Trials@uspto.gov
Tel: 571-272-7822

Paper 11
Date: December 19, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

VOIP-PAL.COM, INC.,
Patent Owner.

IPR2022-01073
Patent 8,630,234 B2

Before MITCHELL G. WEATHERLY, TERRENCE W. McMILLIN, and CHRISTOPHER L. OGDEN, *Administrative Patent Judges.*

WEATHERLY, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Google LLC ("Petitioner") filed a petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 30–33, 35, 37–40, 43, 45–48, 51, 53, 54, 61, 62, 64, 65, 70, 72, and 75 (the "challenged claims") of U.S. Patent No. 8,630,234 B2 (Ex. 1001, "the '234 patent"). 35 U.S.C. § 311.

VoIP-pal.com, Inc. ("Patent Owner") timely filed a Preliminary Response. Paper 6 ("Prelim. Resp."). With our prior authorization, Petitioner filed a Reply to the Patent Owner Preliminary Response (Paper 7), and Patent Owner filed a Surreply in response to the Reply (Paper 8). Institution of an *inter partes* review is authorized by statute when "the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). Based on our review of the record, we conclude that Petitioner has failed to demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims, and we do not institute *inter partes* review.

Petitioner challenges the patentability of claims as follows:

Claim(s) challenged	35 U.S.C. §[1]	Reference(s)
30, 31, 33, 40, 45	102	Teodosiu[2]
32, 43, 46–48, 61, 62, 64, 65, 72, 75	103	Teodosiu
35, 51	103	Teodosiu, Kaal[3]

[1] The Leahy-Smith America Invents Act ("AIA") included revisions to 35 U.S.C. §§ 102 and 103 that became effective March 16, 2013. Because the application for the '234 patent was filed on July 28, 2009, we apply the pre-AIA versions of §§ 102, 103.

[2] US 2008/0137642 A1, published June 12, 2008 (Ex. 1005, "Teodosiu").

[3] US 2008/0144578 A1, published June 19, 2008 (Ex. 1006, "Kaal").

Claim(s) challenged	35 U.S.C. §[1]	Reference(s)
37, 53	103	Teodosiu, Guedalia[4]
38, 39, 54, 70	103	Teodosiu, Nix[5]
30–33, 40, 43, 45–48, 61, 62, 64, 65, 72, 75	103	Teodosiu, Rosenberg[6]
35, 51	103	Teodosiu, Rosenberg, Kaal
37, 53	103	Teodosiu, Rosenberg, Guedalia
38, 39, 54, 70	103	Teodosiu, Rosenberg, Nix

Generally, Patent Owner contends that the Petition should be denied in its entirety. On April 24, 2018, the Supreme Court held that, under 35 U.S.C. § 314, the Office may not institute review of fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). For the reasons expressed below, we decline to institute *inter partes* review of the challenged claims on any of the alleged grounds of unpatentability.

B. Related Proceedings

The parties identify the following related proceedings: *VoIP-Pal.com, Inc. v. Amazon.com, Inc.*, No. 6-21-cv-00668 (W.D. Tex.); *VoIP-Pal.com, Inc. v. Verizon Communications Inc. et al*, No. 6-21-cv-00672 (W.D. Tex.); *VoIP-Pal.com, Inc. v. T-Mobile US, Inc. et al*, No. 6-21-cv-00674 (W.D. Tex.); *Cellco Partnership d/b/a Verizon Wireless Inc. et al v. VoIP-Pal.com,*

[4] US 2008/0167039 A1, published July 10, 2008 (Ex. 1007, "Guedalia").

[5] US 2007/0127449 A1, published June 7, 2007 (Ex. 1014, "Nix").

[6] US 2002/0102973 A1, published Aug. 1, 2002 (Ex. 1021, "Rosenberg").

Inc., No. 3-21-cv-05275 (N.D. Cal.); *VoIP-Pal.com Inc. v. Samsung Electronics Co., Ltd. et al*, No. 6-21-cv-01246 (W.D. Tex.); *VoIP-Pal.com Inc. v. Huawei Technologies Co., Ltd. et al*, No. 6-21-cv-01247 (W.D. Tex.); and *VoIP-Pal.com, Inc. v. Google, LLC f/k/a Google Inc.*, No. 3-22-cv-03199 (N.D. Cal.). Pet. 1–2; Paper 5, 2.

Petitioner further identifies the following related proceedings: *VoIP-Pal.com, Inc. v. Samsung Electronics Co., Ltd. et al*, No. 1-21-cv-01084 (W.D. Tex.); *VoIP-Pal.com, Inc. v. Huawei Technologies Co., Ltd. et al*, No. 1-21-cv-01085 (W.D. Tex.); *Apple Inc. v. VoIP-Pal.com, Inc.*, No. 3-21-cv-05110 (N.D. Cal.); *AT&T Corp. et al. v. VoIP-Pal.com, Inc.*, No. 3-21-cv-05078; *VoIP-Pal.com, Inc. v. Facebook, Inc. et al*, No. 6-21-cv-00665 (W.D. Tex.); *VoIP-Pal.com, Inc. v. Google, LLC f/k/a Google Inc.*, No. 6-21-cv-00667 (W.D. Tex.) (transferred to N.D. Cal.); *VoIP-Pal.com, Inc. v. Apple Inc.*, No. 6-21-cv-00670 (W.D. Tex.); and *VoIP-Pal.com, Inc. v. AT&T Corp. et al*, No. 6-21-cv-00671 (W.D. Tex.). Pet. 1–2.

