

Supplemental Brief in Response to Patent Owner's 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' SUPPLEMENTAL BRIEF IN RESPONSE TO PATENT
OWNER'S CONTINGENT MOTION TO AMEND**

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PETITIONERS' SUPPLEMENTAL BRIEF 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”)
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
1065	Expert Declaration of Dr. Thomas F. La Porta in Support of Reply to Patent Owner’s Response
1066	Expert Declaration of Dr. Thomas F. La Porta in Support of Opposition to Motion to Amend
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
2062	Clean and Redlined Versions of the Proposed Substitute Claim

I. INTRODUCTION

Petitioners submit this supplemental brief pursuant to the Board’s October 19, 2017 order to address “the issue regarding the unpatentability of the proposed substitute [Claim 49 of U.S. Pat. No. 7,764,777 (“the ’777 Patent”)]” and specifically to “address[] original claim limitations not previously addressed by Petitioners based on the prior art in the record.” Paper 65 (“*Aqua Order*”), 6.

A. Preliminary Matters

Petitioners contend that the Board’s March 21, 2017 order (Paper 29, 4-6) was correct that the burden of persuasion on the Motion to Amend (Paper 31) is properly *on the Patent Owner to show patentability* of Claim 49. In *Aqua Prods., Inc. v. Matal*, No. 2015-1177, 2017 WL 4399000 (Fed. Cir. Oct. 4, 2017), the Federal Circuit shifted this burden onto Petitioners to show *unpatentability*. Petitioners object to and reserve their rights to challenge the *Aqua* decision, and any reliance on that decision by the Board.

In order to preserve this right, Petitioners object to the *Aqua Order* (Paper 65, pp. 6-7) on the ground that: (1) in view of the absence of rules issued by the PTO addressing this burden, it is improper for the Board in the first instance to engage in rulemaking in the Order, and (2) it violates Petitioners’ due process rights. The *Aqua Order* does not account for the difference between the burden of showing *patentability* and *unpatentability*. In order to meet its burden of patentability,

Patent Owner needed only to identify a *single limitation* that is missing from the prior art. Under 37 C.F.R. §§ 42.20, 42.24 and 42.121, Patent Owner had 25 pages to argue the either of the *two* alleged limitations in Claim 49 were *missing* from the prior art, and the Board authorized Patent Owner to submit its §112 support in a separate chart. Paper 29, 2-7; Paper 31, 12-13, 22. On the other hand, for a petitioner to meet its burden of unpatentability, it needs to show where *every limitation* of a claim is found in the prior art. In light of these different burdens, it is improper and unduly prejudicial for the Board to issue a rule limiting Petitioners to only 15 pages for this Supplemental Briefing, especially while prohibiting them from: (1) using expert testimony, including in support of any *Graham* analysis, and (2) incorporating by reference arguments from prior briefing. *Aqua* Order, 5-7.

B. Petitioner’s Supplemental Briefing

In their Opposition (Paper 35), Petitioners addressed the two features that Patent Owner asserted were not found in the prior art. Per the Board’s *Aqua* Order, this Supplemental Briefing is directed to the remaining four limitations:

Proposed Substitute Claim 49 Limitation	Abbreviation
“A method for processing an incoming call from a particular PSTN tandem switch on a PSTN communication network using a tandem access controller”	“ <i>incoming call processing</i> ”
“wherein the PSTN communication network comprises edge switches connected to telephones on one side and PSTN tandem switches on the other side, wherein the PSTN tandem switches include the particular PSTN tandem switch, wherein the edge switches route calls within a local geographic area, wherein the PSTN tandem	“ <i>PSTN telecommunications network and switches</i> ”

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