

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

VOIP-PAL.COM INC.,
Patent Owner.

Case IPR2016-01082
Patent 8,542,815 B2

Before BARBARA A. BENOIT, LYNNE E. PETTIGREW, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

MARGOLIES, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Unified Patents Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1, 2, 7, 27–29, 34, 54, 72–74, 92, 93, and 111 of U.S. Patent No. 8,542,815 B2 (Ex. 1001, “the ’815 patent”). Paper 1 (“Pet.”). Voip-Pal.com, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6

(“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and the Preliminary Response, we conclude that the information presented does not show a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of any of claims 1, 2, 7, 27–29, 34, 54, 72–74, 92, 93, and 111 of the ’815 patent.

A. Related Matters

The parties identify the following district court proceedings in which the ’815 patent has been asserted: *Voip-Pal.com, Inc. v. Verizon Wireless Services, LLC*, Case No. 2-16-cv-00271 (D. Nev.), and *Voip-Pal.com, Inc. v. Apple, Inc.*, Case No. 2-16-cv-00260 (D. Nev.). *See* Pet. 4; Paper 4, 2.

Another petitioner—Apple Inc.—has filed a petition for *inter partes* review of claims of the ’815 patent in IPR2016-01201, and a petition for *inter partes* review of claims of U.S. Patent No. 9,179,005—a continuation of the ’815 patent—in IPR2016-001198.

B. The ’815 Patent

The ’815 patent is directed to classifying a call as a public network call or a private network call and producing a routing message based on that classification. Ex. 1001, Abstract. Figure 7 of the ’815 patent, shown below, illustrates a routing controller that facilitates communication between callers and callees:

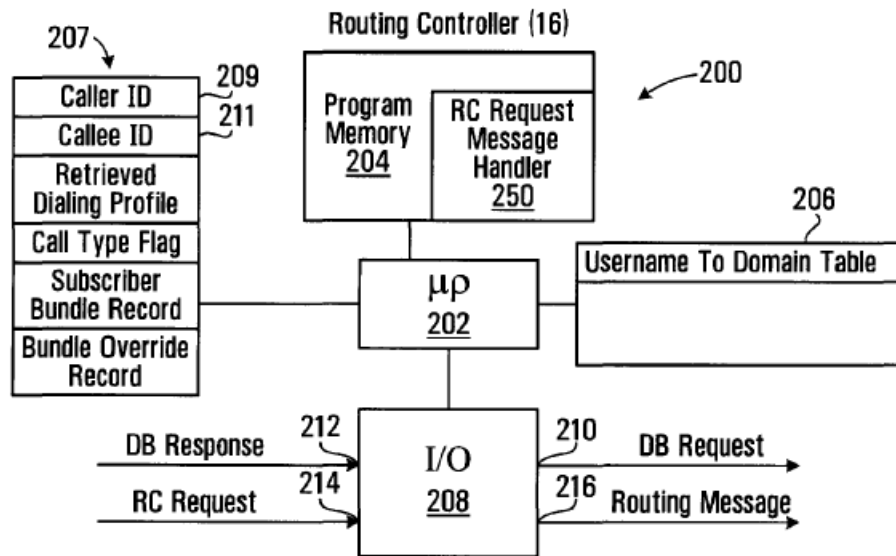


FIG. 7

Id. at Fig. 7, 14:24–25, 17:16–17. As shown in Figure 7, above, routing controller (RC) 16 includes RC processor circuit 200, which in turn includes processor 202, program memory 204, table memory 206, buffer memory 207, and I/O port 208. *Id.* at 17:17–22. Routing controller 16 queries database 18 (shown in Figure 1) to produce a routing message to connect caller and callee. *Id.* at 14:10–17, 14:24–34. Program memory 204 includes blocks of code for directing processor 202 to carry out various functions of the routing controller. *Id.* at 17:38–40. Those blocks of code include RC request message handler 250, which directs the routing controller to produce the routing message. *Id.* at 17:40–44.

According to the '815 patent, in response to a calling subscriber initiating a call, the routing controller:

receiv[es] a callee identifier from the calling subscriber, us[es] call classification criteria associated with the calling subscriber to classify the call as a public network call or a private network call[,] and produc[es] a routing message identifying an address

on the private network, associated with the callee[,] when the call is classified as a private network call and produc[es] a routing message identifying a gateway to the public network when the call is classified as a public network call.

Id. at 14:24–34.

