

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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Case IPR2016-01198  
Patent 9,179,005 B2

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Before JOSIAH C. COCKS, JENNIFER MEYER CHAGNON, and  
JOHN A. HUDALLA, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1, 24–26, 49, 50, 73–79, 83, 84, 88, 89, 92, 94–96, 98, and 99 of U.S. Patent No. 9,179,005 B2 (Ex. 1001, “the ’005 patent”). Paper 2 (“Pet.”). Voip-Pal.com, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 5 (“Prelim. Resp.”). Based on those submissions, the Board instituted trial to determine whether the above-noted claims would have been obvious over (1) Chu ’684<sup>1</sup> and Chu ’366<sup>2</sup>, and (2) Chu ’684 and Chen<sup>3</sup>. Paper 6 (“Inst. Dec.”). Patent Owner’s Request for Rehearing (Paper 9) was denied (Paper 11).

Subsequently, Patent Owner filed a Patent Owner Response. Paper 17 (“PO Resp.”). As a part of that Patent Owner Response, Patent Owner included new evidence on which it relied in contending that the Petitioner had not met the enhanced burden of establishing by a “preponderance of the evidence” (35 U.S.C. § 316(e)) the unpatentability of any of the claims of the ’005 patent. *See* Exs. 2008–2050. Petitioner filed a Reply. Paper 34 (“Pet. Reply”). Patent Owner filed a Sur-Reply. Paper 41 (“PO Sur-Reply”).<sup>4</sup> Patent Owner also filed a Motion to Exclude. Paper 40. Petitioner filed an Opposition (Paper 44), to which Patent Owner replied

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<sup>1</sup> U.S. Patent No. 7,486,684 B2 to Chu et al. issued Feb. 3, 2009 (Ex. 1006) (“Chu ’684”).

<sup>2</sup> U.S. Patent No. 8,036,366 B2 to Chu issued Oct. 11, 2011 (Ex. 1007) (“Chu ’366”).

<sup>3</sup> U.S. Patent Application Publication No. US 2007/0064919 A1 to Chen et al. published Mar. 22, 2007 (Ex. 1008) (“Chen”).

<sup>4</sup> The Sur-Reply was authorized by the panel. Paper 37.

(Paper 47). Oral argument was conducted on July 20, 2017. A copy of the transcript of the argument was entered into the record. Paper 52.

We have jurisdiction under 35 U.S.C. § 6. This Decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of the challenged claims. For the reasons that follow, we determine Petitioner has not shown by a preponderance of the evidence that claims 1, 24–26, 49, 50, 73–79, 83, 84, 88, 89, 92, 94–96, 98, and 99 of the '005 patent are unpatentable.

#### *A. Related Matters*

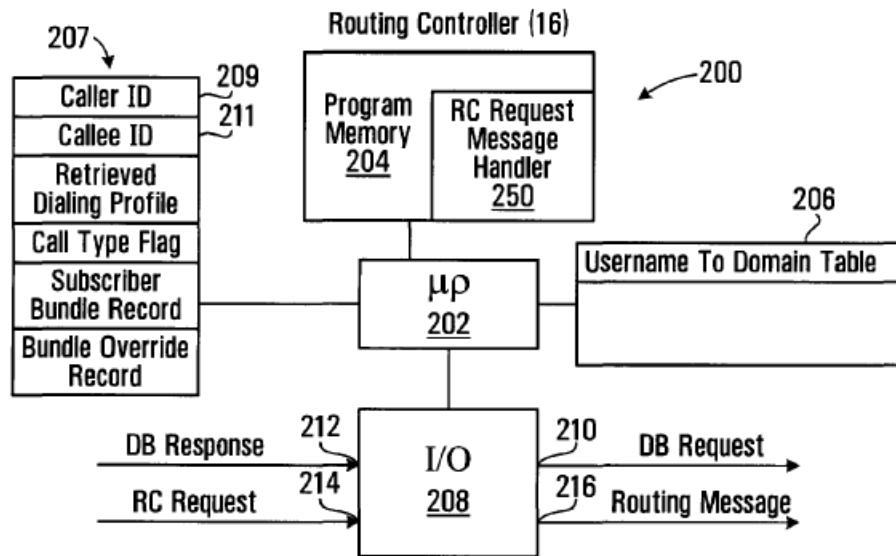
The parties identify the following district court proceedings in which the '005 patent has been asserted: *Voip-Pal.com, Inc. v. Apple, Inc.*, Case No. 2-16-cv-00260 (D. Nev.); and *Voip-Pal.com, Inc. v. Verizon Wireless Services, LLC*, Case No. 2-16-cv-00271 (D. Nev.). See Pet. 60–61; Paper 4, 1. Petitioner also has filed a petition for *inter partes* review of claims of the '005 patent in IPR2017-01398, as well as petitions in connection with related U.S. Patent No. 8,542,815 (“the '815 patent”) in IPR2016-01201 and IPR2017-01399.<sup>5</sup>

#### *B. The '005 Patent*

The '005 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 '005 patent is shown below.

