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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.

Petitioner,

v.

VOIP-PAL.COM INC.,

Patent Owner

Case No. IPR2016-01082
U.S. Patent 8,542,815

PATENT OWNER'S PRELIMINARY RESPONSE

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Pursuant to 35 U.S.C. § 313, 37 C.F.R. § 42.107 and the Notice of Filing Date Accorded to Petition (Paper 3), dated **May 26, 2016**, Voip-Pal.com, Inc. ("Voip-Pal") hereby timely submits this Preliminary Response to the Petition for *Inter Partes* Review of U.S. 8,542,815 (the '815 Patent) (Paper 1) filed on May 24, 2016 by Unified Patents Inc. ("Unified").

I. INTRODUCTION

Petitioner challenges Claims 1, 2, 7, 27, 28, 29, 34, 54, 72, 73, 74, 92, 93 and 111 of the '815 Patent on two grounds:

1. Petitioner alleges anticipation under § 102(e) by U.S. Patent No. 7,218,722 B1 Ex. 1003 ("Turner").

2. Petitioner alleges obviousness under § 103(a) over U.S. Patent No. 6,961,334 B1 Ex. 1004 ("Kaczmarczyk") in view of Turner.

Petitioner also submitted a Declaration by declarant Michael Caloyannides Ex. 1002 ("Declaration").

As Voip-Pal explains below, Petitioner's arguments and assessments of the cited art with respect to the '815 Patent claims fail to establish a reasonable likelihood that Petitioner would prevail as to its asserted grounds, as required under 35 U.S.C. § 314(a). As such, institution of this proceeding should be denied as to both asserted grounds.

II. ARGUMENT

A. Introduction to Claimed Subject Matter

The Petition has focused its analysis on Claim 1, which recites:

1. [1p] A process for operating a call routing controller to facilitate communication between callers and callees in a system comprising a plurality of nodes with which callers and callees are associated, the process comprising:

[1a] in response to initiation of a call by a calling subscriber, receiving a caller identifier and a callee identifier;

[1b] locating a caller dialing profile comprising a username associated with the caller and a plurality of calling attributes associated with the caller;

[1c] determining a match when at least one of said calling attributes matches at least a portion of said callee identifier;

[1d] classifying the call as a public network call when said match meets public network classification criteria and classifying the call as a private network call when said match meets private network classification criteria;

> [1e] when the call is classified as a private network call, producing a private network routing message for receipt by a call controller, said private network routing message identifying an address, on the private network, associated with the callee;
>
> [1f] when the call is classified as a public network call, producing a public network routing message for receipt by the call controller, said public network routing message identifying a gateway to the public network.

By way of technology background, a public switched telephone network (PSTN) uses traditional telephone technology including dedicated telephone lines from a service provider to transmit calls over a circuit-switched network. Voice over Internet protocol (VoIP) is used for the delivery of voice communications and multimedia sessions over Internet protocol (IP) networks, such as the Internet. Digital information is packetized, and transmission occurs as IP packets over a packet-switched network.

The method of Claim 1 is directed to telecommunications call routing. The routing method allows a call to be classified and routed as a "public network call" or as a "private network call" based on whether a match of at least one calling attribute and at least a portion of the callee identifier, meets certain network criteria. For example, when a caller initiates a call to a callee the call may be

routed to PSTN, e.g., traditional circuit switched network, or to Internet networks, e.g., a packet switched network, based on a calling attribute *matching* at least a portion of callee information. The method of Claim 1 does not evaluate the callee identifier in isolation, but interprets the callee identifier based on attributes in the caller's dialing profile. The caller dialing profile including a plurality of calling attributes, at least one of which is matched with at least a portion of a callee identifier, is utilized to establish whether the call meets network classification criteria based on the *match*.

Turner discloses a system for routing calls locally and remotely within a type of IP network called a Virtual Private Network (VPN) and also externally to the PSTN. However, claim element [1c], "determining a match when at least one of said calling attributes matches at least a portion of said callee identifier," is not shown by the Petition to be present in Turner. The Petition merely makes a statement that: "Turner discloses the call agent analyzing a caller address, callee address, and information about the addresses such as associated network locations to determine whether the caller and callee are connected to the same gateway or in the same location." Petition at 24.

Kaczmarczyk discloses a communications network and a call routing system. The system provides call connectivity between a PSTN network and an IP network as shown in FIG. 1. Two scenarios are described: the flow of FIG. 4A

illustrating calls originating in the IP network and terminating in the PSTN, and the flow of FIG. 4B illustrating calls originating in the PSTN network and terminating in the IP network. However, claim element [1d], "classifying the call as a public network call when said match meets public network classification criteria and classifying the call as a private network call when said match meets private network classification criteria," is not shown by the Petition to be present in Kaczmarczyk because how the decision is made to route to a particular kind of network is not disclosed.

Turner and Kaczmarczyk, whether taken alone or in combination, fail to disclose or even suggest the method of call classification and routing recited in Claim 1. This Preliminary Response shows that the Petitioner's arguments fail for the following reasons:

(a) The Petition mischaracterizes the disclosure of Turner in asserting that it discloses all elements of the claims. The routing decisions in Turner are not made by "determining a match" as recited in Claim 1, which is thus not anticipated. Furthermore, Turner's intra-gateway and inter-gateway call recognition feature does not involve classifying and routing the call as a "public network call" or a "private network call." The Petition also conflates together distinct features of Turner's system as if these distinct features were seamlessly

used together. But the Petition fails to establish that these distinct features are used in Turner in the same manner as arranged in the claims.

(b) The Petition admits that the Kaczmarczyk reference is deficient and relies on Turner to remedy Kaczmarczyk's deficiencies for *each* of claim elements [1d], [1e] and [1f]. However, Kaczmarczyk never discloses ***how*** the decision is made to route to a particular kind of network (*e.g.*, PSTN or IP-based). Kaczmarczyk's disclosure of call routing is limited to scenarios where the destination network is known. Thus, Kaczmarczyk fails to disclose public and private "network criteria" for classifying and routing a call as claimed. Turner doesn't cure this deficiency because it similarly fails to disclose classifying and routing the call as a "public network call" or a "private network call" as recited in Claim 1.

(c) The Petition states that the combination of Kaczmarczyk with Turner would have been obvious but provides minimal and conclusory reasoning as to *why* one of ordinary skill would have combined the references. Petitioner's proposed combination relies on a multiplicity of teachings from Turner, but fails to explain how these would have been combined into Kaczmarczyk's system. Petitioner also fails to explain how major differences in Kaczmarczyk's and Turner's methods could be reconciled. Thus, the Petition fails to articulate a

proper reason to combine the known elements in the fashion claimed by the patent at issue, as required by *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

B. The Petition and Declaration are flawed and inadequate

The petitioner has the burden of providing and explaining "with particularity" the specific evidence that allegedly supports each of the petition's challenges of the claims. 35 U.S.C. § 312(a)(3). A petition must construe the claims, identify "[h]ow the construed claim is unpatentable," and identify "specific portions of the evidence that support the challenge." 37 C.F.R. § 42.104(b)(3)-(5). The petition must also include a "full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence." 37 C.F.R. § 42.22(a)(2).

As discussed below, the Petition and Declaration fall well below the bar of legal requirements. First, the Petition was submitted with a Declaration that is nearly a carbon copy of the Petition, and therefore is entitled to no weight. Second, the Petition's proposed claim constructions are devoid of any analysis, and fail to meet the requirements of 37 C.F.R. § 42.104(b)(3). Third, **only** the Petition's claim charts address the claim language and attempt to link the claim language to the cited art to explain "[h]ow the construed claim is unpatentable," but those explanations are terse and insufficient.

The failures of the Petition are not inconsequential. As explained in subsequent sections *infra*, these shortcomings of the Petition and Declaration belie the insufficiencies of the references to render the claims unpatentable.

1. The Declaration Is Simply A Copy Of The Petition, And Should Be Accorded No Weight

The declaration of Dr. Caloyannides (Ex. 1002), submitted by Petitioner, mirrors the corresponding text from the Petition and provides no additional facts or analysis to support the grounds of rejection beyond the attorney arguments in the Petition. In fact, the substantive portions of the Caloyannides declaration are near verbatim copies of the Petition. Ex. 2001 submitted herewith illustrates just one example of the mirroring of text from the Petition in the Caloyannides declaration, with the differences shown in mark-up. Indeed, pages 15-20 and 34-40 of the Petition are nearly identical to paragraphs 36-46 and 48-59 of the Caloyannides declaration. Similarly, the Caloyannides declaration (at pages 49-65 and 67-84) wholesale adopts the Petitions' claim charts (at pages 20-34 and 40-56, respectively) without adding any further analysis or explanation of how the asserted passages from the references meet the elements recited in the claims.

"Merely repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value." *Kinetic Techs., Inc. v. Skyworks Solutions, Inc.*, IPR2014-00529, Paper 8 at 15 (P.T.A.B.

Sept. 23, 2014); *see also InfoBionic, Inc. v. Braemer Mfg., LLC*, IPR2015-01704, Paper 11 at 6 (P.T.A.B. Feb. 16, 2016) (finding expert declaration unpersuasive when it "repeats the Petitioner's arguments and offers little or no elaboration").

Because the relevant portions of the Petition and the Caloyannides declaration are near verbatim copies, the citations to the Caloyannides declaration do not add to the Petition's attorney arguments. Accordingly, Patent Owner requests that the Board accord little or no weight to the Caloyannides declaration. Further, Patent Owner's analysis *infra* of the proposed grounds addresses the Petitioner's arguments without separately addressing Dr. Caloyannides's nearly identical Declaration.

2. <u>The Petition's Claim Constructions Are Devoid Of Explanation</u>

The Petition presents ten proposed constructions of claim terms, eight of which are asserted means-plus-function constructions of terms in Claims 28, 34, 93, and 111. Paper 1 at 10-15. Each of these eight means-plus-function constructions are formulaic and lack any analysis. They consist of two sentences: a recitation of the claim language, and an equivocal sentence pointing to the specification ("the specification may provide the following structure"). *Id.* at 12-15. 37 C.F.R. § 42.104(b)(3) requires construction of means-plus-function language in claims. The Petition provides no explanation for how the cited portion of the specification meets the respective alleged means-plus-function construction,

or for why it is uncertain whether or not that cited portion of the specification meets the respective alleged means-plus-function construction. The Petition is required under 35 U.S.C. § 312(a)(3) to present its arguments "with particularity." The Petition's two-sentence equivocal constructions fall short of this requirement.

Voip-Pal does not address the merits of Petition's claim construction arguments at this time. However Voip-Pal does not acquiesce to the Petition's asserted constructions, and Voip-Pal reserves the right to present its claim construction positions later in this proceeding, if appropriate.

3. The Claim Charts Fall Well Below the Requirement to Explain Its Ground of Unpatentability "With Particularity"

The entirety of Petitioner's attempting to link each element of Claim 1 to Turner's disclosure is found in the claim charts. Patent Owner understands that under the present Rules of practice, it is not improper to include arguments in the claim charts. However, the present Rules cannot be read in a manner that excuses Petitioner from meeting their burden of providing a meaningful explanation with particularity as to the grounds for challenging each claim.

Congress requires that petitions identify, "with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim . . ." 35 U.S.C. § 312(a)(3). The Board has further provided that a petition must identify "[h]ow

the construed claim is unpatentable under the statutory grounds identified" and "where each element of the claim is found in the prior art," and must explain the "relevance of the evidence to the challenge raised . . ." 37 C.F.R. § 42.104(b); *see also* 37 C.F.R. § 42.22(a)(2) (a petition must include a "full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence").

The Petition's claim charts fail to meet these requirements.

The Petition's first claim chart is directed to Ground 1 (Alleged Anticipation by Turner). For each element of Claim 1, the claim chart provides a few lines of argument followed by large block quotes from assorted portions of Turner. For example, regarding element 1b, the claim chart provides six lines of argument followed by over two pages of citations to Turner that jump from FIG. 3 to FIG. 1 and jump from column 7 to column 9, to column 10, then back again to column 7, then to column 17, and eventually to column 21. Paper 1 at 21-24. Similarly, for element 1c, the claim chart jumps back and forth throughout Turner with almost no explanation for how these reassembled portions of Turner constitute an anticipatory disclosure. *Id.* at 24-26.

On its face, the claim chart fails to establish anticipation because it fails to explain how these multiple, distinct teachings represent a single anticipatory disclosure. "[I]t is not enough that the prior art reference . . . includes multiple,

distinct teachings that the artisan might somehow combine to achieve the claimed invention." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). Further, the claim chart fails to meet Congress's requirement under 35 U.S.C. § 312(a)(3), and the Board's requirements under 37 C.F.R. § 42.104(b) and § 42.22(a)(2) to provide sufficient explanation of how Turner renders the claims unpatentable. The Petition leaves to the Board and to Patent Owner the work of independently reviewing and understanding the various cited portions of Turner, and then evaluating whether or not these cited portions are arranged in a manner that constitutes an anticipatory disclosure of the claims. It is neither the Board's nor Patent Owner's responsibility to remedy the inadequacies of a Petition that fails to meet the statutory requirements of asserting its unpatentability grounds "with particularity." *A.C. Dispensing Equipment Inc. v. Prince Castle LLC*, IPR2014-00511 (PTAB Sep. 10, 2014) (Paper 16 at 4-5) ("Petitioner should not expect the Board to search the record and piece together the evidence necessary to support Petitioner's arguments.")(citing *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999)).

Moreover, as detailed in sections *infra*, these inadequacies of the claim chart mask the fact that Turner's disclosure does not anticipate the claims, and Petitioner's presentation of Turner glosses over important distinctions between Turner's disclosures and Claim 1.