Figures 8A through 8D of the '815 patent illustrate a flowchart of an RC request message handler executed by the RC processor circuit. *Id.* at 10:62–63. Figure 8B, shown below, illustrates steps for performing checks on the callee identifier:

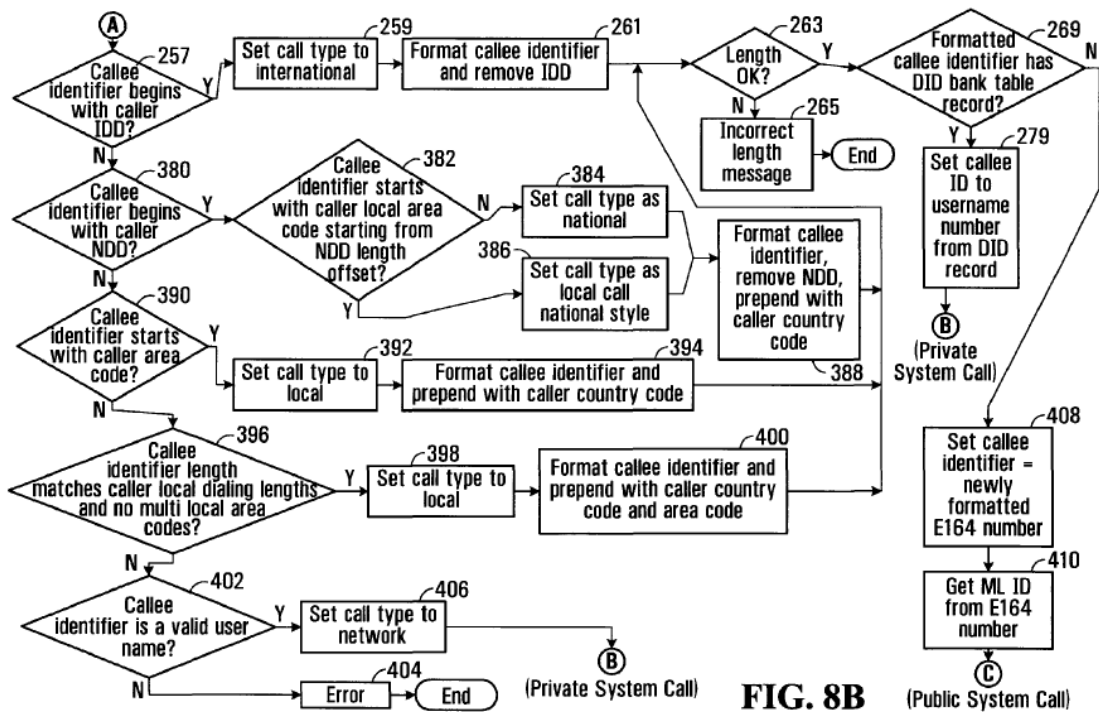


FIG. 8B (Private System Call) (Public System Call)

Id. at Fig. 8B, 19:45–49. Blocks 257, 380, 390, 396, 402 in Figure 8B above effectively “establish call classification criteria for classifying the call as a public network call or a private network call.” *Id.* at 22:48–51. For example, block 402 “directs the processor 202 of FIG. 7 to classify the call as a private network call when the callee identifier complies with a

predefined format, i.e. is a valid user name and identifies a subscriber to the private network” *Id.* at 22:51–60. Block 269 also classifies the call as public or private, depending on whether the callee is a subscriber to the system. *Id.* at 22:51–23:8, 20:14–24; *see also id.* at 18:55–19:22.

C. Illustrative Claim

Among the challenged claims, claims 1, 27, 28, 54, 74, and 93 are independent. Claim 1 is illustrative and reads:

1. A process for operating a call routing controller to facilitate communication between callers and callees in a system comprising a plurality of nodes with which callers and callees are associated, the process comprising:

in response to initiation of a call by a calling subscriber, receiving a caller identifier and a callee identifier;

locating a caller dialing profile comprising a username associated with the caller and a plurality of calling attributes associated with the caller;

determining a match when at least one of said calling attributes matches at least a portion of said callee identifier;

classifying the call as a public network call when said match meets public network classification criteria and classifying the call as a private network call when said match meets private network classification criteria;

when the call is classified as a private network call, producing a private network routing message for receipt by a call controller, said private network routing message identifying an address, on the private network, associated with the callee;

when the call is classified as a public network call, producing a public network routing message for receipt by the call controller, said public network routing message identifying a gateway to the public network.

Id. at 36:14–38.

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