

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COX COMMUNICATIONS, INC.
Petitioner

v.

AT&T INTELLECTUAL PROPERTY I, L.P.
Patent Owner

Case IPR2015-01227
Patent 7,907,714

Title: PROFILE MANAGEMENT SYSTEM INCLUDING USER INTERFACE
FOR ACCESSING AND MAINTAINING PROFILE DATA OF USER
SUBSCRIBED TELEPHONY SERVICES

AT&T'S PATENT OWNER RESPONSE

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I. Introduction.

AT&T Intellectual Property I, L.P. (“AT&T” or “Patent Owner”) submits the following Response to the Revised Amended Petition filed by Cox Communications, Inc. (“Cox” or “Petitioner”) on June 22, 2015, requesting *inter partes* review of claims 1-22 of U.S. Patent No. 7,907,714 (“the ’714 Patent”). Cox has not shown unpatentability of the claims by a preponderance of the evidence, as the allegedly anticipatory prior art either fails to disclose each and every feature of the independent claims (*Buhrmann*) or do not qualify as prior art (*An*). The obviousness grounds do not remedy the deficiencies of the allegedly anticipatory references.

In its Revised Amended Petition, Cox alleged that *Buhrmann* anticipates claim 1 and claim 13 (amongst others) of the ’714 Patent, and the Board instituted trial based on anticipation grounds as to claims 1-7, 12-17 and 20. Faced with a clear lack of evidence supporting disclosure of element [1c], the Board appears to have wandered into *obviousness-style* reasoning to explain its threshold determination that Cox had presented sufficient evidence to nonetheless institute trial. Regardless, the record is clear that trial has been instituted as to claims 1-7, 12-17 and 20 on *anticipation* grounds. Once the Board, having benefit of a now more complete record, (re)considers the actual express and inherent disclosure of *Buhrmann*, it will become clear that, amongst other things, *Buhrmann* does not

disclose “retrieving” as recited in element [1c] of claim 1, and accordingly, that *Buhrmann* does not, and indeed cannot, anticipate any of claims 1-7 and 12 (or claims 13-17 and 20, for which Cox relies upon similar “proofs”).

With respect to the *An* reference upon which trial was also instituted, Cox has failed to present evidence that *An* is entitled to the October 23, 1996 filing date of the *An Provisional*. A petitioner must show that the **claims** of a reference patent are supported by an earlier-filed provisional application in order for that reference patent to be entitled to that earlier filing date. *See Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1381-1382 (Fed. Cir. 2015). Cox has not shown support in the *An Provisional* for the claims of *An*, and without entitlement to the *An Provisional* filing date, *An* is not prior art, because on its face, *An* was filed well after the priority date of the '714 Patent. The *An Provisional* is also antedated by the inventors' actual reduction to practice of the '714 Patent's challenged claims. All *An*-based grounds necessarily fail.

Based on the scant evidence and argument that Cox has chosen to present in its Revised Amended Petition, and with the benefit of a now full record including AT&T's testimonial evidence of Dr. Robert Akl, the Board should now conclude that no claim on which trial has been instituted is, in fact, unpatentable. *See Trivascular, Inc. v. Samuels*, No. 2015-1631, 2016 WL 463539 at *9 (Fed. Cir.

Feb. 5, 2016). A final written decision confirming patentability of all challenged claims is respectfully requested.

II. Overview of the '714 Patent.

The '714 Patent discloses methods of providing customers the ability to access and maintain service profile data for a communications service. Ex. 1001, 3:49-67. The '714 Patent describes, for example, a method for accessing and maintaining profile data associated with a telecommunications service subscribed to by a user. Ex. 1001, 6:12-15. Subscriber profile data is stored on a communications network, which executes the telecommunications service in accordance with the subscriber profile data. Ex. 1001, 4:33-36. A client hosting a user interface allows the user to view and update the subscriber profile data. The subscriber profile data is retrieved from the telecommunications network via a server and forwarded to the client. The server receives client requests to update the profile data, such that a user can update his or her profile data without interacting with service personnel. Ex. 1001, 4:36-48.

III. Cox's Evidence and Arguments Do Not Establish Unpatentability.

The instituted grounds of unpatentability are simply not supported by evidence sufficient to demonstrate that the challenged claims are anticipated or obvious. *Buhrmann* does not disclose each and every feature of the independent claims (1 and 13) from which all other challenged claims of the '714 Patent

depend. Regarding *An*-based grounds, *An* was filed ***after*** the priority date of the '714 Patent and has not shown to be prior art to the '714 Patent, and accordingly all *An*-based grounds necessarily fail.

To be clear, Cox had and has the burden of going forward in its Petition with facts to shown that *An*, which it alleges to be a § 102(e) reference, has an effective reference date prior to the priority date of the '714 Patent. *Dynamic Drinkware*, 800 F.3d at 1381. That failure is fatal as Cox cannot now supplement its record in an attempt to carry, going forward, a burden it ultimately bears, but which it failed to carry in its Revised Amended Petition. In any case, AT&T's response herein, including evidence of prior actual reduction to practice, effectively forecloses even an attempt by Cox to untimely supplement its record.

For avoidance of doubt, and as preliminary matter, AT&T further maintains, as it argued in the Preliminary Response, that the *Buhrmann* and *An* anticipation grounds lack any argument, evidence and/or positions for element [1a] of claim 1 or element [13d] of claim 13. While the Board found portions of the preamble limiting, *see* Institution Decision, p. 16, the Board was apparently unwilling to assess the necessary consequence of that claim construction against Cox. The limitations of element [13d] are recited in the body of claim 13, and correspond to the limitations recited in the limiting preamble (element [1a]) of claim 1. Thus, when Cox, in proposing its rejection of claim 13, simply referred to its claim 1

“proofs” of element [1a] (which are facially and utterly nonexistent) for element [13d], its proofs for claim 13 necessarily must fail (regardless of the Board’s remedy of Cox’s case).

AT&T recognizes that the Board found it to be within its discretion to “understand” (for purposes of its threshold inquiry on institution) Cox to assert positions that, with respect, Cox did not itself advance in its Revised Amended Petition. However, as there are presently pending legal challenges regarding reviewability of decisions of the Board, and because the Board’s final written decision (unlike its institution) must necessarily be anchored in substantial evidence,¹ AT&T (re)states its opposition to any reliance by the Board (on institution or on final written decisions) on positions that were not, in fact, advanced by Cox in its Revised Amended Petition.

Indeed, at this stage, any failure of proofs is particularly notable because Cox cannot now remediate its record. Cox has gone forward with its proofs, and it is impermissible to submit evidence with a Reply that could have been submitted with the Petition. 37 C.F.R. § 42.23(b); Office Patent Trial Practice Guide, 77 Fed.

¹ *Belden Inc. v. BerkTek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015); *but cf. Merck & Cie v. Gnosis S.P.A.*, 808 F.3d. 829, 843 (Fed.Cir. 2015)(*reh ’g denied*) (Newman J. dissenting) (“the question ... is whether the preponderance of the evidence supports the PTAB’s decision.”).

Reg. 48,756, 48,767 (Aug. 14, 2012) (“Trial Practice Guide”). There is no question that evidence concerning the content of *Burhmann*’s disclosure (or indeed, *An*’s effective filing date) could have been submitted with the Petition. Cox cannot now, after the window for filing a motion to submit supplemental information under Rule 42.123(a) has closed and, indeed, after its witness has been deposed and AT&T has filed its Patent Owner Response, remediate its Revised Amended Petition.

Turning to the grounds on which the Board actually instituted trial (and even given the assertions the Board generously understood Cox to have made), Cox cannot show that *Buhrmann* anticipates claim 1 of the ’714 Patent. *Buhrmann* lacks disclosure of multiple features of claim 1. Indeed, consistent with the construction of claim features adopted by the Board in its Institution Decision, whereby limitation [1a], the preamble, is entitled to patentable weight, *Buhrmann* does not disclose: “**retrieving the subscriber profile data from the communications network based upon receiving the subscriber request to view the subscriber profile data from the client,**” “**forwarding the subscriber profile data to the client,**” or “**receiving a subscriber request to view the subscriber profile data from a client which hosts a user interface configured to allow the subscriber to view and update the subscriber profile data.**”

As before, *An* cannot anticipate the claims, because *An* is not prior art, and

neither anticipation, nor obviousness of claim 1 or 13 (or any challenged dependent claims) has been demonstrated based on *Buhrmann*. As a result, based on Cox's failure to demonstrate unpatentability by the statutorily required preponderance of the evidence, the Board should confirm all claims in its final written decision.

A. Dr. Mir's Opinion Should be Afforded No Weight

Cox relies heavily on Exhibit 1014, the Declaration of Professor Nader F. Mir, to support its positions that *Buhrmann* and *An* anticipate the claims of the '714 Patent. However, as exposed during his cross-examination, Dr. Mir's declaration is replete with errors and inconsistencies. Upon being informed of these errors, Dr. Mir suggested that such errors should have been expected. Based on the errors in Dr. Mir's deficient declaration, AT&T submits that his declaration should be afforded no weight.

First, Dr. Mir asserts in his declaration that "the relevant fields for the purposes of the '714 patent are the design and implementation of modems, routers, and cable systems." Ex. 1014, ¶ 33. However, when asked about the relevant fields of the patent during cross-examination, Dr. Mir testified that the '714 Patent does *not* relate to the design and implementation of modems and does *not* relate to the design and implementation of cable systems. Ex. 2042, 202:13-20, 205:2-7. AT&T's expert Dr. Akl agrees: the relevant field of the '714 Patent includes profile management systems for telecommunications services, not the design of

modems or routers. Ex. 2043, ¶ 38. Cox's expert cannot even correctly define the field of the '714 Patent. One must begin to question the sourcing and reliability of "Dr. Mir's" declaration.

Additionally, even Dr. Mir's overview and knowledge of telephone networks, a field more closely related to the '714 Patent, is deficient. In paragraph 39, Dr. Mir defines a "SSP" as a "signal transfer point." Ex. 1014, ¶ 39. When questioned about this definition, he admitted that "SSP" should have been written as "signal switching point." Ex. 2042, 65:3-11. But the self-styled "expert in the art" is even incorrect about that attempted correction. "SSP" is an acronym for "*service* switching point," as defined by the '714 Patent in its list of acronyms. Ex. 1001, 1:61. Dr. Mir's own textbook confirms this definition; *see* Ex. 2047, p. 5, raising once again questions of sourcing and reliability.

Furthermore, based on cross-examination, it is unclear whether Dr. Mir even understood the '714 Patent at all. Dr. Mir believes the patent "has confusing points." Ex. 2042, 166:10-11. He also stated that "the '714 has a number of confusing terms" including "profile management system," which is a term in both independent claims 1 and 13 of the '714 Patent, and indeed, part of the title of the patent itself. Ex. 2042, 78:16-18; 151:8-9. Yet inexplicably, notwithstanding that stated confusion, he was still able to come to multiple conclusions regarding anticipation and obviousness of claims that recited that term. Absent evidence that

Dr. Mir understands the '714 Patent or the terms of the claims challenged in this *inter partes* review, Dr. Mir's opinion should not carry any weight. Further, if Dr. Mir believed, for example, that "profile management system" had multiple meanings (as he testified, Ex. 2042, 151:8-12), a construction for the term should have been advocated by Cox, but the Board found that Cox failed to provide any claim construction. *See* Institution Decision, p. 14.

