

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VOIP-PAL.COM INC.,
Patent Owner

Cases IPR2016-01198 and IPR2016-01201
Patents 9,179,005 B2 and 8,542,815 B2¹

Before JOSIAH C. COCKS, JENNIFER MEYER CHAGNON, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

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

¹ This Order pertains to both noted proceedings. The Board exercises its discretion to issue a single Order for entry in each proceeding. The parties are not authorized to use this style heading for any subsequent papers.

1. Introduction

On June 7, 2017, a call was held between counsel for the respective parties and Judges Cocks, Chagnon, and Hudalla. Apple Inc. (“Petitioner”) was represented by Adam Seitz. Voip-Pal.com Inc. (“Patent Owner”) was represented by Kerry Taylor. The purpose of the call was to discuss Patent Owner’s request for authorization to file a sur-reply to Petitioner’s Reply to Patent Owner’s Response in each proceeding (Paper 34).²

2. Discussion

During the call, Patent Owner indicated to the panel that it was seeking a 5-page sur-reply to respond to arguments made by Petitioner in each of its Replies in response to Patent Owner’s arguments and evidence that references applied by Petitioner in its Petition are not prior art to either involved patent. Petitioner conveyed to the panel that it opposed Patent Owner’s request.

Sur-replies are not prohibited, but they also are not routine. The Board has, however, on various occasions permitted a patent owner to file a sur-reply to address arguments raised in a petitioner’s reply to address similar issues as those present in these proceedings. *See, e.g., ABB, Inc. v. ROY-G-BIV Corp.*, IPR2013-00063 (Paper 51); *Sensio, Inc. v. Select Brands, Inc.*, IPR2013-00580 (Paper 19); *Cox Comm’ns, Inc. v. AT&T Intellectual Prop. I, L.P.*, IPR2015-01227 (Paper 50). Where, as here, a patent owner seeks to demonstrate actual reduction to practice for purposes of antedating a prior art reference, the patent owner bears the burden of production. *See*

² Patent Owner had arranged for a court reporter to transcribe the call. When a transcript of the call is available, Patent Owner should file a copy of the transcript using its next available exhibit number.

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HTC Corp. v. NFC Tech., LLC, IPR2014-01198 (Paper 45). Indeed, during the call, Patent Owner acknowledged that it had such a burden. With that in mind, and recognizing that there is no prejudice to Petitioner that Patent Owner be permitted a short, focused sur-reply pertaining to the antedating issue, we authorize such a sur-reply. Accordingly, Patent Owner is permitted to file a sur-reply in each proceeding that is no longer than five (5) pages in length, and due no later than June 14, 2017. No new evidence or testimony of any kind shall be introduced or filed with each sur-reply.

It is so ORDERED.

For PETITIONER:

Adam P. Seitz
Eric A. Buresh
Paul R. Hart
ERISE IP, P.A
adam.seitz@eriseip.com
eric.buresh@eriseip.com
paul.hart@eriseip.com

For PATENT OWNER:

Kerry Taylor
John M. Carson
KNOBBE, MARTENS, OLSON & BEAR, LLP
2KST@knobbe.com
2jmc@knobbe.com