

United States District Court
Northern District of California

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

TWITTER, INC.,
Plaintiff,
v.
VOIP-PAL.COM, INC.,
Defendant.

Case No. 20-CV-02397-LHK
**ORDER DENYING MOTION TO
DISMISS**
Re: Dkt. No. 31

Plaintiff Twitter, Inc. (“Plaintiff”) sues Defendant VoIP-Pal.com, Inc. (“Defendant”) for a declaration of non-infringement and invalidity of U.S. Patent No. 10,218,606 (“the ’606 patent”). Before the Court is Defendant’s motion to dismiss Plaintiff’s complaint. Having considered the parties’ submissions, the relevant law, and the record in this case, the Court DENIES Defendant’s motion to dismiss.

I. BACKGROUND

This case represents the latest chapter in a long dispute between the parties regarding whether Plaintiff infringes Defendant’s patents, which relate to a system for routing internet-protocol communications. Below, the Court discusses in turn: (1) the parties; (2) Defendant’s first set of lawsuits against Plaintiff, Apple, AT&T, and Verizon, originally filed in the District of

1 Nevada in 2016 (“the 2016 cases”); (3) Defendant’s second set of lawsuits against Apple and
2 Amazon, originally filed in the District of Nevada in 2018 (“the 2018 cases”); (4) Defendant’s
3 most recent lawsuits against Apple, AT&T, Verizon, Amazon, Facebook, and Google, filed in the
4 Western District of Texas in April of 2020 (“the Texas cases”); and (5) the instant case, which was
5 filed by Plaintiff in this Court in April of 2020.

6 **A. The Parties**

7 Plaintiff Twitter is a Delaware corporation with its principal place of business in San
8 Francisco, California. ECF No. 1 ¶ 7. Twitter “operates a global Internet platform for public self-
9 expression and conversation in real time.” *Id.* ¶ 8. Twitter uses and sells “messaging services using
10 messaging application software and/or equipment, servers and/or gateways that route messages to
11 computing devices such as smartphones, tablet computers, and personal computers.” *VoIP-*
12 *Pal.Com, Inc. v. Apple Inc.*, 375 F. Supp. 3d 1110, 1117 (N.D. Cal. 2019) (quotation omitted).

13 Defendant VoIP-Pal is a Nevada corporation with its principal place of business in
14 Bellevue, Washington. ECF No. 1 ¶ 8. Defendant owns a portfolio of patents relating to Internet
15 Protocol based communication. *VoIP-Pal.Com, Inc. v. Apple Inc.*, 411 F. Supp. 3d 926, 930 (N.D.
16 Cal. 2019).

17 **B. The 2016 Cases**

18 On February 9, 2016, Defendant sued Apple in the District of Nevada for infringement of
19 U.S. Patent Nos. 8,542,815 (“the ’815 patent”), and 9,179,005 (“the ’005 patent”), both of which
20 relate to a system for routing calls between a caller and a callee over Internet Protocol. *VoIP-*
21 *Pal.Com*, 375 F. Supp. 3d at 1118, 1122. The following day, Defendant sued Verizon and AT&T
22 in the District of Nevada for infringement of the same patents. *Id.* On October 6, 2016, Defendant
23 sued Plaintiff in the District of Nevada for infringement of the same patents. *Id.* at 1121. The
24 District of Nevada stayed the cases pending *inter partes* review. *Id.*

25 After the stays were lifted, on February 28, 2018, Plaintiff moved to change venue to the
26 Northern District of California. *VoIP-Pal.Com, Inc. v. Twitter, Inc.*, Case No. 16-CV-02338, 2018
27 WL 3543031, at *1 (D. Nev. July 23, 2018). On July 23, 2018, the District of Nevada granted

1 Plaintiff's motion for change of venue. *Id.* On October 1, 2018, the District of Nevada granted
 2 Verizon and Defendant's stipulation to transfer the case. *VoIP-Pal.Com*, 375 F. Supp. 3d at 1121.
 3 On October 4, 2018, the District of Nevada granted a similar stipulation by AT&T and Defendant.
 4 *Id.* The following day, the District of Nevada granted a similar stipulation by Apple and
 5 Defendant. *Id.* As a result, all four cases were transferred to this Court, where they were
 6 consolidated.

