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19 **UNITED STATES DISTRICT COURT**
NORTHERN DISTRICT OF CALIFORNIA
20 **(SAN JOSE DIVISION)**

21 VOIP-PAL.COM, INC.,

22 *Plaintiff,*

23 v.

24 APPLE, INC.,

25 *Defendant.*
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27
28

Case No. 5:18-cv-06216-LHK

**(CORRECTED) VOIP-PAL'S OPPOSITION
TO APPLE'S AND AMAZON'S
CONSOLIDATED MOTION TO DISMISS
PLAINTIFF'S COMPLAINT:
MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT**

Date: September 5, 2019

Time: 1:30PM

Courtroom: Courtroom 8 – 4th Floor

Hon. Judge Lucy H. Koh

1 VOIP-PAL.COM, INC.,

2 *Plaintiff,*

3 v.

4 AMAZON.COM, INC. and AMAZON
5 TECHNOLOGIES,

6 *Defendants.*

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1 Pursuant to Fed. R. Civ. P. 12, Plaintiff VoIP-Pal, Inc. (“VoIP-Pal” or “Plaintiff”) files this opposition
2 to Defendants’ Joint Consolidated Motion to Dismiss for failure to state a claim under 35 U.S.C. § 101 (ECF
3 No. 89 (Apple Case¹) and ECF No. 67 (Amazon Case), also referred to as the “Motion”). VoIP-Pal’s
4 opposition is made in conjunction with the Declaration of Kevin N. Malek (“Malek Decl.”) and the
5 Declaration of Dr. William H. Mangione-Smith (“Mangione-Smith Decl.”) filed herewith.

6 I. INTRODUCTION

7 Starting in 2004, Digifonica (International) Limited (“Digifonica”), a wholly owned subsidiary of
8 VoIP-Pal, spent over fifteen million dollars researching, developing, and testing a communication solution
9 for seamlessly integrating a private voice-over-IP (“VoIP”) network with an external network (e.g., the
10 “public switched telephone network” or “PSTN”). Numerous top professionals, three of whom hold Ph.D.
11 degrees, developed a system that had physical nodes across internationally geographic regions, including
12 working nodes in Vancouver (Canada) and London (UK). Digifonica applied for and obtained patents
13 worldwide for its valuable inventions including applications that culminated in the Patents-in-Suit.
14 Defendants now ask this Court to invalidate every asserted claim of the Patents-in-Suit at the motion to
15 dismiss stage before construction of any claim, despite the absence of an adequate factual record and the
16 existence of factual disputes.² Contrary to Defendants’ allegations, the claims are not ineligible under 35
U.S.C. § 101 and the Motion should be denied for at least the following reasons:

17 **First**, the asserted claims are not directed to an abstract idea, such as manipulating information or
18 emulating longstanding human practices, but rather, to a specific technological process and system that
19 enables communications between physical devices, such as a phone call, and an *improved* communication
20 routing system and controller that evaluates user-specific profile settings (“*attributes*”) in order to identify
21 and classify the destination of a communication, such as a phone call, between two distinct networks (e.g.,
IP-based vs. PSTN).

22 **Second**, the asserted claims recite *unconventional* inventive concepts to address problems rooted in
23 communication network technology, for example, the use of caller-specific evaluations of a callee identifier,
24

25 ¹ Reference to the “Apple Case” refers to Case No. 5:18-cv-06216-LHK and reference to the “Amazon
26 Case” refers to Case No. 5:18-cv-07020-LHK.

27 ² VoIP-Pal makes a proffer of expert evidence herewith, *i.e.*, the Declaration of Dr. Mangione-Smith, to aid
28 the Court’s understanding of the types of evidence that Plaintiff would elicit on discovery, including, without
limitation: (1) technical facts relevant to the invention, (2) improvements enabled by asserted claims, and
(3) factual disputes related to the Motion requiring further briefing. As set forth in the last section of this
brief, this material is intended to demonstrate the premature nature of the present inquiry.

1 based on caller-specific profile settings, to enable caller-specific initiation and/or vetting of a communication
2 and transparent routing of the communication integrated over a system network (e.g., IP-based) and an
3 external network (e.g., circuit switched or PSTN); and

4 **Third**, the Motion is *premature* in that there are numerous factual disputes at issue thereby warranting
5 denial of the Motion. (See FN 2 cited herein). Before the resolution of the Motion, the factual record needs
6 development in order to establish, amongst other things, the state of the art and what was “well-understood,
7 routine and conventional” in 2006 as a baseline for evaluating the non-abstract improvements and eligible
8 inventive concepts in VoIP-Pal’s claims.³

9 II. LEGAL STANDARD

10 In considering Defendants’ Motion under Fed. R. Civ. P. 12(b)(6), a court must take “all allegations
11 of material fact in the complaint as true and construe them in the light most favorable to the non-moving
12 party.” *Cedars-Sinai Med. Ctr. v. Nat’l League of Postmasters of U.S.*, 497 F.3d 972, 975 (9th Cir. 2007).
13 Although a complaint “need not contain detailed factual allegations,” it must “plead ‘enough facts to state a
14 claim to relief that is plausible on its face.’ ” *Weber v. Dep’t of Veterans Affairs*, 521 F.3d 1061, 1065 (9th
15 Cir. 2008) (quoting *Bell Atl. Corp v. Twombly*, 550 U.S. 544, 570 (2007)).

16 III. ARGUMENT

17 A. Defendants’ Purported Characterization of the Abstract Idea Is Inaccurate

18 From the outset, Defendants mischaracterize the Patents-in-Suit, falsely asserting that the claims are
19 directed to “the abstract idea of *routing a communication based on characteristics of the participants.*”
20 (See Motion at p. 6 (emphasis in original)). Defendants’ abstract idea expression is not anywhere near a true
21 reflection of the asserted claims, but is instead a significantly generic expression of routing in general.

22 The asserted claims are specific and technological processes and systems that enable
23 communications, such as a telephone call (e.g., in response to initiation of the communication by the first
24 participant device), to be routed (e.g., method for routing a communication) using a controller (e.g., by a
25 controller comprising at least one processor) in a process that analyzes attributes and criteria of the users
26 (e.g., a first participant identifier) in order to seamlessly route the call to specific addresses, nodes (e.g.,

27 ³ “Courts faced with such motions must scrutinize reductive descriptions with great care. It has also become
28 increasingly common for litigants to pursue such judicial rulings, which can be as complex as Markman
rulings but without a similar record. Courts must therefore be alert to motions seeking factual determinations
of what a claimed invention ‘is’ when unaccompanied by the necessary submissions from those skilled in
the art.” *Verint Systems Inc. v. Red Box Recorders Ltd.*, 226 F. Supp. 3d 190, 192 (S.D.N.Y. 2016) (emphasis
in original).

1 device comprises an IP or internet address or domain name of the communication system node) and gateways
2 amongst disparate internet-connected networks (e.g., established using the gateway to the external network)
3 and using a device, such as an internet connected mobile phone (over an Internet Protocol (IP) network). *See*,
4 e.g., claims 3, 4 and 14 of Malek Decl. Ex. 2 (the ‘330 Patent); *see also*, e.g., claims 2, 6 and 8 of Malek
5 Decl. Ex. 3 (the ‘549 Patent).⁴ Separately, Defendants fail to explain both the fact of and the manner in which
6 “*establishment*” of communications is recited in the claims. The Motion conflates *all* sources and types of
7 information that might be involved in routing as being merely information “about” the participants.
8 Defendants have not accounted for even the most rudimentary features that are recited in all of the asserted
9 claims. *See Id.*

10 Under Defendants’ reductive approach, Step 1 of the *Alice* framework is no longer a meaningful
11 inquiry but simply a charade. *See, e.g., Verint Systems Inc. v. Red Box Recorders Ltd.*, 226 F. Supp. 3d 190,
12 192 (S.D.N.Y. 2016) (explaining the danger of “reductionist simplicity” and finding that

13 [v]irtually every invention could be described at a high level in a few words: ‘A method
14 to provide answers to questions’ for a search engine; ‘a tool to assist a user to draft
15 documents’ for a document-processing program; ... Similarly, virtually any invention
16 could be described as simply addressing that which others long ago addressed: the Socratic
17 method to acquire information; quills, pens, typewriters, to create written text... This
18 reductionist simplicity may obscure underlying complexity, and it may jeopardize the
19 innovative improvements upon longstanding accomplishments that patents are intended
20 to incent.

21 *Id.* at 192.

22 As exemplified above, the inaccuracy in Defendants’ characterization of the claims is readily
23 apparent from a straightforward reading of any asserted claim “as a whole”. Any “gathering” or “processing”
24 of information in the claims is not an end in and of itself, but rather, a means subservient to a higher end. For
25 example, referring to claim 1 of the ‘002 Patent,⁵ contrary to Defendants’ assertion, the claim is directed to
26 evaluating originator-specific profile settings (“*attributes*”) to identify and classify an intended destination,
27 as between two distinct networks, and based on the classification to produce a routing message with network-
28 specific addresses, which is then used to establish a communication to the destination in the identified
29 network. Specifically, the “*routing*” method involves “*receiving, by a controller,*” “*over an Internet protocol*

30 ⁴ Significantly, many of these limitations are not expressly claimed in claim 1 of the ‘002 Patent, further
31 supporting and providing examples of how VoIP-Pal’s contention that claim 1 is not a suitable representative
32 claim matters here, as discussed in this brief.

33 ⁵ Defendants allege this claim is representative of all asserted claims. Defendants have not met their burden
34 to show the representativeness of the claims. VoIP-Pal rejects Defendants’ assertion of representativeness
35 for at least the reasons set forth in Section III.B of this brief.

