UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VOIP-PAL.COM, INC.
Patent Owner

Case No. IPR2016-01198
Patent 9,179,005

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.120

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I. INTRODUCTION

Voip-Pal focuses its opposition almost exclusively on establishing an actual reduction to practice that it alleges occurred on June 6, 2005, nearly **17 months before the provisional patent application was actually filed**. Voip-Pal's swear-behind effort suffers from a common deficiency—it relies on witness testimony that Voip-Pal could not corroborate. Voip-Pal points to Exhibit 2014 as the source code that embodied its reduction to practice. Presenting source code is not enough, however. Voip-Pal must demonstrate that the source code (a) worked for its intended purpose and (b) was coextensive with the Challenged Claims. Voip-Pal has done neither. With respect to the first point, Voip-Pal relies exclusively on witness testimony that it cannot corroborate and that is extremely biased with witnesses with enormous personal stakes in this proceeding. Voip-Pal did not compile and execute the code, despite having the code in its possession. Voip-Pal did not present a single test log or other record of testing, despite having such records in its possession. Voip-Pal did not provide a single detail as to any call that was successfully connected using the source code version in Exhibit 2014. In fact, the documentary record shows only that the source code in Exhibit 2014 was an incomplete work as of June 6, 2005, a work that continued to be edited, modified, and added to for a lengthy period thereafter.

Similarly, Voip-Pal relies heavily on the Smart421 Report (Exhibit 2003) to

demonstrate the alleged functionality of the source code in Exhibit 2014. Its reliance on this report is baffling because the report concluded that the code was only a little over half complete and that "it was not easy to ascertain which features were already implemented in the live service, as opposed to those that were able to be added in a future release." **Ex. 2003** at 12. Voip-Pal's other exhibits fare no better and include no actual description or verification of the features that allegedly were in operation in June 2005. Voip-Pal went to great lengths to stitch together a narrative that ultimately does not appear accurate. The more plausible narrative based on the evidence is that whatever Patent Owner had on June 6, 2005, it was not nearly complete and there is no evidence that it was operational for any of the purposes described and claimed in the Challenged Patent.

Voip-Pal's two substantive criticisms of Petitioner's proposed rejections also fail to withstand scrutiny. Its first critique relies on its own expert's opinion that Chu '684 would require specific dialing conventions because it's a PBX system. But Voip-Pal's expert has no telephony expertise, never worked on a PBX system, and his conclusion is directly opposed to the express teachings of Chu '684. Voip-Pal's second critique—that Chu '684's enterprise-wide dial plans fail to teach the claimed calling profile—simply mischaracterizes Petitioner's proposed rejections. The proposed combinations rely on the calling profiles taught by its secondary references (Chu '366 and Chen), not the dial plans in Chu '684.

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