

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

FOCAL IP, LLC,
Patent Owner.

Case IPR2016-01263
Patent 8,155,298 B2

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

CHANG, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Bright House Networks, LLC, WideOpen West Finance, LLC, Knology of Florida, Inc., and Birch Communications, Inc. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claim 1 of U.S. Patent No. 8,155,298 B2 (Ex. 1001, “the ’298 patent”) and a Declaration of Thomas F. La Porta, Ph.D. (Ex. 1002). Paper 5 (“Pet.”). Focal IP, LLC (“Patent Owner”) filed a Preliminary Response and a Declaration of Mr. Regis J. Bates Jr. (Ex. 2001). Paper 12 (“Prelim. Resp.”). Upon consideration of the parties’ contentions and supporting evidence, we instituted an *inter partes* review pursuant to 35 U.S.C. § 314, as to claim 1 of the ’298 patent. Paper 26 (“Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 36, “PO Resp.”) and a second Declaration of Mr. Bates (Ex. 2022); Petitioner filed a Reply (Paper 35, “Reply”) and a second Declaration of Dr. La Porta (Ex. 1065). A transcript of the oral hearing held on September 19, 2017, has been entered into the record as Paper 65 (“Tr.”).¹

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 1 of the ’298 patent is unpatentable.

¹ The oral arguments in the following cases were consolidated: Cases IPR2016-01259, IPR2016-01261, IPR2016-01262, and IPR2016-01263. Paper 55.

A. Related Matters

The parties indicate that the '298 patent is involved in *Patent Asset Licensing LLC v. Bright House Networks, LLC*, No. 3:15-cv-00742-J-32MCR (M.D. Fla.), and identify other related proceedings. Pet. 4–5; Paper 7, 2–3. There are other petitions challenging the '298 patent (IPR2016-01256 and IPR2016-01259) and two related patents: (1) U.S. Patent No. 7,764,777 B2 (Ex. 1006, “the '777 patent”), which issued from a divisional application of the '298 patent’s parent application; and (2) U.S. Patent No. 8,457,113 B2 (Ex. 1007, “the '113 patent”), which issued from a continuation application of the '777 patent. A final written decision is entered currently in each of the following proceedings: IPR2016-01256 and IPR2016-01259.

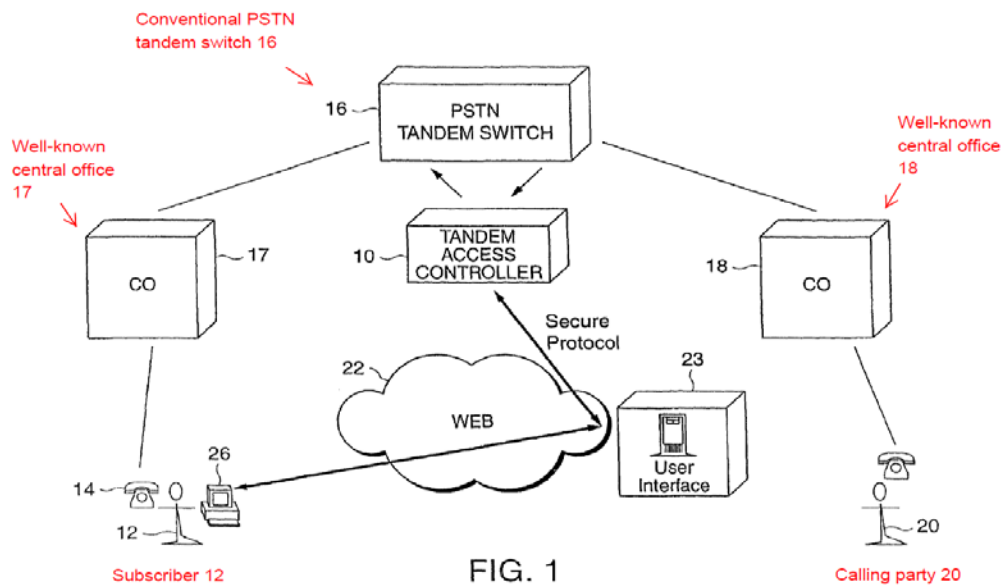
B. The '298 Patent

The '298 patent relates to telephone services. Ex. 1001, 1:20. In the background section, the '298 patent explains that the Public Switched Telephone Network (PSTN) consists of a plurality of edge switches connected to telephones on one side and to a network of tandem switches on the other. *Id.* at 1:42–44. The tandem switch network allows connectivity between all of the edge switches, and a signaling system is used by the PSTN to allow calling and to transmit both calling and called party identity. *Id.* at 1:44–48. Dr. La Porta testifies that the “PSTN had been in existence for decades and consisted of a global network of circuit switches arranged in a geographical hierarchy.” Ex. 1002 ¶¶ 54–57 (citing the ENGINEERING AND

OPERATIONS IN THE BELL SYSTEM (2nd ed. 1984) (“the Bell System Reference,” Ex. 1037)).

According to the '298 patent, at the time of the invention, there were “web-based companies managing 3rd-party call control, via the toll-switch network, which allow users to enter call control information through a web portal.” Ex. 1001, 1:31–34. “Edge devices such as phones and PBXs that include voice mail, inter-active voice response, call forwarding, speed calling, etc., have been used to provide additional call control.” *Id.* at 2:38–41.

The '298 patent discloses a system for allowing a subscriber to select telephone service features. *Id.* at 1:20–23. Figure 1 of the '298 patent is reproduced below (with annotations).



Annotated Figure 1 illustrates tandem access controller 10 connected to conventional PSTN tandem switch 16. *Id.* at 4:60–64. According to the

'298 patent, “[d]etails of the operation of the existing phone network,” including directing of phone calls by “existing” PSTN tandem switch 16 to central offices 17, 18 are further described in a publication incorporated by reference, as well as “numerous books describing the PSTN.” *Id.* at 4:60–5:4. The call flow in the network illustrated in Figure 1 with tandem access controller 10 remains the same as that in a conventional network, “except that additional 3rd-party features are applied to the call.” *Id.* More specifically, in the network illustrated in Figure 1, a call from calling party 20 to subscriber’s phone 14 is directed to tandem access controller 10, which places a second call, subject to 3rd party control information to, subscriber 12. *Id.* at 5:5–20. The second call is placed “to the subscriber’s ‘private’ phone number,” without terminating the first call. *Id.* When subscriber 12 answers the call, tandem access controller 10 connects the first call to the second call so as to connect calling party 20 to subscriber 12. *Id.*

Figure 1 also shows web server 23 within World Wide Web 22, which is connected to tandem access controller 10. *Id.* at Fig. 1. Subscriber 12 specifies 3rd-party call control features via web server 23 and these features are then relayed via World Wide Web 22 to tandem access controller 10. *Id.* at 5:33–41.

C. Challenged Claim

In the instant proceeding, Petitioner challenges only claim 1 of the '298 patent in this proceeding. Claim 1 is reproduced below.

1. A method for providing user control selections for routing of one or more communications between users of one or more

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