

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
U.S. Patent No. 5,818,836

Before MICHAEL R. ZECHER, THOMAS L. GIANNETTI, and
TRENTON A. WARD, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

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

An initial conference call in the above proceeding was held on November 14, 2013, between respective counsel for Petitioners and Patent Owner, and Judges Zecher, Giannetti, and Ward. The purpose of the call was to discuss any proposed changes to the Scheduling Order (Paper 27) and any motions that the parties intend to file. Prior to the call, the parties filed a list of proposed motions. Papers 34 and 35. The following issues were discussed.

Issue No. 1—Schedule

The parties indicated that they do not have any issues with the Scheduling Order.

Issue No. 2—Motion to File Supplemental Information

Petitioners requested authorization to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123. Paper 34 at 1. Petitioners indicated that they seek to file a new expert declaration to explain certain textual portions of the Freeman reference. The declaration would refer to certain textual portions of Freeman cited in the petition as teaching the claimed connecting two telephone calls, as well certain textual portions of Freeman not cited in the petition that allegedly disclose a conference bridge for connecting multiple users of an on-line gaming application. The Board reminded Petitioners that, in its decision to institute, the proposed grounds of unpatentability based in part on Freeman were denied. Paper 26 at 23-29. The Petitioner has requested rehearing of this issue. Paper 36. The Board denied Petitioners's request for authorization to submit supplemental information, noting that the grounds of unpatentability based in part on Freeman are no longer part of this proceeding. Petitioners may

renew their request for authorization to submit supplement information if their request for rehearing is granted.

Issue No. 3—Motion for Additional Discovery

Patent Owner requested authorization to file a motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2). Paper 35 at 1. Patent Owner indicated that it seeks discovery regarding the issue of privity between Petitioners, specifically within the context of 35 U.S.C. § 315(b), for the purpose of developing a record for appeal to the Federal Circuit. The Board reminded Patent Owner that, in its decision to institute, it concluded that Petitioners—namely Ingenio LLC—are not barred from pursuing an *inter partes* review pursuant to § 315(b). Paper 26 at 15-18. Patent Owner has requested rehearing of this issue. Paper 37. The Board denied Petitioners’s request for authorization to seek additional discovery, noting that the privity issue already has been decided and, therefore, is no longer part of this proceeding. Patent Owner may renew its request for authorization to file a motion for additional discovery if its request for rehearing is granted.

In consideration of the foregoing, it is:

ORDERED that Petitioners’s request for authorization to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123 is denied; and

FURTHER ORDERED that Patent Owner’s request for authorization to file a motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2) is denied.

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For PETITIONERS:

James M. Heintz
DLA Piper LLP (US)
Oracle-IPRP@dlapiper.com

Mitchell G. Stockwell
Kilpatrick Townsend & Stockton LLP
mstockwell@kilpatricktownsend.com

For PATENT OWNER:

Peter J. Ayers
LEE & HAYES, PLLC
peter@leehayes.com

Craig J. Yudell
Yudell Isidore Ng Russell PLLC
Yudell@yudellisidore.com