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9 UNITED STATES DISTRICT COURT  
10 NORTHERN DISTRICT OF CALIFORNIA  
11 SAN FRANCISCO DIVISION

<p>13 AT&amp;T CORP. et al., 14 Plaintiffs, 15 v. 16 VOIP-PAL.COM, INC., 17 Defendant.</p>	<p>Case No. 3:21-cv-05078-JD</p> <p><b>RESPONSE IN SUPPORT OF <i>SUA SPONTE</i> JUDICIAL REFERRAL TO CONSIDER WHETHER CASES SHOULD BE RELATED</b></p> <p><b>(Civil L.R. 3-12 and 7-11)</b></p>
<p>19 TWITTER, INC., 20 Plaintiff, 21 v. 22 VOIP-PAL.COM, INC., 23 Defendant.</p>	<p>Case No. 5:21-cv-9773-EJD</p>

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RESPONSE IN SUPPORT OF *SUA SPONTE* JUDICIAL REFERRAL TO CONSIDER WHETHER CASES SHOULD

## I. INTRODUCTION

Under Civil Local Rules 3-12 and 7-11, Defendant VoIP-Pal.com, Inc. (“VoIP-Pal”) submits this response in support of the *sua sponte* judicial referral to consider whether the case *Twitter Inc. v. VoIP-Pal.com, Inc.*, Case No. 3:21-cv-09773-EJD (“the Twitter action” or “*Twitter IIP*”) should be related to the above-captioned action (“the AT&T action” or “*AT&T IIP*”). Under Local Rule 3-12, an action is related to another when: (1) the actions concern substantially the same parties, property, transaction or event; and (2) it appears likely that there will be an unduly burdensome duplication of labor and expense or conflicting results if the cases are conducted before different Judges. As explained below, the Court has already related *Apple Inc. v. VoIP-Pal.com, Inc.*, Case No. 3:21-cv-05110-JD (“the Apple action” or “Apple II”) and *Cellco Partnership d/b/a Verizon Wireless Inc. et al. v. VoIP-Pal.com, Inc.*, Case No. 3:21-cv-05275-JD (“the Verizon action” or “Verizon II”) to the instant action because these actions concern the same patent owner, the same patents, U.S. Patent Nos. 8,630,234 and 10,880,721 (“the ’234 patent” and “the ’721 patent” or “the Mobile Gateway patents”), and substantially the same property, transaction or event (i.e., overlapping patent claims and similar allegedly non-infringing products).<sup>1</sup> Because the Twitter action also concerns the same patent owner, the same Mobile Gateway patents, and substantially the same property, transaction or event, the Twitter action should also be related to the instant action. Moreover, there would be an unduly burdensome duplication of labor and expense, and potentially conflicting results, if the cases were conducted before different Judges because these cases concern the same patents and allegations of non-infringement directed to similarly functioning products.

## II. FACTUAL BACKGROUND

The parties in the Twitter action have been engaged in multiple rounds of litigation involving VoIP-Pal’s patent portfolio. Three cases between the parties are or were pending before Judge Lucy H. Koh.<sup>2</sup> All of those cases involve VoIP-Pal’s Routing, Billing, Rating (“RBR”) family of patents, not the Mobile Gateway patents.

<sup>1</sup> See Case No. 3:21-cv-5110-JD, Dkt. No. 25.

<sup>2</sup> *VoIP-Pal.com, Inc. v. Twitter Inc.*, Case No. 5:18-cv-04523-LHK (N.D. Cal.); *Twitter, Inc. v. VoIP-Pal.com, Inc.*, Case No. 5:20-cv-02397-LHK (N.D. Cal.) (“*Twitter I*”); *Twitter, Inc. v. VoIP-Pal.com, Inc.*, Case No. 5:20-cv-02769-LHK (N.D. Cal.) (“*Twitter II*”).

