

Docket No. 2020- 1241, 2020- 1244

In the
United States Court of Appeals
For the
Federal Circuit

VOIP-PAL.COM, INC.,

Plaintiff-Appellant,

v.

APPLE, INC.,

Defendant-Appellee.

VOIP-PAL.COM, INC.,

Plaintiff-Appellant,

v.

AMAZON.COM, INC. and AMAZON TECHNOLOGIES, INC.,

Defendants-Appellees.

*Appeal from the United States District Court for the Northern District of California
in Case Nos. 5:18-cv-06216-LHK and 5:18-cv-07020-LHK · United States District Judge Lucy H. Koh*

**COMBINED PETITION FOR PANEL REHEARING
AND REHEARING *EN BANC***

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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 20-1241

Short Case Caption VoIP-Pal.com, Inc. v. Apple Inc.

Filing Party/Entity VoIP-Pal.com, Inc.

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 12/17/2020

Signature: /s/Lewis E. Hudnell, III

Name: Lewis E. Hudnell, III

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>
<p>VoIP-Pal.com, Inc.</p>	<p>VoIP-Pal.com, Inc.</p>	

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable Additional pages attached

5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

None/Not Applicable Additional pages attached

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6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable Additional pages attached

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TABLE OF ABBREVIATIONS

ABBREVIATION	TERM
VoIP-Pal	Plaintiff-Appellant VoIP-Pal.com, Inc.
BB#	VoIP-Pal's Opening Brief at page ##
The '002 patent	U.S. Patent No. 9,826,002
The patents-in-suit	U.S. Patent No. 9,537,762, U.S. Patent No. 9,813,330, the '002 patent, and U.S. Patent No. 9,948,549
FAC	First Amended Complaint
POSITA	Person of Ordinary Skill in the Art

I. STATEMENT OF COUNSEL UNDER FED. CIR. R. 35(B)

Based on my professional judgment, I believe that the panel decision is contrary to the Supreme Court's decisions in *Alice Corp. Pty. v. CLS Bank Int'l*, 573 U.S. 208 (2014) and *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012). I also believe that the panel decision conflicts with this Court's precedent in *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253 (Fed. Cir. 2017). I further believe that that panel decision conflicts with Ninth Circuit precedent in *Lopez v. Smith*, 203 F.3d 1122, 1127 (9th Cir. 2000).

Based on my professional judgment, I believe that this appeal requires an answer to one or more precedent-setting questions of exceptional importance, including:

1. Did the district court err by applying 35 U.S.C. §112 considerations in finding the asserted claims ineligible under 35 U.S.C. §101?
2. Did the district court err by finding the asserted claims ineligible under the *how* test despite accepting as true that the alleged inventive concepts constitute unconventional improvements over the prior art?

3. Did the district court err by failing to give VoIP-Pal the opportunity to amend its FAC to address the §112 considerations raised by the district court's ineligibility analysis?

By: /s/ Lewis E. Hudnell, III
Attorney of Record for Appellant

II. POINTS OF LAW OR FACT OVERLOOKED BY THE PANEL

The Court should rehear this case because the district court’s blended §101/§112 analysis was an egregious misapplication of §101 stemming from this Court’s failure to clearly define where the §101 eligibility inquiry stops and where the §112 inquiry begins. Under the guise of §101 eligibility, the district court wielded the *how* inquiry to bludgeon four VoIP-Pal patents to death. The district court *sua sponte* alleged at least 32 instances where the asserted claims failed to recite the *how* with complete disregard as to whether that *how* invoked §101 eligibility considerations or §112 patentability considerations. The district court raised *how* issues in identifying representative claims, raised *how* issues at step one, and raised *how* issues at step two. The district court even raised *how* issues at step two after it accepted as true that VoIP-Pal’s alleged inventive concepts constituted unconventional improvements over the prior art. Simply put, the district court’s ineligibility analysis far exceeded whatever boundary exists between §101 and §112.