Even more egregious than the shortcomings of the claim chart in discussing Claim 1, the claim chart's explanation for all other claims is nearly non-existent. The Petition asserts that 6 independent claims and 14 total claims are anticipated. These various claims are directed to different concepts using different language. Yet the claim chart nearly exclusively incorporates by reference its analysis of Claim 1 for the other claims without addressing the subject matter encompassed by those claims or the language used in those claims to explain how the analysis for Claim 1 can be identically applied to anticipate those claims. Even independent claims are attacked solely by incorporation by reference to the analysis of Claim 1 without explanation.

The Board has held that such practice is insufficient to carry Petitioner's burden: "As the Federal Circuit has made clear, the Board cannot rely on conclusory statements by Petitioner that the same analysis applies without further explanation; rather, Petitioner must present 'particularized arguments explaining why its arguments . . . would be cross-applicable.' . . . Thus, in this case in light of the differences in the claim language, Petitioner's conclusory statements implying that the same analysis for claim 1 also applies to independent claim 17 do not satisfy Petitioner's burden to demonstrate obviousness." *Nautilus Hyosung Inc. v. Diebold Inc.*, Case IPR2016-00633 (PTAB Aug. 22, 2016) (Paper 9 at 32) (*citing*

In re Magnum Oil Tools Int'l, Ltd., No. 2015-1300, 2016 WL 3974202, at *9 (Fed. Cir. July 25, 2016))(internal citations omitted).

The present Petition is even more deficient than the petition in the above cited decision by the Board in *Nautilus*, because the present Petition doesn't even contain "conclusory statements implying that the same analysis for claim 1 also applies" to the other claims. Instead, the entirety of the claim chart's assertion of anticipation of Claims 27, 28, 29, 34, 54, 73, 92, 93 and 111 consists of incorporation by reference to the analysis of other claims. There is no consideration of claim language differences or claim constructions, and no explanation why these arguments are cross-applicable. As the Board in *Nautilus* held, such conclusory analysis is insufficient. Thus, at a minimum, the Petition fails for these claims in which Petitioner chose to do no analysis beyond a simple incorporation by reference.

Moreover, as discussed above, the Petition asserted ten different claim constructions. 37 C.F.R. § 42.104(b)(4) requires the Petition to explain "[h]ow the construed claim is unpatentable . . ." Yet the claim chart never once attempts to equate the asserted claim constructions with the teachings of Turner. In view of the undeveloped means-plus-function constructions discussed above, the Petition was particularly required to provide a reasoned analysis of "[h]ow the construed claim is unpatentable," over Turner. 37 C.F.R. § 42.104(b). Yet the claim chart is

silent as to any of the asserted means-plus-function constructions and how those construed claim elements are disclosed in Turner. Again, the Petition falls far short of the requirements under 35 U.S.C. § 312(a)(3), 37 C.F.R. § 42.104(b) and § 42.22(a)(2) to provide a reasoned basis for the unpatentability of the claims.

Petitioner's second claim chart (Ground 2 – Alleged Obviousness over Kaczmarczyk and Turner) has the same inadequacies. For example, the claim chart cites to two portions of Kaczmarczyk and four portions of Turner in asserting obviousness of element 1d. However, the claim chart did not even indicate how or why these various teachings would be combined to meet element 1d. The Petition's claim chart in the obviousness argument also wholesale incorporated its Claim 1 analysis for most of the other challenged claims despite their differences in language and scope. Thus, for the reasons provided above, the Petition's obviousness claim chart also fails to meet the requirements of 35 U.S.C. § 312(a)(3), 37 C.F.R. § 42.104(b) and § 42.22(a)(2).

C. Ground 1 fails because Turner does not disclose every element of Claim 1

Under 35 U.S.C. § 102, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2s 1051, 1053 (Fed. Cir. 1987). "The identical invention

must be shown in as complete detail as is contained in the … claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, if even a *single* claim element is not disclosed in Turner, the claim is not anticipated.

The following section provides an overview as background to an explanation of why the Petition mischaracterizes and fails to establish that Turner discloses each and every element, arranged as set forth in Claim 1.

1. Overview of Turner

Turner discloses a communication system and method for providing call management services (CMS) in a Virtual Private Network (VPN). See Turner, Abstract. Turner implements a system for routing calls locally and remotely within an IP-based VPN and also externally to the PSTN. Turner at 9:10-10:22; 10:24-12:41; 12:43-67.

Turner illustrates its routing method in FIG. 1.

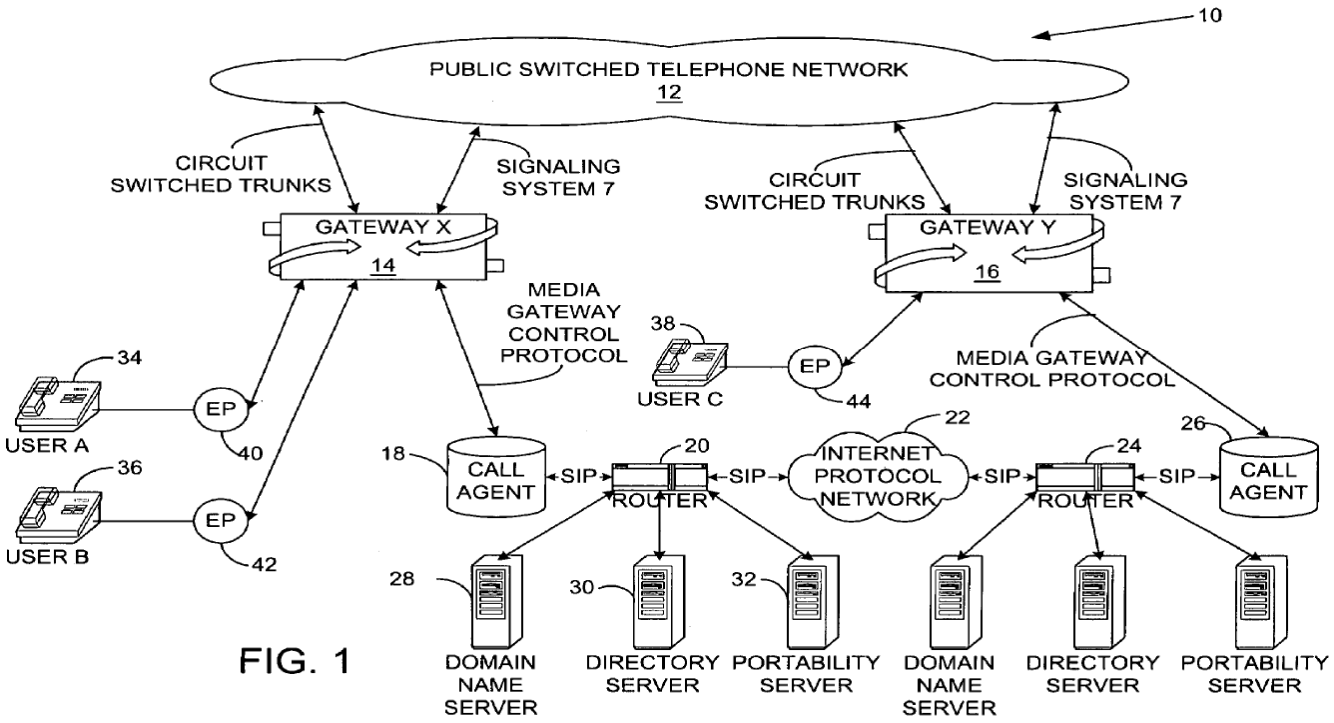


FIG. 1

Notably, Turner uses a two-layer numbering scheme, consisting of a lower number layer (NA's) and a higher number layer (CA's).

> The system and method of the present invention users [sic] a two-layer numbering scheme. The first or lower layer comprises the Directory Numbers from the North American Numbering Plan (NANP), as assigned by a Local Exchange Carrier (LEC) or a neutral Industry number administrator. [...] The second or higher layer of numbers identifying individual users, are assigned by the customer's administrator, and remain with these users wherever they are located in the network. The Directory Numbers (DN) are also the Network Addresses (NA). The artificial numbers assigned to specific users are the Customer Addresses (CA). A Directory Server performs the

> translation from Customer Address to Network Address and vice versa.

Ex. 1003 at 2:35-51.

FIG. 1 refers to Users A, B, and C who are associated with the following CAs, NAs, and gateways (*Id.* at 4:51-60):

	CA	**Current NA**	**Current Gateway**
User A	2001	313-555-2001	X
User B	2002	313-555-2002	X
User C	3001	709-555-3001	Y

As seen above, the lower number layer contains Network Addresses (NAs) that describe customer terminations or endpoints and that also represent the PSTN Directory Numbers of the associated telephones. Turner's system is non-traditional because it also uses a higher number layer containing Customer Addresses (CAs). Users are identified by their Customer Addresses (CAs), rather than the Network Addresses (NAs) of their phones. A Directory Server is provided to translate between CAs and NAs. Calls are placed by dialing the CA of the user (or by entering a user name, which is translated internally to a CA) to allow Turner's system to send calls to users even if they roam among a number of different physical telephone endpoints (NAs).

> It should be noted that users are identified by their CAs, rather than by their NAs. This allows calling and called users to roam amongst a multiplicity of NAs while preserving the validity of the matching logic tree's decision.

Id. at 15:36-41.

> User identities are normalized to be CAs. Thus, if a caller enters a user name instead of a CA to reach a desired user, the name is translated to a CA in the Directory Server . . .

Id. at 14:19-23.

Turner's reliance on CAs allows users to roam throughout the network while retaining call management service (CMS) features. Turner criticizes prior art implementations for basing CMS features on network interface points or endpoints (*i.e.*, NA's or Directory Numbers of phones) instead of specific users.

> Traditional Call Management Services suffer from several serious shortcomings such as... 2) the features recognize calling and called network interface points or endpoints instead of specific users, making them useless and inappropriate in an environment where users roam amongst a multiplicity of network interface points. *Id.* at 1:55, 63-67; *contrast with* 14:45-46 and 17:43-48.

A "User Profile Object" stores user profile information linking a user's CA with the user's current NA. "There is one user profile object... for each recognized user in the customer's organization." *Id.* at 7:29-30. The search keys for user

profiles are "the Customer Addresses (CA) and the user name." *Id.* at 2:53-54. The CA is used as a "search key in translations between network addresses and user profiles," as shown in FIG. 3. *Id.* at 7:63-65.

