

Case IPR2017-01977
Patent No. 8,755,376

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELESIGN CORPORATION
Patent Owner,

v.

TWILIO INC.
Patent Owner

Case IPR2017-01977
Patent 8,755,376

**PATENT OWNER'S MOTION TO STRIKE PORTIONS OF
PETITIONER'S REPLY BRIEF AND EXHIBIT 1019
PURSUANT TO 37 C.F.R. § 42.23(b)**

As authorized by the Board (Paper 33), Patent Owner moves to strike certain portions of Petitioner’s Reply (Paper 30) and Exhibit 1019 that exceed the scope of reply. In its Petition, Petitioner was required to identify each ground with particularity. 35 U.S.C. § 312(a)(3). “A reply may only respond to arguments raised in the corresponding opposition or patent owner response.” 37 C.F.R. § 42.23(b). Further, “Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.” Aug. 2018 PTAB Trial Practice Guide Update, 14.

Petitioner’s Reply contains new evidence and argument that were not included in the Petition, constituting new grounds. The new grounds are not directly responsive rebuttal to the Patent Owner Response and should be struck from the record. The same is true of Exhibit 1019—a supplemental declaration from Petitioner’s expert that addresses claim construction positions Petitioner could have but never did raise in the Petition.

If permitted, Petitioner’s new evidence and arguments would require new analysis and expert testimony from Patent Owner. For example, does the newly-presented disclosure from Ransom (EX 1004) for Claim 1[b][ii] meet the claim language? Are ETSI-4’s “Parlay X Web Services” “a plurality of API resources”

as claimed? The evidence and theories are the type of new reply evidence and arguments that 35 U.S.C. § 312(a)(3) and this Board's Practice Guide prohibit.

I. GROUND 1 – CLAIM 1[a]: “A PLURALITY OF API RESOURCES”

The Petition relies on “various telephony-based servers” (e.g., TEL 20) of Maes as “a plurality of API resources” to make its prima facie case. Pet., 15. Petitioner changes its grounds in Reply, pointing instead to Maes's “enumeration values” such as MakeCall and TransferCall as “a plurality of API resources” for the first time. Paper 30, 7 (citing EX 1003 at cols. 34-35). This constitutes new evidence and a new argument and grounds that is outside the scope of proper rebuttal. Paper 30, page 7 (Section II.C.2 in its entirety) should be struck.

II. GROUND 1 – CLAIM 1[b][ii]: “RESPONDING TO THE API REQUEST ACCORDING TO THE REQUEST AND THE SPECIFIED RESOURCE URI”

Petitioner did not rely on Ransom at all in attempting to make its prima facie case for the “responding” limitation in the Petition. Pet., 29. Petitioner makes a wholesale addition of this prior art reference to its allegations for the “responding” limitation for the first time in reply. Paper 30, 14-15. Petitioner *also* did not rely on Figure 20 of Ransom (EX1004) anywhere in the Petition, let alone for this claim limitation. This constitutes new evidence and a new argument and grounds that is outside the scope of proper rebuttal. Paper 30, page 14, second paragraph and page 15 (EX1004, Fig. 20) should be struck.

III. GROUND 1 – CLAIM 16: “THE INFORMATIONAL API RESOURCE”

Petitioner cited “the collected digits” of Maes (EX 1003) as “an informational API resource” required by claim 1[a][iv] (which provides antecedent basis for “the informational API resource” in Claim 16). Pet., 20. Petitioner relies for the first time in reply on Maes’ “TEL 20’s collecting-digits-functionality” as an “informational API resource” for claim 1[a][iv] in an attempt to fix the antecedent basis issue in its allegations for claim 16. Paper 30, 15-16. This constitutes new evidence and new grounds that are outside the scope of proper rebuttal. Paper 30, page 15 (last four lines) and page 16 (first three lines) should be struck.

IV. GROUND 3 – CLAIM 1[a]: “A PLURALITY OF API RESOURCES”

The Petition identifies “the functionality of sending an SMS message and initiating a phone call, respectively, over a telephony network, i.e., a plurality of API resources” to make its prima facie case for “a plurality of API resources.” Pet., 44-45. In reply, Petitioner points to the Parlay X Web Services (EX 1006) to address the “plurality” requirement for the first time. Paper 30, 17. This constitutes new evidence and a new argument and grounds that is outside the scope of proper rebuttal. Paper 30, page 17 (Section III.A) should be struck.

V. GROUND 3 – CLAIM 1[b]: “THE PLURALITY OF API RESOURCES”

The Petition identifies “the getReceivedSMS API resource, i.e., a plurality of API resources” to make its prima facie case for “the plurality of API resources.” Pet., 50. In reply, Petitioner points to the Parlay X Web Services (EX 1006) to address the “plurality” requirement for the first time. This constitutes new evidence and a new argument and grounds that is outside the scope of proper rebuttal. Paper 30, page 17 (Section III.B) should be struck.

VI. GROUND 3 – CLAIM 16

Petitioner failed to address claim 16 in the Petition. Pet., 59. Petitioner now asserts that its assertions for claim 1 satisfy claim 16. Paper 30, 21. All evidence (i.e., citations to Pet., 49, 52-55) cited in the Reply is brand-new evidence for claim 16, constituting new grounds, that is outside the scope of proper rebuttal. *Id.* Paper 30, page 21 (first full paragraph, addressing claim 16) should be struck.

VII. EXHIBIT 1019

With its reply, Petitioner for the first time submitted expert opinion applying a construction of “REST API” that it could have and should have addressed in the Petition. EX1019. In Petitioner’s expert’s declaration submitted with the Petition, he states: “I have been told that Patent Owner, Twilio, has construed a REST API as ‘an application programming interface that is operable with the Representation State Transfer (REST) conventions.” EX1009, ¶ 45. But at the time of the Petition, he and Petitioner knew of the dissertation by Roy Fielding (EX2034) that defines

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