

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

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

IPR2022-01393
Patent 10,880,721 B2

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

McMILLIN, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review

35 U.S.C. § 314

Granting Motion for Joinder

35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. Introduction

A. Background

Samsung Electronics Co., Ltd. (“Petitioner”) filed a Petition to institute an *inter partes* review (Paper 1, “Pet.”) of claims 51, 52, 57, 60, 63, 65, 67, 73, 77, 103, 104, 108, 109, 110, 124, 130, 133, 138, and 139 of U.S. Patent No. 10,880,721 B2 (Ex. 1001, “the ’721 patent”). 35 U.S.C. § 311.

VoIP-Pal.com, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With our prior authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 9) and Patent Owner filed a Sur-reply in Support of its Preliminary Response (Paper 10).

Concurrently with the Petition, Petitioner filed a Motion for Joinder in which it sought to join IPR2022-01235 (the “Meta IPR”) as a party if we were to institute review in the Meta IPR. Paper 3, 1 (“Mot.” or “Motion”). Patent Owner also opposed the Motion. Paper 5 (“Opp.” or “Opposition”). Petitioner filed a reply in support of the Motion. Paper 7.

Petitioner challenges the patentability of claims on the same basis advanced in the Meta IPR as follows:

Claims Challenged	35 U.S.C. §¹	Reference(s)/Basis
51, 52, 57, 60, 63, 65, 67, 73, 77, 103, 104, 108, 109, 110, 124, 130, 133, 138, 139	103	Buckley ²
63, 130, 133, 138, 139	103	Buckley, Ejzak ³
51, 52, 57, 60, 63, 65, 67, 73, 77, 103, 104, 108, 109, 110, 124, 130, 133, 138, 139	103	Buckley, Bates ⁴
63, 130, 133, 138, 139	103	Buckley, Bates, Ejzak

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102 and 103 that became effective on March 16, 2013. Because the ’721 patent claims the benefit of the filing date of U.S. Patent Application No. 13/056,277, which was filed before March 16, 2013, and neither party has argued that the provisions of the AIA apply, we apply the pre-AIA versions of §§ 102, 103. *See* Ex. 1001, code (63).

² U.S. Patent No. 7,668,159 B2 (Ex. 1005, “Buckley”).

³ U.S. Patent No. 6,954,654 B2 (Ex. 1007, “Ejzak”).

⁴ U.S. Patent No. 8,731,163 B1 (Ex. 1009, “Bates”).

Petitioner files the Declaration of Dr. Vijay Madisetti from the Meta IPR in support of the Petition. Ex. 1003.

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons expressed below, we (1) institute *inter partes* review on the same grounds instituted in the Meta IPR, and (2) grant the Motion, subject to the conditions set forth below.

B. Related Proceedings

Both parties identify the following active district court proceedings involving the ’721 patent and related U.S. Patent No. 8,630,234 B2 (“the ’234 patent”) as being related to this proceeding: *VoIP-Pal.com, Inc. v. Meta Platforms, Inc. et al.*, 3-22-03202 (N.D. Cal.) (the “Litigation”); *VoIP-Pal v. Google*, No. 3:22-cv-03199 (N.D. Cal.); *VoIP-Pal v. Amazon*, No. 6-21-cv-00668 (W.D. Tex.); *VoIP-Pal v. Verizon*, No. 6-21-cv-00672 (W.D. Tex.); *VoIP-Pal v. T-Mobile*, No. 6-21-cv-00674 (W.D. Tex.); *VoIP-Pal v. Samsung*, No. 6-21-cv-01246 (W.D. Tex.); *VoIP-Pal v. Huawei*, No. 6-21-cv-01247 (W.D. Tex.); *Verizon v. VoIP-Pal*, No. 3-21-cv-05275 (N.D. Cal.); and *Twitter v. VoIP-Pal*, No. 3-21-cv-09773 (N.D. Cal.). Pet. 2; Paper 4, 2–3.

Petitioner further identifies a number of completed district court proceedings involving the ’721 patent that it contends to be related, including: *VoIP-Pal v. Apple*, No. 6-21-cv-00670 (W.D. Tex.); *Apple v. VoIP-Pal*, No. 3:21-cv-05110 (N.D. Cal.); *VoIP-Pal v. AT&T*, No. 6-21-cv-

00671 (W.D. Tex.); and *AT&T v. VoIP-Pal*, No. 3-21-cv-05078 (N.D. Cal.).
Pet. 2–3.

