Trials@uspto.gov
571-272-7822

Paper No. 6
Entered: November 20, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

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

Case IPR2017-01398
Patent 9,179,005 B2

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

COCKS, *Administrative Patent Judge*.

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

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition for *inter partes* review of claims 8, 12, 13, 33, 37, 38, 41, 57, 61, 62, 81, 82, 86, 90, and 91 of U.S. Patent No. 9,179,005 B2 (Ex. 1001, "the '005 patent"). Paper 2 ("Pet."). Voip-Pal.com, Inc. ("Patent Owner") 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, we conclude that the information presented does not show reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 8, 12, 13, 33, 37, 38, 41, 57, 61, 62, 81, 82, 86, 90, and 91 of the '005 patent.

A. Related Matters

The parties identify the following district court proceedings in which the '005 patent has been asserted: *Voip-Pal.com, Inc. v. Apple, Inc.*, Case No. 2-16-cv-00260 (D. Nev.); *Voip-Pal.com, Inc. v. Verizon Wireless Services, LLC*, Case No. 2-16-cv-00271 (D. Nev.); and *Voip-Pal.com, Inc. v. Twitter, Inc.*, 2:-16-cv-00260 (D. Nev. Feb. 9, 2016). Paper 4, 1; *See* Pet. 45–46. Petitioner also has filed a petition for *inter partes* review of claims of the '005 patent in IPR2016-01198, as well as petitions in connection with related U.S. Patent No. 8,542,815 ("the '815 patent") in IPR2016-01201 and IPR2017-01399.[1] Patent Owner further identifies the following proceedings to which Petitioner is not a party:

---

[1] Trial was instituted in each of IPR2016-01198 and IPR2016-01201 on November 21, 2016. A decision regarding institution of trial in IPR2017-01399 is being mailed concurrently with this decision.

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

IPR2016-01382, challenging the ’815 patent;

IPR2016-01383, challenging the ’005 patent; and

IPR2016-01384, challenging the ’005 patent.

Paper 4, 1.

B. The ’005 Patent

The ’005 patent is directed to classifying a call as a public network call or a private network call and producing a routing message based on that classification. Ex. 1001, Abstract. Figure 7 of the ’005 patent is shown below.

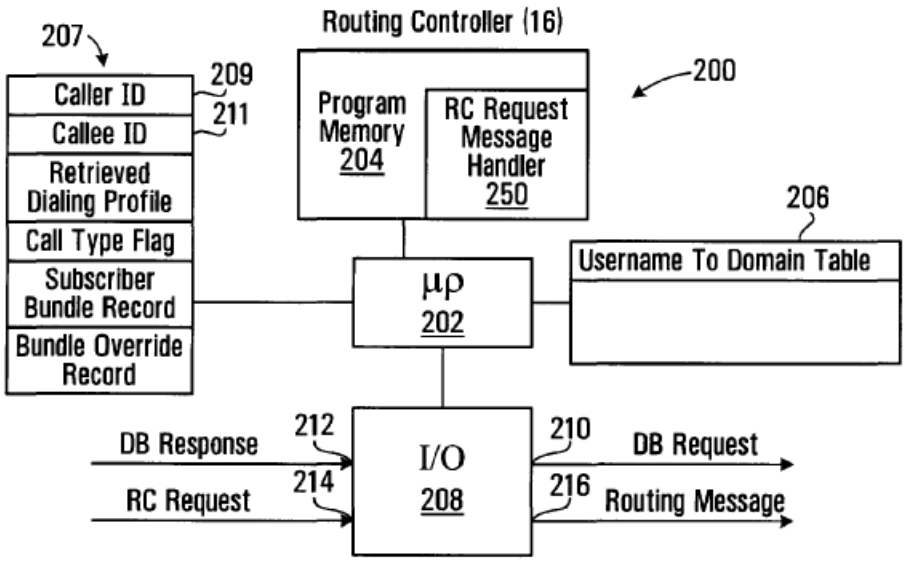

FIG. 7

Figure 7 above illustrates a routing controller that facilitates communication between callers and callees. *Id.* at Fig. 7, 14:32–33, 17:26–27. As shown in Figure 7, routing controller (RC) 16 includes RC processor circuit 200, which in turn includes processor 202, program memory 204, table memory 206, buffer memory 207, and I/O port 208. *Id.* at 17:28–31. Routing controller 16 queries database 18 (shown in Figure 1) to produce a routing

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

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 the routing controller. *Id.* at 17:47–49. Those blocks of code include RC request message handler 250, which directs the routing controller to produce the routing message. *Id.* at 17:49–53.