1 On June 25, 2021, VoIP-Pal filed suit against AT&T, Apple, Verizon, and four other  
2 defendants in the Western District of Texas (WDTX) asserting infringement of the Mobile Gateway  
3 patents.<sup>3</sup> AT&T filed this declaratory-judgment action on June 30, 2021.<sup>4</sup> AT&T sought  
4 declarations that its Voice over WiFi or VoWiFi products do not infringe the Mobile Gateway patents  
5 and that the patents are invalid.<sup>5</sup> Apple filed the Apple action on July 1, 2021.<sup>6</sup> Apple sought similar  
6 declarations that its FaceTime and Messages applications do not infringe the Mobile Gateway patents  
7 and that the patents are invalid.<sup>7</sup> Verizon filed the Verizon action on July 8, 2021, also seeking a  
8 declaration of invalidity of the Mobile Gateway patents and that its Voice over WiFi or VoWiFi  
9 products do not infringe the Mobile Gateway patents.<sup>8</sup>

10 On July 8, 2021, AT&T filed an administrative motion to consider whether the instant action  
11 should be related to *AT&T Corp. v. VoIP-Pal.com, Inc.*, Case No. 5:20-cv-02995-LHK (“*AT&T P*”),  
12 which was pending before Judge Koh.<sup>9</sup> *AT&T I* involved VoIP-Pal’s U.S. Patent No. 10,218,606 (the  
13 “’606 patent”). Similarly, on July 12, 2021, Apple filed an administrative motion in the Apple action  
14 to consider whether *Apple II* should be related to *Apple Inc. v. VoIP-Pal.com, Inc.*, Case No. 5:20-cv-  
15 02460-LHK (“*Apple P*”), which was pending before Judge Koh.<sup>10</sup> *Apple II* involved the ’606 patent  
16 and U.S. Patent No. 9,935,872 (“the ’872 patent”). The ’606 patent and the ’872 patent are related  
17 and are part of the RBR family of patents. On July 27, 2021, Judge Freeman issued a *sua sponte*  
18 judicial referral to Judge Koh to determine whether *Verizon II* is related to *Cellco Partnership dba*  
19 *Verizon Wireless v. VoIP-Pal.com, Inc.*, Case No. 5:20-cv-03092-LHK (N.D. Cal.) (“*Verizon P*”),

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21 <sup>3</sup> *VoIP-Pal.com, Inc. v. Facebook, Inc., et al.*, Case No. 6:21-cv-665 (W.D. Tex.); *VoIP-Pal.com, Inc.*  
22 *v. Google, LLC*, Case No. 6:21-cv-667 (W.D. Tex.); *VoIP-Pal.com, Inc. v. Amazon.com, Inc., et al.*,  
23 *Case No. 6:21-cv-668* (W.D. Tex.); *VoIP-Pal.com, Inc. v. Apple, Inc.*, 6:21-cv-670 (W.D. Tex.);  
*VoIP-Pal.com, Inc. v. AT&T Corp., et al.*, 6:21-cv-671 (W.D. Tex.); *VoIP-Pal.com, Inc. v. Verizon*  
*Communications, Inc., et al.*, 6:21-cv-672 (W.D. Tex.); *VoIP-Pal.com, Inc. v. T-Mobile US, Inc., et*  
*al.*, 6:21-cv-674 (W.D. Tex.).

24 <sup>4</sup> See Dkt. No. 1.

25 <sup>5</sup> See *id.*

26 <sup>6</sup> See *Apple Inc. v. VoIP-Pal.com, Inc.*, Case No. 3:21-cv-05110, Dkt. No. 1 (N.D. Cal.).

27 <sup>7</sup> See *id.*

28 <sup>8</sup> See *Cellco Partnership d/b/a Verizon Wireless Inc. et al. v. VoIP-Pal.com., Inc.*, Case No. 3:21-cv-  
05275, Dkt. No. 1 (N.D. Cal.).

<sup>9</sup> See *AT&T Corp. v. VoIP-Pal.com, Inc.*, Case No. 5:20-cv-02995-LHK, Dkt. No. 89 (N.D. Cal.);  
Dkt. No. 12.

<sup>10</sup> See *Apple Inc. v. VoIP-Pal.com, Inc.*, Case No. 5:20-cv-02460-LHK, Dkt. No. 88 (N.D. Cal.).

1 which was pending before Judge Koh and involved the '606 patent.<sup>11</sup> On August 25, 2021, Judge  
2 Koh denied AT&T's and Apple's motions to relate.<sup>12</sup> On August 26, 2021, Judge Koh issued an  
3 order determining that *Verizon I* and *Verizon II* are not related.<sup>13</sup>

4 VoIP-Pal and AT&T stipulated to the dismissal of the instant action on October 13, 2021.  
5 VoIP-Pal and Apple stipulated to the dismissal of the related Apple action on October 22, 2021. The  
6 related Verizon action remains pending and is stayed.

