

Opposition to Patent Owner's Contingent Motion to Amend
IPR 2016-01262
U.S. Patent No. 7,764,777

IN THE 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

Before SALLY C. MEDLEY, JONI Y. CHANG, and BARBARA A. PARVIS,
ADMINISTRATIVE PATENT JUDGES.

**PETITIONERS' OPPOSITION TO PATENT OWNER'S CONTINGENT
MOTION TO AMEND**

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. SUMMARY OF THE UNPATENTABILITY GROUNDS.....	1
III. STANDARDS FOR A MOTION TO AMEND	2
IV. SUMMARY OF SUBSTITUTE CLAIMS	2
V. PATENT OWNER’S ARGUMENTS FOR PATENTABILITY OF SUBSTITUTE CLAIM 49.....	3
VI. ARCHER DISCLOSES THE ADDED FEATURE	5
VII. THE NEWLY CITED ART DISCLOSES THE ADDED FEATURE.	13
A. Lewis Discloses the Added Feature	13
B. LaPier Discloses the Added Feature	19
VIII. PATENT OWNER HAS NOT ATTRIBUTED PATENTABILITY TO ANY OF THE OTHER NEWLY ADDED LIMITATIONS	24
IX. CONCLUSION	25

PETITIONERS' OPPOSITION EXHIBIT LIST

Exhibit Number	Document
1001	U.S. Patent No. 7,764,777 (“the ’777 Patent”)
1002	Expert Declaration of Dr. Thomas F. La Porta
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
1057	U.S. Patent No. 6,442,169 to Lewis (“Lewis”)
1058	U.S. Patent No. 6,333,931 to LaPier (“LaPier”)
1059	May 8, 2017 Transcript of Deposition of Regis “Bud” Bates
1060	May 9, 2017 Transcript of Deposition of Regis “Bud” Bates
1061	March 1, 2017 Transcript of Deposition of Mr. Willis in IPR2016-01254, IPR2016-01257
1066	Expert Declaration of Dr. Thomas F. La Porta in Support of Opposition to Motion to Amend
1067	Claim Chart of Lewis Against Proposed Substitute Claim 49
1068	Claim Chart of LaPier Against Proposed Substitute Claim 49
2019	Deposition Transcript of Dr. La Porta, Feb. 24, 2017, for IPR 2016-01259, -01261, -01262, and -01263.
2020	Deposition Transcript of Dr. La Porta, Feb. 23, 2017, for IPR 2016-01259, -01261, -01262, and -01263.
2040	Expert Declaration of Regis “Bud” Bates in Support of Patent Owner’s Motion to Amend
2041	Section 112 Written Description Support for the Proposed Substitute Claim
2057	\$200 Billion Broadband Scandal, Bruce Kushnick, 2006
2061	Karen Kaplan, Can I Put You on Hold? Profits are Calling, Los Angeles Times, February 3, 1997
2062	Clean and Redlined Versions of the Proposed Substitute Claim

I. INTRODUCTION

Patent Owner filed a Contingent Motion to Amend (“Motion”) substituting Claim 49 for Claim 46 of U.S. Pat. No. 7,747,777 (“the ’777 Patent”). Petitioners hereby oppose this Motion because Patent Owner has not met its burden of showing that substitute Claim 49 is patentable. Patent Owner has not made the required showing that Claim 49 is patentable over the cited art, and cannot show that Claim 49 is patentable over newly cited U.S. Patent No. 6,442,169 to Lewis (“Lewis”) (EX1057) and U.S. Patent No. 6,333,931 to LaPier (“LaPier”) (EX1058). Accordingly, the Motion should be denied.

II. SUMMARY OF THE UNPATENTABILITY GROUNDS

The Board instituted the present trial on the following ground: Claims 18, 21, 23, 25, 26, 28-31, 37, 38, 41, 45, and 46 of the ’777 Patent are obvious over Archer (EX1003) in view of Chang (EX1004) and the knowledge and skill of a person of ordinary skill in the art (“POSA”).

In its Response, Patent Owner has asserted that Archer does not disclose a “controlling device” for several reasons:

- (1) There is no disclosure that server processor 128 performs the step of connecting the first and second calls nor how this step is performed; and

(2) There is no disclosure of a controlling device coupled to/in communication with a switching facility because Archer's gateways are edge devices not switching facilities (and thus necessarily connected to a PSTN edge switch).

Likewise, in the present Motion, Patent Owner makes arguments that overlap with its arguments in its Response regarding Archer with respect to substitute Claim 49, asserting that Claim 49 is patentable over all cited art (including Archer and Chang) because the cited art either discloses a tandem access controller or "TAC" (controlling device) external to the PSTN and thus necessarily connected to an edge switch of the PSTN, or (2) discloses a TAC (controlling device) internal to the PSTN that does not receive call requests or initiate call requests to establish a call.

Thus, Patent Owner's arguments for patentability of Claim 46 and substitute Claim 49 largely turn on the same issues.

III. STANDARDS FOR A MOTION TO AMEND

Under 37 C.F.R. §42.121, the patent owner has the burden to show its entitlement to the proposed claim amendments, including written description support in the original disclosure and patentability over the prior art. Patent Owner has failed to carry this burden.

IV. SUMMARY OF SUBSTITUTE CLAIMS

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