

1 Kurt R. Bonds, Esq.
Nevada Bar No. 6228
2 Adam R. Knecht, Esq.
Nevada Bar No. 13166
3 ALVERSON, TAYLOR,
4 MORTENSEN & SANDERS
7401 W. Charleston Boulevard
5 Las Vegas, NV 89117
(702) 384-7000
6 efile@alversontaylor.com

7 *Attorneys for Plaintiff*
8 *Voip-Pal.com, Inc.*

Michael J. McCue
Nevada Bar No. 6055
LEWIS ROCA ROTHGERBER CHRISTIE LLP
3993 Howard Hughes Pkwy, Suite 600
Las Vegas, NV 89169-5996
Tel: (702) 949-8200
E-mail: mmccue@lrrc.com

John M. Desmarais (admitted *pro hac vice*)
Michael P. Stadnick (admitted *pro hac vice*)
Ameet A. Modi (admitted *pro hac vice*)
Kerri-Ann Limbeek (admitted *pro hac vice*)
DESMARAIS LLP
230 Park Avenue
New York, NY 10169
Tel: (212) 351-3400
E-mail: jdesmarais@desmaraisllp.com
E-mail: mstadnick@desmaraisllp.com
E-mail: amodi@desmaraisllp.com
E-mail: klimbeek@desmaraisllp.com

Attorneys for Defendant Apple Inc.

13 **UNITED STATES DISTRICT COURT**
14 **DISTRICT OF NEVADA**

15 VOIP-PAL.COM INC.,

16 Plaintiff,

17 v.

18 APPLE INC.,

19 Defendant.

Case No. 2:16-cv-00260-RFB-VCF

JOINT STATUS REPORT

21 Pursuant to this Court’s order (*see* ECF No. 34), Plaintiff Voip-Pal.com, Inc. (“Plaintiff”
22 or “Voip-Pal”) and Defendant Apple Inc. (“Defendant” or “Apple”), through undersigned
23 counsel, hereby submit the following Joint Status Report outlining the parties’ positions on how
24 this case should proceed in light of recent developments in proceedings concurrently pending in
25 the Patent Trial and Appeal Board (“PTAB”).

26 **I. PROCEDURAL HISTORY**

27 On February 9, 2016, Voip-Pal filed this action against Apple alleging infringement of
28 U.S. Patent Nos. 8,542,815 (the “815 patent”) and 9,179,005 (the “005 patent”). (ECF No. 1.)

1 Voip-Pal filed an Amended Complaint on April 6, 2016 and a Second Amended Complaint on
2 May 5, 2016. (ECF Nos. 4, 11.) By stipulation, Apple's deadline to respond to the Second
3 Amended Complaint was extended to July 29, 2016. (ECF Nos. 12, 13.)

4 On July 20, 2016, the Court granted the parties' stipulation to stay this litigation pending
5 decisions by the Patent Trial and Appeal Board ("PTAB") on whether to institute *inter partes*
6 review ("IPR") on the '815 and '005 patents based on petitions filed by Apple (the "IPR
7 Petitions"). (ECF Nos. 24, 25.) On November 21, 2016, the PTAB instituted IPR on all asserted
8 claims of the '815 and '005 patents. (*See* ECF No. 27 at ¶¶ 6-7.) On December 21, 2016, the
9 Court granted the parties' stipulation and proposed order to continue the stay pending final
10 written decisions by the PTAB in the pending IPR proceedings. (ECF No. 26, 27.)

11 On November 20, 2017, the PTAB issued final written decisions concerning the IPR
12 Petitions. In its decisions, the PTAB held that Apple did not show by a preponderance of the
13 evidence that the asserted claims of the '815 and '005 patents were unpatentable. (*See* ECF No.
14 34 at ¶ 9.)

15 The parties agreed to provide the Court with their respective positions on how the case
16 should proceed in light of the PTAB's final written decisions. (*See id.* at ¶ 10.) Similar status
17 reports are being concurrently filed in two other cases filed by Voip-Pal pending in this district:
18 *VoIP-Pal.com, Inc v. Verizon Wireless Services, LLC, et al.*, Case No. 2:16-cv-00271-RCJ-VCF
19 and *VoIP-Pal.com, Inc. v. Twitter Inc.*, Case No. 2:16-cv-02338-RFB-VCF.

