

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

VOIP-PAL.COM, INC.,  
Patent Owner

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Cases IPR2016-01198 and IPR2016-01201  
Patents 9,179,005 B2 and 8,542,815 B2

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Before SCOTT R. BOALICK, *Chief Administrative Patent Judge*,  
JACQUELINE WRIGHT BONILLA, *Deputy Chief Administrative Patent Judge*,  
and MICHAEL P. TIERNEY, *Vice Chief Administrative Patent Judge*.

BOALICK, *Chief Administrative Patent Judge*.

DECISION  
*Dismissing certain claims*  
37 C.F.R. § 42.72<sup>1</sup>

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<sup>1</sup> This decision pertains to both IPR2016-01198 and IPR2016-01201, as the appeals from those proceedings were consolidated and the issues before us now span both proceedings. Citations are to the paper numbers in IPR2016-01198.

## I. BACKGROUND

On November 20, 2017, the Board issued a Final Written Decision in each of these proceedings. Paper 53 (“Final Written Decision”). On December 21, 2018, we entered an Order granting-in-part a motion for sanctions filed by Petitioner Apple Inc. (“Petitioner”). Paper 70 (“Sanctions Order”). As part of the Sanctions Order, we authorized Petitioner to file a request for rehearing of the Final Written Decisions entered on November 20, 2017. Order 13–16. Following the parties’ briefing, we denied Petitioner’s request for rehearing. Paper 75.

On appeal, the Federal Circuit determined that these proceedings were moot as to claims deemed patent ineligible under 35 U.S.C. § 101 in a prior appeal of a district court judgment, *Voip-Pal.com, Inc. v. Twitter, Inc.*, 798 F. App’x 644 (Fed. Cir. 2020). *Apple Inc. v. Voip-Pal.com, Inc.*, 976 F.3d 1316, 1321 (Fed. Cir. 2020). Thus, the Court vacated our Final Written Decisions as to those “overlapping claims”—claims 1, 7, 27, 28, 72, 73, 92, and 111 of U.S. Patent No. 8,542,815 B2 (“the ’815 patent”) and claims 49, 73, 74, 75, 77, 78, 83, 84, 94, 96, and 99 of U.S. Patent No. 9,179,005 B2 (“the ’005 patent”). 976 F.3d at 1321. The Federal Circuit directed us to dismiss the Petitions as to those claims. *Id.* (citing *United States v. Munsingwear, Inc.*, 340 U.S. 36, 39-41 (1950)), 1326. The Federal Circuit affirmed the Board’s non-obviousness determinations as to the remaining claims in these proceedings, and affirmed the Board’s Sanctions Order. *Id.* at 1326.

## II. ANALYSIS

As directed by the Federal Circuit, we dismiss the Petition in IPR2016-01201 as to claims 1, 7, 27, 28, 72, 73, 92, and 111 of the ’815 patent and

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IPR2016-01201 (Patent 8,542,815 B2)

dismiss the Petition in IPR2016-01198 as to claims 49, 73, 74, 75, 77, 78, 83, 84, 94, 96, and 99 of the '005 patent. 37 C.F.R. § 42.72.

### III. ORDER

It is, therefore,

ORDERED that the Petition in IPR2016-01198 is dismissed as to claims 49, 73, 74, 75, 77, 78, 83, 84, 94, 96, and 99 of the '005 patent; and

FURTHER ORDERED that the Petition in IPR2016-01201 is dismissed as to claims 1, 7, 27, 28, 72, 73, 92, and 111 of the '815 patent.

IPR2016-01198 (Patent 9,179,005 B2)

IPR2016-01201 (Patent 8,542,815 B2)

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