

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

**PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE**

## TABLE OF CONTENTS

<b>I. The Prior Art Discloses Each and Every Limitation of the Challenged Claims .....</b>	<b>1</b>
<b>II. An, An in view of Bayless, and An in view of Beck .....</b>	<b>1</b>
A. An, An in view of Bayless, and An in view of Beck disclose each and every limitation of claims 1-7, 10, 11, 13-17, and 21-22.....	1
B. An is entitled to the priority date of the An Provisional. ....	3
1. <i>Dynamic Drinkware</i> in context. ....	3
2. An's claims are fully supported by the An Provisional. ....	5
C. AT&T fails to demonstrate a priority date for the '714 patent which antedates An. ....	24
<b>III. Conclusion .....</b>	<b>29</b>

## TABLE OF EXHIBITS

<b>Exhibit</b>	<b>Description</b>
1001	USPN 7,907,714 (the “’714 patent”) (patent under <i>Inter Partes</i> Review)
1002	The file history for the ’714 patent
1003	USPN 5,629,978 to Blumhardt <i>et al.</i> (“ <i>Blumhardt</i> ”)
1004	USPN 5,903,845 to Buhrmann <i>et al.</i> (“ <i>Buhrmann</i> ”)
1005	USPN 6,031,904 to An <i>et al.</i> (“ <i>An</i> ”)
1006	U.S. Patent Appl. No. 60/028,760 to An <i>et al.</i> (“ <i>An Provisional</i> ”)
1007	USPN 6,335,927 to Elliott <i>et al.</i> (“ <i>Elliott</i> ”)
1008	USPN 5,757,899 to Boulware <i>et al.</i> (“ <i>Boulware</i> ”)
1009	USPN 5,754,636 to Bayless <i>et al.</i> (“ <i>Bayless</i> ”)
1010	USPN 5,883,946 to Beck <i>et al.</i> (“ <i>Beck</i> ”)
1011	Supplemental Declaration of Terry L. Vieth Pursuant to 37 C.F.R. § 1.131, for U.S. Patent Appl. No. 09/050,986
1012	Second Supplemental Declaration of Terry L. Vieth Pursuant to 37 C.F.R. § 1.131, for U.S. Patent Appl. No. 10/761,382
1013	Third Supplemental Declaration of Terry L. Vieth Pursuant to 37 C.F.R. § 1.131, for U.S. Patent Appl. No. 10/761,382
1014	Declaration of Professor Nader Mir, Ph.D. in Support of Request for Inter Partes Review of the ’714 Patent
1015	Declaration of Scott W. Bertulli in Support of Motion for Admission <i>Pro Hac Vice</i>
1016-1019	<Reserved>
1020	Cox Email notice to AT&T of Production in the Delaware Litigation – July 30, 2015
1021	Cox Email notice to AT&T of Production in the Delaware Litigation – August 14, 2015

1022	Engagement Letter between Counsel for Petitioner and Cox Communications, Inc. [Redacted]
1023	Representative Invoice from Counsel for Petitioner to Cox Communications, Inc. [Redacted]
1024	Petitioner's Alternative Proposed Discovery Requests in Red-Line of Patent Owners' Proposal
1025	Amended Protective Order and Acknowledgment for Access to Protective Order Material
1026	Deposition testimony of Dr. Robert Akl for the '714 matter
1027	Reply Declaration of Dr. Nader Mir
1028	Deposition testimony of Michelle Watson-Williams
1029	Deposition testimony of John Sherman

## **I. THE PRIOR ART DISCLOSES EVERY LIMITATION OF THE CHALLENGED CLAIMS**

The Patent Trial and Appeal Board (“Board”) instituted this *inter partes* review, because it found that Petitioner Cox was reasonably likely to prevail in showing that claims 1-22 of the ’714 patent are unpatentable. (Paper 13, pp. 40-41.) Although Patent Owner AT&T criticizes the Board for its institution decision, AT&T has not provided the evidence or reasoning necessary to overcome the Board’s conclusion.

In fact, the evidence and the plain language of the references confirm that all challenged claims are indeed unpatentable.

## **II. AN, AN IN VIEW OF BAYLESS, AND AN IN VIEW OF BECK**

### **A. An, An in view of Bayless, and An in view of Beck disclose each and every limitation of claims 1-7, 10, 11, 13-17, and 21-22.**

The instituted grounds involving An disclose all of the elements recited in the challenged claims. (*See* Paper 9, pp. 40-52.) Importantly, AT&T’s Response is silent as to An’s technical disclosures, and its expert, Dr. Akl, confirmed at his deposition that he had no opinion as to whether claims of the ’714 patent were unpatentable in view of An. (Ex. 1026, 59:15-20 (“Q: Now you don’t provide an analysis of any claims in the ’714 patent as being unpatentable under An; right? A: It is unnecessary because it’s not prior art. So we -- there is no need to do an analysis on a document that is not prior art.”).)

In its Institution Decision, the Board determined that the preamble’s recitation of certain elements, such as “subscriber profile data,” “a communications network,” and “the subscriber profile data being stored on a communications network which executes the communications service in accordance with the subscriber profile data” are entitled to patentable weight. (Paper 13, pp. 14-16.) Despite AT&T’s argument that Cox did not address the preamble, Cox’s Petition already demonstrates that these elements are disclosed by An. (See, e.g., Paper 9, p. 16 (“An discloses that subscriber profile data is retrieved from the communications network (e.g., “DMS 160”) via at least one intermediate system (e.g., “SSPM (subscriber service provisioning manager) Server” alternately referred to as the “JavaTel Server” in the *An Provisional*), which is “. . . connected to/forming part of a public communications network.” (See, e.g., Ex. 1005, 4:16-46, 8:31-36, FIGS. 2-3, 15-16; Ex. 1014, ¶ 99.)”).) Dr. Mir’s first declaration also supports An’s disclosure of these elements, and the Board’s construction does not change his position. (Ex. 1014, ¶ 99; Ex. 1027, ¶¶ 8-10.) In addition, Dr. Mir confirms now that the An Provisional supports these disclosures of An. (Ex. 1027, ¶ 10.)

AT&T attempts to counter Cox’s unpatentability arguments by antedating An, arguing that: (1) An should not be entitled to the priority date of its provisional application and (2) the purported invention claimed in the ’714 patent was actually

reduced to practice prior to An's priority date. Both of AT&T's arguments fail. As shown in Cox's Petition and explained in further detail here, the subject matter and claims of An are well supported by the An Provisional's disclosures. (*See, e.g.*, Paper 9, pp. 15-17, 40-52; Ex. 1014, ¶¶ 98-111.) In addition, AT&T's evidence in support of its newly-asserted priority date is insufficient.

**B. An is entitled to the priority date of the An Provisional.**

Cox's Petition contains sufficient evidence to satisfy its burden of production regarding An's entitlement to the priority date of its provisional application. (*See* Paper 9, pp. 17, 40-52.) Moreover, Dr. Mir opined that "the *An Provisional* fully describes the substance of the subject matter claimed in *An*." (Ex. 1014, ¶¶ 98-111.) Nevertheless, AT&T challenges the priority date entitlement, and Cox responds herein.