7 Twitter filed *Twitter III* on December 17, 2021. *Twitter III* was assigned to Judge Edward J.  
8 Davila on January 5, 2022.<sup>14</sup> On January 7, 2022, Judge Davila issued a *sua sponte* judicial referral  
9 to Judge Koh to determine whether *Twitter III* is related to *Twitter II*. VoIP-Pal filed a response in  
10 opposition to that judicial referral because Judge Koh had already determined that the Apple, AT&T,  
11 and Verizon actions involving the RBR patents are not related to the Apple, AT&T, and Verizon  
12 actions involving the Mobile Gateway patents as discussed above.<sup>15</sup> Rather, VoIP-Pal believes that  
13 *Twitter III* should be related to the instant action for the reasons stated in this response.

### 14 III. ARGUMENT

#### 15 A. Civil L.R. 3-12(a)(1) is satisfied.

16 Although the plaintiffs in each of the cases sought to be related are different, the patent owner  
17 and declaratory-judgment defendant, VoIP-Pal, is the same. The "property, transaction or event" in  
18 these actions are also the same. Both actions concern the Mobile Gateway patents. Further, Twitter's  
19 allegedly non-infringing WiFi calling technology, particularly as it relates to claim 20 of the '234 patent  
20 and claim 38 of the '721 patent, is similar. Indeed, if VoIP-Pal had filed both actions in this District, then  
21 these actions would have been deemed related under Patent L.R. 2-1(a)(1).<sup>16</sup> Accordingly, because the  
22 property, transaction, or event at issue in these actions is identical and/or substantially the same, it is  
23 proper to relate these cases under Local Rule 3-12.

24 <sup>11</sup> See *Cellco Partnership v. VoIP-Pal.com, Inc.*, No. 5:20-cv-03092-LHK, Dkt. 75 (N.D. Cal.).

25 <sup>12</sup> See *Apple Inc. v. VoIP-Pal.com, Inc.*, Case No. 5:20-cv-02460-LHK, Dkt. No. 95 (N.D. Cal.);  
*AT&T Corp. v. VoIP-Pal.com, Inc.*, Case No. 5:20-cv-02995-LHK, Dkt. No. 97 (N.D. Cal.).

26 <sup>13</sup> See *Cellco Partnership v. VoIP-Pal.com, Inc.*, No. 5:20-cv-03092-LHK, Dkt. 78 (N.D. Cal.).

27 <sup>14</sup> See *Twitter, Inc. v. VoIP-Pal.com, Inc.*, Case No. 5:21-cv-09773-EJD (N.D. Cal.).

28 <sup>15</sup> *Id.*, Dkt. No. 20.

<sup>16</sup> See Patent L.R. 2-1(a)(1) ("When actions concerning the same patent are filed within two years of each other by the same plaintiff, they will be deemed related.").

1           **B. Civil L.R. 3-12(a)(2) is satisfied.**

2           Due to the substantial similarity of these cases, it is highly likely that there will be an unduly  
3 burdensome duplication of labor and expense or the possibility of conflicting results if the cases are  
4 not related. The patent owner in both actions is the same, as are the patents-in-suit. The allegedly  
5 non-infringing WiFi calling technology in both actions is similar. Because of the significant overlap  
6 between both actions, there would be an unduly burdensome duplication of labor and expense that  
7 could potentially lead to conflicting results if two different courts heard motions concerning the  
8 alleged noninfringement and invalidity of the same patents. The instant action is the first case  
9 concerning the Mobile Gateway patents filed in this District. Therefore, neither Judge Davila in  
10 *Twitter III* nor Judge Koh in the *Twitter II* have any prior familiarity with the Mobile Gateway  
11 patents. In addition, the Court has already related the Apple action and the Verizon action to the  
12 instant action.<sup>17</sup> Relating the Twitter action to the instant action will not have an adverse effect on  
13 the procedural schedule of any of the actions because the Verizon action, which is the only pending  
14 action related the instant action, is stayed.<sup>18</sup> Also, no Case Management Order has been entered in  
15 either action. Indeed, VoIP-Pal's deadline to answer or otherwise respond to the complaint in *Twitter*  
16 *III* is February 11, 2022.

17           **IV. CONCLUSION**

18           In conclusion, VoIP-Pal respectfully requests that the Court grant the judicial referral and  
19 relate the Twitter action and with the instant action.

20 Dated: January 12, 2022

Respectfully Submitted,

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23           /s/ Lewis E. Hudnell, III

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26           VOIP-PAL.COM, INC.

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28           <sup>17</sup> See Case No. 3:21-cv-5110-JD, Dkt. No. 25.

<sup>18</sup> See Case No. 3:21-cv-5110-JD, Dkt. No. 35.

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