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Filed on behalf of Patent Owner Voip-Pal.com Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**APPLE INC.**

Petitioner,

v.

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

Patent Owner

Case No. IPR2016-01198

U.S. Patent 9,179,005

**PATENT OWNER MOTION TO EXCLUDE**

Patent Owner Voip-Pal.com, Inc. (“Voip-Pal”) hereby moves to exclude the following exhibits and their use in the Petitioner’s Reply. 37 C.F.R. § 42.64(c).

**Exhibit 1009 – Declaration of Henry Houh**

Apple’s use of certain statements from Dr. Henry Houh’s declaration (Ex. 1009) is irrelevant and misleading, and should be excluded under FRE 401-403.

Apple’s obviousness arguments rely on Dr. Houh’s testimony in ¶¶38 and ¶43 of Ex. 1009 that “improvements” are needed in Chu ’684’s system, i.e., to allow users to “place calls as if they were dialing from a standard PSTN phone”. Paper 2 at 16 & 40-41. But Dr. Houh’s assertion in Ex. 1009 of deficiency in Chu ’684 is based on no evidence that Chu ’684’s system failed to allow users to “place calls as if they were dialing from a standard PSTN phone”. Indeed, this alleged deficiency in Chu ’684 is unsupported by any citation to Chu ’684 or explanation. Thus, Dr. Houh’s unsupported statements in ¶¶38 and ¶43 are improper testimony under FRE 701-703 that are not based on facts or data, and should also be excluded under FRE 401-403 as irrelevant and misleading.

Apple’s Petition relies on Dr. Houh’s declaration (Ex. 1009), which incorrectly assumes that the word “subscriber” in Chu ’684 (Ex. 1006) means “an individual phone user”. *See* Ex. 1009 at ¶¶ 37, 42 and 45. Dr. Houh later conceded in deposition testimony that, in Chu ’684, “subscriber” means “enterprise”, not “subscriber” as used in the Patent Owner’s patent. Ex. 2043 at 15:11-17:4; Ex.

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2044 at 221:20-222:4, 220:17-24, 178:17-184:5, 223:8-224:8, 215:20-217:9, 214:1-215:19; 217:10-220:9. Dr. Houh’s fundamental misunderstanding of “subscriber” and “subscriber-specific dial plan” in Ex. 1009 has led to Apple’s Petition mischaracterizing “dial plans” in Chu ‘684 as being *caller*-specific (rather than *enterprise*-specific). Thus ¶¶ 37, 42, and 45 in Ex. 1009 should also be excluded under FRE 401-403 as irrelevant and misleading.

### **Exhibits 1010-1013 & 1015 –Deposition Transcripts of Declarants**

Apple selectively uses deposition statements of Exs. 1010-1013 & 1015 in a misleading fashion, and should be excluded under FRE 401-403. Further, care should be taken when reviewing Apple’s characterizations of the deposition testimony, because these characterizations create a misleading impression by citing statements out of context that are incomplete and, in fairness under FRE 106, should be considered with the entirety of the deposition testimony.

### **Exhibit 1010 – Deposition Transcript of William Mangione-Smith**

Apple relies on Ex. 1010 at **45:8-21** to allege that Exhibit 2014 was created by Dr. Mangione-Smith “from an undisclosed [sic] source code repository” and is “not the original source code file from 2005” but rather is “snippets of code... cut-and-pasted” with a date “added as a header by Patent Owner’s counsel, not by Dr. Mangione-Smith or natively by the source code repository software.” Reply at 4-5. This citation is used in a misleading manner because: (1) the source of the

repository was not “undisclosed”; rather, the repository was proven to be *identical* to a repository extracted by forensics expert Mr. Purita from a portable hard drive of a Digifonica employee (Ex. 1010 at 75:18-77:3); (2) this repository provided Dr. Mangione-Smith with the metadata confirming that version 361 of the RBR software was dated June 6th, 2005, at 9:22:59 A.M. (*id.* at 162:19-163:24), as also confirmed in the RBR log file (*id.* at 162:19-163:18, 49:15-50:19; *compare* log file, Ex. 2015 at 52:2); and (3) the Subversion repository software Dr. Mangione-Smith used to extract this metadata was “widely used”, “extremely well tested”, maintained or monitored repository integrity, and “support[ed] the ability to accurately review earlier releases of the code.” Ex. 1010 at 74:2-24, 164:1-165:21.

Apple relies on Ex. 1010 at **47:25-49:14** to allege that Dr. Mangione-Smith “never confirmed the proffered code actually worked at all... [or] was actually operational”. Reply at 5. This citation is used in a misleading manner since Dr. Mangione-Smith testified that he: (1) reviewed the code both manually (Ex. 1010 at 48:20-49:9) and using a software analysis tool (*id.* at 178:2-13); (2) “confirmed that all variables are accurately and consistently referenced in this code to the extent needed for operation” (*id.* at 48:3-19, 177:1-178:13); (3) reviewed testing code stored in the repository from the relevant time (*id.* at 48:20-49:14, 58:4-22, 59:5-60:11); (4) reviewed call log or call setup records from the relevant time (*id.* at 63:1-10, 65:11-21); and (5) considered corroborating evidence, which gave him

“strong confidence” that the RBR code was operational. (*id.* at 62:6-16).

Apple cites **100:18-101:24** to characterize Dr. Mangione-Smith’s testimony as arguing that the “non-routable Digifonica ID” (or “username”) could satisfy the claimed “address, on the private network, associated with the callee”. Reply at 13-14. This citation is used in a misleading manner since Dr. Mangione-Smith stated that the “address, on the private network, associated with the callee” in the claimed “private network routing message” could be satisfied by: (1) a username (user ID) stored in a variable called “E.164 formed number” (Ex. 1010 at 98:23-99:14, 169:16-170:7, 172:14-173:6), **or** (2) a callee domain, i.e., an address of a supernode associated with the callee (*id.* at 106:24-107:25, 174:5-20, 102:9-18), **or** (3) a **combination** of these pieces of data (*id.* at 172:14-173:6, 174:5-20, 100:18-101:2). Apple’s citation of **100:18-101:24** is also misleadingly contrasted to testimony indicating that routing messages do not include the “IP address of the phone.” Reply at 14 (citing Ex. 1015 at 120:12-121:6). Dr. Mangione-Smith testified that the claims do not require a routable IP address to a specific component on a private network (Ex. 1010 at 101:15-24); the Digifonica telephone number (or username) itself is an “address on the private network associated with the callee” (*id.* at 174:5-20; *see also* 101:3-14). Dr. Mangione-Smith’s other testimony also belies Apple’s assertion that a username is “non-routable” since the username alone could have been used to place private network communication (*id.*

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