**1. *Dynamic Drinkware* in context.**

It is well-established that 35 U.S.C. § 102(e) "codified the 'history of treating the disclosure of a U.S. patent as prior art as of the filing date of the earliest U.S. application to which the patent is entitled, provided the disclosure was contained in substance in the said earliest application.'" *In re Giacomini*, 612 F.3d 1380, 1385 (Fed. Cir. 2010). AT&T does not challenge Cox's showing that the relied-upon disclosures of An find support in the An Provisional, acknowledging that Cox addressed this part of the standard. (*See* Paper 40, pp. 47-49.) Indeed,

Cox's Petition is replete with examples demonstrating the An Provisional's support for the relied-upon disclosures of An. (*See, e.g.*, Paper 9, pp. 42-52, Table C.)

Recently, in *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, the Federal Circuit elaborated on *Giacomini*, adding that "[a] reference patent is only entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the claims in the reference patent in compliance with § 112, ¶ 1." 800 F.3d 1375, 1381 (Fed. Cir. 2015). In *Dynamic Drinkware*, the Federal Circuit found that the petitioner satisfied its initial burden of production, a shifting burden, on the issue of entitlement to a provisional priority date "by arguing that [the reference] anticipated the asserted claims of the [challenged] patent under § 102(e)(2)." 800 F.3d at 1379.

After *Dynamic Drinkware*, the Board indicated that a Petitioner need only show support for *one* claim of the reference patent, as opposed to all claims. *Cisco Systems, Inc. v. Capella Photonics, Inc.*, IPR2014-01166, Paper 44, at 18 n.8 (PTAB Jan. 28, 2016) (stating that a Petitioner "need not show that every claim of [a patent] is supported by the [provisional application] to demonstrate that subject matter disclosed in both [the patent] and [the provisional application] is entitled to the benefit of the filing date of the [provisional application]"). Cox has carried its initial burden of production on the issue of An's entitlement to the priority date of



the An Provisional at least by asserting in its Petition that An is prior art under § 102(e). (See Paper 9, p. iv, 17, 42-52; see also Ex. 1014, ¶¶ 98-111.)

AT&T's assertion that Cox's showing is "untimely" or would constitute "new evidence," is contrary to the framework set forth by *Dynamic Drinkware*, 800 F.3d at 1381 ("[Petitioner] did not waive its argument that Raymond was entitled to an earlier effective date. . . . [Petitioner] did not have the burden of producing evidence relating to the [] provisional application until after [Patent Owner] made its argument regarding reduction to practice. As a result, it was not necessary for [Petitioner] to prove in its petition that [the patent] was entitled to the filing date of its provisional application."). The arguments advanced in AT&T's Response only shifted the burden of production back to Cox, who presents arguments and evidence in rebuttal herein, its first opportunity to address AT&T's challenge.

## **2. An's claims are fully supported by the An Provisional.**

Table 1, below, identifies support in the An Provisional for each of An's claim elements. Dr. Mir's analysis confirms that, in the face of AT&T's arguments to the contrary, the An Provisional supports An's claims. (See, e.g., Ex. 1027, ¶ 26.)

Cox responds herein to the specific contentions raised by AT&T. For example, AT&T and its expert dispute the An Provisional's support for the term

“protocol conversion.” (Paper 40, p. 52.) Yet, rather than seek to define the term in his declaration, Dr. Akl instead conflated “conversion” with “encapsulation,” turning to a dictionary source to define the word “encapsulate.” (Ex. 2043, ¶¶ 86, 89.) However, as later confirmed by Dr. Akl in his deposition, neither “encapsulate” nor any variation of the word appear in An’s claims. (*See* Ex. 1005; Ex. 1026, 63:19-64:15.)

An’s specification also draws an express distinction between “encapsula[tion]” and “formatting,” which Dr. Mir confirms is analogous to the recited “conversion.” (*See* Ex. 1005, 7:55-64 (“The service manager adaptor 138 *encapsulates* the specific protocols to be used to communicate with each class of service manager. . . . It receives transactions from the dispatcher 132, *formats them in a service manager specific protocol*, and sends them to the service manager 142.” (emphasis added); Ex. 1027, ¶¶ 14-15.) This distinction highlights that AT&T reliance on the word “encapsulate” in the An Provisional to provide meaning for “protocol conversion” is wrong.

Dr. Akl’s interpretation of the term would also require support for “multiple types of service manager nodes.” (Ex. 2043, ¶ 80.) However, Dr. Akl identifies nothing in An’s claims that suggests a requirement for “multiple types” of service manager nodes. An’s claim language instead recites “*a type*” or “*the type*” of service manager node. Even if Dr. Akl’s interpretation was correct, one of

ordinary skill in the art would understand that the An Provisional provides support for multiple types of service manager nodes. (Ex. 1027, ¶ 16.)

During his deposition, Dr. Akl explained that “protocol conversion” merely involves “changing” or “modifying” a protocol. (See Ex. 1026, 66:11-68:24 (“Q: So you admit that you applied the plain and ordinary meaning to the term ‘protocol conversion’ in your analysis of the An patent; correct? A: Yes. Q: But sitting here today, you can’t tell me what that definition of protocol conversion is that you used in your analysis; right? A: . . . So an example that I gave you previously was you’re modifying the protocol. You’re changing it. You’re doing conversion on the protocol.”).) Dr. Mir agrees with this definition, and confirms its support in the An Provisional. (Ex. 1027, ¶ 12-16.) For example, the An Provisional states that the “ServiceManagerAdaptor . . . receives transactions from the Dispatcher, formats them in a ServiceManager specific protocol, and sends them to the ServiceManager.” (See Ex. 1006, 11:19-25, 25, 29, 31-35, 46, 55; Table 1, Element [1e].)

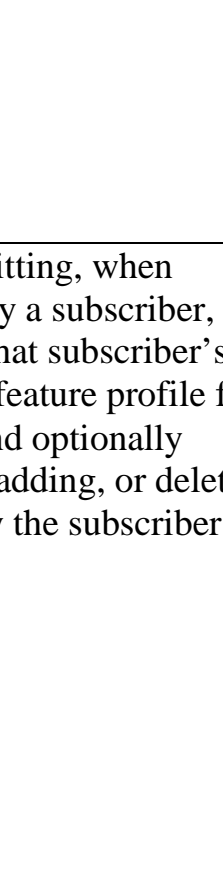
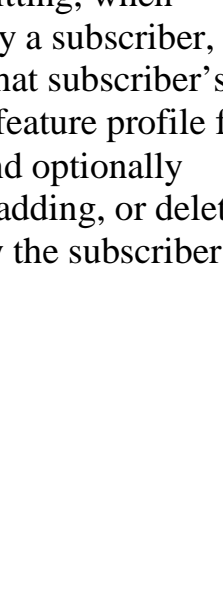
The An Provisional is also enabling to one of ordinary skill in the art. Dr. Akl’s focus on only two of the *Wands* factors—amount of guidance presented and presence or absence of working examples—places inappropriate emphasis on these factors, is based on incorrect assumptions, and leads to a skewed result. (Ex. 2043, ¶¶ 92-94; *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).)