To be sure, Dr. Mir's opinions as to unpatentability are based on an extremely tenuous foundation, which the record and deposition testimony both suggest to be statements of Cox's counsel, rather than Dr. Mir's own independent evaluation of the '714 Patent and prior art. As one example relevant to the instituted grounds, Dr. Mir bases his opinion that claims 1-7, 12-17, and 20 are anticipated by *Buhrmann* on "ground B(1) in the claim chart of Table B in the IPR Petition, with which [he] agree[s]." Ex. 1014, ¶ 80. But Dr. Mir could not recall reviewing the final Petition filed by Cox. Ex. 2042, 31:8-16. His declaration was signed May 18, 2015; the first Petition was filed May 19, 2015. Ex. 1014, p. 51; Petition (Paper No. 2), Cover Page.

Significantly, Dr. Mir testified that: (1) the draft petition he reviewed "was not ready;" (Ex. 2042, 31:11-16) (2) he did not know who drafted the claim charts (Ex. 2042, 33:20-22); (3) he doesn't know if those claim charts were changed after he signed his declaration (Ex. 2042, 40:15-23); (4) he has not reviewed the original

petition filed by Cox to confirm he agrees (Ex. 2042, 42:19-23; 43:2-11); and (5) he has not reviewed the current, operative Revised Amended Petition (Ex. 2042, 43:12-44:2). *His declaration is based on claim charts in **draft** petitions.* Indeed Dr. Mir himself testified that he reviewed two or three versions, but Dr. Mir cannot confirm that he reviewed the Petition which his declaration states he agreed with. Ex. 2042, 213:23-214:16. Given the important questions in this proceeding regarding substantiality of evidence, AT&T requested those claim charts (Ex. 2042, 32:2-5, 84:5-7) and believes them to be routine discovery, ***but Cox refuses to produce them.*** Accordingly, Dr. Mir's declaration does not provide the "underlying facts or data on which the opinion is based" and accordingly his ***testimony is entitled to no weight.*** 37 C.F.R. § 42.65(a).

Dr. Mir also admits a substantive and rather critical error in the sole paragraph of his declaration cited in the Institution Decision relative to *Buhrmann*. Specifically, the final sentence in paragraph 80 of Dr. Mir's declaration states "[a] modem 138 ***retrieves*** the subscriber profile data..." Ex. 1014, ¶ 80. But in cross-examination, Dr. Mir now admits that a modem does not "retrieve" any data; it only "receives" data. Ex. 2042, 86:15-22. Although Dr. Mir characterized the use of the word "retrieve" as a "minor error[]," it is hard to imagine how a significant technical difference can be construed as a minor error. Ex. 2042, 111:2-22. Indeed, as will become apparent, the fact that *Burhmann* does not disclose the

recited “**retrieving** [of] the subscriber profile data from the communications network **based upon receiving the subscriber request to view the subscriber profile data from the client**” is dispositive.

Dr. Mir believes that AT&T and the Board “should expect” errors in his declaration. Ex. 2042, 111:2-11. Apparently, Cox’s expert would have the Board believe that, in a proceeding in which a patent owner’s property rights are being adjudicated, a certification that a declaration is “true and correct” has some gray area, and that “true and correct” does not really mean “true and correct.”

Finally, it is unclear whether Dr. Mir understands *Buhrmann* or general basic technological concepts of *Buhrmann*, such as the distinction between hardware and software. During cross-examination, Dr. Mir was emphatic that the term “client” has always meant “software.” Ex. 2042, 78:5-13 (“Client has always been a software ... If you use client in the context of computer communication, telecommunications, the client is defined as a software that requests a service.”). When asked what he identifies in *Buhrmann* as disclosing the “client” recited in claim 1, Dr. Mir stated: “[t]he client is Box 136.” Ex. 2042, 162:20-21. *Buhrmann* enumerates examples of user interface 136 as “a display monitor, printer, mouse, keyboard, light pen, touch pad, or the like,” that is, all **hardware** devices. Ex. 1004, 7:14-16. If Cox’s expert cannot be relied upon to distinguish hardware from software, the Board cannot rely on his testimony.

Because Dr. Mir's testimony is of questionable sourcing and lacks foundation, and given that his testimony suggests rather serious questions as to technical correctness and reliability, his declaratory "evidence" should be *afforded absolutely no weight* in this proceeding which seeks to adjudicate validity of AT&T's property rights.

B. *Buhrmann* Does Not Disclose the Features of Independent Claims 1 and 13, and Does Not Anticipate the Claims [Ground A].

Cox alleges the *Buhrmann* reference, U.S. Patent No. 5,903,845, anticipates claims 1-7, 12-17, and 20 and, in combination with various other references, renders obvious other challenged claims. Revised Amended Petition, pp. 31-40. However, for at least the following reasons, Cox has failed to show that *Buhrmann* explicitly or inherently discloses each and every feature of the claims, recited and arranged as in the claims. None of the secondary references cure these deficiencies in *Buhrmann* as to the independent claims, and accordingly, claims depending from claims 1 and 13 have also not shown to be unpatentable over *Buhrmann* and the secondary references.

1. *Buhrmann* Does Not Disclose the Features of Claim 1

a) *Buhrmann* Does Not Disclose Element [1c]

Element [1c] of claim 1 recites, *inter alia*, "retrieving the subscriber profile data from the communications network based upon receiving the subscriber request to view the subscriber profile data from the client." *Buhrmann* does not

disclose this feature of claim 1, because *Buhrmann* does not describe PIM 122, modem 138, or any other component retrieving (or for that matter, even receiving) any data from the wireless cellular communication network 102 of *Buhrmann* based upon receiving a subscriber request, nor does any other element or portion of *Buhrmann* disclose retrieval of subscriber profile data from the communications network based upon receiving a subscriber request to view the subscriber profile data from the client.

The Board correctly agreed with AT&T that portions of the preamble are limiting. Institution Decision, p. 16. Specifically, the Board agreed that “subscriber profile data being stored on a communications network which executes the communications service in accordance with the subscriber profile data” states necessary and defining aspects of the invention, including “the storage...of the ‘subscriber profile data.’” Institution Decision, pp. 15-16. Thus, each time claim 1 refers to “subscriber profile data,” it is referring to the subscriber profile data which is “stored on a communications network.” With this proper construction, *Buhrmann* simply cannot anticipate claim 1. AT&T first addresses the entirety of *Buhrmann* and how a properly informed analysis of *Buhrmann* reveals an inescapable lack of disclosure of element [1c]. AT&T then addresses Cox’s minimal record evidence and argument.

For clarity, exact terminology of *Buhrmann* and the ’714 Patent are used

herein. The terminology of *Buhrmann* includes: personal information data 127, schedule data 128, contact data 129, profile update data, subscriber profiles, subscriber profile records, subscriber profile database 118, and wireless cellular communication network 102. The terminology of claim 1 includes at least: subscriber profile data and communications network.

i. Burhmann's Operating Principle Differs from that of the '714 Patent Claims

The fundamental principle of operation of *Buhrmann* is different than that of claim 1 of the '714 Patent, and an understanding of *Buhrmann* using its terminology is instructive. *Buhrmann* describes a method of utilizing a subscriber's personal information manager software (e.g., a subscriber's calendar program), which itself stores personal information data (e.g., the subscriber's calendar appointments), to generate profile update data, which is supplied to, and used by, a component of a wireless cellular communication network to update the network's subscriber profile for the subscriber. Ex. 2043, ¶¶ 53-55.

In more detail, the subscriber of *Buhrmann* maintains ***personal information data***, such as ***schedule data*** describing timed events and ***contact data*** describing subscriber contacts, in a memory of a personal information manager or PIM. Ex. 2043, ¶ 53. If the subscriber wishes, the subscriber can utilize the ***personal information data*** in the memory of the PIM to generate ***profile update data***, which is ***transmitted to*** a wireless cellular communications network node (SCP 108). Ex.

2043, ¶¶ 54-55. A component of the wireless cellular communications network node (SCP logic 120 of SCP 108) recognizes the profile update data and uses the profile update data to update a **subscriber profile** (i.e., the data the Board understood Cox to assert constitutes the recited “subscriber profile data”) which is stored in a database 118. Ex. 1004, 9:19-22; Ex. 2043, ¶ 55. Thus, in *Buhrmann*, the data that the user views, interacts with, and directly updates is **personal information data** stored within a memory of the PIM. That memory, memory 126, which stores the personal information data, is **not** part of wireless cellular communications network 102; rather, it is part of PIM 122. Ex. 1004, Fig. 1; Ex. 2043, ¶ 53. The subscriber profiles, which the subscriber **does not** view or retrieve, are stored in database 118, which is part of wireless cellular communication network 102. Ex. 1004, Fig. 1; Ex. 2043, ¶ 55.

By contrast, in the '714 Patent's claim 1, the subscriber views subscriber profile data **stored on a communications network**. To accomplish this, the subscriber profile data is **retrieved** from the communications network **based on a subscriber request to view the data**, and **forwarded to a client configured to allow the subscriber to view the subscriber profile data**. An update to the subscriber profile data is received, and that update is forwarded to the communications network based upon receiving the subscriber's request to update the subscriber profile data. Ex. 2043, ¶ 36.

ii. *Because of the Difference in Operating Principle, Buhrmann does not “Retrieve” as Required by the Subject Claims*

A primary (and dispositive) difference between *Buhrmann* and claim 1 of the '714 Patent is that, in *Buhrmann*, there is no disclosure of retrieving subscriber profiles from database 118, and thus, no disclosure of “**retrieving** the subscriber profile data from the communications network” as recited, nor is there any reason to do so. Ex. 2043, ¶¶ 56-71.

In further detail, *Buhrmann* can be characterized as a one-way or “blind push” process for updating a subscriber profile. Ex. 2043, ¶¶ 44, 57. Using *Buhrmann*'s Fig. 3 (depicting “the steps of generating profile update data for use in updating the subscriber profile database”) as an example, the subscriber updates schedule data (step 302 and Fig. 4) and contact data (Fig. 11) resident on the PIM. Ex. 1004, 7:33-34. The schedule data and contact data are retrieved from their storage on the PIM 122 itself, i.e., memory 126. Ex. 1004, FIG. 1, 7:33-34; Ex. 2043, ¶ 53. Once the subscriber updates such personal information data on the PIM, the updated personal information data is stored in the memory 126 of the PIM. Ex. 1004, 7:46-48; Ex. 2043, ¶ 54. The PIM then asks the subscriber whether she would like to update the subscriber's telecommunication subscriber profile (step 304). Ex. 1004, 7:55-64; Ex. 2043, ¶ 54. If the subscriber chooses to do so (the “Yes” option in Fig. 3), the subscriber is presented with profile request fields (i.e., the text fields in column 502), which are added to the schedule display by the

PIM (Fig. 5). Ex. 1004, 7:62-8:9. The subscriber is not presented with any existing set of current profile requests or with any profile related data retrieved from database 118. Ex. 2043, ¶ 54. Indeed, no such retrieval would be expected given *Burhmann*'s blind push design in which updates are pushed without regard to the data or state that they may overwrite. Ex. 2043, ¶¶ 43, 55.

In *Burhmann*'s design, the subscriber can enter in profile requests (step 306) using those profile request fields. Ex. 1004, 8:15-37. Once the subscriber has done so, the PIM generates profile update data (step 308), using the PIM's subscriber profile update API 132. Ex. 1004, 8:37-54; Ex. 2043, ¶ 54. That profile update data is then *transmitted* (or "pushed"), using modem 138, *to the* SCP 108, using links 140 and 142 and PSTN 114 (step 310), which causes SCP logic 120 to update the subscriber profile in database 118. Ex. 1004, 9:14-26; Ex. 2043, ¶ 55.

