

Declaration of Dr. Thomas F. La Porta in Support of Petitioners' Opposition to
Patent Owner's Contingent Motion to Amend
IPR 2016-01262
U.S. Patent No. 7,764,777

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. IPR2016-01262
U.S. Patent No. 7,764,777

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

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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. 7,764,777 (“the ‘777 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 ‘777 patent (Ex. 1001), its file history (Ex. 1010), the prior art, and considering the subject matter of the claims of the ‘777 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 18, 21, 23, 25, 26, 28-31, 37, 38, 41, 45, and 46 of the ‘777 patent are obvious over Archer (Ex. 1003) in view of Chang (Ex. 1004) and the knowledge and skill of a person of ordinary skill in the art (“POSA”). My opinions are unchanged.

8. As set forth herein, it is my opinion that Patent Owner has not made the required showing that Substitute Claim 49 is patentable over the cited art in the

Petition and my June 24, 2016 Declaration.

9. As set forth herein, it is my opinion that Patent Owner cannot show that Substitute Claim 49 is patentable over newly cited U.S. Patent No. 6,442,169 to Lewis (“Lewis”) (Ex. 1057) and U.S. Patent No. 6,333,931 to LaPier (“LaPier”) (Ex. 1058).

C. Materials Considered

10. My analysis is based on my education and experience as set out in my June 24, 2016 declaration in this case (Ex. 1002) and in my curriculum vitae (Ex. 1053), including the documents I have read and authored and systems I have developed and used since then.

11. In addition to the materials set forth in my June 24, 2016 Declaration in this case (Ex. 1002), I have reviewed the following:

| Exhibit No. | Description of Document |
|--------------------|---|
| | Decision Granting Institution of <i>Inter Partes</i> Review No. IPR2016-01261, January 3, 2017 (“Institution Decision”) |
| | Patent Owner’s Contingent Motion to Amend |
| 1001 | U.S. Patent No. 7,764,777 (“the ‘777 patent”) |
| 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. 8,457,113 (“the ‘113 patent”) |
| 1007 | U.S. Patent No. 8,115,298 (“the ‘298 patent”) |
| 1010 | File history of U.S. Patent No. 7,764,777 |

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