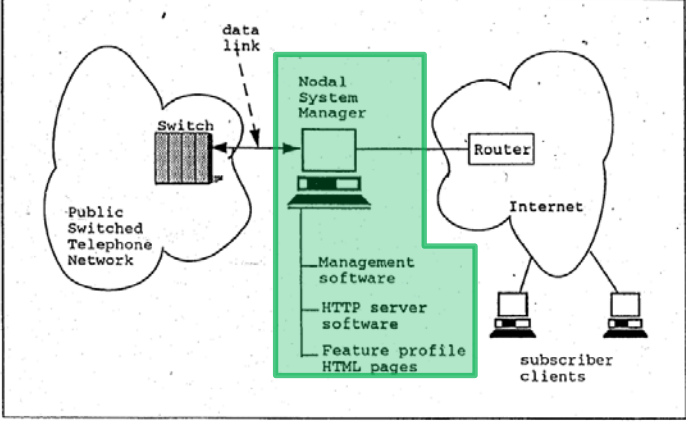
While the *Wand* factors are “illustrative,” “a reasonable amount of routine experimentation required to practice a claimed invention does not violate the enablement requirement.” *Cephalon, Inc. v. Watson Pharma., Inc.*, 707 F.3d 1330, 1336 (Fed. Cir. 2013). Thus, even if Dr. Akl was correct about the absence of working examples, this fact alone would be insufficient for a finding that the disclosure was not enabling. *See* M.P.E.P. § 2164.02. And, Dr. Akl’s assertion that “the An Provisional does not provide sufficient direction for how to implement protocol conversion,” is based on a wrong interpretation of what “protocol conversion” is, as discussed above. Dr. Mir, on the other hand, confirms that the An Provisional’s disclosure, in light of *all* of the *Wands* factors, points to a conclusion that a person of ordinary skill in the art *could* practice An without undue experimentation. (*See* Ex. 1027, ¶¶ 17-25.)

Because the An Provisional fully supports the claims of An in accordance with § 112, An is entitled to the October 23, 1996 filing date of the An Provisional, and is prior art against the ’714 patent. (Ex. 1027, ¶ 26.)

**Table 1: U.S. Prov. App. SN 60/028,760 Support for USPN 6,031,904**

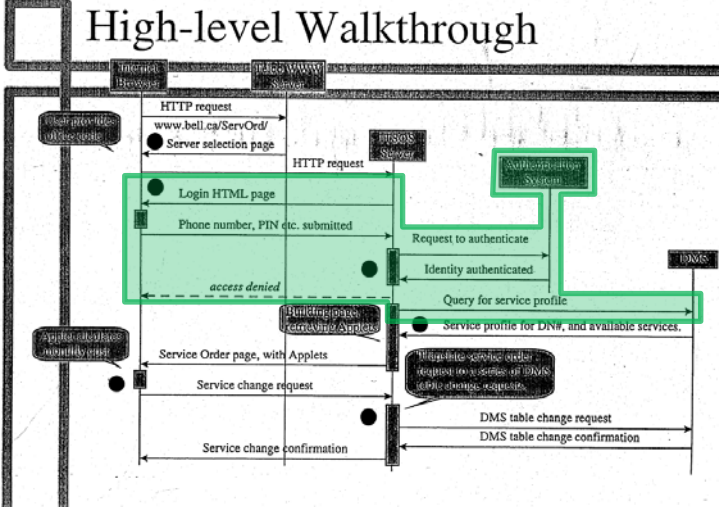
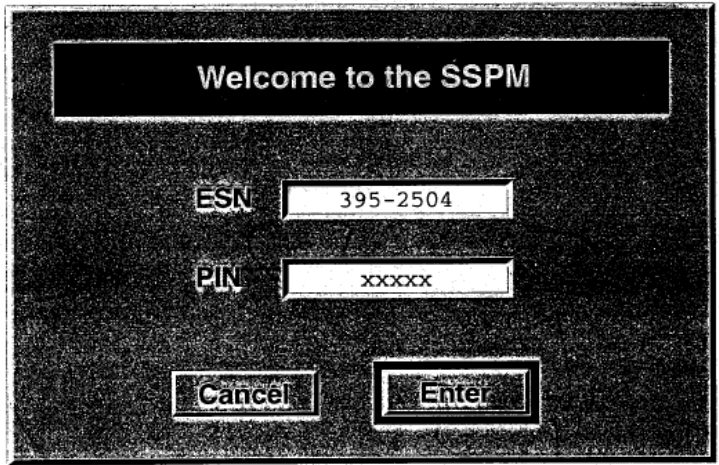
<b>Claim</b>	<b>Provisional Support</b>
[1a.] A feature ordering system for use in connection with a telephone network which implements features for individual subscribers on the basis of a feature profile stored for each subscriber	The An Provisional discloses that “[t]he subscriber can locate his personal ‘telephone feature profile’ on the telephone service provider’s server on the Internet, access it via a password, such as his/her ‘calling card’ PIN, and see at a glance the features and options currently active on his line/number. Additionally, the

<p><b>Claim</b></p>	<p><b>Provisional Support</b></p>
<p>DN (directory number), the feature ordering system comprising:</p>	<p>subscriber may submit requests to add/change/delete features, on-line.” (See, e.g., Ex. 1006, 7:2-6, 7:22-28, 8:2-7, 9:23-10:1, 13, 25, 38, 50-51.)</p>
<p>[1b.] a server acting directly or indirectly on the feature profiles, the server being connected to an information communications network and accessible by subscribers through the information communications network and</p>	<p>The An Provisional discloses this element.</p>  <p>The diagram, titled "High-level Walkthrough", illustrates the process flow. It starts with a "Subscriber's Browser" sending an "HTTP request" to a "Server". The server responds with a "Server selection page", then a "Login HTML page". The subscriber submits "Phone number, PIN etc.", which is sent to an "Authentication System". The system returns "Identity authenticated". The subscriber then sends a "Request to authenticate" to the "Authentication System". The system returns "Query for service profile". The subscriber sends "Service profile for DN#, and available services". The server then sends a "Service Order page, with Applets" to the subscriber. The subscriber sends a "Service change request" to the server. The server sends a "DMS table change request" to a "DMS" (Database Management System). The DMS returns a "DMS table change confirmation". The server then sends a "Service change confirmation" to the subscriber.</p>
<p>[1c.] permitting, when accessed by a subscriber, access to that subscriber's telephone feature profile for viewing and optionally changing, adding, or deleting features by the subscriber; and</p>	<p>The An Provisional discloses that “[v]ia a mechanism such as an HTML ‘form’ or a Java ‘applet’, a subscriber can activate/deactivate features and change the parameters of those features, on-line. Submission of the ‘form’ will modify his ‘profile’.”</p>  <p>The diagram, titled "Service Order Page", shows a "Subscriber's Browser" sending an "HTTP request" to a "Server". The server responds with a "Service Order page". The subscriber interacts with the page, and the server sends a "Confirmation Page" back to the subscriber. The diagram also shows a "Subscriber's Browser" sending an "HTTP request" to a "Server". The server responds with a "Service Order page". The subscriber interacts with the page, and the server sends a "Confirmation Page" back to the subscriber. The diagram also shows a "Subscriber's Browser" sending an "HTTP request" to a "Server". The server responds with a "Service Order page". The subscriber interacts with the page, and the server sends a "Confirmation Page" back to the subscriber.</p>
<p></p>	<p>(See, e.g., Ex. 1006, 9:3-10:4, 12:1-10, 31-35, 38-40, 48, 50.)</p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>
<p></p>	<p></p>

