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

_____

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 MOTION FOR OBSERVATIONS REGARDING CROSS-EXAMINATION OF DR. NADER MIR

I. Introduction

Patent Owner AT&T Intellectual Property I, L.P. ("AT&T") submits the following Motion for Observation Regarding Cross-Examination of Dr. Nader Mir, Petitioner's reply witness. The transcript of Dr. Mir's cross-examination was previously filed as Exhibit 2051.

References to the "Patent Owner Response" are to be understood to refer to Paper 40, AT&T's Patent Owner Response filed April 29, 2016.

References to the "first Declaration" are to be understood to refer to Exhibit 1014, the Declaration of Professor Nader Mir, Ph.D., in Support of Request for *Inter Partes* Review of the '714 Patent, submitted May 19, 2015. References to the "Reply Declaration" are to be understood to refer to Exhibit 1027, the Reply Declaration of Professor Nader Mir, Ph.D., submitted June 30, 2016. References to the "Reply" are to be understood to refer to Paper 48, the Petitioner's Reply to Patent Owner's Response filed June 30, 2016.

Observation 1: In Exhibit 2051, from page 26, line 17 through page 29, line 4, Dr. Mir testified that Exhibit 1014, his first Declaration submitted with the Petition, did not contain a full listing of citations needed to show that the An Provisional provides written description support for the claims of An. This testimony is relevant because it confirms AT&T's contention that Cox's Reply exceeds the proper scope of a reply, as it belatedly submits evidence. "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).

Observation 2: In Exhibit 2051, at page 33, lines 1-6, Dr. Mir testified that the pages cited[1] as allegedly supporting claim element 1[e] of An were not cited in his first declaration, Exhibit 1014. As with Observation 1, this testimony is relevant because it confirms AT&T's contention that Cox's Reply exceeds the proper scope of a reply, as it belatedly submits evidence that would have been necessary to make out a *prima facie* case in its Petition. This testimony is also relevant because it confirms AT&T's contention that Cox failed to carry its burden of production under *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015), the *inter partes* review statutes and subsequent decisions of the Board[2] that require Cox to have proven entitlement to priority of the An Provisional in its Revised Amended Petition.

[1] That is, pages from the An Provisional cited in the Reply Declaration.

[2] As detailed in the Patent Owner Response, pp. 44-45; pp. 49-51.

Observation 3: In Exhibit 2051, at page 36, lines 1-7, Dr. Mir testified that nothing prevented him from submitting Table 1 in connection with his first declaration, Exhibit 1014. As with Observations 1-2, this testimony is relevant because it confirms AT&T's contention that Cox's Reply exceeds the proper scope, as it presents evidence that could have been submitted earlier.

Observation 4: In Exhibit 2051, at page 43, lines 6-12, Dr. Mir testified that he could not find anything that supports the An claim language "wherein the server performs a protocol conversion dependent on a type of service manager node" in his first declaration, Exhibit 1014. This testimony is relevant because it confirms AT&T's contention that Cox did not supply sufficient evidence in the Revised Amended Petition to show that the claims of An were supported by the An Provisional and failed to carry its burden of production under *Dynamic Drinkware,* statute and subsequent decisions of the Board. *See* Patent Owner Response, pp. 44-45; pp. 49-51. Additionally, as with Observations 1-3, this testimony is relevant because it confirms AT&T's contention that Cox's Reply exceeds the proper scope of a reply, as it belatedly submits evidence.

Observation 5: In Exhibit 2051, at page 55, line 16-24, Dr. Mir testified that he did not recall whether the word "conversion" or the term "protocol conversion" appear in the An Provisional. This testimony is relevant because it confirms AT&T's contention that the An Provisional does not support the claims

of An, as each independent claim of An recites the term "protocol conversion." *See* Patent Owner Response, pp. 53-55.

Observation 6: In Exhibit 2051, at page 56, line 9-20, Dr. Mir testified that he did not recall whether the phrases "changing a protocol" or "modifying a protocol" appear in the An Provisional. This testimony is relevant because it confirms AT&T's contention that the An Provisional does not support the claims of An, as each independent claim of An recites the term "protocol conversion," which Dr. Mir indicates he understands as "changing" or "modifying" a protocol. *See* Patent Owner Response, pp. 53-55; Exhibit 1027, ¶ 13.

Observation 7: In Exhibit 2051, at page 70, line 1-7, Dr. Mir testified that his first declaration, Exhibit 1014, did not consider the An Provisional's enablement of the An claims, and that he could have performed that analysis for the first declaration. As with Observations 1-4, this testimony is relevant because it confirms AT&T's contention that Cox's Reply exceeds the proper scope of a reply, as it belatedly submits evidence.

Respectfully submitted,

/David W. O'Brien/
David W. O'Brien, Reg. No. 40,107
HAYNES AND BOONE, LLP

Dated: July 29, 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 29, 2016

Manner of service Electronic mail

Documents served Patent Owner's Motion for Observations

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