Patent Owner further identifies the following related proceedings: *Twitter, Inc. v. VoIP-Pal.com, Inc.*, No. 3-21-cv-09773 (N.D. Cal.); and *VoIP-Pal.com, Inc. v. Meta Platforms, Inc. et al*, No. 3-22-03202 (N.D. Cal). Paper 5, 2.

Petitioner further states it is concurrently filing another *inter partes* review petition challenging the ’234 patent.[7] Pet. 3. Petitioner additionally states the ’234 patent is related to U.S. Patent No. 10,880,721 B2 (“the ’721 patent”), which is also at issue in the above-referenced civil actions,

[7] The ’234 patent is challenged in eight pending IPRs: IPR2022-01072, IPR2022-01073, IPR2022-01178, IPR2022-01179, IPR2022-01231, IPR2022-01232, IPR2022-01390, IPR202-01391.

and that Petitioner is concurrently filing *inter partes* review petitions challenging the '721 patent.[8] *Id.*

C. The '234 Patent

The '234 patent is titled "Mobile Gateway." Ex. 1001, code (54). The '234 patent is directed to a method of initiating a call to a callee using a mobile telephone. *Id.* at 1:36–38. The method involves receiving, from a user of the mobile telephone, a callee identifier associated with the callee. *Id.* at 1:38–40. The method further involves transmitting an access code request message to an access server, where the access code request message includes the callee identifier. *Id.* at 1:40–42. The method further involves receiving an access code reply message from the access server in response to the access code request message, where the access code reply message includes an access code different from the callee identifier and associated with the callee identifier. *Id.* at 1:42–46. The method further involves initiating a call with the mobile telephone using the access code to identify the callee. *Id.* at 1:46–47. Figure 1 of the '234 patent is reproduced below.

[8] The '721 patent is challenged in eight pending IPRs: IPR2022-01074, IPR2022-01075, IPR2022-01180, IPR2022-01181, IPR2022-01234, IPR2022-01235, IPR2022-01392, IPR202-01393.

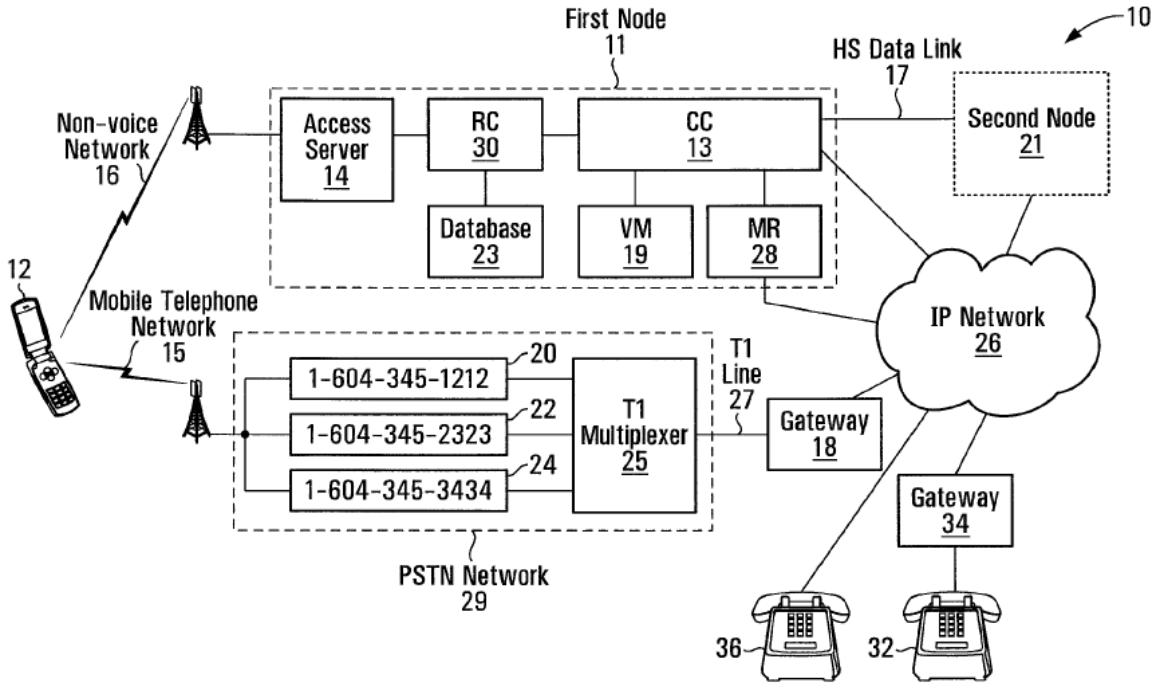

FIG. 1

Figure 1 depicts a system 10 for enabling a mobile telephone to initiate a call to a callee. *Id.* at 8:29–30. The system 10 includes a first node 11, a second node 21, and a mobile telephone 12. *Id.* at 8:30–32. The first and second nodes 11 and 21 support "voice-over-IP" (VoIP) calls between telephones and/or videophones using the Internet Protocol (IP). *Id.* at 8:33–36. The first node 11 includes a call controller (CC) 13, an access server 14, a routing controller (RC) 30, a database 23, a voicemail server 19, and a media relay 28. *Id.* at 8:62–64. The system 10 further includes a gateway 18 in communication with at least one, and preferably, a plurality of channels 20, 22, and 24, to which the mobile telephone 12 may initiate a call over the mobile telephone network 15. *Id.* at 9:18–22. The channels 20, 22, and 24, are configured to cooperate with an IP network 26 via gateway 18 to cause a call involving the mobile telephone 12 and the callee to be routed through the IP network in response to a call received at one of the channels. *Id.*