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<sup>5</sup> Trial was instituted in IPR2016-01201 on November 21, 2016. A decision regarding institution of trial in each of IPR2017-01398 and IPR2017-01399 has not yet been made.



**FIG. 7**

Figure 7 above illustrates a routing controller that facilitates communication between callers and callees. *Id.* at Fig. 7, 14:32–33, 17:26–27. As shown in Figure 7, 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 17:28–31. Routing controller 16 queries database 18 (shown in Figure 1) to produce a routing message to connect caller and callee. *Id.* at 14:18–25, 14:32–42. Program memory 204 includes blocks of code for directing processor 202 to carry out various functions of the routing controller. *Id.* at 17:47–49. Those blocks of code include RC request message handler 250, which directs the routing controller to produce the routing message. *Id.* at 17:49–53.

In response to a calling subscriber initiating a call, the routing controller of the '005 patent:

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 14:32–42.

Figures 8A through 8D of the '005 patent illustrate a flowchart of an RC request message handler executed by the RC processor circuit. *Id.* at 11:3–4. Figure 8B is reproduced below.

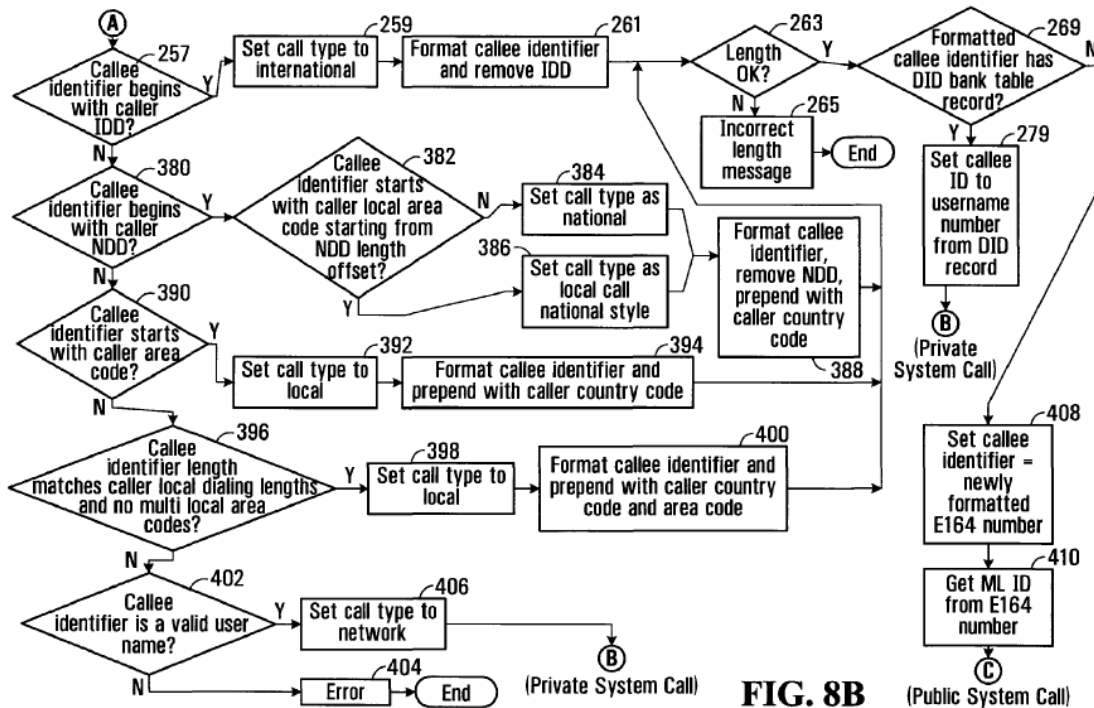


Figure 8B above illustrates steps for performing checks on the callee identifier. *Id.* at Fig. 8B, 19:53–57. Blocks 257, 380, 390, 396, 402 in Figure 8B effectively “establish call classification criteria for classifying the call as a public network call or a private network call.” *Id.* at 22:58–61. 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

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