

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 December 19, 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 Kevin N. Malek.² Petitioner arranged for a court reporter to transcribe the call. When a transcript of the call is available, Petitioner should file a copy of the transcript using its next available exhibit number. In e-mail correspondence requesting the call, Petitioner indicated that it was seeking “authorization from the Board to file a Motion for Entry of Judgment In Favor Of Petitioner As A Sanction For *Ex Parte* Communications and As a Remedy For Due Process Violations, Or, Alternatively, For ‘Entirely New’ and ‘Constitutionally Correct’ Proceedings” (“Motion”). *See* Ex. 3002. As a part of the e-mail, Petitioner attached six .pdf documents, which we make of record in this proceeding as Exhibits 3003–3008.

2. Discussion

During the call, Petitioner represented that it believed certain communications (Exs. 3003–3008) constituted improper *ex parte* communications with the Board that warranted the filing of its requested

² Prior to the call, the Board received an e-mail containing a letter from counsel Ryan L. Thomas for Patent Owner indicating that Mr. Malek had been retained to represent Patent Owner during the call. *See* Ex. 3001. Mr. Malek indicated that as of the call, he had attempted, but had not yet been able to file a power of attorney in connection with these involved proceedings. Petitioner did not object to permitting Mr. Malek’s representation of Patent Owner for purpose of the call. To continue his representation of Patent Owner, Mr. Malek must file a power of attorney in each proceeding.

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Motion. Petitioner indicated that it was prepared to file its requested Motion of up to fifteen (15) pages on December 20, 2017. The panel authorized Petitioner to file the Motion. The panel also authorized Patent Owner to file an opposition to the Motion of up to fifteen (15) pages by January 12, 2018, and Petitioner to file a reply of up to ten (10) pages by January 26, 2018.

During the call, the panel also informed the parties that it was staying the deadline (*see* 37 C.F.R. § 42.71(d)(2)) in each proceeding for the parties to file requests for rehearing to the final written decisions that were issued on November 20, 2017. *See* IPR2016-01198, Paper 53; IPR2016-01201, Paper 53. Those stays will be in effect pending a decision on Petitioner's Motion in each case.

3. *Order*

It is

ORDERED that Petitioner is authorized to file its requested Motion in each proceeding no later than December 20, 2017, and numbering no more than fifteen (15) pages; and

FURTHER ORDERED that Patent Owner is authorized to file an opposition to each Motion no later than January 12, 2018, and numbering no more than fifteen (15) pages;

FURTHER ORDERED that Petitioner is authorized to file a reply to any opposition to each Motion no later than January 26, 2018, and numbering no more than ten (10) pages; and

FURTHER ORDERED that the deadline for filing a request for rehearing of the final written decision in each proceeding is stayed pending a decision on Petitioner's Motion.

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