at 9:54–58. The access server 14 is in communication with the routing controller 30 of the first node 11, and the routing controller 30 is configurable to associate a callee identifier with one of the channels 20, 22, and 24. *Id.* at 9:59–63.

Figure 3, reproduced at right, depicts a flow chart 100 that directs a microprocessor 52 (not shown in Figure 2) to initiate a call with the mobile telephone 12 to a callee. *Id.* at 11:23–26. The processor 100 begins at 102, and, upon initiation of the process 100, block 140 directs the microprocessor 52 to obtain a callee identifier. *Id.* at 11:34–37. The callee identifier is associated with a desired callee. *Id.* at 11:39–40. Block 106 directs the microprocessor 52 to transmit an access code request message, the access code request message including the callee identifier obtained at block 104. *Id.* at 11:44–48. The process 100 continues at block 130, which directs the microprocessor 52 to receive an access code reply message from the access server 14 in response to the access code request message that was transmitted at block 106. *Id.* at 12:55–59. Further, block 149 directs the microprocessor 52 to initiate a call with the mobile telephone 12 on the mobile telephone network 15 using the access code received in the access code reply message. *Id.* at 13:29–33.

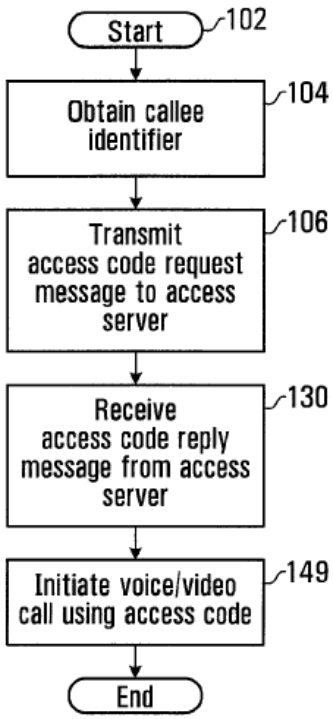

FIG. 3

Claims 30, 46, and 62 are the independent claims among the challenged claims. Claim 30, which is illustrative, recites:

> 30. [a] A method for enabling mobile telephone roaming, the method comprising:

[b] receiving from the mobile telephone an access code request message including a callee identifier associated with the callee and ***a location identifier separate and distinctive from said callee identifier, identifying a location of the mobile telephone***;

[c] producing ***an access code identifying a communication channel based on said location identifier*** and/or based on a location pre-associated with the mobile telephone,

[d] said access code being different from the callee identifier and useable by the mobile telephone to initiate a call to the callee using the channel, and

[e] wherein said access code expires after a period of time and

[f] wherein producing said access code comprises selecting said access code from a pool of access codes,

[g] wherein each access code in said pool of access codes identifies a respective telephone number or Internet Protocol (IP) network address; and

[h] transmitting an access code reply message including said access code, to the mobile telephone.

Id. at 38:5–25 (with certain line breaks and letter designations added to aid discussion) (emphasis added).

II. ANALYSIS

A. Claim Interpretation

We interpret claims in the same manner used in a civil action under 35 U.S.C. § 282(b) "including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent." 37 C.F.R. § 42.100(b). When applying that standard, we interpret the claim language as it would have been understood by one of ordinary skill in the art in light of the specification. *Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*,

853 F.3d 1272, 1279–80 (Fed. Cir. 2017). Thus, we give claim terms their ordinary and customary meaning as understood by an ordinarily skilled artisan. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

We determine that it is not necessary to expressly interpret any claim language in order to decide whether to institute review.

B. Legal Standards

"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., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), reaffirmed the framework for determining obviousness as set forth in *Graham v. John Deere Co*., 383 U.S. 1 (1966). The *KSR* Court summarized the four factual inquiries set forth in *Graham* that we apply in determining whether a claim is reasonably likely to be unpatentable as obvious under 35 U.S.C. § 103(a) as follows: (1) determining the scope and content of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, (3) resolving the level of ordinary skill in the pertinent art, and (4) considering objective evidence indicating obviousness or nonobviousness. *KSR*, 550 U.S. at 406. With these standards in mind, we address each challenge below.

C. Prior Art

In our analysis of the challenges to the claims, we discuss Teodosiu, Kaal, and Guedalia. Summaries of these references are provided below.