Accordingly, data flows one way in *Buhrmann*: from the PIM 122 to the wireless cellular communication network 102. Ex. 2043, ¶ 57. Additionally, even the data that is sent to the communication network is not a subscriber profile, it is profile update data; thus, *Buhrmann* does not even disclose transmitting of a subscriber profile in the reverse direction (i.e., from client to server) of the direction recited in claim 1 (i.e., from server to client). Ex. 2043, ¶ 57. Specifically, *Buhrmann*'s disclosure of transmitting data is limited to *profile update data* being transmitted from the PIM 122, using modem 138, to the communication network

102. Ex. 1004, 7:21-22 (“modem 138 is used for *sending information* from the PIM 122 to the SCP 108 through the PSTN 114.”); Ex. 2043, ¶ 57.

Though modems are unquestionably *capable* of being used to receive data, there is simply *no express or inherent disclosure* of modem 138 *receiving* any data from the communications network 102, let alone “*retrieving* ... subscriber profile data ... based upon recei[pt of a] subscriber request ... from the client” as recited in claim 1 of the ’714 Patent. Ex. 2043, ¶ 62. Simply stated, the presence of a modem, conventional or otherwise, does not alter *Burhmann*’s blind push principle of operation.²

A person of skill in the art would understand and characterize *Burhmann* operating principle as a one-way or push process in which updates are pushed without regard to the data or state that they may overwrite. Ex. 2043, ¶ 58. Indeed, in its Summary of the Invention section, *Burhmann* describes “[a] personal

² In fairness, Cox does not appear to have even made this argument. Rather, it was the Board that volunteered this analysis. *See* Institution Decision, p. 21-22. With respect, AT&T must note that the Board’s views are not evidence and, to the extent that the Board sought to advocate (for Cox) a finding that *Burhmann*’s modem 138 *receives* or *retrieves* subscriber profile data based upon receipt of a subscriber request from a client, such a finding would be errant and would lack any evidence let alone any substantial evidence in Cox’s record.

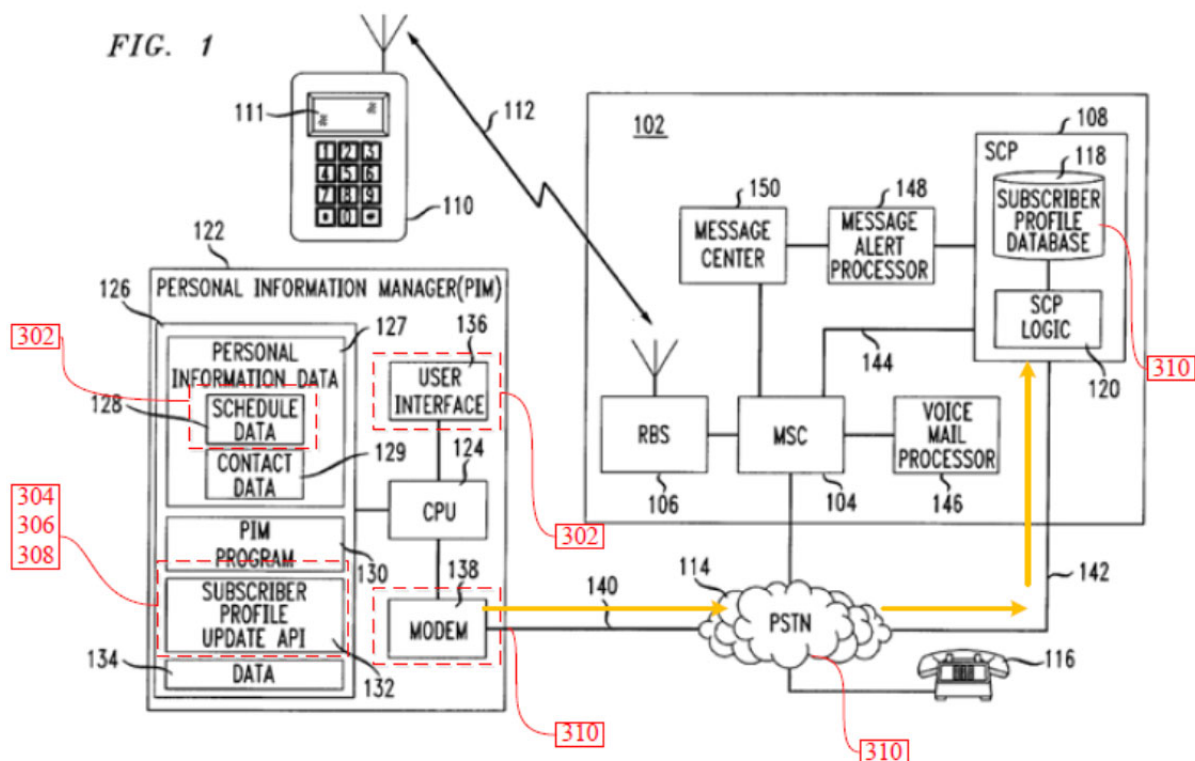
information manager (PIM) for **updating** a telecommunication subscriber profile based on subscriber personal information data entered into the PIM.” Ex. 1004, 3:43-45. Both experts agree; updating a data set does not require viewing the data set which is to be updated. Ex. 2042, 147:8-13, Ex. 2043, ¶ 58. Thus, the mere updating of a telecommunication subscriber profile in *Buhrmann* does not require viewing (which would entail retrieval) of that subscriber profile. Ex. 2043, ¶ 58. Indeed, contrary to the explicit language of claim 1, the subscriber in *Buhrmann* never **retrieves** a subscriber profile from the subscriber profile database 118. Ex. 2043, ¶¶ 59, 72. In *Buhrmann*, the subscriber has no occasion or need to do so, nor is there a facility disclosed for doing so, nor is such retrieval suggested. Ex. 2043, ¶ 57. The subscriber updates **schedule data** and **contact data** (which are part of **personal information data**), which are, again, stored on the PIM 122 itself in memory 126. Ex. 2043, ¶ 59. Dr. Mir agreed that if the subscriber is viewing information from the storage of the PIM, consistent with how *Buhrmann* operates, it is **not** retrieving information from the communication network. Ex. 2042, 148:13-23. Dr. Akl agrees. Ex. 2043, ¶ 60.

Furthermore, subscriber profile database 118 simply does not store personal information data 126; *Buhrmann* neither depicts this in Figure 1 or elsewhere, nor does it describe such a possibility. Ex. 2043, ¶¶ 46, 53. Thus, there is no need for the subscriber to retrieve data to be viewed from the subscriber profile database

118. The data to be viewed at PIM 122 is already present on PIM 122. Ex. 2043, ¶ 60. Therefore, *Buhrmann's* updating of a telecommunications subscriber profile does not involve or require viewing the subscriber profile, and accordingly *Buhrmann* does not involve, require, disclose, or even suggest retrieving the subscriber profile data from the communication network as recited in the '714 Patent claims.

iii. *Proper Interpretation of Burhmann's own FIG. 1 Confirms Absence of "Retrieval" as Claimed*

Consistent with the overview of *Buhrmann's* Figure 3 described above, Dr. Akl has annotated Figure 1 of *Buhrmann* to highlight (in red) the components of the block diagram which are implicated in each step of Figure 3 and the flow of data in Figure 3. Ex. 2043, ¶ 63, p. 30. As shown in Dr. Akl's annotated Figure 1, the subscriber profile database 118 of *Buhrmann* is only implicated or referred to in *Buhrmann* as part of step 310, which is described as "**Send** Profile Update Data **To** Database." Ex. 1004, Fig. 3. Furthermore, the profile update data flows only one way, as annotated by the orange arrows: from PIM 122, using modem 138 and links 140 and 142, to subscriber profile database 118. Ex. 1004, 7:21-22.



Ex. 2048 (annotating Ex. 1004, FIG. 1)

Thus, a careful review of Fig. 1 and *Burhmann*'s disclosure reveals that there is no disclosure of retrieval of subscriber profile data from a communications network within Fig. 3 of *Burhmann* (nor any other portion). Dr. Akl's careful review of *Burhmann* here stands in sharp contrast to the unreliable, errant, and questionably sourced testimony procured by, and relied upon, by Cox.

In contrast with *Burhmann*, claim 1 of the '714 Patent involves a two-way, or "pull and push" updating process. In claim 1, a request to view the subscriber profile data is received from a client which hosts a user interface configured to allow the subscriber to view the subscriber profile data. In response, the subscriber profile data is retrieved ("pulled") from the communications network where it is

stored, and forwarded to the client. Ex. 2043, ¶¶ 36, 40. After the subscriber requests an update to the subscriber profile data, that update is received and forwarded (“pushed”) to the communications network for storage. Ex. 2043, ¶¶ 36, 40.

If *Buhrmann* were a two-way process like claim 1, and actually retrieved subscriber profiles from the communications network for viewing prior to updating that data, one of ordinary skill in the art would expect *Buhrmann* to disclose such a step prior to step 302 of Fig. 3. But *Buhrmann* does not disclose such a step or a facility to do so. Ex. 2043, ¶ 59.

Further supporting the correct conclusion that the PIM 122 does not retrieve subscriber profiles from the subscriber profile database 118 of *Buhrmann* is the fact that the data of record (i.e., data actually useful to the subscriber) for the subscriber’s personal information data is stored on the PIM itself, and the data in the subscriber profile database is not an exact copy of the data on the PIM. Ex. 2043, ¶ 64. *Buhrmann* states: “the subscriber’s telecommunication profile *closely corresponds* to the subscriber’s actual schedule.” Ex. 1004, 4:38-39 (emphasis added). Thus, any retrieving of subscriber profiles from the database 118 for viewing would have the marked disadvantage of not being a complete copy of the subscriber’s actual schedule, as that data only “closely corresponds.” In short, in systems such as *Burhmann*’s, in which the primary and complete copy of schedule

data resides at the PIM, there would be no reason to retrieve schedule data from the subscriber profile database 118, which would be incomplete data. Ex. 2043, ¶ 64.

This close (though incomplete) correspondence of data sets in *Burhmann* is confirmed by a comparison of its depiction of schedule data and a subscriber profile record. FIG. 4 (the data on the PIM) depicts a schedule display of the subscriber's schedule data, FIG. 6 depicts an example subscriber record in database 118. In FIG. 4, the user has a "Description" field with text like "Meeting with John in Room 4A" from 9:00 AM to 11:00 AM. Ex. 2043, ¶ 65. The subscriber profile record in FIG. 6 contains no such "Description" field nor does it contain analogous text: the subscriber profile record contains only feature invocations and a start/end time for each feature invocation. Ex. 2043, ¶ 65.

Additional support for the conclusion that there exists no reason to retrieve subscriber profile data is evident from the format of the subscriber profile record. The format of a subscriber profile record is depicted in Fig. 2; such a record contains, for example, the subscriber's mobile telephone number, a serial number, and feature entries. Ex. 1004, Fig. 2. 6:13-36; Ex. 2043, ¶ 65. But the subscriber would not need to retrieve the mobile telephone number and serial number of its own telephone. Moreover, as described above with reference to Fig. 4 and Fig. 6, retrieving this information from the communication network would lead to an incomplete data set. Ex. 2043, ¶ 65. In any case, and for avoidance of doubt, none

of this data is disclosed as being retrieved from the communications network for presentation at any time on the PIM 122. Ex. 2043, ¶ 65.

