

**Docket Nos. 2019-1808 (L), -1812, -1813, -1814**

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*In the*  
**United States Court of Appeals**  
*For the*  
**Federal Circuit**

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

v.

TWITTER, INC.,  
*Defendant-Appellee.*

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

v.

CELLCO PARTNERSHIP, dba Verizon Wireless Services LLC,  
*Defendant-Appellee.*

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*Appeal from the United States District Court for the Northern District of California  
in Case Nos. 5:18-cv-04523-LHK, 5:18-cv-06054-LHK, 5:18-cv-06177-LHK  
and 5:18-cv-06217-LHK · United States District Judge Lucy H. Koh.*

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**APPELLANT'S COMBINED PETITION FOR  
PANEL REHEARING AND REHEARING *EN BANC***

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**Caption Continued on Inside Cover**

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

v.

AT&T CORP.,  
*Defendant-Appellee.*

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

v.

APPLE, INC,  
*Defendant-Appellee.*

**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**  
**VOIP-PAL.COM, INC. v. TWITTER, INC.**

Case No. 19-1808 (lead case)

**CERTIFICATE OF INTEREST**

Counsel for the:

(petitioner)  (appellant)  (respondent)  (appellee)  (amicus)  (name of party)

**VoIP-Pal.com, Inc.**

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10% or more of stock in the party
VoIP.Pal.com, Inc.	VoIP-Pal.com, Inc.	None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court **(and who have not or will not enter an appearance in this case)** are:

None

FORM 9. Certificate of Interest

Form 9  
Rev. 10/17

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47. 4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

VoIP-Pal.com, Inc. v. Cellco Partnership, dba Verizon Wireless Services LLC, Inc., Case No. 19-1812; VoIP-Pal.com, Inc. v. AT&T Corp., Case No. 19-1813; VoIP-Pal.com, Inc. v. Apple, Inc., Case No. 19-1814; Apple, Inc. v. VoIP-Pal.com, Inc., Case No. 18-1456

4/15/2020

Date

/s/Lewis E. Hudnell, III

Signature of counsel

Lewis E. Hudnell, III

Printed name of counsel

Please Note: All questions must be answered

cc: All counsel of record

Reset Fields

## TABLE OF CONTENTS

CERTIFICATE OF INTEREST

TABLE OF CONTENTS.....i

TABLE OF AUTHORITIES ..... ii

TABLE OF ABBREVIATIONS .....v

I. STATEMENT OF COUNSEL UNDER FED. CIR. R. 35(B).....1

II. POINTS OF LAW OR FACT OVERLOOKED BY THE PANEL .....2

III. ARGUMENT IN SUPPORT OF REHEARING EN BANC, OR IN  
THE ALTERNATIVE, PANEL REHEARING.....4

A. The Panel’s Affirmance Of The District Court’s Decision  
Conflicts With *MyMail*.....4

B. The Panel’s Decision Improperly Placed The Burden Of  
Raising A Claim Construction Dispute On VoIP-Pal.....10

C. The District Court Erroneously Rejected VoIP-Pal’s Plausible  
Allegations That The Claims Recite An Inventive Concept  
Based On A Facial Review Of The Asserted Claims .....14

IV. CONCLUSION.....17

CERTIFICATE OF COMPLIANCE.....18

JUDGMENT, Filed March 16, 2020

CERTIFICATE OF SERVICE

**TABLE OF AUTHORITIES**

**CASES**

*Aatrix Software, Inc. v. Green Shades Software, Inc.*,  
882 F.3d 1121 (Fed. Cir. 2018) .....1, 4, 7, 15, 17

*Advanced Mktg. Sys. v. CVS Pharm., Inc.*,  
2016 U.S. Dist. LEXIS 86711 (E.D. Tex. Jan. 25, 2016) .....8

*Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada*,  
687 F.3d 1266 (Fed. Cir. 2012).....6

*Card Verification Solutions, LLC v. Citigroup Inc.*,  
2014 U.S. Dist. LEXIS 137577 (N.D. Ill. Sep. 29, 2014).....11

