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17 *AT&T Services, Inc., and AT&T Mobility*
18 *LLC*

19 **UNITED STATES DISTRICT COURT**
20 **NORTHERN DISTRICT OF CALIFORNIA**

21 AT&T CORP., AT&T SERVICES, INC., AND
22 AT&T MOBILITY LLC,

23 Plaintiffs,

24 v.

25 VOIP-PAL.COM, INC.,

26 Defendant.

27 Case No. 5:21-cv-5078

28 **COMPLAINT FOR DECLARATORY
JUDGMENT OF NONINFRINGEMENT
AND INVALIDITY**

DEMAND FOR JURY TRIAL

1 Plaintiffs AT&T Corp., AT&T Services, Inc., and AT&T Mobility LLC (“the AT&T
2 plaintiffs”) seek a declaratory judgment that they do not infringe any claim of U.S. Patent Nos.
3 8,630,234 (the “’234 patent”), and 10,880,721 (the “’721 patent”), and that the ’234 and ’721 patents
4 are invalid. There is a live and existing controversy between the parties to this lawsuit. On April
5 24, 2020, defendant VoIP-Pal filed a patent infringement suit asserting U.S. Patent No. 10,218,606
6 (the “’606 patent”) in the Western District of Texas against two of the three plaintiffs (AT&T Corp.
7 and AT&T Services, Inc.). That case was dismissed without prejudice on March 25, 2021. (Case
8 No. 20-cv-325, Dkt. 53.) However, AT&T’s declaratory judgment complaint of noninfringement
9 and invalidity of the ’606 patent is pending in this District. Nevertheless, on June 25, 2021,
10 defendant VoIP-Pal.com, Inc. (“VoIP-Pal”) filed a patent infringement suit attempting to assert
11 the ’234 and ’721 patents in the Western District of Texas against the AT&T plaintiffs. The
12 Honorable Judge Lucy H. Koh of the Northern District of California has extensive experience with
13 VoIP-Pal’s patents, the technology claimed in its patents, and its litigation campaign against AT&T,
14 making it logical and judicially efficient for the parties’ dispute to be heard in this Court.

15 INTRODUCTION

16 1. This is an action for a declaratory judgment arising under the patent laws of the
17 United States, Title 35 of the United States Code. The AT&T plaintiffs seek a declaratory judgment
18 that they do not infringe any claim of the ’234 and ’721 patents and that the ’234 and ’721 patents
19 are invalid. The action arises from a real and immediate controversy between the AT&T plaintiffs
20 and VoIP-Pal as to whether the AT&T plaintiffs infringe any claims of the ’234 and ’721 patents.
21 The ’234 patent is attached as Exhibit 1A, and the ’721 patent is attached as Exhibit 1B, both of
22 which are entitled “Mobile Gateway.”

23 2. This is not the first lawsuit between VoIP-Pal and an AT&T entity in this District.
24 As this Court has previously recognized, the parties have a long history. In 2016, VoIP-Pal filed six
25 lawsuits—one against plaintiff AT&T Corp., two against Apple, and three others against Amazon,
26 Verizon, and Twitter—collectively alleging infringement of six patents (“the 2016 cases”). After its
27 case against Twitter was transferred to this District, VoIP-Pal voluntarily consented to transfer of
28 the remaining cases to this District. (Exhibit 2.) This Court subsequently found that all six patents

1 were invalid under 35 U.S.C. § 101 for claiming ineligible subject matter. (Exhibits 3-4.) Both of
2 this Court’s two decisions have already been affirmed by the Federal Circuit pursuant to Fed. R.
3 App. P. 36. (Exhibits 5A-5B.)

4 3. Dissatisfied with this Court’s decisions, and in an apparent effort to avoid a similar
5 judgment, VoIP-Pal filed a cluster of lawsuits against Google, Facebook, Apple, Amazon, Verizon,
6 and various AT&T entities in the Western District of Texas in 2020, alleging infringement of a
7 seventh (and related) patent, the ’606 patent, which is part of the same family as, shares a common
8 specification with, and contains similar claim language as, the six already-invalidated patents.

9 4. Within weeks, Apple, Twitter, Verizon, and AT&T filed declaratory judgment
10 complaints in the Northern District of California, alleging noninfringement and invalidity of VoIP-
11 Pal’s seventh patent, the ’606 patent. VoIP-Pal moved to dismiss those complaints under the first-
12 to-file rule, arguing that its Western District of Texas complaints were the first-filed cases. VoIP-
13 Pal also sought dismissal for, *inter alia*, lack of personal jurisdiction and improper venue. The Court
14 declined to apply the first-to-file rule in the interests of judicial efficiency. (Exhibit 8.) In particular,
15 the Court appreciated that VoIP-Pal’s argument “completely ignores the history of disputes between
16 the parties whether Plaintiffs infringe Defendant’s family of patents related to communications over
17 internet protocol, including a set of cases filed in 2016 and another set filed in 2018, all of which
18 were adjudicated by this Court.” (*Id.* at 11.) The Court also found that VoIP-Pal had no ties to the
19 Western District of Texas and “decline[d] to apply the first-to-file rule to permit [VoIP-Pal] to forum
20 shop.” (*Id.* at 13.) Therefore, the Court denied VoIP-Pal’s motions. The Apple, Twitter, and AT&T
21 declaratory-judgment cases are still pending in this District.¹

22 5. Faced again with an unfavorable decision, and desperate to flee this Court’s
23 jurisdiction, VoIP-Pal filed yet another set of complaints against the same parties in the Western
24 District of Texas on June 25, 2021. (*See* Exhibit 6.) This time, VoIP-Pal chose a new patent family
25 to assert. However, the ’234 and ’721 patents relate to the same subject matter as VoIP-Pal’s
26 previous seven patents: call routing functionality based on callee identifiers. A simple comparison