As mentioned above, the subscriber profile data is in a different format than the subscriber's schedule data or contact data. *Buhrmann* explains that, once schedule data is updated along with profile request fields, profile update data is generated "by the subscriber profile update API 132", in one embodiment, in a TCAP message form. That TCAP format of the data is then transmitted to the communications network 102 for recognition by SCP 120, which in turn stores data as the format of Fig. 6. Ex. 2043, ¶ 57. If *Buhrmann* disclosed retrieval **from** the communications network, one would expect that *Buhrmann* would explain a procedure for generating schedule data or contact data from a subscriber profile record, but it does not disclose such a procedure, nor would one of ordinary skill in the art understand such a procedure to be inherently disclosed by *Buhrmann*.

Additionally, if retrieval of subscriber profile data were disclosed in *Buhrmann*, one would expect discussion in *Buhrmann* for synchronizing the contents of the subscriber profile database 118 and the personal information data 127 or similar concepts. Again, there is not, because *Buhrmann* does not disclose retrieval of any data from the communication network 102 by the PIM 122.

iv. *Cox's Alleged Proofs do not Withstand Scrutiny or Cross-Examination*

Turning to the minimal proofs that Cox has actually offered, the Board

found in the Institution Decision that “Buhrmann’s subscriber profiles stored in database 118 constitutes the claimed ‘subscriber profile data,’ and Buhrmann’s wireless cellular communication network 102 constitutes the claimed ‘communication network.’” Institution Decision, p. 19. Dr. Mir confirms that, to the extent *Buhrmann* discloses “subscriber profile data” of claim 1, it does so in its subscriber profiles stored in “subscriber profile database 118.” Ex. 2042, 162:25-163:9. Thus, for Cox to have presented sufficient evidence to show *Buhrmann* discloses retrieval of subscriber profile data, Cox must have shown *Buhrmann* discloses retrieval of information from database 118. But as its only evidence in Table B for element [1c], Cox cites discussion of “user interface 136” of PIM 122 which “allows the subscriber...to view, enter and update ***personal information data 127***...” Revised Amended Petition, p. 34; *citing* Ex. 1004, 7:13-22.

The user interface of *Buhrmann* does not allow updating or viewing of *Buhrmann*’s subscriber profiles (i.e. the allegedly equivalent “subscriber profile data”). Ex. 2043, ¶ 67. Nor does this quotation discuss ***retrieval*** of subscriber profiles, it only mentions ***updating*** of “personal information data.” Ex. 2043, ¶ 67. Dr. Mir confirms that the quotation cited by Cox in its Petition does not explicitly show retrieving information from the communication network. Ex. 2042, 137:2-12. Viewing, entering, and updating personal information data 127 in *Buhrmann* does

not require retrieval from the wireless cellular communications network, as such data is already stored on the PIM 122. Ex. 2042, 127:13-16; Ex. 2043, ¶ 60.

Personal information data 127 is not, cannot be, and indeed has not been shown by Cox to be, one and the same as subscriber profiles stored in database 118, or “subscriber profile data” stored in a communication network as recited. Ex. 2043, ¶¶ 64-65. Furthermore, the relied upon portion of *Buhrmann* does not even discuss “retrieving...***from the communications network***” as recited in the claim. Thus, the evidence presented in Table B cannot show disclosure of element [1c].

v. *Cox's Own Expert Confirms Patent Owner's Positions*

Dr. Mir agreed that it was “absolutely possible” that “information is simply retrieved from the PIM and not the communication network, updated and then transmitted to the database without ever having received anything from the communication network.” Ex. 2042, 148:18-23. This *possibility* (as Dr. Mir would have it) could, perhaps more candidly be described simply as the way the *Buhrmann* system is described and operates, as detailed above, as supported by Figure 3, and as confirmed by Dr. Akl's annotations and analysis. The schedule data 128 is retrieved from the memory 126 of the PIM 122, updated (302), profile update data is generated (304, 306, 308), and then profile update data is transmitted (310) ***to the database 118*** on the wireless cellular communications network 102. Ex. 1004, Fig. 3.

Dr. Mir also confirms that *Buhrmann*, at least from Figure 1, “doesn’t show anything other than PIM that provides data to modem.” Ex. 2042, 90:23-91:3. Thus, Dr. Mir confirms that the modem of *Buhrmann* does not receive subscriber profile data from the communications network 102 according to Figure 1. With respect to *Buhrmann* as a whole, Dr. Mir was repeatedly asked if *Buhrmann* discloses that data, or subscriber profile data, is received by the modem, and answered negatively in various forms, stating “I haven’t found that one yet” or “So far I haven’t found explicit mention of receiving data from PSTN to modem” or “I found no explicit disclosure of the fact that the modem 138 receives any signal from the PSTN.” Ex. 2042, 94:17-25, 95:2-25, 96:25-13.

Dr. Mir also agrees that the information in Figure 6 of the *Buhrmann* reference, that is, the “subscriber profile data,” is information that the subscriber would not see. Ex. 2042, 237:19-25. If the subscriber would not see such data, there is no need to retrieve such data from the communications network and therefore no disclosure of retrieving such data as recited in claim 1.

vi. *Instituted Grounds for Independent Claims 1 and 13 are Anticipation, not Obviousness*

The Board, in its attempt to remedy Cox’s failings, cited case law in the Institution Decision as instructing that “[a] prior art reference must be considered for everything it teaches by way of technology.” Institution Decision, pp. 21-22, citing *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985).

With respect, this citation is legally erroneous and inapplicable: *EWP Corp.* dealt with a finding of ***obviousness*** under Section 103. 755 F.2d at 905-908 (“The Obviousness Question”). ***Anticipation*** was not implicated or discussed. Thus, what a reference “teaches by way of technology” has no applicability to the contention that *Buhrmann* anticipates claim 1. Even though *Buhrmann* states “[t]he use of a modem for communication with external devices is well known and will not be described in detail herein,” for a finding of ***anticipation***, *Buhrmann* must disclose retrieval of subscriber profile data from the communications network. This singular statement relating to the capabilities of a modem does not rise to the level of ***anticipation*** of element [1c].

To anticipate, the reference must explicitly or inherently ***disclose*** the features of the claim. Explicit disclosure is not shown. Inherent disclosure has not been alleged, nor is it ***necessarily present*** in *Buhrmann* that subscriber profile data is retrieved from the communications network. Dr. Mir confirms that the modem does not “necessarily retrieve data” (Ex. 2042, 87:20-22) and thus it is not inherent that modem 138 retrieves subscriber profile data. Indeed, even assuming the modem 138 is used to retrieve or receive data from the communications network 102 via PSTN 114, that data may be, for example, voice mail data or message data from the message center 150. It is not necessarily true that the data retrieved or received by modem 138 is “subscriber profile data.” Inherency cannot be

established by possibilities or probabilities. Dr. Mir confirms the lack of inherent disclosure: “So, for example, the modem can receive data. What kind of data? I mean, there’s no mention of it...” Ex. 2042, 93:21-23.

The Board also incorrectly alleged that other disclosures in *Buhrmann* “would support a finding that PIM 122 retrieves subscriber profile database 118.” Institution Decision, p. 22. The Board pointed to Figures 4 and 5 of *Buhrmann* which allegedly “illustrate that PIM retrieves schedule data 128 and contact data 129.” *Id.* But the only way such a conclusion can be reached is by ignoring the language of the claim and the claim construction the Board adopted: the subscriber profile data of claim 1 must be stored on a communication network. Schedule data 128 and contact data 129 are stored on PIM 122, not the communication network. Cox’s expert identifies *Buhrmann*’s disclosure of the “communication network” of claim 1 as element 102. Therefore, schedule data 128 and contact data 129 are not “stored on a network” even according to Cox’s expert, and thus, PIM 122’s “retrieval” of such schedule data 128 and contact data 129 from memory 126 does not support the conclusion that *Buhrmann* discloses retrieval of subscriber profile data *from a communications network* as recited. Ex. 2043, ¶¶ 59-60, 66-68.

Dr. Mir also confirmed that there is no disclosure in the *Buhrmann* reference that states the data in *Buhrmann*’s Figure 4 is received from the communications network. Ex. 2042, 213:10-14. Nor would there be: Figure 4 is an “example

schedule display 400” generated from data in memory 126 on PIM 122. Ex. 2043,

¶ 66. Figure 4 does not depict data retrieved from a communications network.

Likewise, Figure 5 is “a display 500” “presented [] through the user interface 136” which is “added to the conventional scheduling display 400 presented by the PIM 122.” Thus, again, *Buhrmann*’s Figure 5 does not depict data retrieved from a communications network. Ex. 2043, ¶ 66.

Dr. Mir also effectively recanted his second sentence of paragraph 80, in which he alleges “*Buhrmann* discloses receiving from a client, via ‘profile request field 502,’ a request to view subscriber profile data...” Ex. 1014, ¶ 80. When asked if *Buhrmann* contained a disclosure that the profile request field 502 is a request to the subscriber profile database to send subscriber profile data to the client, he stated that there was not any explicit answer to that question in the *Buhrmann* reference:

Q. Is there a disclosure in the *Buhrmann* reference that the profile request field 502 is a request to the subscriber profile database to send subscriber profile data to the client, even though the client, according to Figure 5, already has the subscriber profile data? It’s a yes-or-no question.

A. I don’t think there is any explicit answer to your question in the patent.

Ex. 2042, 210:23-211:7. Additionally, Dr. Mir testified that profile request field 502 of *Buhrmann* is merely a text field, and that Figure 5 is “an example of PIM scheduled display with an added profile request field” and “that’s the display from the PIM.” Ex. 2042, 208:10-20. Further, as described in detail here, “schedule data” or “telephone numbers of authorized or unauthorized users” is “personal information data,” not “subscriber profile data.” Ex. 2043, ¶ 46.

The Board also concluded, in support of Cox’s contentions, that “personal information data 127 *is associated with* updated subscriber profile data.” Institution Decision, p. 21. With respect, whether one set of data is *associated* with another set of data has no relevance to the question of disclosure or anticipation. While personal information data 127 is used to update subscriber profile data stored in database 118, a mere “association” of such data does not rise to the level of an anticipating disclosure of “retrieving subscriber profile data from a communications network” as recited.

Additionally, for personal information data 127 to be associated with updated subscriber profile data, it must be generated into profile update data by the subscriber profile update API 132, sent to the SCP 108, recognized by SCP logic 120, and used by SCP logic 120 to update the appropriate subscriber profile record in database 118. Ex. 2043, ¶ 69. Thus, the personal information data 127 is associated with updated subscriber profile data in the same way that a tomato on a

vine is associated with a bottle of ketchup in a restaurant. There is some relation between the two concepts, but going from one to the other requires multiple steps, transformations, and changes in location, and one cannot reasonably say that the proffered association supports a finding of an anticipating disclosure.

vii. *Buhrmann's Modem 138 Simply Does not "Retrieve"*

During cross-examination, Dr. Mir agreed that *Buhrmann* does not disclose that the modem receives any information from the PSTN, and he could not find disclosure that *Buhrmann's* modem 138 received data from the PSTN. Ex. 2042, 94:17-25, 95:2-25, 96:25-13. That should come as no surprise to a person of ordinary skill in the art. While a modem is, in general, capable of receiving data, one would not expect *Buhrmann's* modem 138 to be employed to receive subscriber profiles in the context of the blind push system that *Buhrmann* actually describes. Accordingly, *Buhrmann* does not, expressly or inherently, disclose "retrieving subscriber profile data from the communications network" as recited in claim 1.

