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Paper 11
Entered: January 3, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VOIP-PAL.COM INC.,
Patent Owner.

Case IPR2016-01198
Patent 9,179,005 B2

Before BARBARA A. BENOIT, LYNNE E. PETTIGREW, and STACY B. MARGOLIES, *Administrative Patent Judges*.

MARGOLIES, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Voip-Pal.com, Inc. ("Patent Owner") filed a Request for Rehearing (Paper 9, "Rehearing Request" or "Reh'g Req.") of the Decision granting institution of *inter partes* review dated November 21, 2016 (Paper 6, "Institution Decision" or "Inst. Dec."). Patent Owner requests reconsideration of the decision to institute *inter partes* review of claims 1, 24–26, 49, 50, 73–79, 83, 84, 88, 89, 92, 94–96, 98, and 99 of U.S. Patent No. 9,179,005 B2 (Ex. 1001, "the '005 patent"). For the reasons discussed below, Patent Owner's request is denied.

II. STANDARD OF REVIEW

The party challenging a decision in a request for rehearing bears the burden of showing the decision should be modified. 37 C.F.R. § 42.71(d). A request for rehearing "must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed." *Id.* Upon a request for rehearing, the decision on a petition will be reviewed for an abuse of discretion. 37 C.F.R. § 42.71(c).

III. DISCUSSION

Patent Owner maintains that, in the Institution Decision, the Board overlooked Patent Owner's argument that a proper construction of the claims requires a particular ordering of steps, whereas Petitioner's obviousness argument is based on the performance of these steps in a different order. Reh'g Req. 2. Patent Owner also argues that the Board overlooked Patent Owner's arguments that Petitioner failed to provide a

valid motivation for why a skilled person would have combined with Chu '684[1] with either Chu '366[2] or Chen.[3] *Id.* at 3. We address each argument below.

A. Ordering of steps argument

Patent Owner argues that the Board overlooked Patent Owner's argument—set forth in pages 17 through 19 of Patent Owner's Preliminary Response—that a proper construction of the challenged claims requires a particular ordering of steps, and that Petitioner's obviousness analysis fails "when a claim construction of the ordering of steps is carried out and the obviousness case considered in view of the construed claims." *Id.* at 3, 7. Specifically, Patent Owner argues that the Board overlooked the argument that Petitioner's obviousness analysis fails to account for performing the "locating" step before the "producing" steps. *Id.* at 6–7. Patent Owner maintains that the Board "overlooked the significance of the Patent Owner's claim construction explaining the required ordering of steps and the Patent Owner's arguments showing that the Petitioner's obviousness arguments fail due to Chu '684's distinct ordering of steps." *Id.* at 5. Patent Owner also maintains that the Board "misapprehended the distinction between the claims and the cited references with respect to the order of steps." *Id.*

We disagree. We did not overlook or misapprehend Patent Owner's argument regarding the ordering of steps. First, we explicitly cited Patent

[1] U.S. Patent No. 7,486,684 B2, filed Sept. 30, 2003 (Ex. 1006, "Chu '684").
[2] U.S. Patent No. 8,036,366 B2, filed Aug. 4, 2006 (Ex. 1007, "Chu '366").
[3] U.S. Patent Application Publication No. 2007/0064919 A1, filed Sept. 14, 2005 (Ex. 1008, "Chen").

Owner's argument and repeated Patent Owner's explanation of the argument in the context of Figure 6 of Chu '684, as follows:

> Figure 6 of Chu '684, above, depicts a sequence for handling an on-net call. Ex. 1006, 8:39–40. *According to Patent Owner*, Petitioner relies on step 608, in which server 110 consults a dial plan to classify the call, for the "classification criteria" requirement, and *improperly relies on subsequent step 610*, in which soft-switch 220 uses a callee identifier to locate a dial plan, *for the "using a caller identifier . . . to locate" step*. Prelim. Resp. 17–19.