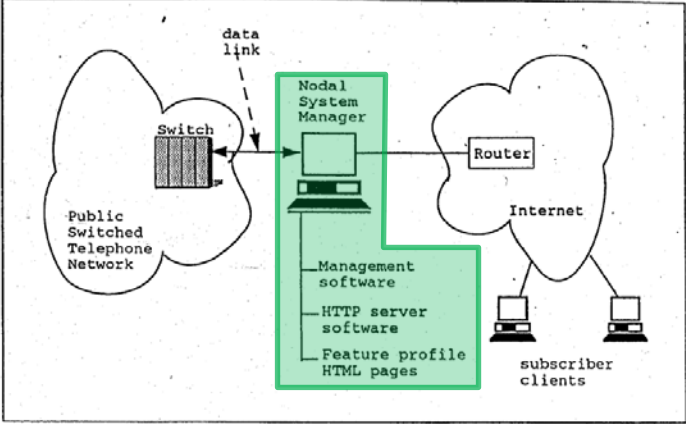
Claim	Provisional Support
	10, 16-26, 31-35, 49-55.)
<p>[1d.] a profile repository storing the feature profiles, the profile repository managed by a service manager program on a service manager node,</p>	<p>The An Provisional discloses that “[a]n HTTP server is placed on the machine which stores the feature profiles, or on a machine that has direct (and probably proprietary) access to the machine that does have those profiles.”</p> <p>FIGURE 1.</p>  <p>(See, e.g., Ex. 1006, 9:3-13, 11:13-25, 15, 27-28, 31, 46, 59.)</p>
<p>[1e.] wherein the server performs a protocol conversion dependent on the type of the service manager node.</p>	<p>The An Provisional discloses that the “ServiceManagerAdaptor . . . receives transactions from the Dispatcher, formats them in a ServiceManager specific protocol, and sends them to the ServiceManager.”</p>

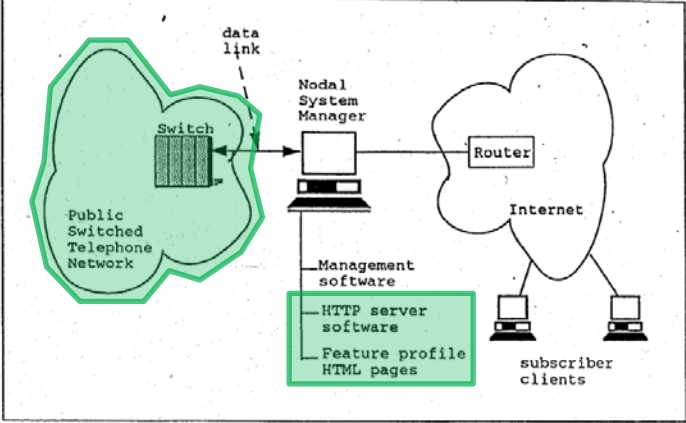


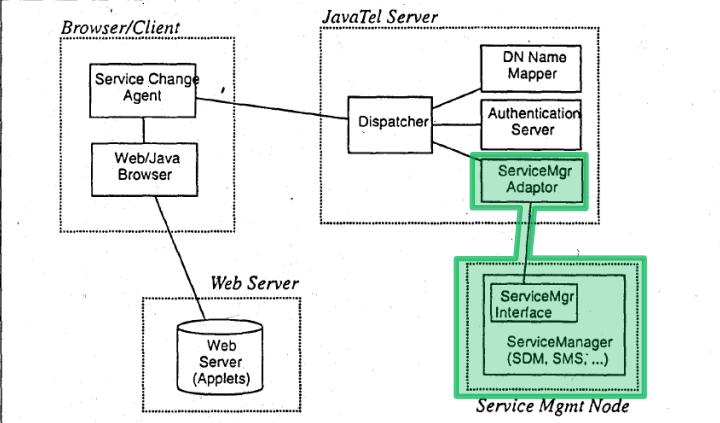


Claim	Provisional Support
<p>identification information which is then authenticated by the authentication server before the subscriber is allowed to view or change the feature profile.</p>	<p><b>High-level Walkthrough</b></p>  <p>FIGURE 2</p>  <p>(See, e.g., Ex. 1006, 9:23-26, 10:19-22, 11:1-3, 16, 30, 31-35, 38, 44, 50-52.)</p>
<p>[4.] A system according to claim 1 wherein said server also provides access to billing information in relation to the DN.</p>	<p>The An Provisional discloses that “[t]he contents of the pages could be almost without limit, showing perhaps current bill, detailed list of calls etc., as well as current features and cost what-ifs on possible feature complements.” (See, e.g., Ex. 1006, 9:26-10:1, 44, 49-51.)</p>
<p>[5.] A system according to claim 1 wherein said server provides cost estimates for features selected by the subscriber.</p>	<p>The An Provisional discloses that “[t]he contents of the pages could be almost without limit, showing perhaps current bill, detailed list of calls etc., as well as current features and cost what-ifs on possible feature complements.” (See, e.g., Ex. 1006, 9:26-10:1, 44, 49-51.)</p>

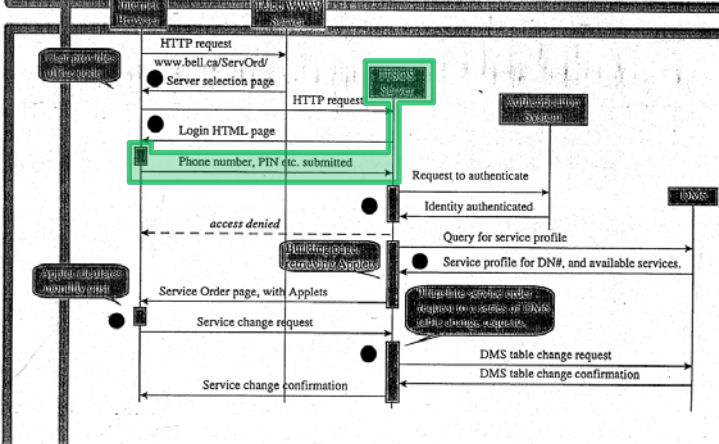
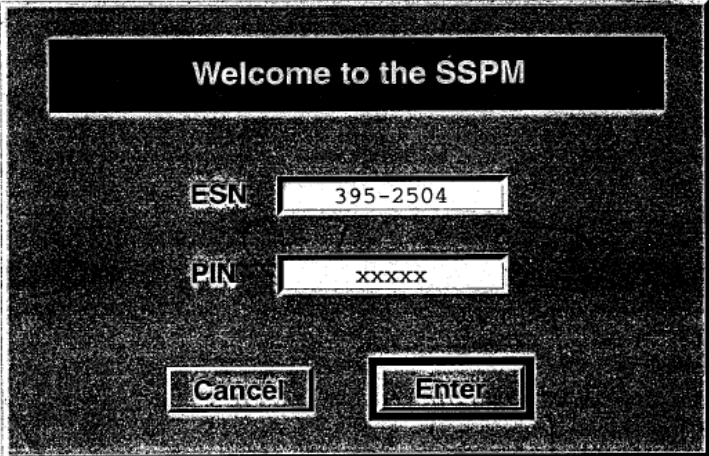


