UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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T-MOBILE USA, INC.,

Petitioner,

v.

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

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Case IPR2023-00638

Patent 8,630,234

_____

PATENT OWNER OPPOSITION TO PETITIONERS' MOTION FOR JOINDER

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EXHIBIT LIST

2001	DEFENDANTS' PRELIMINARY INVALIDITY CONTENTIONS, *VoIP-Pal.com, Inc. v. T-Mobile USA, Inc.*, et al., 6:21-cv-00674 (W.D. Tex.) Served January 25, 2022
2002	DEFENDANTS' FINAL INVALIDITY CONTENTIONS, *VoIP-Pal.com, Inc. v. T-Mobile USA, Inc.*, et al., 6:21-cv-00674 (W.D. Tex.) served July 26, 2022

TABLE OF ABBREVIATIONS

ABBREVIATION	TERM
The ‘234 Patent	U.S. Patent No. 8,630,234
The ‘721 Patent	U.S. Patent No. 10,880,721
Pet.Br.	Petitioner’s Motion for Joinder
T-Mobile	Petitioner T-Mobile USA, Inc.

I. STATEMENT OF PRECISE RELIEF REQUESTED

The instant IPR petition and the concurrently filed motion for joinder constitutes the second attempt by Petitioner to institute an IPR proceeding on the same patent. Petitioner's second filing violates the factors set forth in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, Paper 19 at 9-10, (Sept. 6, 2017) (precedential as to § II.B.4.i). Accordingly, the petition should not be instituted and the motion for joinder should be denied.

T-Mobile filed four IPR petitions on February 28, 2023, namely *T-Mobile-USA, Inc. v. VoIP-Pal.com, Inc.*, IPR2023-00638, Paper 3 (PTAB); *T-Mobile-USA, Inc. v. VoIP-Pal.com, Inc.*, IPR2023-00639, Paper 3 (PTAB); *T-Mobile-USA, Inc. v. VoIP-Pal.com, Inc.*, IPR2023-00640, Paper 2 (PTAB); and *T-Mobile-USA, Inc. v. VoIP-Pal.com, Inc.*, IPR2023-00641, Paper 1 (PTAB) (collectively "Round II IPRs"). Two petitions are directed to claims of the '234 Patent and two of the petitions are directed to claims of the '721 Patent. Concurrently, Petitioner filed a Motion for Joinder seeking to join each IPR with an IPR previously filed by Meta Platforms, Inc. ("Meta").

Meta had filed four IPR petitions on June 30, 2022, namely *Meta Platforms, Inc. v. VoIP-Pal.com, Inc.*, IPR2022-01231, Paper 3 (PTAB); *Meta Platforms, Inc. v. VoIP-Pal.com, Inc.*, IPR2022-01232, Paper 3 (PTAB); *Meta Platforms, Inc. v. VoIP-Pal.com, Inc.*, IPR2022-01234, Paper 3 (PTAB); and *Meta Platforms, Inc. v.*

VoIP-Pal.com, Inc., IPR2022-01235, Paper 3 (PTAB) (collectively the "Meta IPRs"). The Meta IPRs were instituted on January 31, 2023.

Petitioner had previously filed four IPR petitions on June 27, 2022, namely *Amazon.com, Inc., et al., v. VoIP-Pal.com, Inc.*, IPR2022-01178, Paper 3 (PTAB); *Amazon.com, Inc., et al., v. VoIP-Pal.com, Inc.*, IPR2022-01179, Paper 3 (PTAB); *Amazon.com, Inc., et al., v. VoIP-Pal.com, Inc.*, IPR2022-01180, Paper 1 (PTAB); and *Amazon.com, Inc., et al., v. VoIP-Pal.com, Inc.*, IPR2022-01181, Paper 1 (PTAB) (collectively the "Round I IPRs"). Two petitions were directed to claims of the '234 Patent and two of the petitions were directed to claims of the '721 Patent. Petitioner's Round I IPRs were all substantively reviewed and denied on December 22, 2022, for failing to demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims.

II. BACKGROUND AND RELATED PROCEEDINGS

A. District Court Litigations

Concurrent district court litigation between Petitioner and Patent Owner is pending in the United States District Court for the Western District of Texas. *VoIP-Pal.com, Inc. v. T-Mobile USA, Inc., et al.*, 6:21-cv-00674 (W.D. Tex.) (the VoIP-Pal/T-Mobile Litigation) has progressed significantly. Specifically, the

parties have exchanged claim construction briefing, a claim construction hearing occurred, and the Court has entered a claim construction order. Petitioner served Defendants' Preliminary Invalidity Contentions (Exh. 2001) on Patent Owner on January 25, 2022, citing, *inter alia*, the same patents cited in Petitioner's Round II IPRs. Petitioner also served Final Invalidity Contentions on Patent Owner on July 26, 2022 citing the same art (Exh. 2002). Trial is set to start on July 17, 2023. *Id.*, Dkt. No. 27 at 81 at 3 (W.D. Tex.).