1. Teodosiu

Teodosiu is titled "Mobile Device Call to Computing Device." Ex. 1005, code (54). Teodosiu discloses technology that enables a mobile device to make a call to a contact that is logged into a communication service at a computer. *Id.* ¶ 6. Figure 3 of Teodosiu is reproduced at right and is a flowchart describing a method for establishing an audio connection between a mobile device and a computer. *Id.* ¶ 55. At step 310, a first request is received by a network server from the mobile device. *Id.* The request is made to establish a call from the mobile device to a contact through a computer application. *Id.* At step 320, a VoIP phone number is provided to the mobile device from the network server. *Id.* ¶ 56. The VoIP phone number may be selected based on the phone number of the mobile device. *Id.* At step 330, a first call to the VoIP phone number is received by the Voice to IP System from the mobile device. *Id.* ¶ 57. The call is made to the VoIP system phone number provided to the mobile device. *Id.*

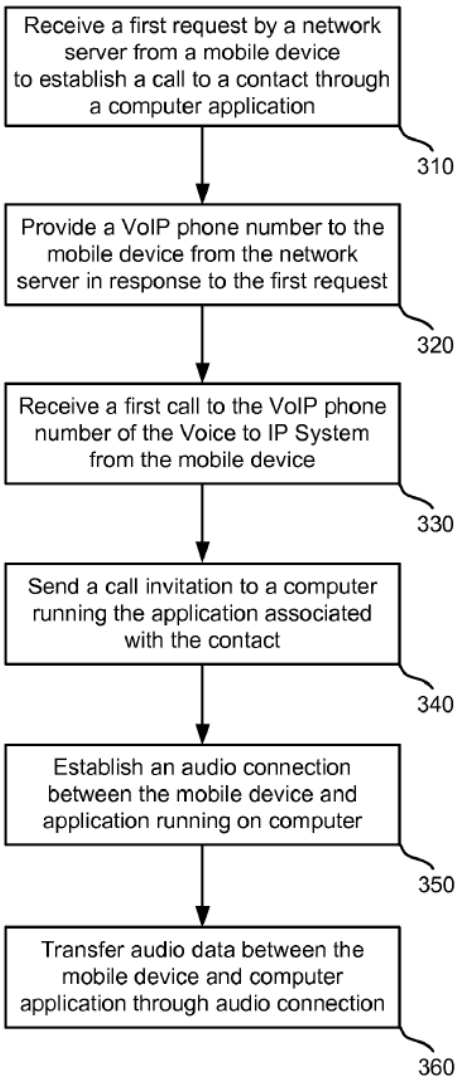

Figure 3

Next, at step 340, a call invitation is sent to the computer which runs an application. *Id.* The call invitation is sent by a soft switch through a Session Internet Protocol (SIP) proxy to the machine or set of machines where the selected contact is currently logged into a messaging service. *Id.* At step 350, an audio connection is established between the mobile device and an application running on the computer. *Id.* ¶ 58. The audio connection can be a hybrid connection consisting of a voice connection between the mobile device and a Voice to IP gateway and a VoIP connection between the Voice to IP gateway and the computer. *Id.* After establishing the audio connection, at step 360, audio data may be transferred between the mobile device and the computer application through an audio connection. *Id.* ¶ 59.

2. Kaal

Kaal is titled "Communication System." Ex. 1006, code (54). Kaal discloses a method for handling communication in a communication system. *Id.* ¶ 2. Figure 1 of Kaal is reproduced below.

