

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

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

v.

FOCAL IP, LLC,  
Patent Owner.

---

Case IPR2016-01262  
Patent 7,764,777 B2

---

Before SALLY C. MEDLEY, JONI Y. CHANG, and  
BARBARA A. PARVIS, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

## I. INTRODUCTION

Bright House Networks, LLC, WideOpenWest Finance, LLC, Knology of Florida, Inc., and Birch Communications, Inc. (collectively “Petitioner”)<sup>1</sup> filed a Petition for *inter partes* review of claims 18, 21, 23, 25, 26, 28–31, 37, 38, 41, 45, and 46 of U.S. Patent No. 7,764,777 B2 (Ex. 1001, “the ’777 patent”). Paper 1 (“Pet.”). Focal IP, LLC (“Patent Owner”) filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). Petitioner filed a Reply. Paper 17 (“Reply”). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and Preliminary Response, we conclude the information presented shows there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 18, 21, 23, 25, 26, 28–31, 37, 38, 41, 45, and 46 of the ’777 patent.

### A. *Related Matters*

The parties state that the ’777 patent is the subject of pending lawsuits in the Middle District of Florida, and these lawsuits include assertions against Bright House Networks, LLC, WideOpenWest Finance, LLC, YMax Corporation, Birch Communications, Inc., and T3 Communications, Inc. Pet. 4; Paper 7 (Patent Owner’s Mandatory Notices), 2–3. Another

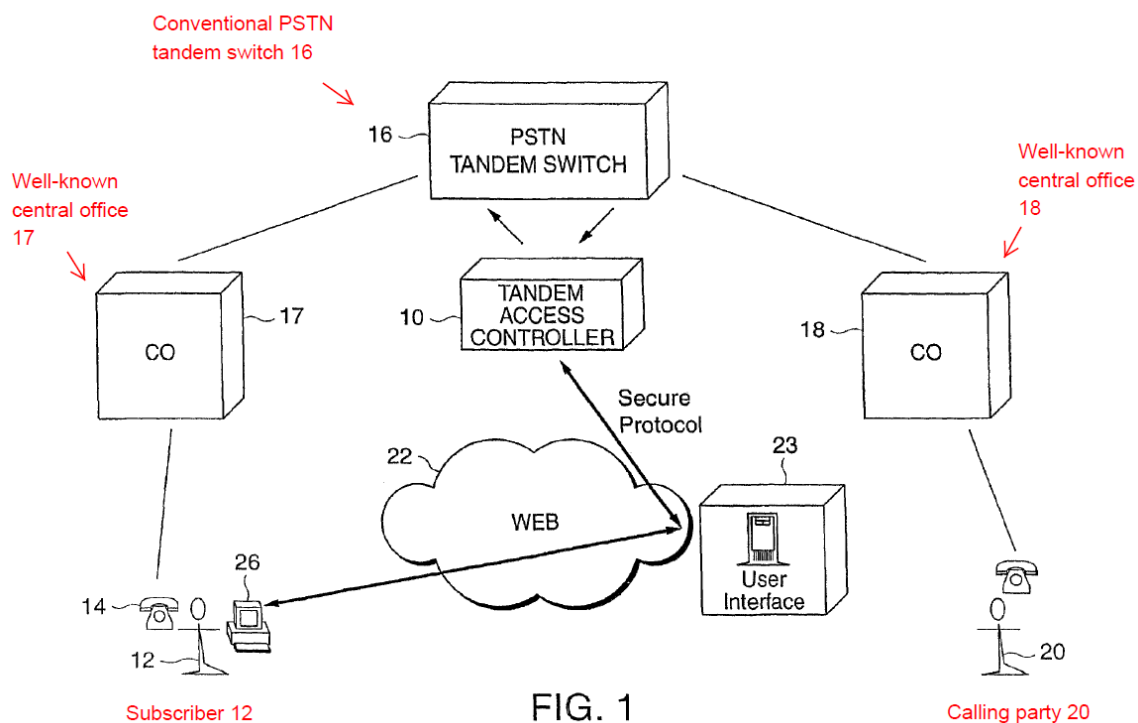
---

<sup>1</sup> Petitioner identifies several real parties-in-interest, as well as other “potential real parties-in-interest” to Petitioner. Pet. 2–4.

petitioner filed a petition also challenging claims of the '777 patent (i.e., IPR2016-01258). Paper 7, 3.

### B. The '777 Patent

The '777 patent is directed to a system for allowing a subscriber to select telephone service features. Ex. 1001, 1:18–21. Figure 1 of the '777 patent is reproduced below.



Annotated Figure 1 illustrates tandem access controller 10 connected to conventional Public Service Telephone Network (PSTN) tandem switch 16. *Id.* at 4:40, 41. According to the '777 patent, “[d]etails of the operation of the existing phone network,” including directing of phone calls by “existing” PSTN tandem switch 16 to central offices 17, 18 are further described in a publication incorporated by reference, as well as “numerous books describing the PSTN.” *Id.* at 4:40–51.

The call flow in the network illustrated in Figure 1 with tandem access controller 10 remains the same as that in a conventional network, “except that additional 3rd-party features are applied to the call.” *Id.* at 4:40–44. More specifically, in the network illustrated in Figure 1, a call from calling party 20 to subscriber’s phone 14 is directed to tandem access controller 10, which places a second call, subject to 3<sup>rd</sup> party control information to subscriber 12. *Id.* at 4:52–55. The second call is placed “to the subscriber’s ‘private’ phone number,” without terminating the first call. *Id.* at 4:55–57. When subscriber 12 answers the call, tandem access controller 10 connects the first call to the second call so as to connect calling party 20 to subscriber 12. *Id.* at 4:59–62.

Figure 1 also shows web server 23 within World Wide Web 22, which is connected to tandem access controller 10. *Id.* at Fig. 1. Subscriber 12 specifies 3<sup>rd</sup>-party call control features via web server 23 and these features are then relayed via World Wide Web 22 to tandem access controller 10. *Id.* at 5:13–21.

### *C. Illustrative Claim*

Petitioner challenges claims 18, 21, 23, 25, 26, 28–31, 37, 38, 41, 45, and 46 of the ’777 patent. Claims 18, 37, 45, and 46 are independent claims. Claims 21, 23, 25, 26, and 28–31 depend directly from claim 18. Claims 38 and 41 depend directly from claim 37. Independent claim 18, reproduced below, is illustrative of the claimed subject matter:

18. A method for processing an incoming call from a switching facility on a communication network that comprises edge switches for routing calls to subscribers within a local geographic area and switching facilities for routing calls to edge switches, or other switching facilities local or in other geographic areas the method comprising the steps of:

receiving a first call, which is intended for a specified recipient, at a controlling device in communication with the switching facility;

identifying one or more control criteria previously associated with the specified recipient, wherein the one or more control criteria was entered via a web-based interface;

initiating a second call at the controlling device in accordance with the control criteria associated with the specified recipient; and

connecting the first and second calls at the controlling device after the second call is received by a communication device associated with the specified recipient.

*Id.* at 15:12–30.

Independent claim 37 is similar to claim 18, except that when the call is forwarded, the claim requires using a “packet-based connection.”

Independent claim 45 is similar to claim 18, except that instead of initiating a second call to a specified recipient, the original first call is routed to a "voicemail server." Independent claim 46 is similar to claim 18, except that instead of initiating a second call to a specified recipient, the original first call is blocked.

#### *D. Asserted Grounds of Unpatentability*

Petitioner asserts that claims 18, 21, 23, 25, 26, 28–31, 37, 38, 41, 45, and 46 are unpatentable based on the following grounds (Pet. 4):

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.