*Cellspin Soft, Inc. v. Fitbit, Inc.*,  
927 F.3d 1306 (Fed. Cir. 2019) .....1, 15

*Data Distribution Techs., LLC v. BRER Affiliates, Inc.*,  
2014 U.S. Dist. LEXIS 115543 (D.N.J. Aug. 19, 2014).....11

*DietGoal Innovations LLC v. Bravo Media LLC*,  
33 F. Supp. 3d 271 (S.D.N.Y. 2014) .....7

*Grecia v. Bank of N.Y. Mellon Corp.*,  
2020 U.S. Dist. LEXIS 45223 (S.D.N.Y. Mar. 3, 2020).....9

*Integrated Claims Sys., LLC v. Old Glory Ins. Co.*,  
2020 U.S. Dist. LEXIS 36533 (E.D. Tex. Mar. 3, 2020).....9

*Intellectual Ventures I LLC v. Erie Indem. Co.*,  
134 F. Supp. 3d 877 (W.D. Pa. 2015), *aff'd and vacated in part by*,  
*remanded*, 850 F.3d 1315 (Fed. Cir. 2017) .....7

*Joao Control & Monitoring Sys., LLC v. Telular Corp.*,  
173 F. Supp. 3d 717 (N.D. Ill. 2016).....7

*Loyalty Conversion Sys. Corp. v. Am. Airlines, Inc.*,  
66 F. Supp. 3d 829 (E.D. Tex. 2014) .....8

*Mortg. Application Techs. v. Meridianlink, Inc.*,  
 2020 U.S. Dist. LEXIS 40036 (C.D. Cal. Jan. 6, 2020).....10, 12

*MyMail, Ltd. v. ooVoo, LLC*,  
 934 F.3d 1373 (Fed. Cir. 2019).....*passim*

*Natural Alternatives Int’l, Inc. v. Creative Compounds, LLC*,  
 918 F.3d 1338 (Fed. Cir. 2019) .....2, 7

*Nobelbiz, Inc. v. Global Connect, L.L.C.*,  
 876 F.3d 13263 (Fed. Cir. 2017) .....3, 14

*O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*,  
 521 F.3d 1351 (Fed. Cir. 2008) .....4

*P&G v. QuantifiCare Inc.*,  
 288 F. Supp. 3d 1002 (N.D. Cal. 2017).....8

*Phillips v. AWH Corp.*,  
 415 F.3d 1303 (Fed. Cir. 2005) .....5

*Prescriber, LLC v. AO Capital Partners LLC*,  
 2015 U.S. Dist. LEXIS 194148 (E.D. Tex. Mar. 31, 2015).....8

*Retractable Techs. v. Becton, Dickinson & Co.*,  
 659 F.3d 1369 (Fed. Cir. 2011) .....2

*Twilio, Inc. v. Telesign Corp.*,  
 249 F. Supp. 3d 1123 (N.D. Cal. 2017).....8

*Uniloc USA Inc. v. LG Elecs. USA Inc.*,  
 379 F. Supp. 3d 974 (N.D. Cal. 2019).....8

*Voip-Pal.com, Inc. v. Apple Inc.*,  
 411 F. Supp. 3d 926 (N.D. Cal. 2019).....9, 14

**STATUTES**

35 U.S.C. §101 .....1, 2, 4, 8  
35 U.S.C. §112(6) .....13

**OTHER AUTHORITIES**

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Procedure §1357 (3d ed. 2018).....11  
Gene Quinn, Is the Federal Circuit Closer to Requiring a Real Claim  
Construction for Patent Eligibility, IPWatchdog.com (Nov. 5, 2018).....5  
Paul R. Gugliuzza, Quick Decisions in Patent Cases,  
106 Georgetown L.J. 619 (2018).....12  
Timothy R. Holbrook & Mark D. Janis, Patent-Eligible Processes:  
An Audience Perspective, 17 Vand. J. Ent. & Tech. L. 349 (2015) .....5



