

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 26, 2016, by email correspondence to the Board, Patent Owner requested authorization to designate additional testimony of Patent Owner's expert to be considered with the testimony cited by Petitioner. Patent Owner proposed a filing similar to that authorized in an unrelated case before a different panel in *Deere & Company v. Richard Gramm*, IPR2015-00898 (Paper 27). In its email, Patent Owner indicated that Petitioner opposes Patent Owner's request as creating unnecessary work for the parties, but Petitioner requests authorization to submit a responsive filing if Patent Owner's request is granted.

Having considered the parties' arguments, we deny Patent Owner's request. A separate filing is not necessary because Patent Owner has the opportunity to discuss its expert's responsive testimony at the Oral Hearing. Similarly, Petitioner may respond to Patent Owner's presentation at the Oral Hearing should it choose to do so.

In Patent Owner's email, Patent Owner further informed us that lead counsel, Mr. Barry Schindler, is to present at the 15th IATI-BIOMED 2016 Conference and is scheduled to fly out of the United States early in the afternoon on the day of the Oral Hearing. Thus, Mr. Schindler will not be able to attend the Oral Hearing scheduled for May 19, 2016. Patent Owner requests that back-up counsel, Mr. Douglas Weider, be permitted to argue without Mr. Schindler's attendance at Oral Hearing. Petitioner does not object to this request.

We remind the parties, generally, we expect that lead counsel *will*, and back-up counsel *may*, participate in all hearings. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,758 (Aug. 14, 2012) (emphasis added). Nonetheless, given the circumstances, we grant Patent Owner's request on

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the condition that Patent Owner is further represented by a registered practitioner present in person at the Oral Hearing. We previously granted Patent Owner's request for *pro hac vice* admission of Mr. Weider in the instant proceeding as back-up counsel. We note that, according to PRPS, Patent Owner is also represented by back-up counsel, Mr. Jeremy Monaldo, who is a registered practitioner.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request to designate additional testimony of Patent Owner's expert as responsive to testimony cited by Petitioner is *denied*; and

FURTHER ORDERED that back-up counsel, Mr. Douglas Weider, may argue at the Oral Hearing in Mr. Barry Schindler's (lead counsel) absence on the condition that Patent Owner is represented by a registered practitioner present in person at the Oral Hearing.

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