

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRIGHT HOUSE NETWORKS, LLC
WIDOPENWEST FINANCE, LLC
KNOLOGY OF FLORIDA, INC.
BIRCH COMMUNICATIONS, INC.

Petitioner

v.

FOCAL IP, LLC,

Patent Owner

Case IPR2016-01261
Patent Number: 8,457,113 B2

**PATENT OWNER FOCAL IP, LLC'S OPPOSITION TO
PETITIONERS' MOTION TO EXCLUDE**

Patent Owner Focal IP, LLC respectfully submits this opposition to Petitioners' Motion to Exclude filed on August 21, 2017.

I. EXHIBIT 2070 SHOULD NOT BE EXCLUDED.

Petitioners argue that Exhibit 2070 should be excluded because (1) Mr. Bates's opinions are unreliable and unhelpful to the Board, and (2) Mr. Bates's opinions go beyond the proper scope of reply. Paper No. 50 at 1-9. Petitioners are wrong on both counts. Petitioners appear to be using their motion to file an improper surreply and an improper motion to strike. The Court should deny Petitioners' motion for this reason alone. Moreover, Mr. Bates's opinions are reliable and helpful, and his opinions are all proper rebuttal testimony. Exhibit 2070 is therefore admissible.

A. Petitioners' Motion is an Improper Surreply in Disguise

The Board should deny Petitioners' motion to exclude Exhibit 2070 because it is merely a surreply in disguise. Petitioners argue that Mr. Bates's opinion is premised on the understanding that Petitioners have the burden to prove the unpatentability of proposed substitute claims. Paper No. 50 at 5-6. Petitioners argue that Mr. Bates's "error" has caused him to now argue that limitations are missing from the prior art that he did not discuss in connection with the motion to amend. *Id.* at 5. In support of this argument, Petitioners improperly reiterate their arguments in opposition to the motion to amend, cite to Mr. Bates's deposition testimony in

connection with a previous declaration, and point to various portions of Mr. Bates's reply declaration that are allegedly inconsistent with the motion to amend and Mr. Bates's prior testimony. *Id.* at 5-8. In short, Petitioners are attempting to use the motion to exclude as another opportunity to argue the merits. This is not proper. *Liberty Mutual Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00002, Paper No. 66 at 62 (P.T.A.B. Jan. 23, 2014) ("While a motion to exclude may raise issues related to admissibility of evidence, it is not an opportunity to file a sur-reply, and also is not a mechanism to argue that a reply contains new arguments or relies on evidence necessary to make out a prima facie case."). Petitioners should have either sought to file a surreply or deposed Mr. Bates in connection with his reply declaration and filed a motion for observations on cross-examination. They did neither. The Board should therefore deny Petitioners' motion because it seeks to circumvent the rules.

B. Petitioners' Motion is an Improper Attempt to Strike Patent Owner's Reply.

Petitioners also argue that Mr. Bates's opinion is inadmissible because he introduces new opinions and arguments that he could have included in his original declaration in support of the motion to amend. Paper No. 50 at 8-9. While Petitioners have couched their argument as an attack on the admissibility of Mr. Bates's testimony, it is really an attack on the arguments in the reply itself. Motions

to exclude are not the proper vehicles for challenging the scope of arguments in replies. *See Vibrant Media, Inc. v. General Elec. Co.*, IPR2013-00170, Paper No. 56 at 31 (P.T.A.B. June 26, 2014) (“A motion to exclude is not a mechanism to argue that a reply contains new arguments or relies on evidence necessary to make out a prima facie case.”); *BlackBerry Corp. v. Zipit Wireless, Inc.*, IPR2014-01508, Paper No. 49 at 40 (P.T.A.B. Mar. 29, 2016) (“As an initial matter, a motion to exclude is not a proper vehicle for a party to raise the issue of arguments exceeding the scope of a reply.”).

Moreover, the challenged portions of Mr. Bates’s reply declaration are proper rebuttal testimony. Paragraphs 44-45, 47, and 50-51 are about Lewis and LaPier. Ex. 2070, ¶¶ 44-45, 47, 50-51. Lewis and LaPier were not brought to Patent Owner’s attention until Petitioners filed their opposition to Patent Owner’s motion to amend. Mr. Bates therefore could not have included testimony about Lewis and LaPier until his reply declaration. Paragraph 54 is Mr. Bates’s explanation of why the proposed substitute claim is not obvious even in light of Petitioners’ arguments. Ex. 2070, ¶ 54. And while paragraph 42 is about Archer, it is directly responsive to Petitioners’ argument that Patent Owner has not attributed patentability to when the first and second calls are connected. *Id.*, ¶ 42; *see also* Paper No. 35 (Petitioners’ opposition to motion to amend) at 25. Moreover, as paragraph 42 indicates, Patent Owner argued in its motion that Archer discloses that a first call request is answered

prior to processing a second call request across the packet network. Ex. 2070, ¶ 42 (citing Mot. at 18, 25). The Board therefore should not exclude Exhibit 2070.

Neither of the cases Petitioners cite support a contrary conclusion. In *The Scotts Company LLC v. Encap, LLC*, the Board excluded a second reply declaration because the majority of it was in support of the motion to amend instead of the reply. IPR2013-00110, Paper No. 79 at 6-8 (P.T.A.B. June 24, 2014). In *Veeam Software Corp. v. Symantec Corp.*, the Board expunged expert declarations after a party requested to file a motion to strike, finding that the declarations included testimony that was not proper rebuttal testimony. IPR2013-00141, Paper No. 35 at 3-5 (P.T.A.B. Apr. 7, 2014). Here, Mr. Bates's declaration is proper rebuttal testimony, and instead of following the proper procedure by seeking to file a motion to strike, Petitioners improperly filed a motion to exclude. The Board therefore should not exclude Exhibit 2070.

C. Exhibit 2070 is Admissible Under Rules 403, 702, and 703.

Petitioners argue that Exhibit 2070 is inadmissible under Rules 403, 702, and 703¹ because (1) it relies on an incorrect legal standard, and (2) Mr. Bates fails to

¹ Petitioner also states that Mr. Bates's opinions should be excluded under 37 C.F.R. § 42.20(c). This regulation merely states that a party that files a motion has

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