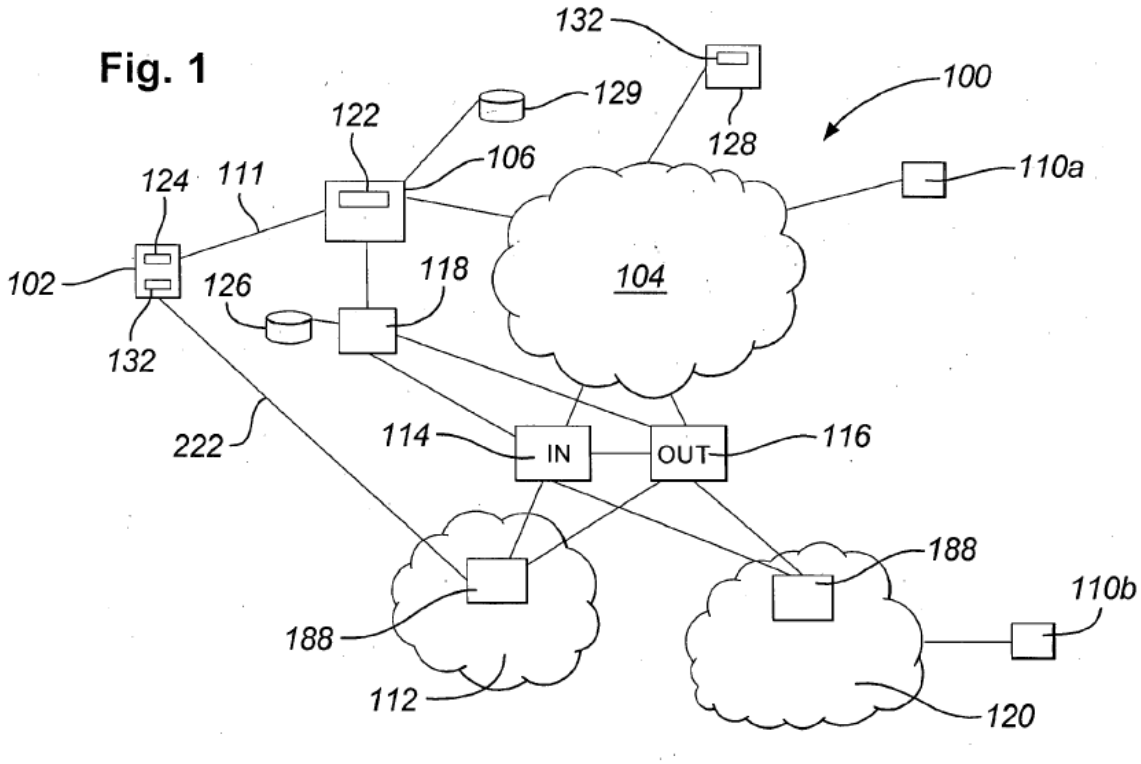

Figure 1 depicts a communication network 100. *Id.* ¶ 26. Communication network 100 includes a peer to peer system 104 operating on a packet switched network (e.g., the internet), and Public Switched Telephone Network (PSTN) networks 112 and 120. *Id.* A user device 102 is connected to the peer to peer system 104 via a session node 106. *Id.* ¶ 27. The user device 102 is also connected to the PSTN network 120. *Id.* The session node 106 runs a communication instance 122 defining a session dedicated to a user of the user device 102. *Id.* ¶ 30. The communication instance 122 enables the user of the user device 102 to communicate across the communication network 100 to establish a connection with another device enabled to communicate via the peer to peer system 104. *Id.* The communication instance 122 allocates the other device a PSTN number that is transmitted and interpreted by both the PSTN network 120 and the peer to peer system 104. *Id.* ¶ 76.

3. Guedalia

Guedalia is titled "Methods and Systems of Providing Local Access Number Calling Features." Ex. 1007, code (54). Guedalia discloses a method of, and a system for, providing a local access number to a subscriber. *Id.* ¶¶ 7, 10. Figure 6 of Guedalia is reproduced at right and is a flowchart describing a method of placing a long-distance call using a local access number. *Id.* ¶ 38. At 600, a subscriber who wants to make a third-party long-distance call registers for a long-distance service using a browser on his mobile device. *Id.* At 605, upon registration, the subscriber provides locale information, such as a local telephone number with an area code. *Id.* At 610, the locale information is processed by the server, and, at 615, the subscriber receives a list of one or more long-distance service providers. *Id.* At 620, the subscriber selects a long-distance provider, and, at 625, the subscriber receives a local access number based on the selected long-distance provider on his mobile device. *Id.*

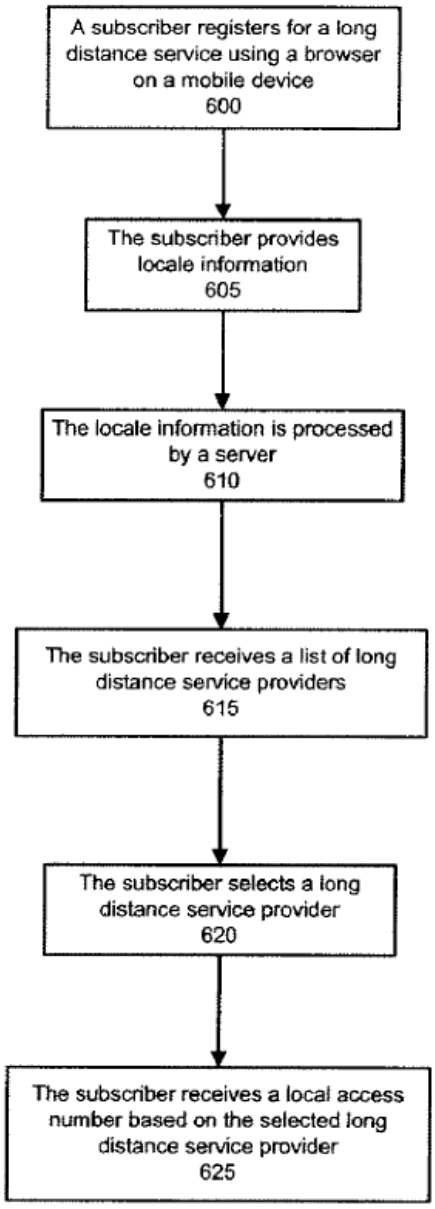

FIG. 6

D. Discussion of the Challenges to the Claims

For all its grounds, Petitioner relies on Teodosiu for allegedly disclosing "a location identifier separate and distinctive from said callee identifier, said location identifier identifying a location of the mobile telephone" as recited in each of the challenged independent claims of the

'234 patent. *See* Pet. 19–21 (claim 30), 44–45 (claim 46), 56 (claim 62). Petitioner relies on its showing as to this limitation of claim 30 for each of the other independent claims. *Id.* Because the Petitioner fails to establish that Teodosiu discloses this limitation, we determine that the Petition does not show a reasonable likelihood that the Petitioner would prevail in showing any of the challenged claims are unpatentable.