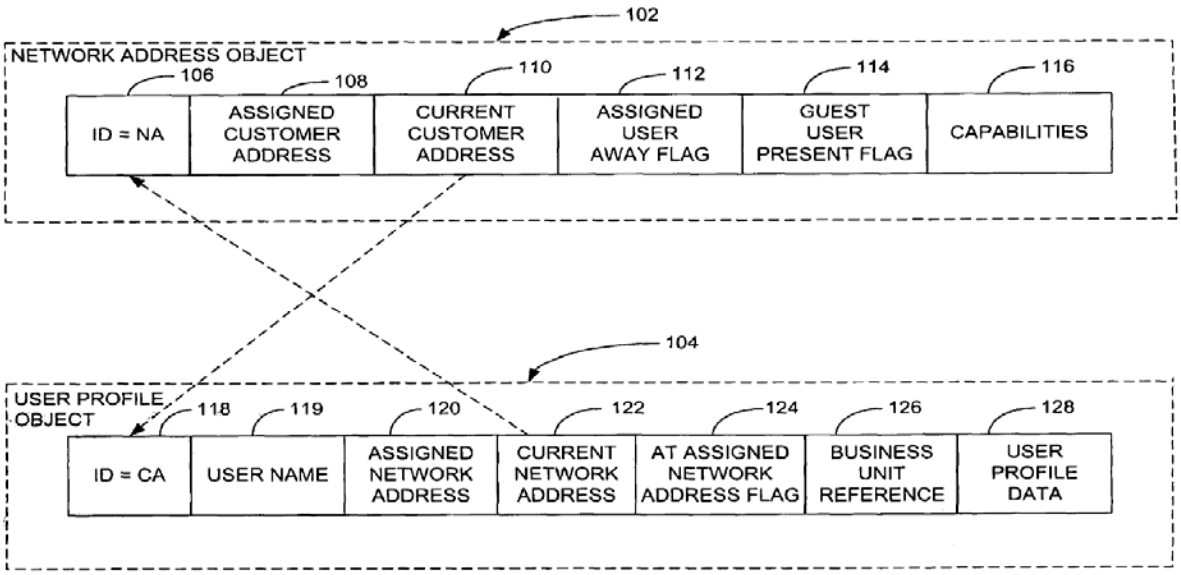


FIG. 3

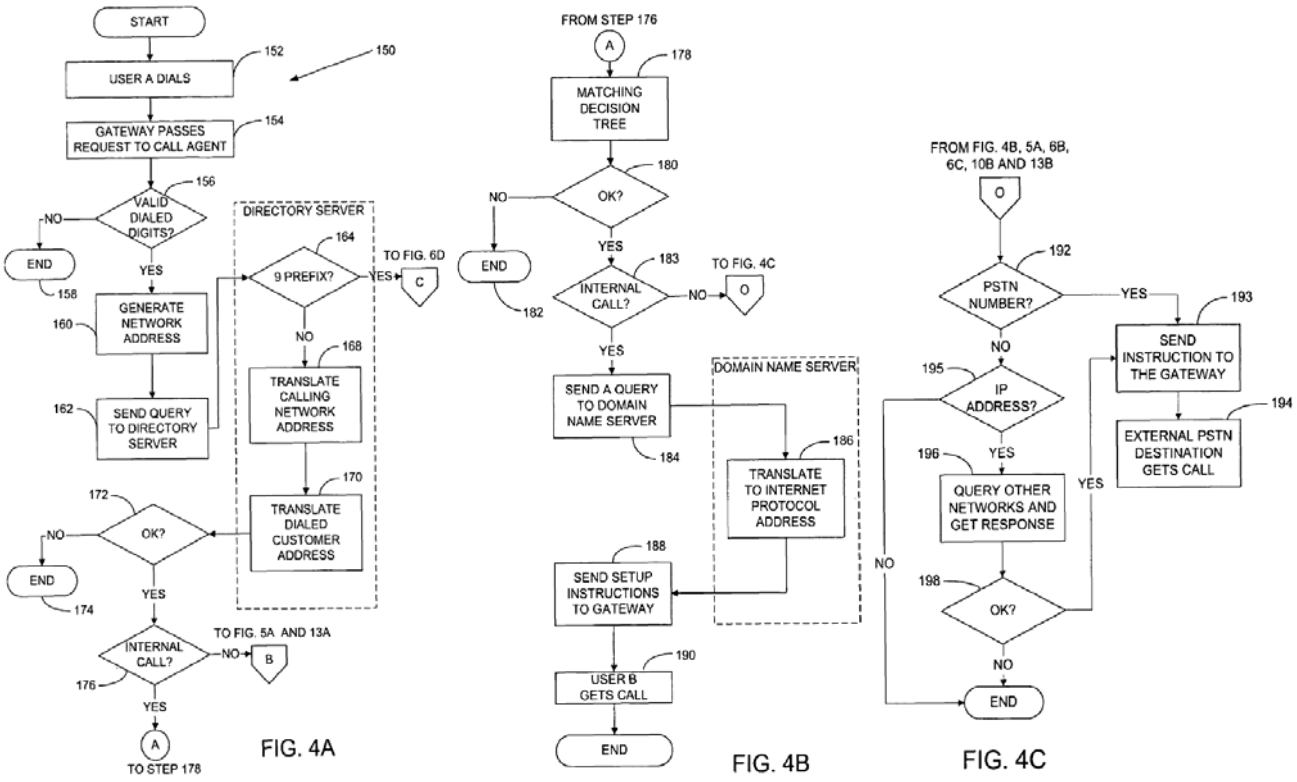
A user profile object 104 associated with a user identifies a user's current NA (Directory Number) 122. The Directory Server can look up the Network Address Object 102 associated with this NA using the user profile object. A network address object for an NA identifies the CA 110 of a user currently associated with this NA, which can be used to look up the user profile object 104 of the current user. Network address objects 102 can be searched using the NA field (i.e., PSTN Directory Number) as the search key. The user profile objects 104 can be searched by using either the CA field 118 or the User Name

field 119. This allows the Directory Server to translate CAs to NAs, and vice versa. *See*, *id.* at 7:66-8:14.

Next, the routing methods for intra-gateway calls and inter-gateway calls are described as background for why Turner fails to disclose the "classifying" step in element [1d].

a. Turner's Routing Method for an Intra-Gateway Call

Turner's first example (an "intra-gateway call") is described at 9:12-10:22 and in FIGS. 4A-C. This example depicts User A (34 in FIG. 1) at Gateway X (14) dialing "2002" to place a call to User B at the same gateway.



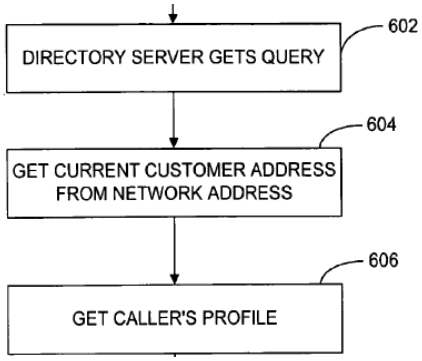
In step 154 of FIG. 4A, "the call agent associated with user 'A' receives a CA (2002) from the user as the dialed number" and "assigns an NA (313-555-2001) as the calling user's identity at step 160." *Id.* at 9:18-22. The assigned NA comes from a table maintained by each call agent "cross-referencing stations or endpoints to NAs, both being relatively static physical addresses." *Id*. at 9:22-24. At this point, "[a] query is launched [by the originating call agent, 18 in FIG. 1] to the Directory Server [30 in FIG. 1] per step 162..." *Id.* at 9:24-25, *see also* FIG. 1.

Prior to any attempt by the Directory Server to translate the caller's NA into a corresponding caller CA (step 168) or the dialed CA into a corresponding callee NA (step 170), a check for a predefined prefix code is performed; *e.g.*, the prefix digit "9" represents a call destined for the Public Switched Telephone Network (PSTN, 12 in FIG. 1), which results in the translation process being bypassed. *See, id.* at 12:44-50.

If step 164 recognizes a prefix digit of "9," call flow proceeds to FIG. 6D instead of continuing along the routing methods of Figs. 4A-C (or Figs. 5A-C as described below for an inter-gateway call).

If no prefix digit is recognized, the Directory Server "performs a dual translation per steps 168, 170 [in FIG. 4A]." *Id.* at 9:25-26. In step 168, "the NA assigned to the endpoint being used to make the call (313-555-2001) becomes a CA (2001)." *Id.* at 9:28-30. The caller's translated CA (2001) is used to locate the

caller's User Profile object. *Id.*, *see also* FIG. 3, 19:27, step 606 in FIG. 11 (shown below):



In step 170, "the dialed CA (2002) [identifying User B] becomes an NA (313-555-2002)." *Id.* at 9:24-30. If a successful response is received from the Directory Server at step 172, the call agent proceeds to step 176, where a decision is made as to whether a call is internal to the gateway (intra-gateway) or whether it requires interaction with a call agent at another gateway (inter-gateway).

> Upon receipt of the response, the originating call agent recognizes that the called party is within the gateway at step 176 and can therefore process the call internally. This is a major decision point, leading either to a process that can be completed internally or one that involves interaction with a call agent at another gateway.

Id. at 9:30-36.

Where User A calls User B, Turner's call flow proceeds to step 176 in FIG. 4A, where the call agent must decide whether or not the called party is internal to the gateway. It does so based on the NPA and Central Office (CO) code

of the called party NA, as received from the Directory Server. The call agent recognizes that the caller's assigned NA and the callee's translated NA both begin with "313-555", which is associated with Gateway X. *Id.* at 5:43-46, 9:30-36.

If the call is determined by step 176 in FIG. 4A to be "internal" to the gateway, then "the call agent negotiates the 'Matching Decision Tree' per step 178 [in FIG. 4B]." *Id.* at 9:37-38. "This decision tree matches the preferences and privileges of the two parties and arrives at a decision [which] involves the granting or alternatively, denying of permission to step up a call and the return of an appropriate NA." *Id.* at 9:39-43. The returned callee NA may be the *same* as that returned by the Directory Server, or it may be a *different* NA, depending on the "busy/idle status of the terminating station or endpoint." "[T]he final result might be the NA of a voice mailbox, administrative assistant, call attendant or even an external PSTN destination such as home telephone number." *Id.* at 9:46-52 (emphasis added).

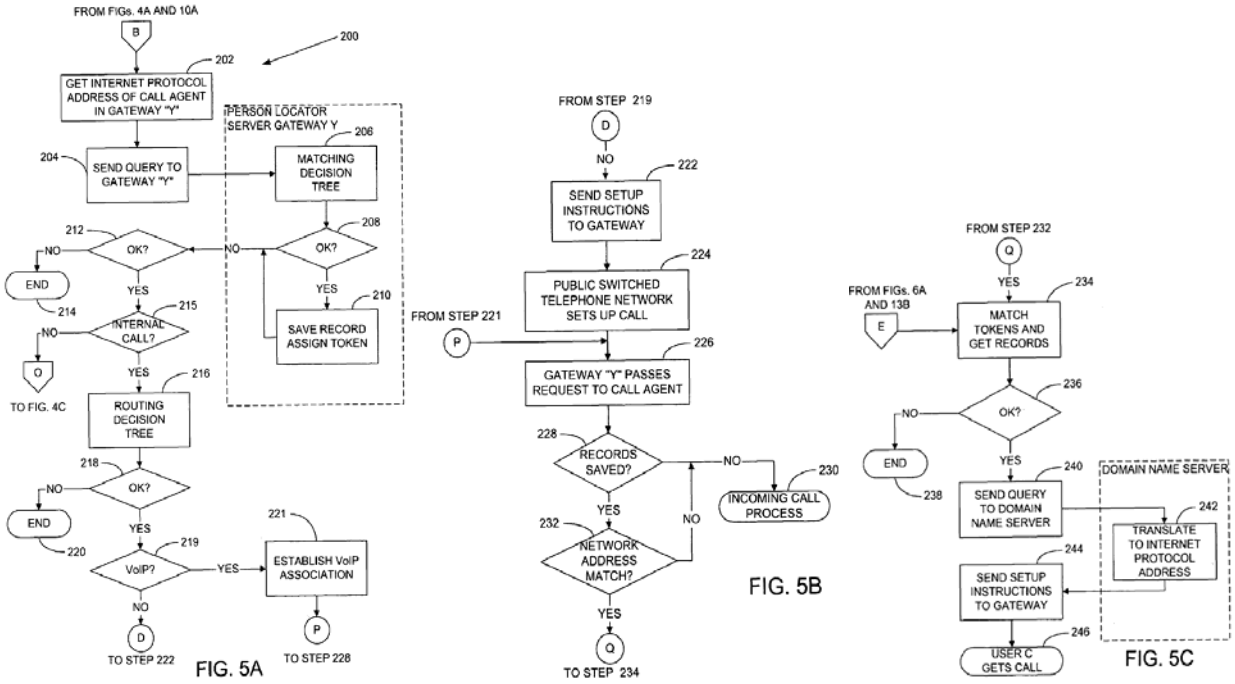
Negotiating the Matching Decision Tree in step 178 of FIG. 4B can result in either a call that is internal to the originating gateway (*e.g.*, the call is placed to the telephone of User B) or it can result in an external PSTN or VPN call (*e.g.*, the call is directed to User B, but User B is unavailable and/or has set up call forwarding). In step 183 of FIG. 4B, "the number provided by the Matching Decision Tree, if altered from that provided by the Directory Server, is examined to ensure the

destination is still internal." *Id.* at 9:49-55. If the destination is still internal, call flow proceeds through steps 184, 186, 188, and 190 of FIG. 4B. If the call is no longer internal, call flow proceeds to FIG. 4C. *Id.* at 9:52-56.

b. Turner's Routing Method for an Inter-Gateway Call

Turner's second calling example (an "inter-gateway call"), described at 10:25-12:41 and in Figs. 5A-C, involves User A, at Gateway X, dialing "3001" to place a call to User C who is connected to *another* gateway, Gateway Y at 16.

As discussed above, if step 176 of FIG. 4A finds that the caller and callee are associated with *different* gateways (*i.e.*, the callee's NPA and CO of "709-555" is associated with Gateway Y; *id.* at 10:36-42), then call flow goes to Figs. 5A-C.



In step 202 of FIG. 5A, the originating call agent obtains the IP address of the call agent in Gateway Y, and queries the Gateway Y at step 204. (The busy/idle status of the terminating endpoint is only known to Gateway Y's call agent.) In step 206, the call agent of Gateway Y negotiates the "Matching Decision Tree," in which there is a "return of an appropriate NA." *Id.* at 11:8-13. Gateway Y's call agent sends its response to Gateway X's call agent for evaluation at steps 212-215. If the call was redirected to an external PSTN or VPN destination, flow proceeds to FIG. 4C. But assuming that the call agent at Gateway Y granted permission for the call to User C to proceed internally, in step 216, the call agent at Gateway X consults a "Routing Decision Tree" that comes to one of three alternate conclusions about routing the call between Gateways X and Y:

> [1] the call is to be aborted due to lack of appropriate voice transport facilities,
>
> [2] an end-to-end VoIP association is to be established between the gateways. . . or that
>
> [3] an end-to-end call through the circuit-switched PSTN is to be attempted.

Id at 11:46-54.

Thus, an inter-gateway call from User A to User C, if not redirected by the Matching Decision Tree, will be aborted, proceed via the circuit switched PSTN

(entry point "D" in FIG. 5B, followed by steps 222-224), or proceed via an end-to-end VoIP association (steps 219-221 in FIG. 5A; entry point "P" in FIG. 5B).

2. Turner fails to disclose determining whether "calling attributes match[] at least a portion of [the] callee identifier" as in claim element [1c]

Claim 1 recites, *inter alia*, [1c] "determining a match when at least one of said calling attributes matches at least a portion of said callee identifier." Turner fails to disclose all the features of element [1c] and thus cannot anticipate Claim 1.

Petitioner provides only several cursory and vague statements in its claim chart (e.g., Petition at 24, 25) and in the body of the Petition (e.g., Petition at 18) alleging that Turner discloses "determining a match when at least one of said calling attributes matches at least a portion of said callee identifier" because Turner "analyz[es]" a callee identifier. Yet the Petition provides no explanation whatsoever of how such "analyzing" discloses the specific subject matter of claim element [1c], namely, "determining a match when at least one of said calling attributes matches at least a portion of said callee identifier." Since the Declaration's claim chart simply parrots the same attorney arguments from the Petition's claim chart, Petitioner's expert provides nothing more.

Turner describes two pieces of information for the caller and the callee, namely, a CA and an NA. *See, e.g.*, Ex. 1003 at 9:18-36; *see also id* at 10:30-35. When the caller initiates a call, the system determines an NA of the caller and the

digits dialed by the caller are assigned as the CA of the callee. *Id.* The caller's NA is converted to a CA and the callee's CA is converted to an NA. *Id.* Turner discusses comparing portions of the NAs (e.g., the Number Plan Area and the Central Office) to determine the IP gateways with which the two parties are associated. *See, e.g., id.* at 4:51-60; *see also id.* at 10:39-42. A routing decision is made based on whether the called party is located at the same IP gateway as the caller or at another IP gateway. *Id.*, 10:28-38; *see also* 9:30-36.