1 (*IP*) network,” a “*first participant identifier and a second participant identifier*”. The “*first participant*
2 *identifier*” is used to “*access a database comprising user profiles*” to “*locate a plurality of first participant*
3 *attributes*,” at least one of which is used to process the “*second participant identifier obtained from a user*
4 *profile for the first participant*” to “*produce a new second participant identifier*” capable of describing
5 destinations in either the system network or the external network. Depending on the classification of the
6 destination, either a “*system routing message identifying an Internet address associated with the second*
7 *participant device*” is produced, or an “*external network routing message identifying an Internet address*
8 *associated with a gateway to an external network.*” See, e.g., claims 3, 4 and 14 of Malek Decl. Ex. 2 (the
9 ‘330 Patent); see also, e.g., claims 2, 6 and 8 of Malek Decl. Ex. 3 (the ‘549 Patent); see also claim 1 of
10 Malek Decl. Ex. 4 (the ‘002 Patent). The routing message “*causes the communication to be established*” by
11 setting up suitable communication infrastructure to route the call.

11 **B. Claim 1 Of The ‘002 Patent Is Not Representative Of The Asserted Claims**

12 Contrary to Defendants’ assertions, claim 1 of the ‘002 Patent is not a representative claim for
13 purposes of a § 101 analysis of the twenty (20) asserted claims. Claims of a United States Patent are presumed
14 to be valid. See 35 U.S.C. § 282 (providing that “[e]ach claim of a patent...shall be presumed valid
15 independently of the validity of other claims...even though dependent upon an invalid claim”). In light of
16 that presumption, patent-eligibility must be evaluated, like any other ground of invalidity, for each
17 individual claim. *Ortho Pharm. Corp. v. Smith*, 959 F.2d 936, 942 (Fed. Cir. 1992) (“grounds of invalidity,
18 must be analyzed on a claim-by-claim basis”), citing *Shelcore, Inc v. Durham Industries, Inc.*, 745 F.2d 621,
19 624 (Fed. Cir. 1984) (“a party challenging the validity of a claim, absent a pretrial agreement or stipulation,
20 must submit evidence supporting a conclusion of invalidity of *each* claim the challenger seeks to destroy”).

21 (1) *Defendants’ Motion Does Not Address Any of the Claimed Inventive and Unconventional Processes and Systems.*

22 Certain claims that are omitted from Defendants’ analysis set forth materially *different* methods of
23 communication blocking or prevention and in *different* technical contexts, e.g.: (1) preventing calls *while*
24 evaluating “network classification” (e.g., by a sending an “error message” to a “call controller”); or (2)
25 locating *callee*-specific blocking information *after* classification if the network is IP-based. See, e.g., Malek
26 Decl. Ex. 1 (‘762 Patent) at claims 2, 21, 26; Ex. 2 (‘330 Patent) at claim 14); Ex. 4 (‘002 Patent) at claim
27 26; and Ex. 3 (‘549 Patent) at claims 11 and 12. The intrinsic record demonstrates how these features provide
28 non-abstract improvements to routing *and/or* contribute to one or more unconventional “inventive concepts,”
viz.: (1) using “caller-specific attributes and caller profile settings associated with their profile for

1 determining whether or not they are permitted to initiate a communication *and/or* (2) using “callee-specific
2 information to...implement selective call blocking” for the IP network. Such claims improved the
3 functioning, classification, and integration of networks, overcoming the limitations of PSTN nodes and PBX
4 switches. *See* FAC⁶ at ¶¶ 38 and 23-27.

5 Aside from claims classifying certain communications as invalid or erroneous, some claims recite other
6 specific classification methods: (1) determining a *system registration status* of the “called” party for use as
7 a criterion-in-part for network classification (Malek Decl. Ex. 1 (‘762 Patent) at claims 1, 21, 14, 25); (2)
8 *comparing* a “calling” party’s profile settings with a second party’s identifier to classify the communication
9 (*Id.* at Ex. 2 (‘330 Patent) at claims 1 and 12)⁷; (3) classifying based on whether a profile associated with a
10 produced new second participant identifier exists in a database (*Id.* at Ex. 3 (‘549 Patent) at claims 8, 9); and
11 (4) classifying by determining a destination device’s configuration (*Id.* at claim 6).

12 Different claims recite different aspects of system architecture for establishing a communication, e.g.,
13 Malek Decl. Ex. 2 (‘330 Patent) at claims 1 (“communication system node”), claim 3 (a plurality of “nodes
14 each operably configured to provide communications services to a plurality of communication system
15 subscribers”) and claim 12; and *id.* Ex. 4 (‘002 Patent) at claim 29 (selecting from among a “plurality of
16 gateways”)—concrete, tangible architectural elements that improve system resiliency and load distribution
17 for the IP-based communication network and external network, respectively. *See* FAC at ¶¶ 35, 37. Other
18 claims recite specific ways of identifying what infrastructure to use (e.g., Malek Decl. Ex. 4 (‘002 Patent) at
19 claim 22). For example, a user-specific “domain” profile setting (260) affects how routing is conducted *to*
20 a subscriber by (configurably) identifying a node address associated with that user. *See* Malek Decl. Ex. 1
21 (‘762 Patent) at col. 18 ll. 59-65; element 260 in Figs. 9-12; element 360 in Fig. 15 (routing message). It is
22 permissible, even essential, to read the specification to understand such patent-eligible features and
23 improvements by construing the claims “in light of [the] written description.” *Amdocs (Isr.) Ltd. v. Openet
24 Telecom Inc.* 841 F.3d 1288 at 1299, 1303. Claim 1 of the ‘002 cannot be representative.⁸

24 ⁶ FAC refers throughout this brief collectively to ECF No. 61 (First Amended Complaint -cv-07020) and
25 ECF No. 81 (First Amended Complaint -cv-06216).

26 ⁷ These claims *also* differ from claim 1 of the ‘002 Patent in that they do not recite producing a “new second
27 participant identifier” and using it as a basis for destination network classification.

28 ⁸ Indeed, to rely on one claim would result in an inaccurate § 101 process and risk stripping Plaintiff of due
process with respect to its valuable property rights in the Patents-In-Suit without having afforded it an
opportunity to support its case with expert evidence, claim construction, and sufficient briefing. *Cedars-
Sinai Medical Center v. Watkins*, 11 F.3d 1573, 1582 (Fed. Cir. 1993) (patents are “property rights of which
the patentee cannot be deprived without due process of law”) (quotation omitted); *Postsecondary Educ.*

1 (2) Claim 1 of the '002 Patent Is Not Representative of the Claims Found to be Ineligible in the
2 Related Case.

3 Defendants' argument that claim 1 of the '002 Patent is "substantially the same" as the claim of the
4 '815 patent that the Court found to be ineligible in the Related Case⁹, is wrong. See Motion at 4. Not only
5 is claim 1 of the '002 Patent not representative here; it also recites specific features that are not set forth in
6 claim 1 of the '815 Patent and are relevant to a § 101 inquiry. Claim 1 of the '002 Patent recites generation
7 of a "new second participant identifier", a feature not recited in claim 1 of the '815 Patent. The creation of a
8 new second participant identifier is a tangible feature that was not considered in the Related Case.
9 Specifically, claim 1 of the '002 recites a two-stage mechanism for classification in which first participant
10 attributes are used to produce a new second participant identifier, which, in turn, is used to classify and route
11 the communication. The first step utilized user-specific information; the second step does not; and this
12 intermediate, new identifier bridges the two stages to allow them to work together. This mechanism, not
13 previously considered by the Court, is an example of the asserted claims specifying "how" functions are
14 carried out.¹⁰

14 **C. Under Alice/Mayo Step One, The Claims Are Not Directed To An Abstract Idea.**

15 An abstract idea under §101 "is a fundamental truth; an original cause; a motive." (*Parker v. Flook*,
16 437 U.S. 584, 589 (1978) (citing *Le Roy v. Tatham*, 55 U.S. 156, 175 (1852))). A specific technological
17 process and system that enables one to make a telephone call or to send a message from a device, such as a
18 phone, to other users whether on private or public internet-connected networks is not an abstract idea. In
19 their *Alice/Mayo* Step 1 analysis, Defendants make three arguments that Defendants contend lead to the
20 conclusion that the asserted claims are directed to an abstract idea: (1) that the claims recite generalized steps
21 to carry out generic functions that are not specific improvements in computers, (2) that the claims can be
22 carried out in a person's mind with paper and pencil and (3) that determining where to route communications
23 based on participant information is analogous to longstanding fundamental practices. None of Defendants'
24 assertions warrant dismissal or a conclusion that the claims are directed to an abstract idea here. Defendants'
25 contention that the asserted claims are abstract at *Alice/Mayo* Step 1 requires stripped down characterizations

26 *Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627 (1999) (holding that patents are private property rights secured
27 under the Due Process Clause of the Fourteenth Amendment).

27 ⁹ The Related Case is as defined in Defendants' Motion.

28 ¹⁰ To take another example, claim 1 of the '002 Patent expressly recites that the routing message causes the
communication to be established and explains how it is done for different classifications. Claim 1 of the
'002 Patent also recites a "first... [and] second participant device" This represents a concrete real-world
result relevant to a Section 101 inquiry.

1 of the claims that eliminate tangible and concrete limitations that the Defendants assert can be ignored
2 because these limitations are allegedly generic, conventional, lack novelty and are not unique to the patented
3 invention. But that is not the proper inquiry at *Alice/Mayo* Step 1. Under Step 1 of *Alice/Mayo*, the proper
4 inquiry is whether, taking all limitations of the asserted claims as a whole, the claimed inventions are to an
5 abstract idea or concept. *Alice*, 573 U.S. at 224, 225. In *Alice*, the Supreme Court precluded **computerization**
6 **of** abstract ideas with generic and conventional means. The Supreme Court did not invalidate the use or
7 incorporation of computer or other technology into a claim – generic or not. Such a test would foreclose
8 improvement of existing technologies. *Id.* Therefore, in order to determine whether a claim is abstract, a
9 court must consider whether the claims merely computerize an abstract idea – not whether the claims use
10 generic computer elements as part of its claims. *Id.* at 225.

