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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

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Case No. IPR2016-01201

U.S. Patent 8,542,815

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**PATENT OWNER REPLY TO OPPOSITION TO MOTION TO EXCLUDE**

## **1. Portions Of The Houh Declaration Should Be Excluded**

Apple's Declarant cites no evidence in ¶¶ 38 & 43 of Ex. 1006, and misconstrues the meaning of "subscriber". Regarding unsupported ¶¶ 38 & 43, Apple briefly points to unrelated paragraphs in the declaration for support and then dedicates pages of attorney argument attempting to patch the holes in its Petition and the Houh Declaration. Regarding "subscriber" Apple unabashedly argues that Dr. Houh knew all along that Chu '684's use of the term was distinct from the use in the '815 Patent, despite the fact that the Houh Declaration never once hinted at this discrepancy. Apple's attempts to rehabilitate Dr. Houh's flawed Declaration belie its unreliability. Accordingly, the Houh Declaration should be excluded.

### **a) Ex. 1006 Lacks Support For Motivation To Modify Chu '684**

Apple fails to refute Voip-Pal's arguments that ¶¶ 38 & 43 of Dr. Houh's Declaration (Ex. 1006) are not based on facts or data as required under FRE 701-703 and irrelevant and misleading under FRE 401-403.

Apple asserts that additional paragraphs in the Houh Declaration, namely ¶¶ 22-44, "work together to inform Houh's opinion". Paper 44 at 7. However, ¶¶ 22-44 are not linked to the conclusory statements in ¶¶ 38 & 43. In his declaration, Dr. Houh states that his conclusions in ¶¶ 38 & 43 are based "[u]pon reading the disclosure of Chu '684...." However, Dr. Houh doesn't cite to any disclosure of Chu '684 for support. Instead of explaining how Dr. Houh relied upon Chu '684,

Apple's argument is that other portions of the Houh Declaration "inform Houh's opinion regarding modifications to Chu '684". Paper 44 at 7. This *ex post* argument is inconsistent with Dr. Houh's own stated explanation in ¶¶ 38 & 43.

Apple's argument on opposition attempts to supplement the Houh Declaration by presenting unsupported and inaccurate attorney arguments regarding why the skilled artisan might have been motivated to modify Chu '684. Apple mistakenly argues: "IP phones, conversely, are not tied to any specific physical location". *Id.* at 8. This is incorrect. IP phones such as those in Chu '684, *are* tied to specific physical locations because they are installed in fixed locations. Apple's attorney argument itself is based on no evidence, and is merely an attempt to explain unsupported testimony via unsupported attorney argument. Apple concludes that "some additional functionality must be provided to an IP-based telephony service to allow users to dial as if they were calling from a PSTN phone." *Id.* Again, this is attorney argument without support. In fact, IP/PBX systems are no different in this respect than traditional PBX systems and *are* capable of PSTN dialing based on the PSTN conventions of the installed location. Apple quotes Chu '366 that: "existing global VoIP service providers require users to enter fully formatted E.164 telephone numbers." *Id.* at 9. However, no evidence or argument is presented that Chu '684's system would have faced a similar requirement to reach PSTN destinations, and such requirement is contrary to what

was known in PBX systems. *See* Paper 17 at 48-50. Thus, without any evidence or reasoned explanation, Dr. Houh concocts a motivation to modify Chu '684 despite the fact that it does not suffer from any of the problems discussed in Chu '366.

Apple also states: “Similarly, there is no disagreement between the parties that Chu '684 does not teach reformatting dialed digits such that callers could dial as if they were calling from the PSTN.” Paper 44 at 10. Thus, Apple admits that Chu '684 fails to teach reformatting dialed digits, but Apple then inexplicably links reformatting to dialing “as if ... calling from the PSTN”. *Id.* Chu '684 describes how a system can direct dialed calls to either PSTN or IP destinations in a manner that did not contemplate reformatting of the dialed digits, yet still permitted callers to dial using local PSTN conventions. Further, Dr. Houh does not explain how the combination of Chu '384 and Chu '366 would be made, and does not base his rationale on any evidence. Not surprisingly, Dr. Houh’s conclusions in ¶¶ 38 & 43 are not accompanied by citations to evidence because there is no teaching in the cited references that support his conclusions.

To further muddy the waters, Apple states: “That IP-based telephony systems did not permit dialing as if on a standard PSTN phone is one of the most central concepts to the Challenged Patent and this proceeding.” Paper 44 at 10. The premise of this statement is false (because IP-based systems *did* permit dialing as if on a standard PSTN phone) as is the conclusion (because dialing as if on a standard

PSTN is *not* one of the central concepts of this case). *See, e.g.*, '815 Patent at Abstract & Claim 1. Apple attempts to fundamentally redirect the issues in the case by making unsupported arguments. Tellingly, these attorney arguments do not point to the '815 Patent, the Houh Declaration, or any other evidence for support. This is a last ditch effort to gloss over a factual deficiency in Apple's challenge.

For the above reasons, Apple has not refuted the fact that ¶¶ 38 & 43 of the Houh Declaration are not based on facts or data, are irrelevant and misleading, and should be excluded under FRE 401-403 & 701-703.

**b) Houh's Misunderstanding Of The Meaning Of "Subscriber" Renders His Opinion Irrelevant And Misleading**

It is undisputed that the '815 Patent and Chu '684 use the term "subscriber" in different ways. Paper 44 at 11. These distinctions resulted in the Houh Declaration incorrectly characterizing Chu '684. Thus, ¶¶ 37, 42, and 45 of Ex. 1006 should be excluded under FRE 401-403 as irrelevant and misleading. Apple attempts to rehabilitate Dr. Houh's incorrect characterization after the fact by asserting that Dr. Houh used "his own convention adopted for clarity in his declaration". Paper 44 at 11 & 12. This is not credible. The Houh Declaration itself never recognized or acknowledged this distinction. If Dr. Houh knew this different usage all along, he should have explained this in his declaration. This confusion of the meaning of the term "subscriber" led Dr. Houh to an incorrect assumption

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