7 On March 25, 2019, this Court granted Apple, AT&T, Verizon, and Plaintiff's
 8 consolidated motion to dismiss all four cases. *Id.* at 1117. In a 45-page order, the Court concluded
 9 that the '815 and '005 patents were unpatentable under 35 U.S.C. § 101. *Id.* at 1138, 1144. On
 10 March 16, 2020, the Federal Circuit affirmed this Court's decision. *VoIP-Pal.Com, Inc. v. Apple,*
 11 *Inc.*, 798 F. App'x 644, 645 (Fed. Cir. 2020). On May 18, 2020, the Federal Circuit denied
 12 Defendant's petition for panel or en banc rehearing. *VoIP-Pal.Com, Inc. v. Twitter*, Case No.
 13 2019-1808, ECF No. 99.

14 C. The 2018 Cases

15 On May 24, 2018, Defendant sued Apple in the District of Nevada for infringement of four
 16 more patents: U.S. Patent Nos. 9,537,762 ("the '762 patent"); 9,813,330 ("the '330 patent");
 17 9,826,002 ("the '002 patent"); and 9,948,549 ("the '549 patent"). *VoIP-Pal.Com*, 411 F. Supp. 3d
 18 at 934. Like the two patents that were the subject of the 2016 Cases, these four patents relate to a
 19 system for routing communications over Internet Protocol. *Id.* at 931. On June 15, 2018,
 20 Defendant sued Amazon in the District of Nevada for infringement of the same patents. *Id.* The
 21 lawsuits against Apple and Amazon were transferred from the District of Nevada to this Court,
 22 where they were consolidated and related to the 2016 cases. *Id.*

23 On November 1, 2019, this Court granted Apple and Amazon's consolidated motion to
 24 dismiss both cases with prejudice. *Id.* at 930. Just as with the 2016 Cases, the Court concluded, in
 25 a 68-page order, that the four patents were unpatentable under 35 U.S.C. § 101. *Id.* at 941. On
 26 November 3, 2020, the Federal Circuit affirmed this Court's decision. *VoIP-Pal.Com, Inc. v.*
 27 *Apple, Inc.*, 828 F. App'x 717, 717 (Fed. Cir. 2020). If Defendant chooses to petition for

1 rehearing, the petition is due on December 17, 2020. *See* Order, *VoIP-Pal.Com, Inc. v. Apple, Inc.*,
2 Case No. 2020-1241 (Fed. Cir. Nov. 9, 2020). If Defendant chooses to petition the United States
3 Supreme Court for a writ of certiorari, Defendant's petition is due on April 3, 2021. *See* Order,
4 March 19, 2020 (ordering that "the deadline to file any petition for a writ of certiorari due on or
5 after the date of this order is extended to 150 days from the date of the lower court judgment").

6 **D. The Texas Cases**

7 In April of 2020, Defendant sued Apple, AT&T, Verizon, Amazon, Facebook, and Google
8 in the Waco Division of the Western District of Texas for infringement of the '606 patent. *VoIP-*
9 *Pal.Com, Inc. v. Facebook, Inc.*, Case No. 20-CV-00267-ADA, ECF No. 1 (W.D. Tex. Apr. 2,
10 2020); *VoIP-Pal.Com, Inc. v. Google LLC*, Case No. 20-CV-00269-ADA, ECF No. 1 (W.D. Tex.
11 Apr. 3, 2020); *VoIP-Pal.Com, Inc. v. Amazon.Com, Inc.*, Case No. 20-CV-00272-ADA, ECF No.
12 1 (W.D. Tex. Apr. 6, 2020); *VoIP-Pal.Com, Inc. v. Apple Inc.*, Case No. 20-CV-00275-ADA,
13 ECF No. 1 (W.D. Tex. Apr. 7, 2020); *VoIP-Pal.Com, Inc. v. AT&T Inc.*, Case No. 20-CV-00325-
14 ADA, ECF No. 1 (W.D. Tex. Apr. 24, 2020); *VoIP-Pal.Com, Inc. v. Verizon Comms., Inc.*, Case
15 No. 20-CV-00275-ADA, ECF No. 1 (W.D. Tex. Apr. 24, 2020). Like the six patents that were the
16 subjects of the 2016 and 2018 Cases, the '606 patent relates to a system for routing
17 communications over Internet Protocol. Specifically, the '606 patent shares a common
18 specification, title, parent application, inventors, and owner with Defendants' six other patents that
19 were examined by this Court in the 2016 and 2018 cases. *Compare* ECF No. 1-1 *with VoIP-*
20 *Pal.Com, Inc. v. Apple Inc.*, Case No. 18-CV-06217-LHK, ECF No. 1-2.