Cox's sole testimonial "evidence" that Cox offered for the proposition that *Buhrmann* discloses "retrieving the subscriber profile data" appears in the last sentence of paragraph 80 of Dr. Mir's declaration, and has now effectively been *recanted*. For the following reasons, it is also insufficient to establish disclosure of that element of claim 1. *First*, the sentence is not a direct quote from *Buhrmann*

and, indeed, such language simply does not exist in *Buhrmann*. Ex. 2043, ¶ 68.

Second, Dr. Mir admits that the sentence is technically incorrect: modems do not retrieve data, and thus Dr. Mir believes the sentence should read “modem 138 receives the subscriber profile data.” Ex. 2042, 85:7-9, 86:15-22. Third, Dr. Mir admits that the first relied-upon citation (from 3:54-4:4) does not disclose retrieval as recited. Ex. 2042, 169:5-11. Fourth, the next relied-upon citation (from 7:36-39), recites, in full: “In general, the subscriber is provided with a schedule display for a chosen day via the user interface 136.” Ex. 1004, 7:36-39. This citation clearly does not support “retrieving the subscriber profile data from the communications network” at least because schedule data is contained on the PIM 122 itself as schedule data 128 stored in memory 126, which would not require retrieval from a communications network. Ex. 2042 at 148:13-23, Ex. 2043, ¶ 68. Fifth, the final textual citation of *Buhrmann* (from 7:13-22) is reproduced in full here:

“The CPU 124 is also connected to a user interface 136, which allows for subscriber interaction with the PIM. Such a user interface 136 may be, for example, a display monitor, printer, mouse, keyboard, light pen, touch pad, or the like. Further, user interface 136 may include a combination of such devices. The user interface 136 allows the subscriber who is using the PIM 122 to view, enter and update personal information data 127 and otherwise interact with the PIM 122. The modem 138 is used for sending information from the PIM 122 to the

SCP 108 through the PSTN 114.”

Ex. 1004, 7:13-22. Again, this citation does not support “retrieval” at least because it only describes that the modem 138 is used for *sending information*, not receiving or retrieving. Ex. 2043, ¶ 68. Also, viewing, entering, and updating personal information data 127 does not require retrieval of subscriber profile data from a communications network, because personal information data is not subscriber profile data, and because personal information data 127 is stored within memory 126 of the PIM 122 itself. Ex. 2042 at 148:13-23. It is not stored on a communication network.

Sixth, and finally, Dr. Mir was asked if *Buhrmann* describes the modem receiving anything from the PSTN. His answer: “As you notice here, that I read, that no, it doesn’t say anything further what modem, it doesn’t say anything.” Ex. 2042, 92:6-14. Stated more directly, that answer would appear to be *no*.

Thus, instead of being arranged as alleged, or disclosing “retrieving” as recited, *Buhrmann* only states that “modem 138 is used for *sending* information *from the PIM 122 to the SCP 108 through the PSTN 114.*” Ex. 1004, 7:13-22 (emphasis added). Thus, PIM 122 does not “retriev[e] the subscriber profile data *from the communications network*” using modem 138. Indeed, *Buhrmann* only describes the *transmission of information to* the SCP 108 (e.g., the sending of updates, etc.); the reference *never describes retrieval from* SCP 108 (whether by

modem 138 or otherwise) of subscriber profile data. This is, of course, entirely consistent with *Buhrmann*'s blind push principle of operation: *Buhrmann* has no need to discuss retrieval or receiving of information from the communications network, as *Burhmann* does not use such information. Consistent with that blind push principle of operation, *Buhrmann* never discusses transmitting any information *from* the SCP 108 or subscriber profile database 118 *to* PIM 122, the alleged client.

One final portion of *Burhmann* bears attention. Cox and Dr. Mir do not cite this portion of *Buhrmann* to establish disclosure of element [1c], but even this sole use of the word “retrieve” in *Buhrmann* does not support “retrieving the subscriber profile data from the communications network based upon receiving the subscriber request to view the subscriber profile data from the client” as recited. In column 10, line 47-58, *Buhrmann* states:

“a call is placed from landline telephone 116 to mobile station 110. In step 704 the call is routed through the PSTN 114 to the MSC 104...the MSC 104 sends a query to database 118 via link 144 requesting the subscriber profile record of the subscriber associated with mobile station 110. The SCP logic 120 is configured to receive the request, retrieve the subscriber profile record 600 from the database 118, and send the subscriber profile record 600 containing the subscriber profile data to the MSC 104.”

Ex. 1004, 10:47-58.

It is perhaps not surprising that Cox refrains from raising this passage since it **does not** implicate the PIM which Cox must rely on as “the client.” However, for completeness, and in view of the Board’s history in this proceeding of positing unargued positions and “understanding” them to have been asserted or intended by Cox, AT&T preemptively debunks as follows.

Even considering this unargued portion of the reference, *Buhrmann* still fails to disclose element [1c] of claim 1. First, the “retrieval” of the subscriber profile record in this portion of *Buhrmann* is not “based upon receiving the subscriber request...***from the client.***” Instead, the retrieval occurs in response to a call placed from a telephone 116 to the mobile station 110, and neither element of *Buhrmann*’s system corresponds to the “client” of claim 1. Ex. 2043, ¶ 70. Second, the “retrieval” is not “based upon receiving the subscriber request ***to view the subscriber profile data.***” Instead, the retrieval occurs so that *Buhrmann*’s MSC 104 can, for example, “determine that FEATURE-2 606 is active” and route calls in accordance with that instruction. Indeed, the retrieval occurs during “call processing” when “a call is placed from landline telephone 116 to mobile station 110.” Ex. 1004, 10:45-61. In addition, it is clear that the data is retrieved by SCP logic 120 and only used by MSC 104. Accordingly, there is no disclosure of that data being transmitted to, or retrieved by, anything except for MSC 104.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Here, the MSC 104’s retrieval of a subscriber profile record simply does not correspond to element [1c] in which retrieval of subscriber profile data is ***based upon a subscriber request to view the subscriber profile data from the client***, and therefore (even considering this additional portion of the reference, not relied upon by Cox) *Buhrmann* still does not disclose this claim element.

Cox has not identified anything in *Buhrmann* that explicitly discloses retrieval of subscriber profile data from a communications network. The Board could not identify anything in *Buhrmann* that explicitly discloses retrieval of subscriber profile data from a communications network. Dr. Mir could not identify such disclosure during deposition. In its Reply, Cox will be unable to identify such disclosure. This should come as no surprise, as *Buhrmann* simply fails to disclose retrieval of subscriber profile data from a communications network based upon a subscriber request to view the subscriber profile data from the client.

The overwhelming evidence of record supports the conclusion that *Buhrmann* does not disclose “retrieving...” as recited. No amount of rewriting the reference, application of incorrect legal analysis, or unreliable “expert” testimony from Dr. Mir, can change that conclusion. *Buhrmann* simply has no disclosure of retrieving subscriber profile data from the communications network based upon

receiving the subscriber request to view the subscriber profile data from the client.

Accordingly, because *Buhrmann* does not disclose element [1c] of claim 1,

Buhrmann cannot anticipate claim 1.

b) *Buhrmann* Does Not Disclose Element [1d]

It follows that, because *Buhrmann* does not disclose “retrieving the subscriber profile data from the communications network” as recited in element [1c], *Buhrmann* cannot disclose “forwarding the subscriber profile data to the client.” Again, *Buhrmann* never discloses the retrieval of any subscriber profiles in database 118 from the communications network 102. It is simply silent on this point, and inherent disclosure is neither alleged nor supported. Because *Buhrmann* does not retrieve the subscriber profile data from the communication network, there can be no disclosure of forwarding such unretrieved subscriber profile data. Even in *Buhrmann*’s description of the MSC 104 “retrieving” subscriber profile data, that data is not forwarded or otherwise transmitted “to the client” as recited. Ex. 2043, ¶ 72.

Thus, at least because *Buhrmann* does not disclose “retrieving the subscriber profile data from the communications network,” *Buhrmann* also does not disclose “forwarding the subscriber profile data to the client,” and for this additional reason as well, does not anticipate claim 1.

c) *Buhrmann* Does Not Disclose Element [1b]

Again, as properly construed, the “subscriber profile data” is stored on a communications network. With this proper construction, *Buhrmann* also cannot disclose element [1b] of claim 1. Element [1b] recites “receiving a subscriber request...from a client which hosts a user interface ***configured to allow the subscriber to view and update the subscriber profile data.***” *Buhrmann*’s user interface does not allow the user to “view...the subscriber profile data.” As detailed above, the data that the user views and interacts with is personal information data 127 stored on memory 126 of *Buhrmann*. Ex. 2043, ¶ 53. *Buhrmann* does not disclose or otherwise support viewing of subscriber profiles in database 118. Ex. 2043, ¶ 67. Thus, because *Buhrmann*’s user interface is not “configured to allow the subscriber to view...the subscriber profile data,” *Buhrmann* cannot disclose element [1b] of claim 1, and does not anticipate the claim for this additional reason.

d) *Buhrmann* Does Not Disclose Element [13c]

Cox relies on its explanation and citation to *Buhrmann* in element [1c] of Table B to show that the reference allegedly discloses element [13c], which recites, *inter alia*, “the profile management system being configured to forward the subscriber profile data to the client when the profile management system receives the subscriber profile data.” Revised Amended Petition, p. 38. However, because *Buhrmann* does not disclose element [1c], Cox’s evidence as to element [13c] is

also insufficient. Accordingly, because *Buhrmann* does not disclose element [13c], *Buhrmann* does not anticipate claim 13.

e) *Buhrmann* Does Not Disclose Element [13b]

Cox relies on its explanation and citation to *Buhrmann* in element [1b] of Table B to show that the reference allegedly discloses element [13b], which recites, *inter alia*, “receiving, ***from a profile management system***, a subscriber request to view the subscriber profile data.” Revised Amended Petition, p. 37. However, Cox entirely fails to account for the differences in claim language between the two claims, and identifies no portion of *Buhrmann* as disclosing the receipt of a subscriber request “from a profile management system.” It is unclear what element or perhaps combination of elements Cox identifies as the “profile management system.”

Without citing to any evidence of record, the Board, in the Institution Decision, “underst[ood] Cox to assert that *Buhrmann*’s PIM 122 constitutes the claimed ‘profile management system’...” Institution Decision, p. 23. Dr. Mir does not understand the claim term, but he also disagrees with the Board’s understanding: he testified during deposition that the “profile management system” disclosed in *Buhrmann* includes PIM 122, PSTN 114, and wireless cellular communication network 102. Ex. 2042, 162:6-11; Ex. 2040 (blue highlighting). Thus, it is still unclear what Cox identifies as the claimed “profile management

system” of claim 13, which cannot support a finding of anticipation by a preponderance of the evidence.

Further, element [13b] recites in part, like element [1b] “based upon the profile management system receiving the subscriber request to view the subscriber profile data from *a client which hosts a user interface configured to allow the subscriber to view* and update *the subscriber profile data*.” Assuming the Board’s identification of PIM 122 is correct, the PIM 122 does not host a user interface configured to allow the subscriber to view subscriber profile data, as there is no facility to retrieve or receive subscriber profiles from database 118 in *Buhrmann* for at least the reasons detailed above.

