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 SURREPLY

Pursuant to the Order entered July 11, 2016 (Paper 50), Patent Owner ("AT&T") submits this surreply. Petitioner ("Cox") cannot, by its factually unsupported and legally unsustainable arguments, overcome AT&T's evidence that, prior to the *An Provisional*, challenged claims of the '714 Patent were actually reduced to practice in the form of the commercially-available Positive ID system.

I. Invention Was Actually Reduced to Practice Prior to *An Provisional*.

Actual reduction to practice is established where the inventors have "constructed an embodiment or performed a process that met all the limitations" and "determined that the invention would work for its intended purpose." *In re Omeprazole Patent Lit.*, 536 F.3d 1361, 1373 (Fed. Cir. 2008). Regarding the first inquiry, Dr. Akl compared each challenged claim with a Requirements Document (Ex. 2044) describing operation of the Positive ID system and identified specific evidence supporting the conclusion that each element of each claim was performed in the described system. Ex. 2043, pp. 46-52. Strikingly, Cox's expert, Dr. Mir has not even reviewed Ex. 2044 to evaluate correspondence of the Positive ID system with the challenged claims, and Dr. Mir confirmed during cross-examination that he has "no opinions regarding Exhibit 2044." Ex. 2051, 71:21-73:1.

Cox does not dispute the substantive evidentiary value of the Requirements Document. Rather, Cox questions whether the commercially-available Positive ID system described by the Requirements Document was "operable for its intended

purpose." Reply, p. 24. In a quest to distract from the overwhelming evidence of actual reduction to practice, Cox alleges uncertain authenticity, hypothecates untested product features unanchored to any challenged claim, and invites the Board to discredit Dr. Akl for not opining on issues that are within the personal knowledge ***and testimony*** of another witness or are irrelevant to the challenged claims.

A. Dr. Akl's Opinion that Every Element of the Challenged Claims finds Support in the Requirements Document is Unchallenged

In an attempt to discredit rather than challenge, Cox mischaracterizes Dr. Akl's testimony. However, the record shows that Dr. Akl confirms the relevant factual basis. He states that the Positive ID system described in the Requirements Document "supports an actual reduction to practice" (which is unchallenged) and he provides citations "supporting a conclusion that each element of the challenged claims was actually reduced to practice." Ex. 2043, ¶ 95. Cox failed to challenge Dr. Akl on the substance of his analysis, and it is before the Board unrebutted.

Cox's characterization of testimony as "conclusory" or as failing to address intended purpose is a distraction, as Dr. Akl's testimony is offered to establish correspondence of the Positive ID system documentation with the claims. Cox complains that "Dr. Akl was unable to say what the standard was that he used to make the conclusory statement" that the Requirements Document shows an actual reduction to practice. Reply, p. 25. But that's not really true; Cox never asked the question that it alleges was unanswered and indeed, Dr. Akl, explained his

understanding as "implement[ing] the invention" such as in the form of a "prototype … [or] a working model." Ex. 1026, 56:18-59:5.

B. The Positive ID Service Worked for its Intended Purpose.

Cox notes that Dr. Akl offers no opinion on whether the system operated for its intended purpose. So what? That conclusion is supported by testimony of Ms. Watson-Williams, who concludes, based on first-hand knowledge and experience with the Positive ID system, that "the Positive ID service as described was operational as of July 17, 1996, as supported by the [Requirements Document] and my personal knowledge." Ex. 2045, ¶ 14. The record is replete with evidence that the claimed invention operated for its intended purpose. Under a heading "Usability Tests for Positive ID," the authors reported "[n]o substantial problems or bugs" and "it appears that the software is usable and friendly." Ex. 2044, p. 22.

Cox's focus on manual work-arounds and future functionality of "Application Manager" software is simple misdirection. As explained by Ex. 2044, "App Manager" and "Positive ID" are separate software packages. Ex. 2044, pp. 6, 11. Ms. Watson-Williams established that Positive ID, which embodies the challenged claims of the '714 Patent, operated for its intended purpose and was tested and fully functional. ***Application Manager is irrelevant***, and it is very telling that Cox's technical expert, Dr. Mir fails to associate any manual work around or future functionality with any limitation of any challenged claim.

Cox cherry-picks from the '714 Patent Specification to imply a *no reliance on service personnel* intended purpose that it alleges is incompatible with existence of a help desk for telephonic inquiries. Reply, pp. 26-27. It is telling (again) that Cox's technical expert, Dr. Mir fails to opine as to the intended purpose of any challenged claim. Often, the "intended purpose" of an invention can be determined from the claims themselves. *Manning v. Paradis*, 296 F. 3d 1098, 1102 (Fed. Cir. 2002). Here, claim 1 is instructive in that its preamble recites an intended purpose of "managing, by a profile management system, subscriber profile data associated with a communications service subscribed to by a subscriber." Ex. 1001, Claim 1.

The Positive ID system clearly worked for that purpose. As Ms. Watson-Williams describes, "[t]he Positive ID service provided a subscriber with the ability to manage the calling telephone numbers that were allowed access to the subscriber's telephone numbers." Ex. 2045, ¶ 11. There is no indication from the evidence that the "interim procedures" or "help desk" personnel referenced by Cox meant that subscriber profile data could not be managed in the intended manner.