Claim	Provisional Support
<p>[6.] The system according to claim 1, wherein the server and the service manager program are each run on the service manager node, and the profile repository is stored on the service manager node.</p>	<p>The An Provisional discloses support for this claim.</p> <p>FIGURE 1.</p>  <p>(See, e.g., Ex. 1006, 9:6-13, 11:13-18, 15, 59-60.)</p>
<p>[7a.] A service order system for allowing a subscriber having access to an Internet browser to select which features are active on a subscriber line having a particular directory number, the features being provided by a service provider having a feature profile repository containing feature profile information determining which features are active on the subscriber line, the service order system comprising:</p>	<p>The An Provisional discloses this element. See Table 1, Element [1a], above.</p>
<p>[7b.] a server in communication with the feature profile repository and also with a communications network</p>	<p>See Table 1, Element [1b], above.</p>
<p>[7c.] for presenting feature profile information on a</p>	<p>See Table 1, Element [1c], above.</p>

Claim	Provisional Support
subscriber's access unit connected to the server through the communications network, and for receiving changes, additions or deletions requested by the subscriber through their access unit,	
[7d.] wherein the feature profile repository is managed by a service manager program on a service manager node,	See Table 1, Element [1d], above.
[7e.] and the server performs a protocol conversion dependent on the type of the service manager node.	See Table 1, Element [1e], above.
[8.] A service order system according to claim 7 wherein the profile repository is stored on a switch forming part of the PSTN (public switched telephone network), and the server is an HTTP (hypertext transport protocol) server which downloads feature profile information to the subscriber's access unit in the form of HTML (hypertext mark-up language) pages.	<p>The An Provisional discloses that “[i]n a preferred aspect of the invention the machine storing the feature profiles is a switch” and “[t]he HTTP server has a communication link to the DMS switch.”</p> <p>FIGURE 1.</p>  <p>(See, e.g., Ex. 1006, 9:6-17, 11:13-18, 15, 26-27, 50.)</p>
[9a.] A service order system according to claim 8 wherein there are a plurality of said	The An Provisional discloses that the “Service Manager [is t]he service management service as used by the Service Provider. It provides the

Claim	Provisional Support
<p>profile repositories each managed by a respective service manager program on a respective service manager node, each service manager node having a type;</p>	<p>necessary interface to the profile repository, and has a transactional interface to the rest of the world (create, read, update, delete). There may be many Service Managers.” (See, e.g., Ex. 1006, 9:3-13, 11:13-25, 15, 27-31, 46, 59.)</p>
<p>[9b.] wherein the server performs a protocol conversion to convert the profile information received from each service manager node to a form suitable for inclusion in the HTML pages, the protocol conversion being dependent on the type of the service manager node.</p>	<p>The An Provisional discloses that the “Service Change Agent . . . interacts with ServiceManagers from Service Providers,” “uses HTML formatting where appropriate,” and the “ServiceManagerAdaptor . . . receives transactions from the Dispatcher, formats them in a ServiceManager specific protocol, and sends them to the ServiceManager.”</p> <p>Figure 8 High-level Design View</p>  <p>(See, e.g., Ex. 1006, 11:19-25, 29, 31-35, 46, 55.)</p>
<p>[10.] A service order system according to claim 9 further comprising a name mapper which determines which service manager controls the feature profile information for a given subscriber directory number.</p>	<p>The An Provisional discloses that the “DN Name Mapper . . . maps Directory Numbers to specific ServiceManager references.” (See, e.g., Ex. 1006, 31-35.)</p>
<p>[11a.] A method of updating features which are active on a subscriber line having a</p>	<p>See Table 1, Element [1a], above.</p>

Claim	Provisional Support
particular DN (directory number), the method comprising:	
[11b.] a subscriber accessing a feature management server with an access device with a connection through a communications network;	See Table 1, Element [1c], above.
[11c.] the feature management server presenting a series of pages on the access device;	<p>The An Provisional discloses that “[a] telephone subscriber would use [a personal computer or other suitable device] and a Universal resource Locator for access to his/her telephone service provider’s server. . . . [T]he HTTP server would provide access to a series of pages about this particular telephone number.”</p> <p><b>High-level Walkthrough</b></p> <p>(See, e.g., Ex. 1006, pp. 9:16-10:18, 16-26, 48-49.)</p>
[11d.] the subscriber entering their DN on one of the pages and submitting this to the server;	The An Provisional discloses this element.

Claim	Provisional Support
	<p data-bbox="771 247 1224 296">High-level Walkthrough</p>  <p data-bbox="781 762 894 785">FIGURE 2</p>  <p data-bbox="680 1270 1382 1346">(See, e.g., Ex. 1006, 9:23-26, 10:19-22, 11:1-3, 16, 30, 31-35, 38, 44, 50-52.)</p>
<p data-bbox="212 1360 613 1856">[11e.] the server collecting from a feature profile repository feature profile information relevant to the DN entered by the subscriber, performing a protocol conversion dependent upon a type of service node containing a service manager program that manages the feature profile repository, and</p>	<p data-bbox="680 1360 1398 1856">The An Provisional discloses that the “Service Change Agent . . . provides the User Interface for accessing, browsing, and modifying subscriber service profile information,” the “Dispatcher . . . routes transactions to the DNMapper to resolve the subscriber’s DN into the appropriate ServiceManager type and specific address,” and “ServiceManagerAdaptor . . . receives transactions from the Dispatcher, formats them in a ServiceManager specific protocol, and sends them to the ServiceManager.”</p>

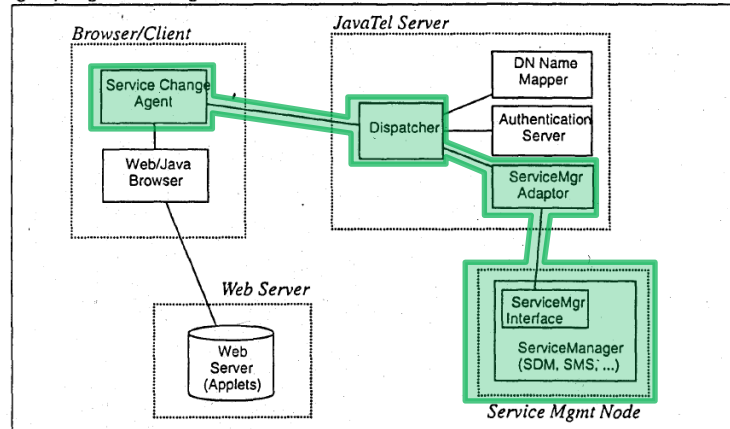


## Claim

presenting this feature profile information on one or more of the pages;