Thus, Cox has failed to show that *Buhrmann* discloses each and every feature of claim 13, and therefore *Buhrmann* cannot anticipate the claim.

f) The Petition Fails to Show Disclosure of Element [13c]

Element [13c] recites, in part, “the profile management system being configured to forward the subscriber profile data to the client when the profile management system receives the subscriber profile data.” Again, without a clear identification of what the “profile management system” is, Cox cannot show unpatentability by a preponderance of the evidence. As before, Cox only refers back to its proofs of elements [1c] and [1d] to support disclosure of this claim

element. But as shown above, *Buhrmann* does not disclose “retrieving” as recited in element [1c], and does not disclose “forwarding” as recited in element [1d].

Accordingly, Cox cannot show disclosure of element [13c] by a preponderance of the evidence, because it has not shown “when the profile management system receives the subscriber profile data” at least because PIM 122 (again, identified by the Board as the “profile management system”) never receives any subscriber profile data. If the PIM 122 never receives any subscriber profile data, Cox cannot show disclosure of “the profile management system being configured to forward the subscriber profile data” that it does not receive. Thus, because Cox has not shown disclosure of element [13c] of claim 13, Cox has not shown *Buhrmann* anticipates claim 13 for this additional reason.

2. Grounds B-D Do Not Show a *Prima Facie* Case of Obviousness

Cox alleged various obviousness combinations for claims dependent from independent claims 1 and 13, using the secondary references *Boulware*, *Bayless*, and *Beck*. However, Cox fails to demonstrate how any of the proposed secondary references teach the features of elements [1c], [1d], [1b], [13b], [13d], and [13c] addressed above, features which are not disclosed by *Buhrmann*. Accordingly, Grounds B-D cannot show by a preponderance of the evidence that claims 8-10, 14-15, 18-19, and 21-22 are unpatentable as obvious.

Further, the Board instituted trial on the ground that claims 8-9 and 18-19

were obvious over the combination of *Buhrmann* and *Boulware*, claims 14-15 and 21-22 were obvious over the combination of *Buhrmann* and *Beck*, and claim 10 was obvious over the (contextually-derived) combination of *Buhrmann*, *Boulware*, and *Bayless*. Institution Decision, p. 26. The Board confirmed that Cox's alleged reasons to combine the references are based on Dr. Mir's declaration. Institution Decision, pp. 26, 29-30. However, as established above, Dr. Mir's declaration should be afforded absolutely no weight. Without the support of his declaration, Cox's arguments are mere attorney argument – no objective evidence of record supports Cox's contentions. Attorney argument is not evidence. Thus, Cox's allegations of obviousness which add *Boulware*, *Beck*, and *Bayless* do not provide a preponderance of evidence to support a *prima facie* case of obviousness of claims 8-10, 14-15, 18-19, and 21-22 and accordingly, those claims are not unpatentable over the alleged combinations.

3. Conclusion –The Challenged Claims are Not Anticipated or Obvious over Grounds A-D

Because *Buhrmann* has not been shown to disclose each and every feature of claims 1 and 13, arranged as in the claim, *Buhrmann* does not anticipate independent claims 1 and 13. Challenged dependent claims 2-10, 12, and 14-22 all depend from claims 1 and 13, and are also not anticipated by *Buhrmann* nor rendered obvious by the *Buhrmann*-based combinations for at least the reasons set forth for claims 1 and 13, because Cox's reasons to combine are conclusory and

are not based on evidence that should be afforded any weight, and further in view of their own respective features. Accordingly, a final written decision confirming patentability of claims 1-10 and 12-22 is respectfully requested.

C. *An* Is Not Prior Art, and Cannot Anticipate the Claims [Ground E].

Cox also alleges the *An* reference, U.S. Patent No. 6,031,904, anticipates claims 1-7, 11, and 13-17 and renders obvious other challenged claims in combination with various other references. Revised Amended Petition, pp. 40-52. However, the '714 Patent claims priority of U.S. Provisional Application 60/042,680, filed April 3, 1997. That priority appears on the face of the '714 Patent and has not been challenged by Cox in its petition. Ex. 1001, [60].

Cox has the burden of persuasion to prove that the challenged claims are unpatentable, and that burden never shifts to AT&T. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378-79 (Fed. Cir. 2015). Furthermore, as in *VMware* and *Ariosa* (each applying *Dynamic Drinkware*), Cox has the burden of production to demonstrate an effective filing date for *An* that would predate the April 3, 1997 filing date of U.S. Provisional App. 60/042,680 to which the '714 Patent claims priority. *VMware v. Clouding*, IPR2014-01305, Paper 34 at 13-14 (January 7, 2016); *see also Ariosa Diagnostics v. Illumina*, IPR2014-01093, Paper 69 at 14 (January 7, 2016). Cox has not gone forward in its petition with evidence sufficient to demonstrate an effective filing date for *An* prior to April 3, 1997 or

with evidence that the '714 Patent is not entitled to priority. As before, it is impermissible to submit evidence with a Reply that could have been submitted with the Petition. 37 C.F.R. § 42.23(b); Trial Practice Guide at 48767. In this regard, *VMware* and *Ariosa* are arguably dispositive and dictate that Cox's *An*-based grounds must fail.

In any case, and for avoidance of doubt, AT&T demonstrates (below) that *An* cannot be prior art to the '714 Patent. In particular, AT&T demonstrates that claims 1-7, 11, and 13-17 of the '714 Patent are all entitled to the April 3, 1997 date of the provisional application, such that even under a shifting production burdens analysis of *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1328-29 (Fed.Cir.2008), the burden of production has shifted to Cox. Specifically, Dr. Akl confirms that claims 1-7, 11, and 13-17 are each supported in the provisional application. Ex. 2043, ¶¶ 96-99. AT&T goes on to show that specific limitations of *An*'s independent claims are not supported in the *An Provisional*, Ex. 1006, such that Cox's *An*-based grounds necessarily fail under *Dynamic Drinkware*. Finally, AT&T demonstrates that the subject matter of claims 1-7, 11, and 13-17 was actually reduced to practice prior to *An* and prior to the *An Provisional*.

Because *An* has not been (and cannot be) shown to be prior art by the statutorily required preponderance of the evidence, a final written decision confirming that the claims are not unpatentable over *An* and the *An*-based

combinations is respectfully requested.

1. Claims of the '714 Patent are Entitled to Priority

The '714 Patent claims priority of Application 60/042,680, filed April 3, 1997 (the "'680 Provisional", *see* Ex. 2039), and claims 1-7, 11, and 13-17 of the '714 Patent are each supported in accordance with § 112. Dr. Akl has compared each element of the aforementioned claims to the disclosure of the '680 Provisional and identifies, *see* Ex. 2043, ¶¶ 95-99, corresponding written description support. In particular, for simplicity of proofs, though without limitation, Dr. Akl identifies disclosure appearing in a "Final" version of a Requirements Document - PC User Interface, dated July 17, 1996, that is reproduced and included in the '680 Provisional. *See* Ex. 2039, pp. 95-118. Dr. Akl concludes that each of claims 1-7, 11, and 13-17 is fully supported. Ex. 2043, ¶ 95-99. The entirety of the '680 Provisional, including the Requirements Document is incorporated by reference into the disclosure of the '714 Patent.

Because claims 1-7, 11, and 13-17 of the '714 Patent are fully supported in the '680 Provisional filed April 3, 1997, *An*, based on its utility filing date of June 19, 1997, and not its provisional date to which it is not entitled as shown below, is not prior art and the Board should confirm in its final written decision that the claims are not unpatentable over *An* and the *An*-based combinations.

2. Cox has not Shown that *An* is Entitled to Priority

Cox alleges *An* qualifies as prior art under 35 U.S.C. § 102(e). Revised Amended Petition at iv. *An*'s non-provisional filing date of June 19, 1997 is after the '714 Patent's effective filing date of April 3, 1997. Cox does not challenge the '714 Patent's entitlement to an April 3, 1997 priority date, and as shown in the preceding section, the '714 Patent is entitled to that priority date. See Revised Amended Petition, p. 6. Thus, for *An* to qualify as prior art to the '714 Patent, Cox must have shown *An* is entitled to an earlier priority date, here, the October 23, 1996 filing date of the *An Provisional*. But Cox has not provided any evidence, much less a preponderance of the evidence, to show that the *An Provisional* provides support under 35 U.S.C. § 112 ¶ 1 for the claims of *An* and accordingly, Cox has not shown by a preponderance of the evidence that *An* is prior art.

It is well-settled law, as first explained by Judge Rich in *In re Wertheim*, and as most recently confirmed by the Federal Circuit in *Dynamic Drinkware*, that to establish that a reference patent is entitled to an earlier effective filing date (here, *An* purports to claim priority of the *An Provisional*), the *invention* (as defined by the *claims*) of the subject patent must find support under 35 U.S.C. § 112 ¶ 1 in the earlier application. See *Dynamic Drinkware, LLC*, 800 F.3d at 1381 (“A reference patent is only entitled to claim the benefit of the filing date of its provisional if the disclosure of the provisional application provides support for the claims in the reference patent in compliance with § 112, ¶ 1.”) citing *In re Wertheim*, 646 F.2d

527, 539 (CCPA 1981). *Wertheim* applied that requirement to a continuation-in-part application; in 2010, the Federal Circuit applied the § 112 analysis to claims of priority to provisional applications. *In re Giacomini*, 612 F.3d 1380, 1383-84 (Fed. Cir. 2010).

Thus, as part of its *prima facie* showing that *An* was a valid reference against the '714 Patent under § 102(e), Cox must have made a showing that the *claims* of *An* have § 112 ¶ 1 support in the *An Provisional*. There is no presumption that a reference patent is necessarily entitled to the filing date of its provisional application. *Dynamic Drinkware*, 800 F.3d at 1380, citing *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1305 (Fed. Cir. 2008).

Cox utterly failed to carry this burden. Instead of establishing that the claims of *An* were supported by the *An Provisional*, Cox simply makes a *pro forma* assertion that “[t]he *An Provisional* Application, to which *An* claims priority, fully supports and explicitly describes *An*’s disclosure of the **features claimed by the ’714 patent**....” Revised Amended Petition, p. 17 (emphasis added), citing *Giacomini*, 612 F.3d at 1385 (Fed. Cir. 2010). Thus, Cox only alleged that the *An Provisional* supported the **disclosures** of *An* used against the '714 Patent claims. This is precisely the analysis that was rejected in *Dynamic Drinkware*, see 800 F.3d at 1381, and that the Board itself has rejected. *NVIDIA Corp. v. Samsung Electronics Co., Ltd.*, IPR2015-01315, Paper 11 at 5–6 (Feb. 17, 2015) (rejecting

“Petition [that] does not show how the disclosure in the [provisional application] supports the claims of [the reference patent]” but instead “describes what the [provisional application] discloses and maps this disclosure to the challenged claims . . .”).

But the burden of production under *Dynamic Drinkware* and the *inter partes* review statutes requires Cox to show “why the written description in the earlier application [the *An Provisional*] supports the claim” of *An*. See *Dynamic Drinkware*, 800 F.3d at 1379 (citing *Tech. Licensing Corp.*, 545 F.3d at 1327). Cox made ***no attempt*** to show support for the *An* claims (nor did it cite any claims of *An* or compare the claims of *An* against any disclosure in the *An Provisional*). Cox addressed only one part of the standard, and thus Cox’s proofs are entirely insufficient to show that *An* is entitled to the filing date of the *An Provisional*. See *Cisco Systems, Inc. v. Capella Photonics, Inc.*, Case No. IPR2015-01166, Paper No. 44, slip op. at 17 (PTAB January 28, 2016) (“demonstrating only that the provisional application of the prior art patent provided a written description of the subject matter in the prior art patent relied upon to establish the unpatentability of the challenged claims was insufficient to show that the prior art patent was entitled to the benefit of the filing date of its provisional application.”), citing *Dynamic Drinkware*, 800 F.3d at 1378.