21 On September 29, 2020, Judge Alan Albright of the Western District of Texas stayed the
22 six cases pending before him until this Court enters an order on the instant motion to dismiss and
23 the consolidated motion to dismiss in three related declaratory judgment actions, *Apple, Inc. v.*
24 *VoIP-Pal.com, Inc.*, Case No. 20-CV-02460-LHK; *AT&T, Inc. v. VoIP-Pal.com, Inc.*, Case No.
25 20-CV-02995-LHK; and *Cellco Partnership, Inc. v. VoIP-Pal.com, Inc.*, Case No. 20-CV-03092-
26 LHK. *See VoIP-Pal.Com, Inc. v. Facebook, Inc.*, Case No. 20-CV-00267-ADA, ECF No. 47
27 (W.D. Tex. Apr. 2, 2020).

E. The Instant Case

1 On April 8, 2020, six days after Defendant started filing lawsuits in the Western District of
2 Texas that alleged infringement of the '606 patent, Plaintiff sued Defendant for a declaration of
3 non-infringement of the '606 patent in the Northern District of California. ECF No. 1. On April
4 21, 2020, this Court granted Plaintiff's motion to relate its declaratory judgment action to the 2016
5 case against Plaintiff. ECF No. 14.

6 Shortly after Plaintiff filed the instant case, the other three defendants in the 2016 cases
7 (Apple, AT&T, and Verizon) also filed declaratory judgment actions in the Northern District of
8 California for a declaration of non-infringement and invalidity of the '606 patent. Case No. 20-
9 CV-02460-LHK, ECF No. 1; Case No. 20-CV-02995-LHK, ECF No. 1; Case No. 20-CV-03092-
10 LHK, ECF No. 1. On April 14, 2020, Apple amended its complaint to also seek a declaration of
11 non-infringement and invalidity of the '872 patent. Case No. 20-CV-02460, ECF No. 10. The
12 Court then related Apple, AT&T, and Verizon's cases to Defendant's 2016 cases against them,
13 just as the Court had done in the instant case. Case No. 20-CV-02460-LHK, ECF No. 18; Case
14 No. 20-CV-02995-LHK, ECF No. 23; Case No. 20-CV-03092-LHK, ECF No. 18.

15 On May 26, 2020, this Court related the instant case to the Apple, AT&T, and Verizon
16 cases. ECF No. 24. On June 4, 2020, this Court consolidated the motion to dismiss briefing for the
17 Apple, AT&T, and Verizon cases but ordered that the motion to dismiss in the instant case be
18 briefed separately. ECF No. 26.

19 On July 10, 2020, Defendant filed a consolidated motion to dismiss the Apple, AT&T, and
20 Verizon cases. Case No. 20-CV-02460-LHK, ECF No. 32. On December 11, 2020, this Court
21 denied Defendant's consolidated motion to dismiss. Case No. 20-CV-02460-LHK, ECF No. 60.
22 The Court concluded that there was personal jurisdiction over Defendant because Defendant had
23 purposefully directed its enforcement activities towards the forum state by litigating six lawsuits in
24 this district. *Id.* at 17–20. The Court also concluded that it would be reasonable and fair to assert
25 personal jurisdiction over Defendant. *Id.* at 20–23. Because the Court found that there was
26 personal jurisdiction over Defendant, the Court found that venue was proper in this district. *Id.* at
27

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