

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

VOIP-PAL.COM, INC.,
Patent Owner

IPR2023-00648
Patent No. 8,630,234

**PETITIONER'S REPLY
IN SUPPORT OF MOTION FOR JOINDER**

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Google LLC (“Google”) respectfully submits this Reply to VoIP-Pal.com, Inc.’s (“VoIP-Pal”) Opposition to Petitioner’s Motion for Joinder (Paper 8, “Opp.”). As discussed in more detail below, the circumstances here compel granting Google’s motion for joinder.

I. VoIP-Pal Does Not Dispute Key Facts Favoring Joinder

In its opposition, VoIP-Pal does not dispute any of the key facts identified in Google’s motion for joinder. *See* Paper 3 (“Mot.”) at 5-9. For example, VoIP-Pal does not dispute that Google’s petition is substantively identical to that in *Meta Platforms, Inc. v. VoIP-PAL.com, Inc.*, IPR2022-01232 (“the Meta IPR Proceeding”) or that Google’s petition does not propose any new grounds of unpatentability. Nor does VoIP-Pal dispute that joinder will not negatively impact the Meta IPR Proceeding or that Google has agreed to procedures that will simplify briefing and discovery. Undisputed, these considerations all weigh in favor of institution. VoIP-Pal instead stresses discretionary issues under *General Plastic*. *See* Opp. at 5-11. But as discussed below, none of VoIP-Pal’s discretionary-based arguments have merit.

II. The *General Plastic* Factors Weigh in Favor of Institution

***General Plastic* Factor 1:** VoIP-Pal admits that additional claims are at issue in this proceeding as compared to Google’s previous petition—namely claims 67 and 69. Opp. at 7. As such, factor 1 favors institution. *Advanced Micro Devices*,

Inc. v. Monterey Research, LLC, IPR2021-00776, Paper 13 at 12 (Oct. 13, 2021) (finding factor 1 did not weigh against institution when the “me-too” petition challenged different claims that the petitioner did not challenge in its two previous petitions). VoIP-Pal attempts to distinguish a different case, *Code200, UAB v. Bright Data Ltd.*, calling Google's reliance on it “[s]urprising[.]” Opp. at 7, but Google cited *Code200* for *General Plastic* factor 3, not factor 1. Pet. at 9.

General Plastic Factors 2, 4, and 5: VoIP-Pal stresses that Google knew about prior art references cited in the Meta IPR Proceeding before Google filed its first petition. Opp. at 8-10. As an initial matter, however, any impact of Google's prior art knowledge is minimal at best because Google is not raising new challenges, but “merely present[ing] the same challenges that previously resulted in institution.” *See Atlassian Corp. v. Express Mobile Inc.*, IPR2022-00783, Paper 16 at 10 (Oct. 7, 2022). Moreover, Google acknowledged its limited knowledge. Pet. at 8-9. But as Google explained, it was “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. VoIP-Pal does not dispute this, but dismisses it as irrelevant. Opp. at 8-10. But a petitioner's knowledge of “the specific combinations, raised in the grounds” is relevant when considering these factors. *See Express Mobile*, IPR2022-00783, Paper 16 at 10; *see also Google LLC v. Express Mobile Inc.*, IPR2022-00791, Paper 15 at 7-12 (Oct. 7, 2022) (granting joinder where the

petitioner (Google) “admit[ted] that it had received [the primary reference]” before filing its first IPR petition, but also “represent[ed] that it was not aware of the significance of [that reference] when it filed the [first] petition,” because it was not unreasonable for the first IPR petition to omit that reference, and once that first IPR petition was filed, it was not unreasonable for the petitioner to wait to file the second IPR petition until after the first IPR petition was denied and the proceeding to which it sought joinder was instituted). Thus, these factors do not weigh in favor of discretionary denial.