11 (1) *The Asserted Claims Are Not Generic; They Are to Specific Technological Methods and*
12 *Systems That Improve Call and Messaging Routing Technology.*

13 Eliminating significant and tangible limitations from the claims, Defendants argue that, at their
14 essence, the claims “recite (1) receiving over an IP network identifiers for first and second parties for a
15 communication; (2) locating attributes associated with the first party; (3) processing the second party
16 identifier “based on” the attributes of the first party; and (4) based on the processed identifier, classifying
17 and routing the communications to a ‘system’ or ‘external network.’”¹¹ See Motion (ECF No. 67 (Case No.
18 7020)) at p. 9. Based on this mischaracterization of claim 1 of the ‘002 Patent – which is not a representative
19 claim for the reasons discussed above - Defendants argue that all of the asserted claims are abstract because
20 they are generic and “generalized, functionally-written data collection processing steps” that VoIP-Pal “did
21 not invent.” See *Id.* at 9 – 11.

22 Foremost, as discussed above, claim 1 of the ‘002 Patent is not representative of the twenty (20)
23 asserted claims. Secondly, Defendants’ characterization of the asserted claims strips the claims down to such
24 a high level of generality that Defendants’ analysis becomes a self-fulfilling charade. For example, nowhere
25 in Defendants’ expression of the asserted claims have Defendants identified the presence of an “Internet
26 connected first participant device.” See Motion (ECF No. 67 (Case No. 7020)) at p. 8-9. That is a physical
27 device, such as a handheld phone or a computer that is used to initiate a phone call, for example, as required

28 ¹¹ Defendants articulate two different characterizations of the claims and it should be noted that this second
characterization of what the claims recite is not a reflection of the over-simplistic and generalized expression
of the alleged abstract idea: “routing a communication based on characteristics of the participants.” See
Motion (ECF No. 67 (Case No. 7020)) at p. 8. Yet neither characterization is a true reflection of the scope
of the asserted claims.

1 under the patented inventions. *See supra*. Defendants’ also eliminated from their characterization of the
2 claims, the fact that the patented inventions require a physical “controller comprising at least one processor”
3 that receives a communication, such as a phone call, over an “Internet Protocol (IP) network,” a physical and
4 distinct high technology network environment. *Id.*

5 Defendants point to various decisions holding patent claims ineligible where the claims at issue
6 “pertain[ed] to collecting and analyzing information” arguing that “such information gathering and analysis
7 fell squarely within the abstract-ideas exception to Section 101” because they are “focused on characterizing
8 incoming data and acting based on that characterization.” *See* Motion (ECF No. 67 (Case No. 7020)) at p. 9)
9 (citations omitted). But the asserted claims are not merely directed to information gathering and analysis.
10 Like all computer and software inventions, the asserted claims do involve, in some aspects, information
11 processing. However, the asserted claims do much more – they enable a telephone call for example. Indeed,
12 claim 12 of the ‘549 Patent enables a phone call and requires many distinct technological features as
13 discussed above. Claim 12 of the ‘549 is no mere information processing claim. Claim 12 of the ‘549 Patent
14 enables an actual phone call over a physical network and to specific network gateways and nodes. There is
15 nothing generic about the asserted claims. It is Defendants’ analysis that is entirely generic.

16 Courts have cautioned against evaluating claims at a stripped-down level of generality as Defendants
17 have done here. As the Supreme Court recognized, “[a]t some level all inventions embody, use, reflect, rest
18 upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Alice Corp. v. CLS Bank Int’l* 134 S.
19 Ct. 2347, 2354 (2014) (internal citations omitted); *see also Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 1335,
20 1344 (Fed. Cir. 2013) (subsequent history omitted). Some claim steps may *involve* “gathering and processing
21 information” as part of an improved routing process, but such an improved process is not barred by § 101,
22 notwithstanding incorporation of a law of nature, natural phenomenon or abstract concept. *See, e.g., Diamond*
23 *v. Diehr*, 450 U.S. 175, 188 (1981); *see also Parker v Flook*, 437 U.S. 584, 590 (1978). Defendants have
24 focused on a subset of the claim limitations to distort the character of the claim as a whole. That is error. The
25 Supreme Court has mandated that “claims must be considered as a whole.” *Diamond v. Diehr*, 450 U.S. at
26 188; *see also Mackay Radio & Telegraph Co. v. Radio of America*, 306 U.S. 86, 94 (1939); *see also Huawei*
27 *Techs., Co, Ltd v. Samsung Elecs. Co, Ltd.*, 340 F. Supp. 3d 934, 980 (N.D. Cal. 2018) (rejecting § 101
28 challenge where the defendant failed “to address the claims as a whole and ignore[d] the patent’s disclosure
of providing an improvement to telecommunication systems”).

The claimed inventions improve communication routing technology using specific technological means and are therefore not abstract. Claims directed to an improved process have never been barred by §

1 101, notwithstanding reliance on judicially excepted subject matter. *See, e.g., Diamond v. Diehr*, 450 at 188.
2 The Federal Circuit has followed the Supreme Court’s lead, finding claims directed to “new and useful
3 techniques” for performing tasks to be not abstract. *See, e.g., Thales Visionix Inc. v. United States*, No. 2015-
4 5150, 2017 WL 914618, at *5 (Fed. Cir. Mar. 8, 2017) (“claims directed to a new and useful technique for
5 using sensors to more efficiently track an object” to be not abstract); *Rapid Litigation Management Ltd., v.*
6 *CellzDirect, Inc.*, 827 F.3d 1042, 1047 - 1050 (Fed. Cir. 2016). The Supreme Court acknowledged that claims
7 that “purport to improve the functioning of a computer itself” or “effect an improvement in any other
8 technology or technical field” are patent eligible. *Alice*, 134 S. Ct. at 2359. That is exactly the case here: the
9 claims at issue improve communication routing technology and infrastructure in a manner that overcomes
10 technical limitations in prior art systems.¹² (*See* FAC at ¶¶ 15 – 22; *see also* Malek Decl., Exhibit 4 (‘002
11 Patent) at col. 2 ll. 17 – 18 (“invention relates to voice over IP communications and methods and apparatus
12 for routing”); *id.* at col. 14 l. 65 – col. 15 l. 10 and col. 17 l. 64 – col 18 l. 25 (describing a process for
operating a routing controller for routing to private network and public network destinations)).

13 As a person skilled in the field of the invention would recognize, in view of the patent specification
14 and the state of the art at the time of invention, the patented inventions solve problems arising in the
15 integration and interoperability of disparate networks, such as a system or internal network (*e.g.*, voice-over
16 IP) and an external network (*e.g.*, a “circuit switched network” or public switched telephone communication
17 network (‘PSTN’)). (*See* FAC at ¶¶ 15 – 22, 26, 30 – 31).¹³ Integration involves bridging disparate technical
18 requirements in the two networks. For example, a VoIP system may use non-PSTN protocols such as Session
19 Initiation Protocol (SIP) and a variety of caller/callee identifiers, including proprietary identifiers that are
20 incompatible with PSTN callee identifiers. (*See e.g.*, Malek Decl., Exhibit 1 (‘762 Patent) at col. 13 ll. 63 –
21 67, col. 14 ll. 46 – 50, col. 15 ll. 64 – 67 and FIG. 3 (phones use SIP protocol); *id.* at col. 17 ll. 8 – 12 and
22 col. 27 ll. 57 - 63 (call controller uses SIP protocol, as do communication nodes and gateways); *see id.* at
23 Fig. 15 (358), Fig. 51 (904) (callee identifier may be a Digifonica number/username, or a PSTN compatible
24 number); *see also id.* at col. 17 ll. 61 – 63, col. 26 ll. 13 – 19 and Fig. 26 (606) (caller identifier may be a
PSTN number or a system username); *id.* at col. 17 ll. 34 – 42 (caller identifier may be an IP address)).

25 Consequently, for a system or controller to interoperate with both networks, the claimed systems and
26 methods inherently require computer-based implementation within a computer network. (*See, e.g.*, Malek

27 ¹²If given the opportunity to engage in discovery, VoIP-Pal would elicit evidence to support the proposition
28 that the claims at issue improve communication routing technology and infrastructure in a manner that
overcomes technical limitations in prior art systems. (*See, e.g.*, Mangione-Smith Decl. at ¶¶ 7- 16).

¹³ *See also, e.g.*, VoIP-Pal’s evidentiary proffer at Mangione-Smith Decl. at ¶¶ 7- 16, 19, 23-24.

