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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner,

v.

VOIP-PAL.COM, INC.,

Patent Owner

Case No. IPR2016-01201
U.S. Patent 8,542,815

PATENT OWNER'S OPPOSITION TO APPLE'S MOTION FOR SANCTIONS PURSUANT TO BOARD ORDER OF DECEMBER 20, 2017

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Patent Owner Voip-Pal.com, Inc. ("Voip-Pal") hereby opposes Petitioner Apple's Motion for Sanctions (Paper No. 55) and respectfully submits that denial of the Motion for Sanctions is mandated.

I. INTRODUCTION

Petitioner's Motion for Sanctions is an unwarranted attack on Patent Owner and the Board and is driven by nothing more than speculation and unsupported accusations of bias and misconduct. Petitioner requests that the Board ignore its sound and final written decision and instead render judgment in Petitioner's favor or order re-trial on the merits. Petitioner's request is absurd for numerous reasons:

First, the Code of Federal Regulations and the Rules of Practice make clear that the Sawyer Letters are not impermissible *ex parte* communications;

Second, none of the Sawyer Letters addressed the merits of the pending proceedings and there has been no prejudice here;

Third, Petitioner's request for relief is untimely and barred as it comes after an adverse judgment and also in light of the fact that Petitioner was in possession of the first and the last of the Sawyer Letters and still chose to do nothing; and

Finally, even assuming the Sawyer Letters were improper *ex parte* communications, the requested sanctions are completely unprecedented and disproportionate to the alleged misconduct and actual harm.

II. ARGUMENT

A. The Sawyer Letters Are Authorized By The Rules of Practice and Do Not Qualify As *Ex Parte* Communications.

The Sawyer Letters are **not** impermissible *ex parte* communications; they are exempted and authorized by the C.F.R. and Rules of Practice. The heart of Petitioner's Motion rests upon 37 C.F.R. § 42.5(d), generally prohibiting communications with the Board "unless both parties have an opportunity to be involved." *See* Motion at 9. But § 42.5(d) does **not prohibit** all *ex parte* communications. Indeed, in explaining § 42.5(d), the Rules of Practice provide:

> The prohibition on *ex parte* communications **does not extend to:** […] (4) **reference to a pending case in support of a general proposition** (for instance, citing a published opinion from a pending case **or referring to a pending case to illustrate a systemic concern**).

See, e.g., Rules of Practice for Trials Before the Patent Trial and Appeal Board, 77 FR 48612-01 (emphasis added). Therefore, communications that make "reference" to a pending case in order to "illustrate a systemic concern" are permissible. *Id*.

1. The Sawyer Letters illustrate systemic issues in the IPR process as allowed under the Rules of Practice.

All of the Sawyer Letters constitute the authorized illustration of systemic concerns about the U.S.P.T.O. and PTAB process that are permitted under the Rules of Practice and the C.F.R.[1] Reference to this proceeding does not make the Sawyer

[1] Much has been made about the involvement of Patent Owner in the Sawyer Letters. Patent Owner has been as concerned as Dr. Sawyer about systemic issues with Office practice. Patent Owner did have discussions with Dr. Sawyer about these systemic

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