## TABLE OF ABBREVIATIONS

ABBREVIATION	TERM
VoIP-Pal	Plaintiff-Appellant VoIP-Pal.com, Inc.
Twitter	Defendant-Appellee Twitter, Inc.
Verizon	Defendant-Appellee Cellco Partnership, dba Verizon Wireless Services, LLC
AT&T	Defendant-Appellee Cellco Partnership, dba Verizon Wireless Services, LLC
Apple	Defendant-Appellee Apple, Inc.
The '815 patent	U.S. Patent No. 8,542,815
The '815 claims	Claims 1, 7, 12, 27, 28, 72, 73, 92, and 111 of the '815 patent
The '005 patent	U.S. Patent No. 9,719,005
The '005 claims	Claims 49, 73, 74, 75, 77, 78, 83, 84, 94, 96, and 99 of the '005 patent
The patents-in-suit	The '815 patent and the '005 patent

TAC

Third Amended Complaint

PTAB

Patent Trial and Appeal Board

IPR

*Inter Partes* Review

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 conflicts with this Court's precedent in *MyMail, Ltd. v. ooVoo, LLC*, 934 F.3d 1373 (Fed. Cir. 2019); *Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306 (Fed. Cir. 2019); and *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121 (Fed. Cir. 2018).

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. Is it erroneous for a court to resolve a claim construction dispute in the context of a Rule 12 eligibility challenge without claim construction?
2. Is it erroneous to place the burden on the non-moving party to propose terms for construction in opposing a Rule 12 motion to dismiss under 35 U.S.C. §101?
3. Is it erroneous to refute a non-moving party's plausible factual allegations that the claims recite an inventive concept based merely on a facial review of the asserted claims at the pleadings stage?

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 time has come for this court to reconsider whether a [Rule 12] motion based on §101 should be decided before claim construction.” *See Natural Alternatives Int’l, Inc. v. Creative Compounds, LLC*, 918 F.3d 1338, 1354 (Fed. Cir. 2019) (Reyna, J., concurring-in-part, dissenting-in-part). “Claim construction is the single most important event in the course of a patent litigation. It . . . is often the difference between . . . validity and invalidity.” *Retractable Techs. v. Becton, Dickinson & Co.*, 659 F.3d 1369, 1370 (Fed. Cir. 2011) (Moore, J., dissenting). Yet, district courts continue to invalidate issued patents on eligibility grounds without construing their claims. Recognizing this problem, the Court in *MyMail* recently found that the same district court as in this case—Judge Lucy H. Koh—“erred by failing to address the parties’ claim construction dispute before concluding, on a [Rule 12] motion, that the *MyMail* patents [were ineligible].” *See MyMail*, 934 F.3d at 1381. In this case, however, the panel overlooked the fact that Judge Koh failed to resolve the parties’ claim construction dispute and instead performed a perfunctory facial review of the asserted claims, which *MyMail* no longer allows. The Court should convene *en banc*, or the panel should rehear this case, to address the critically important question of whether a district court may resolve claim construction disputes at the pleadings stage without claim construction. Granting rehearing on this question *en*

*banc* to clarify a district court’s duty to resolve claim construction disputes is also an opportunity to “provide much-needed guidance *en banc* about *O2 Micro’s* reach” insofar as it requires this Court to determine what constitutes an actual claim construction dispute under a Rule 12 eligibility challenge. *See Nobelbiz, Inc. v. Global Connect, L.L.C.*, 876 F.3d 1326, 1327-38 (Fed. Cir. 2017) (O’Malley, J., joined by Newman & Reyna, JJ., dissenting from denial of reh’g *en banc*).

Guidance is also badly needed as to who bore the burden to identify to the district court specific terms to be construed, Appellees or VoIP-Pal. Placing this burden on the non-moving party at the pleadings stage, as Appellees did, has it backwards—Appellees had the burden to show that there is no plausible claim construction under which the asserted claims could be found eligible. The panel failed to hold Appellees to their burden and therefore overlooked a central issue of this appeal.

