

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. TBD  
U.S. Patent No. 9,179,005

---

**PETITION FOR *INTER PARTES* REVIEW  
OF U.S. PATENT NO. 9,179,005**

**TABLE OF CONTENTS**

I. INTRODUCTION..... 1

II. SUMMARY OF THE '005 PATENT..... 1

    A. Description of the Alleged Invention of the '005 Patent ..... 1

    B. Summary of the Prosecution History of the '005 Patent..... 3

    C. The Earliest Possible Priority Date for the Challenged Claims ..... 4

III. REQUIREMENTS FOR INTER PARTES REVIEW UNDER 37 C.F.R. § 42.104..... 4

    A. Grounds for Standing Under 37 C.F.R. § 42.104(a) ..... 5

    B. Identification of Challenge Under 37 C.F.R. § 42.104(b) and Relief Requested ..... 5

    C. Claim Construction Under 37 C.F.R. § 42.104(b)(3)..... 6

        1. Constructions pursuant to 35 U.S.C. § 112, ¶ 6..... 6

            (a) “means for using” ..... 7

            (b) “means for . . . producing” ..... 7

            (c) “means for causing” ..... 8

    D. Level of Skill of a Person Having Ordinary Skill in the Art..... 9

IV. THERE IS A REASONABLE LIKELIHOOD THE CHALLENGED CLAIMS OF THE '005 PATENT ARE UNPATENTABLE..... 9

    A. *Chu '684* in view of *Chu '366* renders the Challenged Claims Obvious Under 35 U.S.C. § 103(a)..... 10

    B. *Chu '684* in view of *Chen* renders the Challenged Claims Obvious Under 35 U.S.C. § 103(a)..... 36

Petition for *Inter Partes* Review of U.S. Patent No. 9,179,005

V.	MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(A)(1) .....	60
A.	Real Party-In-Interest and Related Matters .....	60
B.	Lead and Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3-4) .....	61
C.	Payment of Fees Under 37 C.F.R. § 42.103 .....	62
VI.	CONCLUSION .....	62

## I. INTRODUCTION

Petitioner Apple Inc. (“Petitioner”) requests an *Inter Partes* Review (“IPR”) of claims 1, 24-26, 49-50, 73-79, 83-84, 88-89, 92, 94-96, 98, and 99 (collectively, the “Challenged Claims”) of U.S. Patent No. 9,179,005 (“the ’005 Patent”) issued on November 3, 2015 to Clay Perreault, et al. (“Applicants”). **Exhibit 1001**, *’005 Patent*. As demonstrated by Petitioner below, the purportedly distinguishing feature of the ’005 Patent of using attributes about a caller to determine whether a call is routed to a private or public network was present in the prior art.

## II. SUMMARY OF THE ’005 PATENT

### A. Description of the Alleged Invention of the ’005 Patent

The ’005 Patent generally describes a telephony system in which calls are classified as either public network calls or private network calls and routing messages are generated to route calls accordingly. *See Ex. 1001* at Abstract. A call routing controller receives a request to establish a call from a calling party, which includes an identifier of the called party. *Id.* at 1:59-61. Call routing controller then compares the called party identifier with attributes of the calling party identifier, and may reformat the called party identifier depending on the result of this comparison. *Id.* at 2:13-31. Based on the comparison of attributes of the calling party and the called party identifier, the call routing controller next

determines whether the called party is a subscriber to a private network. *Id.* at 2:51-53, 3:4-8. If so, a routing message is generated so that the call can be directed to the private network node serving the called party. *Id.* at 1:64-67. If the called party is not on the private network, the call is classified as a public network call and a routing message is generated so that the call can be directed through a gateway to a public network. *Id.* at 1:67-2:2.

More specifically, the '005 Patent describes a calling party utilizing a Voice over Internet Protocol ("VoIP") telephone who is able to call (1) other VoIP subscribers on a private packet-based network or (2) standard public switched telephone network ("PSTN") customers on the public telephone network. *Id.* at 1:20-2:2. To identify a single destination the calling party is attempting to reach, the '005 Patent teaches that modifications to the dialed digits may be necessary. Fig. 8B illustrates a variety of modifications, which include, as an example, prepending the calling party's country code and area code to the dialed digits when the called party dials a local number. *Id.* at Fig. 8B. With the formatted number, a direct-inward-dial bank ("DID") table is referenced to determine if the called party is a subscriber to the private packet network. *Id.* If not, the call is directed to a PSTN gateway and the formatted number is used to connect the call over the public PSTN to the called party. *Id.*

# 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.