Petitioner further states it is concurrently filing another petition seeking *inter partes* review of other claims of the '721 patent⁵ and petitions seeking *inter partes* review of claims of the '234 patent.⁶ Pet. 3.

II. INSTITUTION OF INTER PARTES REVIEW

Petitioner contends that the Petition is “substantively identical to the corresponding petition filed in the Meta [IPR].” Pet. 8. Patent Owner does not address whether Petitioner’s contention is accurate. *See generally* Prelim. Resp. Based on our comparison of the Petition in this proceeding to the petition filed in the Meta IPR, we agree with Petitioner. *Compare* Pet. 21–76, *with* IPR2022-01235, Paper 3, 20–76. Additionally, based on our comparison of Patent Owner’s preliminary responses filed in this proceeding and the Meta IPR, we discern no material difference between the arguments raised in those respective preliminary responses. *Compare* Prelim. Resp. 21–60 (addressing merits of Petitioner’s unpatentability challenges), *with* IPR2022-01235, Paper 7, 21–60 (addressing merits of unpatentability challenges in Meta IPR). Accordingly, for the reasons expressed in our Decision Instituting Review in IPR2022-01235 (Paper 10), we find that the Petition in this proceeding also warrants institution of *inter partes* review.

⁵ Claims of the '721 patent are challenged in three other currently co-pending IPRs, including: IPR2022-01234, IPR2022-01235, and IPR2022-01392.

⁶ Claims of the '234 patent are challenged in four pending IPRs, including: IPR2022-01231, IPR2022-01232, IPR2022-01390, and IPR2022-01391.

III. MOTION FOR JOINDER

Petitioner requests joinder pursuant to 35 U.S.C. § 315(c), which provides as follows:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

Section 315(c) “authorizes joinder of a person as a party, not ‘joinder’ of two proceedings” and “does not authorize the joined party to bring new issues from its new proceeding into the existing proceeding.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1335 (Fed. Cir. 2020).

Here, Petitioner’s Motion requests no more than the statute allows. Petitioner represents that the current “Petition and the . . . Petition [in the Meta IPR] 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.” Mot. 1. Furthermore, Petitioner agrees that, if joined as a party to the Meta IPR, “Petitioner will act as ‘understudy’ and will not assume an active role unless Meta ceases to participate” in the Meta IPR, “Meta will maintain the lead role in the proceeding so long as it is a party to the proceeding,” and “Petitioner will not seek additional depositions or deposition time.” Mot. 2.

Patent Owner opposes the Motion for the four reasons discussed below, none of which is persuasive.

A. Whether Petitioner's Motion Complies with Rule 42.122

First, Patent Owner argues that “[c]oncurrent filing of a motion for joinder is permitted under the specific condition that the underlying IPR petition was filed more than one year *after* being served with a complaint alleging infringement of the patent. Petitioners do not fall within that specific condition.” Opp. 5. Patent Owner cites Rules 42.122(b) and 42.101(b) as support for its argument. *Id.* at 6. However, Patent Owner misapprehends the requirements set forth in these Rules.

Rule 42.122(b) sets the expiration of the time period by which a petitioner may request joinder as “one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). We instituted review in the Meta IPR on January 31, 2023, and Petitioner filed the Petition and the Motion on August 23, 2022, long before the expiration of time period set forth in Rule 42.122(b). Petitioner thus complies with this aspect of Rule 42.122(b). Although Rule 42.122(b) also cross-references Rule 42.101(b), that cross-reference does not set the beginning of the time period during which a person may file a request for joinder as Patent Owner contends.

Instead, Rule 42.101(b) bars a petitioner from filing a petition more than one year after that petitioner (or certain related entities) have been served with a complaint alleging infringement of the patent for which review is sought. 37 C.F.R. § 42.101(b). Rule 42.122(b) sets forth an exception to the one-year bar set forth in Rule 42.101(b) by stating that the “time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.” Patent Owner's argument that the combined effect of Rules 42.101(b) and 42.122(b) requires a petitioner to *wait* until “one year

after being served with a complaint alleging infringement of the patent” to concurrently file a petition and request for joinder is simply incorrect.

We find that Petitioner’s Motion complies with the requirements of Rules 42.101 and 42.122.