1 Decl., Exhibit 1 ('762 Patent) at col. 1 ll. 22 – 23 (VoIP phones may be computers); *id.* at col. 14 ll. 21 – 24
2 (VoIP phones may share networking resources such as Network Address Translation with other computers);
3 *id.* at col. 13 ll. 20 – 38 (FIG. 1 illustrating a preferred embodiment of a VoIP system); *id.* at col. 13 ll. 55 –
4 67 (Internet accessibility)). Indeed, the patented method could not be performed without computing
5 equipment such as a routing controller. (See FAC at ¶¶ 21 – 22, 31, 40).¹⁴ Still further, routing to “internal”
6 or “external” destinations may require use of *different* network elements. Internal routing in an IP network
7 may rely on one or more communication nodes, whereas external destinations (*e.g.*, on the PSTN) may only
8 be accessible through a gateway. (See Malek Decl. at Exhibit 1 ('762 Patent) at Fig. 1 (10 and 21 (Vancouver
9 and London system nodes); 20 (multiple gateways)).¹⁵ The asserted claims *improve* routing technology is
10 improved (as explained *infra*), (see FAC at ¶¶ 32 (handling), 33-36 (transparency), 37 (resiliency), 38
11 (blocking) and 40)¹⁶ in part, through a routing system and controller that uses user-specific profile settings
12 (“attributes”) to evaluate an initiated communication, to identify and classify its intended destination, as
13 between two distinct networks (*e.g.*, IP-based vs. PSTN). Examples of improvements include:

14 **User-Specific Handling.** The call routing controller, system and method of the claimed invention is
15 improved over prior art technology that required users to place a call by using a specific callee identifier
16 format or by following certain dialing conventions with no opportunity or support for user-specific handling.
17 For example, PSTN nodes were typically limited to supporting only the dialing conventions of a local calling
18 service area. (See Malek Decl. at Exhibit 1 ('762 Patent) at 1:36-42)). The asserted claims overcome such
19 limitations by evaluating a called party identifier based on profile settings (“attributes”) associated with the
20 calling party. (See, *e.g.*, Malek Decl. at Exhibit 1 ('762 Patent) col. 18 ll. 40-58 (disclosing user-specific
21 “profile” capable of supporting numerous global styles of dialing); *id.* col. 19 ll. 38-50 (individual service
22 preferences supported); *id.* at col 17 ll. 61-63 (support for proprietary usernames); and *id.* at Figs. 8A-8D
23 (processing of a routing request)). Initiation can be handled differently for different originating parties based
24 on their profile attributes. (See Malek Decl. at Exhibit 1 ('762 Patent) Fig. 10 (user profile attributes allow

24 ¹⁴ See also, *e.g.*, VoIP-Pal’s evidentiary proffer at Mangione-Smith Decl. at ¶¶ 15-16, 24, 33, 37, 40.

25 ¹⁵ Because the as-yet-undeveloped factual record in this case constrains VoIP-Pal from a full and fair
26 presentation of the improvements to the state of technology provided by the Patents-In-Suit, VoIP-Pal
27 includes a proffer of evidence to the Court in the form of the enclosed Declaration of Dr. Mangione-Smith,
28 to explain the deficiencies in the record.

¹⁶ See also, generally, Mangione-Smith Decl., including specifically: ¶¶ 25 (improvements in user-specific
communication handling), ¶¶ 26-29 (improvements in routing transparency), ¶ 30 (improvements in
resiliency), ¶ 31 (blocking techniques) ¶ 33, and ¶¶ 37-38 (source code review).

1 dialing using certain conventions, *e.g.*, “011” for international dialing digits); *id.* at Fig. 12 (another user’s
2 profile is different, *e.g.*, IDD is “00”); *compare id.* at claim 31 (evaluating second participant identifier based
3 on first participant’s profile)). All of the asserted claims of the Patents-In-Suit enable user-specific handling
4 of communications. (*See* FAC at ¶ 32).¹⁷

5 **Transparent Routing.** Many prior art systems required users to explicitly signal how a call should be
6 processed or to manually “trigger” special call handling, *e.g.*, PBX systems conventionally required dialing
7 a predefined prefix (*e.g.*, “9”) to indicate that subsequent digits were to be interpreted as a PSTN number. A
8 user was thus required to affirmatively choose *how* routing would take place. In contrast, the asserted claims
9 of the Patents-In-Suit use a caller’s attributes to evaluate a callee identifier against network routing criteria
10 to cause the call to automatically be routed over a system network (*e.g.*, VoIP) or an external network (*e.g.*,
11 a PSTN interconnected through a gateway), *transparently* to the user, without the user specifying which
12 network to use. (*See, e.g.*, Malek Decl. at Exhibit 1 (‘762 Patent) at Fig. 8A (254: get profile for caller from
13 database); *id.* at Fig. 8B (apply caller profile attributes to callee identifier; determine network destination as
14 private system or public system); *id.* at Figs. 8A, 8C, 8D (produce and send routing message to call
15 controller)). The caller may not, and *need not*, know the network location of the called party. In some claimed
16 embodiments, a node associated with the callee is identified (*e.g.*, from a callee profile stored in the
17 communication system: (*see* Malek Decl. at Exhibit 2 (‘330 Patent) at claim 1)) and the communication is
18 *transparently* sent to that node for handling. (*See, e.g.*, Malek Decl. at Exhibit 1 (‘762 Patent) at Figs. 8A,
19 8D; Malek Decl. at Exhibit 1 (‘762 Patent) at col. 13 ll. 20-44). Some claimed embodiments recite automatic
20 network selection based on determination of a callee’s registration status. (*See, e.g.*, Malek Decl. at Exhibit
21 1 (‘762 Patent) at claims 1, 14, 21, and 25). Also, the system can decouple the *type* of number being dialed
22 from call classification and routing; calls can be routed internally to system subscribers (*e.g.*, via VoIP)
23 notwithstanding that a PSTN number was dialed. This enables callers to benefit from IP-based private
24 network calling even if unaware of a callee’s subscriber status. (*See, e.g.*, Malek Decl. at Exhibit 1 (‘762
25 Patent) at col. 19 ll. 23-25, col. 31 ll. 48-32:57 and Figs. 9-12 (field 273), 41, 43, 45, and 47-50 (disclosing
26 support for different resellers (*e.g.*, phone companies retailing communication services)). A callee could re-
27 register at a different node, or move between two disparate networks, and the system could track the
28 destination’s status to maintain the transparency of routing to that callee. All of the asserted claims recite at
least one form of *transparent routing* as described above. (*See* FAC at ¶¶ 33 – 36).¹⁸

¹⁷ *See, e.g.*, proffer of evidence set forth in Mangione-Smith Decl. at ¶ 25.

¹⁸ *See also, e.g.*, proffer of evidence set forth in Mangione-Smith Decl. at ¶¶ 26 - 29.

1 **Resiliency.** The invention improves over prior art (*e.g.*, PSTN exchanges and PBXs) providing
2 service only to a limited area (*see* Malek Decl. at Exhibit 1 ('762 Patent) at col. 1 ll. 50-53) but unable to
3 provide reliable service to many geographically dispersed users. (*Id.* at col. 1 ll. 36-38). If a node failed, prior
4 systems might lack other nodes to take up the load. (*Id.* at col. 1 ll. 42-46). In contrast, the patented inventions
5 can provide reliable service to large areas (*e.g.*, countries and continents), in part, through the technology
6 allowing flexible assignment including nodes with overlapping responsibility. (*Id.* at col. 13 ll. 20-40
7 (network of nodes) and col. 13 ll. 41-44 (nodes for “call load sharing”). A routing message identifies a
8 suitable system network “node” or a gateway (*e.g.*, a gateway to the PSTN) in response to evaluation of a
9 caller’s attributes, the callee identifier, and available routing resources (*Id.* at Figs. 1, 8A-8D) to establish the
10 communication. This design makes it simple to allocate or add new nodes and gateways to particular regions
11 or routes and to have them identified in the routing message produced to provide service availability to
12 subscribers as needed without redesigning the routing apparatus and process. (*See* Malek Decl. at Exhibit 1
13 ('762 Patent) at col. 13 ll. 20-44; col. 25 ll. 51-64, col. 27 ll. 44-47; col. 27 l. 64 – col. 28 l. 7). The technology
14 can also improve resilience by routing through an *available* gateway selected from among many supplier
15 gateways. (*Id.* at col. 27 l. 64 – col. 28 l. 23). As a further improvement, unlike some prior art systems, the
16 technology does not require access to PSTN databases. (*Id.* at col. 1 ll. 33-35). (*See* FAC at ¶ 37).¹⁹

16 **Communication Blocking.** The technology improves over many prior art blocking methods by
17 supporting: (1) using caller-specific attributes associated with a caller’s profile for determining, in a caller-
18 specific manner, whether or not initiation of a communication is permitted (*See* Malek Decl. at Exhibit 1
19 ('762 Patent) at col. 20 ll. 14-32); (2) using caller-specific profile attributes to establish whether an attempted
20 communication is valid, *e.g.*, by evaluating the validity of the called party identifier as a *user-specific*
21 determination (*e.g.*, *id.* at col. 20 ll. 30-34 and Fig. 8B); and (3) by supporting selective blocking, selective
22 forwarding, and/or routing of communications to voice mail without interrupting the callee or the caller
23 making an explicit choice. (*Id.* at Fig. 8A (*e.g.*, steps 602, 608, 610), Fig. 8B, Figs. 26-32 and col. 26 l. 2 –
24 col. 27 l. 43). These improvements are recited in asserted claims. (*See* FAC at ¶ 38).²⁰

24 Where, as here, claims are directed to an improvement in the functioning of technology, the claims
25 are not abstract. *See, e.g., Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356, 1362-3 (Fed.
26 Cir. 2018) (finding claims eligible under § 101 because the claims were directed to an improvement in the
27 functioning of computers; *Evolved Wireless, LLC v. Apple Inc.*, 221 F. Supp. 3d 485, 494 (D. Del. 2016).

28 ¹⁹ *See, e.g.*, proffer of evidence set forth in Mangione-Smith Decl. at ¶ 30.

²⁰ *See, e.g.*, proffer of evidence set forth in Mangione-Smith Decl. at ¶ 31.

1 Defendants reliance on *Glasswall Solsd Ltd.* is misplaced. (See Motion at p. 12). Unlike the claims in
2 *Glasswall Solsd Ltd.*, the claims of the Patents-in-Suit are directed to an improvement in network routing
3 technology as described herein. *Compare Glasswall Sols. Ltd. v. Clearswift Ltd.*, No. 2018-1407, 2018 WL
4 6720014, at *2 (Fed. Cir. Dec. 20, 2018).