Consequently, the district court was free to conduct a facial review of the asserted claims, which led it to the erroneous conclusion that the TAC did not plausibly allege a patent-eligible invention. Specifically, the district court improperly concluded that the asserted claims did not capture VoIP-Pal’s asserted inventive concepts even though there was no evidence and no claim construction to refute VoIP-Pal’s allegations at the pleading stage. The district court’s analysis plainly violated this Court’s rulings in *Aatrix*, *Cellspin Soft*, and *MyMail*.

VoIP-Pal respectfully submits that a rehearing, either by the panel or *en banc*, is necessary to reconsider these critical claim construction issues arising under a Rule 12 eligibility challenge 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’s Affirmance Of The District Court’s Decision Conflicts With *MyMail*.**

The Court should rehear this case because the district court resolved the parties’ claim construction dispute contrary to this Court’s precedent for addressing such disputes under a Rule 12 eligibility challenge. In *MyMail*, this Court expressly stated that “if the parties raise a claim construction dispute at the [Rule 12] stage, the district court must either [1] adopt the non-moving party’s constructions or [2] resolve the dispute to whatever extent is needed to conduct the §101 analysis.” *See MyMail*, 934 F.3d at 1379 (citing *Aatrix*, 882 F.3d at 1125); *see also O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362-63 (Fed. Cir. 2008) (“When the parties present a fundamental dispute regarding the scope of a claim term, it is the court’s duty to resolve it.”). The district court did neither. Instead, the district court conducted a perfunctory facial review of the asserted claims—a third type of claim analysis that *MyMail* no longer allows. Indeed, the district court did not adequately consider the patents-in-suit’s

specification, the prosecution history, or any extrinsic evidence in ascertaining the meaning of the asserted claims. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (“We cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history.”) (citations omitted); *see also* Appx48, at n.7 (denying proffer of extrinsic evidence). Before *MyMail*, commentators bemoaned the fact that district courts routinely decided eligibility challenges at the Rule 12 stage without claim construction. *See* Timothy R. Holbrook & Mark D. Janis, *Patent-Eligible Processes: An Audience Perspective*, 17 Vand. J. Ent. & Tech. L. 349, 365, 376 (2015) (“A patent-eligibility analysis that is not informed by any antecedent claim construction might be considered a patent law *non sequitur*. . . . [T]he Federal Circuit has thus far refused to commit to [requiring or not requiring claim construction], instead attempting to mediate this tension with a rule that appears to permit the court to do whatever it wishes in any given case.”); Gene Quinn, *Is the Federal Circuit Closer to Requiring a Real Claim Construction for Patent Eligibility*, IPWatchdog.com (Nov. 5, 2018) (“Sadly, a perfunctory facial review of claims has become the norm on motions to dismiss filed challenging claims as invalid under 35 U.S.C. 101.”). By affirming the district court’s decision without opinion, the panel tacitly endorsed this outdated and erroneous practice.

The panel should have immediately recognized that the district court misapplied what is now the law. Not only did the district court's decision issue five months before *MyMail*, but the district court judge is the same as in *MyMail*. In *MyMail*, the Court expressly found that Judge Koh "erred by failing to address the parties' claim construction dispute before concluding, on a [Rule 12] motion, that the *MyMail* patents [were ineligible]." *See MyMail*, 934 F.3d at 1381. Judge Koh made precisely the same error in this case, which the panel overlooked.

This error is unsurprising because, in both *MyMail* and in this case, the district court applied claim construction principles that conflict with this Court's holding in *MyMail*. In both cases, the district court noted that this Court has stated that "claim construction is not an inviolable prerequisite to a validity determination under §101." *Compare Appx16-17 with MyMail, Ltd. v. ooVoo, LLC*, 313 F. Supp. 3d 1095, 1102 (N.D. Cal. 2018). But in both cases, the district court ignored that immediately after that statement, this Court specifically noted "that it will ordinarily be desirable—and often necessary—to resolve claim construction disputes prior to a §101 analysis." *See id.; Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada*, 687 F.3d 1266, 1273-1274 (Fed. Cir. 2012). Further, in both cases, the district court asserted that "where the court has a 'full understanding of the basic character of the claimed subject matter,' the question of patent eligibility may properly be resolved on the pleadings." *Compare Appx17 with MyMail*, 313



