

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRIGHT HOUSE NETWORKS, LLC,
WIDOPENWEST FINANCE, LLC, KNOLOGY OF FLORIDA, INC.,
and BIRCH COMMUNICATIONS, INC.,
Petitioner,

v.

FOCAL IP, LLC,
Patent Owner.

Case IPR2016-01261
Patent 8,457,113 B2

Before SALLY C. MEDLEY, JONI Y. CHANG, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Focal IP, LLC (“Patent Owner”) filed a Request for Rehearing of the Decision to Institute (Paper 19, “Dec.”) an *inter partes* review as to claims 1, 2, 8, 11, 15–19, 94, 95, 102, 109–13, 128, 163, 164, 166–68, 175, and 179–81 (“challenged claims”) of U.S. Patent 8,457,113 B2 (Ex. 1001, “the ’113 patent”). Paper 21, “Req. Reh’g.” For the reasons that follow, the Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply. *Id.* When reconsidering a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000).

III. ANALYSIS

Patent Owner contends that we misapprehended or overlooked Patent Owner’s arguments in connection with Petitioner’s reasons for combining

the asserted prior art references. Req. Reh'g at 1–5. Patent Owner also contends that we misapprehended or overlooked Patent Owner's arguments regarding the intrinsic record as to the construction of the term “tandem switch.” *Id.* at 5–8.

We are not persuaded that we misapprehended or overlooked Patent Owner's arguments in connection with Petitioner's reasons for combining the asserted prior art references. *Id.* at 1–5. In its Request for Rehearing, Patent Owner repeats the same arguments as those in the Preliminary Response (Paper 11, “Prelim. Resp.”), which are based on Patent Owner's alleged deficiencies regarding Chang's teachings of a “call processing system.” *Compare* Req. Reh'g 2–5 *with* Prelim. Resp. 58–63. As we indicated in our Decision on Institution, we have considered all of Patent Owner's arguments presented in the Preliminary Response regarding the Petitioner's proposed combination of Archer and Chang, and determined that Petitioner had made a sufficient showing. Dec. 19–21.

A request for rehearing is not an opportunity to express disagreement with a decision on previously made arguments. During trial, Patent Owner has an opportunity to resubmit in its Response arguments previously made in its Preliminary Response, along with any new arguments, explanations, and supporting evidence. As noted in the Scheduling Order, any arguments for patentability not raised in the Response will be deemed waived. Paper 20, 3.

We also are not persuaded by Patent Owner's contentions that we misapprehended or overlooked its arguments regarding the intrinsic record and the claim construction of the term “tandem switch.” Req. Reh'g at 5–8.

Although Patent Owner acknowledges that we considered the intrinsic record, specifically the prosecution history, Patent Owner asserts we misapprehended or overlooked Patent Owner's contentions pertaining to an affirmative disclaimer in the Specification. *Id.* at 6–7. Patent Owner's contentions, however, are new because in the Preliminary Response, the contentions pertaining to the disclaimer disclosed in the Specification were raised with respect to only the terms “switching facility” and “coupled to.” Prelim. Resp. 34–43. Furthermore, in its Request for Rehearing, Patent Owner attempts to import a negative limitation into the claims (Req. Reh'g 6), without taking into account “access tandem” and “hybrid switch” specifically identified in that prosecution history as being examples of the term “tandem switch” (Ex. 2005, 82).

A request for rehearing is not an opportunity to submit new arguments. *See* 37 C.F.R. § 42.71(d). We could not have misapprehended or overlooked arguments that were not made previously in Patent Owner's Preliminary Response.

Patent Owner also mischaracterizes the Decision stating that we relied “on an item of extrinsic evidence. . . to modify the meaning of this term, as used in the intrinsic record.” Req. Reh'g 7. However, our Decision is based on the intrinsic record, including the Specification's disclosure of “conventional PSTN tandem switch 16,” and “well-known, PSTN tandem switches.” Dec. 10 (citing Ex. 1001, 4:43–45). We, further, determined no express construction of the term “tandem switch” was needed because the

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asserted prior art expressly discloses “tandem” switches. *See, e.g., id.* at 9–12.

For the foregoing reasons, Patent Owner has not demonstrated that we abused our discretion in construing the terms of the challenged claims for purposes of the Decision on Institution or that we misapprehended or overlooked Patent Owner’s other arguments and, consequently, Patent Owner’s Request for Rehearing is *denied*.

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