

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

FOCAL IP, LLC,
Patent Owner.

Case: IPR2016-01254¹
Patent 8,457,113 B2

Before SALLY C. MEDLEY and BARBARA A. PARVIS,
Administrative Patent Judges.

PARVIS, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On September 14, 2017, a conference call was held with Judges Medley and Parvis and counsel for the parties in attendance. Patent Owner

¹ This Order addresses the same issues in the *inter partes* reviews IPR2016-01254, -01257, -01259, -01261, -01262, and -01263, also listed in the Appendix. Therefore, we issue one Order to be filed in all of the cases. The parties, however, are not authorized to use this style of filing in subsequent papers.

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requested the conference call to raise objections to demonstrative slides filed by Petitioner Cisco Systems Inc. in IPR2016-01254 and -01257, and demonstrative slides filed by Petitioner Bright House Networks, LLC, WideOpenWest Finance, LLC, Knology of Florida, Inc., and Birch Communications (herein “Bright House Networks Group”) in IPR2016-01259, 01261, -01262, and -01263. During the call, Petitioners Cisco Systems Inc. and Bright House Networks Group indicated that Patent Owner’s slides are similar to their slides, so if we agree with Patent Owner, then in Petitioners’ view, Patent Owner’s slides are objectionable for the same reasons.

Regarding the remaining proceedings, Patent Owner explained that it does not have objections to slides filed by Petitioner YMax Corporation in IPR2016-01256, -01258 and -01260 and is not aware of objections by Petitioner YMax Corporation to Patent Owner’s slides in these proceedings. Accordingly, this Order does not pertain to demonstrative exhibits filed in in IPR2016-01256, -01258 and -01260.

We turn to Patent Owner’s objection to certain of Petitioners’ slides as including new annotations and, therefore, new argument. As an example, Patent Owner identified Petitioner Cisco Systems Inc.’s slide 38 in demonstrative slides for IPR2016-01254 and -01257. Patent Owner indicated that this slide includes new arrows highlighted in colors, which in Patent Owner’s view constitutes a new argument. Patent Owner further indicated that Bright House Networks Group similarly includes new annotations in certain of its demonstrative slides.

Cisco Systems Inc. and Bright House Networks Group acknowledged that certain of their slides include annotations that are not provided in their

papers. Cisco Systems Inc. and Bright House Networks Group, however, argue that such annotations are not new argument, but instead useful in facilitating the presentation to the Board.

During the call, we asked Cisco Systems Inc., Bright House Networks Group, and Patent Owner to provide input regarding possible remedies to this dispute, as follows: (1) we expunge demonstrative slides after the hearing; or (2) the parties present their arguments using only papers in the record and ELMO audio visual equipment, instead of demonstrative slides. Petitioners Cisco Systems Inc. and Bright House Networks Group generally favored the first remedy, whereas Patent Owner favored the second remedy. Cisco Systems Inc. argued that a judge participating remotely would benefit from demonstrative slides, but as no judge in this proceeding will be participating remotely, we need not consider further those arguments.

As set forth in the guidance provided in the Order Granting the Parties' Requests for an Oral Hearing in each of the proceedings (*see, e.g.*, IPR2016-01254, Paper 47), we have discretion to limit the parties' demonstratives to pages in the record should there be no easy resolution to objections over demonstratives. *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, Case IPR2013-00033 (PTAB Oct. 23, 2013) (Paper 118). At this stage in the instant proceedings, nothing new can be presented, no new evidence, no new arguments. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

We are not persuaded by Cisco Systems Inc. and Bright House Networks Group that their currently filed demonstrative slides present arguments consistently with the guidance given in the Orders Granting the Parties' Requests for an Oral Hearing in each of the proceedings (*see, e.g.*,

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IPR2016-01254, Paper 47). Cisco Systems Inc. and Bright House Networks Group acknowledged that their presentations include annotations not already present in the record. Based on the characterizations provided during the call, these modifications are not consistent with our guidance to the parties in preparing for the Oral Hearing. *See, e.g.*, IPR2016-01254, Order Granting the Parties' Requests for an Oral Hearing (Paper 47) (*citing St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case IPR2013-00041 (PTAB Jan. 27, 2014)(Paper 65); *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, Case IPR2013-00033 (PTAB Oct. 23, 2013) (Paper 118)). Additionally, Patent Owner explained that its preference is that both parties' restrict their presentation to papers in the record. Accordingly, we expunge both parties' demonstrative slides in IPR2016-01254, -01257, -01259, 01261, -01262, and -01263.

In light of the preferences of Cisco Systems Inc. and Bright House Networks Group to use demonstrative slides during the Oral Hearing, we allow the parties the opportunity to further meet and confer and, if the parties arrive at an agreement, the parties may re-file their demonstrative slides in IPR2016-01254, -01257, -01259, 01261, -01262, and -01263 on or before noon Eastern Monday September 18, 2017. If the parties elect to re-file their demonstrative exhibits, in light of the late re-filing of these demonstrative exhibits just one day prior to the Oral Hearing, we caution the parties that we may determine that the parties are not permitted to use their re-filed demonstrative slides, if further objections are raised. Therefore, even if the parties elect to re-file, the parties should be prepared to present their arguments at the Oral Hearing based on the papers in the record. As a further caution to the parties, if a party raises objections to demonstrative

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slides during the Oral Hearing, that party should consider that time allocated toward arguing objections to a parties' demonstratives may be counted against that party in total time allocated for oral argument, particularly if efforts have been made to remedy the objections previously raised.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, in each of IPR2016-01254, -01257, -01259, 01261, -01262, and -01263 Petitioner's and Patent Owner's demonstrative slides, set forth in the Appendix, *shall be expunged without prejudice* to Petitioner and Patent Owner revising and refiling their demonstrative exhibits on or before noon Monday September 18, 2019.

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