

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

VOIP-PAL.COM, INC.,
Patent Owner

Patent No. 10,880,721

**PETITIONER'S NOTICE
REGARDING MULTIPLE PETITIONS**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	RANKING	1
III.	DIFFERENCES BETWEEN THE PETITIONS, WHY THEY ARE MATERIAL, AND WHY BOTH SHOULD BE INSTITUTED	2
IV.	CONCLUSION.....	5

I. INTRODUCTION

Petitioner is filing two petitions challenging different claims of U.S. Patent No. 10,880,721 (“the ’721 patent”). “To aid the Board in determining” why “more than one petition is necessary,” Petitioner provides the information below. *See* PTAB Consolidated Trial Practice Guide (“TPG”) (November 2019) at 59-60.

II. RANKING

While both petitions are meritorious and justified as explained below, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Challenged Claims	Grounds
1	Petition 1	1, 6, 14, 15, 16, 20, 25, 34, 38, 39, 43, 45, 46, 49, 50, 135, 136, and 140	<p><u>Ground 1</u>: Claims 1, 14, 15, 20, 38, 39, 46 and 136 Anticipated by Teodosiu;</p> <p><u>Ground 2</u>: Claims 16, 34, and 49 Obvious over Teodosiu;</p> <p><u>Ground 3</u>: Claims 6, 25, and 43 Obvious over Teodosiu and Kaal;</p> <p><u>Ground 4</u>: Claim 45 Obvious over Teodosiu and Guedalia;</p> <p><u>Ground 5</u>: Claims 50 and 140 Obvious over Teodosiu and Nix;</p> <p><u>Ground 6</u>: Claim 135 Obvious over Teodosiu and Jiang; and</p> <p><u>Ground 7</u>: Claims 34 and 49 Obvious over Teodosiu and Rosenberg.</p>
2	Petition 2	51, 57, 63, 77, 103, 104, 108, 109, 110, 124, 130, 133, 138,	<p><u>Ground 1</u>: Claims 51, 57, 77, 103, 104, 108, and 124 Obvious over Teodosiu;</p> <p><u>Ground 2</u>: Claims 63, 109, 110, 138, and 139 Obvious over Teodosiu and Nix; and</p> <p><u>Ground 3</u>: Claims 130 and 133 Obvious over</p>

		and 139	Teodosiu, Nix, and Kaal.
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III. DIFFERENCES BETWEEN THE PETITIONS, WHY THEY ARE MATERIAL, AND WHY BOTH SHOULD BE INSTITUTED

While Petitioner provides the above ranking per the PTAB’s guidance, Petitioner believes ranking in this instance is inappropriate and/or unnecessary. The Board should institute both petitions because each petition addresses different claims that recite different features. This, coupled with the number of claim elements/features that need to be addressed across the challenged claims, warrant the submission of two petitions.

Patent Owner asserts claims 1, 6, 15, 16, 20, 25, 34, 38, 39, 43, 45, 46, 49, 50, 51, 63, 77, 103, 104, 109, 110, 124, 130, 133, 135, 136, 138, 139, and 140 of the ’721 patent against Petitioner in the related litigation, *VoIP-Pal.com, Inc. v. Google, LLC f/k/a Google Inc.*, 6-21-cv-00667 (WDTX). (See, e.g., Petition 1, Section II.) Independent claims 1, 20, 38, and 50 relate to the features from the perspective of the wireless device requesting and receiving an access number from a server, while independent claims 51, 77, 103, and 130 relate to the features from the perspective of the server providing an access number to a wireless device. And while independent claims 1 and 51, for example, include similar limitations, e.g., transmitting/receiving an “access code request message,” the claims also recite limitations that do not overlap and require their own separate explanations, e.g., “in response to receiving the access code reply message, causing the wireless device to

use the access code ... to initiate communications from the wireless device to the destination node through the channel identified by the access code ...” (cl. 1.i) and “in response to receiving the access code request message, causing a routing controller to produce an access code” (cl. 51.c). (*Compare* EX1001, cls.1, 20, 38, and 50 *with id.*, cls. 51, 77, 103, and 130.) Thus, thirty-one claims are challenged across the two petitions.

Moreover, the dependent claims relate to various different features requiring explanations. For example, claim 133 recites features related to if the destination node is a PSTN telephone on the public switched telephone network (PSTN). (Petition 2, 77-80.) Claim 45 recite features related to the location identifier comprises a user-configured identifier of a location associated with the wireless apparatus. (Petition 1, 66-69.) Given the different features recited in the challenged claims, as well as the numerous claims and claim elements, challenging all claims of the '721 patent in a single petition is not feasible or administratively efficient.

For instance, Petitioner’s analysis for independent claims 1, 20, 38, and 50 in Petition 1 occupies about 28 pages (Petition 1, 17-27, 29-42, 76-80) and the analysis for the dependent claims 6, 14, 15, 16, 20, 25, 34, 39, 43, 45, 46, 49, 135, 136, and 140 occupies another 51 pages (*id.*, 27-29, 42-76, 81-88). Petitioner’s analysis for independent claims 51, 77, 103, and 130 in Petition 2 occupies about 37 pages (Petition 2, 13-29, 30-44, 70-76) and the analysis for the dependent claims 57, 63,

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