

Filed: February 10, 2017

Filed on behalf of:

Patent Owner Voip-Pal.com Inc.

By: Kerry Taylor

John M. Carson

KNOBBE, MARTENS, OLSON & BEAR, LLP

2040 Main Street, 14th Floor

Irvine, CA 92614

Tel.: (858) 707-4000

Fax: (858) 707-4001

Email: BoxDigifonica@knobbe.com

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

U.S. Patent 8,542,815

PATENT OWNER RESPONSE TO PETITION

TABLE OF CONTENTS

	Page No.
I. INTRODUCTION	1
II. ARGUMENT.....	4
A. CHU '366 IS NOT PRIOR ART UNDER PRE-AIA 35 U.S.C. 102(e).....	4
1. Digifonica's RBR Software	5
2. Digifonica Release of RBR Version 361	31
3. The Smart 421 Engagement.....	32
4. Inventor and Employee Testimony.....	35
B. CHEN IS NOT PRIOR ART UNDER PRE-AIA 35 U.S.C. 102(e).....	38
C. PETITIONER FURTHER FAILS TO ESTABLISH THAT THE CHALLENGED CLAIMS ARE OBVIOUS	39
1. CLAIMED SUBJECT MATTER.....	39
2. OVERVIEW OF CITED ART	41
a. Overview of Chu '684	41
b. Overview of Chu '366	43
c. Overview of Chen.....	44
D. PETITIONER'S COMBINATIONS FAIL TO PROVIDE CLAIM STEPS [1D], [27D], [28D-E], OR [54B-C], [74B-C], [93B-C].....	46
1. The proposed combinations fail to provide steps [1d], [27d], [28d-e], or [54b-c], [74b-c], or [93b-c]	46

TABLE OF CONTENTS
(cont'd)

	Page No.
2. A PHOSITA would not follow the order of steps set forth in the Petition to combine the teachings of the references.	50
3. Petitioner fails to identify any equivalent structure in the references corresponding to the “means for classifying” or “means for producing” in steps [28d-e], [93b-c].....	57
E. PETITIONER’S PROPOSED COMBINATIONS FAIL TO LOCATE ATTRIBUTES ASSOCIATED WITH THE CALLER AS RECITED IN CLAIMS [1B], [27B], [28B], [74A], and [93A]	59
1. The Petition fundamentally misinterpreted the dial plans of Chu ‘684 as being <i>user</i> -specific instead of <i>enterprise</i> -specific.....	59
2. Chu ‘684’s “dial plan” is <i>enterprise</i> -specific, not <i>user</i> -specific, which undercuts Petitioner’s obviousness theories	60
a. Consulting an <i>enterprise</i> “dial plan” in Chu ‘684 is distinct from “locating a <i>caller</i> dialing profile” as recited in claims [1b], [27b], [28b].....	61
b. A <i>single</i> “dial plan” is not a <i>plurality</i> of “profiles” for “respective” users as recited in claims [74a] and [93a]	62
c. Chu ‘684’s <i>enterprise</i> “dial plan” cannot be combined with individualized profiles	63
F. PETITIONER FAILS TO ARTICULATE A PROPER REASON TO COMBINE AND OVERLOOKS WHY THE COMBINATIONS ARE UNDESIRABLE	64

TABLE OF CONTENTS
(cont'd)

	Page No.
1. No articulated reasoning for reason to combine	64
2. No reason to reformat numbers in Chu '684	66
3. Adding individual user-specific dialing rules in a PBX is irreconcilable with an enterprise "dial plan"	67
III. CONCLUSION.....	69

TABLE OF AUTHORITIES

Page No(s).

<i>Eaton v. Evans</i> , 204 F.3d 1094 (Fed. Cir. 2000)	4, 38
<i>Google, Inc. v. EVERYMD.COM LLC</i> , IPR2014-00347, Paper 9 (May 22, 2014).....	58
<i>In re Gordon</i> , 733 F.2d 900 (Fed. Cir. 1984)	51
<i>KSR Int’l. Co. v. Teleflex, Inc.</i> , 550 U.S. 398 (2007).....	64
<i>In re NuVasive, Inc.</i> 842 F.3d 1376	64, 65
<i>In re Ratti</i> , 270 F.2d 810, 123 USPQ 349 (CCPA 1959).....	63
<i>Valeo N. Am., Inc. v. Magna Elec., Inc.</i> , IPR2014-01206, Paper 13 (Dec. 23, 2014).....	58

OTHER AUTHORITIES

35 U.S.C. § 102	3, 4, 37, 38
35 U.S.C. § 112	57
35 U.S.C. § 312.....	58
35 U.S.C. § 316.....	3
37 C.F.R. § 42.22	58
37 C.F.R. § 42.104.....	58

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.