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.
_____

Case IPR2016-01198
Patent 9,179,005 B2
_____

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

MARGOLIES, *Administrative Patent Judge*.

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

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."). 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 shows that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1, 24–26, 49, 50, 73–79, 83, 84, 88, 89, 92, 94–96, 98, and 99 of the '005 patent.

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 U.S. Patent No. 8,542,815 ("the '815 patent") in IPR2016-001201. Another petitioner—Unified Patents Inc.—filed a petition for *inter partes* review of claims of the '815 patent in IPR2016-01082. We did not institute a trial in that case.

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, shown below, illustrates a routing controller that facilitates communication between callers and callees:
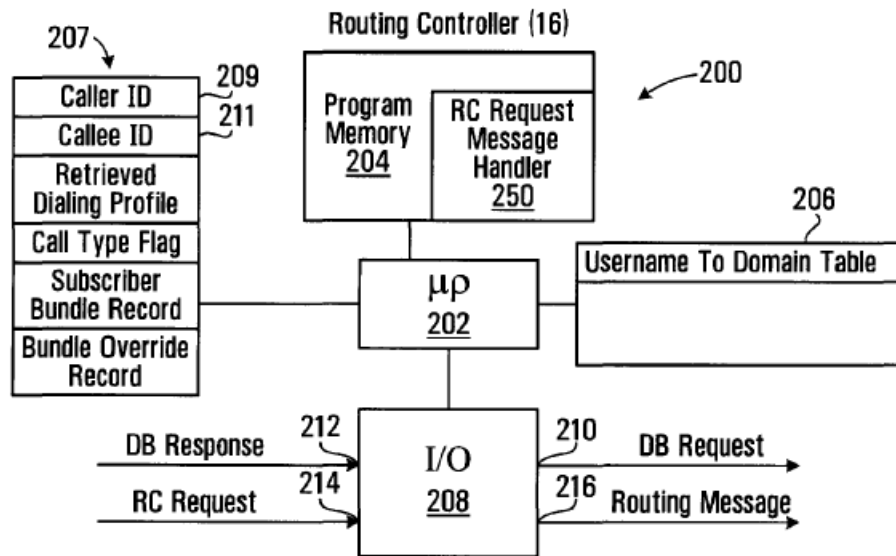
Routing Controller (16)

207

209
211

| Caller ID |
| Callee ID |
| Retrieved Dialing Profile |
| Call Type Flag |
| Subscriber Bundle Record |
| Bundle Override Record |

-200

Program Memory 204 | RC Request Message Handler 250

206

Username To Domain Table

μρ 202

212 DB Response
214 RC Request

210 DB Request
216 Routing Message

I/O 208

FIG. 7

Id. at Fig. 7, 14:32–33, 17:26–27. 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 17:28–31. 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.

According to the '005 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 14:32–42.

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, shown below, illustrates steps for performing checks on
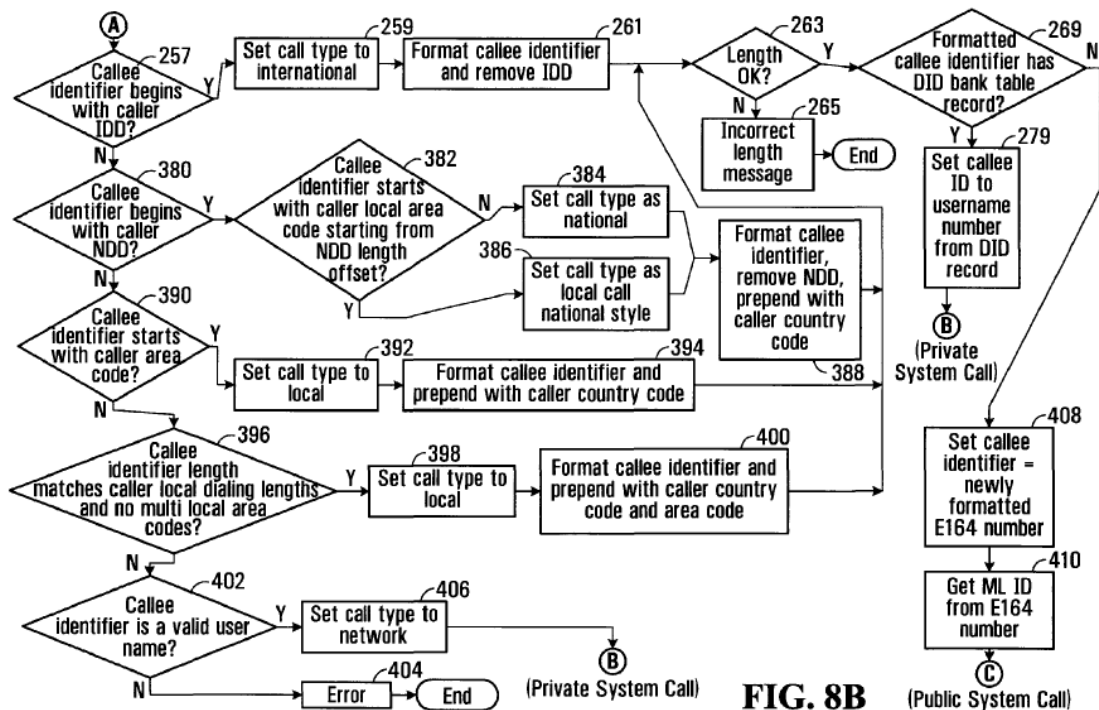
the callee identifier:

FIG. 8B

Id. at Fig. 8B, 19:53–57. 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 22:58–61. 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

predefined format, i.e. is a valid user name and identifies a subscriber to the private network . . . ." *Id.* at 22:61–23:3. Block 269 also classifies the call as public or private, depending on whether the callee is a subscriber to the system. *Id.* at 22:61–23:19, 20:23–33; *see also id.* at 18:63–19:30.

C. Illustrative Claim

Among the challenged claims, claims 1, 26, 50, 74, 94, and 99 are independent. Claims 1 and 74 are illustrative and read:

1. A process for producing a routing message for routing communications between a caller and a callee in a communication system, the process comprising:

using a caller identifier associated with the caller to locate a caller dialing profile comprising a plurality of calling attributes associated with the caller;

when at least one of said calling attributes and at least a portion of a callee identifier associated with the callee meet private network classification criteria, 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; and

when at least one of said calling attributes and at least a portion of said callee identifier meet a public network classification criterion, producing a public network routing message for receipt by the call controller, said public network routing message identifying a gateway to the public network.

74. A method of routing communications in a packet switched network in which a first participant identifier is associated with a first participant and a second participant identifier is associated with a second participant in a communication, the method comprising:

after the first participant has accessed the packet switched network to initiate the communication, using the first participant identifier to locate a first participant profile comprising a plurality of attributes associated with the first participant;

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