VoIP-Pal respectfully submits that the panel overlooked issues of precedent-setting importance when it affirmed the district court’s opinion without oral argument and without its own opinion. The district court’s opinion squarely raises issues in an area of the law that one judge on the panel—Judge Moore—has called “inconsistent and chaotic” and has declared that the Court is “bitterly divided.” *See Am. Axle & Mfg. v. Neapco Holdings LLC*, 977 F.3d 1379, 1382 (Fed. Cir. 2020)

(Moore, J., concurring). Indeed, Judge Moore sharply criticized the *American Axle* majority for “imbu[ing] §101 with a new superpower—enablement on steroids.” *See Am. Axle & Mfg. v. Neapco Holdings LLC*, 967 F.3d 1285, 1305 (Fed. Cir. 2020) (Moore, J., dissenting). But enablement is exactly the superpower that the district court exercised to invalidate the asserted claims, even more egregiously than in *American Axle*. The district court repeatedly accused the specification of the patents-in-suit for failing to disclose the *how* without even offering VoIP-Pal a fair opportunity to respond. The district court also required that the asserted claims recite far more implementation details than are required to address the preemption concern that undergirds §101. The district court further infused its §101 eligibility analysis with §112 considerations to such a degree that it improperly eliminated the perspective of a POSITA.

The panel’s affirmance of the district court’s overreaching §101 analysis further blurred the already uncertain line between §101 eligibility and §112 and sowed confusion for future cases. Not only have these issues deeply troubled members of the panel, but several other members of the Court have agreed that granting “*en banc* review would provide an opportunity for . . . the full court to consider, where eligibility analysis stops and enablement analysis begins.” *Am. Axle*, 966 F.3d at 1363 (Stoll, J., joined by Newman, Moore, O’Malley, and Reyna, JJ., dissenting from denial of reh’g *en banc*). Accordingly, VoIP-Pal respectfully

submits that a rehearing, either by the panel or *en banc*, is necessary to reconsider these critical §101 eligibility issues that the panel overlooked and that the district court misapprehended.

III. ARGUMENT IN SUPPORT OF REHEARING *EN BANC*, OR IN THE ALTERNATIVE, PANEL REHEARING

A. The Panel Overlooked That The District Court Erroneously Based Its §101 Eligibility Analysis On §112 Considerations.

The Court should rehear this case because the district court’s unbridled use of §112 considerations to invalidate the asserted claims under §101 was improper. As Judge Newman opined in *American Axle*, joined by Judges Moore and Reyna from the panel in this case, “[e]ligibility under Section 101 is not the same as patentability under the substantive statutory provisions of novelty (§102), nonobviousness (§103), and description and enablement (§112).” *See Am. Axle & Mfg. v. Neapco Holdings LLC*, 966 F.3d at 1359 (Newman, J., joined by Moore, O’Malley, Reyna, and Stoll, JJ., dissenting from denial of reh’g *en banc*); *see also BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341, 1354 (Fed. Cir. 2016) (Newman, J., concurring) (“Claims that are imprecise or . . . that are unsupported by description or that are not enabled raise questions of patentability, not eligibility.”). As the Court has noted, “the Supreme Court advised that section 101 eligibility should not become a substitute for a patentability analysis related to prior art, adequate disclosure, or the other conditions and requirements of Title 35.” *See Research Corp. Techs. v.*

Microsoft Corp., 627 F.3d 859, 868 (Fed. Cir. 2010). In rejecting an invitation to substitute the inquiry under other sections of Title 35 for §101, the Supreme Court also expressly warned that shifting “the patent eligibility inquiry entirely to these later sections risks creating significantly greater legal uncertainty.” *See Mayo*, 566 U.S. at 90. But even shifting some of the eligibility inquiry to the later sections, as the district court did in this case, creates great legal uncertainty because the Court has yet to clarify how much shift is too much or whether any shift is allowed at all. This uncertainty is precisely what troubled Judge Stoll in *American Axle* who, also joined by Judges Moore and Reyna, opined that “*en banc* review would provide an opportunity for . . . the full court to consider, where eligibility analysis stops and enablement analysis begins.” *See Am. Axle*, 966 F.3d at 1363 (Stoll, J., joined by Newman, Moore, O’Malley, and Reyna, JJ., dissenting from denial of reh’g *en banc*). Not only is it critically important that the Court rehear this case to determine where the line between eligibility and enablement is, but wherever that line is, the district court far exceeded it.