This showing must be made in the Petition (or in this case, the Revised Amended Petition). Because *An*, on its face, shows a filing date after that of the '714 Patent, it was necessary for Cox to prove entitlement to the *An Provisional* in the Revised Amended Petition. See *Apple Inc. v. OpenTV, Inc.*, Case No. IPR2015-00969, Paper No. 8, slip op. at 13 (PTAB September 23, 2015) (denying institution on ground where claim support in provisional application not identified); see also *Sony Mobile Commn's Inc. v. SSH Commn's Security OYJ*, Case No. IPR2015-01869, Paper No. 6, slip op. at 2 (PTAB October 16, 2015) (requiring new filing date when petitioner sought to add comparison of disclosure between claims of reference patent and related provisional application). Cox did not make such a showing in the Revised Amended Petition. A petitioner has the initial burden of production of evidence establishing that an alleged prior art reference is applicable as prior art. *Friendfinder Networks Inc. et. al. v. WAG Acquisition*, Case No. IPR2015-01033, Paper 8 at 6-7 (PTAB Oct. 19, 2015) (citing *Dynamic Drinkware*, 800 F.3d at 1378- 1379). Cox did not meet this burden.

Cox's expert Dr. Mir knew (at least in part) the correct standard, stating: "[m]y review of the *An Provisional* shows that it fully describes the substance of the subject matter **claimed in *An*.**" Ex. 1014, ¶ 101 (bold emphasis added). But Dr. Mir, like Cox, does not actually compare the *claims* of *An* against the disclosure of the *An Provisional*, and does not satisfy Cox's burdens to show such written

description support. For example, Dr. Mir does not compare the claims of *An* against the language of the *An Provisional* in a claim chart or other comparison: his declaration does not provide **any** facts or evidence showing written description support of the claims of *An*.

Thus, Cox's failure to show support for the *An* claims in the *An Provisional* is ***fatal***. Because an identification of support should have been provided in the Petition, any attempt by Cox to untimely remediate its record with an identification of support for the ***claims*** of *An* in the *An Provisional* now would be "new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim" and "new evidence that could have been presented in a prior filing." Trial Practice Guide at 48767. Thus, such evidence should not be considered or entered at the Reply stage. *See Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00424, Paper 50, p. 21 (P.T.A.B. Jan. 12, 2015) *citing* 77 Fed. Reg. at 48767 (Replies do not afford the Petitioner "an opportunity to cure deficiencies in its Petition. . . . Replies that raise new issues or belatedly present evidence ***will not be considered***." (emphasis added)).

3. Cox cannot Show that *An* is Entitled to Priority

In the following paragraphs, AT&T identifies certain obvious failures of Cox's "evidence" establishing *An*'s priority. As one example of Cox's ineffectual attempt to show support in the *An Provisional* for the *An* claims, claim 1 of *An*

recites a “feature ordering system for use in connection with a telephone network which implements features for individual subscribers on the basis of a feature profile stored for each subscriber DN (directory number).” Neither paragraph 101 nor any other portion of Dr. Mir’s declaration appears to reveal where the *An Provisional* contains §112 ¶ 1 support for this portion of claim 1.

Similarly, claim 1 of the *An* issued patent recites “a profile repository storing the feature profiles, the profile repository managed by a service manager program on a service manager node, wherein the server performs a protocol conversion dependent on the type of the service manager node.” Again, nothing in the citation of the *An Provisional* reveals any written description or enablement support under 35 U.S.C. § 112 ¶ 1 for this limitation of claim 1. Ex. 2043, ¶¶ 78-80.

Notwithstanding the fact that Dr. Mir and Cox fail to explain where the *An Provisional* provides § 112 ¶ 1 support for this limitation, AT&T’s expert Dr. Akl confirms that the *An Provisional* does not provide such support for this limitation. Ex. 2043, ¶ 78-80. For example, Dr. Akl confirms that the *An Provisional* does not use the word “conversion” or “convert,” and thus, the *An Provisional* lacks “full, clear, concise, and exact terms” to support the “protocol conversion” language of the independent claims. Ex. 2043, ¶ 81. Dr. Akl further confirms that the other portions of the *An Provisional* do not support this language of the claims, and the *An Provisional* does not enable a person of ordinary skill in the art at the time of

the *An Provisional* to make and use the invention of *An*'s claim 1 (or any other claim). Dr. Akl confirms the same failings apply to the other independent claims of *An*. Ex. 2043, ¶¶ 78-94. "[F]or a non-provisional utility application to be afforded the priority date of the provisional application ... the specification of the *provisional* must 'contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,' 35 U.S.C. § 112 ¶ 1, to enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application." *Dynamic Drinkware*, 800 F.3d at 1378 (citing *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002) (emphasis in original).) The *An Provisional* does not meet this standard.

Accordingly, as Cox has failed to make a showing that *An* is properly a prior art reference under § 102(e), all of challenges E-G based on *An* must fail.

Institution Decision, p. 41.

4. The '714 Patent Claims Were Actually Reduced to Practice

Though Cox failed to provide any evidence to support *An*'s entitlement to the *An Provisional* priority date, even if *An*'s effective date is October 23, 1996, *An* is still not prior art. As shown by documentary evidence, the testimony of Dr. Akl, and the testimony of Michelle Watson-Williams, Marketing Manager for Southwestern Bell telephone at the time of the invention, the invention of the '714 Patent claims was actually reduced to practice at least no later than July 17, 1996,

well prior to the *An Provisional* filing date of October 23, 1996.

Attached as Exhibit 2044 is a copy of a document obtained from AT&T's records entitled "Requirements Document PC User Interface" with a "Final" revision date of July 17, 1996. Ex. 2044. An exact copy of the same document, without the footer, was submitted to the Office as part of the provisional application to which the '714 Patent claims priority, U.S. Prov. App. No. 60/042,680. Ex. 2039, pp. 95-118. Ms. Watson-Williams attests as to the authenticity of the document, and that the July 17, 1996 date is accurate. Ex. 2045, ¶ 10. John Sherman, IP Legal Group Operations Manager for AT&T Services, Inc., confirms that the document is maintained in AT&T's regular course of business. Ex. 2046.

Included in the table below is an identification of the support contained in Exhibit 2044 showing an actual reduction to practice for each and every claim limitation of the claims challenged as anticipated by *An* or obvious over an *An*-based combination. Ms. Watson-Williams further testifies that, as of July 17, 1996, the Positive ID system, which embodied every element of the features of the claims of the '714 Patent, operated for its intended purpose of allowing users to manage their service profiles. Ex. 2045, ¶¶ 10-14.

Claim	Support in Exhibit 2044
[1a.] A method for managing, by a profile management system,	"SPACE: (Service Provisioning And Creation Environment): SPACE carries a copy of the data in the ISCP. SPACE is the network element used for data

Claim	Support in Exhibit 2044
<p>subscriber profile data associated with a communications service subscribed to by a subscriber, the subscriber profile data being stored on a communications network which executes the communications service in accordance with the subscriber profile data, the method comprising:</p>	<p>queries and management by the selected users that have access to it, such as repair. The users do not access the ISCP directly, because we would not want to interfere with call processing by performing data manipulations on the same platform. Updates made through SPACE are input into the ISCP immediately.” Ex. 2044, p. 5.</p> <p>“The ISCP reads the Call Processing Record (CPR) for 235-5000, sees that the customer has Positive ID and checks the screening list to see if the originating number is authorized. 314 965-4122 is on the authorized list, so the ISCP sends a message back to the switch to go ahead and complete the call.” Ex. 2044, p. 4.</p> <p>“The following information is needed to easily and quickly access Southwestern Bell in order to establish and modify your Authorized Telephone Numbers and Access Codes. For your protection, the software was provided under separate cover.” Ex. 2044, p. 24.</p>
<p>[1b] receiving a subscriber request to view the subscriber profile data from a client which hosts a user interface configured to allow the subscriber to view and update the subscriber profile data;</p>	<p>“After the customer has successfully completed their installation process, future log-on attempts will be easier. The customer will click on the Application Manager icon in the Southwestern Bell menu. They will be prompted for their User ID and password and then they will connect their modem to Southwestern Bell and bring up their tool bar. From the tool bar, they click on Positive ID and the application will launch. Based on their User ID, the customer will be provided with a choice of Positive ID numbers to work with. The user's choices will be for the active view of each Positive ID number that they have access to, as well as a pending version if one exists.” Ex. 2044, p. 11.</p> <p>“User Interface Allows customer to manipulate their Auth. # and Access Codes” Ex. 2044, p. 4.</p>
<p>[1c] retrieving the subscriber profile data from the</p>	<p>“Once the customer selects a Positive ID number, the application server will launch a query to SMS to pull down the tables (authorized number table and access</p>

Claim	Support in Exhibit 2044
communications network based upon receiving the subscriber request to view the subscriber profile data from the client;	code table) associated with that Positive ID number.” Ex. 2044, p. 12.
[1d] forwarding the subscriber profile data to the client;	“SMS has to send back data for either every AIN service. The server will ignore any extraneous data and only deliver the Positive ID information to the user's screen.” Ex. 2044, p. 12.
[1e] receiving a subscriber request to update the subscriber profile data from the client, and	“When the customer has created some data, they will “submit” it to Southwestern Bell and software will request an effective date on the changes.” Ex. 2044, p. 12.
[1f] forwarding an update for the subscriber profile data to the communications network based upon receiving the subscriber request to update the subscriber profile data from the client.	“Once the due date is validated the server will send the tables to SMS who will pass the data through front-end edits and save it until the due date.” Ex. 2044, p. 12.
[2.] The method for managing subscriber profile data of claim 1, wherein the subscriber profile data is retrieved from the communications network via at least one intermediate system.	<div data-bbox="597 1283 1105 1545" data-label="Diagram"> <pre> graph TD UI["User Interface Allows customer to manipulate their Auth. # and Access Codes"] --> SMS["SMS New Provisioning system for AIN (Triggered services)"] SMS --> SPACE["SPACE Copy of data in the ISCP"] </pre> </div> <p>Ex. 2044, p. 4.</p>
[3.] The method for managing subscriber profile data of claim 1, wherein the update for the subscriber profile	“Customers will load software on their local PC, review and change their subscriber data and send an updated file back to Southwestern Bell. This file will be received by SMS who will send the updated copy to SPACE and subsequently, the ISCP.” Ex 2044, p. 5.