5 Courts have found similar telephone and communication routing claims eligible. *See, e.g., Genband*
6 *US LLC v. Metaswitch Networks Corp.*, No. 2:14-cv-33-JRG-RSP, 2016 WL 7645424, *1 (E.D. Tex., Jan.
7 6, 2016); *Ronald A. Katz Tech. Licensing, L.P. v. FedEx Corp.*, No. 2:15-cv-02329-JPM-tmp, 2016 WL
8 1179218, *1 (W.D. Tenn. Mar. 24, 2016); *Twilio, Inc. v. Telesign Corporation*, Case No. 16-cv-06925-LHK,
9 2017 WL 1208588, *32 (N.D. Cal. Mar. 31, 2017).

10 Defendants argue that claim 1 of the ‘002 Patent, and therefore all of the asserted claims, are abstract
11 because they are directed to functionally-written steps that do not recite how those steps are achieved. (See
12 Motion at p. 11). Defendants simply ignore numerous details in the claims which, in fact, do explain
13 particular ways of achieving the result. As explained above, claim 1 of the ‘330 Patent (Malek Decl. at
14 Exhibit 2) does specify “how” “*participant identifiers are received,*” namely: they are received “*by a*
15 *controller comprising at least one processor,*” and this occurs “*over an Internet protocol (IP) network,*” and
16 is “*in response to initiation of the communication by the first participant device.*” Defendants’ “how”
17 questions are adequately answered by looking at the claim “as a whole” and, in some cases, by looking at
18 dependent or parallel claims. To take a second example, “how” “the communication is classified” is
19 adequately answered in claim 1: it is classified “*based on [a] new second participant identifier*” that was
20 “*produce[d]*” “*based on at least one of the plurality of first participant attributes obtained from a user*
21 *profile for the first participant,*” and results in a classification of a “*system communication*” or “*an external*
22 *network communication*” by “*using the at least one processor*”. Moreover, numerous dependent claims (at
23 least claims 3-7 of the ‘330 Patent (Malek Decl. at Exhibit 2) recite various possible implementations of the
24 step of “classifying” in detail.²¹ A claim is not patent ineligible merely because it has a broad scope that is
25 supported by the patent specification. *Prompt Medical Systems, L.P. v. Allscripts Healthcare Sols, Inc.*, No.
26 6:10-cv-71, 2012 WL 678216, *7 (E.D. Tex. Feb. 13, 2012) (citation omitted). VoIP-Pal rejects the
27 contention that just claim 1 of the ‘002 Patent “captures” all of the as-yet-unconstrued variants or that *all*

28 ²¹ Each of the features recited in claim 1 of the ‘002 Patent (Malek Decl. at Exhibit 4) have counterparts in
numerous other claims within the Patents-In-Suit. However, given the variety of ways in which these
features are claimed, the lack of a claim construction at this early juncture, as well as the page limits for
reply in this Opposition, simply do not permit proper consideration of each variant on this motion to dismiss
under § 101, thus demonstrating yet another reason why this Motion is premature.

1 possible ways a feature has been claimed are necessarily equivalent for § 101 purposes. In effect, Defendants
2 seek a premature finding of ineligibility *in lieu of* the necessary work of claim construction for properly
3 informing an analysis of the claims under § 101. *See, generally, Markman v. Westview Instruments, Inc.*, 517
4 U.S. 370, 384-391 (1996); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1324 (Fed. Cir. 2005).

5 And the cases relied upon by Defendants in support of the proposition that the claims are purely
6 functional and lack specialized technology regarding how to carry out those functions are easily
7 distinguished. Unlike the *24/7 Customer* and *Internet Patents Corp.* cases relied upon by Defendants (Motion
8 at p. 11), it cannot be said that VoIP-Pal's claims have "no restrictions on how [a] result is accomplished".
9 Likewise, the claims in *Broadsoft* were held ineligible as being directed to organizing "human activity" (a
10 person with a list of numbers could have manually called all of the callee's numbers). *See Broadsoft, Inc. v.*
11 *CallWave Comm'n, LLC*, 282 F. Supp. 3d 771 (D. Del. 2017). For all of the above reasons, Defendants'
12 arguments under Step 1 of *Alice* should be rejected.

13 (2) *The Asserted Claims Cannot Be Carried Out In A Person's Mind Or With Paper and Pencil.*

14 Next, Defendants allege that the claims are directed to ineligible subject-matter because they "could
15 be performed as a series of mental steps." (*See* Motion at p. 11). This assertion is clearly incorrect. That
16 falsity is premised upon Defendants' previous mischaracterization of the claims as directed *solely* to
17 "gathering" and "processing" information. It ignores that a person could not, in their mind (nor with pen and
18 paper), enable a phone call with a mobile phone (an Internet-connected first participant device ... operable
19 to initiate a communication ... that causes the communication to the second participant device to be
20 established using the gateway to the external network). *See, e.g.,* Malek Decl. Ex. 3 ('549 Patent) at claim
21 12. Nor could a person constitute a physical computer (a controller comprising at least one processor in
22 communication with at least one memory) that transmits a telephone call over a physical network (receive
23 over an Internet protocol (IP) network a first participant identifier and a second participant identifier) and
24 route the phone call to a particular destination in the network (produce a system routing message identifying
25 an Internet address of a communication system node ... wherein the system routing message causes the
26 communication to be established to the second participant device/Internet address associated with a gateway
27 to an external network). *Id.* A person could not "receiv[e]" first and second participant identifiers "over an
28 Internet protocol (IP) network," as expressly recited in, *e.g.,* '002 Patent (Malek Decl. Exhibit 4) at claim 1.
Nor could a person mentally "produc[e]" a "routing message" for use by the communication system using
"a gateway to an external network," in order to route to a specific "Internet address." Defendants
conveniently omit these and other claim elements from their reduced list of what claim 1 of the '002 Patent

1 (Malek Decl. at Exhibit 2) allegedly “requires”. (See Motion at pp. 11 – 12).

2 Defendants’ purported performance of the claim using “mental steps” implausibly requires
3 clairvoyance and telekinesis, among other superhuman abilities. See, e.g., *In re Mahoney* 421 F.2d 742, 745
4 – 46 (C.C.P.A. 1970) (finding that “it would be absurd to say that the claims reasonably read on a mentally
5 implemented process. We are aware of no way in which the human mind can operate on such signals.”); see
6 also *Communique Lab., Inc. v. Citrix Sys.*, 151 F. Supp. 3d 778, 790 – 1 (N.D. Ohio 2015) (rejecting
7 “telephone operator” analogy where defendant failed to consider claim “as a whole” (citation omitted)).
8 Courts have rejected Defendants’ very argument in the context of computer-related inventions. See, e.g.,
9 *California Institute of Technology v. Hughes Comm’n Inc.*, 59 F. Supp. 3d 974, 994 (C.D. Cal. 2014). Facing
10 a similar mental steps argument, the court in *Hughes Comm’n* explained:

11 this mode of analysis [is] unhelpful for computer inventions. Many inventions could be
12 theorized with pencil and paper, but pencil and paper can rarely produce the actual effect of
13 the invention. Likewise, with regard to software, a human could spend months or years
14 writing on paper the 1s and 0s comprising a computer program and applying the same
15 algorithms as the program. At the end of the effort, he would be left with a lot of paper that
16 obviously would not produce the same result as the software. *Id.*

17 Furthermore, Defendants do not cite any evidence that operators could have performed the steps of
18 the asserted claims mentally or with pen and paper. Defendants’ argument is entirely conclusory lawyer
19 argument. And the cases Defendants cite in this regard are inapposite. For example, Defendants cite various
20 cases for the proposition that the inventions claimed in the Patents-in-Suit can be performed completely
21 through mental steps. (See Motion at pp. 6, 9 (citing *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350
22 (Fed. Cir. 2016), *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343
23 (Fed. Cir. 2014), and *Fair Warning IP v. Iatric Sys., Inc.*, 839 F.3d 1089 (Fed. Cir. 2016)). But the facts in
24 those cases are nothing like the present. Those cases merely require monitoring power grid information
25 (*Electric Power Group*), extracting and storing check information (*Content Extraction*), or notifying a user
26 of fraud (*FairWarning IP*), activities which do not inherently require computers.²² Defendants’ reliance on
27 *AT&T Mobility* is also inapposite. (See Motion at pp. 6, 9). Unlike the claims in *AT&T Mobility*, the claims
28 in the Patents-in-Suit cannot be performed in the human mind. Compare *Intellectual Ventures I LLC v. AT*

26 ²² Evidence demonstrating that the asserted claims are directed to a system that is inherently rooting in
27 computer technology is set forth in the First Amended Complaints, allegations that must be accepted as true
28 on Defendants’ Rule 12(b)(6) Motion. (See FAC at ¶¶ 21, 22, 26, 31, and 40). Separately, VoIP-Pal makes
the following proffer of evidence that, if given the opportunity to engage in discovery, VoIP-Pal would elicit
evidence that the asserted claims are directed to a system that is inherently rooted in computer technology.
(See Mangione-Smith Decl. at ¶¶ 15, 16, 19, 24, 33 – 46).

1 & *T Mobility LLC*, 235 F. Supp. 3d 577, 594 (D. Del. 2016) (finding claims to be directed to an abstract
2 concept because they can be performed by a human instead of a computer).

3 (3) *The Asserted Claims Are Not Analogous To Any Longstanding Fundamental Process*

4 Defendants then allege the claims are directed to the same steps performed by telephone operators or
5 the “longstanding” operations of a “corporate mailroom” and are therefore abstract. Defendants rely on a
6 decision finding ineligibility of a claim that pertained to “using a ‘computer and telecommunications network
7 for receiving, sending and managing information.” See Motion at p. 14 (citing *Parus Holdings, Inc. v. Sallie*
8 *Mae Bank*, 137 F. Supp. 3d 660, 672 (D. Del. 2015), aff’d, 677 Fed. App’x 682 (Fed. Cir. 2017). Defendants’
9 assertion that *Parus Holdings* supports a finding that the present claims are abstract is misplaced. In *Parus*
10 *Holdings*, the court started with an unfounded hostility towards computer software inventions that has no
11 place in law:

12 [b]ecause computer software comprises a set of instructions, the first step of *Alice* is, for the
13 most part, a given; i.e., computer-implemented patents generally involve abstract ideas.

