UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TELESIGN CORPORATION

Petitioner

v.

TWILIO, INC.

Patent Owner

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Patent 8,755,376

IPR Case Number: IPR2017-01977

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**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO STRIKE**

Even though "striking the entirety **or a portion of** a party's brief is an exceptional remedy that the Board expects will be granted rarely," Patent Owner moves (Paper No. 35) to strike eight portions of Petitioner's Reply.[1] *Trial Practice Guide*, August 2018 Update, 83 Fed. Reg. No. 156, 39989 (Aug. 13, 2018) at 18. Indeed, all eight portions are properly responsive and do not present new unpatentability theories. Petitioner's Reply may properly respond to Patent Owner's arguments, including arguments raised "at least implicitly." *Idemitsu Kosan Co. v. SFC Co.*, 870 F.3d 1376, 1381 (Fed. Cir. 2017).

Rebuttal I. Section II.C.2 of Petitioner's Reply (p. 7) cannot properly be stricken. First, it properly responds to POR's argument that Petitioner violates antecedent basis (Paper 26 at § V.B.1, p. 16). Second, the argument and evidence is not new. The Petition pointed to Maes's "enumeration values" which, for example, allow modifying the state of a telephone session—such as via "MakeCall" and "TransferCall"—as "a plurality of API resources." Pet. 16:1-6 (discussing element 1[a]) ("Maes teaches that TEL 20, includes various functionalities that allow an application to *modify the state of a telephony session*, such as *setting up a call*, *transferring a call*, and recording audio during a call."). And when the same element is discussed again in element 1[e], the Petition expressly points to the enumeration values as API Resources. Pet. 21.

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[1] Herein, all emphasis is added in quotations unless indicated otherwise.

Rebuttal II. The second paragraph at Reply 14 and FIG. 20 at Reply 15
cannot properly be stricken. First, ¶ 2 properly responds to POR's erroneous
assertion that "Petitioner relies solely on Maes" to show the "responding . . ."
limitation 1[b][ii] (Paper 26 at 33, ¶ 2). Second, relying on Maes and Ransom for
the *receiving* and *responding* limitations is not new. The "receiving a REST API
request" and "responding to the API request" limitations are related. The Petition
relies on the *collective* teachings of Maes and Ransom, not just Maes (see Ground
1). The Petition's analysis of the "responding" limitation (Pet. 29, § [1g])
immediately follows a lengthy analysis of the *combined* teachings of Maes and
Ransom (Pet. 24-29, § [1f]). The content under the subsequent heading builds on
that analysis. And FIG. 20 on page 15 of Petitioner's Reply is not new. It is
described in Maes's ¶ [0185], which the Petition expressly references and is
referenced via numerals (e.g., 2010, 2005) when describing the "REST" model. Pet.
26:6-12 – 27:1-2.

Rebuttal III. Reply at 15, last full paragraph cannot properly be stricken.
First, that excerpt properly responds to the POR's assertion that the Petition contends
the collected digits are both an informational API resource and data of the API
Resource. POR 37-38 (spanning ¶). Second, this is not new because that is not what
the Petition contends. Claim 16 refers to two things: "an informational API
resource" and "data of the informational API resource." The Petition maps the API

resource to the "CollectDigits" functionality and the data to the actual "collected

digits." Pet. 19-20 § 1[d]; see particularly 20, ll. 6-13 (reproduced below):

> *Id.* at 34:20-35:9 (annotated). Maes discloses that media created in response to the
> application's instruction, namely the collected digits, i.e. an informational API
> resource, are then sent from TEL 20 via the Internet to application 14. *Id.* at 35:29-

Context and singular/plural agreement make clear that the media created are

the collected digits (plural), which "are" (plural) sent to application 14; while the

"i.e." before "an informational API resource" (singular) refers to "the" application's

instruction (singular). Any further ambiguity is resolved by the Petition's consistent

explanation that an informational API resource is associated with functionality (such

as an instruction), not with mere data. *See, e.g.*, Pet. 32 ("an informational API

resource . . . '*functions* to allow . . .'"); Pet. 19 ("call router resources . . . preferably

functions to expose information . . . ."); Pet. 19 (referring to functionality such as

allowing an application to *retrieve* or *access* information when discussing element

[1d]); Pet. 20 ("Maes discloses an application sending TEL 20 a SOAP message

instructing *the collection of* DTMF digits.").

Rebuttal IV. Reply § III.A (p. 17) cannot properly be stricken. First, the

excerpt properly responds to the POR's mischaracterization of the Petition's

reference to "the functionality" (Paper 26 § VII.A at 40:10-11). Second, the excerpt

is not new. Patent Owner's motion argues that "Petitioner points to the Parlay X

Web Services (EX 1006) to address the 'plurality' requirement *for the first time*."

Mot. 3. Not so. The Petition plainly refers to these web services when discussing this element. Pet. 44 ("ETSI ES 202 391-4 teaches *Parlay X Web Services*, including the SMS *and* Third Party Call Web Services . . . .") (the *and* term providing one example of "plurality"). And ETSI ES 202 391-4 *is* EX1006. Pet. 68.

Rebuttal V. Reply § III.B (pp. 17-18) cannot properly be stricken. First, that excerpt properly responds to the POR argument that the Petitioner fails to show that ETSI-4 discloses "the plurality" of API resources. Paper 26, § VII.B.1 (pp. 41-42). Second, the excerpt is not new. The motion reads too much into the "i.e." reference at Pet. 50, line 2. Element [1e] describes an "exposing" step. The Petition need not copy and paste all instances of prior claim-limitation discussions where each limitation is discussed. The Petition addressed the "a plurality of API resources" limitation when it was first introduced in the preamble (Pet 44-45), which expressly refers to both the Short Message (SMS) Web Service and the Third Party Call Web Service. Pet. 44. How those are *exposed* is explained more fully in element [1e], which mentions both the "Short Messaging Web Service" (Pet. 50, ¶ 1) and the "Third Party Call Web Service" (Pet. 50, ¶ 2).

Rebuttal VI. Reply 21, first full paragraph cannot properly be stricken. First, that excerpt responds to POR's argument that the Petition failed to address claim 16. Paper 26 at 56 (§§ 4). Second, the argument is not new. Patent Owner

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