

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,
ORACLE OTC SUBSIDIARY LLC,
INGENIO LLC, and
YELLOWPAGES.COM LLC,
Petitioners,

v.

CLICK-TO-CALL TECHNOLOGIES LP,
Patent Owner.

Case IPR2013-00312
Patent 5,818,836

Before MICHAEL R. ZECHER and TRENTON A. WARD,
Administrative Patent Judges.

ZECHER, *Administrative Patent Judge.*

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

A conference call in the above proceeding was held on March 26, 2014, between respective counsel for Petitioners and Patent Owner, and Judges Zecher and Ward. Petitioners initiated the conference call to discuss the following issues.

1. Petitioners's compliance with 37 C.F.R. §§ 42.23(a) and 42.24(c)

Petitioners sought guidance from the Board regarding how they should respond to the "Statement of Material Facts in Dispute" in Patent Owner's Response (Paper 41, Preface at ix) in their Reply to Patent Owner's Response. In particular, Petitioners requested the Board's guidance regarding whether their Reply should include a response to Patent Owner's "Statement of Material Facts in Dispute," and, if so, whether such a response should be included within the fifteen pages allotted for their Reply.

We informed Petitioners that, under 37 C.F.R. § 42.24(c), their Reply should include a short response that admits, denies, or otherwise indicates they cannot admit or deny each fact set forth in Patent Owner's "Statement of Material Facts in Dispute," but such a response need not be included within the fifteen pages allotted for the Reply. We explained that Petitioners may include their response in either a preface or an appendix to their Reply. However, if Petitioners wish to include an additional statement of facts in support of their Reply, according to 37 C.F.R. § 42.24(c), such a statement should be included within the fifteen pages allotted for their Reply.

2. Whether Petitioners are permitted to place additional excerpts of a book relied upon by Patent Owner in its Patent Owner Response into the record with their Reply

Petitioners sought guidance from the Board on whether they could submit additional excerpts of a book into the record with their Reply because

Patent Owner only filed certain portions of the book as an attachment to an Exhibit with its Patent Owner's Response. In response, Patent Owner inquired whether Petitioners should have served an evidentiary objection alleging that Patent Owner's submission of the book was incomplete. We explained that Petitioner may submit additional excerpts of the book with their Reply as long as those excerpts are within the scope of proper rebuttal to the issues raised in Patent Owner's Response.

3. Petitioners request three additional pages for their Reply

Petitioners argued that, given the number of issues raised in Patent Owner's Response, as well as the voluminous record, e.g., a one hundred page declaration filed by the inventor of U.S. Patent No. 5,818,836 (Ex. 2017), they were requesting three additional pages for their Reply. We indicated that Petitioners's request did not present extraordinary circumstances that justified three additional pages for their Reply. For instance, we noted that only three grounds of unpatentability based on two references were instituted in this proceeding. Paper 26, 30. We also noted that Petitioners need not address issues in their Reply that we already decided in this proceeding.

ORDER

Accordingly, it is ORDERED that Petitioners's request for three additional pages for their Reply is DENIED.

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Patent 5,818,836

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