

Filed: February 10, 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, 14<sup>th</sup> 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

---

**APPLE INC.**

Petitioner,

v.

**VOIP-PAL.COM, INC.,**

Patent Owner

---

Case No. IPR2016-01198

U.S. Patent 9,179,005

---

**PATENT OWNER RESPONSE TO PETITION**

## TABLE OF CONTENTS

	<b>Page No.</b>
I. INTRODUCTION .....	1
II. ARGUMENT.....	4
A. CHU '366 IS NOT PRIOR ART UNDER PRE-AIA 35 U.S.C. 102(e).....	4
1. Digifonica's RBR Software .....	5
2. Digifonica Release of RBR Version 361 .....	41
3. The Smart 421 Engagement.....	42
4. Inventor and Employee Testimony.....	45
B. CHEN IS NOT PRIOR ART UNDER PRE-AIA 35 U.S.C. 102(e).....	47
C. PETITIONER FURTHER FAILS TO ESTABLISH THAT THE CHALLENGED CLAIMS ARE OBVIOUS .....	48
1. Claimed Subject Matter .....	49
2. Overview Of Cited Art.....	50
a. Overview of Chu '684 .....	50
b. Overview of Chu '366 .....	52
c. Overview of Chen.....	53
D. PETITIONER'S COMBINATIONS FAIL TO PROVIDE "PRODUCING..." WHEN AN "ATTRIBUTE" AND A "CALLEE IDENTIFIER" MEET "NETWORK CRITERIA" .....	55
1. The proposed combinations fail to provide at least one element in each claim.....	55

**TABLE OF CONTENTS**  
*(cont'd)*

	<b>Page No.</b>
2. A PHOSITA would not follow the order of steps set forth in the Petition to combine the teachings of the references. ....	59
<b>E. PETITIONER’S PROPOSED COMBINATIONS FAIL TO LOCATE ATTRIBUTES ASSOCIATED WITH THE CALLER.....</b>	<b>66</b>
1. The Petition fundamentally misinterpreted the dial plans of Chu ‘684 as being <i>user</i> -specific instead of <i>enterprise</i> -specific.....	66
2. Chu ‘684’s “dial plan” is <i>enterprise</i> -specific, not <i>user</i> -specific, which undercuts Petitioner’s obviousness theories .....	67
a. Consulting an <i>enterprise</i> “dial plan” in Chu ‘684 is distinct from locating a “ <i>caller</i> dialing profile” .....	67
b. Chu ‘684’s <i>enterprise</i> “dial plan” cannot be combined with individualized profiles .....	68
<b>F. PETITIONER FAILS TO ARTICULATE A PROPER REASON TO COMBINE AND OVERLOOKS WHY THE COMBINATIONS ARE UNDESIRABLE .....</b>	<b>69</b>
1. No articulated reasoning for reason to combine .....	69
2. No reason to reformat numbers in Chu ‘684 .....	71
<b>III. CONCLUSION.....</b>	<b>71</b>

**TABLE OF AUTHORITIES**

**Page No(s).**

*Eaton v. Evans*,  
204 F.3d 1094 (Fed. Cir. 2000) .....4, 48

*In re Gordon*,  
733 F.2d 900 (Fed. Cir. 1984) .....59

*KSR Int’l. Co. v. Teleflex, Inc.*,  
550 U.S. 398 (2007).....69

*In re NuVasive, Inc.*  
842 F.3d 1376 .....70

**OTHER AUTHORITIES**

35 U.S.C. § 102 .....3, 4, 47, 48

35 U.S.C. § 316.....3

Patent Owner Voip-Pal.com, Inc. (“Voip-Pal”) respectfully submits this Response to the Petition for *Inter Partes* Review of U.S. 9,179,005 (the ‘005 Patent) (Paper 1) by Apple Inc. (“Apple”).

## I. INTRODUCTION

Digifonica, a real party-in-interest to this proceeding and wholly owned subsidiary of Patent Owner Voip-Pal, starting in 2004 employed top professionals including three Ph.D.’s with various engineering backgrounds, to develop innovative software solutions for communications, which, by the mid-2000s it had implemented in four nodes across three geographic regions. Digifonica’s R&D efforts led to several patents, including the ‘005 Patent.

Prior to the ‘005 Patent, private branch exchange (PBX) systems typically enabled users to call destinations internal to the PBX by dialing an extension (i.e., “private number”) and destinations external to the PBX on the public switched telephone network (PSTN) by dialing a “public number.” Such PBX systems relied on a *user-specified classification* of the dialed number to interpret the number and route the call. For example, a user placing a call to the public network dialed a predefined prefix such as “9” to indicate that subsequent digits were to be interpreted as a public PSTN number. If no prefix was dialed, the dialed digits were to be interpreted as a private PBX extension. The number alone, as dialed,

# 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.