The Petition has identified the dialed digits in Turner as corresponding to the "callee identifier" of Claim 1: "Turner discloses a call agent that receives a request for a call including digits dialed by a caller, and determines an identifier for the caller." Petition at 21 (emphasis added). Turner refers to the dialed digits as the "Customer Address (CA)". Ex. 1003 at 9:18-28; *see also id* at 10:30-35. However, Petitioner has failed to provide any analysis showing that Turner's system *matches* at least a portion of the callee's CA with something that could be considered a "calling attribute", as required by element [1c]. Petitioner merely states that: "Turner discloses the call agent analyzing a caller address, callee address, and information about the addresses such as associated network locations to determine whether the caller and callee are connected to the same gateway or in the same location." Petition at 24 (emphasis added). However, Petitioner fails to carry the burden of showing that the "analyzing" of Turner involves "determining

a match" as recited in element [1c]. Petitioner does not identify with sufficient clarity *which* elements are used in Turner's "analyzing" and *how*. For example, the Petitioner lists *three* subjects of the analysis—(i) caller address; (ii) callee address; and (iii) information about the addresses—yet fails to explain *how* each of the three subjects are used in the "analyzing." In the case of the third subject category, Petitioner fails to specify *what* specific "information" about *which* address is involved in the "analyzing".

In fact, it is not possible to explain how Turner discloses matching "at least one of said calling attributes" with "at least a portion of the callee identifier." Turner's system uses the callee identifier to look up other information but does not disclose any matching of the callee identifier (CA) with anything akin to "calling attributes" in deciding whether a call is "internal" to the gateway in step 176 of FIG. 4A. (*See, e.g.,* Ex. 1003 at 9:18-33; 10:30-42, discussing the conversion of the dialed CA into an NA and the further use of the NA's of both endpoints.)

Thus, Petitioner has failed to explain how Turner discloses all of the elements of Claim 1, and so Claim 1 is not anticipated for this reason.

3. Turner fails to disclose the "classifying" features in claim element [1d]

Claim 1 recites, *inter alia*, [1d] "classifying the call as a public network call when said match meets public network classification criteria and classifying the call as a private network call when said match meets private network classification criteria." Turner fails to disclose all the features of element [1d] and thus cannot anticipate Claim 1.

Petitioner argues that Turner discloses a call agent determining whether a callee is within the same gateway as the caller or whether the callee is on another gateway, and that in making *this* determination, "the call agent classifies the call as a private network call or a public network call." Petition at 18. While Turner's system does decide whether a callee's telephone endpoint is associated with the *same* gateway as the caller (*i.e.*, an internal or "intra-gateway" call) or a *different* gateway (*i.e.*, an "inter-gateway" call), this decision does not involve classifying the call for routing as a "public network call" or as a "private network call". For example, an "inter-gateway" call in Turner can proceed through either a PSTN or through a private network (it is not limited to using the PSTN); and an "intra-gateway" call in Turner may nevertheless get routed out to a PSTN. Therefore, Petitioner's argument fails to establish that Turner anticipates Claim 1.

a. Turner's decision to classify a call as an inter-gateway call is not a disclosure of "classifying the call as a public

network call when said match meets public network classification criteria"

Claim 1 recites, *inter alia*, "classifying the call as a public network call when said match meets public network classification criteria..." in claim element [1d].

Petitioner does not explain how Turner discloses this claim element. Petitioner, at best, provides a claim chart juxtaposing Turner's handling of calls that are *not* "internal" to a gateway (*i.e.*, "inter-gateway" calls) with this element of Claim 1. Petition at 18, 26. However, Petitioner fails to explain how Turner's handling of an "inter-gateway" call meets the requirements of "classifying the call as a public network call...," as recited in Claim 1, given that Turner's inter-gateway calls need not even traverse a public network, and moreover, connect two endpoints within the same "Virtual Private Network."

According to Turner, step 176 of FIG. 4A may decide that a call is not an "internal call" directed to a user within the gateway:

> This is a major decision point, leading either to a process that can be completed internally or one that involves interaction with a call agent at another gateway. Ex.1003 at 9:33-36.

> Upon receipt of the response [from the Directory Server], the originating call agent recognizes that the called party is within the private network, but at a location outside of gateway 'X'. *Id.* at 10:36-38

If so, the flow proceeds to step 202 in FIG. 5A.

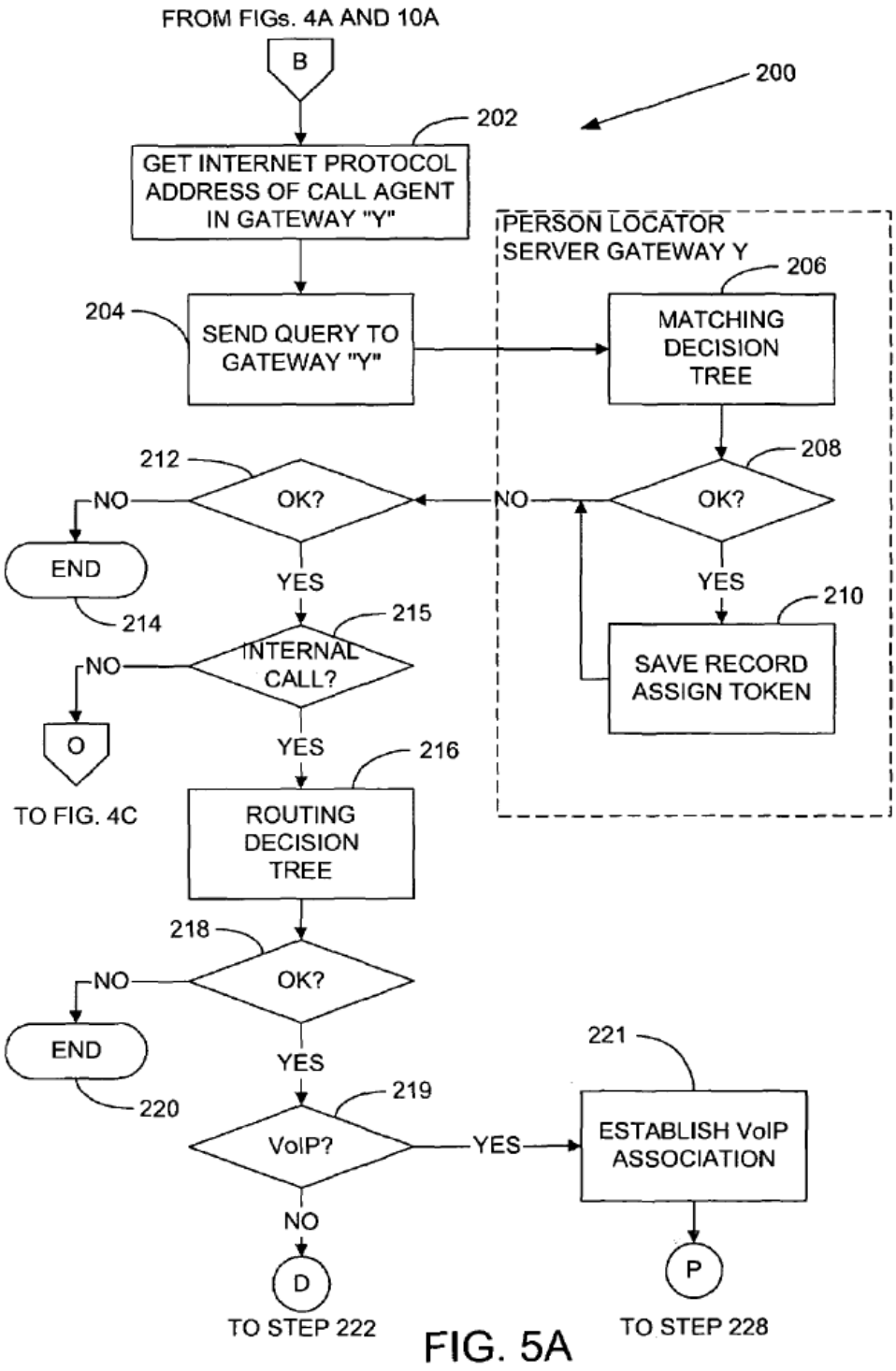


FIG. 5A

At step 215 of FIG. 5A, depending on the NA provided from gateway Y (e.g., Ex. 1003 at 11:8-16), the call flow may proceed to step 192 in FIG. 4C (*i.e.*, an external PSTN or VPN call). But assuming that the call agent gateway Y granted permission for the call to User C to proceed internally, in step 216, the call agent in gateway X consults a "Routing Decision Tree" to decide how the call from User A to User C is to be routed. *Id.* at 11:42-47; *see also* 3:62-64, FIG. 8. One possible outcome of the "Routing Decision Tree" is for the call to be routed end-to-end via VoIP (Voice over IP) between the gateways, *i.e.*, *not* via the PSTN. This outcome is shown explicitly in step 221 of FIG. 5A (shown above). Petitioner is mistaken to conclude that if step 176 of FIG. 4A decides that a call is not internal, that this will lead to "a call that will be routed through the PSTN or to a PSTN destination." Petition at 18 and 20. This is explained further by Turner:

> The managed IP network 22 may also support voice associations between the gateways 14, 16 using a suitable Internet RTP. For the sake of simplicity, the transport facility supporting the RTP associations between the gateways 14, 16 has been omitted from FIG. 1. It can be assumed to physically coexist in the aforementioned managed IP network [22 in FIG. 1] along with the signaling path from gateway 14 to call agent 18, thence from call agent 18 to call agent 26 via paths 20, 22 and 24, and finally from call agent 26 to gateway 16.

Ex. 1003 at 5:23-31; *compare* 5:8, (emphasis added).

Thus, it is clear that calls between gateways in Turner may proceed over the managed IP network 22, rather than over the PSTN 12. Merely deciding, at step 176 of FIG. 4A, that the current call is not an internal call and is being placed to a user at another gateway (*i.e.*, deciding this is an "inter-gateway" call) and which can be over the IP network 22 is not tantamount to a decision that the call is a "public network call" as recited in Claim 1. Turner's disclosure of a decision in step 176 of FIG. 4A, that a "call is directed toward a callee on another gateway" is not a disclosure of "the call agent classif[ying] the call as [...] a public network call," as argued by Petitioner. Petition at 18. Accordingly, Turner fails to disclose "classifying the call as a public network call..." and thus fails to anticipate Claim 1.

Petitioner makes no attempt to account for this distinction between the handling of "inter-gateway" calls and the claimed "classifying the call as a public network call," providing no analysis of how the "Routing Decision Tree" as disclosed, *e.g.*, at step 216 of FIG. 5A, 11:45-52, 17:35-18:61 and FIG. 8 teach the features of element [1d]. Petitioner's expert merely repeats the attorney argument from the Petition. Thus, the Petition fails to demonstrate how Turner meets this claim element.

b. <u>Turner's decision to classify a call as an internal (intra-gateway) call is not a disclosure of "classifying the call as a private network call when said match meets private network classification criteria"</u>

Claim 1 also recites, *inter alia*, "...classifying the call as a private network call when said match meets private network classification criteria," and Turner likewise fails to disclose this element in step 176 of FIG. 4A.

Step 176 of Turner's FIG. 4A discloses that when a call is determined to be "internal" to a gateway, the call flow proceeds to step 178 in FIG. 4B:

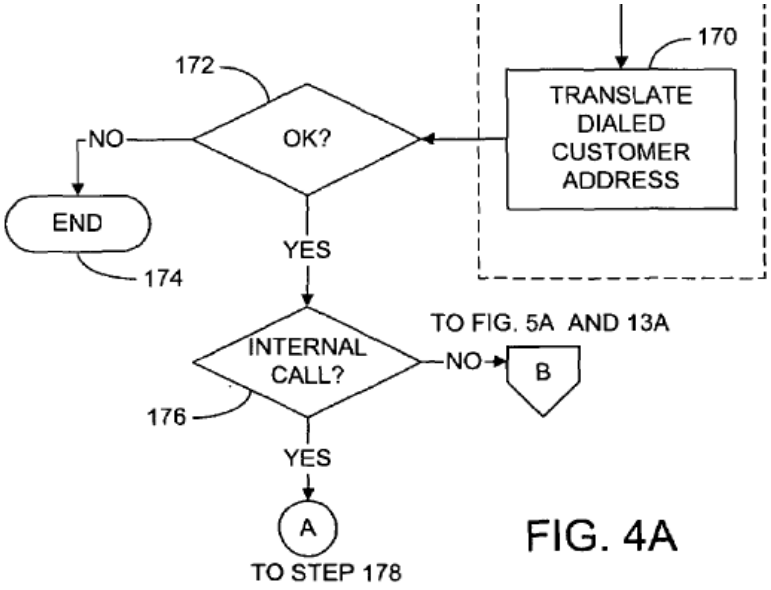
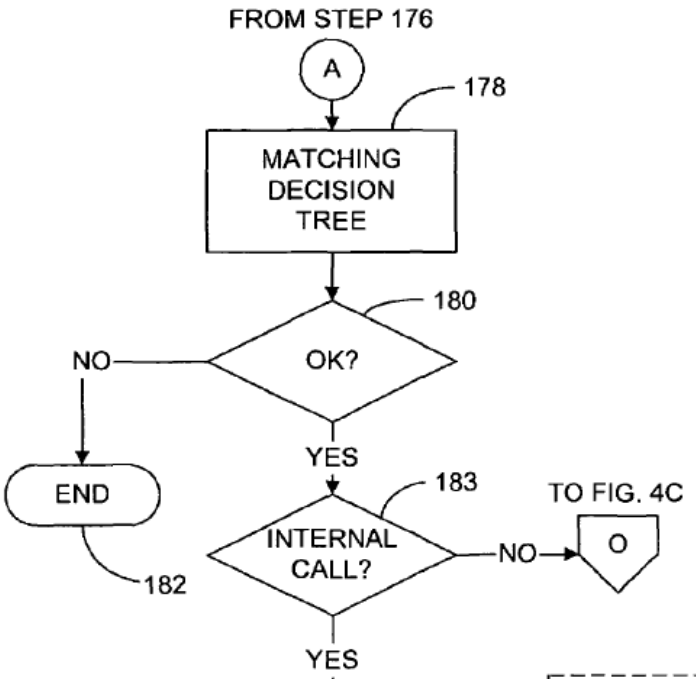


FIG. 4A

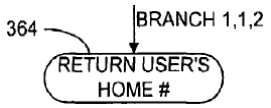
Ex. 1003 at FIG. 4A (partial detail view).