General Plastic Factor 3: VoIP-Pal suggests factor 3 weighs in favor of discretionary denial because “Petitioner filed a prior petition in which it received patent owner’s preliminary response and had received the Board’s decision” before filing its copycat joinder petition. Opp. at 9. But factor 3 concerns road-mapping issues, i.e., issues relating to whether a previous preliminary response or institution decision could be leveraged to gain an advantage in a later petition. *Code200*, IPR2022-00861, Paper 18 at 5; see also *Expedia, Inc. v. Express Mobile, Inc.*, IPR2022-00785, Paper 16 at 9 (Sept. 27, 2022). “[R]oad-mapping’ concerns are minimized when, as in this case, a petitioner files a later petition that raises unpatentability challenges substantially overlapping with those in the previously-filed petition and the later petition is not refined based on lessons learned from later developments.” *Code200*, IPR2022-00861, Paper 18 at 5. Indeed, road-mapping

“concerns simply don’t apply in the case of a ‘me too’ Petition like this one, because Petitioner is not trying to leverage an earlier Petitioner for an unfair advantage.” *Expedia*, IPR2022-00785, Paper 16 at 9; *see also* Pet. at 9-10 (explaining how this is the case here). Thus, factor 3 weighs in favor of institution.

General Plastic Factor 6: As set forth in the Petition, factor 6 weighs in favor of institution. Pet. at 10-11. The Board already allocated resources to complete the Meta IPR Proceeding, which supports institution. *See Advanced Micro Devices*, IPR2021-00776, Paper 13 at 17. Indeed, the Board recently confirmed its resource allocation for the Meta IPR Proceeding by permitting another party, Samsung, to join the proceeding. *Samsung Elecs. Co. v. VoIP-Pal.com, Inc*, IPR2022-01391, Paper 12 (Mar. 16, 2023) (granting joinder). VoIP-Pal does not point to any substantive factors counseling otherwise, and instead simply asserts without basis that “the Board should not have to expend resources on Google” should Meta and Samsung both settle with VoIP-Pal before a final written decision issues. Opp. at 10-11. There is no indication, however, that settlement will actually occur, and as such any discussion of settlement is mere speculation. And even if there was a settlement, given the large number of civil actions that VoIP-Pal has initiated based on the patent-at-issue here, allowing the Meta IPR Proceeding to continue would be a worthwhile use of the Board’s resources.

General Plastic Factor 7: VoIP-Pal asserts in conclusory fashion that “[t]his

General Plastic factor appears neutral in relation to denying institution and joinder.” *See* Opp. at 11. That is incorrect. Similar to as described in *Expedia*, the seventh *General Plastic* factor weighs in favor of institution because Google merely seeks to join an ongoing proceeding as an understudy, and the Board will not face difficulty in timely issuing a final written decision in that proceeding. *See Expedia*, IPR2022-00785, Paper 16 at 10.

III. The Stay of the Related Parallel Litigation Favors Institution

As Google previously explained, Pet. at 11, the seven *General Plastic* factors are “a non-exhaustive list,” and “additional factors may arise in other cases for consideration, where appropriate.” *General Plastic*, IPR2016-01357, Paper 19 at 16, 18. One additional factor that the Board may consider is whether a petitioner’s parallel district court litigation has been stayed. *See Google LLC v. Express Mobile, Inc.*, IPR2022-00598, Paper 13 at 9-10 (Aug. 19, 2022). VoIP-Pal ignores the fact that the parallel Northern District of California case involving the challenged patent is presently stayed. Pet. at 11. Such a stay favors institution because it further “alleviates concerns about potential issues that may arise from having Board and district court proceedings occurring in parallel.” IPR2022-00598, Paper 13 at 9-10.

IV. Conclusion

Because the joinder factors and the *General Plastic* factors weigh in favor of institution, Google respectfully requests that the Board grant joinder.

Google's Reply in Support of Motion for Joinder

Respectfully submitted,

April 26, 2023

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CERTIFICATE OF SERVICE

I hereby certify that on April 26, 2023, I caused a true and correct copy of the foregoing Petitioner's Reply in Support of Motion for Joinder to be served on the Patent Owner at the following correspondence address of record:

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