27 ¹ The Court dismissed the Verizon case on May 26, 2021 via a stipulation of dismissal. (Case No.
28 20-cv-3092, Dkt. 73.) Notwithstanding, VoIP-Pal also filed a new suit against Verizon in the
Western District of Texas on June 25, 2021. (Case No. 21-cv-672.)

of the patents' abstracts demonstrates that similarity:

U.S. Patent No. 8,542,815 (2016 case)	U.S. Patent No. 8,630,234 (2021 case)
<p>(57) ABSTRACT</p> <p>A process and apparatus to facilitate communication between callers and callees in a system comprising a plurality of nodes with which callers and callees are associated is disclosed. In response to initiation of a call by a calling subscriber, a caller identifier and a callee identifier are received. Call classification criteria associated with the caller identifier are used to classify the call as a public network call or a private network call. A routing message identifying an address, on the private network, associated with the callee is produced when the call is classified as a private network call and a routing message identifying a gateway to the public network is produced when the call is classified as a public network call.</p>	<p>(57) ABSTRACT</p> <p>A method of initiating a call to a callee using a mobile telephone involves: receiving, from a user of the mobile telephone, a callee identifier associated with the callee; transmitting an access code request message to an access server, said access code request message including said callee identifier; receiving an access code reply message from the access server in response to said access code request message, said access code reply message including an access code different from said callee identifier and associated with said callee identifier; and initiating a call with the mobile telephone using said access code to identify the callee.</p>

6. Similarly, VoIP-Pal accuses the same technology of infringement. For example, in both the 2016 Northern District of California case and the 2020 Western District of Texas case, VoIP-Pal accused AT&T's "Wi-Fi Calling" of infringement. (Case No. 18-cv-6177, Dkt. 3-16, 3-19; Case No. 20-cv-325, Dkt. 1-2.) In the 2021 Western District of Texas, VoIP-Pal accuses AT&T's "Voice over WiFi or VoWiFi" of infringement. (Case No. 21-cv-671, Dkt. 1-3, 1-4.) (*See* Exhibits 9-12.)

7. VoIP-Pal's forum shopping attempts should be disregarded, and in the interests of justice and judicial efficiency, any dispute between VoIP-Pal and the AT&T plaintiffs concerning the '234 and '721 patents should be adjudicated in this District.

8. The AT&T plaintiffs believe that they do not infringe the '234 and '721 patents, and that they have not infringed any claims of the '234 and '721 patents, and that the claims of the '234 and '721 patents are invalid.

9. VoIP-Pal's actions have created a real and immediate controversy between VoIP-Pal and the AT&T plaintiffs as to whether their products and/or services infringe any claims of the '234 and '721 patents, and whether the claims of the '234 and '721 patents are invalid. The facts and allegations recited herein show that there is a real, immediate, and justiciable controversy concerning these issues.

THE PARTIES

10. AT&T Corp. is a New York corporation with a place of business at One AT&T Way, Bedminster, New Jersey 07921.

11. AT&T Services, Inc. is a Delaware corporation with a place of business at 208 S.

1 Akard St., Dallas, Texas 75202.

2 12. AT&T Mobility LLC is a Delaware limited liability company with a place of
3 business at 1025 Lenox Park Blvd NE, Atlanta, Georgia 30319.

4 13. On information and belief, VoIP-Pal is a company incorporated and registered under
5 the laws of Nevada with a principal place of business in Bellevue, Washington.

6 14. On information and belief, including VoIP-Pal's allegations in litigations filed in
7 Texas, VoIP-Pal owns the '234 and '721 patents.

8 **JURISDICTIONAL STATEMENT**

9 15. This action arises under the Declaratory Judgment Act, 28 U.S.C. § 2201 et seq., and
10 under the patent laws of the United States, Title 35 of the United States Code.

11 16. This Court has subject matter jurisdiction over the claims alleged in this action under
12 28 U.S.C. §§ 1331, 1332, 1338, 2201, and 2202 because this Court has exclusive jurisdiction over
13 declaratory judgment claims arising under the patent laws of the United States pursuant to 28 U.S.C.
14 §§ 1331, 1338, 2201, and 2202. Jurisdiction is also proper under 28 U.S.C. § 1332 because AT&T
15 and VoIP-Pal are citizens of different states, and the value of the controversy exceeds \$75,000.

16 17. This Court can provide the declaratory relief sought in this Declaratory Judgment
17 Complaint because an actual case and controversy exists between the parties within the scope of this
18 Court's jurisdiction pursuant to 28 U.S.C. § 2201. An actual case and controversy exists as to
19 the '234 and '721 patents at least because the AT&T plaintiffs do not infringe and have not infringed
20 any claims of the '234 and '721 patents; VoIP-Pal previously filed a lawsuit against AT&T Corp.
21 alleging infringement of three similar patents with similar claim language and implicating the same
22 AT&T technology; VoIP-Pal has accused the AT&T plaintiffs of infringing the '234 and '721
23 patents in litigation in the Western District of Texas; VoIP-Pal's infringement allegations generally
24 implicate products or services provided by the AT&T plaintiffs; and, on the basis of VoIP-Pal's
25 allegations in the Western District of Texas complaint, the AT&T plaintiffs therefore have a
26 reasonable apprehension of suit with regard to these allegations.

27 18. Moreover, the first two patents previously asserted by VoIP-Pal against AT&T Corp.
28 were held invalid under 35 U.S.C. § 101 by this Court, and—based on the substantial similarities

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