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.

Petitioner

v.

FOCAL IP, LLC,

Patent Owner

Case IPR2016-01262
Patent Number: 7,764,777

PATENT OWNER FOCAL IP, LLC'S MOTION TO EXCLUDE EVIDENCE UNDER 37 C.F.R. § 42.64

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner Focal IP, LLC hereby moves to exclude Exhibits 1057, 1058, and portions of Exhibit 1065.

I. PROCEDURAL HISTORY

Petitioners filed a petition for *inter partes* review on June 24, 2016 (Paper No. 1). Patent Owner filed a preliminary response on October 19, 2016 (Paper No. 11), and Petitioners filed a reply to Patent Owner's preliminary response on November 11, 2016 (Paper No. 17).[1] The Board instituted trial on January 3, 2017 (Paper No. 19). Patent Owner filed a request for rehearing on January 17, 2017 (Paper No. 21), which the Board denied on January 24, 2017 (Paper No. 23). Patent Owner filed its Patent Owner Response on April 3, 2017 (Paper No. 30) accompanied by the Declaration of Regis J. "Bud" Bates (Exhibit 2022). Patent Owner also filed a contingent motion to amend on April 3, 2017 (Paper No. 31). Petitioners filed a reply to Patent Owner's response (Paper No. 34) and an opposition to Patent Owner's motion to amend (Paper No. 35) on June 26, 2017. Patent Owner filed objections to evidence submitted, relied on, or cited by Petitioners in connection

[1] Petitioner's reply to Patent Owner's preliminary response was originally filed as Paper No. 14, but exceeded the ten-page limit. A corrected reply was filed as Paper No. 17.

with their reply and opposition to Patent Owner's motion to amend on June 30, 2017 (Paper No. 38).

II. ARGUMENT

Motions to exclude are authorized by 37 C.F.R. § 42.64(c). "The motion must identify the objections in the record in order and must explain the objections." 37 C.F.R. § 42.64(c). "A motion to exclude evidence must: (a) Identify where in the record the objection originally was made; (b) Identify where in the record the evidence sought to be excluded was relied upon by an opponent; (c) Address objections to exhibits in numerical order; and (d) Explain each objection." 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012).

The Federal Rules of Evidence apply in *inter partes* review proceedings. 37 C.F.R. § 42.62(a). Evidence is only admissible if it is relevant. Fed. R. Evid. 402. "Evidence is relevant if: (a) it has any tendency to make a fact more or less probable than it would be without the evidence; and (b) the fact is of consequence in determining the action." Fed. R. Evid. 401. Even if relevant, evidence may be excluded "if its probative value is substantially outweighed by a danger of one or more of the following: unfair prejudice, confusing the issues, misleading the jury, undue delay, wasting time, or needlessly presenting cumulative evidence." Fed. R. Evid. 403.

A. Exhibit 1057 Should Be Excluded In Connection With Petitioners' Reply.

Exhibit 1057 is a copy of U.S. Patent No. 6,442,169 to Lewis ("Lewis). Petitioners rely on Lewis as a new prior art reference to support their new and untimely arguments that it was well-understood to a POSA to interconnect an IP network to the PSTN through a tandem switch. Paper No. 34 at 8-9. Patent Owner objected to Exhibit 1057 in Paper No. 38.

Patent Owner moves to exclude Exhibit 1057 in connection with Petitioners' reply as irrelevant under Rule 402. The Board did not institute trial with respect to Lewis (*see* Paper No. 19 at 19), nor did the petition ever argue that it was well-understood to a POSA to interconnect an IP network to the PSTN through a tandem switch. Petitioners improperly attempt to use Lewis to remedy the deficiencies of the prior art Petitioners rely on in their petition. The trial is limited to the arguments, evidence, and grounds raised in the petition and instituted by the Board. *See* 37 C.F.R. § 42.104(b)(5) (requiring the petitioner to identify *in the petition* the evidence relied on to support the challenge); *id.* § 42.108(a) ("When instituting *inter partes* review, the Board may authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim."). Because Petitioners failed to timely bring this argument or this evidence in their petition, Lewis is irrelevant.

Further, any probative value is substantially outweighed by the danger by one or more of the following: unfair prejudice, misleading the factfinders, and confusing the issues. Lewis and the untimely argument it allegedly supports were not properly raised in the petition. This evidence should therefore be excluded under Rule 403 to prevent unfair prejudice, misleading of the factfinders, and confusing of the issues.[2]

B. Exhibit 1058 Should Be Excluded In Connection With Petitioners' Reply.

Exhibit 1058 is a copy of U.S. Patent No. 6,333,931 to LaPier ("LaPier"). Petitioners rely on LaPier as a new prior art reference to support their new and untimely arguments that it was well-understood to a POSA to interconnect an IP

[2] Petitioners also rely on Lewis in connection with their opposition to Patent Owner's motion to amend. Patent Owner does not object to the use of Lewis in connection with the motion to amend, but only seeks its exclusion in connection with Petitioners' reply. *Cf.* Fed. R. Evid. 105 ("If the court admits evidence that is admissible against a party or for a purpose—but not against another party or for another purpose—the court, on timely request, must restrict the evidence to its proper scope and instruct the jury accordingly.").

DOCKET ALARM

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.