The *American Axle en banc* majority drew a bright line between eligibility and enablement in describing two distinct *how* requirements in patent law. The eligibility *how* requirement “is that the claim itself . . . must go beyond stating a functional result; it must identify ‘how’ that functional result is achieved by limiting the claim scope to structures specified at some level of concreteness, in the case of

a product claim, or to concrete action, in the case of a method claim.” *See Am. Axle*, 967 F.3d at 1302. The enablement *how* requirement, which is distinct from the eligibility requirement, applies to the specification, not the claims, and requires that once the “concrete physical structures or actions are set out in the claim, the specification must set forth enough information for a relevant skilled artisan to be able to make and use the claimed structures or perform the claimed actions.” *Id.* The district court in this case plainly conflated these two requirements.

Indeed, the following table illustrates numerous examples of the district court mistakenly relying on an alleged lack of *how* in the specification to invalidate the asserted claims on eligibility grounds, which this Court has held is improper. *See Visual Memory*, 867 F.3d at 1261 (“[W]hether a patent specification teaches an ordinarily skilled artisan how to implement the claimed invention presents an enablement issue under 35 U.S.C. §112, not an eligibility issue under §101.”).

District Court Analysis	Text of Order	Citation
Step 1, Claim 1 of '002 patent	<i>The specification lists example attributes (national dialing digits, international dialing digits, country code, local area code, the maximum number of concurrent calls the user is entitled to cause, username; see id. at 18:40-58; 19:37-49), but does not explain</i>	Appx44 (emphasis added)

	<i>how they form a user profile.</i>	
Step 1, Claim 1 of '002 patent	“Yet, <i>the specification does not explain how to ‘identify a subscriber to the private network.’</i> ”	Appx44 (emphasis added)
Step 1, Claim 1 of '002 patent	“Critically, however, the claim and <i>the specification do not explain how to ‘identify’ the appropriate Internet address.</i> ”	Appx45 (emphasis added)
Step 1, Claim 1 of '002 patent	“It is therefore unsurprising that neither the claim <i>nor the specification discloses how to design a communication system that ‘makes it simple to allocate or add new nodes and gateways to particular regions or routes.’</i> ”	Appx57 (emphasis added)
Step 1, Claim 26 of '002 patent	“To begin with, Representative Claim 26 discloses ‘blocking’ in purely functional terms, <i>without explaining how the blocking is accomplished. The claim and the specification are devoid of any details regarding implementation that might ‘add a degree of particularity.’</i> ”	Appx61 (emphasis added)
Step 2	“Because neither the claims <i>nor the specification</i> provided the critical ‘how,’ the	Appx76 (emphasis added)

	improvements are not attributable to the invention as claimed.”	
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Not only do these examples show that the district court erred by applying the enablement *how* requirement despite the fact that enablement was not at issue in this case, but these examples also draw into serious question the validity of the 26 other times that the district court purported to apply an eligibility *how* requirement to the asserted claims. Under the district court’s scattershot *how* analysis, VoIP-Pal has no way of knowing which of the two *how* requirements were fatal to its claims.

The district court’s *how* analysis suffered from the same problem that Judge Stoll criticized in the *American Axle en banc* majority’s *how* analysis—it went further than an eligibility analysis and incorporated a heightened enablement requirement into §101. *See Am. Axle*, 966 F.3d at 1363 (Stoll, J., joined by Newman, Moore, O’Malley, and Reyna, JJ., dissenting from denial of reh’g *en banc*). By raising an endless array of narrow *how* questions, the district court transformed its eligibility inquiry from how the claims achieve a desired goal to the more detailed question of how the invention is implemented. *See* Appx28 (“how” a gateway is selected; “how” multiple gateways are supported); Appx30 (“how the ‘user profile’ is used”); Appx34 (“how” a callee identifier is processed or compared; “how” a node is selected); Appx38 (“how” a caller is notified of error message); Appx44 (“how” attributes form a user profile or are processed; “how” classifying is done; “how”

