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 RESPONSE TO PATENT OWNER'S SUBMISSION REGARDING SCOPE OF PETITIONER'S REPLY**

Pursuant to the authorization granted in the Board's Order of July 5, 2016 (Paper 49), Petitioner ("Cox") hereby submits an item-by-item response to the items identified in Patent Owner's submission (Paper 51) that Patent Owner contends exceed the proper scope of Petitioner's Reply (Paper 48).

| **Portion of Petitioner's Reply (Paper 48) Which Patent Owner Contends is Outside the Scope** | **Portion of Patent Owner's Response (Paper 40) to Which Petitioner's Reply is Responsive** |
|---|---|
| Page 5, line 14 – Page 23, line 29. | Page 2, lines 4 – 14;<br>Page 4, lines 1 – 11;<br>Page 44, line 4 – Page 46, line 1;<br>Page 46, line 20 – Page 53, line 13. |

Although the Board directed that there should be no argument, in Patent Owner's submission, AT&T argues that the entire section showing the An Provisional's support of An's claims—which includes a claim chart mapping the claims of An to the corresponding support in the An Provisional—is "new evidence," citing the Office Patent Trial Practice Guide.

In Patent Owner's Response, to which this portion is responsive, AT&T argued that An is not entitled to the An Provisional application's priority date. The arguments advanced in AT&T's Response, questioning whether there was support for the claims in the An Provisional, shifted the burden of production to Cox. *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 portion of Petitioner's Reply identified by AT&T is responsive to AT&T's arguments regarding the An Provisional, and is therefore well within the proper scope of a Petitioner's Reply. The portion of Petitioner's Reply objected to by Patent Owner provides confirmation that the An Provisional application contains support for the claims of the An utility application.

Dated: July 18, 2016

Respectfully submitted,

By: /Steven M. Bauer/
Steven M. Bauer, Reg. No. 31,481
Proskauer Rose LLP

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 July 18, 2016, I caused a complete copy of Petitioner's Response to Patent Owner's Submission Regarding Scope of Petitioner's Reply 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: /Gerald E. Worth/
Gerald E. Worth
Proskauer Rose LLP
One International Place
Boston, MA 02110
Tel: (617) 526-9600
Fax: (617) 526-9899
Attorney for Petitioner, Cox Communications, Inc.