

Paper No. _____

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

PATENT OWNER'S SECOND SURREPLY

AT&T submits this *restricted* surreply to address Cox's untimely arguments and evidence. Cox's factually unsupported and legally unsustainable arguments do not establish that claims of An are entitled to the filing date of the An Provisional.

I. Cox Cannot Show Entitlement to the *An Provisional* Filing Date.

A. "Protocol Conversion" As Recited is Not Supported.

Dr. Mir admitted that he could not find the An claim language "protocol conversion" in the An Provisional. Ex. 2051, 55:16-24. While *ipsis verbis* support is not required, "protocol conversion dependent on the type of service manager node" *does not* necessarily follow from anything actually disclosed. Dr. Mir interprets "protocol conversion" as "converting a protocol," "changing a protocol" or "modifying a protocol," but his first interpretation is circular, and neither "changing" nor "modifying" a protocol appears in An or the An Provisional. Ex. 2051, 56:9-20.

Dr. Mir also suggests that "format[ing] them in a service manager specific protocol," is "analogous to '*protocol conversion*.'" Reply, p. 6; Ex. 1027, ¶ 14. But his unsupported conclusion only asserts that such "formatting" is "analogous"; he does not state that "protocol conversion" necessarily follows from "formatting," nor does it. Dr. Mir's "formatting" opinion on is also admittedly based in hindsight:

Dr. Mir: "If you are asking me now, I would say formatting does change...However, if you're asking formatting in the critical year, I need time to render my opinion to go and do research before I answer. 'Formatting' could mean other things." Ex. 2051, 61:3-8.

Dr. Akl has testified that this portion of the An Provisional is *insufficient* to support the claim language, and review of the claim and the alleged “support” reveals little correspondence. Ex. 2043, ¶ 87. Claim 1 recites (with similar language in other independent claims) “the server performs a protocol conversion dependent on the type of the service manager node.” Cox’s alleged “support” is that the “ServiceManagerAdaptor ... receives transactions from the Dispatcher, formats them in a ServiceManager specific protocol....” Reply, pp. 7, 10-11. This language is insufficient to establish written description support for An’s claims.

In particular, missing from Cox’s “support” is any identification of the recited “service manager *node*”. Dr. Akl previously noted this deficiency of the An Provisional. Ex. 2043, ¶ 86 (“there is no mention of ‘service manager *nodes*...’”). To skirt the issue, Dr. Mir incorrectly equates “ServiceManagers” with the “service manager node.” *See* Ex. 1027, ¶ 16. Dr. Mir’s opinion is inconsistent with the understanding of a person of ordinary skill in the art. For example, Figure 5 of the An Provisional (cited by Cox) depicts the “ServiceManager” and the “Service Mgmt Node” (which the An patent notes is a “service manager node”) as *different elements*. Reply, p. 11; Ex. 1005, 7:7-9. An’s claim language supports this clear distinction, reciting a “service manager program on a service manager *node*,” and An further differentiates between “service managers” which are “running on service manager nodes,” and “service manager *nodes*” themselves, which are “processing

platforms for running the service managers...” Ex. 1005, 3:20-23.

As the “service manager *node*” and “ServiceManagers” are not the same, Cox’s identified language of “formats them in a ServiceManager specific protocol” cannot support “protocol conversion dependent on the type of service manager *node*” as recited. There is nothing else in the An Provisional to support “formatting” or “conversion” to a service manager *node*-specific protocol, or anything similar. Dr. Mir’s conclusions alleging support for “multiple ServiceManagers” are also insufficient, as they require that one *read out* the term “*node*” from An’s claims.

Thus, because “protocol conversion,” under any interpretation is not supported by the An Provisional, and because a “service manager *node*” is not equivalent to a “ServiceManager” as Cox contends, the Board cannot find support by a preponderance of the evidence for “protocol conversion dependent on a type of service manager node” by referring to “formats them in a ServiceManager specific protocol,” as Cox argues. Cox’s Reply cites additional pages of the An Provisional as alleged support for elements [1e], [7e], [11e], [14e], and [15e], which also recite a “service manager node” or “service node.” The Board’s Order (paper 63) precludes AT&T from factually rebutting Cox (with testimonial and documentary evidence), but regardless, Cox’s new Reply citations do not establish support for the An claims.

This lack of evidence is fatal to Cox’s contentions that the An Provisional provides written description support for independent claims 1, 7, 11, 14, and 15 of

An, and fatal to its contentions that An is prior art to the '714 Patent.

B. Other Limitations of An's Claims Are Unsupported.

“Protocol conversion” is not the only claim language lacking support in the An Provisional. Claim element [1d] of An recites “a profile repository storing the feature profiles, the profile repository managed by a service manager program on a service manager node.” Cox’s untimely Reply quotes language in the An Provisional to support only the first portion of that claim element. Completely missing from the quoted language, and from Cox’s analysis, is support for a “profile repository managed by a service manager program on a service manager node” as recited in the remainder of the claim element. Reply, p. 10. Cox’s incomplete analysis cannot support a finding of § 112 ¶ 1 support for claim 1. The same language is cited for claim element [7d], and fails for the same reasons.

