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Paper 11
Date: December 22, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC., AMAZON.COM SERVICES, LLC, AMAZON WEB SERVICES, INC., AND T-MOBILE USA, INC.,
Petitioners,

v.

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

IPR2022-01179
Patent 8,630,234 B2

Before MITCHELL G. WEATHERLY, TERRENCE W. McMILLIN, and CHRISTOPHER L. OGDEN, *Administrative Patent Judges.*

WEATHERLY, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314
Denying Motion for Joinder
35 U.S.C. § 315

I. INTRODUCTION

Amazon.com, Inc., Amazon.com Services, LLC, Amazon Web Services, Inc., and T-Mobile USA, Inc. ("Petitioners") filed a petition (Paper 3, "Pet.") to institute an *inter partes* review of claims 30–33, 35,

37–40, 43, 45–48, 51, 53, 54, 61, 62, 64, 65, 70, 72, and 75 (the "challenged claims") of U.S. Patent No. 8,630,234 B2 (Ex. 1001, "the '234 patent"). 35 U.S.C. § 311. VoIP.Pal.com, Inc. ("Patent Owner") timely filed a Preliminary Response. Paper 10 ("Prelim. Resp."). In the Petition, Petitioners indicated that the reasons for finding the challenged claims unpatentable were identical to the reasons set forth in the Petition in IPR2022-01073 ("the 1073 proceeding"). Pet. 1. The Petition in the 1073 proceeding sought cancellation of the same claims challenged in this proceeding on the same grounds asserted in this proceeding. *Compare* IPR2022-01073 Paper 1 (Petition), 4–5, *with* Pet. 5–6. In addition, the Patent Owner's Preliminary Response in the 1073 proceeding was substantially the same as its Preliminary Response in this proceeding. *Compare* IPR2022-01073 Paper 6, *with* Prelim. Resp. We denied institution on the merits in the 1073 proceeding. *See* IPR2022-01073 Paper 10, 23.

Concurrently with the Petition, Petitioners filed a Motion for Joinder. Paper 5 ("Mot." or "Mot. for Joinder"). In the Motion for Joinder, Petitioners request that they be joined as a party in the 1073 proceeding. Mot. 1, 13. Patent Owner filed an Opposition to the Petitioners' Motion for Joinder. Paper 8. And, Petitioner filed a Reply in Support of the Motion for Joinder. Paper 9.

For the reasons discussed below, we deny institution and deny the Motion for Joinder.

II. ANALYSIS

The denial of institution on the merits in the 1073 proceeding dictates that institution also be denied in this proceeding. Because we did not

institute review in the proceeding that Petitioner seeks to join as a party, we also deny the Motion for Joinder.

A. Institution of Inter Partes Review

Petitioners repeatedly indicate that the Petition is substantively identical to the Petition in the 1073 proceeding. In the "Introduction," the Petition states, "[f]or the reasons below, ***which are identical to the petition in IPR2022-01073***, the challenged claims should be found unpatentable and canceled." Pet. 1 (emphasis added). The Petitioners' Motion for Joinder states:

> The Petition is materially the same as the petition filed in the 1073 proceeding ("Google's Petition"). The Petition and the Google Petition challenge the same claims, on the same grounds, and rely on the same prior art and evidence, including an identical declaration from the same expert.[1]
>
> Petitioners agree to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the 1073 proceeding as instituted.

Mot. 1–2.

> Here, joinder with the 1073 proceeding is appropriate because the present Petition introduces identical arguments and the same grounds raised in the existing 1073 proceeding (i.e., they contain the same grounds, based on the same prior art combinations and supporting evidence, against the same claims). Indeed, there are no changes to the facts, evidence, or arguments used by Google's Petition in the 1073 proceeding in demonstrating satisfaction of the implicated claims by the applied prior art.
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> * * *

[1] In a footnote to the Motion for Joinder, Petitioners state, "[t]he declaration is a duplicate of the declaration filed in IPR2022-01073." Mot. 1, n.1.

> Petitioners have copied the substance of Google's Petition and have relied on the same accompanying declaration. . . . Petitioners are using the same expert and have submitted an identical declaration as in the 1073 proceeding. . . . The present Petition introduces no new substantive issues relative to the 1073 proceeding and does not seek to broaden the scope of the 1073 proceeding.
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> * * *
>
> [T]he present Petition presents no new issues or grounds of unpatentability.

Id. at 6–7.

* * *

> Through this motion to join and corresponding Petition, Petitioners have not modified the positions advanced in the 1073 proceeding.

Id. at 10.

Thus, Petitioners have repeatedly indicated that the Petition in this proceeding includes identical grounds and arguments and relies on the same prior art and declaration and other evidence as in the 1073 proceeding. And, the Patent Owner's Preliminary Response in the 1073 proceeding is substantively identical to the Preliminary Response in this proceeding on the merits of the challenge to the claims. *Compare* IPR2022-01073 Paper 6, 28–44, *with* Prelim. Resp. 25–43.

After consideration of the arguments and evidence in the Petition and the Preliminary Response in the 1073 proceeding, we denied institution, because "Petitioner [in the 1073 proceeding] had not shown that the cited art disclose[d] all the limitations of any challenged claim" and that, therefore, "there [wa]s not a reasonable likelihood that the Petitioner would prevail with respect at least one of the claims challenged in the Petition." IPR2022-

01073 Paper 10, 23. Because the arguments and the evidence in this proceeding are substantively identical to the arguments and evidence in the 1073 proceeding, we deny institution in this proceeding for the reasons set forth in the Decision Denying Institution in the 1073 proceeding. IPR2022-01073 Paper 10.

B. Motion for Joinder

The Director may grant a motion for joinder and allow the movant to "join as a party" an existing proceeding only "[i]f the Director institutes an inter partes review" in the proceeding to which joinder as a party is sought. 35 U.S.C. § 315(c). Petitioner implicitly recognized this prerequisite to granting its Motion for Joinder when it requested that the Petition be granted: "only if, an IPR is instituted in the 1073 proceeding." Mot. 1. Because we did not institute review in the 1073 proceeding, we deny the Motion for Joinder.

III. CONCLUSION

For the reasons stated above, we do not institute *inter partes* review any claim of the '234 patent, and we deny the Motion for Joinder.

IV. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review of the challenged claims of U.S. Patent No. 8,630,234 B2 is *not instituted* with respect to any ground of unpatentability set forth in the Petition; and

FURTHER ORDERED that Petitioner's Motion for Joinder is *denied*.

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