

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GLOBAL TEL\*LINK CORPORATION,  
Petitioner,

v.

SECURE AXCESS, LLC,  
Patent Owner.

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Case IPR2014-00493 (Patent 7,899,167 B1)  
IPR2014-00749 (Patent 8,577,003 B2)<sup>1</sup>

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Before KEVIN F. TURNER, BARBARA A. BENOIT, and  
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

INITIAL CONFERENCE CALL SUMMARY  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

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<sup>1</sup> This Order addresses issues that are identical in both cases. Therefore, we exercise our discretion to issue one order to be filed in both cases.

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An initial conference call for the above-identified proceedings was held on October 6, 2014, between respective counsel for Petitioner and Patent Owner, and Judges Turner, Benoit, and Braden. The purpose of the call was to discuss any proposed changes to the Scheduling Order (Paper 9<sup>2</sup>), as well as any motions that the parties intend to file. Neither party filed a list of proposed motions. The following was discussed.

### 1. Schedule

The Board indicated that the schedules for both proceedings had been coordinated and that oral argument, if requested, would be combined. The Board explained that the oral argument transcript would be useable across all proceedings.

The Board inquired whether the parties had any issues with the Scheduling Order. The parties indicated they were working together to change some of DUE DATES 1 – 5 and would notify the Board of any changes. The parties did not have other issues with the Scheduling Order.

### 2. Motions Practice

The Board provided some general guidance about motions practice before the Board.

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<sup>2</sup> For the purpose of clarity and expediency, IPR2014-00493 is representative and all citations are to IPR2014-00493 unless otherwise noted.

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### Motion to Amend

Patent Owner indicated that it is still contemplating whether to file a motion to amend and indicated it was aware of the requirement to confer with the Board before filing a motion to amend. *See* 37 C.F.R. § 42.221(a). The Board also reminded Patent Owner that a motion to amend, if any, should be filed by DUE DATE 1.

A motion to amend must explain in detail how any proposed substitute claim obviates the grounds of unpatentability authorized in this proceeding, and clearly identify where the corresponding written description support in the original disclosure can be found for each claim added. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary. 37 C.F.R. § 42.221. For further guidance regarding requirements concerning motions to amend, Patent Owner is directed to the following Board decisions and orders:

- (1) IPR2013-00124, Paper 12 (granting-in-part a motion to amend)
- (2) IPR2012-00027, Papers 26 and 66; and (3) IPR2013-00088, Paper 16;
- (4) IPR2013-00099, Paper 19; (5) IPR2013-00136, Paper 33; and
- (6) IPR2013-00347, Paper 20.

### Motion to Exclude Evidence

The Board indicated the scope of a motion to exclude evidence was limited to arguments to exclude evidence believed to be inadmissible. The Board explained that arguments regarding the sufficiency or weight of evidence, or concerning an allegedly improper scope of a reply, would not be proper in a motion to exclude evidence. *See* Office Patent Trial Practice

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Guide, 77 Fed. Reg. 48,765, 48,767 (Aug. 14, 2012). A motion to exclude evidence also must:

- (a) Identify where in the record the objection originally was made;
- (b) Identify where in the record the evidence sought to be excluded was relied upon by an opponent;
- (c) Address objections to exhibits in numerical order; and
- (d) Explain each objection.

*Id.*

#### Motion for Additional Discovery

The Board explained that discovery is limited in an *inter partes* review and the standard for additional discovery is “necessary in the interests of justice.” The parties may agree to additional discovery between themselves. Where the parties fail to agree, a party may move for additional discovery. 37 C.F.R. § 42.51(b)(2)(i). Prior authorization for filing a motion for additional discovery is required. 37 C.F.R. § 42.20(b). For further guidance regarding factors considered in a motion for additional discovery, the parties are directed to the Board order authorizing motion for additional discovery in *Garmin International v. Cuozzo Speed Technologies*, Case IPR2012-00001 (Paper 20).

The Board also reminded the parties that Board authorization is not required to conduct routine discovery. *See* 37 C.F.R. § 42.51(b)(1).

#### Motion for Observation on Cross-Examination

The Board indicated that no further authorization is needed for a party to file a motion for observation on cross-examination, because such motions are authorized in the Scheduling Order (Paper 9).

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Motion for *Pro Hac Vice* Admission

The Board reminded the parties that they have been authorized to file motions for *pro hac vice* admission. See Notice of Filing Date Accorded to Petition (Paper 4). The Board also explained that an unopposed motion for *pro hac vice* admission would enable the Board to act before the five days allowed for opposition has expired.

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