F. Supp. 3d at 1102. That statement of the law, however, merely gave the district court an excuse in both cases to eschew formal claim construction and to perform a perfunctory facial claim review, which, as noted above, is irreconcilable with *MyMail*. What is more, the district court's reliance on *Bancorp* in both cases, which this Court decided two years before *Alice*, for the proposition that Rule 12 patent-eligibility challenges can be resolved without claim construction is no longer sound. *See MyMail*, 934 F.3d at 1381; *Natural Alternatives*, 918 F.3d at 1354 (Reyna, J., concurring-in-part, dissenting-in-part); *Aatrix*, 882 F.3d at 1125 (doubting Rule 12 ineligibility finding without claim construction).

Nevertheless, district courts across the country still look to *Bancorp* and its progeny to circumvent formal claim construction in deciding Rule 12 eligibility motions. *See, e.g., Joao Control & Monitoring Sys., LLC v. Tehular Corp.*, 173 F. Supp. 3d 717, 725 (N.D. Ill. 2016); *Intellectual Ventures I LLC v. Erie Indem. Co.*, 134 F. Supp. 3d 877, 908 (W.D. Pa. 2015) (“Federal Circuit precedent does not mandate [claim construction], but instead counsels that it is generally desirable only when needed to understand the basic character of the claimed subject matter.”), *aff'd and vacated in part by, remanded*, 850 F.3d 1315 (Fed. Cir. 2017); *DietGoal Innovations LLC v. Bravo Media LLC*, 33 F. Supp. 3d 271, 289 (S.D.N.Y. 2014). Indeed, *MyMail* and this case are not Judge Koh's only examples of this practice. Judge Koh routinely grants Rule 12 motions to dismiss

under §101 without conducting claim construction. *See, e.g., Uniloc USA Inc. v. LG Elecs. USA Inc.*, 379 F. Supp. 3d 974, 983 (N.D. Cal. 2019); *P&G v. QuantifiCare Inc.*, 288 F. Supp. 3d 1002, 1010 (N.D. Cal. 2017); *Twilio, Inc. v. Telesign Corp.*, 249 F. Supp. 3d 1123, 1136 (N.D. Cal. 2017). Indeed, the Court is reviewing another Judge Koh ineligibility decision argued the same day as this case in which the Court questioned Judge Koh’s failure to conduct claim construction despite the parties not asking for claim construction. *See Uniloc USA Inc. v. LG Elecs. USA Inc.*, No. 19-1835, Oral Arg. Recording at 11:05-11:15 (Fed. Cir. Mar. 3, 2020) (Moore, J.) (“Before we’re gonna declare claims ineligible, if there is a question about the construction ought that not to be resolved?”).

Even before *MyMail*, several judges, including Judge Bryson, required claim construction before considering a Rule 12 motion under §101. *See, e.g., Advanced Mktg. Sys. v. CVS Pharm., Inc.*, 2016 U.S. Dist. LEXIS 86711, at \*4 (E.D. Tex. Jan. 25, 2016); *Prescriber, LLC v. AO Capital Partners LLC*, 2015 U.S. Dist. LEXIS 194148, at \*6 (E.D. Tex. Mar. 31, 2015); *Loyalty Conversion Sys. Corp. v. Am. Airlines, Inc.*, 66 F. Supp. 3d 829, 835 (E.D. Tex. 2014) (Bryson, J.) (“[T]he Court has waited until after the claim construction hearing in this case to rule on the [Rule 12(c) motion] in order to ensure that there are no issues of claim construction that would affect the Court’s legal analysis of the patentability issue.”). After *MyMail*, some district courts have now made claim construction a

prerequisite to deciding a Rule 12 eligibility challenge. *See Grecia v. Bank of N.Y. Mellon Corp.*, 2020 U.S. Dist. LEXIS 45223, at \*6 (S.D.N.Y. Mar. 3, 2020) (“it is error for a district court to decide subject-matter eligibility before addressing a claim construction dispute”) (citing *MyMail*, 934 F.3d at 1379); *Integrated Claims Sys., LLC v. Old Glory Ins. Co.*, 2020 U.S. Dist. LEXIS 36533, at \*7 (E.D. Tex. Mar. 3, 2020) (denying motion to dismiss without prejudice to refile “*only* after the Court has issued a claim construction order addressed to any asserted claims.”) (emphasis in original) (citing *MyMail*, 934 F.3d at 1379). If *MyMail* is the law, then the panel should have applied it in this case, especially considering that this case arose from the same district court as *MyMail*. But the panel did not.

