Filed: June 14, 2017

Filed on behalf of Patent Owner Voip-Pal.com Inc.
By:
Kerry S. Taylor
John M. Carson
William R. Zimmerman (pro hac vice)
KNOBBE, MARTENS, OLSON
& BEAR, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

Ph.: (858) 707-4000
E-mail: BoxDigifonica@knobbe.com

Ryan Thomas (pro hac vice)

Ph.: (435) 630-6005
E-mail:
thomasattorney711@gmail.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 SUR-REPLY IN RESPONSE TO PETITIONER'S REPLY

Pursuant to Board Order (Paper 37), Patent Owner Voip-Pal.com, Inc. ("Voip-Pal") hereby submits its Sur-Reply addressing Apple's Reply arguments.

I. Apple Relies On An Incorrect Testing Requirement Standard

Apple argues that rigorous testing is required to establish reduction to practice for software. Reply at 4-12. But this requirement is satisfied when there is evidence of actual successful use. "A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used." *Blicke v. Treves*, 241 F.2d 718, 720 (C.C.P.A. 1957); *see also Estee Lauder, Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 592 (Fed. Cir. 1997). The evidence shows that Digifonica's system performed all features of the claims by placing on-net and off-net calls via supernodes in Vancouver and London; indeed, Digifonica routinely used the system as its primary telephone system. Ex. 2018 ¶¶3-7; Ex. 1009 at 12:17-24, 23:12-21, 39:24-40:5, 47:18-48:10, 49:15-50:21, 53:25-54:5, 54:24-55:12, 71:9-16, 80:12-81:1; Ex. 2003 at §§ 1.1, 2.4.2, 4.3.7.2; Exs. 2008-2009 ¶¶4&7; Ex. 1010 at 25:2-8, 73:1-18, 76:10-22; Ex. 2012 at ¶¶11&16; Ex. 1012 at 84:6-85:20; Exs. 2023-2027. This actual successful use of the RBR code in June 2005 establishes it was working for its intended purpose.

Even if evidence of testing were required, Voip-Pal has carried its burden. Apple premises its rigorous testing requirement on a single inapposite IPR decision in which a *specific* invention required "hundreds, if not thousands" of tests.

IPR2015-00325 (Paper 62 at 29). But the Federal Circuit has held that "the testing requirement depends on the particular facts of each case, with the court guided by a common sense approach in weighing the sufficiency of the testing." *Scott v. Finney* 34 F.3d 1058, 1061 (Fed. Cir. 1994). The record establishes that successfully placing on-net and off-net calls was itself sufficient to show that the RBR code was operational. Ex. 2008 ¶4; Ex. 2003 § 4.3.7.2; Ex. 1009 at 13:9-14:21, 39:7-15, 77:19-78:7 (referencing Ex. 2018 ¶4). Voip-Pal has provided evidence of testing. Apple provides no reason why a "common sense approach" would require more.

II. Apple Disregards Evidence that RBR Worked For Its Intended Purpose

Apple—bereft of any expert testimony—disregards or distorts voluminous evidence of record that RBR v361 worked in June 2005 for its intended purpose.

Apple attacks the authenticity of Ex. 2014 (i.e., RBR code v.361) despite not filing any objection to this exhibit. Ex. 2014 is authenticated by multiple witnesses. Ex. 2014 is based on a code repository provided by Mr. Huttunen (whom Apple declined to depose) to forensic expert, Mr. Purita, who calculated the repository's checksums. Exs. 2010-2011. Dr. Mangione-Smith and Mr. Bjorsell verified these checksums and the date of RBR code v361 in the repository, which Dr. Mangione-Smith used to produce Ex. 2014 and analyze RBR v361 relative to the '815 Patent claims. Ex. 2016 at ¶¶20-24; Ex. 1012 at 46:7-55:7. Contrary to Apple's distortions, expert declarant Dr. Mangione-Smith explains that Ex. 2014 is a set of

interdependent PHP files that he extracted from Digifonica's code repository and *merely formatted for presentation*, and that Ex. 2014 reliably reproduces RBR code v361 dated June 6, 2005, which Mr. Bjorsell confirmed. Ex. 1007 at 75:18-77:3, 162:19-163:24, 74:2-24, 164:1-165:21; Ex. 1012 at 46:7-55:7.

Apple asserts there's "no evidence" that the RBR code was operational or tested in June 2005, nor was its functionality confirmed by any witness. Reply at 2, 6 & 9. Apple grossly misrepresents the record. First, Mr. Terry testified extensively from personal knowledge that RBR v361 worked for its intended purpose by placing on-net and off-net calls in June 2005, corroborating similar testimony from inventors Mr. Perreault and Mr. Bjorsell. Ex. 2018 at ¶¶3-5&7; Ex. 1009 at 12:17-24, 23:12-24:4, 39:7-40:20, 48:20-50:24, 79:23-81:1; Ex. 2013 at ¶¶12-13; Ex. 1010 at 97:3-98:14; Ex. 2012 at ¶16; Ex. 1012 at 84:11-85:20. Second, the declarants testified how the RBR code was extensively tested in June 2005. Ex. 1009 at 46:18-48:19, 53:25-54:5, 77:5-78:7, 80:8-81:1; Ex. 1010 at 29:17-30:8, 73:1-18, 76:10-22, 25:2-8; Ex. 1012 at 82:7-85:20. Third, contemporaneous emails corroborate that RBR code v361 was deployed and tested on June 6, 2005. Exs. 2025-2027. Fourth, Mr. Rutter and Mr. Gare from UK company Smart421 corroborate that Digifonica was successfully classifying and routing calls in June 2005. Ex. 1008 at 21:3-11, 22:7-12, 24:20-25, 31:3-13, 32:25-33:7, 34:4-35:21; Exs. 2008-2009 at ¶¶4-7; Ex. 2003 ("calls ... reliably routed" at §1.1, "tested in live

operation" at § 2.4.2). Fifth, contrary to Apple's assertions, Mr. Bjorsell executed the v361 RBR code to test it and Dr. Mangione-Smith also confirmed its operability by multiple methods. Ex. 1012 at 72:2-15; Ex. 1007 at 48:3-49:14, 177:1-178:13, 58:4-22. Expert Dr. Mangione-Smith states that the evidence is convincing that RBR v361 was operational in June 2005. Ex. 2016 ¶¶24-29; Ex. 1007 at 62:6-16. Apple's assertion of "no evidence" is contradicted by the record.

Apple's assertion that RBR v361 was "a work in progress" (Reply at 5-6) is a red herring: Apple ignores the evidence that RBR's core call classification and routing features were complete, and changes to RBR were minor "bug fixes" and adding "bells and whistles". Ex. 1009 at 54:24-55:12, 77:5-18; Ex. 1010 at 98:17-99:13. That the claimed call classification/routing functionality was complete in June 2005 is shown by the RBR code's stability, as the RBR log file confirms. Ex. 1009 at 71:9-16; Ex. 2015 at 51-53 (RBR changes shown in log are minor).

III. Apple's Argument Rests On An Overly Narrow Claim Construction

Apple incorrectly asserts that because Digifonica's RBR code did not generate "the IP address of the phone," the RBR code did not produce "an address … associated with the callee" as recited in the claims. Reply at 12-15. Implicit in Apple's argument is that "address" is limited to "the IP address of the callee phone." But Apple provides no support for such a narrow construction, and this construction is inconsistent with the '815 Patent and Apple's own Petition.

DOCKET ALARM

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.