

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 20, 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 Brent Babcock. The purpose of the call was to discuss Petitioner’s request for authorization to file a motion to expunge pages 2–15 of Patent Owner’s Motion to Exclude in each proceeding (Paper 40²).³

2. Discussion

During the call, Petitioner indicated that it believed that the majority of Patent Owner’s Motion to Exclude constituted an unauthorized sur-reply to the Petitioner’s Reply to Patent Owner’s Response (Paper 34) rather than setting forth appropriate reasons to exclude content of the record. Petitioner, thus, requested authorization to file a motion to expunge portions of the Motion to Exclude. Patent Owner opposed Petitioner’s request. According to Patent Owner, even if portions of the Motion to Exclude do amount to substantive response to Petitioner’s Reply, the panel could deny the Motion to Exclude, if it believes that is appropriate, rather than entertain the extreme remedy of expungement.

Motions to exclude are filed to preserve evidentiary objections previously made on the record; they “must identify the objections in the record in order and must explain the objections.” 37 C.F.R. § 42.64(c).

² The identified Paper numbers in this Order are the same for each proceeding.

³ 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.

Importantly, such motions are directed to “evidence” that a party considers to be inadmissible. *Id.* They do not pertain to a party’s arguments. In that respect, the panel advised the parties on the call that a motion seeking to exclude an opposing party’s argument is beyond of the scope of § 42.64 and will not be successful. In reviewing Patent Owner’s Motion to Exclude in each proceeding, we observe that various portions of the Motion seek to exclude Petitioner’s “citations” to evidence of record, rather than the underlying evidence itself. *See, e.g.*, Paper 40, 6, 8, 11, 14, 15. Although we do not authorize, at this time, a motion to expunge, we advise the parties that, to the extent that Patent Owner’s Motion to Exclude amounts to an unauthorized sur-reply or seeks to exclude Petitioner’s argument in its Reply, such content is not proper for a motion to exclude.

3. Order

It is

ORDERED that Petitioner is not authorized to file a motion to expunge in connection with Patent Owner’s Motion to Exclude (Paper 40); and

FURTHER ORDERED that any opposition to the Motion to Exclude is due as set forth in the Scheduling Order (Paper 7).

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