

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner

v.

FOCAL IP, LLC,

Patent Owner

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

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

Petitioners' opposition to Patent Owner's motion to exclude mischaracterizes the record. Lewis and LaPier, which Petitioners raised for the first time in reply, raise new arguments that Petitioners failed to make in their petition and that the Board did not consider when instituting review. Lewis and LaPier are therefore irrelevant to the instituted grounds and should be excluded.

### **I. Lewis and LaPier Should be Excluded**

As an initial matter, the Board should disregard Petitioners' arguments regarding Lewis and LaPier because Petitioners' opposition impermissibly argues the merits of the case. Instead of merely stating why it believes that Lewis and LaPier are relevant to the instituted grounds, Petitioners' opposition includes substantial argument regarding the merits of the case. *See* Paper No. 52 at 5-7. Motions to exclude (and their corresponding oppositions) are not the proper place for substantive arguments. *See Liberty Mutual Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00002, Paper No. 66 at 62 (P.T.A.B. Jan. 23, 2014) ("While a motion to exclude may raise issues related to admissibility of evidence, it is not an opportunity to file a sur-reply . . ."). The Board should therefore ignore Petitioners' arguments.

Moreover, Lewis and LaPier are not relevant to the issues raised in the petition and the grounds instituted by the Board. Petitioners argue that their petition explains that "a POSA would understand that Archer discloses server processor 128 coupled to a PSTN tandem switch in PSTN 118 (136) via gateway 126." Paper No. 52 at 4.

Petitioners further argue that Lewis and LaPier were necessary to rebut Mr. Bates's opinion that "[p]rior to the date of the invention . . . a POSA would understand that any prior art disclosing an edge device external to the PSTN must access the PSTN through an edge switch first, not a tandem switch." Paper No. 52 at 4 (emphasis added).

Petitioners claim that the Reply Exhibits demonstrate what a POSA would have understood in May 2000. *See id.* at 2-3. But there is no evidence that Lewis and LaPier were even known to the public at that time and could have been considered by a POSA or anyone else not employed by the assignees. Lewis claims a priority date of November 20, 1998, and LaPier claims a priority date of December 28, 1998. Assuming both of these patents (or related applications) were published 18 months after their respective priority dates, they would have been published *after* the priority date of the '777 Patent. Given the testimony that Petitioners would like to rebut with the Reply Exhibits concerns Mr. Bates testifying about the knowledge of a POSA *as of the '777 Patent's priority date*, these Exhibits are wholly deficient because a POSA would not have known about these patents at that time.<sup>1</sup>

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<sup>1</sup> Patent Owner understands that while the Reply Exhibits may be prior art to the '777 Patent under 35 U.S.C. § 102, that is not the proper focus. Petitioners

Although a complete discussion of the technical aspects of Lewis and LaPier is outside the scope of this reply, Patent Owner disputes that Lewis and LaPier show an edge device external to the PSTN that accesses the PSTN directly through a tandem switch. Petitioners' spin of Lewis and LaPier simply emphasizes the deficiencies of the art cited in the original petition. Indeed, Archer, Petitioners' primary reference, does not even mention tandem switches. It is these deficiencies that Petitioners seek to cure with Lewis and LaPier, not any statements by Mr. Bates, which go to the knowledge of a POSA at a point in time before Lewis and LaPier were publicly available.

In summary, instead of merely using the new exhibits to elaborate on their positions raised in the petition, as the Board held was proper in *Ford Motor Co. v. Paice LLC*, Petitioners are using Lewis and LaPier to impermissibly add new arguments that they did not make in their petition.<sup>2</sup> IPR2014-00579, Paper No. 45

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attempt to use these Exhibits to show what the knowledge of a POSA would have been at the time the '777 Patent was filed, and for a POSA to have been informed by these Exhibits, they would need to have been publicly available at that time.

<sup>2</sup> Petitioners' argument is also belied by its argument in reply that Archer discloses connecting to the PSTN through a tandem switch. Paper No. 34 at 6-7. If

at 30 (P.T.A.B. Sep. 28, 2015) (“In its reply, Ford merely elaborated on an initial position raised in its Petition and presented evidence in direct rebuttal to Paice’s Response.”). The Board should therefore exclude Lewis and LaPier.

Dated: September 5, 2017

Respectfully Submitted,

/s/ Brent N. Bumgardner

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NELSON BUMGARDNER, P.C.

### **CERTIFICATE OF SERVICE**

I hereby certify that on this 5th day of September 2017, a copy of Patent Owner FOCAL IP, LLC’s Reply in Support of Motion to Exclude Evidence Under 37 C.F.R. § 42.64 has been served in its entirety via email on the following:

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Petitioners believe this is true, it is unclear why they also rely on Lewis and LaPier unless Petitioners use them as the basis for additional grounds of unpatentability.

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