subscribers are identified); Appx45 (“how” routing message is produced; “how” it establishes communication; “how” address is identified); Appx57 (“how” design facilitates new nodes/gateways); Appx61 (“how” blocking is accomplished and “when”); Appx63 (“how” blocking information is generated and in “what form”); Appx65 (“how” error criteria are determined); BB51-52. As Judge Reyna recognized in *Amdocs*, the level of *how* required to satisfy the eligibility inquiry is not especially exacting: “the recited way of accomplishing the goal need not be extensively detailed or even complete. Rather, it must meaningfully limit the claim to a manner of achieving the desired result without unduly foreclosing future innovation.” *See Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1315 (Fed. Cir. 2016) (Reyna, J., dissenting); *see also Am. Axle*, 966 F.3d at 1363 (Stoll, J., joined by Newman, Moore, O’Malley, and Reyna, JJ., dissenting from denial of reh’g *en banc*) (“[A] claim can be specific enough to be directed to an application of a law of nature—which is patent eligible—without reciting how to perform all the claim steps.”). The level of detail that the district court required far exceeded that necessary to determine the eligibility of the asserted claims. *Cf. Koninklijke KPN N.V. v. Gemalto M2M GmbH*, 942 F.3d 1143, 1148, 1151, 1153 (Fed. Cir. 2019).

Further evidence that the district court mistakenly applied an enablement analysis and not an eligibility analysis is that the district court did not aim its *how* inquiry at determining whether the asserted claims preempted the alleged abstract

idea of routing communications based on characteristics of the participants. Although the district court addressed preemption, it did so only *after* it applied its flawed ineligibility analysis. Appx150 (“Hence, where a court has deemed a claim to disclose only patent-ineligible subject matter under the *Alice* framework—as the Court has in the instant case—‘preemption concerns are fully addressed and made moot.’”). Instead, as shown above, the district court focused its eligibility inquiry on narrow details of how each element of the claims is implemented, which undermines the role of §112. *See Treehouse Avatar LLC v. Valve Corp.*, 170 F. Supp. 3d 706, 718 (D. Del. 2016) (“[I]t is less than clear how a §101 inquiry that is focused through the lens of specificity can be harmonized with the roles given to other aspects of the patent law (such as enablement under §112 . . .), especially in light of the Federal Circuit’s past characterization of §101 eligibility as a ‘coarse’ gauge of the suitability of broad subject matter categories for patent protection.”). The district court’s improper focus on implementation details rather than preemption concerns is the same type of focus that Judge Moore disagreed with in the *American Axle* panel decision: “[t]he majority’s concern is not preemption of a natural law (which should be the focus) but rather that the claims do not teach a skilled artisan how to tune a liner without trial and error.” *See Am. Axle*, 967 F.3d 1285, 1316 (Fed. Cir. 2020) (Moore, J., dissenting); *see also* Mark A. Lemley, et al., *Life After Bilski*, 63 Stan. L. Rev. 1315, 1330 (2011) (“The question is not whether one could make

the embodiments claimed, but rather whether the inventor has contributed enough to merit a claim so broad that others will be locked out.”). By affirming the district court’s decision without opinion, Judge Moore and the rest of the panel tacitly endorsed the enablement-infused ineligibility analysis that has caused sharp division within the Court and that needs to be addressed head on.

The panel’s unwillingness to use this case to clarify the boundary between §101 and §112 is particularly distressing because not only have several members of the Court recognized the impropriety of using §112 considerations to invalidate claims under §101, but several district courts across the country have rejected that practice as well. *See Stormborn Techs., LLC v. Topcon Positioning Sys.*, 444 F. Supp. 3d 1119, 1125 n.3 (N.D. Cal. 2020) (“Whether or not these steps are specific enough to detail how to implement the claimed invention is better suited for a challenge under section 112.”); *Avocent Huntsville, LLC v. ZPE Sys.*, Case No. 3:17-cv-04319-WHO, 2018 U.S. Dist. LEXIS 47655, at *20 (N.D. Cal. Mar. 21, 2018); *Treehouse Avatar*, 170 F. Supp. 3d at 718; *Prompt Med. Sys., L.P. v. Allscripts Healthcare Solutions, Inc.*, 6:10-cv-71, 2012 U.S. Dist. LEXIS 30694, at *21-22 (E.D. Tex. Feb. 13, 2012). If the Court truly wants to bring uniformity and certainty to its §101 jurisprudence, then it should rehear this case and reject the district court’s blended §101/§112 analysis. Otherwise, district courts will continue to invalidate claims with little regard for Congress’s carefully crafted statutory framework.