## Provisional Support

Figure 3 High-level Design View



## High-level Walkthrough

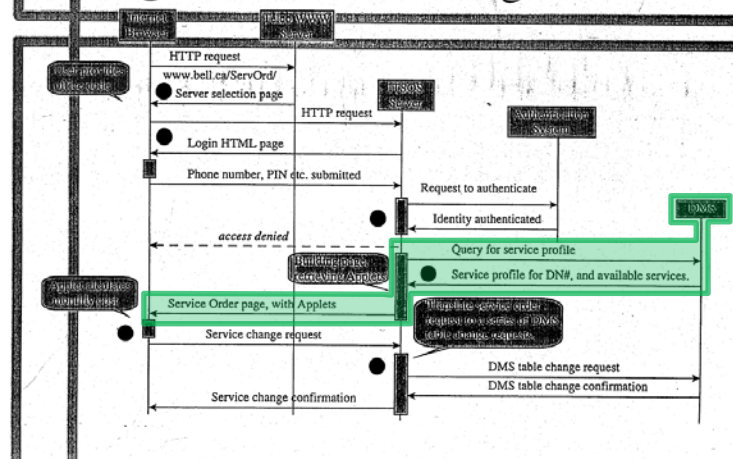
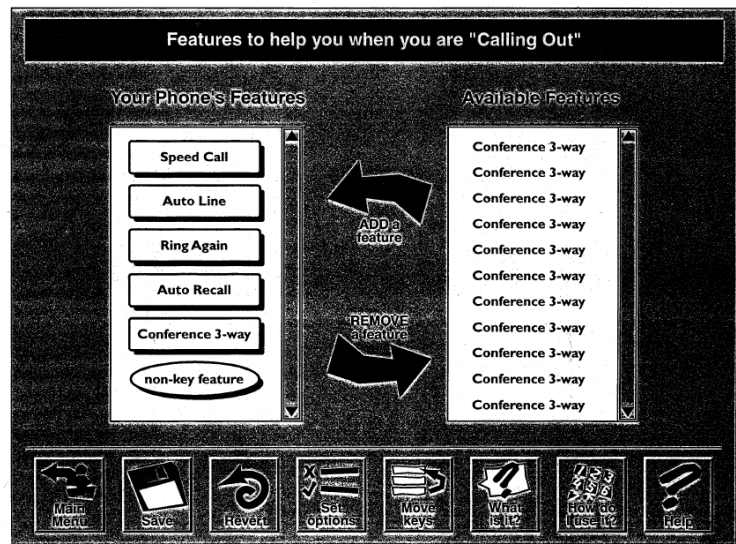
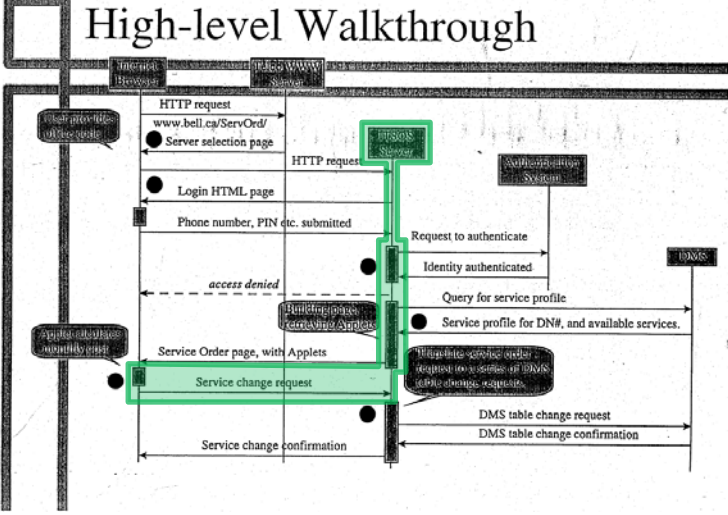
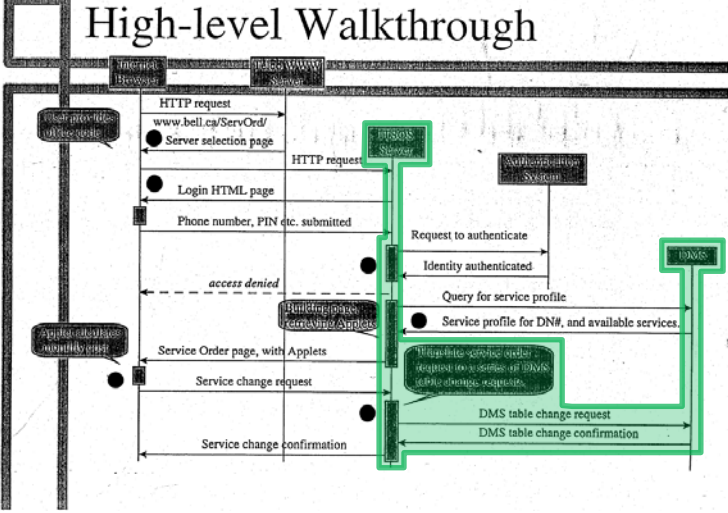


FIGURE 4



(See, e.g., Ex. 1006, 9:3-10:4, 11:19-25, 15-24, 29, 31-35, 46, 55.)

Claim	Provisional Support
<p>[11f.] the subscriber selecting, on one or more of the pages, changes, additions, or deletions for the feature profile information and submitting this to the server; and</p>	<p>The An Provisional discloses that “[v]ia a mechanism such as an HTML ‘form’ or a Java ‘applet’, a subscriber can activate/deactivate features and change the parameters of those features, on-line.”</p> <p><b>High-level Walkthrough</b></p>  <p>(See, e.g., Ex. 1006, 9:23-10:18, 15-26, 31-35, 49-55.)</p>
<p>[11g.] the server making corresponding changes to the feature profile repository.</p>	<p>The An Provisional discloses support for this element.</p> <p><b>High-level Walkthrough</b></p>  <p>(See, e.g., Ex. 1006, 9:6-11, 31-35, 38-40, 50.)</p>
<p>[12.] A method according to claim 11 further comprising: the subscriber entering security information together</p>	<p>The An Provisional discloses this element.</p>

### Claim

with the DN; and the server performing authentication on the security information before allowing the subscriber access to the feature profile information.

### Provisional Support

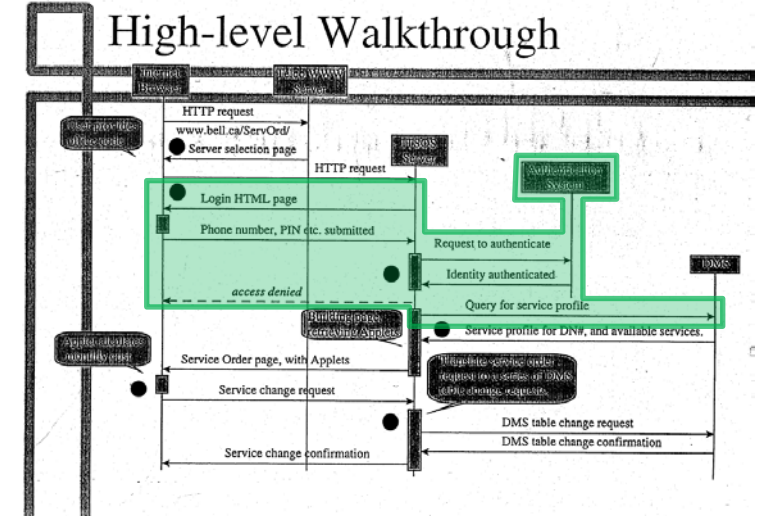
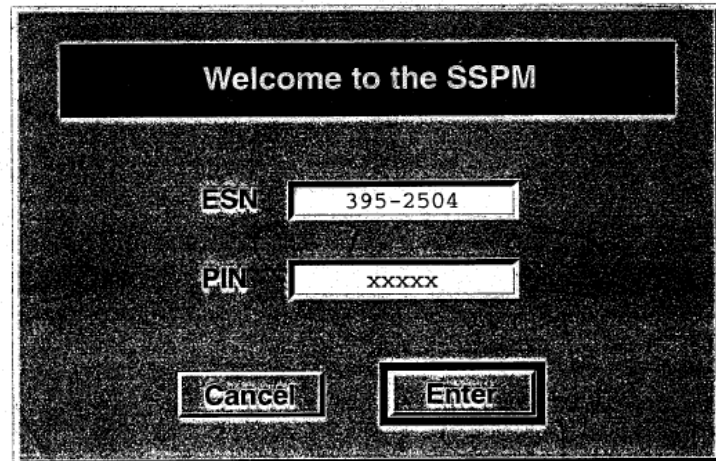