Inst. Dec. 18 (emphasis added). As shown above, we expressly referenced Patent Owner's argument that Petitioner's analysis improperly relies on performing the locating step after performing the producing steps. *Id.* Second, in our Institution Decision, we explained that Petitioner sufficiently met its burden at the preliminary stage to show that the combined teachings of the references rendered the subject matter of the claims obvious, and that Patent Owner's attempt to distinguish the single reference Chu '684 did not address Petitioner's showing that the combination teaches the claimed steps. *Id.* at 19–20 (citing *In re Mouttet*, 686 F.3d 1322, 1333 (Fed. Cir. 2012) and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) ("[T]he test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art.")); *see also id.* at 16 (addressing Petitioner's reliance on both Chu '684 and Chu '366 for teaching the locating step, including Petitioner's reliance on Chu '366 for teaching call origin profiles that include calling attributes such as geographic location, country code, and area code); Pet. 17–18 (relying on both Chu '684 and Chu '366 for teaching the locating step of claim 1), 42–43 (relying on both Chu '684 and Chen for teaching the locating step of claim 1). Patent Owner again raises the same argument it raised in its Preliminary Response—that

Petitioner's obviousness analysis fails because *Chu '684's* ordering of steps is distinct—without explaining how we overlooked a previously-made argument that squarely addresses Petitioner's proposed combinations. *See, e.g.*, Reh'g Req. 4 (arguing that Petitioner "premised its obviousness theory on Chu '684's ordering of steps, which are distinct from those in claim 1"), 5 (arguing that "Chu '684 teaches a method distinct from that of claim 1 because Chu '684 performs its method in an order different from that required by claim 1"), 5 (arguing that the Institution Decision overlooked "Patent Owner's arguments showing that the Petition's obviousness arguments fail due to Chu '684's distinct ordering of steps").

For the above reasons, we are not persuaded that we overlooked or misapprehended the ordering of steps argument in our Institution Decision.

B. Motivation to combine argument

Patent Owner also argues that the Board overlooked Patent Owner's argument that the purported motivation to combine—that allowing users to place calls as if they were dialing from a standard PSTN phone would be desirable—is unsupported by substantial evidence. Reh'g Req. 8–12. Specifically, Patent Owner argues that the Institution Decision relies on testimony from Petitioner's declarant, Dr. Houh, and that that declaration testimony "do[es] not rely upon any evidence for support." *Id.* at 10. Patent Owner also argues that the Board overlooked Patent Owner's argument that Dr. Houh's testimony should be entitled to little or no weight. *Id.* at 11–12.

We do not agree that we overlooked Patent Owner's argument regarding the motivation to combine. In the Institution Decision, we expressly referenced Patent Owner's argument that Petitioner's purported reason for combining the references is conclusory and insufficient. Inst.

Dec. 22 (citing Prelim. Resp. 37–42). We also determined that for purposes of institution, Petitioner's showing is sufficient. *Id.* As explained in the Institution Decision, Petitioner sufficiently cites either the references themselves or Mr. Houh's testimony to show that each of the references teaches telecommunications systems in which VoIP subscribers can place calls to a callee on the PSTN, that one of ordinary skill in the art would have recognized upon reading Chu '684 that allowing users to place calls as if they were dialing from a standard PSTN phone would have been desirable, creating a system capable of supporting a more intuitive and user-friendly interface, and that the infrastructure of the Chu '684 system would support dialed digit reformatting based on attributes of the caller as taught by Chu '366 or Chen. *Id.* at 22–23, 29. Patent Owner fails to persuasively show that we overlooked or misapprehended Patent Owner's arguments regarding Petitioner's proffered motivation to combine—which is based on the evidence of Mr. Houh's testimony—particularly given that Mr. Houh (i) testifies to his educational background and experience in the field, including his "extensive familiarity with systems, networks, architectures, and methods related to traditional circuit-switched telecommunications, packet-based telecommunications, and systems that merged the two technologies," Ex. 1009 ¶¶ 5–17, Appendix A, and (ii) based on his familiarity with the art, provides an overview of the state of the art in 2006, *id.* ¶¶ 17, 26–34.

Patent Owner thus fails to establish that we should revisit our determination that for institution purposes Petitioner has articulated sufficient reasoning with rational underpinning for combining the teachings of the references.

IV. CONCLUSION

Because Patent Owner fails to show that we misapprehended or overlooked a matter, or abused our discretion, we conclude that Patent Owner is not entitled to the relief it seeks.

V. ORDER

Accordingly, it is:

ORDERED that Patent Owner's request for rehearing is *denied*.

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