14 *Parus Holdings, Inc. v. Sallie Mae Bank*, 137 F. Supp. 3d at 665. From that entirely unfounded premise, the
15 *Parus Holdings* court found the claims there to be abstract under *Alice/Mayo* Step 1 because the claims were
16 directed to nothing more than organizing human activity:

17 Although at the time of issuance the challenges addressed by the patents-in-suit undoubtedly
18 were considered to be Internet-centric, under the current analytical paradigm (i.e., in
19 hindsight), the fact that there are pre-Internet analogs to the patent claims suggests methods
20 of organizing human (business) activity and, therefore, an abstract idea.

21 See *Parus Holdings, Inc. v. Sallie Mae Bank*, 137 F. Supp. 3d at 672. But the claims here are directed to
22 much more than merely processing information. See, e.g. Section III.A herein. As another court explained,
23 criticizing conclusions like the one made in *Parus Holdings*:

24 ***[I]t is difficult to imagine any software patent that survives under this approach***—most
25 inventions today build on what is known in the art, and an improvement to software will
26 almost inevitably be an algorithm or concept which, when viewed in isolation, will seem
27 abstract. ***This analysis would likely render all software patents ineligible***

28 *Cal. Inst. of Tech. v. Hughes Commc’ns Inc.*, 59 F.Supp.3d 974, 989 (C.D. Cal. 2014) (emphasis added).

Defendants’ operator analogy also relies on numerous *ad hoc* and *conclusory* assertions about what
an operator “*could*” do: (1) “the operator *could* then look up the caller in a phone book to find... full phone
number or location” (but why look up information that is not needed to route the call?); (2) “[*If needed*, the
operator *could* easily ‘process’ the callee’s identifier by removing or adding digits to the dialed number...”

1 (but why do so rather than use the ‘dialed number’ to connect the call? And why the qualifier, “if needed?”);²³
2 (3) “the operator *could* compare that information to a network subscriber directory to determine if the call
3 should be routed as an internal or external network call” (again, why is the ‘dialed number’ insufficient to
4 route the call?). (See Motion at p. 14 (emphasis added)). Defendants simply assert, with no evidence or
5 cogent explanation, that human operators “could” do things that they had no apparent need to do. The analogy
6 is incoherent, unsupported, and specious. In PSTN numbering plans, telephone numbers were self-
7 interpreting (e.g., a country code, area code or exchange code self-evidently facilitated the next step in
8 routing). Operators “could” and did routinely route calls based on callee identifier *alone*. But even if
9 (*arguendo*) operators used information other than the callee identifier to make routing decisions, Defendants
10 have no factual evidence to show that the operators would have utilized information sources and methods of
11 analysis analogous to those recited in the asserted claims. This is a material dispute. See *Pure Data Sys., LLC*
12 *v. Ubisoft, Inc.*, 329 F. Supp. 3d 1054, 1068 (N.D. Cal. 2018) (rejecting asserted comparisons to longstanding
13 commercial practices and methods of organizing human activity because “the Court has no knowledge of
14 any actual use of such practice, much less any confidence that the common use of such a practice is generally
15 known”). So too here. Defendants’ detailed assertions are not supported by any evidence.

15 Defendants’ reliance upon *Whitepages* for the mere idea of reading a phone book is unavailing. (See
16 Motion at p. 14 (citing *Whitepages, Inc. v. Isaacs*, 196 F. Supp. 3d 1128 (N.D. Cal. 2016)). In *Whitepages*,
17 the “invention” was nothing more than a simple look-up from an existing database, for which reading a phone
18 book was an analogy. *Id.* The trivial concept of reading a phone book does not even begin to prove that “the
19 claimed steps can be performed as a mental process”. (See Motion at p. 12).

20 There is also no evidence of record that switchboard operators needed anything other than a callee
21 identifier to route a call, let alone evidence of any plausible scenario in which an operator would have needed
22 to evaluate, based a caller’s *profile* settings, the intended destination represented by a called number as
23 relating to any one of *multiple* disparate networks, one of which was *external* and required routing through
24 a *gateway*. In contrast, the asserted claims recite that a caller’s profile settings (attributes) are used to evaluate
25 a callee identifier to determine and route to the destination on the *appropriate* communication network. See
26 *Intellectual Ventures II LLC, v. BITCO General Insurance Corp.*, Case No. 6:18-cv-00298, 00299, 2019 WL

27 ²³ VoIP-Pal is left guessing as to what scenario the Motion is even alleging. If a caller was calling long-
28 distance, the “dialed number” or spoken destination would reflect that fact. VoIP-Pal cannot respond to
incomplete or incoherent arguments by the Defendants with no underlying factual record.

1 313207, *4 (E.D. Tex. Jan. 24, 2019).²⁴

2 Defendants next grasp at a “corporate mailroom” analogy to argue that the asserted claims are
3 “abstract” as being directed to “longstanding fundamental practices for organizing human activity.” (*See*
4 *Motion* at pp. 12-13). As in *Symantec*, in which the Court analogized the claims of the subject ‘142 patent to
5 a “corporate mailroom” taking action “based on attributes of the correspondence,” Defendants assert that
6 VoIP-Pal’s claims can be analogized to outgoing letters in a mailroom. *Id.* The analogy is unavailing. First,
7 neither the Court’s mailroom analogy in *Symantec* nor the impugned claims recite anything akin to VoIP-
8 Pal’s asserted claims. The *Symantec* court cited an example involving “gat[ing] an e-mail for further review
9 for any e-mail message that is addressed to the president of the company.” *Intellectual Ventures I LLC v.*
10 *Symantec*, 838 F.3d 1307, 1317, FN 10 (Fed. Cir. 2016) (citing the ‘142 Patent at col. 3, ll. 45-48). This
11 decision taken is based on *to whom* the e-mail is addressed. There is no need to decide *to whom* the e-mail is
12 addressed, just what to do about it. There is no need to decide the network location of the president—it is
13 known. Evaluating e-mail “attributes,” as in *Symantec*, is neither analogous to, nor used in the same manner
14 or for the same purposes as the “*plurality of first participant attributes*” recited in, *e.g.*, claim 1, of the ‘002
15 Patent, which are, *inter alia*, “*obtained from a user profile for the first participant,*” and used as a basis for
16 identifying and classifying the first participant’s intended destination, as between two distinct networks, for
17 an initiated communication. Second, in *Symantec*, not only did the patentee admit that the specification of
18 the ‘142 Patent described its claimed method as long prevalent in the brick and mortar corporate world, but
19 the plaintiff there *expressly* informed the district court that its e-mail processing method was
20 “[c]onceptually... not much different than a United States Postal Service office.” *Id.* There is no brick-and-
21 mortar analog here.

22 Defendants also cite a further analogy from *Symantec*, relating to the ‘050 Patent at issue in that case,
23 in which the court analogized filtering unwanted emails to the “long-prevalent practice” of discarding letters
24 without opening them. *Symantec* at 1314, FN 6 (quoting *Jones v. Flowers*, 547 U.S. 220, 248 (2006)
25 (Thomas, J. dissenting) (“[I]t is common for ‘an occupant who receives generically addressed mail [to]
26 discard it as junk mail’.”). But to discard mail because it is generically addressed (*e.g.*, “To: occupant”) is

26 ²⁴ For example, ‘002 Patent Claim 1 recites “*locat[ing] a plurality of first participant attributes*” which are
27 “*obtained from a user profile for the first participant*” and used to “*produce a new second participant*
28 “*identifier*” for classifying the communication and “*producing a [‘system’ or ‘external network’] routing*
“*message identifying an Internet address*” “*associated with the second device*” or “*associated with a gateway*
“*to an external network,*” depending on the classification, thereby “*caus[ing] the communication... to be*
“*established*”. The claim allows the callee identifier to potentially identify a destination on either the private
or public network. (*See* Malek Decl., Exhibit 4 (‘002 Patent) at col. 37 ll. 30 to col. 38 ll. 2)).

1 merely to decide based on the *recipient address alone*; it requires no knowledge of the sender, let alone use
2 of “attributes” obtained from a “profile” associated with the sender.

3 Defendants’ reliance on such a poor analogy is astounding. In a corporate mailroom, mailing
4 decisions can be made based on recipient address *alone*. Even if no return address is listed on mail, it is
5 delivered based on the “To:” address. Defendants present no evidence or explanation as to why a destination
6 address on the mail would not *itself* contain the information needed for mailing, let alone attempting to
7 explain how *other* limitations of VoIP-Pal’s claims are met in this strained analogy. Ironically, the failure of
8 Defendants’ “mailroom” and “operator” analogies actually serves to reinforce VoIP-Pal’s position that its
9 inventions do *not* practice or pre-empt any known “brick-and-mortar” practice.

9 **D. Step 2. The Asserted Claims Recite Inventive Concepts That Are Patent Eligible**

10 As explained *supra*, the claims are not directed to an abstract idea, thus the Motion must be denied.
11 Under Step 2 of the *Alice* analysis, the claims also recite *inventive concepts*, providing yet another ground
12 for denial of Defendants’ Motion. *See, e.g., DDR Holdings LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257
13 (Fed. Cir. 2014); *Bascom Global Internet Servs., Inc. v. AT&T Mobility, LLC*, 827 F.3d 1341, 1349 (Fed.
14 Cir. 2016). In determining whether there is an “inventive concept” in a claim, courts must “consider the
15 elements of each claim both individually and ‘as an ordered combination’.” *Alice*, 134 S. Ct. at 2355; *see*
16 *also Berkheimer v. HP, Inc.*, 881 F.3d 1360, 1370 (Fed. Cir. 2018); *Amdocs (Israel) Ltd. v. Openet Telecom,*
17 *Inc.*, 841 F.3d 1288, 1318 (Fed. Cir. 2016).

