IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

VOIP-PAL.COM, INC., Plaintiff v. AMAZON.COM, INC., AMAZON.COM SERVICES LLC, and AMAZON WEB SERVICES, INC., Defendants.	CASE NO. 6:20-cv-00272-ADA

AMAZON'S OPPOSITION TO VOIP-PAL'S MOTION TO LIFT STAY AND RESET *MARKMAN* HEARING DATE

The sole patent asserted in this lawsuit, U.S. Patent No. 10,218,606 ("the '606 patent"), is the seventh patent that VoIP-Pal has asserted from the same patent family. The Northern District of California held,[1] and the Federal Circuit summarily affirmed,[2] that all asserted claims of those other six patents are invalid for failure to recite patent-eligible subject matter.

Undeterred by those consistent adverse rulings, VoIP-Pal asserted the '606 patent in this district against Amazon, Google, and Meta[3] in hopes that a different venue might lead to a different result. This Court, however, transferred the Google and Meta cases to the Northern District of California, where Google and Meta filed motions for judgment on the pleadings. As detailed in those motions, like the other six patents in the same family, the '606 patent claims patent-ineligible subject matter. (*See* Exs. A (Google's motion for judgment on the pleadings) and B (Meta's motion for judgment on the pleadings).) In their motions, Google and Meta demonstrated the overwhelming similarity between the asserted claims of the '606 patent and the previously invalidated claims of the related patents. (*See, e.g.*, Ex. A at 18-19 (comparing claim 1 of the '606 patent and claim 1 of U.S. Patent No. 9,826,002); *see also id.* at 4-5 (discussing the comparison).)

Earlier today, Judge Donato held a status conference in the transferred Google and Meta cases, as well as in the related cases. At that conference, Judge Donato held that VoIP-Pal had two weeks to file an answer to a related declaratory judgment complaint and that the parties seeking to invalidate the '606 patent under 35 U.S.C. section 101 would then have up to four weeks to file a consolidated motion for judgment on the pleadings. (Shvodian Decl. ¶ 5.) Google and Meta

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[1] *VoIP-Pal.com, Inc. v. Apple Inc.*, 375 F. Supp. 3d 1110 (N.D. Cal. 2019); *VoIP-Pal.com, Inc. v. Apple Inc.*, 411 F. Supp. 3d 926 (N.D. Cal. 2019).

[2] *VoIP-Pal.com, Inc. v. Twitter, Inc.*, 798 Fed. Appx. 644 (Fed. Cir. 2020); *VoIP-Pal.com, Inc. v. Apple, Inc.*, 828 Fed. Appx. 717 (Fed. Cir. 2020).

[3] VoIP-Pal sued both Meta Platforms, Inc. and WhatsApp LLC, collectively referred to herein as "Meta."

have stated that they intend to file such a motion. (Shvodian Dec. ¶ 6.) After the parties complete the briefing, Judge Donato will rule on that motion. (Shvodian Decl. ¶ 5.) The cases in the Northern District of California will otherwise be stayed. (*Id*.)

That consolidated motion for judgment on the pleadings will address every claim asserted here against Amazon because VoIP-Pal asserted the same claims against Google. (Shvodian Decl. at ¶ 4.) If the Northern District of California court grants the motion for judgment on the pleadings—as seems likely given the past results with numerous nearly identical patents from the same family—VoIP-Pal will be collaterally estopped from asserting those claims against Amazon, pending any potential reversal of the decision by the Federal Circuit. *See, e.g.*, *DietGoal Innovations LLC v. Chipolte Mexican Grill, Inc.*, 70 F. Supp. 3d 808, 816 (E.D. Tex. 2014) (Bryson, J., sitting by designation) (holding that invalidity decision by another district court collaterally estopped from the plaintiff from further litigating the same claims). Any judicial time and resources, as well as the time and resources of the parties, expended on this case in the meantime will have been wasted.

Amazon requests that this Court maintain the stay in this matter until after Judge Donato rules on the consolidated motion for judgment on the pleadings. In deciding whether to lift the stay, this Court need not rule on whether the claims of the '606 patent are invalid. This Court need only recognize the similarity between the claims of the '606 patent and the claims in the related VoIP-Pal patents that were previously invalidated, as well as the benefit of awaiting the ruling of the Northern District of California before further resources are expended on this case.

In arguing that the Court should lift the stay now, VoIP-Pal asserts that "it is uncertain if and when Meta and Google will refile their motions for judgment on the pleadings." (Mot. at 2-3.) That is precisely why, when VoIP-Pal contacted Amazon on January 13 about lifting the stay

in this case, Amazon suggested that the parties wait until after the Northern District of California's status conference when the parties would know more about the schedule for resolving those motions. VoIP-Pal, however, refused to wait despite having already waited almost three months since the Court ruled on Amazon's transfer motion before even raising the issue of lifting the stay. We now know the schedule for the motion in the Northern District of California, and VoIP-Pal has not and cannot show that it will be harmed by a stay awaiting resolution of that motion. To the contrary, if the '606 patent is invalidated, VoIP-Pal will have saved litigation expense. And if the '606 patent is not invalidated, this case can then go forward with VoIP-Pal having suffered no loss. Moreover, the parties are currently fully engaged in the second litigation that VoIP-Pal filed against Amazon in this Court (Case No. 6:21-cv-668-ADA), with that case scheduled for trial starting on July 17, 2023. There is no reason to require the parties to simultaneously litigate this case while the Northern District of California decides a motion that is likely to resolve this matter.

Amazon respectfully requests that this Court maintain the stay in this case until the Northern District of California rules on the motion for judgment on the pleadings that would be dispositive here.

Dated: January 26, 2023

Respectfully submitted,

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