

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. IPR2016-01201
Patent 8,542,815

PETITIONER'S REQUEST FOR REHEARING

PURSUANT TO 37 C.F.R. § 42.71(d)

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I. INTRODUCTION

Apple Inc. (“Petitioner”) hereby respectfully requests that the Patent Trial and Appeal Board (“Board”) reconsider its Final Written Decision (Paper 53) upholding the patentability of claims 1, 7, 27-28, 34, 54, 72-74, 92-93, and 111 of U.S. Patent No. 8,542,815 (Ex. 1001, “the ’815 Patent”).

The Final Written Decision (“FWD”), issued by the Replacement Panel, rests on an erroneous understanding of the Proposed Combination that was advanced by Patent Owner in its Preliminary Response. The Institution Decision (“ID”), issued by the Original Panel, rejected the same arguments, noting that they were premised on Patent Owner’s mischaracterization of the Proposed Combinations. The Original Panel again rejected the very same arguments in response to Patent Owner’s Request for Rehearing of the ID and again noted that they were premised on Patent Owner’s mischaracterization of the Proposed Combinations. After being twice rejected, Patent Owner largely abandoned the mischaracterizations in its Response.

The Replacement Panel, in the FWD, adopted Patent Owner’s pre-institution mischaracterization of the Proposed Combination, which had been twice-rejected by the Original Panel and largely abandoned by Patent Owner. In so doing, the Replacement Panel did not cite or otherwise discuss a single paper submitted by Petitioner post-institution correcting the Patent Owner’s mischaracterizations and supporting the actual Proposed Combination. Petitioner had specifically reiterated the nature and operation of the Proposed Combination in its Reply and again at the

oral argument. The Replacement Panel's failure to even cite to Petitioner's post-institution briefs is telling. Had the Replacement Panel considered the full record, it would not have misapprehended the Proposed Combinations and it would not have overlooked the ample record evidence supporting the instituted grounds.

Accordingly, Petitioner respectfully requests that the Board reconsider the Final Written Decision in view of the actual Proposed Combinations and the totality of the record, including Petitioner's arguments submitted post-institution.

This request is timely filed by January 8, 2019—the deadline set forth in the Board's Order, Granting-in-Part Petitioner's Motion for Sanctions. Paper 70 at 16.

II. RESERVATION OF RIGHTS

By presenting the Request for Rehearing authorized by Paper 70, Petitioner does not concede, expressly or by implication, the correctness of the Board's Order resolving Petitioner's motion for sanctions. Patent Owner engaged in improper *ex parte* communications that created at least the appearance of impropriety and prejudiced Petitioner. Petitioner continues to maintain that, in addition to violating the Board's rules, this improper conduct violated both the Administrative Procedure Act and the Due Process Clause. In the context of this proceeding, and given the undisputed timing and nature of the events, Patent Owner's violations, individually or collectively, warrant a meaningful sanction to alleviate the prejudice to Petitioner. The rehearing request authorized by Paper 70 is at most a partial remedy for Patent Owner's improper conduct.

III. APPLICABLE STANDARDS

“A party dissatisfied with a decision may file a single request for rehearing.” 37 C.F.R. §42.71(d). “The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.* The Board reviews a decision for an abuse of discretion. 37 C.F.R. §42.71(c). “An abuse of discretion may arise if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors.” IPR2013-00298, Paper 24, at 2 (Feb. 11, 2014) (citations omitted).

IV. RELEVANT PROCEDURAL HISTORY

Petitioner requested *Inter Partes* Review of claims 1, 7, 27-28, 34, 54, 72-74, 92-93, and 111 of the '815 Patent (“the Challenged Claims”) on two grounds (“the Proposed Combinations”), both of which rely on the same base reference—Chu '684—and similar secondary references—Chu '366 and Chen (“the Secondary References”). Paper 1, *Petition* at 5, 12-20, 37-41. Each of the Proposed Combinations relies on Chu '684 for its infrastructure, call classifying, and call routing teachings, and the Secondary References for their caller profile and dialed digit reformatting teachings. *Id.* The Proposed Combinations each propose that Chu '684 would benefit if its users could employ short form dialing—as is common for local PSTN calls on a standard landline (e.g., 555-1234)—rather than being required

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