Claim	Support in Exhibit 2044
data is forwarded to the communications network via at least one intermediate system.	
[4.] The method for managing subscriber profile data of claim 1, wherein the profile management system comprises a server.	“The hardware that is the engine for our Application called the Application Server.” Ex. 2044, p. 6.
[5.] The method for managing subscriber profile data of claim 1, wherein the user interface is a graphical user interface.	“VGA or higher resolution video adapter” “A mouse or compatible pointing device” “Microsoft Windows version 3.1 or later” “[W]e do not support text-based emulations for VT-100s.” Ex. 2044, p. 7.
[6.] The method for managing subscriber profile data of claim 1, wherein the communications service comprises positive identification.	“The service that is demonstrated is Positive ID.” Ex. 2044, p. 4.
[7.] The method for managing subscriber profile data of claim 6, wherein the communications network comprises a telecommunications network.	“Below is an example of how the Advanced Intelligent Network (AIN) interacts with our existing switch network.” Ex. 2044, p. 4.
[10.] The method for managing subscriber profile data of claim 9, wherein a reporting system generates reports	“One possible evolution is that the call processing reports that are produced for Positive ID from the DRS system, the ‘Successful Attempts Log’ and the ‘Unsuccessful Attempts Log’ be delivered to the user through the PC, rather than through the mail.” Ex. 2044,

Claim	Support in Exhibit 2044
comprising calling parties attempting to connect to the subscriber, indicating each calling party successfully connected to the subscriber and each calling party not successfully connected to the subscriber.	p. 23.
[11.] The method for managing subscriber profile data of claim 1, further comprising: controlling access to the subscriber profile data, using an access control system, to only allow authorized subscribers to view and request updates to the subscriber profile data.	“They will be prompted for their User ID and password and then they will connect their modem to Southwestern Bell and bring up their tool bar.” Ex. 2044, p. 11.
Claim	Support in Exhibit 2044
[13a.] A method for managing subscriber profile data associated with a communications service subscribed to by a subscriber, the subscriber profile data being stored on a communications network which executes the communications service in accordance with the subscriber profile data, the method comprising:	<i>See [1a] above.</i>
[13b.] receiving, from a profile management system, a subscriber request to view the subscriber profile data, the subscriber request to view the subscriber profile data being received from the profile management system based upon the profile management system receiving the subscriber request to view the subscriber profile data from a client which hosts a user interface configured to allow the subscriber to view and update the subscriber profile data;	<i>See [1b] and [1c] above.</i>
[13c.] forwarding the subscriber profile data to the profile management system based upon receiving the subscriber request to	<i>See [1c] and [1d], above.</i>

Claim	Support in Exhibit 2044	
	view the subscriber profile data from the profile management system, the profile management system being configured to forward the subscriber profile data to the client when the profile management system receives the subscriber profile data;	
	[13d.] receiving an update for the subscriber profile data from the profile management system, the update for the subscriber profile data being received from the profile management system based upon the profile management system receiving a subscriber request to update the subscriber profile data from the client,	See [1e] and [1f], above.
	[13e.] wherein the communications network executes the communications service in accordance with the updated subscriber profile data.	See [1a], above.
	[14.] The method for managing subscriber profile data of claim 13, wherein the subscriber profile data is forwarded to the profile management system via at least one intermediate system.	See claim 2, above.
	[15.] The method for managing subscriber profile data of claim 13, wherein the update for the subscriber profile data is received from the profile management system via at least one intermediate system.	See claim 3, above.
	[16.] The method for managing subscriber profile data of claim 13, wherein the communications service comprises positive identification.	See claim 6, above.
	[17.] The method for managing subscriber profile data of claim 16, wherein the communications network comprises a telecommunications network.	See claim 7, above.
	[21.] The method for managing subscriber profile data of claim 14, wherein the intermediate system further comprises SPACE.	See claim 2, above.
Claim	Support in Exhibit 2044	
[22.] The method for managing subscriber profile data of claim 13, wherein the profile management system communicates with the client using TCP/IP.	“We may have compatibility issues with modems, TCP/IP stacks, the customer's software that is loaded onto their local PC, the hardware that the customer is running on, with the Network LAN configurations of the customer's company, etc.” Ex. 2044, p. 21.	

This actual reduction to practice prior to the *An Provisional* date is further supported by Exhibit 1011 submitted by Cox, which includes a press release dated

April 5, 1996 introducing Positive ID, which “allows users to authorize incoming calls for access to computer terminals and other devices and denies unauthorized calls and callers without an access code.” Exhibit 1011, p. 4. Ms. Watson-Williams is quoted in the press release. *Id.*, Ex. 2045, ¶ 14. Additionally, Exhibit 2044 states that “it appears that the software is usable and friendly” and “[n]o substantial problems or bugs were uncovered.” Ex. 2044, p. 22.

5. Conclusion – *An* Does Not Anticipate

Because Cox failed to show that *An* is entitled to the filing date of the *An Provisional*, and because the inventors actually reduced the challenged claims of the '714 Patent to practice prior to even the *An Provisional* date, no finding of unpatentability over *An* can be sustained. A final written decision confirming that claims 1-7, 10-11, 13-17, and 21-22 are not unpatentable over *An* or the *An*-based combinations is respectfully requested.

IV. Conclusion

Because no instituted ground is supported by the evidence, all claims should be confirmed patentable in the final written decision.

Respectfully submitted,

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Dated: 29-April-2016

IPR2015-01227

Cox Communications, Inc.

v.

AT&T Intellectual Property I, L.P.

Patent Owner's Exhibit List

April 8, 2016

ATT-2001	Docket Report – AT&T Intellectual Property I, L.P. <i>et al.</i> v. Cox Communications, Inc., <i>et al.</i> , Case No. 14-1106-GMS (D. Del.)
ATT-2002	Complaint – AT&T Intellectual Property I, L.P. <i>et al.</i> v. Cox Communications, Inc., <i>et al.</i> , Case No. 14-1106-GMS (D. Del.)
ATT-2003	Plaintiffs' Answering Brief in Opposition to Defendants' Motion to Transfer – Document 90, AT&T Intellectual Property I, L.P. <i>et al.</i> v. Cox Communications, Inc., <i>et al.</i> , Case No. 14-1106-GMS (D. Del.)
ATT-2004	Defendants' Answer, Affirmative Defenses, and Counterclaims – Document 38, AT&T Intellectual Property I, L.P. <i>et al.</i> v. Cox Communications, Inc., <i>et al.</i> , Case No. 14-1106-GMS (D. Del.)
ATT-2005	Aggregated Rule 7.1 Statements of Defendants – AT&T Intellectual Property I, L.P. <i>et al.</i> v. Cox Communications, Inc., <i>et al.</i> , Case No. 14-1106-GMS (D. Del.)
ATT-2006	Summary of Cox Entities
ATT-2007	E-mail dated July 21, 2015 from Gourdin W. Sirles to Jared Hoggan and attached draft Joint Stipulation to Dismiss Certain Cox Defendants
ATT-2008	Declaration of Robin Sangston in Support of Cox Communications, Inc.'s Motion to Dismiss – Document 35-3,

	Sprint Communications Company L.P. v. Cox Communications, Inc. <i>et al.</i> , Case No. 11-cv-2683 JAR (D. Kansas)
ATT-2009	Federal Communications Commission, Evolution of Cable Television, available at https://www.fcc.gov/print/node/37265 .
ATT-2010	Order Denying Motion to Transfer – Document 132, AT&T Intellectual Property I, L.P. <i>et al.</i> v. Cox Communications, Inc., <i>et al.</i> , Case No. 14-1106-GMS (D. Del. July 9, 2015)
ATT-2011	CCI's Supplemental Brief Concerning Personal Jurisdiction – Document 56, Sprint Communications Company L.P. v. Cox Communications, Inc. <i>et al.</i> , Case No. 11-cv-2683 JAR (D. Kansas)
ATT-2012	Complaint – Cox Communications, Inc., <i>et al.</i> v. Sprint Communications Company <i>et al.</i> (D. Del.)
ATT-2013	Stipulation and Order of Dismissal of Cox Communications Inc. and Substitution of CoxCom, LLC – Document 11, Joao Control & Monitoring Systems, LLC v. Cox Communications Inc., Case No. 1:14-CV-520-GMS (D. Del. Oct. 7, 2014)
ATT-2014	Stipulation and Order to Substitute – Document 9, Futurevision.com, LLC v. Cox Communications, Inc. <i>et al.</i> , Case No. 14-870-GMS (D. Del. Sept. 3, 2014)
ATT-2015	IPR2015-01477 – Petition for <i>Inter Partes</i> Review of U.S. Patent No. 6,587,046
ATT-2016	IPR2015-01477 – Petitioners' Power of Attorney
ATT-2017	IPR2015-01760 – Petition for <i>Inter Partes</i> Review of U.S. Patent No. 6,549,130
ATT-2018	IPR2015-01796 – Petition for <i>Inter Partes</i> Review of U.S. Patent

	No. 5,563,883
ATT-2019	Complaint – C-Cation Technologies, LLC v. Atlantic Broadband Group, LLC et al. (D. Del.)
ATT-2020	Summary of Cox Entity <i>Inter Partes</i> Review Petitions
ATT-2021	Collection of Dun and Bradstreet Reports of Cox Entities
ATT-2022	Declaration of Stephanie Allen-Wang in Support of Cox's Motion to Transfer Venue Pursuant to 28 U.S.C. § 1404(a) – Document 78, AT&T Intellectual Property I, L.P. <i>et al.</i> v. Cox Communications, Inc., <i>et al.</i> , Case No. 14-1106-GMS (D. Del.)
ATT-2023	Summary of Cox Entity Leadership
ATT-2024	[RESERVED]
ATT-2025	[RESERVED]
ATT-2026	Transcript of Conference Call Hearing held January 5, 2016.
ATT-2027	Form 10-Q for the quarter ended September 30, 2015 of Arris Group, Inc. dated November 6, 2015, as filed with the U.S. Securities and Exchange Commission, <i>available at</i> https://www.sec.gov/Archives/edgar/data/1141107/000119312515370106/d70478d10q.htm (last retrieved January 12, 2016)
ATT-2028	ARRIS Corporate Terms and Conditions of Sale, <i>available at</i> https://www.arris.com/globalassets/resources/company-overview/tc.pdf (last retrieved January 12, 2016)
ATT-2029	America Invents Act, HR Rep No 112-98, 112th Cong, 1st Sess (2011)
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- ATT-2038** AT&T's Proposed Discovery Requests
- ATT-2039** File History of U.S. Provisional Application No. 60/042,680
- ATT-2040** Annotated FIG. 1 of Buhrmann from Deposition of Dr. Mir
- ATT-2041** Standing Protective Order and Standard Acknowledgment for Access to Protective Order Material
- ATT-2042** Transcript of Deposition of Nader F. Mir, Ph.D. taken January 29, 2016

ATT-2043	Declaration of Dr. Robert Akl, D.Sc.
ATT-2044	Requirements Document PC User Interface dated July 17, 1996
ATT-2045	Declaration of Michelle Watson-Williams
ATT-2046	Declaration of John Sherman
ATT-2047	Page 642 from Computer and Communications Networks, Nader F. Mir, 2 nd ed. (excerpt)
ATT-2048	Annotated Figure 3 from Exhibit 1004 (Buhrmann)
ATT-2049	Microsoft Computer Dictionary, Fourth Edition (excerpt)

UNITED STATES PATENT AND TRADEMARK OFFICE

COX COMMUNICATIONS, INC.

Petitioner

v.

AT&T INTELLECTUAL PROPERTY I, L.P.

Patent Owner

Case IPR2015-01227

Patent 7,907,714

Title: PROFILE MANAGEMENT SYSTEM INCLUDING USER INTERFACE
FOR ACCESSING AND MAINTAINING PROFILE DATA OF USER
SUBSCRIBED TELEPHONY SERVICES

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6, that service
was made on the Petitioner as detailed below.

Date of service April 29, 2016

Manner of service Electronic Mail

Documents served AT&T's Patent Owner Response
Exhibits 2039, 2040, and 2042-2049

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