All the challenged independent claims of the '234 patent require, receiving and access code request message from the mobile telephone "including . . . a location identifier . . . identifying a location of the mobile telephone."[9] Ex. 1001, 38:7–11 (claim 30), 39:33–37 (claim 46), 41:4–8 (claim 62). In an effort to establish Teodosiu teaches this limitation, the Petition states: "[Teodosiu's] mobile device 110 phone number includes "geographic information" (EX1005, cl. 12), such as an area code (*id*. ¶[0066].) An area code of a device's phone number identifies an area/location in which the device may be located. (EX1002 ¶¶87-89; EX1005 ¶[0066]; *see also* EX1001, 18:29-37, 18:9-27; EX1020 ¶¶[0027], [0070].)" Pet. 19. Petitioner's basis for its assertion that Teodosiu discloses receiving an access code request message from a mobile telephone including a "location identifier identifying a location of the mobile telephone" is that Teodosiu discloses its mobile phone transmitting its phone number which includes an area code. *See id.* at 20. And, Petitioner argues that the area code identifies the location of the mobile telephone "because it is used to

[9] Neither party argued that any explicit claim construction was necessary for the phrase "a location identifier identifying a geographical location of the wireless device." *See* Pet. 9–16; Prelim. Resp. 20–30. Accordingly, we apply the ordinary and customary meaning to this phrase and the terms in this phrase.

select a VoIP phone number in close geographic vicinity to the device" *Id.* at 24 (citing Ex. 1005 ¶ 93). Later, Petitioner recognizes that a mobile telephone may be outside the geographic area associated with its area code, but argues that an ordinarily skilled artisan would still consider the area code to be a "location identifier" because a mobile device would "typically be located within such a geographic area." *Id*.

The cited paragraph 66 in Teodosiu provides:

> Network server 130 receives the confirmation message from call registration server 140 at step 530. Next, network server 130 selects a phone number associated with Voice to IP system 190 that is based on the mobile device phone number at step 540. In some embodiments, network server 130 selects a Voice to IP system phone number which is close in geographic vicinity to the phone number associated with mobile device 110. A Voice to IP system phone number that is close geographically to mobile device 110 may reduce the costs associated with a call between mobile device and the particular selected phone number. For example, the selected VoIP phone number may have the same area code as the mobile device phone number.

Ex. 1005 ¶ 66. In this paragraph, Teodosiu is determining what phone number to supply to the mobile device to use to access the VoIP system. *See id.* ¶¶ 67–69. Teodosiu discloses selecting a VoIP phone number with the same area code as the mobile device phone number and "which is close in geographic vicinity to the phone number associated with mobile device 110." *Id.* ¶ 66.

But Patent Owner argues, and we agree, that the area code in the phone number of Teodosiu's mobile device is not "a location identifier identifying a location of the mobile telephone." *See* Prelim. Resp. 31–38. The area code does not change as the geographical location of the mobile telephone changes. The area code of the phone number associated with the

mobile device does not identify the geographical location of the mobile telephone.

Teodosiu does not disclose otherwise. Teodosiu uses the phone number of the mobile device to select a VoIP phone number "which is close in geographic vicinity to the phone number associated with mobile device 110." Ex. 1005 ¶ 66. And, because the location of the mobile device is not identified by the area code of the phone number associated with the mobile device, by disclosing transmission of the mobile device phone number (*id.* ¶ 63, Fig. 4 (ref. no. 440)), Teodosiu does not disclose "receiving/receive from the mobile telephone an access code request message including . . . a location identifier . . . identifying a location of the mobile telephone" as recited in independent claims 30, 46, and 62 of the '234 patent.

For this limitation, the Petitioner also relies on paragraphs 87–89 and 93 of the Mir Declaration. *See* Pet. 19–20 (citing Ex. 1002 ¶¶ 87–89, 93). We have considered the Mir Declaration and determine that it does not support finding that Teodosiu discloses receiving an access code request message including "a location identifier identifying a location of the mobile telephone" as recited in each independent claim of the '234 patent by disclosing transmission of the mobile device's phone number. The Mir Declaration states: "[a] person of ordinary skill in the art would have understood that an area code associated with a device's phone number can identify an area (e.g., location) in which the device may be located." Ex. 1002 ¶ 87. We agree with this statement to the extent that we agree that the device's phone number could possibly identify an area or location in which the device might be located. But, we do not agree with Dr. Mir's

conclusion that "a person of ordinary skill in the art would have understood that "Teodosiu's method includes a network server receiving from the mobile device ('mobile telephone') a request ('access code request message') including a selected contact ('callee identifier') and mobile device 110 phone number, which includes geographic information ('location identifier')." *Id.* ¶ 89. Dr. Mir fails to adequately explain how or why the area code of a mobile device's phone number is a "location identifier identifying a location of the mobile telephone."

Patent Owner relies on the Declaration of William Henry Mangione-Smith (Ex. 2017 ("Mangione-Smith Decl.")) in disputing the showing as to this limitation. *See* Prelim. Resp. 31–38. Patent Owner argues that "an 'area code' of a mobile phone does not identify 'a location ***of the mobile phone***.' Rather, it ***identifies a location of a rate center*** associated with the mobile phone's billing account." *Id.* at 31 (citing Ex. 2017 ¶ 12). Dr. Mangione-Smith testifies:

> A phone number that is assigned to a mobile phone within the United States of America includes an "area code" portion, however, the area code does not identify the location of the *phone*. The point of having a mobile phone is to have telephone service while being mobile. The location of a mobile phone can change to outside of the geographical boundary of an area code, including the area code in the phone number. Indeed, the mobile phone need not operate at all within the area code boundaries of its phone number.