B. Whether the Petition Should Be Denied in Discretion Under *Apple v. Fintiv*

Patent Owner argues that we should deny the Petition under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 2–3 (PTAB Mar. 20, 2020) (precedential). Opp. 7–12. Patent Owner points to the Litigation. *See supra* Part B.

We decline to exercise our discretion under *Fintiv* to deny institution of *inter partes* review. On June 21, 2022, the Director of the USPTO issued an *Interim Procedure for Discretionary Denials in AIA Postgrant Proceedings with Parallel District Court Litigation*, available at: https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf (the “Interim Procedure”). The Interim Procedure provides that “the PTAB will not discretionarily deny institution of an IPR or PGR in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.” Interim Procedure 7. Here, Petitioner stipulates that it will not pursue the grounds raised, or that reasonably could have been raised, in this IPR in the parallel litigation if IPR is instituted. Pet. 9; Reply 1. We therefore adhere to the Interim Procedure in this Decision and decline to exercise our discretion to deny institution of *inter partes* review upon this basis.

C. Whether the Petition Must Set Forth “Compelling Evidence of Unpatentability” Under the Interim Procedure

Patent Owner argues by implication that the Petition must set forth “compelling evidence of unpatentability” to avoid analysis of the *Fintiv* factors for deciding whether to exercise discretion to deny a petition.

Opp. 13. Patent Owner’s argument is flawed for two reasons. First, as we discuss immediately above, even applying the *Fintiv* framework for deciding whether to discretionarily deny the Petition, we decline to exercise such discretion. Second, the Interim Procedure does not impose a requirement that a petition must always present compelling evidence of unpatentability to warrant institution. Rather, the Interim Procedure merely indicates that whenever a petitioner adduces compelling evidence of unpatentability, panels will not discretionarily deny the petition under *Fintiv*. Interim Procedure 2.

D. Whether a Potential Denial of the Petition in the Meta IPR Justifies Denying the Petition in this Proceeding

Patent Owner argues that if we were to “discretionarily deny the Meta Platforms IPRs . . . there is nothing for Petitioners to join.” Opp. 13–14. The factual predicate for Patent Owner’s argument fails because we have instituted review in the Meta IPR. IPR2022-01235, Paper 10. Thus, a proceeding (the Meta IPR) does exist for Petitioner to join as a party. For all the reasons expressed above, we find that Petitioner has persuaded us to exercise discretion and grant its Motion to join the Meta IPR as a party.

E. Conclusion

Based on our review of the before us, we find that Petitioner demonstrates that allowing it to join the Meta IPR as a party will not materially lengthen the schedule, increase cost, or add to the complexity of

briefing or discovery in the Meta IPR. Accordingly, we grant Petitioner's Motion and add it as a party to the Meta IPR.

IV. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review of claims 51, 52, 57, 60, 63, 65, 67, 73, 77, 103, 104, 108, 109, 110, 124, 130, 133, 138, and 139 of U.S. Patent No. 10,880,721 B2 is *instituted* with respect to all grounds of unpatentability set forth in the Petition;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of U.S. Patent No. 10,880,721 B2 is instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is given of the institution of a trial; and

FURTHER ORDERED that the Motion for Joinder is *granted*, and Samsung Electronics Co., Ltd. is hereby joined as a petitioner in IPR2022-01235;

FURTHER ORDERED that the grounds on which trial was instituted in IPR2022-01235 are unchanged, and no other grounds are added;

FURTHER ORDERED that Samsung Electronics Co., Ltd.'s role in IPR2022-01235 shall be limited as stated in the Motion for Joinder (Paper 3), unless and until Meta Platforms, Inc. is terminated from that proceeding;

FURTHER ORDERED that the Scheduling Order in place for IPR2022-01235 (Paper 11) shall continue to govern the proceeding after the joinder of Samsung Electronics Co., Ltd. as a petitioner;

FURTHER ORDERED that all future filings are to be made only in IPR2022-01235;

FURTHER ORDERED that the case caption in IPR2022-01235 shall be changed to reflect the joinder of Samsung Electronics Co., Ltd. in accordance with the example below; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2022-01235.

Example Caption

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IPR2022-01235⁷
Patent 10,880,721 B2

⁷ Samsung Electronics Co., Ltd., which filed a petition and a motion for joinder in IPR2022-01393, has been joined as a petitioner in this proceeding.

IPR2022-01393
Patent 10,880,721 B2

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