FIGURE 2

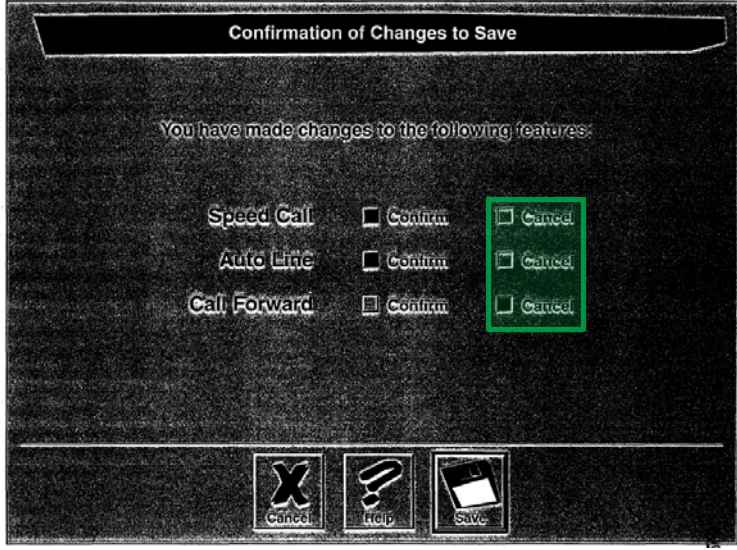


(See, e.g., Ex. 1006, 9:23-26, 10:19-22, 11:1-3, 16, 30, 31-35, 38, 44, 50-52.)

[13.] A method according to claim 11 further comprising the server providing on the access device information pertaining to the cost of the selected feature profile, wherein the subscriber is given the option of cancelling the submission of the changes made to the feature profile.

The An Provisional discloses that “[t]he contents of the pages could be almost without limit, showing perhaps current bill, detailed list of calls etc., as well as current features and cost what-ifs on possible feature complements.”



Claim	Provisional Support
	<p data-bbox="743 237 820 252">FIGURE 10</p>  <p data-bbox="678 819 1365 892">(See, e.g., Ex. 1006, 9:26-10:1, 22, 24, 44, 49-51.)</p>
[14a.] A method of updating features which are active on a subscriber line having a particular DN (directory number), the method comprising:	See Table 1, Element [1a], above.
[14b.] a subscriber accessing a feature management server with an access device over a communications network;	See Table 1, Element [1c], above.
[14c.] the subscriber receiving from the feature management server one or more pages on the access device;	See Table 1, Element [11c], above.
[14d.] the subscriber entering a DN on at least one of the one or more pages and submitting this to the feature management server;	See Table 1, Element [11d], above.
[14e.] the subscriber receiving feature profile information on one or more	See Table 1, Element [11e], above.

Claim	Provisional Support
additional pages, wherein the feature profile information is from a feature profile repository which is managed by a service manager program on a service manager node, the feature profile information is relevant to the DN entered by the subscriber, and a protocol conversion is performed dependent upon a type of the service manager node; and	
[14f.] the subscriber selecting, on at least one of the one or more additional pages, changes, additions, or deletions for the feature profile information and submitting this to the feature management server.	<i>See Table 1, Element [11f], above.</i>
[15a.] A method of updating features which are active on a subscriber line having a particular DN (directory number), the method comprising:	<i>See Table 1, Element [1a], above.</i>
[15b.] a feature management server being accessed by an access device;	<i>See Table 1, Element [1c], above.</i>
[15c.] the feature management server sending at least one first page to the access device;	<i>See Table 1, Element [11c], above.</i>
[15d.] the feature management server receiving at least one second	<i>See Table 1, Element [11d], above.</i>

Claim	Provisional Support
page in which a DN has been entered;	
[15e.] the feature management server collecting from a feature profile repository feature profile information relevant to the DN, performing a protocol conversion dependent upon a type of a service node containing a service manager program that manages the feature profile repository, and sending this feature profile information in at least one third page;	<i>See Table 1, Element [11e], above.</i>
[15f.] the feature management server receiving at least one fourth page containing at least one change, addition, or deletion to the feature profile information; and	<i>See Table 1, Element [11f], above.</i>
[15g.] the feature management server making one or more corresponding changes to the feature profile repository.	<i>See Table 1, Element [11g], above.</i>

**C. AT&T fails to demonstrate a priority date for the '714 patent which antedates An.**

AT&T argues that its '714 patent should be entitled to an effective filing date earlier than the An Provisional, pointing to a single document it says shows an actual reduction to practice by July 17, 1996.

To demonstrate actual reduction to practice, a party must show “that the inventor (1) ‘constructed an embodiment or performed a process that met all the limitations’ and (2) ‘determined that the invention would work for its intended purpose.’” *In re Omeprazole Patent Litigation*, 536 F.3d 1361, 1373 (Fed. Cir. 2008). All but the most simple inventions require evidence of testing to show an actual reduction to practice. *See Scott v. Finney*, 34 F.3d 1058, 1061-62 (Fed. Cir. 1994) (citing cases describing testing requirements). Where an invention is more complex, testing more closely duplicating real-world conditions is required. *Id.*

AT&T has not demonstrated that, as of July 17, 1996, the subject matter claimed in the '714 patent was operable for its intended purpose, and thus actually reduced to practice. AT&T relies on a “Requirements Document PC User Interface” (“Requirements Document”), bearing a “Revision Date” of “July 17, 1996” to show what it says is a reduction to practice. (Ex. 2043; Ex. 1026, 55:15-56:17 (identifying Exhibits 1001, 2044, and 2039 as relevant to Dr. Akl’s analysis.)

First, the Requirements Document, including the “Revision Date” thereon, is of uncertain authenticity, an issue which was not resolved by the deposition testimony of John Sherman, who attempted to authenticate the document. In his deposition, Mr. Sherman confirmed that he did not retrieve the Requirements Document from AT&T’s files, nor could he identify who might have. (Ex. 1029, 14:19-15:5.) What he could say, though, is that although AT&T maintained a log which recorded when the document was in fact added to the file, he did not consult that log before signing his declaration. (Ex. 1029, 25:9-20.) More importantly, Mr. Sherman could not say whether the document had been accessed and modified between when it was first added to the file, and when it was printed out for use here. (Ex. 1029, 27:3-10.)