The panel’s unwillingness to use this case to uphold *MyMail* is particularly distressing because district courts still find patents ineligible at the Rule 12 stage without regard for *MyMail*’s holding. Significantly, nearly three months after this Court decided *MyMail*, Judge Koh, who at one hearing described VoIP-Pal’s patents as a “cancer,” found four other VoIP-Pal patents ineligible at the Rule 12 stage without construing their claims and without even citing *MyMail*. *See Voip-Pal.com, Inc. v. Apple Inc.*, 411 F. Supp. 3d 926 (N.D. Cal. 2019). Instead, the district court applied the same outdated *Bancorp* standard that it applied in this case. *Id.* at 936. Worse, the district court ignored the parties’ claim construction disputes, which were fully briefed. *See Voip-Pal.com, Inc. v. Apple Inc.*, 5:18-cv-

06216-LHK (N.D. Cal.), Dkt. Nos. 93-95. Unless the Court rehears this case, the district court and others will continue to resolve eligibility-determinative claim construction disputes without claim construction despite what *MyMail* requires. *See, e.g., Mortg. Application Techs. v. Meridianlink, Inc.*, 2020 U.S. Dist. LEXIS 40036, at \*7 (C.D. Cal. Jan. 6, 2020) (“[T]he Court notes that it may properly entertain this [Rule 12] motion [under §101] without construing claims.”) (citing *MyMail*, 934 F.3d at 1379).

In sum, *MyMail* seriously undermined the propriety of district courts, including the district court in this case, bypassing their duty to construe claims whose meaning is disputed under a Rule 12 eligibility challenge. Without clear guidance from this Court, the inconsistent and erroneous practices noted above will persist. The Court should address this critically important issue head on.

**B. The Panel’s Decision Improperly Placed The Burden Of Raising A Claim Construction Dispute On VoIP-Pal.**

It is also exceptionally important that the Court answer the following question: who had the burden to propose claim terms for construction—Appellees or VoIP-Pal? Either way, the Court should rehear this case. At oral argument, Appellees repeatedly faulted VoIP-Pal for failing to ask the district court to construe specific terms, claiming that such a request is required by *MyMail*. *See VoIP-Pal.com v. Twitter, Inc.*, No. 19-1808 (Lead Case), Oral Arg. Recording at 21:01-21:21 (Fed. Cir. Mar. 3, 2020) (“[M]ost importantly Judge O’Malley VoIP-

Pal has never said to the district court or this court what limitation if construed in VoIP-Pal's favor would change the 101 analysis and under *MyMail* that's the question for claim construction." Appellees even went as far as arguing that it was VoIP-Pal's "obligation to put forward . . . a disputed limitation and explain why it matters for the 101 structure." *Id.* at 22:01-22:08. This argument, however, is plainly untenable.

Such an approach improperly shifts the burden of proving ineligibility from Appellees to VoIP-Pal. *See Data Distribution Techs., LLC v. BRER Affiliates, Inc.*, 2014 U.S. Dist. LEXIS 115543, at \*19 (D.N.J. Aug. 19, 2014) (denying Rule 12 eligibility motion because although the patentee "has not provided proposed constructions," it "has no obligation to do so at this time"); *see also* 5B Charles Alan Wright & Arthur R. Miller, *Federal Practice and Procedure* §1357 (3d ed. 2018) ("All federal courts are in agreement that the burden is on the moving party to prove that no legally cognizable claim for relief exists."). Appellees plainly had the burden to show that there was no plausible reading of the patents-in-suit under which the asserted claims satisfied the eligibility requirement. *See Card Verification Solutions, LLC v. Citigroup Inc.*, 2014 U.S. Dist. LEXIS 137577, at \*6 (N.D. Ill. Sep. 29, 2014) ("[D]ismissal is appropriate solely when the only plausible reading of the patent is that there is clear and convincing evidence of ineligibility."). As one commentator succinctly stated, "[u]nder *Twombly* and