Step 178 of Turner's FIG. 4B invokes the "Matching Decision Tree," which attempts to resolve any ambiguities that may exist in how to handle the call.



Id. at FIG. 4B (partial detail view).

Turner teaches that, following an analysis of caller and callee preferences, privileges, and status in the "Matching Decision Tree," "the final result might be the [Network Address] (NA) of a voice mailbox, administrative assistant, call attendant, or even an external PSTN destination such as [a] home telephone number." *Id.* at 9:46-52 (emphasis added). Thus, even if Turner's system decides that a call is "internal," the call may nevertheless be routed to the PSTN and processed as an external call. For example, the callee may have set up call forwarding to their home phone, as shown in block 364 of the "Matching Decision Tree" in FIG. 7A.



Id. at FIG. 7A (partial detail view).

FIG. 4B also illustrates the possibility that an "internal" call may get routed to the PSTN, as shown by the call flow path from step 183 to step 192 in FIG. 4C. *Id.* at 9:52-56. Step 194 of FIG. 4C routes the call to an "External PSTN Destination." A decision, at step 176 of FIG. 4A, that a call is "internal" is not a disclosure of "classifying the call as a private network call," as there is no requirement in Turner that an "internal" call actually be a "*private network* call."

Because Turner fails to disclose "classifying the call as a private network call" as recited in Claim 1, Turner fails to anticipate Claim 1.

4. Turner's disclosure of prefix digits fails to anticipate claim elements [1b], [1c], [1d], and [1f]

In discussing Turner's prefix digit feature, the Petition relies on two distinct call flow processes to erroneously assert that Turner provides an anticipatory disclosure of the method of Claim 1. However, each of these two distinct call flows is mutually exclusive of the other—there is no instance where Turner's system would perform all the steps of both call flows for a single call. As such, the combination of these two distinct call flows fails to establish anticipation. Further, neither call flow individually anticipates Claim 1.

"[T]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *Net MoneyIN, Inc.*, at 545 F.3d 1369 (*quoting Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). "[I]t is not enough that the prior art reference ... includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention." *Id.* at 1371.

a. <u>The Petition improperly combines two distinct call flows</u>

Petitioner has confusingly intermingled multiple citations to Turner's prefix digit feature in the Petition with citations to Turner's internal call recognition feature (Ex. 1003 at 9:12-36). This is without attempting to show how these distinct features are used in a manner that demonstrates Turner's method discloses all elements as arranged in Claim 1. The Petition cites to Turner as disclosing a call flow involving recognition of certain prefix digits in its argument and in its claim chart for elements [1c], [1d], and [1f]. *See* Petition at 19 (citing Ex. 1003 at 12:44-67 twice), 25, 26, and 29.

As discussed below, Turner's prefix digit feature involves steps distinct from the steps in the internal call recognition feature. Given these differences, it was incumbent on Petitioner either to explain how these two distinct features should be viewed as a single anticipatory disclosure, or to separately analyze these call flows

to show that one or both individually disclose all elements as arranged in Claim 1. Yet the Petition fails to do so. Thus, the Petition does not establish anticipation by Turner because it fails to establish that Turner "disclose[s] those elements 'arranged as in the claim.'" *Net MoneyIN, Inc.*, at 1369.

As previously described (see section II(C)(1)(a)) and as detailed below, the call flow for Turner's internal call recognition feature (e.g., step 176 of FIG. 4A) is distinct from a call flow of recognizing and processing of certain prefix digits (step 164 of FIG. 4A and steps 312-320 of FIG. 6D) in that each of the two call flows includes distinct processing steps not found in the other.

Turner describes the prefix digit feature as follows:

> External Call Handling
>
> In a preferred embodiment, CAs cannot begin with the digits "8", "9", or "0", these being reserved for private trunk network access, escape to the PSTN, and attendant services, respectively. Thus, the Directory Server is set up to recognize these prefix digits and bypass the normal translation algorithms. For example, if the call is destined for the PSTN, neither the dialed number nor the caller's NA is translated.
>
> FIGS. 4A and 6D are flowcharts illustrating a method for handling outgoing external calls in accordance with a preferred embodiment of the present invention. Assuming an outgoing call to the PSTN per step 152, the aforementioned user "A" dials the PSTN number, for

> example, 9-313-555-7860. The call agent associated with user "A" receives the full PSTN number as the dialed digits and assigns an NA (313-555-2001) as the caller's identity per step 160. A query is launched to the Directory Server per step 162, which recognizes the escape code and declines to translate either number per step 164. Both are returned to the call agent unchanged per step 312 (from FIG. 6D), with the DS flag set to indicate that the translation function has been completed. The call agent then requests trunk gateway X to set up a call to the PSTN. Because the call is destined for the PSTN….

Ex. 1003 at 12:44-67 (emphasis added).

As indicated in the above quote, the handling of a prefix digit of "9" (for PSTN calls) is illustrated in Turner's FIG. 4A (at step 164) and FIG. 6D (connected back to FIG. 4A at "C"):

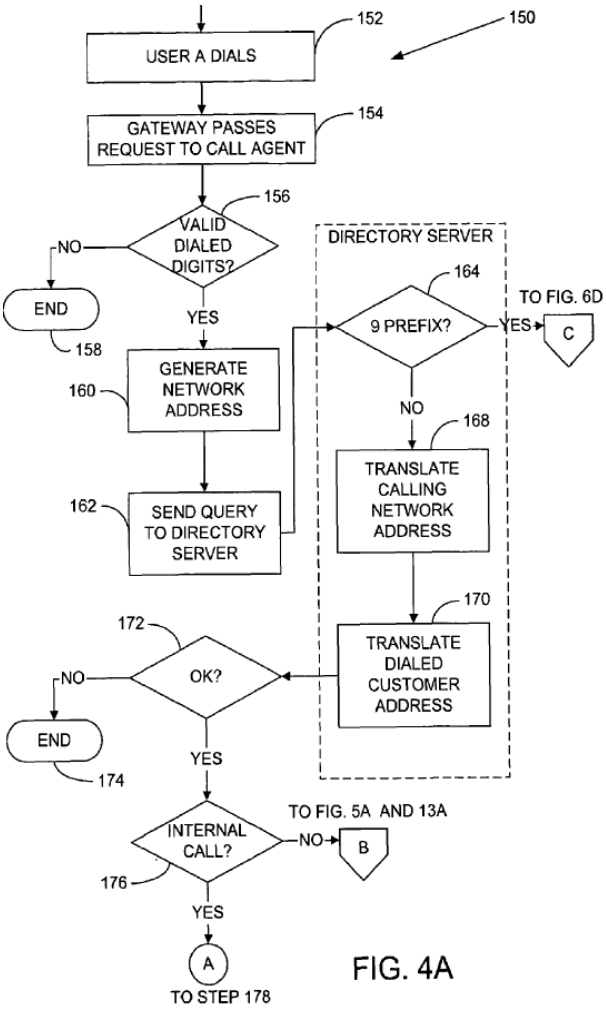


FIG. 4A

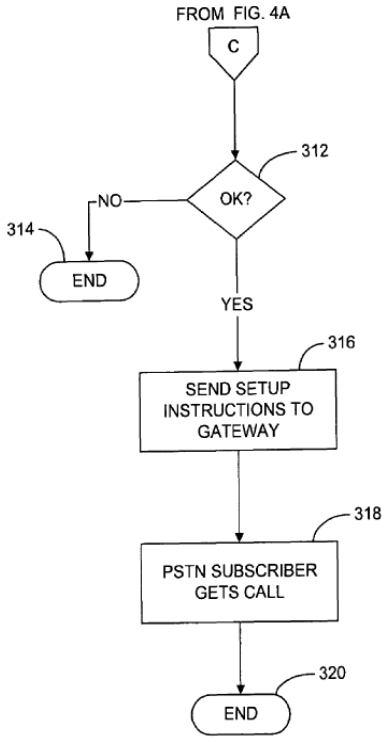


FIG. 6D

According to the figures above, if, in step 152, user "A" dials a PSTN number with a prefix of "9," *e.g.*, 9-313-555-7860, FIG. 4A of Turner shows that the "9" prefix (or "escape code") is recognized at step 164, and the call flow will then proceed via steps 312, 316 and 318 of FIG. 6D to place the PSTN call.

However, the Petitioner's argument about Turner's prefix digit feature is sandwiched between arguments relating to Turner's internal call feature, thus giving the false impression that the two features are arranged together as a single

call flow process. For example, at page 18, the Petition discusses Turner's internal call recognition feature, including step 176 of FIG. 4A. This is immediately followed by a three-sentence argument regarding Turner's prefix digit feature discussion at 12:44-67. Petition at 18-19. The Petition then goes on to discuss, *inter alia*, FIG. 4B, which illustrates steps that can only be performed *after* the internal call decision in step 176. Petition at 19. Thus, the Petitioner's argument about the prefix digit feature is immediately preceded *and* followed by a discussion of steps relating to internal call recognition, creating the false impression that, for any given call, both Turner's internal call recognition feature and Turner's prefix digit feature would be invoked. However, the call flow for processing a prefix digit is *distinct* from the call flow for recognizing an internal call. FIG. 4A shows that if a "9" prefix digit is recognized at step 164, call flow will *never* proceed to step 176; instead, it will instead proceed to FIG. 6D. Thus, the call flows shown in FIG. 4A itself makes clear that *either* Turner's internal call recognition feature *or* Turner's prefix digit feature would be invoked, not both.

Thus, the prefix digit call flow includes processing steps which are not part of the internal call recognition call flow, and vice versa, such that the two distinct call flows cannot be combined into a single method that anticipates Claim 1. It is Petitioner's burden to explain with specificity how the asserted disclosure of

Turner constitutes an anticipatory disclosure of Claim 1. 37 C.F.R. § 42.104(b)(4). Petitioner fails to do so, and thereby fails to meet its burden.

b. Turner's prefix digit is not equivalent to the claimed "calling attributes"

Petitioner cannot use the prefix digit call flow to anticipate Claim 1 since Turner's prefix digit is not equivalent to the claimed "calling attributes." Initially, Turner's predefined prefix digits ("8", "9" or "0") are not the same as the claimed "calling attributes" where "calling attributes associated with the caller" are included in a "caller dialing profile", [1b]. Nor are they used in "determining a match when at least one of said calling attributes matches at least a portion of said callee identifier," [1c].

Petitioner asserts that "the Directory Server analyzes the called address to identify codes or digits that are associated with the caller...." Petition at 18 (citing Ex. 1003 at 12:44-67) (emphasis added). But the cited passage of Turner fails to disclose that the prefix digits are calling attributes included in a caller dialing profile "associated with the caller," as recited in element [1b]. Ex. 1002 (Declaration at ¶ 43) repeats the Petitioner's argument verbatim, again, without explaining why 12:44-67 of Turner should be seen as disclosing that the prefix digits are calling attributes included in a caller dialing profile "associated with the caller."

Petitioner argues that Turner discloses a "caller profile... associated with the caller" including a "user profile [object] and linked network address object (data structure) [which] include information associated with the caller...," including "data associated with the caller (caller attributes) such as addresses and preferences." *Id.* at 16-17 (citing FIG. 3 and 7:29-61 of Turner). However, while FIG. 3 and 7:29-61 disclose a user profile object that stores certain data for each user (e.g., CA, NA) and is linked to a respective network address object, Turner fails to disclose that these objects store any predefined prefix digits such that they are "associated with the caller". Again, the Declarant provides no further explanation that would substantiate the attorney arguments in the Petition. Declaration at ¶¶ 38-39.

Thus, the Petition fails to support the contention that the predefined prefixes in Turner (i.e., "8" for private trunk network access, "9" for escape to the PSTN, and "0" for attendant services, as disclosed at 12:44-67) are "calling attributes associated with the caller."

Petitioner conveniently overlooks Turner's teachings that contradict their argument:

> CAs ***cannot*** begin with the digits "8", "9", or "0", these being ***reserved*** for private trunk network access, escape to the PSTN, and attendant services, respectively.

[Turner at 12:44-47, emphasis added]

As discussed above, calling within Turner's system is typically effected by dialing a CA of the callee. However, Turner states that CA's cannot start with a prefix, e.g., "9" as a prefix, because the prefix has a predefined meaning or function associated with it throughout Turner's system and is "reserved" for this function. Thus, dialing a "9" as the first digit (prefix) *always* leads (via step 164 of FIG. 4A) to subsequent dialed digits being interpreted as a PSTN number. Turner nowhere discloses that such prefix digits are reflective of a setting or *preference* in a caller's "user profile object." They have a fixed meaning or function (i.e., "8" for private trunk network access, "9" for escape to the PSTN, and "0" for attendant services, as disclosed at 12:44-67) for all callers in that they have predefined meanings or function system-wide and are "reserved" for these functions.

