

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

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

Case IPR2017-01399
Patent 8,542,815 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

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition for *inter partes* review 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, 104, and 105 of U.S. Patent No. 8,542,815 B2 (Ex. 1001, “the ’815 patent”). Paper 1 (“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 3, 4, 8, 9, 11, 12, 14–16, 30, 31, 35, 36, 38, 39, 42, 43, 61, 65, 66, 81, 86, 100, 104, and 105 of the ’815 patent.

A. Related Matters

The parties identify the following district court proceedings in which the ’815 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.); *Voip-Pal.com, Inc. v. Twitter, Inc.*, 2:-16-cv-00260 (D. Nev. Feb. 9, 2016). Paper 4, 1; *See* Pet. 56–57. Petitioner also has filed a petition for *inter partes* review of claims of the ’815 patent in IPR2016-01201, as well as petitions in connection with related U.S. Patent No. 9,179,005 (“the ’005 patent”) in

IPR2016-0198 and IPR2017-01398.¹ Patent Owner further identifies the following proceedings to which Petitioner is not a party:

- IPR2016-01382, challenging the '815 patent;
- IPR2016-01383, challenging the '005 patent; and
- IPR2016-01384, challenging the '005 patent.

Paper 4, 1.

B. The '815 Patent

The '815 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 '815 patent is shown below.

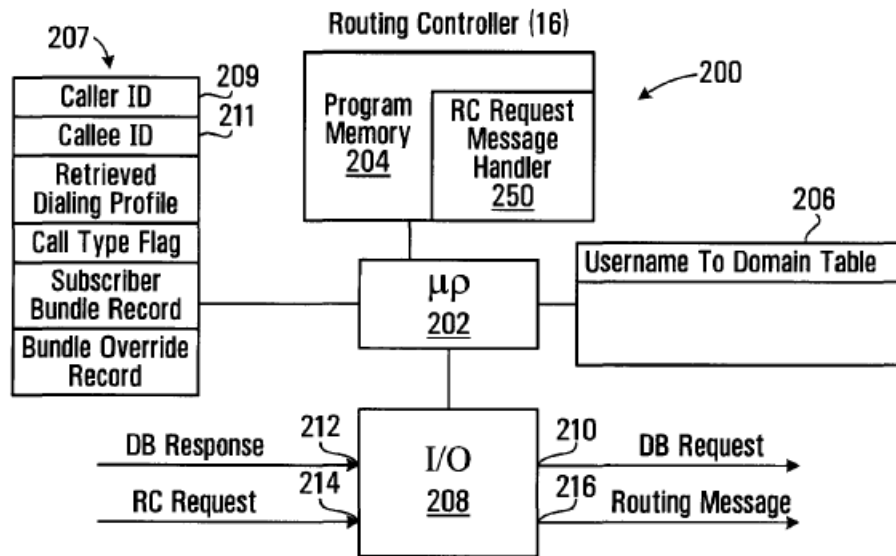


FIG. 7

¹ Trial was instituted in each of IPR2016-01198 and IPR2016-01201 on November 21, 2016. A decision regarding institution of trial in IPR2017-01398 is being mailed concurrently with this decision.

Figure 7 above illustrates a routing controller that facilitates communication between callers and callees. *Id.* at Fig. 7, 14:24–25, 17:16–17. As shown in Figure 7, above, 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 17:17–22.

Routing controller 16 queries database 18 (shown in Figure 1) to produce a routing message to connect caller and callee. *Id.* at 14:10–17, 14:24–34.

Program memory 204 includes blocks of code for directing processor 202 to carry out various functions of the routing controller. *Id.* at 17:38–40. Those blocks of code include RC request message handler 250, which directs the routing controller to produce the routing message. *Id.* at 17:40–44.

In response to a calling subscriber initiating a call, the routing controller of the '815 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 14:24–34.

Figures 8A through 8D of the '815 patent illustrate a flowchart of an RC request message handler executed by the RC processor circuit. *Id.* at 10:62–63. Figure 8B is reproduced below.

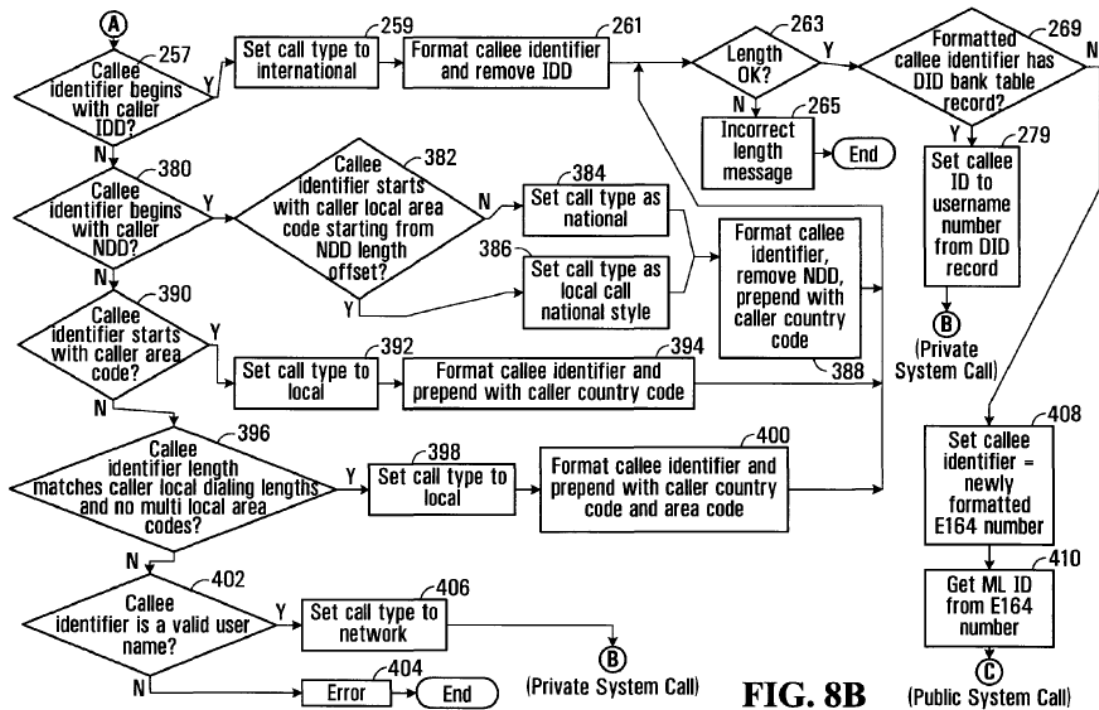


FIG. 8B (Private System Call) (Public System Call)

Figure 8B above illustrates steps for performing checks on the callee identifier. *Id.* at Fig. 8B, 19:45–49. 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 22:48–51. 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 22:51–60. Block 269 also classifies the call as public or private, depending on whether the callee is a subscriber to the system. *Id.* at 22:51–23:8, 20:14–24; *see also id.* at 18:55–19:22.

C. Illustrative Claims

Each 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, 104, and 105 is a dependent claim. Claim 3

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