

Filed: August 24, 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

AT&T SERVICES, INC.

Petitioner,

v.

VoIP-PAL.COM, INC.,

Patent Owner

Case No. IPR2017-01384

U.S. Patent 9,179,005

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

TABLE OF CONTENTS

Page No.

I. INTRODUCTION	1
II. ARGUMENT	4
A. Introduction to Claimed Subject Matter.....	4
B. Overview of Cited Art.....	7
1. Overview of Nadeau	7
2. Overview of Kelly.....	9
3. Overview of Vaziri.....	11
C. Grounds 1 and 2 fail because the Petition fails to show how the combination of Nadeau and Kelly “produc[es] a public network routing message for receipt by the call controller, said public network routing message identifying a gateway to the public network”	12
1. The “routing instructions” in Nadeau do not identify a gateway to the public network	14
2. The Petitioner’s assertion that the “routing instructions” in Nadeau “must” include an identification of the IP-PSTN Gateway is unsupported	16
3. The Petitioner fails to explain how Nadeau would be modified such that a public network routing message is produced which identifies a gateway to the public network as recited in the claims.....	21
a. Petitioner proposes to use the call packet produced by Kelly’s gateway selection process as routing instructions in Nadeau	24

TABLE OF CONTENTS
(cont'd)

Page No.

b.	Petitioner fails to explain how modifying Nadeau’s SLC to produce a call packet as taught by Kelly, leads to “producing a public network routing message for receipt by [a] call controller, said public network routing message identifying a gateway to [a] public network” as claimed	25
i.	The Petition has not indicated where the call packet would be sent	26
ii.	The Petition fails to explain how the call packet would be modified such that the proposed combination produces a public network routing message for receipt by the call controller, ... identifying a gateway to the public network	27
D.	Ground 2 fails because the Petitioner has failed to identify a structure in Nadeau that is functionally equivalent to the “means” recited in Claims 50 and 73	30
E.	The Petitioner’s rationale for combining Nadeau-Kelly is simplistic and incomplete, and is not fairly based upon the cited arts’ teaching.....	35
1.	Petitioner overlooks that Nadeau does not need Kelly’s solution to perform least cost routing, thus there is no motivation to combine.....	37
2.	Petitioner fails to explain why a POSITA would have been motivated to modify Nadeau in a manner that is unsupported by the cited art’s teachings.....	41

TABLE OF CONTENTS
(cont'd)

	Page No.
3. Petitioner’s analysis of the modifications required is too truncated and simplistic to establish a reasonable expectation of success.....	46
III. CONCLUSION.....	51

TABLE OF AUTHORITIES

Page No(s).

<i>Ariosa Diagnostics v. Verinata Health, Inc.</i> , 805 F.3d 1359 (Fed. Cir. 2015)	36
<i>Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.</i> , 800 F.3d 1375 (Fed. Cir. 2015)	17
<i>Innogenetics, N.V. v. Abbott Laboratories</i> , 512 F.3d 1363	36
<i>Interconnect Planning Corporation v. Feil</i> 774 F.2d 1132 (1985).....	44, 45
<i>Ex parte Kastelewicz</i> , Appeal 2008-004808 (June 9, 2009)	39, 40
<i>Kinetic Concepts, Inc., v. Smith and Nephew, Inc.</i> , 688 F. 3d. 1342 (Fed. Cir. 2012)	40
<i>In re Kotzab</i> , 217 F.3d 1365 (Fed. Cir. 2000)	35, 36
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	36, 41
<i>In re McLaughlin</i> , 443 F.2d 1392 (C.C.P.A. 1971).....	51
<i>In re NuVasive, Inc.</i> , 842 F.3d 1376 (Fed. Cir. 2016)	36
<i>PAR Pharma., Inc. v. TWI Pharmas., Inc.</i> , 773 F.3d 1186 (Fed. Cir. 2014)	17
<i>Personal Web Technologies, LLC v. Apple, Inc.</i> , 848 F.3d 987 (Fed. Cir. 2017)	35, 36

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.