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 MOTION FOR OBSERVATIONS REGARDING CROSS EXAMINATION

Per the Scheduling Order in this proceeding, a motion for observation provides "a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness because no further substantive paper is permitted after the reply." (Paper 14, p. 4.) Patent Owner ("AT&T"), instead, improperly uses its observations as a vehicle to supplement its Response in conflict with the express guidance of the Trial Practice Guide. *See* PTAB Trial Practice Guide, 77 Fed. Reg. 48756, 48768 ("An observation (or response) is not an opportunity to raise new issues, re-argue issues, or pursue objections."). AT&T's observations also include attorney argument, mischaracterizations of Dr. Mir's testimony, and omissions of other relevant portions of Dr. Mir's testimony that provide the full context of each issue. Petitioner ("Cox") hereby objects to AT&T's improper use of its observations. Petitioner's Responses below provide proper context for AT&T's observations and identify the mischaracterizations of Dr. Mir's testimony.

Response to Observation 1:

AT&T mischaracterizes Dr. Mir's testimony by ignoring that Dr. Mir confirms that his first Declaration is consistent with his continuing opinion that the An Provisional fully supports An. ("However, you are seeing the sentence in paragraph 101, I put a quote here, "My review of the An Provisional shows that it fully describes the substance of the subject matter claimed in An...";" Ex. 2051, 27:21 – 28:9.) Also, AT&T improperly re-argues the scope of Petitioner's Reply

in this observation.

Response to Observation 2:

AT&T improperly re-argues both its incorrect interpretation of *Dynamic Drinkware* and the scope of Petitioner's Reply in this observation.

Response to Observation 3:

AT&T mischaracterizes Dr. Mir's testimony by ignoring the full context of this line of questioning, in which Dr. Mir confirms that there was no need to submit Table 1 in connection with his first declaration. ("Q. But, you know, just to be clear, you didn't submit a table -- you didn't submit anything like the claim chart in Table 1 with respect to your original declaration; right? A. No. There was no need for it;" Ex. 2051, 36:8-12.) Also, AT&T improperly re-argues the scope of Petitioner's Reply in this observation.

Response to Observation 4:

AT&T improperly re-argues both its incorrect interpretation of *Dynamic Drinkware* and the scope of Petitioner's Reply in this observation.

Response to Observation 5:

AT&T mischaracterizes Dr. Mir's testimony by ignoring the full context of the testimony and failing to include portions of the deposition transcript in which Dr. Mir goes on to clarify that the word "conversion" or the term "protocol conversion" does not need to literally appear in the An Provisional for him to

identify the required support for “protocol conversion.” (“…But I came across with the exact equivalent to "protocol conversion" or the "conversion;” Ex. 2051, 56:1-3.) Also, AT&T improperly re-argues the scope of Petitioner’s Reply in this observation.

Response to Observation 6:

AT&T mischaracterizes Dr. Mir’s testimony by ignoring the full context of the testimony and failing to include portions of the deposition transcript that provide necessary context for the cited passage in this observation. The phrases “changing a protocol” and “modifying a protocol” are phrases used by AT&T’s expert Dr. Akl – not An or the An Provisional –to describe a “protocol conversion.” Dr. Mir only expresses agreement with Dr. Akl’s understanding of these phrases, not that these phrases must appear literally in the An Provisional. (“Q… you can agree with Dr. Akl that in general, protocol conversion would be understood to mean changing or modifying a protocol; correct? A. That's correct;” Ex. 2051, 56:4-8.)

Response to Observation 7:

AT&T mischaracterizes Dr. Mir’s testimony by ignoring the full context of this line of questioning, in which Dr. Mir confirms that there was no reason to perform an enablement analysis in his first declaration. (“Q. You could have performed that analysis in your original declaration; correct? A. Correct. And I did

not see any reason to do so;" Ex. 2051, 70:5-8.) Also, AT&T improperly re-argues the scope of Petitioner's Reply in this observation.

Dated: August 5, 2016

Respectfully submitted,

By: /Steven M. Bauer/
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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 August 5, 2016, I caused a complete copy of Petitioner's Response to Patent Owner's Motion for Observations Regarding Cross Examination to be served on the Patent Owner of the subject *Inter Partes* Review via electronic mail.

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