UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AT&T SERVICES, INC.,
Petitioner,

v.

VOIP-PAL.COM, INC.,
Patent Owner.

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Case IPR2017-01383
Patent 9,179,005 B2

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Before JOSIAH C. COCKS, JENNIFER MEYER CHAGNON, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I.   INTRODUCTION

AT&T Services, Inc. ("Petitioner")[1] filed a Petition for *inter partes* review of claims 74–79, 83, 84, 88, 89, 92, 94–96, 98, and 99 ("the challenged claims") of U.S. Patent No. 9,179,005 B2 (Ex. 1001, "the '005 patent"). Paper 1 ("Pet."). Petitioner relies on the Declaration of James Bress (Ex. 1003) to support its positions. Voip-Pal.com, Inc. ("Patent Owner")[2] filed a Preliminary Response. Paper 5 ("Prelim. Resp.").

We have authority to determine whether to institute *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Upon consideration of the Petition and the Preliminary Response, and for the reasons explained below, we determine that the information presented does not show a reasonable likelihood that Petitioner would prevail with respect to any of the challenged claims. *See* 35 U.S.C. § 314(a). Accordingly, no trial is instituted.

A. Related Proceedings

The parties indicate that the '005 patent is the subject of the following district court proceedings: *Voip-Pal.com, Inc. v. Verizon Wireless Services, LLC & AT&T Corp.*, Case No. 2:16-cv-00271 (D. Nev.); *Voip-Pal.com, Inc. v. Apple, Inc.*, 2-16-cv-00260 (D. Nev.); and *Voip-Pal.com, Inc. v. Twitter, Inc.*, 2-16-cv-02338 (D. Nev.). Pet. 2; Paper 4, 1.

Petitioner concurrently filed a petition for *inter partes* review of other claims of the '005 patent. Pet. 2; Paper 4, 1; *AT&T Services, Inc. v.*

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[1] Petitioner identifies several additional entities as real parties-in-interest. *See* Pet. 1–2.

[2] Patent Owner identifies Digifonica (International) Limited as an additional real party-in-interest. Paper 4, 1.

Voip-Pal.com, Inc., Case IPR2017-01384. Petitioner also filed a petition for
inter partes review of related U.S. Patent No. 8,542,815 B2
("the '815 patent"). Paper 4, 1; *AT&T Services, Inc. v. Voip-Pal.com, Inc.*,
Case IPR2017-01382.

The parties also identify the following proceedings, filed by
Apple, Inc., to which Petitioner is not a party:

> IPR2016-01198, challenging the '005 patent;
> IPR2016-01201, challenging the '815 patent;
> IPR2017-01398, challenging the '005 patent;
> IPR2017-01399, challenging the '815 patent.

Pet. 3; Paper 4, 1.

B. The '005 Patent

The '005 patent is titled "Producing Routing Messages for Voice Over
IP Communications." Ex. 1001, at [54]. In particular, the '005 patent
relates to producing a routing message for routing calls in a communication
system, where the routing message is based on call classification criteria that
are used to classify a particular call as a public network call or a private
network call. Ex. 1001, at [57]. Figure 7 of the '005 patent is reproduced
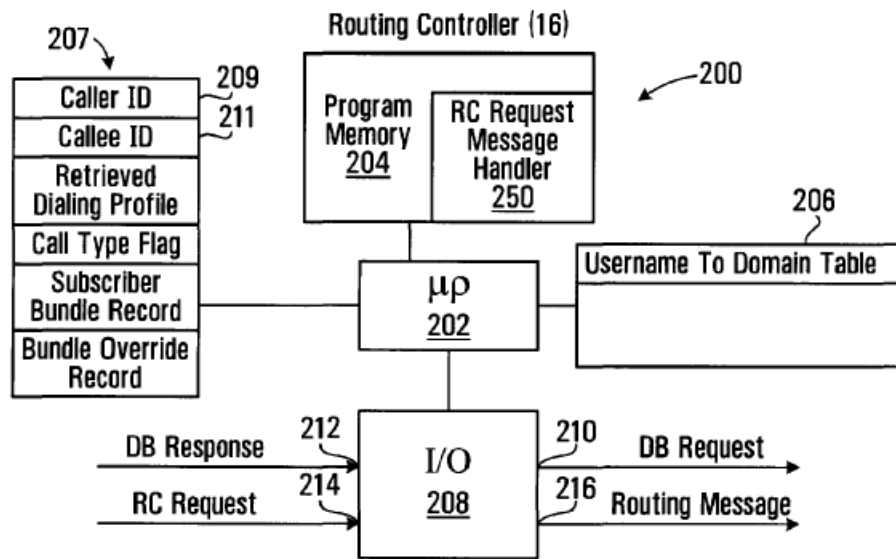below.

