

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,

Petitioner,

v.

VOIP-PAL.COM, INC.,

Patent Owner.

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Case IPR2023-00648

Patent 8,630,234

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**PATENT OWNER OPPOSITION TO  
PETITIONER'S MOTION FOR JOINDER TO  
INTER PARTES REVIEW IPR2022-01232**

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## EXHIBIT LIST

2001	DEFENDANTS' PRELIMINARY INVALIDITY CONTENTIONS, <i>VoIP-Pal.com, Inc. v. T-Mobile USA, Inc.</i> , et al., 6:21-cv-00674 (W.D. Tex.) Served January 25, 2022
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**TABLE OF ABBREVIATIONS**

<b>ABBREVIATION</b>	<b>TERM</b>
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
Pet.	PETITION FOR <i>INTER PARTES</i> REVIEW OF U.S. PATENT NO. 8,630,234
Google	Petitioner Google LLC

## **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). Petitioner's motion for joinder does not address *General Plastics*, but instead characterizes its petition as "substantively identical" and that "Google will act as an understudy" (Pet.Br. at 1) Petitioner addresses *General Plastics* in its Round II IPR petition. For the reasons discussed below, the petition should be discretionarily denied and the motion for joinder should be denied.

Google filed four IPR petitions on February 28, 2023, namely *Google LLC. v. VoIP-Pal.com, Inc.*, IPR2023-00647, Paper 1 (PTAB); *Google LLC. v. VoIP-Pal.com, Inc.*, IPR2023-00648, Paper 1 (PTAB); *Google LLC. v. VoIP-Pal.com, Inc.*, IPR2023-00649, Paper 1 (PTAB); and *Google LLC. v. VoIP-Pal.com, Inc.*, IPR2023-00650, Paper 1 (PTAB) (collectively the "Google 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 3, 2022, namely *Google LLC f/k/a Google Inc. v. VoIP-Pal.com, Inc.*, IPR2022-01072, Paper 1 (PTAB); *Google LLC f/k/a Google Inc. v. VoIP-Pal.com, Inc.*, IPR2022-01073, Paper 1 (PTAB); *Google LLC f/k/a Google Inc. v. VoIP-Pal.com, Inc.*, IPR2022-01074, Paper 1 (PTAB); and *Google LLC f/k/a Google Inc. v. VoIP-Pal.com, Inc.*, IPR2022-01075, 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 19, 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**

District court litigation between Petitioner and Patent Owner had been pending in the United States District Court for the Western District of Texas. *VoIP-Pal.com, Inc. v. Google LLC*, 6:21-cv-00667-ADA (W.D. Tex.) (the VoIP-Pal/Google Litigation). That matter had been transferred to the Northern District of California *VoIP-Pal.com, Inc. v. Google LLC*, 3:22-cv-03199 (N.D. Ca.). During the pendency of the VoIP-Pal/Google Litigation, 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.

#### **B. The Round I and Round II IPR Proceedings**

In Petitioner's Round I IPRs, Petitioner challenged Claims 30-33, 35, 37-40, 43, 45-48, 51, 53-54, 61-62, 64-65, 70, 72, and 75 of the '234 Patent. In Petitioner's Round II IPRs, Petitioner challenged the *same* claims plus claims 67 and 69.

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 Round I IPRs, Petitioner received Patent Owner's preliminary response to the petition on September 21, 2022 and on December 19, 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*, IPR2016-01357, (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). 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 *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.

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 67 and 69. Petitioner attempts to avoid the first factor with the excuse that it previously filed two petitions (Pet. at 7) that did not challenge these claims. 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 that “roadmapping concerns are ‘minimized’ when ‘a petitioner files a later petition that raises unpatentability challenges substantially overlapping with those’ in an earlier petition” (Pet. at 9). 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/Google 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 “was not aware of the specific Buckley, Bates, and Ejzak analysis used in this Petition until June 30, 2022, when the Meta IPR Proceeding was filed.” (Pet. at 8). Again, 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/Google 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 September 21, 2022 and on December 19, 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 "Moreover, the Meta IPR Proceeding was filed before the Board or Patent Owner addressed the merits of any '234 petition." (Pet. at 10). 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 attempts to avoid the issue claiming that it “knew of the Buckley and Bates prior art references when filing its prior IPR petitions ... However, Google was not aware of the specific Buckley, Bates, and Ejzak analysis used in this Petition until June 30, 2022, when the Meta IPR Proceeding was filed (Pet. at 8), ignoring that it had been in possession of the prior art for months 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 avoid the explanation issue stating that it “was not aware of the specific Buckley, Bates, and Ejzak analysis used in this Petition until June 30, 2022” (Pet. at 8). In actuality, 8 months passed between the June 3, 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 Samsung – “... Meta IPR Proceeding could continue even if Meta were to settle because Google (via this IPR proceeding) and Samsung (via IPR2022-01390) are both vying to join the Meta IPR proceeding” (Pet. at 10). But the Board should not have to expend resources on Google continuing the Meta IPR because it already had an opportunity to assert the same that it the subject of its current petition. Rather, that IPR should be terminated if Meta and Samsung settle. 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 OPPOSITION TO PETITIONER'S MOTION FOR JOINDER TO INTER PARTES REVIEW IPR2022-01232 via the PTAB's PTACTS System and via electronic email to the email addresses identified and consented to by Petitioners specifically for service as [Google-VoIP-PalIPR@paulhastings.com](mailto:Google-VoIP-PalIPR@paulhastings.com).

By: /s/ Lewis E. Hudnell, III

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