UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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T-MOBILE USA, INC.,
Petitioner,

v.

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

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Case Nos. IPR2023-00640 & IPR2023-00641
U.S. Patent No. 10,880,721

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PETITIONER'S NOTICE OF MULTIPLE PETITIONS

I.   INTRODUCTION

Petitioner is filing two petitions that challenge non-overlapping sets of claims in U.S. Patent No. 10,880,721 ("the '721 Patent"). The "patent owner has asserted a large number of claims in litigation," including claims that are distinct from one another, that collectively comprise several thousand words of claim language. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) at 59. More than one petition is therefore necessary to sufficiently address the challenged claims, and the Board should exercise its discretion to institute both petitions.[1]

II.   STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner requests that the Board consider the petitions in the following order, although, for the reasons explained below, the Board's analysis would not be complete without considering both petitions:

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[1]   To ease the Board's review, this Notice of Multiple Petitions is substantively the same as the Notice Regarding Multiple Petitions filed in *Meta Platforms, Inc. v. VoIP-Pal, Inc.*, IPR2022-01234 and IPR2022-01235 ("the Meta proceedings"), filed on June 30, 2022, for U.S. Patent No. 10,880,721.

Rank	Petition	Challenged Claims	Primary References
A	IPR2023-00641	51-52, 57, 60, 63, 65, 67, 73, 77, 103-104, 108-110, 124, 130, 133, and 138-139	Buckley (EX1005) Bates (EX1009) Ejzak (EX1007)
B	IPR2023-00640	1, 2, 6, 9, 14-16. 20, 25, 34, 38-39, 43, 45-46, 49-50, 135-136, and 140	Buckley (EX1005) Bates (EX1009)

III. DIFFERENCES BETWEEN THE PETITIONS AND WHY THEY SHOULD BOTH BE INSTITUTED

The two petitions challenge 39 claims, 29 of which were originally assert-ed by Patent Owner against Petitioner in the parallel District Court litigation, *VoIP-Pal.com, Inc. v. T-Mobile USA, Inc.*, Case No. 6-21-cv-00674 (W.D. Tex.). Those asserted claims collectively comprise well over 2,700 words, making it practically infeasible to substantively analyze all of them in a single petition, given the word limit. Indeed, the narrowed set of 16 claims currently asserted against Petitioner comprise more than 2,000 words alone. Moreover, Petitioner files a "me too" petition here, committing Petitioner to challenge the same claims on the same grounds as the Meta petitions.

There are also differences between the claims that warrant grouping them separately for analysis. In particular, independent claims 1, 20, 38, and 50 are

claimed from the perspective of the mobile device (telephone), while independent claims 51, 77, 103, and 130 are claimed from the perspective of the server. As a result, the claims in the two claim sets recite some different language and claim elements. For example, the server-side claims recite elements regarding the specifics to "***produce*** an access code" (cls. 51, 77, 103) that the telephone-side claims do not.[2]

Given the number of asserted claims, their length, and their different groupings, Petitioner reasonably divided its challenge into two petitions: (1) IPR2023-00641 challenging the server-side claims (ranked A above), and (2) IPR2023-00640 challenging the telephone-side claims (ranked B above). There is no overlap in the challenged claims across the two petitions. The Board has instituted multiple petitions in similar situations, and should do so here. *See, e.g.*, *Microsoft Corp. v. Synkloud Tech., LLC*, IPR2020-01269, Paper 9 at 7–9 (PTAB Apr. 7, 2021) (instituting two petitions for IPR where "the length of the claims, and the difference in scope of [the independent claims], warranted the filing of two petitions"); *Adobe*

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[2] During the prosecution of the '721 Patent's parent application, the applicant bucketed the telephone and server claims separately, recognizing the two claims sets are logically distinct. *Compare* IPR2022-01231, EX1002, 1840 ("Independent Claims 1, 12, 22, and 321 all recite a common feature…."), *with id.*, 1843 ("Regarding independent Claims 33, 52, 71 and 90, these claims all recite in various forms the following exemplary language….").

Inc. v. Synkloud Tech., LLC, IPR2020-01392, Paper 8 at 9–10 (PTAB Mar. 11, 2021) (similar).

IV.   CONCLUSION

For the reasons given above and in the concurrently-filed Petitions and Motions for Joinder, the Board should institute both Petitions.

Respectfully submitted,

Dated: February 28, 2023

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