B. The Panel Overlooked That The District Court Misused The *How* Test At Step Two.

The panel also critically overlooked that the district court erred in using the *how* test to undo its acceptance at step two that VoIP-Pal's alleged inventive concepts constitute unconventional improvements over the prior art. This Court has firmly established "that the second step of the *Alice/Mayo* test is satisfied when the claim limitations involve more than performance of well-understood, routine, [and] conventional activities previously known to the industry." *See Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121, 1128 (Fed. Cir. 2018) (internal quotations omitted). The district court expressly "accepted as true [VoIP-Pal's] allegations that (1) user-specific handling, (2) transparent routing, (3) resiliency, and (4) communications blocking are significant and *unconventional improvements upon prior technology.*" Appx76 (emphasis added); *see also* Appx54. Accepting VoIP-Pal's factual allegations that these improvements constitute unconventional improvements over the prior art should have ended the step-two inquiry in VoIP-Pal's favor. *See Aatrix*, 882 F.3d at 1129 ("In light of the allegations made by [patentee], the district court could not conclude at the Rule 12(b)(6) stage that the claimed elements were well-understood, routine, or conventional.").

Instead, the district court erroneously added a third step to the two-step *Alice* inquiry. That is, even though VoIP-Pal articulated unconventional improvements over the prior art, "the Court nevertheless rejected these improvements on the ground

that the Patents-in-Suit did not disclose how to achieve them.” Appx76. The district court’s reference to “the Patents-in-Suit” again exhibits its misunderstanding of the two *how* requirements identified by the *American Axle en banc* majority. Indeed, in the very next sentence, the district court reiterated its mistaken belief that ineligibility can be based on the *specification’s* failure to disclose the *how*: “[b]ecause neither the claims *nor the specification* provided the critical ‘how,’ the improvements are not attributable to the invention as claimed.” *Id.* (emphasis added). But more troubling, the district court compounded its error by using the *how* test to trump VoIP-Pal’s factual allegations that the district court expressly accepted as true.

The only authority that the district court cited for applying the *how* test at step two was *Two-Way Media Ltd v. Comcast Cable Communs., LLC*. *Id.* In *Two-Way Media*, the Court found that the claims-at-issue did not recite the alleged inventive concept and used only generic functional language to achieve other purported solutions. *Two-Way Media Ltd v. Comcast Cable Communs., LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017). Consequently, the Court, relying on *Electric Power Group v. Alstom*, turned its inquiry “to any requirement for how the desired result is achieved.” *Id.* (citing *Elec. Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016)). But unlike *Two-Way Media* and *Electric Power*, the district court did not reject the asserted claims at step two because they allegedly do not recite

user-specific handling, transparent routing, resiliency, and communications blocking. Rather, the district court rejected these inventive concepts because the asserted claims allegedly do not recite the *how*. Appx71, Appx76. But a closer reading of both *Two-Way Media* and *Electric Power* reveals that the Court, in determining how the claims-at-issue achieved their desired result, rejected the claims-at-issue because they did not recite nonconventional components or a nonconventional and nongeneric arrangement of known, conventional pieces. *See Two-Way Media*, 874 F.3d at 1339 (citing *BASCOM*, 827 F.3d at 1350); *Electric Power*, 830 F.3d at 1355 (citing *BASCOM*, 827 F.3d 1341). Thus, the not-well understood, nonroutine, and unconventional nature of VoIP-Pal's alleged inventive concepts *is* the relevant inquiry at step two. And, as explained above, the district court found that the alleged inventive concepts were unconventional. Appx76. Thus, the district court had no basis for not attributing the inventive concepts to the asserted claims, even under the *how* test, and for concluding that the eligibility of the claims turned on something other than their unconventionality. *Id.* The panel overlooked this critical misstep.

C. The Panel Overlooked That The District Court Failed To Allow VoIP-Pal To Cure Alleged Deficiencies With The Knowledge Of A POSITA.