Claim element [11e] of An recites “a service manager program that manages the feature profile repository,” with similar language in element [14e] and [15e]. Cox cites approximately 21 pages of the An Provisional as allegedly providing § 112 ¶ 1 support for this claim feature, but fails to point out any support with particularity. Reply, pp. 17-18. The Board cannot “play archeologist with the record” to determine whether or how the An claims are supported, particularly where the Board denies AT&T a full response to Cox’s untimely Reply. *See Ariosa Diagnostics v. Verinata Health*, IPR2013-00276, slip op. at 17 (PTAB Oct. 23, 2014) (Paper 43). Cox has

failed in meeting its burden with respect to these elements of the An claims.

C. The Board Should Assign Little Weight to Cox's Arguments for Their Repeated Misrepresentations.

Cox's argument that Dr. Akl "conflated 'conversion' with 'encapsulation'" is misdirection. *See* Reply, p. 6. Dr. Akl states, in no uncertain terms, that "[e]ncapsulation, in computer science, is not equivalent to conversion." Ex. 2043, ¶ 86. Cox also misrepresents the record when it relies on Dr. Mir's allegation that "An's specification differentiates between 'conversion' and 'encapsulation,'" quoting An's specification. Ex. 1027, ¶ 14. An does not even use the term "conversion."

Dr. Mir also asserts multiple times that he "previously provided" an opinion regarding the support for the claims of An. Ex. 1027, ¶¶ 11, 15. But his "previously provided opinion" contained no citation or quotation to the An claims, so it is unclear why Dr. Mir believes he has a relevant "previous[] opinion" on the subject.

Moreover, Cox and Dr. Mir base their disagreement with Dr. Akl's view that the claim language requires support for "multiple types of service manager nodes" on their own inappropriately limited view of the claim language. Cox and Dr. Mir assert that the An claim language references "merely '*a type*' or '*the type*' of service manager node, conveniently omitting the context of the claim language which recites "a protocol conversion *dependent on the type* of service manager node." A person of ordinary skill in the art would recognize that "dependent on the type of service manager node" clearly implies the existence of at least two types of service

manager nodes, and the conversion is performed dependent on the one type or the other type of service manager node. Dr. Mir agrees:

Q: “So when you’re referring to the claim which it says it depends on the type of service manager node, you would agree with me that it could include multiple types of service manager nodes; right?”

Dr. Mir: “Yes, it could be. Yeah.” Ex. 2051, 52:19-24.

II. Cox Misunderstands Dynamic Drinkware.

Cox’s “*Dynamic Drinkware* in context” argument is replete with misrepresentations of the case law. First, Cox asserts that the Federal Circuit added a requirement in its *Dynamic Drinkware* opinion. That is flatly wrong. As noted during oral hearing, the requirement that claims in a reference be supported by the reference’s earlier application was established 35 years ago in *Wertheim* (“the application, the filing date of which is needed to make a rejection, must disclose, pursuant to §§ 120/112, the invention claimed in the reference patent”), confirmed six years ago in *Giacomini* (“[a]n important limitation is that the provisional application must provide written description support for the claimed invention”) (**which was cited by Cox**), and was merely reaffirmed in *Dynamic Drinkware*. Cox’s ignorance of the *Wertheim/Giacomini/ Dynamic Drinkware* case law is no excuse.

In its surreply authorization, the Board seems inclined to excuse Cox’s error by noting that *Drinkware* issued after Cox’s Revised Amended Petition. However, the Board may not sacrifice AT&T’s due process on this *ex post* justification.

Drinkware issued on Sept. 4, 2015, and institution occurred on Nov. 19, 2015, giving Cox 2 ½ months to request additional briefing. Furthermore, after institution, Cox could have requested a motion to submit supplemental information under 37 C.F.R. § 42.123. In either case, AT&T would have had a “full and fair opportunity” to respond in its PO Response to Cox’s incorrect conclusions. Instead, AT&T must address Cox’s untimely arguments in this **restricted** (no evidence) sur-reply. Expungement and prohibition of documentary and testimonial evidence (Paper 63) undermines AT&T’s “full and fair opportunity” to respond to Cox’s untimely Reply.

Cox asserts that it timely satisfied its burden of production on the written description. Reply, p. 5. But again, Cox is wrong. Cox fails to recognize that, unlike the *Dynamic Drinkware* petitioner, Cox had the **initial** burden of production. As the Board acknowledged, “it was clear that Petitioner...was relying on the filing date of the An provisional application...” Paper 61, p. 2. Thus, to satisfy its **initial** burden of production, such that the burden would shift to AT&T, Cox was required to show **in the Petition** support in the An Provisional for the An claims. *See, e.g., Alarm.com v. Vivint, Inc.*, IPR2016-00129, slip op. at 16 (PTAB May 3, 2016) (Paper 13) (burden initially on petitioner); *MasterImage 3D, Inc. v. RealD, Inc.*, IPR2015-00035, slip op. at 10 (PTAB April 20, 2016) (Paper 79) (burden initially on petitioner). Cox did not provide such a showing in the Petition. Its Reply showing is untimely, and the Board cannot consider its untimely argument or evidence. 37 C.F.R. § 42.23(b).

Respectfully submitted,

/David W. O'Brien/

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

Dated: September 12, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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 September 12, 2016

Manner of service Electronic mail

Documents served Patent Owner's Second Surreply

Persons served Steven M. Bauer
Proskauer Rose LLP
One International Place
Boston, MA 02110
PTABMattersBoston@proskauer.com

/David W. O'Brien/

David W. O'Brien

Registration No. 40,107