Ex. 2017 ¶ 11. And, outside the U.S., Dr. Mangione-Smith testifies that "what sometimes appears to be an 'area code' may actually convey *no* location information, despite the original meaning of the term." *Id.* ¶ 17. And, for VoIP services (to which Teodosiu is directed (*see* Ex. 1005 ¶¶ 6–9 (Summary)); *see also* Pet. 19–20)), Dr. Mangione-Smith testifies that

"Voice-over-IP services in the U.S. also provided virtual phone numbers since at least 2003" and "[v]irtual phone numbers have an 'area code' that is chosen by the user, therefore a virtual number does not necessarily reflect anything about the user's location or the location of the user's phone." *Id.* ¶ 18. Dr. Mangione-Smith concludes, "[i]n summary, Claims 30, 46, and 62 of the '234 Patent require a 'location identifier' that is 'identifying a location of a mobile phone'" and an "'area code' associated with the phone number assigned to the mobile phone does not provide this information." *Id.* ¶ 21.

Weighing the competing evidence of the parties' declarants, we determine that the testimony of Dr. Mangione-Smith, Patent Owner's declarant, comports with real-world experience and is better reasoned and supported than the testimony of Dr. Mir, Petitioner's declarant. Therefore, we determine that Dr. Mangione-Smith's testimony is entitled to greater weight and is more persuasive on the issue of whether an area code constitutes a location identifier as recited in the independent claims.

Independent claims 30, 46, and 62 of the '234 patent contain additional limitations which reference the "location identifier." For example, claim 30 recites: "producing an access code identifying a communication channel based on said location identifier." Ex. 1001, 38:12–13. Independent claims 46 and 62 recite substantively similar limitations. *Id.* at 39:38–39 (claim 46), 41:10–12 (claim 62). All these limitations require producing an "access code identifying a communication channel based on said location identifier." For these limitations, Petitioner relies on Teodosiu and its purported showing discussed above for disclosing the "an access code . . . associated with said location identifier." *See* Pet. 21,

45–47, 56–57. For the reasons discussed above, we determine that, as Petitioner has not shown Teodusiu discloses a "an access code . . . associated with said location identifier," it necessarily follows that Petitioner has not shown a reasonable likelihood of establishing the cited art discloses these additional limitations.

We determine that the Petition fails to show that the cited art discloses the "location identifier" limitations as recited in the challenged independent claims.

For dependent claims 31–33, 38–40, 43, 45–48, 54, 61, 62, 64, 65, 70, 72, and 75, our determination with regard to the independent claims from which they depend dictates that the challenges to these dependent claims also fail. However, dependent claims 35, 37, 51, and 53 warrant further discussion because they contain "wherein" clauses which further limit the scope of "location identifier" as set forth in independent claims 30 or 46.[10]

Claims 35 and 51 recite, "wherein said location identifier comprises an IP address of the mobile telephone in a wireless IP network." Ex. 1001, 38:46–48 (claim 35 depends from claim 30), 40:9–11 (claim 51 depends from claim 46). Petitioner contends that "Teodosiu in combination with Kaal discloses or suggests this limitation." Pet. 61 (citing Ex. 1002 ¶¶ 233–246), 64–65 (cross-referencing showing for claim 46 and citing Ex. 1002 ¶ 247). The showings in the Petition as to these claims are not very well-explained or well-supported.

First, the Petition states that as "explained for limitations 30.b–c, network server 130 receives geographic information ("location identifier")

[10] Claims 35 and 37 depend from claim 30, and claims 51 and 53 depend from claim 46.

associated with mobile device 110" and cites to the showing relating to limitations 30.b–.c. Pet. 61 (cross-referencing *id*. at 52–54 (limitation 30.b–.c)). We note that to the extent this statement is intended to contend that limitations 30.b–.c recite that a mobile device sends an access code to a network server that includes "***geographic information*** ('location ***identifier***') ***associated with*** [the] mobile device," this is a misstatement of the language of claim 30. Limitations 30.b–c are more specific and recite, "receiving from the mobile telephone an access code request message including . . . a location identifier . . . ***identifying a location*** of the mobile telephone." Ex. 1001, 38:7–11 (emphasis added). The ordinary and customary meaning of: (1) "geographic ***information***" is not the same as meaning of "***location***" as recited; and (2) "***associated with***" is not the same as the meaning of "***identifying***" as recited. The language in this statement in the Petition is broader in several respects when compared to the actual language of limitations 30.b–.c in claim 30. The same defect in Petitioner's argument exists for claim 51.

Moreover, as discussed above, we determine that the Petition fails to show that Teodosiu discloses causing an access code to be transmitted that includes "said location identifier identifying a location of the mobile telephone" as recited in limitations 30.b–.c. For the reasons discussed above, we reject the contention that the Petition discloses limitations 30.b–.c and determine that it is false that the Petition earlier explained that limitation limitations 30.b–.c was disclosed by the cited art. We reach the same conclusion for claim 51 for the same reasons.

