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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T SERVICES, INC.

Petitioner,

v.

VoIP-PAL.COM, INC.,

Patent Owner

Case No. IPR2017-01382

U.S. Patent 8,542,815

**PATENT OWNER'S PRELIMINARY RESPONSE TO
PETITION FOR *INTER PARTES* REVIEW**

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TABLE OF AUTHORITIES

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