

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.

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Case IPR2016-01201  
Patent 8,542,815 B2

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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, 7, 27, 28, 34, 54, 72–74, 92, 93, and 111 of U.S. Patent No. 8,542,815 B2 (Ex. 1001, “the ’815 patent”). Paper 1 (“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, 7, 27, 28, 34, 54, 72–74, 92, 93, and 111 of the ’815 patent.

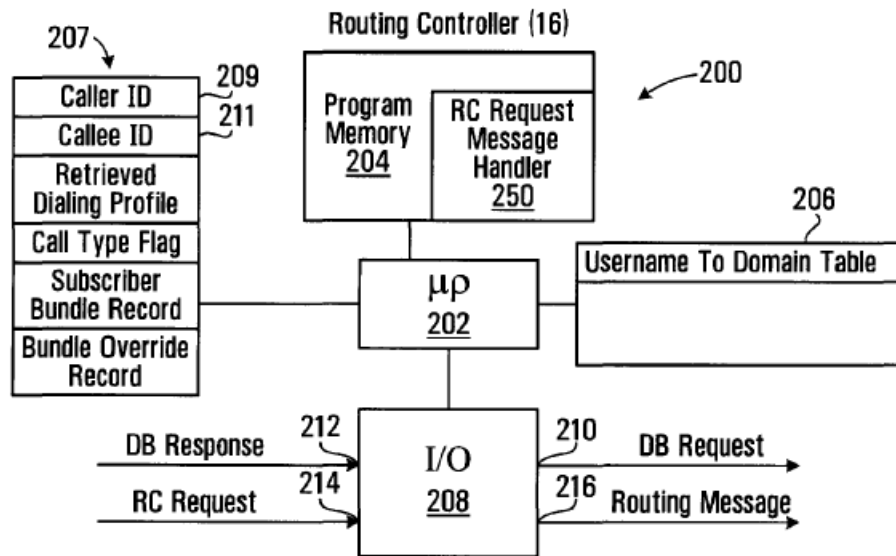
#### A. *Related Matters*

The parties identify the following district court proceedings in which the ’815 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. 58; Paper 4, 1.

Petitioner also has filed a petition for *inter partes* review of claims of U.S. Patent No. 9,179,005—a continuation of the ’815 patent—in IPR2016-001198. 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 ’815 Patent*

The ’815 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 ’815 patent, shown below, illustrates a routing controller that facilitates communication between callers and callees:



**FIG. 7**

*Id.* at Fig. 7, 14:24–25, 17:16–17. 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 17:17–22. Routing controller 16 queries database 18 (shown in Figure 1) to produce a routing message to connect caller and callee. *Id.* at 14:10–17, 14:24–34. Program memory 204 includes blocks of code for directing processor 202 to carry out various functions of the routing controller. *Id.* at 17:38–40. Those blocks of code include RC request message handler 250, which directs the routing controller to produce the routing message. *Id.* at 17:40–44.

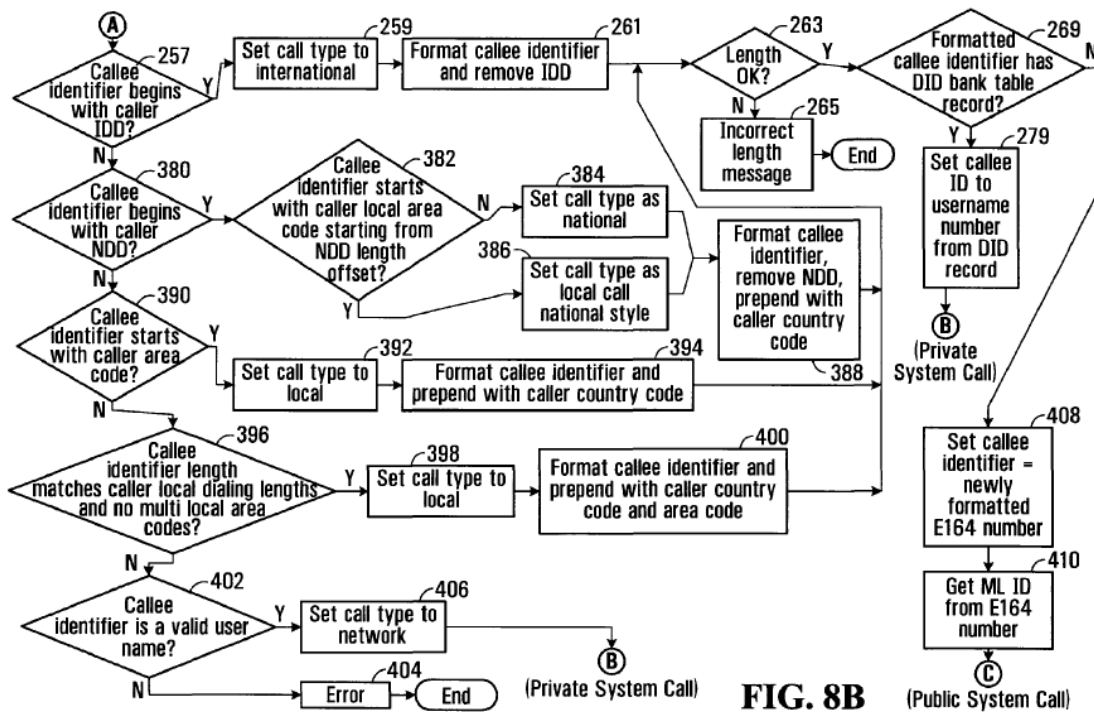
According to the '815 patent, in response to a calling subscriber initiating a call, the routing controller:

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 14:24–34.

Figures 8A through 8D of the '815 patent illustrate a flowchart of an RC request message handler executed by the RC processor circuit. *Id.* at 10:62–63. Figure 8B, shown below, illustrates steps for performing checks on the callee identifier:



**FIG. 8B** (Private System Call) (Public System Call)

*Id.* at Fig. 8B, 19:45–49. 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 22:48–51. 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 22:51–60. Block 269 also classifies the call as public or private, depending on whether the callee is a subscriber to the system. *Id.* at 22:51–23:8, 20:14–24; *see also id.* at 18:55–19:22.

### *C. Illustrative Claim*

Among the challenged claims, claims 1, 27, 28, 54, 74, and 93 are independent. Claim 1 is illustrative and reads:

1. A process for operating a call routing controller to facilitate communication between callers and callees in a system comprising a plurality of nodes with which callers and callees are associated, the process comprising:

in response to initiation of a call by a calling subscriber, receiving a caller identifier and a callee identifier;

locating a caller dialing profile comprising a username associated with the caller and a plurality of calling attributes associated with the caller;

determining a match when at least one of said calling attributes matches at least a portion of said callee identifier;

classifying the call as a public network call when said match meets public network classification criteria and classifying the call as a private network call when said match meets private network classification criteria;

when the call is classified as a private network call, 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;

when the call is classified as a public network call, producing a public network routing message for receipt by the call controller, said public network routing message identifying a gateway to the public network.

*Id.* at 36:14–38.

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