B. The Round I and Round II IPR Proceedings

In Petitioner's Round I IPRs, Petitioner challenged Claims 1, 10-11, 19-22, 24-25, and 28 of the '234 Patent. In Petitioner's Round II IPRs, Petitioner challenged the *same* claims plus claims 2, 3, 6, and 29.

In Petitioner's Round II IPRs, Petitioner cited U.S. Patent No. 7,668,159 ("Buckley '159"), U.S. Patent No. 8,731,163 ("Bates '163"), and U.S. Patent No. 6,954,654 ("Ejzak '654"). In Petitioner's Defendants' Preliminary Invalidity Contentions served on Patent Owner on January 25, 2022, Petitioner cited Buckley '159, Bates '163, and Ejzak '654 (Exh. 2001 at 16-17). In Petitioner's Defendants' Final Invalidity Contentions served on Patent Owner on July 26, 2022, Petitioner also cited Buckley '159, Bates '163, and Ejzak '654 (Exh. 2002 at 15-16).

In Petitioner's Round I IPRs, Petitioner received Patent Owner's preliminary response to the petition on October 6, 2022 and on December 22, 2022 received

the Board's decision denying to institute review for failing to demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims.

Given Petitioner's knowledge of Buckley '159, Bates '163, and Ejzak '654 by at least January 25, 2022, and presumably before that date, over a year passed before Petitioner filed its Round II IPRs on February 28, 2023.

III. ARGUMENT

As the moving party, Petitioners have the burden to establish that they are entitled to the requested relief. (37 C.F.R. §§ 42.20(c), 42.122(b)). Factors that the Board may consider in deciding a motion for joinder include why joinder is appropriate, whether a new ground of unpatentability is raised in the second petition, how the cost and schedule of the first proceeding will be impacted if joinder is granted, and whether granting joinder will add to the complexity of briefing and/or discovery. Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) at 76 (citing *Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15)).

"Also, consideration of the non-exclusive factors set out in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i), may support the

exercise of the Board's discretion to deny institution under 35 U.S.C. § 314(a)." *Proppant Express Invs. v. Oren Techs.,* IPR2018-00914, slip op. at 19 (PTAB Mar. 13, 2019) (Paper 38) (precedential).

In *General Plastic*, the petitioner had filed a first set of petitions seeking *inter partes* review of two patents. For each petition, institution of a trial was denied based upon the merits. Nine months after the filing of the first set of petitions, petitioner filed follow-on petitions against the same patents. For each of those follow-on petitions, the Board exercised its discretion not to institute pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a). *General Plastic* at 2-3. As discussed above, the instant case involves virtually the same facts. Such factors are to be considered in relation to motions for joinder when considering discretionary denial. *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB October 28, 2020) (precedential).

It is noted that in *Apple*, the petitioner, similar to the Petitioner here, argued that would have an "understudy role." The Board was not persuaded by this argument because the copied petition is a petitioner's second challenge to the patent, and "should Microsoft settle, Petitioner would stand in to continue a proceeding that would otherwise be terminated" (*Apple* at 4). In effect, it would be as if the petitioner had brought the second challenge to the patent in the first instance. Apple continues "[t]his is the kind of serial attack that *General Plastic*

was intended to address" *Id*. *citing General Plastic*, Paper 19 at 17 ("Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.").

In the decision, the Board set forth several factors to be considered before exercising discretion to deny institution. When considering discretionary denial under *General Plastic*, the following factors must be examined:

> 1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
>
> 2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
>
> 3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
>
> 4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
>
> 5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
>
> 6. the finite resources of the Board; and
>
> 7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.
>
> *Id*. at 9–10.

Considering the *General Plastic* factors, institution and joinder in this case should be denied.

A. Whether the Same Petitioner Previously Filed a Petition Directed to the Same Claims of the Same Patent

As discussed above, Petitioner is the same and its petition is directed to the same claims of the same patent plus claims 2, 3, 6, and 29. Petitioner attempts to avoid the first factor with the excuse that it previously filed two "me too" petitions. (Pet.Br. at 10). Regardless of the characterization, Petitioner filed a prior petition that was substantively reviewed and denied as failing to demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims. Surprisingly, Petitioner cites *CODE200, UAB, et al. v. Bright Data LTD.*, IPR2022-00861 and IPR2022-00862, Paper 18 (Aug. 23, 2022) (Director Review Decision) as highlighting the importance of "allowing [a petitioner] the opportunity to pursue a decision on the merits" (Pet.Br. at 10). However, *Code200* involved a first petition that was *not reviewed* on the merits but rather *was discretionarily denied*. Petitioner is not in the same position. It had its opportunity with its Round I petition and lost. This factor weighs in favor of denying institution and joinder.