Turner fails to disclose that prefix digits are calling attributes included in a caller dialing profile associated with a caller. Petitioner's arguments not only are deficient, but also are contrary to a careful reading of Turner. Thus Turner's prefix digits cannot be considered the "calling attributes <u>associated with the caller</u>". Turner's prefix digit feature also fails to disclose "locating a caller dialing profile comprising ... a plurality of calling attributes <u>associated with the caller</u>," [1b]. In addition, the prefix feature fails to disclose "determining a match" using a "calling attribute," [1c].

c. The Petition fails to show that Turner's prefix digit feature separately discloses "when the call is classified as a private network call, producing a private network routing message" as recited in Claim 1

The Petition also fails to establish that Turner's prefix digit feature separately discloses "private network" routing, as recited in element [1e].

The Petition cites to Turner's disclosure of identifying a prefix digit of "8" for "private trunk network access" (Petition at 18, last line). However, the Petition and Declaration fail to explain why "private trunk network access" is a disclosure of element [1e] or any other element of Claim 1.

Turner merely states that the "8" prefix relates to "private trunk network access." Turner at 12:45. But Turner is silent about what is expected after an "8" prefix is dialed or the functionality that might be available via private trunk access. Turner nowhere discloses that dialing "8" will result in a "private network call," nor does Turner disclose that a PSTN public network call cannot be made via the private trunk. For a reference to anticipate a claim, "[t]he identical invention must be shown in as complete detail as is contained in the … claim." *Richardson,* 868 F.2d 1236. Here, Turner provides no disclosure and thus does not anticipate element [1e].

Neither the Petition nor the Declaration provide any explanation of how element [1e] is disclosed by Turner's brief mention of the prefix call flow

associated with the "8" prefix. The Petition merely states that "the call agent sends a request to the appropriate gateway to route the call." Petition at 19. However, the Petition (and Turner) never identify the "appropriate gateway" for such a call. A finding of anticipation cannot be based on mere assumption or speculation; rather, it requires *evidence* that each claim element is expressly or inherently disclosed in the cited art—which Petitioner fails to provide.

In summary, Turner's disclosed prefix call flow, whether separate or combined with Turner's internal call recognition feature, is far from the mark of meeting each and every element of Claim 1.

D. Ground 2 fails because the combination of Kaczmarczyk and Turner does not disclose all claim elements and because the combination is not obvious

1. Overview of Kaczmarczyk

Kaczmarczyk discloses a communications network and a call routing and signaling system. The system provides call connectivity between a PSTN and an IP network. Kaczmarczyk at 5:60-62.

The call routing and signaling system includes a call control and routing engine referred to as INIP 16 (Intelligent IP), as shown in FIG. 1 (see below). The communication network includes two portions: a PSTN network 12 and an IP network 14. A media gateway 18 interconnects the two networks.

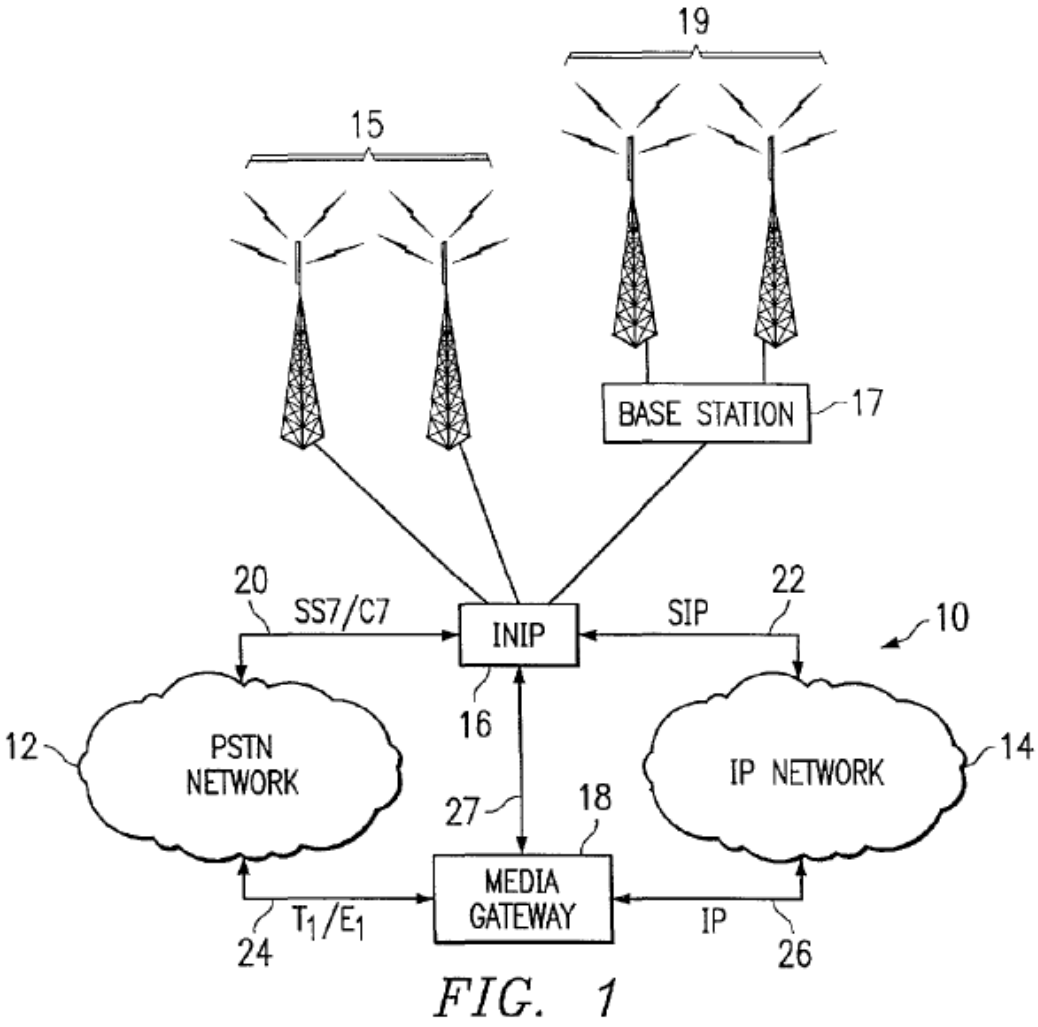


FIG. 1

[Kaczmarczyk at FIG. 1]

INIP 16 also provides connectivity to base station radio systems 15, as well as base station or radio gateway 17, which can connect to wireless systems 19. The Media Gateway 18 handles the transport of the media streams, and the INIP 16 handles call routing and signaling:

> Call routing and signaling system 16 is implemented in this example by a combination of software and hardware known as Intelligent IP (INIP) and is described in greater detail below in conjunction with

> FIG. 2A. Call routing and signaling system 16 provides SS7 protocol to IP interface and coordinates the SS7 view of IP elements and the IP view of SS7 elements. Call routing and signaling system 16 performs functions analogous to the service switching point, or signal switching point (SSP) traditionally used within an SS7 network.
>
> A media gateway 18 terminates switched telephone lines in public switch telephone network 12 and packetized media streams for IP transport over IP network 14.
>
> [Kaczmarczyk at 6:37-48]

As shown in FIG. 1, the INIP 16 communicates with the PSTN Network 12 via SS7 signaling over link 20 and with the IP Network 14 via a SIP protocol over link 22.

The INIP 16 includes Intelligence Engine 36, Call Control Engine 34, and Database 40, along with other units, as shown in FIG. 2A:

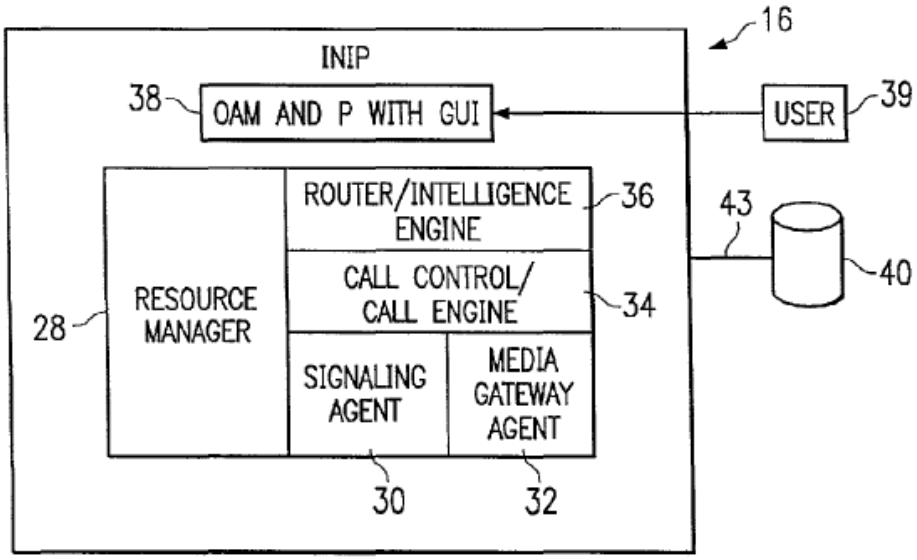


FIG. 2A

[Kaczmarczyk at FIG. 2A]

The functions performed by Call Control Engine 34 and Intelligence Engine 36 are illustrated by step 72 ("Call Control Processing") in FIG. 3.

> Call control engine 34 and route intelligence engine 36 process to call at step 72, determining the route the call should take. In particular, resource manager 28 informs intelligence engine 36 of the available trunks over which a call may be routed in response to call processing by call control engine 34, and intelligence engine 36 selects the route accordingly.
>
> [Kaczmarczyk at 8:35-40, emphasis added]

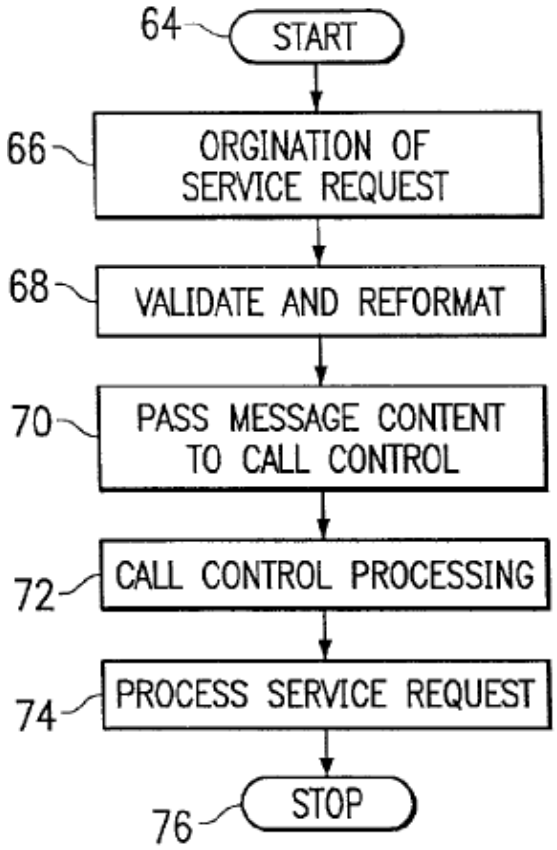


FIG. 3

[Kaczmarczyk at FIG. 3]

The functions of Call Control Engine 34 and Intelligence Engine 36 are further described as follows:

> call control engine 34 validates that a calling party is a valid caller, determines what services are available for the caller, determines what to do with the call, and once it figures out what to do with the call, packages the call and sends it to intelligence engine 36. Call control engine may communicate with external databases 40 over communication line 43 to process calls. … Intelligence engine 36 performs functions related to call control. Intelligence engine 36

> determines what route the call will take, and in doing so, also communicates with database 40 over line 43.
>
> [Kaczmarczyk at 7:29-40, emphasis added]

Thus, Kaczmarczyk's Call Control Engine 34 "validates" and "packages" the call, and Kaczmarczyk's Intelligence Engine 36 "determines what route the call will take."

Kaczmarczyk discloses routing calls from the PSTN Network to the IP Network (*e.g.*, in FIG. 4B), but most of Kaczmarczyk's disclosure is concerned with routing calls that originate in the IP Network and are terminated in the PSTN Network (*e.g.*, FIG. 4A).[1]

FIG. 4B illustrates calls originating in the PSTN network and terminating in the IP network:

[1] Figure 4A is described at 4:48-49 and 8:58-60 as originating in the PSTN and terminating in the IP Network, however, Kaczmarczyk clearly describes the call flow as being in the opposite direction (*e.g.*, FIG. 4A shows that the call flow begins with receiving a translated SIP message at 79 and the preparation of the message at 100 is described as a "PSTN message"). *See also* Ex. 1004 at 8:60-63 and 10:60-11:2. This typographical error seems to have also propagated elsewhere in Kaczmarczyk, in particular, to other Figure descriptions in the "Brief Description Of The Drawings" section.