20 **II. THE PARTIES' POSITIONS**

21 Voip-Pal and Apple respectfully submit that, under the current circumstances, the stay of
22 this case should be lifted, and that Apple's answer or other response to Voip-Pal's Second
23 Amended Complaint (ECF No. 11) shall be due thirty (30) days after an order of this Court
24 lifting the stay of this case. The parties agree to confer on a case schedule and discovery plan
25 pursuant to Fed. R. Civ. P. 26(f) after Apple files its responsive pleading, and the parties agree
26 to submit their plan to the Court no later than seven (7) days before the Court's scheduling
27 conference under Fed. R. Civ. P. 16(b).

28 ///

1 III. ONGOING PTAB PROCEEDINGS

2 The parties further respectfully inform the Court that Apple has filed post-judgment
3 “Motion(s) For Entry Of Judgment In Favor Of Petitioner As A Sanction For Improper *Ex*
4 *Parte* Communications By Patent Owner, Or, Alternatively, For New And Constitutionally
5 Correct Proceedings” in the PTAB proceedings. (*See* Case No. IPR2016-01198, Paper No. 55
6 (P.T.A.B. Dec. 20, 2017); Case No. IPR2016-01201, Paper No. 55 (P.T.A.B. Dec. 20, 2017).)

7 A. Apple’s Statement

8 In its motions, Apple contends that Voip-Pal engaged in misconduct during the IPR
9 proceedings, including by delivering six letters to the PTAB, this Court, and many others (but
10 not Apple), alleging PTAB bias and threatening criminal liability against the PTAB, the former
11 director of the USPTO, and others. Voip-Pal concealed these letters from Apple; Apple
12 received notice of two of those letters only after the clerk of this Court posted those letters on
13 the docket for this case. (*See, e.g.*, Dkt. Nos. 28, 32.) Apple argues that the letters were
14 improper *ex parte* communications, and that the letters and Voip-Pal’s conduct violated federal
15 regulations, the Administrative Procedure Act, and Apple’s due process rights. Apple’s motions
16 seek judgment in favor of Apple or new and constitutionally correct IPR proceedings as a
17 sanction for those alleged violations. Briefing on Apple’s motion closes on January 26, 2018.
18 Apple may renew its request to stay this case if the PTAB grants Apple’s requested relief.

19 B. Voip-Pal’s Statement

20 Voip-Pal vehemently opposes Apple’s motions and the allegations therein. Foremost, as
21 pointed out in Voip-Pal’s opposition to the motions, the first and the last communications were
22 known to Apple; the first of which more than six months before Apple’s motions were filed.
23 Despite this, Apple did not raise any objection to the communications until after Apple lost on
24 the merits of its IPR proceedings – likely because Apple believed the communications had no
25 effect. Secondly, as addressed in Voip-Pal’s opposition to the motions, the communications did
26 not address any technical or substantive merits, but were instead, communications about
27 systemic issues regarding USPTO and PTAB processes, which communications are expressly
28 authorized by the USPTO Rules of Practice and the Code of Federal Regulations. Finally, the

1 relief requested by Apple is unprecedented and perceptibly nothing more than an attempt to
2 drag out a process that Apple lost on the merits. Voip-Pal also contends that Apple's request for
3 relief is untimely and statutorily barred.

4
5 Dated: January 26, 2018

6 Respectfully submitted:

7 ALVERSON, TAYLOR,
8 MORTENSEN & SANDERS

LEWIS ROCA
ROTHGERBER CHRISTIE LLP

9 /s/ Adam R. Knecht

/s/ Michael J. McCue

10 Kurt R. Bonds
11 Nevada Bar No. 6228
12 Adam R. Knecht
13 Nevada Bar No. 13166
14 7404 W. Charleston Blvd.
15 Las Vegas, NV 89117-1401
16 Tel: 702.384.7000
17 E-mail: kbonds@alversontaylor.com
18 E-mail: aknecht@alversontaylor.com

Michael J. McCue
Nevada Bar No. 6055
3993 Howard Hughes Pkwy, Suite 600
Las Vegas, NV 89169-5996
Tel: (702) 949-8200
E-mail: mmccue@lrrc.com

19 *Attorneys for Plaintiff Voip-Pal.com, Inc.*

DESMARAIS LLP
John M. Desmarais (*pro hac vice*)
Michael P. Stadnick (*pro hac vice*)
Ameet A. Modi (*pro hac vice*)
Kerri-Ann Limbeek (*pro hac vice*)
230 Park Avenue
New York, NY 10169
Tel: (212) 351-3400
E-mail: jdesmarais@desmaraisllp.com
E-mail: mstadnick@desmaraisllp.com
E-mail: amodi@desmaraisllp.com
E-mail: klimbeek@desmaraisllp.com

Attorneys for Defendant Apple Inc.