Lastly, the Court should rehear this case because the district court *sua sponte* raised improper *how* questions and failed to give VoIP-Pal the chance to cure its

FAC as it was required to do at the Rule 12 stage. As VoIP-Pal stated in its Opening Brief, under Ninth Circuit law, “a district court should grant leave to amend *even if no request to amend the pleading was made*, unless it determines that the pleading could not possibly be cured by the allegation of other facts.” BB15 (citing *Lopez v. Smith*, 203 F.3d 1122, 1127, 1130 (9th Cir. 2000) (*en banc*) (quoting *Doe v. United States*, 58 F.3d 494, 497 (9th Cir.1995)) (emphasis added). Not only did the district court make no finding that VoIP-Pal’s FAC could not be cured by alleging additional facts, but the district court’s blended §101/§112 analysis was fundamentally unfair. To the extent that the district court’s *how* questions invoked §112 considerations, the district court should have afforded VoIP-Pal the opportunity to allege facts showing that a POSITA would know the answer to those questions. Because the district court did not give VoIP-Pal that opportunity, it effectively eliminated the knowledge of a skilled artisan, which is required for §112 considerations, from its ineligibility analysis. *See also Visual Memory*, 867 F.3d at 1261 (quoting *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986)). This error is also one of the problems that troubled Judge Moore in *American Axle*: “[t]he majority’s new blended 101/112 defense is confusing . . . and eliminates the knowledge of a skilled artisan.” *See Am. Axle*, 967 F.3d at 1316 (Moore, J., dissenting). Worse, the district court rejected VoIP-Pal’s detailed proffer of expert evidence, which could have helped the district court answer its *how* questions and

provided additional plausible allegations supporting eligibility. Appx76. Legal commentators have also noted that eliminating the perspective of a POSITA in the context of an eligibility analysis is particularly troublesome at the Rule 12 stage because it allows the district court to substitute its own perspective for that of a POSITA. *See, e.g.,* Raymond A Mercado, *Resolving Patent Eligibility and Indefiniteness in Proper Context: Applying Alice and Aristocrat*, 20 Va. J.L. & Tech. 240, 250, 257 (2016) (observing that “[s]ince *Alice*, the trend has been for eligibility to be resolved on the pleadings or via motions to dismiss” and arguing that “[c]ourts are improperly resolving these cases in a vacuum, substituting their own perspective for that of the skilled artisan and ignoring critical fact issues.”); Timothy R. Holbrook & Mark D. Janis, *Patent-Eligible Processes: An Audience Perspective*, 17 Vand. J. Ent. & Tech. L. Rev. 349, 362, 382 (2015) (observing that courts are deciding eligibility with “virtually nothing to guide and focus the judicial imagination,” a “dynamic [that] becomes particularly salient when considering the procedural posture of these cases – motions to dismiss under Rule 12(b)(6) or 12(c)” and arguing against the courts’ “problematic” practice of “kick[ing] the hypothetical person of ordinary skill in the art to the curb in favor of a discretionary analysis [by the court] that need not be constrained to establish qualifying prior art evidence”). Unless this Court reconsiders whether the district court’s §112 considerations were improper in a §101 eligibility analysis, this erroneous practice will persist.

IV. CONCLUSION

In conclusion, the district court committed at least three reversible errors that the panel's decision failed to address. Accordingly, VoIP-Pal respectfully requests that the Court grant its petition for panel rehearing or rehearing *en banc* to reconsider the important precedent-setting questions raised by these errors.

Dated: December 17, 2020

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

This brief complies with the type-volume limitation of Federal Circuit Rule 35(e)(5) because this brief contains 3,894 words, excluding the parts of the brief exempted by Federal Circuit Rule 35(c)(2).

Dated: December 17, 2020

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ADDENDUM

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

VOIP-PAL.COM, INC.,
Plaintiff-Appellant

v.

APPLE, INC.,
Defendant-Appellee

2020-1241

Appeal from the United States District Court for the Northern District of California in No. 5:18-cv-06216-LHK, Judge Lucy H. Koh.

VOIP-PAL.COM, INC.,
Plaintiff-Appellant

v.

**AMAZON.COM, INC., AMAZON TECHNOLOGIES,
INC.,**
Defendants-Appellees

2020-1244

Appeal from the United States District Court for the Northern District of California in No. 5:18-cv-07020-LHK, Judge Lucy H. Koh.

JUDGMENT

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THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (MOORE, REYNA, and TARANTO, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

November 3, 2020
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

CERTIFICATE OF SERVICE

I hereby certify that on December 17, 2020, I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit by using the appellate CM/ECF system.

I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

Dated: December 17, 2020

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