Cox also alleges, based on "desired yet unavailable functionality," that the invention was not yet operable. But Cox fails to tie any supposedly "unavailable functionality" to any challenged claim. Futhermore, while Positive ID was commercially available (Ex. 1011) and deployed to consumers, there is "no requirement that an invention, when tested, be in a commercially satisfactory stage

of development in order to reduce the invention to practice." *DSL Dynamic Sciences Ltd. v. Union Switch & Signal, Inc.,* 928 F. 2d 1122, 1126 (Fed. Cir. 1991). There is no evidence to suggest any absence of functionality prevented the managing of subscriber profile data and, again, no testimony from Cox's expert.

C. Exhibit 2044 is Authentic and Cox's Challenges are Untimely

Cox challenges authenticity of Exhibit 2044. Reply, p. 25. The challenge is untimely and specious. Authenticity arguments are proper only in a motion to exclude, which Cox cannot file, as it failed to timely object. In any case, the Requirements Document was included in the provisional application to which the '714 Patent claims priority (Ex. 2039, pp. 95-118), is found in AT&T's records and those of the USPTO, and was entered into this record during Dr. Mir's deposition. Ms. Watson-Williams independently authenticated the document and its contents, stating that the July 17, 1996 date "is accurate and consistent with my experience and knowledge of the development and deployment of the Positive ID service" and that the "contents of the document are accurate." Ex. 2045, ¶ 10. The Requirements Document is over 20 years old and its authenticity has been established.

II. Conclusion

Cox's arguments and its lack of evidence cannot overcome AT&T's evidence-backed showing that challenged claims of the '714 Patent were actually reduced to practice as of July 17, 1996, well before *An* or the *An Provisional*.

Respectfully submitted,

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Dated: July 25, 2016

IPR2015-01227

Cox Communications, Inc.

v.

AT&T Intellectual Property I, L.P.

Patent Owner's Exhibit List

July 25, 2016

ATT-2001	Docket Report – AT&T Intellectual Property I, L.P. *et al*. v. Cox Communications, Inc., *et al.*, Case No. 14-1106-GMS (D. Del.)
ATT-2002	Complaint – AT&T Intellectual Property I, L.P. *et al*. v. Cox Communications, Inc., *et al.*, 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. *et al*. v. Cox Communications, Inc., *et al.*, Case No. 14-1106-GMS (D. Del.)
ATT-2004	Defendants' Answer, Affirmative Defenses, and Counterclaims – Document 38, AT&T Intellectual Property I, L.P. *et al*. v. Cox Communications, Inc., *et al.*, Case No. 14-1106-GMS (D. Del.)
ATT-2005	Aggregated Rule 7.1 Statements of Defendants – AT&T Intellectual Property I, L.P. *et al*. v. Cox Communications, Inc., *et al.*, 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. *et al*., 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. *et al.* v. Cox Communications, Inc., *et al.*, 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. *et al*., Case No. 11-cv-2683 JAR (D. Kansas)
ATT-2012	Complaint – Cox Communications, Inc., *et al*. v. Sprint Communications Company *et al*. (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. et al., Case No. 14-870-GMS (D. Del. Sept. 3, 2014)
ATT-2015	IPR2015-01477 – Petition for *Inter Partes* Review of U.S. Patent No. 6,587,046
ATT-2016	IPR2015-01477 – Petitioners' Power of Attorney
ATT-2017	IPR2015-01760 – Petition for *Inter Partes* Review of U.S. Patent No. 6,549,130

ATT-2018	IPR2015-01796 – Petition for *Inter Partes* 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 *Inter Partes* 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. *et al*. v. Cox Communications, Inc., *et al*., 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, *available at* 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, *available at* 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)
ATT-2030	Brian J. Love & Shawn Ambwani, Inter Partes *Review: An Early*

	Look at the Numbers, 81 U. CHI. L. REV. DIALOGUE 93, 93–95 (2014), https://lawreview.uchicago.edu/page/inter-partes-review-early-look-numbers.
ATT-2031	[CONFIDENTIAL – FILED UNDER SEAL]
ATT-2032	Terms of Sale and Software License Agreement, Cisco Systems Inc., *available at* http://www.cisco.com/web/about/doing_business/legal/docs/tc-us.pdf (last retrieved January 12, 2016).
ATT-2033	Cisco Systems, Inc. v. Sprint Communications Company L.P., Complaint for Declaratory Judgment, May 28, 2015 (D. Del.).
ATT-2034	Cox Selects Broadsoft's Platform For VoIP, TMCNews, *available at* http://technews.tmcnet.com/hosted-voip/feature/articles/7784-cox-selects-broadsofts-platform-voip.htm (last retrieved January 12, 2016).
ATT-2035	AT&T Preliminary Infringement Contentions, Exhibit G38, Case No. 14-1106-GMS (D. Del.).
ATT-2036	Broadsoft, Inc. v. CallWave Communications, LLC, Complaint for Declaratory Judgment, April 23, 2013 (D. Del.).
ATT-2037	Sprint Communications, L.P., v. Cox Communications, Inc., Memorandum and Order, Sept. 14, 2012 (D. Kansas).
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, 2nd ed. (excerpt)
ATT-2048	Annotated Figure 3 from Exhibit 1004 (Buhrmann)
ATT-2049	Microsoft Computer Dictionary, Fourth Edition (excerpt)
ATT-2050	Declaration of James A. Shimota
ATT-2051	Transcript of Deposition of Nader F. Mir, Ph.D taken July 18, 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 25, 2016
Manner of service	Electronic mail
Documents served	Patent Owner's Surreply Exhibit 2051
Persons served	Steven M. Bauer Proskauer Rose LLP One International Place Boston, MA 02110 PTABMattersBoston@proskauer.com

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