

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Twilio Inc.
Petitioner

v.

TeleSign Corporation
Patent Owner

Patent No. 7,945,034

Patent Filing Date: October 31, 2005

Title: PROCESS FOR DETERMINING CHARACTERISTICS OF A
TELEPHONE NUMBER

Inter Partes Review No.: IPR2016-00360

PATENT OWNER'S MOTION FOR OBSERVATIONS

Patent Owner TeleSign submits the following observations on the January 16, 2017 cross-examination of Petitioner Twilio's reply declarant Mr. David H. Williams (Ex. 2036).

1. Williams testified that he could not opine on what someone without 4 years of direct e911 experience would understand Nguyen to disclose, at 150:25-158:2, 165:16-167:20 and 169:12-171:3. This testimony is relevant to paragraphs 12, 14, 46, 48, 49, and 50 of Mr. Williams's declaration (Ex. 1039) and to the assertions regarding how a formerly agreed-upon POSA would understand Nguyen's discussion of the E911 system, for example at pages 16-17 of the Reply (Paper No. 37), pages 1-2, 14, 28-29, and 52-53 of the Petition (Paper No. 2), and pages 60-64 in the Response (Paper No. 27). This testimony is relevant because it shows that Mr. Williams disqualified himself from opining on what a POSA would understand Nguyen to disclose given that the parties have agreed that a POSA does not require such four years of direct work experience. (*See* Resp. at § 3, p. 10.)

2. Williams testified that he is not offering claim-construction opinions at 210:17-19. This testimony is relevant to ¶ 31 of his declaration (Ex. 1039), which addresses a claim-construction dispute regarding the scope of "carrier." The testimony is relevant because it confirms that Mr. Williams is not offering a claim-construction position for the term "carrier" (or any other term).

3. Williams testified that his declaration contains a typo in ¶ 15 of his

declaration, at 171:7-172:5 and 192:22-193:12. The opening sentences refers to the '034 patent when it should refer to Nguyen. The testimony is inherently relevant to correct a substantive inaccuracy in an expert declaration regarding what document is being referenced.

4. Williams testified that he had not fully considered how the allegedly relevant portions of the system of De Petris work or how Nguyen would be modified to apply the teachings of De Petris at 196:4-198:20 and 200:16-201:16. This testimony is relevant to ¶ 52 of his declaration, and to assertions regarding the combination of De Petris and Nguyen at pages 2-13 in the Reply (Paper No. 37), pages 19-21 and 31-34 in the Petition (Paper No. 2), and pages 32-36 in the Response (Paper No. 27). The testimony is relevant because it confirms that ¶ 52 is not offered (nor is any paragraph offered) to show combinability of Nguyen with De Petris or any other aspect of obviousness or invalidity of the '034 patent.

5. Williams testified that the level of ordinary skill in the art regarding Nguyen would require four years of direct E911 work experience, and that “expecting anybody who just happens to have a bit of a technical bent to come in and understand this in any sort of detailed level is just not reasonable,” at 113:19-114:16, 129:6-130:21, 171:7-172:5, 177:6-17 and 192:22-193:12. But the level of skill in the art regarding the '034 patent and De Petris would not require such work experience. *See*, Pet. 9-10; Resp. 10-11. This testimony is relevant because it

contradicts the Petitioner's position that Nguyen is analogous art to the '034 patent and that Nguyen is analogous art to De Petris, as neither the '034 patent nor De Petris discuss E911 systems.

6. Williams testified that he is not offering any opinions regarding invalidity, obviousness, claim construction, written description, or patent-subject-matter eligibility, at 200:16-201:16 and 210:17-19. This is relevant to confirm the scope of Mr. Williams' opinions.

7. Williams testified that carriers do forward location information of an incoming call to an ALI database and that PSAPs do not need to make location requests "to a wireless carrier" for location information, at 33:10-34:8, 48:24-56:17 and 137:1-139:10. This testimony is relevant to ¶¶ 10, 42 of his declaration (Ex. 1039), and to assertions regarding whether the game server of Nguyen *must* identify and contact the carrier of a telephone number to obtain location information, at pages 16-17 in the Reply (Paper No. 37), at pages 2, 14, 28-31 and 46-47 in the Petition (Paper No. 2), and pages 28-36 and 54-64 in the Response (Paper No. 27). The testimony is relevant because it indicates the technological feasibility of a phone company initially forwarding location information to a third party with an incoming call, without the need to query a carrier for the location information.

8. Williams testified that the examples he draws from are among many possible

system configurations, for example, at 17:16-18:20, 19:23-22:6, 76:5-77:14, and 79:12-81:1. This testimony is relevant to statements regarding what the game server of Nguyen allegedly *must* do to obtain location information, for example, at 4-5, 9-16 and 18-19 in the Reply (Paper No. 37), at pages 2, 6-7, 14 and 28-31 in the Petition (Paper No. 2), and at 28-32, 49, 54 and 58-63 in the Response (Paper No. 27). This testimony is relevant because it suggests what a system would do “depends” on system and network “choices,” rather than a single, unavoidable (*i.e.*, necessary) technical approach.

9. Williams testified that the wireless ALI database stores location information from multiple telephone carriers, at 38:1-3 and 59:2-14. This testimony is relevant to statements regarding the necessity of identifying and contacting a particular carrier to obtain location information, at pages 13-14 in the Reply (Paper No. 37), at 30-31 and 33-34 in the Petition (Paper No. 2), and at page 29 in the Response (Paper No. 27). This testimony is relevant because it speaks to the existence of a third-party database that stored location information reported by multiple carriers, apart from databases maintained by individual carriers.

10. Williams testified that he was interpreting Nguyen to suggest commercial alternatives to the e911 system and explaining what those commercial alternatives might be, at 84:24-86:11, 124:3-23 and 152:24-153:18. This testimony is relevant to statements regarding what Nguyen teaches, and particularly to whether

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