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Paper 28
Entered: April 19, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VOIP-PAL.COM INC.,
Patent Owner.

Case IPR2016-01198
Patent 9,179,005 B2
Case IPR2016-01201
Patent 8,542,815 B2

Before BARBARA A. BENOIT, LYNNE E. PETTIGREW, and STACY B. MARGOLIES, *Administrative Patent Judges*.

MARGOLIES, *Administrative Patent Judge*.

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

A telephone conference was held on April 18, 2017 before Judges Benoit, Pettigrew, and Margolies. Adam Seitz and Paul Hart appeared on behalf of Apple Inc. ("Petitioner") and Kerry Taylor appeared on behalf of Voip-Pal.com, Inc. ("Patent Owner"). The purpose of the telephone conference was to address the dispute set forth in an email from Mr. Seitz dated April 12, 2017 to the Board regarding an instruction not to answer a question at a deposition. According to Patent Owner's counsel, the dispute arose after the close of business for the Board and it was not possible to engage the Board in resolving the dispute prior to the close of the deposition.

Specifically, the dispute arose during the March 29, 2017 deposition of one of the named inventors of the challenged patents who submitted a declaration in the above-referenced *inter partes* reviews. During that deposition, Petitioner's counsel asked the witness for another named inventor's telephone number, which was contained in an address book the witness had with him at the deposition. Patent Owner's counsel instructed the witness not to answer the question because it was "outside the scope" of the deposition. During the telephone conference, Patent Owner's counsel further explained that routine discovery is limited in *inter partes* reviews and, here, the deposition is limited to the scope of the witness's declaration.

Petitioner's counsel argued in the April 12, 2017 email that the Testimony Guidelines of the Trial Practice Guide prohibit an instruction not to answer except in three limited circumstances, none of which apply here. Petitioner's counsel further argued that the other named inventor, who has not submitted a declaration in either *inter partes* review, is a primary author of source code on which Patent Owner relies for showing purported reduction to practice of the claimed inventions. Petitioner's counsel also

represented that Petitioner has been unable to obtain the contact information of the other named inventor, who is an unrepresented third party in Canada. Petitioner requests that Patent Owner be ordered to obtain the other named inventor's contact information from the witness and to provide that information to Petitioner.

We agree with Petitioner that Patent Owner's instruction not to answer was improper in the instant proceedings. According to the Trial Practice Guide, "[c]ounsel may instruct a witness not to answer only when necessary to preserve a privilege, to enforce a limitation ordered by the Board, or to present a motion to terminate or limit the testimony." Office Patent Trial Practice Guide, Appendix D: Testimony Guidelines, 77 Fed. Reg. 48,756, 48,772 (Aug. 14, 2012). Patent Owner's reason for the instruction not to answer—that the question is outside the scope of the deposition—is not one of the reasons set forth in the Trial Practice Guide for instructing a witness not to answer. Moreover, Patent Owner fails to provide a persuasive reason why, in these particular proceedings, the telephone number—which the witness had at hand at the deposition—of a named inventor of the challenged patents—who is identified as an author of source code on which the Patent Owner relies for showing actual reduction to practice (*see, e.g.*, IPR2016-01198, Ex. 2014, 1; Paper 17, 7–41)—should not be provided. We do not find it necessary, however, to resume the deposition in order for the information to be provided to Petitioner.

Accordingly, it is:

ORDERED that Patent Owner shall obtain the telephone number in question from the witness and provide that information to Petitioner.

IPR2016-01198, -01201
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