

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

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

IPR2022-01391
Patent 8,630,234 B2

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

WEATHERLY, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review

35 U.S.C. § 314

Granting Motion for Joinder

35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. Background

Samsung Electronics Co., Ltd. (“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, 67, 69, 70, 72, and 75 (the “challenged

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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 8 (“Prelim. Resp.”). With our prior authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 9) and Patent Owner filed a Sur-reply in Support of its Preliminary Response (Paper 10).

Concurrently with the Petition, Petitioner filed a Motion for Joinder in which it sought to join IPR2022-01232 (the “Meta IPR”) as a party if we were to institute review in the Meta IPR. Paper 3, 1 (“Mot.” or “Motion”). Patent Owner also opposed the Motion. Paper 5 (“Opp.” or “Opposition”). Petitioner filed a reply in support of the Motion. Paper 7.

Petitioner challenges the patentability of claims on the same basis advanced in the Meta IPR as follows:

Claims challenged	35 U.S.C. § ¹	Reference(s)
30–33, 35, 38–40, 43, 45–48, 51, 54, 61, 62, 64, 65, 67, 70, 72, 75	103	Buckley ²
38, 39, 54, 70	103	Buckley, Ejzak ³
30–33, 35, 37–40, 43, 45–48, 51, 53, 54, 61, 62, 64, 65, 67, 69, 70, 72, 75	103	Buckley, Bates ⁴

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 U.S. Patent No. 7,668,159 B2 (Ex. 1005, “Buckley”).

³ U.S. Patent No. 6,954,654 B2 (Ex. 1007, “Ejzak”).

⁴ U.S. Patent No. 8,731,163 B1 (Ex. 1009, “Bates”).

Claims challenged	35 U.S.C. § ¹	Reference(s)
38, 39, 54, 70	103	Buckley, Bates, Ejzak

Petitioner files the Declaration of Dr. Vijay Madiseti from the Meta IPR in support of the Petition. Ex. 1003.

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). For the reasons expressed below, we (1) institute *inter partes* review on the same grounds instituted in the Meta IPR, and (2) grant the Motion, subject to the conditions set forth below.

B. Related Proceedings

Both parties identify the following active district court proceedings involving the '234 patent and related U.S. Patent No. 10,880,721 B2 (“the '721 patent”) as being related to this proceeding: *VoIP-Pal.com, Inc. v. Meta Platforms, Inc. et al.*, 3-22-03202 (N.D. Cal.) (the “Litigation”); *VoIP-Pal v. Google*, No. 3:22-cv-03199 (N.D. Cal.); *VoIP-Pal v. Amazon*, No. 6-21-cv-00668 (W.D. Tex.); *VoIP-Pal v. Verizon*, No. 6-21-cv-00672 (W.D. Tex.); *VoIP-Pal v. T-Mobile*, No. 6-21-cv-00674 (W.D. Tex.); *VoIP-Pal v. Samsung*, No. 6-21-cv-01246 (W.D. Tex.); *VoIP-Pal v. Huawei*, No. 6-21-cv-01247 (W.D. Tex.); *Verizon v. VoIP-Pal*, No. 3-21-cv-05275 (N.D. Cal.); and *Twitter v. VoIP-Pal*, No. 3-21-cv-09773 (N.D. Cal.). Pet. 2; Paper 4, 2.

Petitioner further identifies a number of completed district court proceedings involving the '234 patent that it contends to be related,

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including: *VoIP-Pal v. Apple*, No. 6-21-cv-00670 (W.D. Tex.); *Apple v. VoIP-Pal*, No. 3:21-cv-05110 (N.D. Cal.); *VoIP-Pal v. AT&T*, No. 6-21-cv-00671 (W.D. Tex.); and *AT&T v. VoIP-Pal*, No. 3-21-cv-05078 (N.D. Cal.).
Pet. 2–3.

Petitioner further states it is concurrently filing another petition seeking *inter partes* review of other claims of the '234 patent⁵ and petitions seeking *inter partes* review of claims of the '721 patent.⁶ Pet. 3.

II. INSTITUTION OF INTER PARTES REVIEW

Petitioner contends that the Petition is “substantively identical to the corresponding petition filed in the Meta [IPR].” Pet. 7. Patent Owner does not address whether Petitioner’s contention is accurate. *See generally* Prelim. Resp. Based on our comparison of the Petition in this proceeding to the petition filed in the Meta IPR, we agree with Petitioner. *Compare* Pet. 24–78, *with* IPR2022-01232, Paper 3, 23–77. Additionally, based on our comparison of Patent Owner’s preliminary responses filed in this proceeding and the Meta IPR, we discern no material difference between the arguments raised in those respective preliminary responses. *Compare* Prelim. Resp. 25–58 (addressing merits of Petitioner’s unpatentability challenges), *with* IPR2022-01232, Paper 9, 25–57 (addressing merits of unpatentability challenges in Meta IPR). Accordingly, for the reasons expressed in our Decision Instituting Review in IPR2022-01232 (Paper 12),

⁵ Claims of the '234 patent are challenged in three other currently co-pending IPRs, including: IPR2022-01231, IPR2022-01232, and IPR2022-01390.

⁶ Claims of the '721 patent are challenged in four pending IPRs, including: IPR2022-01234, IPR2022-01235, IPR2022-01392, IPR202-01393.

we find that the Petition in this proceeding also warrants institution of *inter partes* review.

III. MOTION FOR JOINDER

Petitioner requests joinder pursuant to 35 U.S.C. § 315(c), which provides as follows:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

Section 315(c) “authorizes joinder of a person as a party, not ‘joinder’ of two proceedings” and “does not authorize the joined party to bring new issues from its new proceeding into the existing proceeding.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1335 (Fed. Cir. 2020).

Here, Petitioner’s Motion requests no more than the statute allows. Petitioner represents that the current “Petition and the . . . Petition [in the Meta IPR] challenge the same claims, on the same grounds, and rely on the same prior art and evidence, including an identical declaration from the same expert.” Mot. 1. Furthermore, Petitioner agrees that, if joined as a party to the Meta IPR, “Petitioner will act as ‘understudy’ and will not assume an active role unless Meta ceases to participate” in the Meta IPR, “Meta will maintain the lead role in the proceeding so long as it is a party to the proceeding,” and that “Petitioner will not seek additional depositions or deposition time.” Mot. 2.

Patent Owner opposes the Motion for the four reasons discussed below, none of which is persuasive.

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