Second, Dr. Akl’s conclusory statement that the Requirements Document shows an actual reduction to practice is entitled to no weight. At his deposition, Dr. Akl was unable to say what the standard was that he used to make the conclusory statement, and his declaration says nothing about it. (Ex. 2043; Ex. 1026, 56:18-58:5.) Apparently, Dr. Akl just repeated the conclusory words given to him by AT&T’s counsel.

Third, Dr. Akl offers no opinion on whether the system described in the Requirements Document ever operated for its intended purpose. Although AT&T offers a declaration from Michelle Watson-Williams, a marketing manager and

associate director for product management at the time of the '714 patent, on this subject, Dr. Akl testified that he did not rely on that declaration in rendering his own “conclusion” on actual reduction to practice. (*See* Paper 40, p. 54; Ex. 2043, Appx. B; Ex. 1026, 55:15-56:17.)

Fourth, turning to the Watson-Williams declaration itself, Ms. Watson-Williams never states whether the system described in the Requirements Document operated according to the intended purpose. All she says is that documents *like* the Requirements Document “were *intended* as handoff documents prepared at the completion of a product, after the product was fully tested and after verification that the product achieved its intended goals.” (Ex. 2045, ¶ 10 (emphasis added).) Whether that is true generally or not, in this present instance the Requirements Document expressly notes that “[t]he Application Manager software *was not tested* . . . . Future testing and enhancements are being coordinated.” Ms. Watson-Williams does not contradict this fact, with her assertion of general intent across the company on all of its projects. (Ex. 2044, p. 22 (emphasis added).)

Indeed, the lack of testing here is unsurprising, given that the Requirements Document shows that the system was far from complete. The specification of the '714 patent states that an “object of the invention is to provide [a system] *that does not rely upon the involvement of service personnel* to permit a user to access and

modify their AIN service profile data.” (Ex. 1001, 4:12-15 (emphasis added).)

But, the Requirements Document notes that a “concern for this interim period is how new tables sent from the customer through the Application Server will make it to SPACE. This procedure will involve the CNOC and a *manual work-around* until 9/7/96.” (Ex. 2044, p. 17 (emphasis added).) In fact, Ms. Watson-Williams confirmed that an “application coordinator” was required to handle a subscriber’s request. (See Ex. 1028, 63:20-65:9 (“Q: . . . [I]n paragraph 12 of your declaration you refer to the subscriber’s request. So what would the subscriber physically do to make that request? A: The subscriber would physically contact the Southwestern Bell application coordinator who is the Southwestern Bell employee that handles the help desk and support functions for the positive ID user interface.”).)

When asked, Ms. Watson-Williams was unable even to verify whether *any* of the desired yet unavailable functionality was ever completed, even months after the purported revision date of the Requirements Document. (Ex. 1028, 77:7-81:8.) In fact, the Requirements Document includes a multipage section bearing the heading “Interim Procedures between 4/1 and 9/7,” discussing workarounds to be adopted while the incomplete system was further developed. (See, e.g., Ex. 2044, pp. 17-19.) Under the heading “Service Evolution,” suggesting that this functionality was not yet complete or tested, the Requirements Document

describes that “[t]wo-way communication is the ultimate goal for this interface, so that when a customer logs onto our server from their PC, their Active view is pulled from the ISCP instead of from a saved version in SMS. This will ensure that any DTMF updates are reflected in the PC file, which today they are not.” (Ex. 2044, pp. 5, 23.) Ms. Watson-Williams’ deposition testimony confirmed her understanding that two-way communication was an important goal for the system, yet was not implemented at the time of the document’s generation. (Ex. 1028, 80:4-81:5.)

In another example, AT&T’s evidence of actual reduction to practice for claim 10 begins “[o]ne possible evolution,” demonstrating that the functionality was even then merely contemplated.

Taken as a whole, the Requirements Document describes nothing more than a work in progress. The plain language of the Requirements Document therefore casts doubt on whether the system was operable for its intended purpose.

Nor can AT&T argue (which it hasn’t) that the Requirements Document would be sufficient to establish *conception* as of the document’s “Revision Date.” “Conception is ‘the formation, in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice.’” *In re Steed*, 802 F.3d 1311, 1320 (Fed. Cir. 2015). The Requirements Document cannot meet this standard, at least because of the



numerous open issues with the operability of important functionality of the purported invention, (*See* Ex. 2044, pp. 17-23), and AT&T has presented *no* evidence to support a finding of diligence in reducing the invention to practice. (A party seeking to show diligence must do so for the period beginning just prior to the “critical date” of a competing reference, through an actual or constructive reduction to practice. *See* M.P.E.P. §§ 715.07, 2138.06. “Merely asserting diligence is not enough; a party must ‘account for the entire period during which diligence is required.’” *Creative Compounds, LLC v. Starmark Lab’s*, 651 F.3d 1303, 1312-13 (Fed. Cir. 2011)). Here, AT&T would be required to show diligence from the time of filing of the An Provisional on October 23, 1996 through, at the *earliest*, the filing of the provisional of the ’714 patent on April 3, 1997, a period of six months, but has not presented any supporting evidence. (*See* Exs. 1001, 1005.)

### **III. CONCLUSION**

For the foregoing reasons and those set forth in the Revised Amended Petition, the challenged claims of the ’714 patent are unpatentable and should be canceled.

Dated: June 30, 2016

Respectfully submitted,

By: /Steven M. Bauer/  
Steven M. Bauer, Reg. No. 31,481  
Joseph A. Capraro Jr., Reg. No. 36,471  
Proskauer Rose LLP  
One International Place  
Boston, MA 02110  
Tel: (617) 526-9600

**CERTIFICATION OF WORD COUNT 37 C.F.R. § 42.24(d)**

Pursuant to 37 C.F.R. § 42.24(d), I hereby certify that this Petitioner's Reply to Patent Owner's Response is 5,387 words in length, as determined by the word count feature of the Microsoft Word word-processing system used to prepare this paper, excluding any table of contents, certificate of service or word count, or table of exhibits.

Dated: June 30, 2016

Respectfully submitted,

/Steven M. Bauer/  
Steven M. Bauer  
Registration No. 31,481  
Proskauer Rose LLP  
Attorney for Petitioner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*Inter Partes* Review Case No. IPR2015-01227

*Inter Partes* Review of: U.S. Patent No. 7,907,714

Title: Profile Management System Including User Interface for Accessing and Maintaining Profile Data of User Subscribed Telephony Services

**CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)**

Dear Sir:

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on June 30, 2016, I caused a complete copy of Petitioner's Reply to Patent Owner's Response and all supporting exhibits to be served on the Patent Owner of the subject *Inter Partes* Review via electronic mail.

David W. O'Brien  
HAYNES AND BOONE, LLP  
2323 Victory Avenue, Suite 700  
Dallas, TX 75219

By: /Scott Bertulli/  
Scott Bertulli  
Proskauer Rose LLP  
One International Place  
Boston, MA 02110  
Tel: (617) 526-9600  
Fax: (617) 526-9899  
Attorney for Petitioner, Cox Communications, Inc.