

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.

IPR2022-01180
Patent 10,880,721 B2

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

McMILLIN, *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. (collectively, “Petitioners”) filed a Petition to institute an *inter partes* review of claims 1, 6, 14–16, 20, 25, 34, 38, 39, 43, 45, 46, 49, 50, 135, 136, and 140 (“the challenged claims”) of U.S. Patent No. 10,880,721 B2 (Ex. 1001, “the ’721 patent”) pursuant to 35 U.S.C. § 311 *et seq.* Paper 1 (“Petition” or “Pet.”). VoIP-Pal.com, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Preliminary Response” or “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 IPR2022-01074 (“the 1074 proceeding”). Pet. 1. The Petition in the 1074 proceeding sought cancellation of the same claims challenged in this proceeding on the same grounds asserted in this proceeding. *Compare* IPR2022-01074 Paper 1 (Petition), 4–5, *with* Pet. 5–6. In addition, the Patent Owner’s Preliminary Response in the 1074 proceeding was substantially the same as its Preliminary Response in this proceeding. *Compare* IPR2022-01074 Paper 6 (Preliminary Response), *with* Prelim. Resp. The Board denied institution on the merits in the 1074 proceeding. *See* IPR2022-01074 Paper 10, 25.

Concurrently with the Petition, Petitioners filed a Motion for Joinder. Paper 5 (“Mot. for Joinder”). In the Motion for Joinder, Petitioners request that they be joined as a party in the 1074 proceeding. Mot. for Joinder 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 1074 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 Parties Review

Petitioners repeatedly indicate that the Petition is substantively identical to the Petition in the 1074 proceeding. In the “Introduction,” the Petition states, “[f]or the reasons below, ***which are identical to the petition in IPR2022-01074***, 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 1074 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 1074 proceeding as instituted.

* * *

Here, joinder with the 1074 proceeding is appropriate because the present Petition introduces identical arguments and the same grounds raised in the existing 1074 proceeding (i.e., they contain the same grounds, based on the same prior art

¹ In a footnote to the Motion for Joinder, Petitioners state, “[t]he declaration is a duplicate of the declaration filed in IPR2022-01074.” Mot. for Joinder 1 n.1.

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 1074 proceeding in demonstrating satisfaction of the implicated claims by the applied prior art.

* * *

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 1074 proceeding. . . . The present Petition introduces no new substantive issues relative to the 1074 proceeding and does not seek to broaden the scope of the 1074 proceeding. . . .
[T]he present Petition presents no new issues or grounds of unpatentability.

* * *

Through this motion to join and corresponding Petition, Petitioners have not modified the positions advanced in the 1074 proceeding.

Mot. for Joinder 1–2, 6–7, 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 1074 proceeding. And, the Patent Owner's Preliminary Response in the 1074 proceeding is substantively identical to the Preliminary Response in this proceeding on the merits of the challenge to the claims. *Compare* IPR2022-01074 Paper 6, 30–48, *with* Prelim. Resp. 33–46,

After consideration of the arguments and evidence in the Petition and the Preliminary Response in the 1074 proceeding, we denied institution, because “Petitioner [in the 1074 proceeding] ha[d] 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.”

IPR2022-01074 Paper 10, 25. Because the arguments and the evidence in this proceeding are substantively identical to the arguments and evidence in the 1074 proceeding, we deny institution in this proceeding for the reasons set forth in the Decision Denying Institution (IPR2022-01074 Paper 10) in the 1074 proceeding.

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 stated: “Petitioners request that . . . the motion be granted only if, an IPR is instituted in the 1074 proceeding.” Mot. for Joinder 1. Because we did not institute review in the 1074 proceeding, we deny the Motion for Joinder.

III. CONCLUSION

For the reasons stated above, we do not institute *inter partes* review on any claims or any challenge to the claims of the ’721 patent and we deny the Motion for Joinder.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and we do not institute *inter partes* review of any challenged claim of U.S. Patent No. 10,880,721 B2; and

FURTHER ORDERED that the Petitioners’ Motion for Joinder is *denied*.

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Patent 10,880,721 B2

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