

Declaration of Dr. Thomas F. La Porta in Support of Petitioners' Opposition to
Patent Owner's Contingent Motion to Amend
IPR 2016-01261
U.S. Patent No. 8,457,113

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 IPR2016-01261
U.S. Patent No. 8,457,113

**DECLARATION OF THOMAS F. LA PORTA IN SUPPORT OF
PETITIONERS' OPPOSITION TO PATENT OWNER'S CONTINGENT
MOTION TO AMEND**

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VIII. MR. BATES TESTIFIED THAT HIS ANALYSIS DID NOT CHANGE BETWEEN ORIGINAL CLAIM 1 AND SUBSTITUTE CLAIM 18342

IX. CONCLUSION.....44

1. I, Thomas F. La Porta, declare as follows:
2. I have personal knowledge of the facts stated in this declaration, and could and would testify to these facts under oath if called upon to do so.

I. INTRODUCTION AND QUALIFICATIONS

A. Engagement Overview

3. I have been retained by counsel for Bright House Networks, LLC, WideOpenWest Finance, LLC, Knology of Florida, Inc., and Birch Communications, Inc. (“Petitioners”) in this case as an expert in the relevant art. I previously provided a declaration in this case in support of the Petition setting forth my opinions regarding the state of the art and invalidity of the challenged claims. I am being compensated for my work at the rate of \$550 per hour. No part of my compensation is contingent upon the outcome of this petition.

4. I was asked to study the Patent Owner’s April 3, 2017 Contingent Motion to Amend in *Inter Partes* Review of U.S. Patent No. 8,457,113 (“the ‘113 patent”), and its exhibits including the declaration of Regis J. “Bud” Bates dated April 2, 2017 (Ex. 2040), the clean and redlined versions of the proposed substitute claim (Ex. 2062), and the listing of Section 112 written description support for the proposed substitute claim (Ex. 2041), and to render opinions based on the testimony of Mr. Bates contained in his declaration (*Id.*) and in the transcripts of Mr. Bates’s

deposition taken on May 8-9, 2017 (Ex. 1059; Ex. 1060).

5. After studying the Contingent Motion to Amend, its exhibits including the declaration of Mr. Bates (Ex. 2040), the transcripts of his deposition (Ex. 2059; Ex. 2060), the '113 patent (Ex. 1001), its file history (Ex. 1009) and the file history of related U.S. Patent No. 7,764,777 (“the ‘777 patent”) (Ex. 1010), the prior art, and considering the subject matter of the claims of the '113 patent in light of the state of technical advancement in the area of telephony in circuit-switched and packet-switched networks in May 2000, I reached the conclusions discussed herein.

6. This declaration, and the conclusions and opinions herein, provide support for the Opposition to Patent Owner’s Contingent Motion to Amend filed by Petitioners in this case. I have reviewed the Opposition in its entirety as well as its corresponding exhibits.

B. Summary of Opinions

7. As set forth in my June 24, 2016 Declaration in this case, it is my opinion that claims 1, 2, 8, 11, 15-19, 94, 95, 102, 109-113, 128, 163, 164, 166-168, 175, 179, 180, 181 of the '113 patent are obvious over Archer in view of the knowledge of a person of ordinary skill in the art (“POSA”). As also set forth in my June 24, 2016 Declaration, it is also my opinion that claims 1, 2, 8, 11, 15-19, 94, 95, 102, 109-113, 128, and 168 of the '113 patent are obvious over Archer in view

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