

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEM, INC.,
Petitioner¹,

v.

FOCAL IP, LLC,
Patent Owner.

Cases IPR2016-01257, IPR2016-01260, IPR2016-01261 (Patent 8,457,113),
IPR2016-01258, and IPR2016-01262 (Patent 7,764,777)²

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

PARVIS, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Request for Response to Supplemental Brief
37 C.F.R. § 42.5

¹ YMax Corporation is Petitioner in IPR2016-01258 and IPR2016-01260. Bright House Networks, LLC, WideOpenWest Finance, LLC, Knology of Florida, Inc., and Birch Communications are Petitioner in IPR2016-01261 and IPR2016-01262.

² This Order addresses the same issues in the cases listed above. Therefore, we issue one Decision to be filed in all of the cases.

IPR2016-01257, IPR2016-01260, IPR2016-01261 (Patent 8,457,113), IPR2016-01258, and IPR2016-01262 (Patent 7,764,777)

On November 21, 2017, counsel for Patent Owner requested a conference call to seek authorization to file a five page response to the supplemental briefing regarding motions to amend filed by Petitioners in each of IPR2016-01257, -1258, -1260, -1261, and -01262. The supplemental briefing was authorized in our Order of October 19, 2017, following a conference call held to give the parties an opportunity to discuss the impact of the Federal Circuit’s en banc decision in *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (“*Aqua Products*”). *See, e.g.*, Paper 57, 1–2.

In our Order of October 19, 2017, Petitioners were authorized to file a supplemental brief limited to the issue of unpatentability of the proposed substitute claims, addressing only original claim limitations not previously addressed by Petitioners. *See, e.g.*, Paper 57, 6. Additionally, Petitioners’ supplemental briefs were limited to the prior art in the record and could not exceed fifteen pages. *Id.*

In these proceedings, Patent Owner submitted requests for rehearing taking the position that Petitioners’ supplemental briefing is unwarranted because there is no intervening change in the law. *See, e.g.*, Paper 58, 4–7. We have responded to the contentions submitted by Patent Owner in full in our decisions denying Patent Owner’s requests. *See, e.g.*, Paper 61. At this stage in the proceedings, all briefs have been filed and the oral argument was conducted on September 19, 2017. Patent Owner already was allowed twenty-five pages for each of its motions to amend, as well as a claim listing contained in an appendix that did not count toward the page limit of the motion. *See, e.g.*, Paper 24, 2. Additionally, Patent Owner was allowed a

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twelve-page reply to each of Petitioner's oppositions to the motions to
amend. *Id.*

In view of the arguments presented by the parties during the
September 19, 2017 hearing and the conference call held October 19, 2017,
as well as the briefs already filed in these proceedings, we determine that no
further briefing by Patent Owner is warranted in these proceedings.

For the foregoing reasons, Patent Owner's request for authorization to
file responses to Petitioners' supplemental briefing is *denied*.

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IPR2016-01258, and IPR2016-01262 (Patent 7,764,777)

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