In response to a calling subscriber initiating a call, the routing controller of the '005 patent:

> 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 executed by the RC processor circuit. *Id.* at 11:3–4. Figure 8B, shown below, illustrates steps for performing checks on the callee identifier:

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

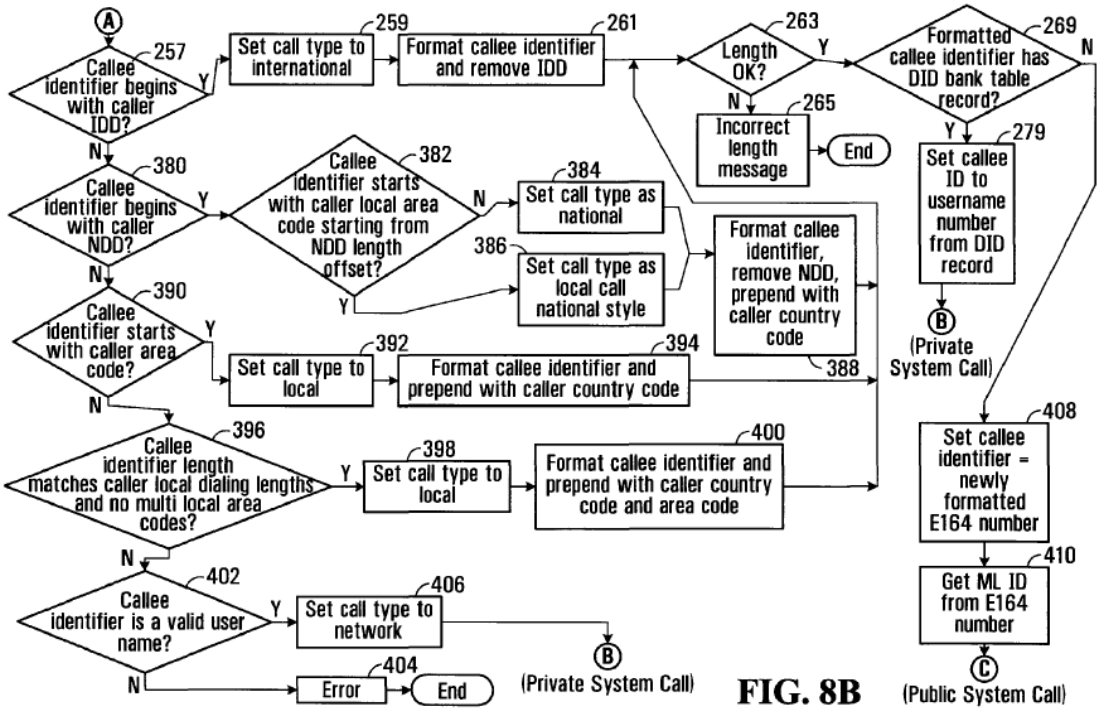

FIG. 8B

Id. at Fig. 8B, 19:53–57. Blocks 257, 380, 390, 396, 402 in Figure 8B above effectively "establish call classification criteria for classifying the call as a public network call or a private network call." *Id.* at 22:58–61. For example, block 402 "directs the processor 202 of FIG. 7 to classify the call as a private network call when the callee identifier complies with a predefined format, i.e. is a valid user name and identifies a subscriber to the private network . . . ." *Id.* at 22:61–23:3. Block 269 also classifies the call as public or private, depending on whether the callee is a subscriber to the system. *Id.* at 22:61–23:19, 20:23–33; *see also id.* at 18:63–19:30.

C. Illustrative Claims

Each of claims 8, 12, 13, 33, 37, 38, 41, 57, 61, 62, 81, 82, 86, 90, and 91 is a dependent claim. Claim 8 depends from claim 1. Claims 1 and 8 are illustrative and are reproduced below:

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

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.