FIG. 7

Figure 7, reproduced above, illustrates routing controller (RC) 16, which facilitates communication between callers and callees. *Id.* at 14:32–33, 17:26–27. RC processor circuit 200 of routing controller (RC) 16 includes processor 202, program memory 204, table memory 206, buffer memory 207, and I/O port 208. *Id.* at 17:27–31. Routing controller 16 queries database 18 (shown in Figure 1) to produce a routing message to connect caller and callee. *Id.* at 14:18–25, 14:32–42. Program memory 204 includes blocks of code for directing processor 202 to carry out various functions of routing controller 16. *Id.* at 17:47–49. One such block of code is RC request message handler 250, which directs routing controller 16 to produce a routing message in response to an RC request message. *Id.* at 17:49–53.

According to the '005 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 14:32–42.

Figures 8A through 8D of the '005 patent illustrate a flowchart of an RC request message handler process, executed by the RC processor circuit. *Id.* at 11:3–4. Figure 8B of the '005 patent is reproduced below.
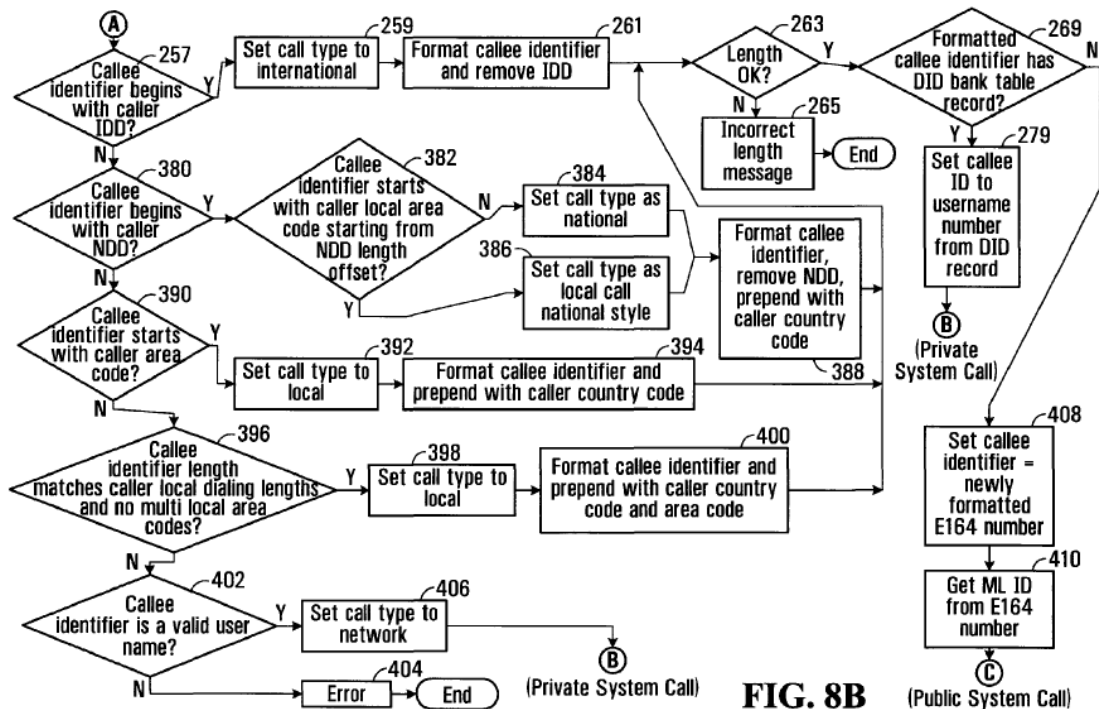

FIG. 8B

Figure 8B, reproduced above, illustrates a portion of the RC request message handler process, and in particular illustrates steps for performing checks on

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