

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. TBD  
U.S. Patent No. 8,542,815

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**PETITION FOR *INTER PARTES* REVIEW  
OF U.S. PATENT NO. 8,542,815**

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## I. INTRODUCTION

Petitioner Apple Inc. (“Petitioner”) requests an *Inter Partes* Review (“IPR”) of claims 3-4, 8-9, 11-12, 14-16, 30-31, 35-36, 38-39, 42-43, 61, 65-66, 81, 85-86, 100, and 104-105 (collectively, the “Challenged Claims”) of U.S. Patent No. 8,542,815 (“the ’815 Patent”) issued on September 24, 2013 to Clay Perreault, et al. (“Applicants”). **Exhibit 1001**, *’815 Patent*. As demonstrated by Petitioner below, the purportedly distinguishing feature of the ’815 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.

Petitioner notes that certain claims of the ’815 Patent not challenged in the present Petition are the subject of IPR2016-01201. In particular, in IPR2016-01201 Petitioner challenged claims 1, 7, 27, 28, 34, 54, 72-74, 92, 93, and 111 of the ’815 Patent, and the Board instituted the IPR on the challenged claims. IPR2016-01201, Paper 6 at 32 (P.T.A.B. Nov. 21, 2016). The present Petition challenges a different set of claims of the ’815 Patent than challenged in IPR2016-01201. Petitioner notes that because the present Challenged Claims depend from independent or dependent claims otherwise challenged in IPR2016-01201 (e.g., claim 1 or claim 7), Petitioner provides a mapping in Section IV for such independent or intervening dependent claims but does not otherwise challenge such claims in the present Petition.

## II. SUMMARY OF THE '815 PATENT

### A. Description of the Alleged Invention of the '815 Patent

The '815 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 1:54-56. 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 2:8-25. 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 2:45-47, 2:65-3:2. 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 1:59-62. 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 1:62-64.

More specifically, the '815 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 1:15-64. To identify a single destination the calling party is attempting to reach, the ’815 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.*

**B. Summary of the Prosecution History of the ’815 Patent**

The ’815 Patent issued from U.S. Patent Application No. 12/513,147 (“the ’147 Application”), which claims priority to International Application No. PCT/CA2007/001956, which was filed on November 1, 2007 and claims priority to Provisional Application No. 60/856,212 (“the ’212 Provisional”), filed on November 2, 2006. *See Ex. 1001.*

All claims presented in the ’147 Application were subject to a single Office Action, rejecting them as unpatentable pursuant to 35 U.S.C. § 103(a) over U.S. Patent No. 6,798,767 to Alexander et al. (“Alexander”). **Ex. 1002**, *Office Action dated March 1, 2013*, at 156. Applicants significantly amended the rejected claims

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