*Iqbal*, dismissal on the pleadings would be appropriate only if . . . there is no plausible claim construction under which the patent would satisfy the eligibility test.” See Paul R. Gugliuzza, *Quick Decisions in Patent Cases*, 106 Georgetown L.J. 619, 662 (2018). Unsurprisingly, Appellees cited no authority for shifting their burden to VoIP-Pal.

Inexplicably, like the district court, the panel overlooked this critical point of law. Indeed, in asking whether VoIP-Pal had proposed any claim constructions relevant to the eligibility inquiry, Judge O’Malley remarked “the problem is you’ve got a district court judge who says, well, it doesn’t really turn on claim construction you oughtta at least give me a couple claims or a couple terms that you want construed.” See *VoIP-Pal.com*, Oral Arg. Recording at 32:14-32:24. The problem Judge O’Malley identified, however, spotlights the district court’s flawed analysis. After *MyMail*, a district court cannot merely say that the eligibility inquiry does not turn on claim construction when the parties dispute what is captured by the claims, as the parties did in this case. Such a dispute is by definition a claim construction dispute. If VoIP-Pal had the burden to identify disputed terms, then the Court should say so. Otherwise, district courts will not hold the moving party to their burden, as in this case, or will misapply the burden against unwitting non-moving parties. See, e.g., *Mortg. Application Techs. v. Meridianlink, Inc.*, 2020 U.S. Dist. LEXIS 40036, at \*7 (C.D. Cal. Jan. 6, 2020)

(granting Rule 12 eligibility motion stating “Plaintiff does not raise a claim construction dispute with proposed constructions but instead simply lists terms that it contends ‘should be construed.’”).

Furthermore, VoIP-Pal specifically argued that claim 28 of the ’815 patent required construction under 35 U.S.C. §112(6). Appx001315-001317. VoIP-Pal also argued that the alleged improvements of user-specific call handling and transparent routing were embodied by “all of the asserted claims.” Appx001309-001310; Appx001337-Appx001339, ¶¶13-14. Appellees argued that “the key claim limitation would be the classifying step [of claim 1 of the ’815 patent].” *See VoIP-Pal.com*, Oral Arg. Recording at 21:30-21:31; *cf.* Appx001313. Judge O’Malley even thought that the “producing a public network routing message for receipt by the call controller” limitation of claim 1 of the ’815 patent was significant to the eligibility inquiry. *Id.* at 22:09-22:14; Appx000167, 36:30-32. VoIP-Pal further argued that claim construction was required before deciding Appellees’ Rule 12 motion. Appx001325. Yet, the district court did not construe any of the above claim aspects to determine their impact on the eligibility analysis. Litigants like VoIP-Pal desperately need guidance from the Court as to what more the non-moving party needs to do, if anything, to raise an actual claim construction dispute under a Rule 12 eligibility challenge. Two panel members and Judge Reyna previously identified the same issue as requiring “much-needed guidance *en*

*banc*” when a claim construction dispute arises at a later procedural stage. *See Nobelbiz*, 867 F.3d at 1327-38 (O’Malley, J., joined by Newman & Reyna, JJ., dissenting from denial of reh’g *en banc*).