18 Step two is related to step one in that the claims are reviewed to determine if the integration of the
19 [step one] ineligible concept with the “additional elements” of the claim supplies an “inventive concept.”

20 To answer that question, we consider the elements of each claim ***both individually and as an***
21 ***ordered combination*** to determine whether the ***additional elements transform*** the nature of the
22 claim into a ***patent-eligible application***.”

23 *Alice*, 134 S. Ct. at 2355 (emphasis added)(citations and quotations omitted).

24 But the claims must be reviewed “***as a whole***” (not dissected) to determine if the *integration* of the
25 ineligible concept with the “additional elements” supplies an “inventive concept.” In *Diehr*, “the overall
26 process [was] patent eligible because of the way the ***additional steps*** of the process ***integrated*** the [patent-
27 ineligible] ***equation*** into the process ***as a whole***.” *Mayo*, 132 S. Ct. at 1298 (emphasis added) (citing *Diamond*
28 *v. Diehr*, 450 U.S. 175, 187). *Alice* at 2355, footnote 3 (emphasis added), stated “Because the approach [the
Court] made explicit in *Mayo* considers ***all*** claim elements, both ***individually*** and ***in combination***, it is
consistent with the general rule that patent claims ‘***must be considered as a whole***.’” *Id.* citing (inter alia)

1 *Diehr*, 450 U.S. at 188 (“claims must be considered as a whole, it being inappropriate to dissect the claims
2 into old and new elements and then to ignore the presence of the old elements in the analysis.”). Defendants’
3 argument focuses on dissecting the claim into pieces, alleging that each of the individual pieces is “generic”,
4 not “unique”, not “inventive” or “conventional” without any evidentiary support (Motion at pp. 17-19) and
5 then, in analyzing the “ordered combination.” This cannot fulfil the actual requirements of *Alice* for the “step
6 two” enquiry, to consider the integration of the “additional elements” as to whether they transform the claim
7 “as a whole”.

8 (1) *Providing Profile-Based, User-Specific Access to Communication Routing Integrated*
9 *Across the Infrastructure of Two Distinct Networks Is Unconventional*

10 *All* of the asserted claims include at least the *inventive concept* of: utilizing user-specific profile
11 settings (e.g., “attributes” associated with an originating first participant in a communication) to evaluate a
12 “second participant identifier” to identify an intended destination (as between two interconnected networks)
13 and an appropriate routing “address” to reach that destination in a “routing message”, to establish routing of
14 the communication to the destination using the identified network infrastructure (i.e., an address in a system
15 network associated with the second participant or of a “gateway” to an external network). *See* FAC at ¶ 40.
16 (Some of the asserted claims provide *additional* inventive concepts that claim 1 of the ‘002 patent does not
17 represent: *see supra*; FAC at ¶¶31-39.)

18 Defendants do not refute VoIP-Pal’s asserted “inventive concepts”. Rather, they simply allege that
19 the “ordered combination” is “conventionally ordered steps” and “conventional technology.” Motion at 19-
20 20. However, even if (*arguendo*) the claim elements were “generic”, “conventional” or known, Defendants’
21 argument is fundamentally flawed. Defendants fail to analyze whether the claims, *as a whole*, contain a “non-
22 conventional and non-generic arrangement of known, conventional pieces.” *BASCOM Glob. Internet Servs.,*
23 *Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349-1350 (Fed. Cir. 2016). As in *BASCOM*, a patent-eligible
24 “arrangement” is not *limited* to the issue of “order of steps”. Numerous cases demonstrate that an
25 unconventional arrangement or combination of even generic or conventional elements can provide an
26 inventive concept under § 101. *See, e.g., the DDR, BASCOM, and Amdocs cases, cited supra; Avocent*
27 *Huntsville, LLC v. ZPE Sys., Inc.*, No. 3:17-CV-04319-WHO, 2018 WL 1411100, at *1, 7-9 (N.D. Cal. Mar.
28 21, 2018) (claims reciting generic components found to contain sufficient inventiveness for eligibility).
Courts have found claims involving communication and internet technology to be eligible where, as here,

1 the inventions constituted unconventional solutions to technological problems. *See, e.g., Meetrix IP, LLC v.*
2 *Citrix Systems, Inc.*, Case No. 1-16-cv-1033-LY, 2017 WL 5653950, *3 (W.D. Tex. July 27, 2017). In
3 *Meetrix IP*, the claims were eligible notwithstanding “the use of generic components, including PSTN, VoIP,
4 IP, and VPN” because the limitations worked together to operate in an unconventional manner. *Id.*

5 Thus, Defendants’ analysis of the “ordered combination” is non-existent. It does not consider the
6 claims “as a whole,” nor does it attempt to consider whether the “additional elements” in the claims, vis-à-
7 vis the alleged “abstract idea” in *Alice* step one—are integrated into a patent-eligible application, i.e., there
8 is no analysis of the “way the *additional steps* of the process [are] *integrated* [with the patent-ineligible
9 abstract idea] into the process *as a whole*” *Mayo*, 132 S. Ct. at 1298. Indeed, all claim elements which are
10 not intrinsic to the step one “abstract idea” should have been analyzed as to whether they provide a patent-
11 eligible application of the idea in the claim “**as a whole**”. *See Elec. Power Group LLC v. Alstom S.A.* 830
12 F.3d 1350 at 1353; *Mayo*, 132 S. Ct. at 1298; *Ameranth, Inc. v. Genesis Gaming Solutions, Inc.* 2014 U.S.
13 Dist. LEXIS 175600 *18 (holding that any “[s]teps that could be omitted while leaving intact [the ineligible
14 abstract idea of step one]” should have been addressed by Defendants under step two.”). Here, they were
15 not. Defendants have failed to carry their burden. Defendants’ rely on *Two-Way Media* as demonstrating
16 that the combination of retrieving, processing data, and making a determination is conventional and not
17 patent-eligible. This argument transforms the *Alice* framework into a farce. If the claims fail Step 2 because
18 they retrieve data, analyze it and make a determination based on the analysis, ***by this standard, every single***
19 ***computer-implemented (software) invention would fail Alice Step 2.*** Defendants have simply described a
20 computer at work.²⁵ But this violates statute (§ 101 does not exclude routing inventions) and ignores the
21 Constitutional imperative underlying patent law “to promote the Progress of Science and the useful Arts.”
22 U.S. Const. art. I, § 8, cl. 8. In effect, Defendants find fault primarily because claim elements can be
23 implemented on a non-proprietary computer, *i.e.*, by software.

24 Defendants also assert that the “ordering” of the claim elements “follows from and is inherent to...
25 the abstract idea of where to route a communication.” Motion at 20:24-27. This conclusion is falsified by
26 *many* examples of communication technology (e.g., prior art PSTN, VoIP, and PBX systems) set forth in the
27 FAC: clearly, ***none*** of the cited prior art examples used the claimed method of routing, yet ***each***

28 ²⁵ *See, e.g.*, proffer of evidence set forth in Mangione-Smith Decl. at ¶¶ 34-40 (explanation of computer implemented features).

1 “determin[ed] where to route a communication” in some fashion. Moreover, the claims are not limited to
2 overbroad “abstract idea of determining where to route a communication”—again, *prima facie* evidence of
3 Defendants stripping out elements to oversimplify the claims “as a whole”. *See Comcast Cable*
4 *Communications, LLC v. Sprint Communications Co., LP*, 203 F. Supp. 3d 499 (E.D. Pa. 2016) (holding that
5 even if a claim was directed to the abstract idea of “matching identifiers to retrieve information,” under “step
6 two” of *Alice*, the claims recited sufficient additional content to transform the claims, which did not pre-empt
7 all implementations of the alleged abstract idea).

8 Defendants’ analysis of individual claim elements is also flawed. Defendants allege that certain
9 information (e.g., telephone numbers) was known. Motion at 17-19. From this, Defendants infer that *all* the
10 processing in the claims was not known, “unique” or inventive, which is a *non sequitur*. Defendants’ only
11 proof is restricted to citing a few short quotations that do not do justice to the full scope of the patent’s
12 disclosure. (Curiously, Defendants spend no time analyzing the detailed processes shown in Figs. 8A-8D.)
13 Defendants’ argument that a simplistic method of “blocking” [messages] not inventive in *Intellectual*
14 *Ventures I LLC v. AT&T Mobility LLC* is unavailing because it trades on isolating a claim element from its
15 integration into the context of *particular* claims “as a whole.” For example, “blocking” of content was held
16 to be patent-ineligible in a *different* technological context in *BASCOM*. The argument is not dispositive.
17 Defendants conclude that all the claimed features are part of “conventional telephony systems,” without a
18 shred of evidence. Motion at 19. VoIP-Pal rejects this allegation, which gives rise to a factual dispute.