B. Whether at the Time of Filing the First Petition the Petitioner Knew or Should Have Known of the Prior Art Asserted in the Second Petition

Clearly, at the time of filing the Round I IPR, Petitioner knew or should have known of the prior art asserted in the Round II IPR where Petitioner cited

Buckley ‘159, Bates ‘163, and Ejzak ‘654. As discussed above, in Defendants’ Preliminary Invalidity Contentions served in the VoIP-Pal/T-Mobile Litigation on Patent Owner on January 25, 2022, Petitioner cited Buckley ‘159, Bates ‘163, and Ejzak ‘654 (Exh. 2001 at 16-17). Petitioner attempts to avoid the second factor by trying to point a finger at someone else saying that it “had no involvement in selecting the prior art presented in either the Google petitions or the Meta petitions” (Pet.Br. at 11). This argument is meaningless. Petitioner could have filed its own petition and made its own selection of prior art but chose not to. Instead, Petitioner made the decision to file a copy-cat petition with full knowledge of the art that it presently asserts. Thus, regardless of the characterization, Petitioner filed a Round I IPR aware of the art cited in the Round II IPR. The Round I IPR was substantively reviewed and denied as failing to demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims. Petitioner knew of the prior art cited in the Round II IPRs at least as early as January 25, 2022 having served it themselves in the VoIP-Pal/T-Mobile Litigation. This factor weighs in favor of denying institution and joinder.

C. Whether at the Time of Filing of the Second Petition the Petitioner Already Received the Patent Owner’s Preliminary Response to the First Petition or Received the Board’s Decision on Whether to Institute Review in the First Petition

As discussed above, at the time of filing of the Round II IPRs, Petitioner already received the patent owner's preliminary response to the first petition on October 6, 2022 and on December 22, 2022 had received the Board's decision denying to institute review for failing to demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims. Petitioner tries to bootstrap itself citing to the Meta IPRs stating that it "moves to join identical Meta petitions that were filed long before Patent Owner filed its preliminary response to the Google petitions and even longer before the Board's institution decision" (Pet.Br. at 12). Again, regardless of the characterization, Petitioner filed a prior petition in which it received patent owner's preliminary response and had received the Board's decision before filing the Round II IPRs. This factor weighs in favor of denying institution and joinder.

D. The Length of Time Elapsed Between the Time the Petitioner Learned of the Prior Art Asserted in the Second Petition and Filing of the Second Petition

As discussed above, over a year – January 25, 2022 until February 28, 2023 – had passed from the time the petitioner learned of the prior art and filed the instant petition. Given that Petitioner's Defendants' Preliminary Invalidity Contentions, served on Patent Owner on January 25, 2022, cited Buckley '159, Bates '163, and Ejzak '654 (Exh. 2001 at 16-17), Petitioner presumably knew

about those references even before service. Petitioner claims that it "filed the Petitions and joinder motion within one month of institution of the Meta proceedings—within the time period specifically allowed under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b)" and that it "was unable to file the Petitions and move to join the Meta proceedings until institution because it was time-barred under 35 U.S.C. § 315(b)" (Pet.Br. at 12), ignoring that it had been in possession of the prior art when it prepared and filed its Round I IPRs. This factor weighs in favor of denying institution and joinder.

E. Whether the Petitioner Provides Adequate Explanation for the Time Elapsed Between the Filings of Multiple Petitions Directed to the Same Claims of the Same Patent

Again, Petitioner attempts to side-step by bootstrapping itself to Meta. Petitioner claims that it "filed the Petitions and joinder motion within one month of institution of the Meta proceedings—within the time period specifically allowed under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b)" and that it "was unable to file the Petitions and move to join the Meta proceedings until institution because it was time-barred under 35 U.S.C. § 315(b)" (Pet.Br. at 12). In actuality, 8 months passed between the June 27, 2022 filing of the Round I IPRs and the February 28, 2023 filing of the Round II IPR. Petitioner knew of the prior art when it prepared

and filed its Round I IPR. Petitioner chose to withhold the prior art at that time. This factor weighs in favor of denying institution and joinder.

F. The Finite Resources of the Board

Petitioner had its chance to file IPRs citing to the prior art it knew about in January, 2022. It chose not to. The finite resources of the Board should not be used for a Petitioner who filed an IPR withholding prior art of which it was aware, failed to demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims, and now wishes to file a second petition. Petitioner tries to justify its expenditure of Board resources in connection with its Round I petitions by again bootstrapping itself to Meta – "… will not impact the Board's resources beyond those resources the Board dedicates to the instant joinder motion" (Pet.Br. at 13). But this argument assumes that Meta will handle the Meta IPR until it is complete. If Meta were to settle before then, however, then the Board's resources will be impacted because T-Mobile will have the opportunity to continue the Meta IPR even though the Meta IPR should be terminated at that point. Enough is enough! Petitioner has already made its decision for using Board resources in connection with its first petition. This factor weighs in favor of denying institution and joinder.

G. Issue a Final Determination Not Later Than One Year After the Date on Which the Director Notices Institution of Review

This *General Plastic* factor appears neutral in relation to denying institution and joinder.

IV. CONCLUSION

For all the reasons set forth above, Petitioners' request to institute and IPR and their motion for joinder in the Round II IPRs should be denied.

Dated: March 28, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on March 28, 2023, I caused to be served a true and correct copy of the forgoing PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTION FOR JOINDER via the PTAB's PTACTS System and via electronic email to the email addresses identified and consented to by Petitioners specifically for service as follows:

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