

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE USA, INC.,
Petitioner,

v.

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

Case Nos. IPR2023-00638 & IPR2023-00639
U.S. Patent No. 8,630,234

PETITIONER'S NOTICE OF MULTIPLE PETITIONS

I. INTRODUCTION

Petitioner is filing two petitions that challenge non-overlapping sets of claims in U.S. Patent No. 8,630,234 (“the ’234 patent”). The “patent owner has asserted a large number of claims in litigation,” including claims that are distinct from one another, that collectively comprise several thousand words of claim language. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) at 59. More than one petition is therefore necessary to sufficiently address the challenged claims, and the Board should exercise its discretion to institute both petitions.¹

II. RANKING OF THE PETITIONS

Petitioner requests that the Board consider the petitions in the following order, although, for the reasons explained below, the Board’s analysis would not be complete without considering both petitions:

¹ To ease the Board’s review, this Notice of Multiple Petitions is substantively the same as the Notice Regarding Multiple Petitions filed in *Meta Platforms, Inc. v. VoIP-Pal, Inc.*, IPR2022-01231 and IPR2022-01232 (“the Meta proceedings”), filed on June 30, 2022, for U.S. Patent No. 8,630,234.

Rank	Petition	Challenged Claims	Primary References
A	IPR2023-00639	30-33, 35, 37-40, 43, 45-48, 51, 53-54, 61-62, 64-65, 67, 69-70, 72, and 75	Buckley (EX1005) Bates (EX1009) Ejzak (EX1007)
B	IPR2023-00638	1-3, 6, 10-11, 19-22, 24-25, and 28-29	Buckley (EX1005) Bates (EX1009)

III. DIFFERENCES BETWEEN THE PETITIONS AND WHY THEY SHOULD BOTH BE INSTITUTED

The two petitions challenge 40 claims, 29 of which were originally asserted by Patent Owner against Petitioner in the parallel District Court litigation, *VoIP-Pal.com, Inc. v. T-Mobile USA, Inc.*, Case No. 6-21-cv-00674 (W.D. Tex.). Those asserted claims collectively comprise well over 2,200 words, making it practically infeasible to substantively analyze all of them in a single petition, given the word limit. Indeed, the narrowed set of 9 claims currently asserted against Petitioner comprise approximately 757 words alone. Moreover, Petitioner files a “me too” petition here, committing Petitioner to challenge the same claims on the same grounds as the Meta petitions.

There are also differences between the claims that warrant grouping them separately for analysis. In particular, independent claims 1, 11, 20, and 29 are claimed from the perspective of the mobile device (telephone), while independent

claims 30, 46, and 62 are claimed from the perspective of the server. As a result, the claims in the two claim sets recite some different language and claim elements. For example, the server-side claims recite elements regarding the specifics of “*producing* an access code” (cls. 30, 32) that the telephone-side claims do not. Even the applicant bucketed these two sets of claims separately during prosecution, in apparent recognition that they were sensibly addressed separately. *Compare* EX1002, 1840 (“Independent Claims 1, 12, 22, and 32² all recite a common feature....”), *with* EX1002, 1843 (“Regarding independent Claims 33, 52, 71 and 90, these claims all recite in various forms the following exemplary language....”).

Given the number of asserted claims, their length, and their different groupings (at least as argued by the applicant during prosecution), Petitioner reasonably divided its challenge into two petitions: (1) IPR2023-00639 challenging the server-side claims (ranked A above), and (2) IPR2023-00638 challenging the telephone-side claims (ranked B above). There is no overlap in the challenged claims across the two petitions. The Board has instituted multiple petitions in similar situations, and should do so here. *See, e.g., Microsoft Corp. v. Syncloud Tech., LLC*, IPR2020-01269, Paper 9 at 7–9 (PTAB Apr. 7, 2021) (instituting two petitions for IPR where “the length of the claims, and the difference in scope of [the independ-

² At this stage of prosecution, then-numbered claim 32 was a telephone-side claim. *See* EX1002, 1825-26.

ent claims], warranted the filing of two petitions”); *Adobe Inc. v. Synkloud Tech., LLC*, IPR2020-01392, Paper 8 at 9–10 (PTAB Mar. 11, 2021) (similar).

IV. CONCLUSION

For the reasons given above and in the concurrently-filed Petitions and Motions for Joinder, the Board should institute both Petitions.

Respectfully submitted,

Dated: February 28, 2023

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CERTIFICATE OF SERVICE

I hereby certify that on February 28, 2023, I caused a true and correct copy of the foregoing **PETITIONER'S NOTICE OF MULTIPLE PETITIONS** to be served via USPS Priority Mail Express on the Patent Owner at the following correspondence address of record as listed on PAIR:

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A courtesy copy was also sent via electronic mail to the Patent Owner's litigation counsel at the following email addresses:

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