

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHATSAPP INC. and FACEBOOK, INC.,
Petitioner,

v.

TRIPLAY, INC.,
Patent Owner.

Case IPR2015-00740
Patent 8,332,475 B2

Before BENJAMIN D. M. WOOD, BRIAN J. McNAMARA, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On April 18, 2016, by email correspondence to the Board, Patent Owner requested guidance on the issue of whether a motion to exclude may address the scope of Petitioner's Reply and Reply Declaration of Mr. Klausner. In particular, Patent Owner requested confirmation that a motion to exclude is not a proper vehicle for addressing arguments that exceed the scope of a reply. Patent Owner indicated that it submitted objections to Petitioner's reply evidence pursuant to 37 C.F.R. § 42.64(b)(1) on April 14, 2016. Paper 41. Patent Owner further requests authorization to file a sur-reply and sur-reply declaration to address "new matters" raised in Petitioner's Reply and Reply Declaration.

Petitioner responded, also by email correspondence to the Board, that Patent Owner's objections were untimely as these were filed after the five business days required by 37 C.F.R. § 42.64(b)(1). Additionally, Petitioner maintains its Reply and accompanying evidence are responsive to the Patent Owner's Response, and opposes Patent Owner's request for a sur-reply.

As an initial matter, we reiterate that a motion to exclude is not a proper vehicle for a party to raise the issue of arguments exceeding the permissible scope of a reply. Generally, the Board will determine for itself whether arguments in the replies and the exhibits are outside the appropriate scope under 37 C.F.R. § 42.23(b) and, if so, not consider those arguments and exhibits. Nonetheless, after considering each party's position, we authorize Patent Owner to file a two-page submission that identifies arguments and evidence in the Reply and in Petitioner's Exhibits, filed contemporaneously therewith, that Patent Owner contends exceeds the proper scope of a reply. The submission shall be in the form of a sequentially numbered, itemized list, containing the paper/exhibit number

and page/paragraph range, as appropriate, of the material that Patent Owner alleges exceeds the proper scope of a reply. Other than a brief introductory sentence immediately after the Caption identifying the submission as being responsive to this Order, no explanation, elaboration, or discussion should be included in the submission.

We also authorize Petitioner to file a two-page Response to Patent Owner's submission. The Response shall be in the form of an itemized list with sequential numbering in one-to-one correspondence with the numbering of Patent Owner's list. Each listed item in Petitioner's Response should provide citations to the Record by paper/exhibit number and page/paragraph range, as appropriate, namely: (1) where, if at all, Petitioner initially raised the issue in its initial Petition and accompanying Exhibits; and/or (2) the specific portions of the Patent Owner Response to which the Reply or accompanying Exhibits are responsive. To maintain sequential correspondence, state "none" for any items for which Petitioner lacks a corresponding citation to the Record. Other than a brief, introductory sentence immediately after the Caption identifying the submission as being responsive to this Order, Petitioner's Response should not include arguments and explanations.

Additionally, we have considered Patent Owner's request for a sur-reply and sur-reply declaration. However, we are not persuaded that a sur-reply is needed at this time.

Accordingly, it is

ORDERED that Patent Owner's two-page, non-argumentative, sequentially numbered, itemized list submission is due on April 26, 2016;

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FURTHER ORDERED that Petitioner's two-page, non-argumentative, sequentially numbered itemized list in Response thereto is due on May 3, 2016; and

FURTHER ORDERED that Patent Owner's request for authorization to file a sur-reply is *denied*.

PETITIONER:

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