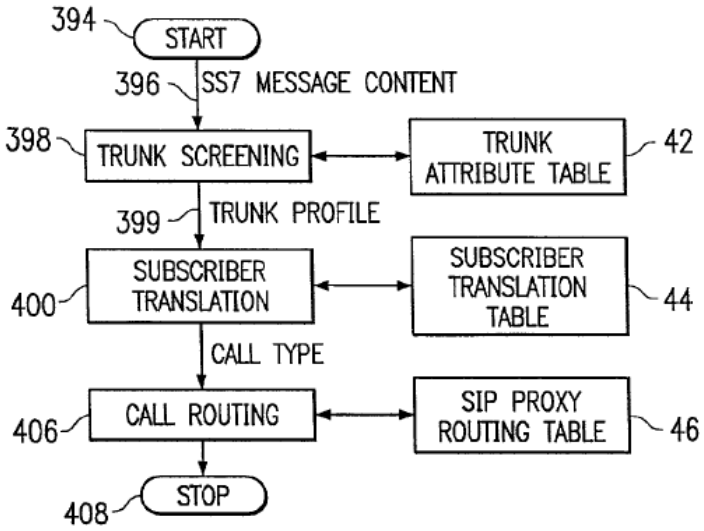


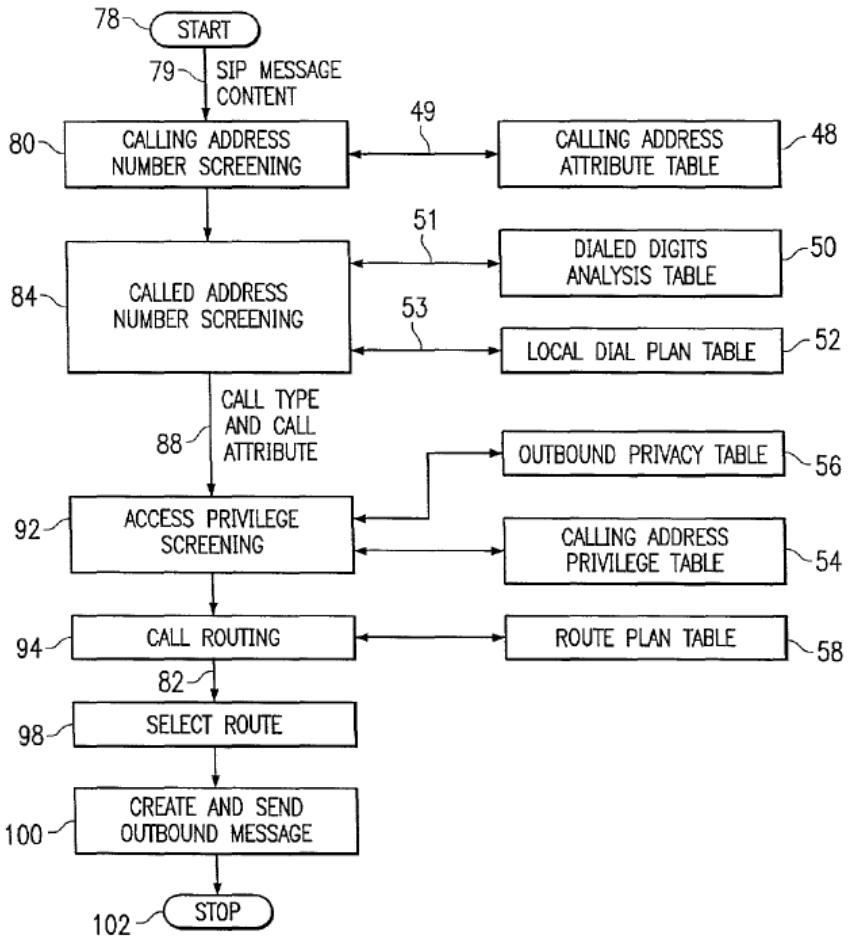
FIG. 4B

[Kaczmarczyk at FIG. 4B]

In FIG. 4B, the function of step 406 is to handle call routing decisions within the destination IP network ("...data necessary to create and route an SIP message are assembled at step 406": *Id.* at 11:61-63). The flow illustrated is thus specific to calls where the destination of the call is known to be the IP network.

FIG. 4A, in contrast, illustrates calls originating in the IP network and terminating in the PSTN ("The process begins at step 78 where a translated SIP message is received by call control engine 34 from signaling agent 30, as denoted by reference numeral 79." *Id.* at 8:60-63):

FIG. 4A



[Kaczmarczyk at FIG. 4A]

In FIG. 4A, the function of step 94 is to handle call routing decisions within the destination PSTN network, based on a "route plan table" 58.

> Once call control engine 34 determines the route at step 94, calling address profile 82 is complete [and is used] to determine the route to use to complete the call request and to formulate the PSTN message to be sent...

> [*Id.* at 10:58-64, emphasis added. *See also* Kaczmarczyk at 9:57-59, 10:37-38, and 10:49 which discuss a "PSTN message" created by call control engine 34.]

The flow illustrated in FIG. 4A is thus specific to calls where the destination network is known to be PSTN.

Thus, the routing decisions in Kaczmarczyk are specific to the destination network. Kaczmarczyk specifically mentions that the selection of the route within the destination network was a key feature to be provided in these types of networks:

> One function that is performed in facilitating communication between various types of networks is determining through which route a telephone call will take place in the network in which the call will terminate. For the PSTN, the route a telephone call takes place is comprised of a plurality of trunks. A trunk (not specifically shown) is a communication line between two switching systems, such as between a central office and a private branch exchange (PBX).
>
> [Kaczmarczyk at 2:2-10, emphasis added]

Much of Kaczmarczyk's disclosure relates to route selection with the PSTN network. Because the IP Network is by definition a connectionless, packet-based network, the only control that the INIP 16 has over call routing in the IP Network is the identification of the destination SIP proxy. This is described in Kaczmarczyk in connection with calls that terminate on the IP Network:

> At a step 406, call control engine 34 routes the call. To do so, remaining data necessary to create and route an SIP message are assembled at step 406. This includes identifying the destination proxy. To accomplish this task, call control engine 34 determines the called party's domain name from the SIP address. The domain name is then used as a key in accessing SIP proxy routing table 46. SIP proxy routing table 46 dictates which proxy is used to terminate the call.
>
> [Kaczmarczyk at 11:61-12:1, emphasis added]

Routing in a PSTN network, by contrast, involves the use of a "route plan index" and a "route list table" that specifies a set of routes such that ultimately a choice of an "outbound circuit" is made.

> Call control engine 43 [sic] uses a route plan index (index 116 in FIG. 5A) together with the call type and call attributes 88 to retrieve an appropriate route list table. A route list table is a table specified by route plan table 58 and specifies a set of routes, or route set, that may be used to complete the call. Example route list tables are found in the third column of Table 9: Route Plan Table. Call type and call attributes 88 are keys to route plan table 58 (e.g., they determine which values from the table are used). Once call control engine 34 determines the route at step 94, calling address profile 82 is complete, as indicated by reference numeral 82 between steps 94 and 98. Call control engine 34 uses calling address profile 82 and call type and call attributes 88 to determine the route to use to complete the call request and to formulate the PSTN message to be sent, and provides the

> determined route, or route set, to resource manager 28 to choose the outbound circuit at step 98.
>
> [Kaczmarczyk at 10:50-66]

The functionality described in this section of Kaczmarczyk is specific to a PSTN Network and would not be applicable to Kaczmarczyk's teaching of a call being routed to an IP network.

Thus, in the context of Kaczmarczyk, "call routing" for calls that are destined for the IP network involves a SIP Proxy Routing Table and the selection of a destination proxy. Kaczmarczyk at 11:61-12:1. In contrast, Kaczmarczyk's "call routing" for calls that are destined for the PSTN involves the use of a Route Plan Table and the selection of an outbound circuit. Kaczmarczyk at 10:50-66.

The call routing functionality of these two scenarios is completely different.

This distinction is seen in Kaczmarczyk's discussion of FIG. 4B (illustrating calls that terminate on the IP network): there is no mention of route plan indexes and route plan tables, which are specific to PSTN destinations. Kaczmarczyk at 11:4-12:4.

2. The Petition Fails to Articulate a Plausible Reason to Combine Kaczmarczyk with Turner

The Petition fails to articulate a plausible reason to combine the elements of Kaczmarczyk and Turner in the fashion claimed by the patent at issue as required by *KSR Intern Co.*, (550 U.S. at 418). The Petition merely provides a brief two-sentence statement arguing the references would have been obvious to combine due to their "similarities" (Petition at 39), and a single conclusory sentence alleging that "incorporating the features of Turner" into Kaczmarczyk's systems and methods would have been expected to provide an improvement. Petition at 40. Neither of these two cursory assertions are proper reasons to combine the references.

The Petition states that: "Both *Turner* and *Kaczmarczyk* disclose call routing and signaling systems for both private and public communication networks, as demonstrated in the similarities between Figure 1 of *Turner*: … and FIG. 1 of *Kaczmarczyk*: ...." Petition at 39. This is not a reason to combine the references; it is just an assertion that the two references relate to call routing. Asserting that two references are in the same field of endeavor is not articulating a plausible reason to combine the references. As a reason to combine references, such a basis is improper as it would justify combining virtually any systems that couple public and private networks; this falls far short of Petitioner's burden to provide a reason

to combine references. The alleged "similarities" between the figures of Turner and Kaczmarczyk illustrated in the Petition are nothing more than an identification of public and private networks and a gateway connecting them. Petition at 39-40.

The remaining sentence provided in the Petition regarding the motivation to combine is that "a POSA [sic] incorporating the features of Turner into the systems and methods of Kaczmarczyk would have expected the results to improve call management services in calls within a private network and calls that traverse between IP and public network [sic]." Petition at 40. This is a conclusory statement that does not articulate what such "improvements" would be. Nor does the Petition point to evidence providing even a hint that the teachings suffer from the alleged shortcomings or would have reason to seek out the alleged improvement.

It is neither the Board's nor Patent Owner's responsibility to remedy the inadequacies of a Petition that fails to meet the statutory requirements of asserting its unpatentability grounds "with particularity." This burden rests solely with Petitioner who, in this case, has not carried their burden to properly articulate how Turner's features would be an improvement to the systems and methods of Kaczmarczyk.

The systems of Turner and Kaczmarczyk are fundamentally different and address different problems. The system of Turner routes calls locally and remotely

within an IP-based VPN and also externally to the PSTN. Turner at 9:10-10:22; 10:24-12:41; 12:43-67; *see also* section II(C)(1)(a) and (b), *supra*. Turner is not concerned with *selecting routes* for calls that terminate within the PSTN. Such calls are simply passed to a PSTN trunk gateway. *Id.* at 9:62-63. Kaczmarczyk, by contrast, discloses a route selection mechanism for calls that terminate on the PSTN, and a proxy selection mechanism for calls that terminate on an IP network. Kaczmarczyk at FIG. 4A (call routing 94 depends on route plan table 58); *see also* section II(D)(1), *supra*. Kaczmarczyk is not concerned with calls from an IP network to the same or a different IP network. In fact, there is little disclosure in Kaczmarczyk regarding calls to IP destinations.

Petitioner has not identified any teaching in Turner or Kaczmarczyk that would have motivated one of ordinary skill in the art to combine the teachings of Turner (which, e.g., routes calls within an IP-based VPN) with the system of Kaczmarczyk (which, e.g., selects routes for calls that terminate on the PSTN). There is no specific problem disclosed or suggested in Turner that would be solved by Kaczmarczyk and no specific problem disclosed or suggested in Kaczmarczyk that would be solved by Turner. Accordingly, the Petition fails to provide a properly articulated motivation to combine the proffered references.

3. The Petition Fails to Demonstrate That All Elements of Claim 1 are Rendered Obvious by Modifying Kaczmarczyk in view of Turner

The lack of a properly articulated and plausible reason to combine Kaczmarczyk with Turner is one burden Petitioner fails to carry. The Petition also fails to show that the combination of Kaczmarczyk and Turner renders obvious each and every element as set forth in Claim 1.

Petitioner cites to Kaczmarczyk in connection with elements [1p], [1a], [1b] and [1c], and cites to both Kaczmarczyk and Turner in connection with claim elements [1d], [1e] and [1f]. The Petition acknowledges that Kaczmarczyk fails to describe routing calls in a private network, and relies on Turner to remedy this. Petition at 37. However, Petitioner mischaracterizes Kaczmarczyk's deficiencies. The differences between Claim 1 and Kaczmarczyk are more fundamental than stated by Petitioner.

While Kaczmarczyk discloses that calls can proceed from a PSTN network to an IP network, and vice versa, (see, e.g., FIGS. 4A and 4B) nowhere does Kaczmarczyk disclose *how* the decision is made to route to a particular kind of network (*e.g.*, PSTN or IP-based). Kaczmarczyk's disclosure of call routing is limited to scenarios where the destination network is known. Thus, Kaczmarczyk fails to disclose public and private "network classification criteria" for classifying and producing routing messages for a call as recited in Claim 1. Kaczmarczyk's

deficiency cannot be cured by Turner because Turner similarly fails to disclose classifying and producing routing messages for the call as a "public network call" or a "private network call" as recited in Claim 1.

a. Kaczmarczyk fails to disclose "public network classification criteria … and … private network classification criteria …"

Claim 1 recites, *inter alia*, [1d] "classifying the call as a public network call when said match meets public network classification criteria and classifying the call as a private network call when said match meets private network classification criteria." Kaczmarczyk fails to disclose element [1d], and since Turner likewise fails to disclose this element, Kaczmarczyk cannot be combined with Turner as alleged by Petitioner to provide the invention recited in Claim 1.

Petitioner provides no explanation of how Kaczmarczyk discloses element [1d]. While the Petition at 34-37 provides a simplistic summary of Kaczmarczyk, the only explanation the Petition provides for how Kaczmarczyk might meet element [1d] is a four-line statement in its claim chart: "*Kaczmarczyk* discloses determining services available to the caller, using the call type and call attributes to select an appropriate route list, and sending the call to the intelligence engine." Petition at 45. However, this terse statement fails to explain how the system disclosed in Kaczmarczyk is "classifying the call as a public network call when said match meets public network classification criteria and classifying the call as a

private network call when said match meets private network classification criteria." In fact, there is no basis for providing such an explanation of such classification criteria because Kaczmarczyk fails to disclose network classification criteria. Because Turner also lacks a disclosure of element [1d], Petitioner's combination of Kaczmarczyk with Turner fails to render Claim 1 obvious.

