

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

**PETITIONERS' REPLY IN SUPPORT OF THEIR MOTION TO
EXCLUDE**

I. PATENT OWNER HAS NOT OVERCOME THE ARGUMENTS IN THE MOTION TO EXCLUDE FOR EXHIBITS 2011, 2021, 2024, 2025, 2027-2030, 2041, AND 2065

For the reasons set forth in Petitioners' Motion to Exclude (Paper 50)¹, Exhibit 2011 remains irrelevant under F.R.E. 402 and any attempted reliance on this exhibit by the Patent Owner for the first time during the oral hearing remains improper under F.R.E. 403 and the Board's rules. Patent Owner acknowledges that it does not cite to Exhibit 2011 in *any* paper in this proceeding. Paper 51, Opposition to Motion to Exclude ("Opposition"), at 7. Thus, the Board should exclude this exhibit and reject any attempt by Patent Owner to make any argument relying on this document at the oral hearing, like the one it improperly attempts to inject for the first time in its Opposition. *Id.*; Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) ("A party may . . . only present arguments relied upon in the papers previously submitted. No new evidence or arguments may be presented at the oral argument.")

Patent Owner acknowledges that Exhibits 2021, 2024, 2025, and 2027-2030 are *incomplete* transcripts and submissions of witnesses who have not submitted

¹ Petitioners have requested permission from the Board to file a Corrected Motion to Exclude to simply reorder the arguments in the Motion to address the objections in numerical order (as Patent Owner raised in its Opposition). *See* Paper 51, 11.

declarations or any direct testimony in the present case, and of entities who are not petitioners in the present case. Opposition at 8-9. Patent Owner’s argument that *Petitioners*, instead of itself, needed to submit the complete transcripts and submissions for each of these exhibits with their Reply is yet another improper attempt to shift Patent Owner’s burden of complying with the F.R.E. onto Petitioners. Rather, Petitioners followed the procedures set forth in F.R.E. 106 and 37 C.F.R. 42.64 by timely objecting to these exhibits as incomplete and preserving those objections in its Motion to Exclude. Patent Owner refused to respond to these objections with supplemental evidence including the complete documents and thus failed to cure its lack of compliance with the F.R.E. Petitioners’ filing of Exhibit 1061 did not retroactively relieve Patent Owner of its obligation to comply with the Federal Rules, or with those of this Board, for all of these exhibits. Thus, Exhibits 2021, 2024, 2025, and 2027-2030 remain inadmissible in this IPR.

Patent Owner acknowledges that it included additional briefing on page 1 of Exhibit 2041 in contravention of the Board’s order. Opposition, 10; Paper 29, Order on Motion to Amend, at 2-3 (“[T]he aforementioned appendix *must contain only* citations and exact text of the specification . . . Patent Owner *may reproduce only* exact text of the specification alongside the corresponding citations.”)

Whether this additional briefing does or does not provide a “factual introduction as to the applications that are referenced in the subsequent claim charts” (as Patent

Owner alleges) is inapposite. By including this briefing in its appendix, rather than in its Motion to Amend, Patent Owner circumvented the page limits of 37 C.F.R. § 42.24(b). Thus, the Board should exclude at least this portion of Exhibit 2041.

Exhibit 2065 remains inadmissible as set forth in Petitioners' Motion and for the same reasons set forth above for Exhibits 2021, 2024, 2025, and 2027-2030.

II. MR. BATES'S MOTION TO AMEND REPLY DECLARATION (EXHIBIT 2070) REMAINS INADMISSIBLE AND SHOULD BE EXCLUDED

Mr. Bates's opinions in Exhibit 2070 are premised on the wrong legal standard such that they cannot be accepted as reliable. Motion to Exclude, 1-9. Patent Owner acknowledges that it applied the wrong legal standard in its Motion to Amend, but remarkably argues that Mr. Bates did not rely on this misunderstanding of the law in his opinions. Opposition, 5-6. Mr. Bates's statements in his declaration submitted in support of Patent Owner's Motion to Amend Reply demonstrate that this argument is false. Indeed, Mr. Bates identified that his "opinions are [] informed by my understanding of the relevant law." Exhibit 2070, ¶22. Moreover, various statements in his declaration reflect that Mr. Bates's opinions are in fact informed by Patent Owner's *misunderstanding* of the relevant law governing motions to amend such as:

- "I understand that . . . the following factors must be evaluated to determine whether *a party challenging a patent claim's validity has met its burden of proof* that the claimed invention is obvious." *Id.*, ¶26;

- “*A party challenging validity must show that a person of ordinary skill in the art would have had a reason to combine the teachings of the prior art to achieve the claimed invention and would have had a reasonable expectation of success in doing so.*” *Id.*, ¶29;
- “*I understand that a party challenging the claims of a patent must present evidence sufficient to establish some articulated, rational reason to select and combine the teachings of the prior art to produce the claimed invention with a reasonable expectation of success.*” *Id.*, ¶31;
- “*Petitioner failed to map numerous limitations of the Substitute Claim to each of the references, but rather focused on certain features.*” *Id.*, ¶32;
- “*Petitioner did not even attempt to show . . .*” *Id.*, ¶¶44-45;
- “*Petitioner did not even attempt to satisfy these limitations . . .*” *Id.*, ¶50;
- “*Petitioner has not provided any reasons as to how or why any reference could be modified or combined to read on each of the limitations recited in the Substitute Claim.*” *Id.*, ¶54;
- “*Petitioner did not even attempt to address . . .*” *Id.*;
- “*Petitioner did not even attempt to show how any prior art reference could possibly render the Substitute Claim obvious.*” *Id.*

Contrary to Patent Owner’s arguments (Opposition, 7), Mr. Bates’s unfettered reliance on Patent Owner’s misunderstanding of the law is further

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