19 Whether the “ordered combination” was unconventional thus becomes a factual issue which, at this
20 point in the proceedings, cannot be proven by Defendants. Defendants’ are asking this Court to accept their
21 unsupported assertions, while ignoring or glossing over the concrete and well-supported factual assertions in
22 the FAC—***backed by a proffer of expert evidence***—factual assertions that must be viewed in the light most
23 favorable to the VoIP-Pal. For example, VoIP-Pal has set forth various branches of communication
24 technology and their limitations—overcome by the claimed inventions and has asserted what was considered
25 “well-understood, routine and conventional” by persons of ordinary skill in the field of the invention. *See,*
26 *e.g.*, FAC at ¶¶ 15-20, 28, 32, 35-38 (describing limitations of PSTN technology overcome by the inventions),
27 ¶¶ 21-23 (describing limitations of VoIP technology overcome by the inventions), ¶¶ 24-25, 29-30, 33-34,
28 37-38 (describing limitations of PBX technology overcome by the inventions), ¶¶ 21-23, 26, 40 (describing
the challenges of integrating VoIP communication networks with external communication networks such as

1 PSTN), ¶¶ 31-38 (describing inherently computer-implemented features for solving problems rooted in
2 computer network technology, and explaining how these improvements are captured in some or all of the
3 asserted claims); ¶¶ 30, 32, 36, 38, 40 (providing examples of unconventional features captured by the
4 asserted claims); ¶ 23 (describing real-world testing of the patented inventions); and ¶ 39 (describing
5 availability of numerous other routing methods to show that the patented inventions do not pre-empt the field
6 of the invention). At this early stage of proceedings, this material necessarily forms the baseline for both
7 steps of the *Alice* framework. VoIP-Pal asserts that the claims are a *unconventional* solution to technology-
8 based problems in routing and integration of distinct communication networks. Profile settings (“attributes”)
9 associated with the first participant are applied to provide customizable, user-specific access to a system
10 integrating routing infrastructure across of two distinct networks. (*See, e.g.*, Malek Decl. at Exhibit 1 (‘762
11 Patent) at Figs. 1, 8A-D, 9-12, col. 13 ll. 20 – 67 and col. 19 ll. 38 – 50).

12 User-specific customization of network functionality has been recognized as a technological
13 improvement eligible under 35 U.S.C. §101. *Bascom Global Internet Servs., Inc. v. AT&T Mobility, LLC*,
14 827 F.3d 1341, 1350 (Fed. Cir. 2016). *Bascom* found claims for Internet filtering at “a specific location,
15 remote from the end-users, with customizable filtering features specific to each end user”—in lieu of a “one-
16 size-fits-all filter”—to be unconventional and eligible. Internet-based filtering methods were already known
17 before *BASCOM* (*see* 827 F.3d at 1344); but *BASCOM* customized filtering for each user. As in both *Bascom*
18 and *DDR*, the specification discloses (and the claims recite) a “technology-based solution... overcom[ing]
19 existing problems” with prior PSTN and VoIP systems. *Bascom* at 1351; *DDR Holdings* at 1257. The claims
20 do not preempt an abstract idea because they recite a particular method of evaluating a callee identifier to
21 determine and route to the intended destination, as between two networks. Other routing methods are
22 available to all.²⁶

23 With regard to blocking, for example, some of the asserted claims recite an inventive concept of:
24 applying criteria from a caller’s profile settings, to make a *caller-specific* determination as to whether an
25 initiated communication is destined for a first network, a second external network, or is invalid according to
26 this caller’s profile settings; and, e.g., if the communication is invalid, producing an error message for a call
27 controller. (*See* Malek Decl. at Exhibit 1 (‘762 Patent) at claim 6). This inventive concept not only provides
28 *user-specific customization* of classification of an intended routing destination as between two networks, it

²⁶ Indeed, VoIP-Pal patents have overcome eight IPR’s asserting routing prior art, as described *supra*, in addition to volumes of routing prior art that were considered by the USPTO during prosecution.

1 also it also allows *user-specific* evaluations of whether each particular call is valid (*e.g.*, to identify violations
2 of a user-specific dialing rule, based on user-specific profile “attributes”), which was not conventionally done
3 in PSTN nodes.²⁷ A still further inventive concept recited is: in response to initiation of a communication by
4 a caller to a callee, applying caller-specific criteria from the caller’s profile settings to identify a callee profile
5 associated with the callee, and based on the callee’s profile settings, identify a network element (*e.g.*,
6 communication node) capable of carrying a communication to the callee in a routing message, to
7 transparently carry the communication to the callee. (*See, e.g.*, Malek Decl. at Exhibit 2 (‘330 Patent) claims
8 1 and 14).²⁸

9 Routing controllers which are capable of providing customized service to different users in the
10 manner described, and to integrate this service over two networks, are an improvement over the art. *See*
11 *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1262 (Fed. Cir. 2017); *see also Alice*, 134 S. Ct. at
12 2355; *see also Fitbit, Inc. v. Aliphcom*, 233 F. Supp. 3d 799, 811-12 (N.D. Cal. 2017). *Compare*
13 *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1326 (Fed. Cir. 2017) (invalidating claims because they
14 were nothing more than coding and decoding image data using a mathematical formula).²⁹ Here, the claims
15 do not merely code and decode data; the invention of the Patents-in-Suit improve the routing of a
16 communication over distinct networks as explained herein.

17 (2) *The Claimed Solution Solves Problems Rooted in Computer Network Technology.*

18 The claims solve problems necessarily rooted in network technology and so are eligible for the same
19 reason that the claims in *DDR Holdings* were found eligible by the Federal Circuit. *DDR Holdings*, 773 F.3d
20 at 1245, 1257. As in *DDR*, the asserted solve problems specific to the realm of computer-based
21 communication networks in a way that is rooted in computer technology.³⁰ *DDR Holdings* at 1257. The
22

23 ²⁷ *See also, e.g.*, proffer of evidence set forth in Mangione-Smith Decl. at ¶ 31 (caller specific blocking is
24 unconventional) and ¶ 33.

25 ²⁸ *See also* Mangione-Smith Decl. at ¶ 44 (claim 1 of the ‘002 Patent is not representative).

26 ²⁹ The remainder of the cases cited by Defendants are all easily distinguished. *Compare MyMail, Ltd. v.*
27 *ooVoo, LLC*, 313 F. Supp. 3d 1095, 1112 (N.D. Cal. 2018) (finding that nothing in the claims or specification
28 suggests that the claims produce a result that overrides the routine and conventional sequence of events for
updating software on a computer); *Personalized Media Commc'ns, LLC v. Amazon.Com, Inc.*, 161 F. Supp.
3d 325, 333 (D. Del. 2015), (asserted claims directed to abstract idea of decryption and are devoid of any
inventive concepts); *Audatex N. Am., Inc. v. Mitchell Int'l, Inc.*, 703 F. App'x 986, 990 (Fed. Cir. 2017)
 (“[w]hen viewed as an ordered combination, the proposed claims recite no more than the sort of “perfectly
conventional” generic computer components employed in a customary manner that we have held
insufficient to transform the abstract idea into a patent-eligible invention”).

³⁰ *See, e.g.*, proffer of evidence in Mangione-Smith Decl. at ¶¶ 15-31, 33, 37-38 and 40.

1 claims specify how interactions with a communication system “are manipulated to yield a desired result...
2 that overrides the routine and conventional sequence of events ordinarily triggered”, in the instant case, by
3 initiating a communication (e.g., dialing a telephone number). *Id.* at 1258. Also instructive is the case of
4 *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1306 (Fed. Cir. 2016). In *Amdocs*, the solution
5 required arguably generic components, including generic network devices. But when the Court reviewed the
6 specification, it found these generic components worked together in an unconventional manner to improve
7 the system. *Id.* (finding eligibility where the claims “describe[d] a specific, unconventional technological
8 solution narrowly drawn to withstand preemption concerns, to a technological problem”); *see also Messaging*
9 *Gateway Sols., LLC v. Amdocs, Inc.*, No. CV 14-732-RGA, 2015 WL 1744343, at *6 (D. Del. Apr. 15, 2015)
10 (the asserted claim “is firmly rooted in technology and is addressed to a specific problem arising in the realm
11 of mobile device-to-Internet communication.

12 **E. Numerous Factual Disputes Show This Rule 12(b)(6) Motion is Premature.**

13 Alternatively, Defendants’ Motion to Dismiss under 35 U.S.C. § 101 should be denied as premature
14 for the reasons set forth through this brief. Given that the Motion is brought with a limited record under Fed.
15 R. Civ. P. 12(b)(6), VoIP-Pal submits the Mangione-Smith Declaration as a proffer of evidence and notes
16 that the material is being submitted for illustrative purposes and is not intended to convert the Motion into a
17 Fed. R. Civ. P. 56 motion for summary judgment. *See, e.g., Geinosky v. City of Chicago*, 675 F.3d 743, FN
18 1 (2012). If provided the opportunity to engage in discovery, VoIP-Pal would elicit evidence to show that
19 the recited invention provides specific technological improvements to routing systems and controllers; that
20 the claims recite these improvements; provide explanation and evidence concerning the various factual
21 disputes (referenced hereinabove) arising from Defendants’ motion; establish how VoIP-Pal’s patents differ
22 from what was “well-known, routine and conventional” in the art; and show that VoIP-Pal’s communication
23 system and routing controllers are inherently computer based and, indeed, are required to be in order to
24 address problems rooted in computer network technology.³¹ The Federal Circuit has made clear that many
25 inquiries in a § 101 analysis are deeply factual and not ripe for adjudication on an undeveloped record.
Berkheimer v. HP Inc., 881 F.3d 1360, 1369 (Fed. Cir. 2018).

26 **IV. CONCLUSION**

27 Plaintiff respectfully requests that Defendants' Motion to Dismiss be denied.

28 ³¹ *See, e.g.*, proffer of evidence set forth in Mangione-Smith Decl., generally; *see also* Malek Decl. at Exhibit
5 (Declaration of William Mangione-Smith made of record in IPR IPR2016-01201 brought by Apple, Inc)
generally.

1 New York, New York

2 June 20, 2019

Respectfully submitted,

3
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing CORRECTED PLAINTIFF VOIP-PAL'S OPPOSITION TO DEFENDANTS' CONSOLIDATED MOTION TO DISMISS has been served on June 20, 2019, to all counsel for Defendant through the Court's CM/ECF system.

/s/ Kevin N. Malek