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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

U.S. Patent 9,179,005

**PATENT OWNER'S REQUEST FOR REHEARING
PURSUANT TO 37 C.F.R. § 42.71(d)**

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Pursuant to 37 C.F.R. § 42.71(d), Patent Owner Voip-Pal.com, Inc. (“Voip-Pal”) respectfully requests reconsideration of the Board’s November 21, 2016 Decision Granting Institution of *Inter Partes* Review (“Decision,” Paper 6). The Board’s decision overlooked two key arguments of the Patent Owner, either of which is sufficient to show that Petitioner failed to carry its burden of proof.

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

The Board’s Decision overlooked that the challenged claims require a specific ordering of steps yet the Petition fails to use a claim construction that accounts for this ordering of steps. The Decision also overlooked that the Petitioner ascribed—without any substantial evidence—an alleged deficiency to Chu ‘684 as its key motivation to combine Chu ‘684 with Chu ‘366 or Chen. Both deficiencies were explained in the Patent Owner’s Preliminary Response but were not addressed by the Board’s reasons in its Decision. In view of these oversights, Voip-Pal respectfully requests that the Board reconsider the Decision and deny institution of *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.

II. LEGAL STANDARD FOR REHEARING

A patent owner may request rehearing of a decision granting institution of *inter partes* review. 37 C.F.R. § 42.71(d). A rehearing request “must specifically identify all matters the party believes the Board misapprehended or overlooked,

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