Paper No._____

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COX COMMUNICATIONS, INC.,
Petitioner

v.

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

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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

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PATENT OWNER'S SUBMISSION REGARDING IMPROPER SCOPE OF PETITIONER'S REPLY

I. Introduction

Pursuant to the authorization granted in the Order entered July 5, 2016 (Paper 49) Patent Owner AT&T Intellectual Property I, L.P. ("AT&T") submits this itemized listing of statements in the Petitioner's Reply (Paper 48) that are beyond the proper scope of a reply. All portions of Exhibit 1027 that are cited in the portions identified in the itemized listing below are also beyond the proper scope of reply. AT&T herein submits facts and statements of law or regulation, and no argument.

A. Entirety of Section II.B.2 of Petitioner's Reply titled "An's claims are fully supported by the An Provisional" (Appearing from Page 5, line 14 through Page 23, line 29)

In Section II.B.2, Petitioner's Reply argues "An's claims are fully supported by the An Provisional." Reply, p. 5. The entirety of this section is beyond the proper scope of a reply.

Petitioner previously argued only that the "*An Provisional* Application, to which *An* claims priority, fully supports and explicitly describes *An*'s disclosure of the features claimed by the '714 patent, as shown at least in Table C, below." Revised Amended Petition, p. 17 (underlined emphasis added). Table C did not map any claims of US Patent 6,031,904 (the *An* Patent) to the *An Provisional*, and Petitioner presented no argument or evidence in the Revised Amended Petition to show that the *claims* of *An* were supported by the *An Provisional* application.

In Section II.B.2 of the Reply, Petitioner now presents 19 pages of argument (including a claim chart, at pp. 8-23) and evidence (Ex. 1027, ¶ 25, pp. 14-41) to argue that the claims of *An* are supported by the *An Provisional* application. "Examples of indications that a new issue has been raised in a reply include 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." Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012).

Respectfully submitted,

/David W. O'Brien/
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HAYNES AND BOONE, LLP

Dated: July 11, 2016

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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	July 11, 2016
Manner of service	Electronic mail
Documents served	Patent Owner's Submission Regarding Improper Scope of Petitioner's Reply
Persons served	Steven M. Bauer Proskauer Rose LLP One International Place Boston, MA 02110 PTABMattersBoston@proskauer.com

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