

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.  
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,  
Patent Owner.

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Case IPR2016-01839  
Patent 6,470,399 B1

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Before JONI Y. CHANG, JAMES B. ARPIN, and  
MIRIAM L. QUINN, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

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

In its email to the Board on November 30, 2017, Patent Owner requested guidance on how to address allegedly new matter improperly added to Petitioner's Reply. Ex. 3001. As we previously discussed during a conference call with Patent Owner in related cases<sup>1</sup>, a motion to exclude is not a proper mechanism to present arguments that a reply and evidence filed in support of the reply are outside the scope of a proper reply under 37 C.F.R. § 42.23(b), and we will determine whether a reply and supporting evidence are outside the scope of a proper reply when we review all of the parties' briefs and prepare the final written decision. *See, e.g.*, IPR2016-01212, Paper 24, 2. As we also noted, other panels had authorized parties to file a two-page itemized listing or surreply in similar situations. *Id.*

Consistent with those other related cases, we hereby authorize Patent Owner to file a paper limited to two pages, in the instant proceeding, that lists, by page and line number, the specific statements in the Petitioner's Reply and evidence filed in support of the Petitioner's Reply that Patent Owner believes to be beyond the proper scope of a reply. No argument is to be included in the contents of the submission.

We also authorized Petitioner to file a responsive paper, limited to two pages, in the instant proceeding, to provide an item-by-item response to the items listed in Patent Owner's submission. Each item in Petitioner's responsive paper should identify specifically the part of Patent Owner's Response and/or expert declaration filed in support of Patent Owner's Response, by page and line number, to which the corresponding item complained of by the Patent Owner is provided as a response, if indeed that

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<sup>1</sup> Cases IPR2016-01211, IPR2016-01212, IPR2016-01213, IPR2016-01214, IPR2016-01216, and IPR2016-01225.

IPR2016-01839  
Patent 6,470,399 B1

is the case. Petitioner also should identify, by page and line number, where in the Petition or other previously-filed paper or exhibit specifically discusses the issue raised in that item. No argument is to be included in the contents of the submission.

Accordingly, it is

ORDERED that Patent Owner is authorized to file a two-page itemized listing, as described above, within five business days from the date of this Order, and

FURTHER ORDERED that Petitioner is authorized to file a two-page responsive itemized listing, as described above, within five business days from the filing of Patent Owner's listing.

IPR2016-01839  
Patent 6,470,399 B1

For PETITIONER:

Lori A. Gordon  
Steven W. Peters  
Yasser Mourtada  
[lgordon-ptab@skgf.com](mailto:lgordon-ptab@skgf.com)  
[speters-ptab@skgf.com](mailto:speters-ptab@skgf.com)  
[ymourtad-ptab@skgf.com](mailto:ymourtad-ptab@skgf.com)  
STERNE, KESSLER, GOLDSTEIN & FOX

For PATENT OWNER:

Gregory s. Donahue  
Minghui Yang  
[gdonahue@dpelaw.com](mailto:gdonahue@dpelaw.com)  
[myang@dpelaw.com](mailto:myang@dpelaw.com)  
[docketing@dpelaw.com](mailto:docketing@dpelaw.com)  
DiNOVO PRICE ELLWANGER & HARDY LLP

Michael R. Fleming  
[mflaming@irell.com](mailto:mflaming@irell.com)  
IRELL & MANELLA LLP

Anthony Meola  
Jason. A. Murphy  
Victor J. Baranowshi  
Arlen L. Olsen  
[ameola@iplawusa.com](mailto:ameola@iplawusa.com)  
[jmurphy@iplawsa.com](mailto:jmurphy@iplawsa.com)  
[vbaranowski@iplawusa.com](mailto:vbaranowski@iplawusa.com)  
[aolsen@iplawusa.com](mailto:aolsen@iplawusa.com)  
SCHMEISER, OLSEN & WATTS, LLP