

Opposition to Patent Owner's Motion to Amend
IPR 2016-01261
U.S. Patent No. 8,457,113

IN THE 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

Before SALLY C. MEDLEY, JONI Y. CHANG, and BARBARA A. PARVIS,
ADMINISTRATIVE PATENT JUDGES.

**PETITIONERS' OPPOSITION TO PATENT OWNER'S CONTINGENT
MOTION TO AMEND**

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PETITIONERS' OPPOSITION EXHIBIT LIST

Exhibit Number	Document
1001	U.S. Patent No. 8,457,113 (“the ’113 Patent”)
1002	Expert Declaration of Dr. Thomas F. La Porta
1003	U.S. Patent No. 6,683,870 to Archer (“Archer”)
1004	U.S. Patent No. 5,958,016 to Chang <i>et al.</i> (“Chang”)
1006	U.S. Patent No. 7,764,777 (“the ’777 Patent”)
1007	U.S. Patent No. 8,115,298 (“the ’298 Patent”)
1010	File history of U.S. Patent No. 7,764,777
1057	U.S. Patent No. 6,442,169 to Lewis (“Lewis”)
1058	U.S. Patent No. 6,333,931 to LaPier (“LaPier”)
1059	May 8, 2017 Transcript of Deposition of Regis “Bud” Bates
1060	May 9, 2017 Transcript of Deposition of Regis “Bud” Bates
1066	Expert Declaration of Dr. Thomas F. La Porta in Support of Opposition to Motion to Amend
1067	Claim Chart of Lewis Against Proposed Substitute Claim 183
1068	Claim Chart of LaPier Against Proposed Substitute Claim 183
2019	Deposition Transcript of Dr. La Porta, Feb. 24, 2017, for IPR 2016-01259, -01261, -01262, and -01263.
2020	Deposition Transcript of Dr. La Porta, Feb. 23, 2017, for IPR 2016-01259, -01261, -01262, and -01263.
2040	Expert Declaration of Regis “Bud” Bates in Support of Patent Owner’s Motion to Amend
2041	Section 112 Written Description Support for the Proposed Substitute Claim
2057	\$200 Billion Broadband Scandal, Bruce Kushnick, 2006
2061	Karen Kaplan, Can I Put You on Hold? Profits are Calling, Los Angeles Times, February 3, 1997
2062	Clean and Redlined Versions of the Proposed Substitute Claim

I. INTRODUCTION

Patent Owner filed a Contingent Motion to Amend (“Motion”) substituting Claim 183 for Claim 1 of U.S. Pat. No. 8,457,113 (“the ’113 Patent”). Petitioners hereby oppose this Motion because Patent Owner has not met its burden of showing that substitute Claim 183 is patentable. Patent Owner has not made the required showing that Claim 183 is patentable over the cited art, and cannot show that Claim 183 is patentable over newly cited U.S. Patent No. 6,442,169 to Lewis (“Lewis”) (EX1057) and U.S. Patent No. 6,333,931 to LaPier (“LaPier”) (EX1058). Accordingly, the Motion should be denied.

II. SUMMARY OF THE UNPATENTABILITY GROUNDS

The Board instituted the present trial on the following grounds:

Ground 1: Claims 1, 2, 8, 11, 15-19, 94, 95, 102, 109-113, 128, 163, 164, 166-168, 175, 179, 180, 181 are obvious over Archer (EX1003) in view of the knowledge of a person of ordinary skill in the art (“POSA”); and

Ground 2: Claims 1, 2, 8, 11, 15-19, 94, 95, 102, 109-113, 128, and 168 are obvious over Archer in view of Chang (EX1004).

With respect to Ground 1, in its Response, Patent Owner has asserted that Archer does not disclose a “web-enabled processing system” for several reasons:

- (1) There is no disclosure that server processor 128 performs the step of establishing voice communications between two networks nor how this step is performed; and
- (2) There is no disclosure of a call processing system coupled to a switching facility/tandem switch because Archer's gateways are edge devices not switching facilities (and thus necessarily connected to a PSTN edge switch).

With respect to Ground 2, in its Response, Patent Owner has asserted that Chang fails to disclose a call processing system coupled to a switching facility/tandem switch because Chang's secure access platform 25 cannot deal with call data or receive, originate, or process a call or call request.

Likewise, in the present Motion, Patent Owner makes arguments that overlap with its arguments in its Response regarding Archer and Chang with respect to substitute Claim 183, asserting that Claim 183 is patentable over all cited art (including Archer and Chang) because the cited art either discloses a tandem access controller or "TAC" (call processing system) external to the PSTN and thus necessarily connected to an edge switch of the PSTN, or (2) discloses a TAC (call processing system) internal to the PSTN that does not receive call requests or initiate call requests to establish a call.

Thus, Patent Owner's arguments for patentability of Claim 1 and substitute Claim 183 largely turn on the same issues.

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