Second, with regard to the limitation in claims 35 and 51, the Petition states, to "the extent Teodosiu does not explicitly disclose the 'location

identifier comprises an IP address of the mobile telephone in a wireless IP network,' it would nevertheless have been obvious in view of Kaal to modify Teodosiu's system to comprise such features." Pet. 61 (citing Ex. 1002 ¶ 234), 64–65 (cross referencing showing for claim 37 and citing (Ex. 1002 ¶ 247)). The Petition does not contain a persuasive contention that Teodosiu discloses this limitation to any extent or even that it would have been suggested by Teodosiu. *See generally* Pet. And, this statement does not explain what specific modifications to Teodosiu would have been obvious in view of Kaal and how or why Teodosiu as modified would meet all the limitations of recited within the body of independent claims 30 and 46 from which claims 35 and 51 depend respectively. From the preceding sentence in the Petition, it appears that Petitioner is arguing that, to the extent that Teodosiu does not teach or suggest limitations 30.b–.c, Kaal teaches or suggests the elements of these limitations. But Petitioner presents no argument that Kaal teaches or suggests "receiving from the mobile telephone an access code request message" that includes "a location identifier" in any form (including an IP address). *See* Pet. 61–65. The Petition does not state when or in what context the IP address of the mobile telephone as disclosed in Kaal is received from the mobile telephone.

And, the section in the Petition relating to claims 35 and 51 and Kaal presents nothing about the additional limitations in independent claims 30 and 46 that recite the manner in which the "location identifier" influences the "access code identifying a communication channel based on said location identifier" as recited in limitations 30.c and 46.c. *See* Pet. 21–22 (claim 30), 45–46 (claim 46). Claim 30 recites: "[c] producing an access code identifying a communication channel ***based on said location identifier***

and/or based on a location pre-associated with the mobile telephone." Ex. 1001, 38:12–14 (emphasis added).[11] In short, the Petition does not show or explain how or why Kaal remedies the deficiencies we previously identified in the showing in the Petition related to independent claims 30 and 46 and Teodosiu.

Claims 37 and 53, which depend from claims 30 and 46 respectively, recite: "wherein said location identifier includes a user-configured identifier of a location associated with the mobile telephone." Ex. 1001, 37:52–54 (claim 37), 40:15–17 (claim 53). Petitioner contends that "Teodosiu in combination with Guedalia discloses or suggests this limitation." Pet. 66 (for claim 37, citing Ex. 1002 ¶¶ 248–259); *see also id*. at 70 (for claim 53, citing Ex. 1002 ¶ 260 and cross-referencing showing for claim 37). Petitioner argues:

> As explained for limitations 30.b-c, network server 130 receives geographic information ("location identifier") associated with mobile device 110 for use in selecting a VoIP phone number that is close geographically to mobile device 110 to reduce costs associated with the call between mobile device and the particular selected phone number. (*Supra* Sections IX.A.1.bc.) To the extent Teodosiu does not explicitly disclose the "location identifier comprises a user-configured identifier of a location associated with the mobile telephone," it would nevertheless have been obvious in view of Guedalia to modify Teodosiu to comprise such features. (EX1002 ¶249.)

Id. This argument is substantially parallel with Petitioner's argument relating to claims 35 and 51 in connection with the combination of Teodosiu and Kaal discussed above and suffers from the same defects. We determine that the Petition does not show or explain how or why Guedalia remedies the

[11] Claim 46 recites substantially the same limitation. Ex. 1001, 39:38–41.

deficiencies we previously identified in the showing in the Petition related to independent claims 30 and 46 and Teodosiu.

Petitioner also challenges all claims based on the same combinations of Teodosiu with one of Kaal, Guedalia, and Nix but with Rosenberg added to bolster its showing that the claimed "mobile telephone roaming" is known. Pet. 78–81. Petitioner does not rely upon Rosenberg as describing the "location identifier" discussed above. We find that Petitioner's reliance on Rosenberg does not address the deficiencies in Petitioner's challenges to the claims that do not rely upon Rosenberg. Therefore, we conclude that Petitioner has also failed to demonstrate a reasonable likelihood of proving that any claim is unpatentable based on its challenges that rely in part on Rosenberg.

In summary, we determine that Petitioner has not shown that the cited art discloses all the limitations of any challenged claim and we deny institution on this basis.

III. CONCLUSION

On the record before us, we conclude that there is not a reasonable likelihood that the Petitioner would prevail with respect at least one of the claims challenged in the Petition. Therefore, we do not institute *inter partes* review on any claims or any challenge to the claims of the '234 patent.

IV. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review of claims 30–33, 35, 37–40, 43, 45–48, 51, 53, 54, 61, 62, 64, 65, 70, 72, and 75 of U.S. Patent No. 8,630,234 B2 is *not instituted.*

PETITIONER:

Naveen Modi
Joseph E. Palys
Daniel Zeilberger
Jason Heidemann
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
josephpalys@paulhastings.com
danielzeilberger@paulhastings.com
jasonheidemann@paulhastings.com

PATENT OWNER:

Lewis Hudnell, III
Nicolas Gikkas
HUDNELL LAW GROUP P.C.
lewis@hudnelllaw.com
nsg@gikkaslaw.com