Kaczmarczyk discloses calls originating in the PSTN network and terminating in the IP network. For example, FIG. 4B illustrates such a call flow:

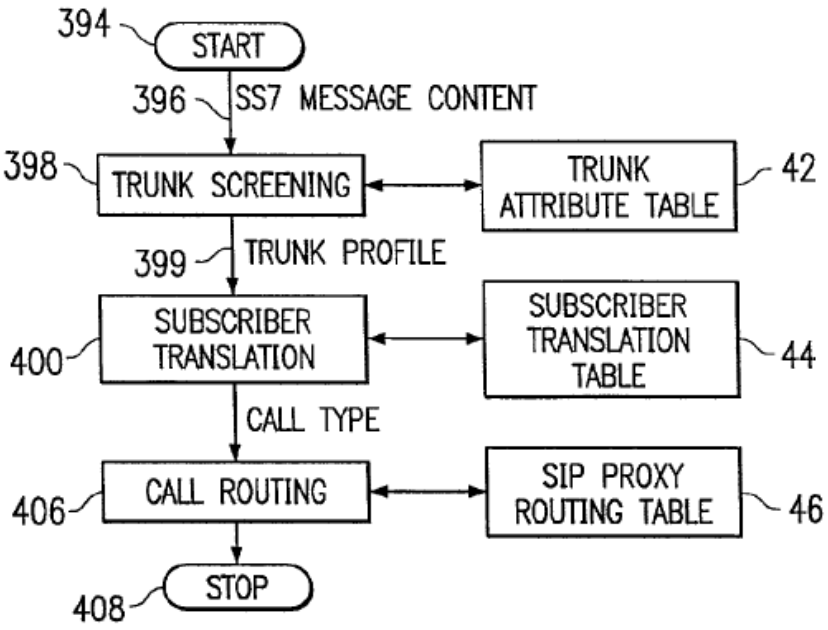


FIG. 4B

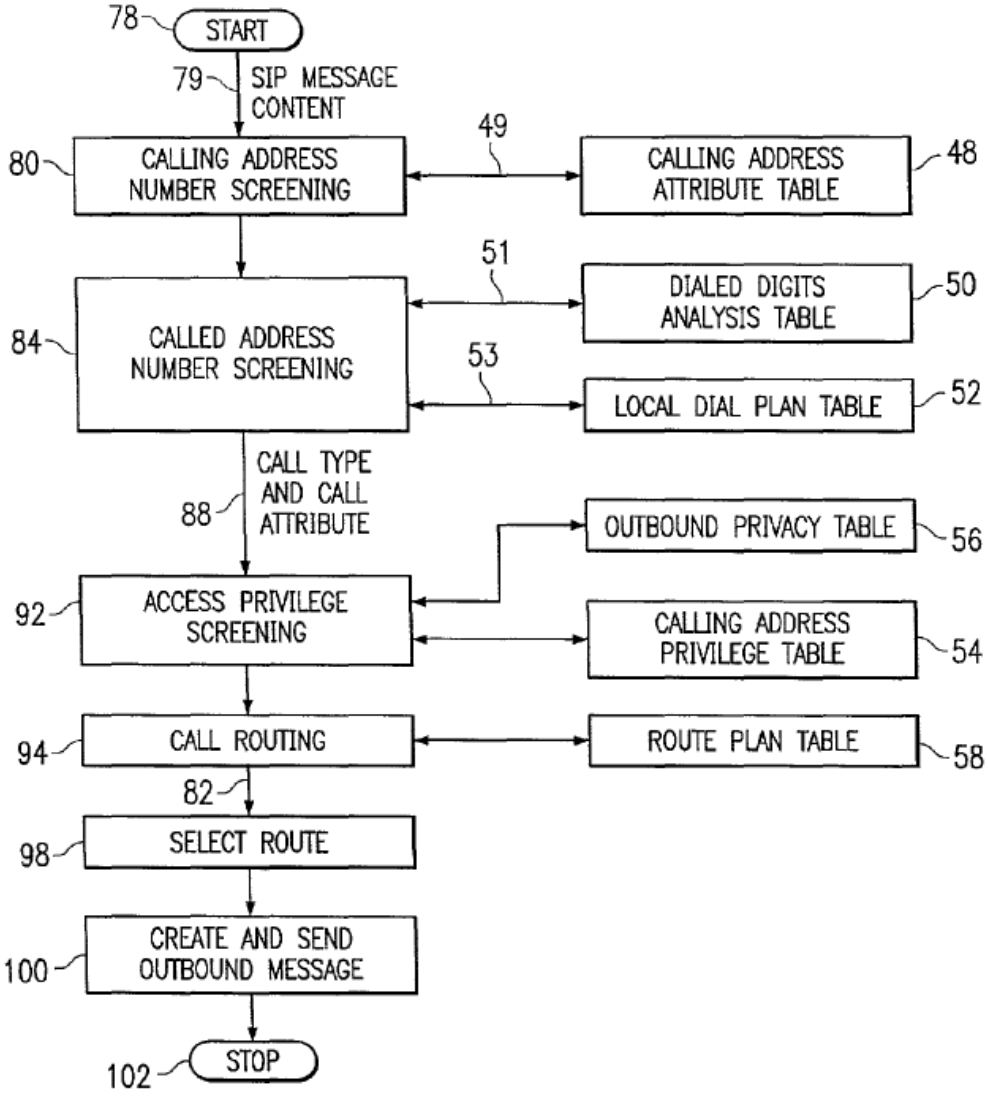
The flow illustrated in FIG. 4B is for calls where the destination of a call originating in the PSTN is known to be the IP network. As noted above in Section II(D)(1), step 406 is responsible for selecting a destination SIP proxy using the SIP Proxy Routing Table 46.

> At a step 406, call control engine 34 routes the call. To do so, remaining data necessary to create and route an SIP message are assembled at step 406. This includes identifying the destination proxy.
>
> [Kaczmarczyk at 11:61-64]

Since SIP messages are specific to the IP network, this selection is specific to calls that are destined for the IP network. Therefore, the flow illustrated in FIG. 4B is for calls where the destination of the call is already known to be the IP network. *See, e.g.*, Kaczmarczyk at 6:18-20, 6:30-36. Thus, Kaczmarczyk discloses that, in the call flow of FIG. 4B, the call always originates from the PSTN (via a SS7 message 396) and that the final call routing step 406 always involves routing to an IP network (via a SIP message). However, there is no disclosure in Kaczmarczyk of *how* the decision was made to route the call to the IP network let alone a teaching of the classifying recited in element [1d]. Thus, Kaczmarczyk fails to disclose or suggest any criteria for deciding, *e.g.*, when a call originating from the PSTN should be classified as an IP network call and routed to an IP network.

Kaczmarczyk also discloses calls originating in the IP network and terminating in the PSTN, as illustrated in FIG. 4A:

FIG. 4A



As noted above in Section II(D)(1), steps 94 and 98 are responsible for selecting a destination circuit within the PSTN network.

> Call control engine 34 uses calling address profile 82 and call type and call attributes 88 to determine the route to use to complete the call request and to formulate the PSTN message to be sent, and provides the determined route, or route set, to resource manager 28 to choose

> the outbound circuit at step 98. [Kaczmarczyk at 10:60-66, emphasis added]

Since these steps are specific to the PSTN network, the flow illustrated in FIG. 4A is for calls where the destination of the call is already known to be the PSTN. *See, e.g.,* Kaczmarczyk at 9:53-59, 10:36-38, 10:46-49. Kaczmarczyk provides other examples of call routing where the destination of the call is already predetermined to be in the PSTN network. Kaczmarczyk at FIGS. 5-14. However, there is no disclosure in Kaczmarczyk of *how* the decision was made to route a call to the PSTN. Thus, Kaczmarczyk fails to disclose or suggest any criteria for deciding when a call originating from the IP network should be classified as a PSTN call and routed to the PSTN.

In view of the above, Kaczmarczyk fails to disclose or suggest "classifying the call as a public network call when said match meets public network classification criteria and classifying the call as a private network call when said match meets private network classification criteria" as recited in element [1d].

b. Petitioner Misstates the Deficiencies of Kaczmarczyk in Erroneously Asserting that Turner Remedies These Deficiencies

Petitioner states that Kaczmarczyk discloses "routing calls across different network such as from an IP network to a PSTN, or from a PSTN to an IP network." Petition at 37. Petitioner then goes on to state that Kaczmarczyk "is silent

regarding routing calls in a private network, such as calls between individuals within an IP network." *Id.* These statements are misleading because they imply that the only distinction between Claim 1 and Kaczmarczyk is the lack of disclosure of calls within a private network, while in fact the distinctions between Claim 1 and Kaczmarczyk are more fundamental.

As explained above, Kaczmarczyk nowhere discloses "public network classification criteria" for classifying a call as a "public network call", or "private network criteria" for classifying a call as a "private network call", even for calls that originate on a private network and terminate on a public network. The Petition mischaracterizes Kaczmarczyk by saying that its only deficiency is the lack of disclosure of routing calls within an IP network because it "focuses on techniques for signaling between IP networks and the PSTN." Petition at 37. As discussed above, the distinctions between Kaczmarczyk and the method of claim 1 are much more fundamental than Petitioner's simplistic presentation of Kaczmarczyk would suggest.

Petitioner argues that Turner remedies the alleged deficiencies of Kaczmarczyk. Petition at 37. But, as discussed above at section II(C)(1)(a), Turner's disclosure of deciding whether or not a call is internal to a gateway also fails to disclose element [1d]. Therefore, neither Kaczmarczyk nor Turner disclose element [1d]. Petitioner does not explain how selected portions of Kaczmarczyk

and Turner would have been obviously assembled in meeting all of the features recited in element [1d]. Accordingly, Kaczmarczyk and Turner, alone or combined, fail to render the subject-matter of Claim 1 obvious.

c. The Petition Fails to Explain How Kaczmarczyk and Turner's Teachings Could be Combined In View of their Significant Differences

Petitioner concludes that it would have been obvious to modify Kaczmarczyk's system to incorporate call routing within an IP network as taught by Turner. Petitioner, however, fails to consider, much less explain, how the teachings of Turner would be incorporated into Kaczmarczyk's system.

Kaczmarczyk's system would have to be significantly re-engineered to work according to Turner's teaching. For example, the Petition relies heavily on Turner in the claim chart for the proposed obviousness combination of Kaczmarczyk with Turner, including the following specific teachings of Turner for claim elements [1d], [1e] and [1f]:

[1d] - Turner at 9:57-63 [citation refers to FIG. 4C]

[1d] - Turner at 12:44-67 [citation refers to FIGS. 4A and 6D]

[1d] - Turner, FIG 4A portion [step 176]

[1d] - Turner at 9:30-36

[1e] - Turner, FIG. 4B portion [steps 183, 184, 186, 188, and 190]

[1e] - Turner at 9:30-33

[1e] - Turner at 10:12-22

[1f] - Turner, FIG. 4C portion [steps 192, 193, 194, 195, 196, and 198]

[1f] - Turner at 9:57-63 [citation refers to FIG. 4C]

[1f] - Turner at 12:44-67 [citation refers to FIGS. 4A and 6D]

[Petition at 40-46, 48-49, 51-52]

Petitioner fails to provide any meaningful discussion of just how each of these passages of Turner would have been applied by a POSITA to modify Kaczmarczyk's system so as to provide each of claim elements [1d], [1e], and [1f].

Petitioner overlooks significant differences between the systems of Kaczmarczyk and Turner that would have made it difficult and non-obvious to apply the teachings of Turner in Kaczmarczyk's system. For example, as noted above in Section II(C)(1), Turner implements a non-traditional, two-level identification scheme for users comprising a Customer Address (CA) and a Network Address (NA). User profiles are identified based on the CA of the user but telephone network locations are identified by the NA of the endpoint. *See, e.g.,* Turner at 2:35-51. When a call is placed, the caller's NA must first be converted into a CA before the user profile can be located, since the relationship between CA and NA can change dynamically. *See, e.g.,* Turner at 14:19-23, 15:36-41, and 26:40-41 ("associations between the customer addresses and network addresses... are dynamically alterable"). In contrast, Kaczmarczyk discloses no

such identification scheme. Callers in Kaczmarczyk's system are identified by their "calling address", which is used to look up Calling Address Attributes. *See, e.g.*, Kaczmarczyk at 7:28-41. Petitioner has not explained how to reconcile these fundamental differences between how callers are identified in Kaczmarczyk's and Turner's systems in the modified system.

Second, as noted above in Section II(C)(1), Turner routes calls within an IP network to an appropriate IP gateway. This involves querying a Directory Server or a Portability Server to identify a current location or endpoint of the callee and the IP gateway associated with the callee's current location. *See, e.g.*, Turner at 7:66-8:14. In contrast, Kaczmarczyk discloses virtually nothing about routing in an IP network. As noted above in Section II(D)(1), the only IP network routing that is discussed in Kaczmarczyk is the selection of a destination SIP proxy for calls routed to the IP network from the PSTN network. *See, e.g.*, Kaczmarczyk at 11:61-63. Petitioner fails to explain how Kaczmarczyk's system should be modified to facilitate Turner's method of routing, much less why such a system would have been obvious.

III. CONCLUSION

For all these reasons, the Petition fails to establish a reasonable likelihood that Claims 1, 2, 7, 27, 28, 29, 34, 54, 72, 73, 74, 92, 93 and 111 of the '815 Patent are unpatentable, therefore the Board should not institute trial in this proceeding.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 26, 2016

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CERTIFICATION UNDER 37 CFR § 42.24

Under the provisions of 37 CFR § 42.24, the undersigned hereby certifies that the word count for the foregoing Response totals 13,695 words, which is less than the 14,000 words allowed under 42.24(b)(1).

CERTIFICATE OF SERVICE

I hereby certify that true and correct copy of **PATENT OWNER'S PRELIMINARY RESPONSE** and Exhibit 2001 is being served on August 26, 2016, via electronic mail pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioners as addressed below:

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