their claims and did not unambiguously exclude the possibility of that facility being an edge switch, Patent Owner has failed to prove the existence of a disclaimer that narrows the scope of the phrase from its plain meaning.

II. THE STANDARD FOR CLAIM SCOPE DISCLAIMER

As the Federal Circuit has explained, 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) (disavowal must be, among other things, "so unmistakable as to be ***unambiguous*** evidence of disclaimer.'") (emphasis added); *LG Electronics, Inc. v. Advanced Micro Devices, Inc.*, Case IPR2015-00324, Paper 39 at 17 (PTAB May 23, 2016).

Patent Owner bears the burden of establishing the existence of a disclaimer here. *See Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1063-64 (Fed. Cir. 2016) ("The party seeking to invoke prosecution history disclaimer bears the burden of proving the existence of a 'clear and unmistakable' disclaimer that would have been evident to one skilled in the art.")

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