**C. The District Court Erroneously Rejected VoIP-Pal’s Plausible Allegations That The Claims Recite An Inventive Concept Based On A Facial Review Of The Asserted Claims.**

Lastly, the Court should rehear this case to clarify precedent that a patentee’s plausible factual allegations that the asserted claims recite an inventive concept cannot be refuted at the Rule 12 stage solely by a facial review of the claims. It is evident that VoIP-Pal alleged a plausibly-patent-eligible invention that is captured by the asserted claims. In considering four other VoIP-Pal patents related to the patents-in-suit, the district court admitted that the alleged improvements of user-specific calling and transparent routing “constitute a meaningful improvement in call routing technology.” *See Voip-Pal.com*, 411 F. Supp. 3d at 960. The district court also agreed that these improvements are “significant and unconventional improvements upon prior technology.” *Id.* at 974. Even Judge O’Malley praised certain aspects of transparent routing. *See VoIP-Pal.com*, Oral Arg. Recording at 8:42-8:46 (“Getting rid of dialing 9 is great. So that’s wonderful.”). Yet, in rejecting VoIP-Pal’s allegations that the asserted claims captured user-specific calling and transparent routing in this case, the district court provided no analysis



beyond stating that the claims do not mention the benefits or concepts embodied by the alleged inventive concepts. Appx000047-Appx000048.

The panel's affirmance of the district court's reasoning conflicts with this Court's precedent that plausible factual allegations preclude dismissing a case under §101 where nothing in the record refutes those allegations as a matter of law or justifies dismissal under Rule 12(b)(6). *See Aatrix*, 882 F.3d at 1125. Moreover, allegations in the complaint are sufficient to overcome a Rule 12 eligibility challenge as long as what makes the claims inventive is recited by the claims. *See Cellspin Soft*, 927 F.3d at 1317. VoIP-Pal specifically alleged that claim 1 of the '815 patent contains the inventive concept of "user-specific calling" and thus describes applying caller-specific "attributes" ("calling attributes associated with the caller") to evaluate a "callee identifier" to identify an intended destination ("callee")—plausibly pointing to specific claim language containing the alleged inventive concept. Appx001308-Appx001309; Appx001313; *see also* Appx001337-Appx001338, ¶12. Nevertheless, the district court rejected VoIP-Pal's plausible allegations apparently because the words "user-specific calling" do not appear in the claims. Appx000047. The district court likewise rejected VoIP-Pal's plausible allegation that, "in contrast" to the prior art's shortcomings, VoIP-Pal's invention provides "routing transparency." Appx001338-Appx001339, ¶¶13-14. Again, in rejecting VoIP-Pal's argument that "[t]ransparent routing is

embodied in all the asserted claims,” the district court ignored VoIP-Pal’s plausible assertion that specific language from claim 1 of the ’815 patent provides this inventive concept (“determining a match when at least one of said calling attributes matches at least a portion of said callee identifier,” and “classifying the call as a [private or public] network call when said match meets [private or public] network classification criteria”). Appx001310.

Unsurprisingly, at oral argument, Appellees repeatedly argued that the claims do not recite the alleged inventive concepts but, despite bearing the burden to prove ineligibility, offered no evidence or claim construction that would show otherwise. *See VoIP-Pal.com*, Oral Arg. Recording at 18:09-18:12, 18:47-18:49. Appellees even told the panel that “[n]othing about this claim requires any user specificity whatsoever” but did not tell the panel that Apple took the exact opposite position before the PTAB—arguing that VoIP-Pal’s claims require user-specific processing. *See VoIP-Pal.com*, Oral Arg. Recording at 23:02-23:15; Appx001544-Appx001545, ¶¶63-64.

Like Appellees, the district court concluded that the claims do not recite an inventive concept without an evidentiary basis for doing so and without undertaking any effort to determine what the claim language actually means. Consequently, the district court unfairly held VoIP-Pal to an impossible standard—requiring that the claims contain the alleged inventive concept yet refusing to

construe the claims to determine if they do. Here, as in *Aatrix*, VoIP-Pal’s allegations and briefing “demonstrate a need for claim construction” and precluded a finding that the claimed elements were well understood, routine, and conventional. *See Aatrix*, 882 F.3d at 1129. Accordingly, the Court should rehear this case to hold that VoIP-Pal’s plausible allegations cannot be trumped by a facial review of the asserted claims.

#### 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: April 15, 2020

Respectfully submitted,

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## CERTIFICATE OF COMPLIANCE

I certify that this brief complies with the type-volume limitation set forth in Rule 35(b)(2)(A) of the Federal Rules of Appellate Procedure. This brief uses a proportional typeface and 14-point font, and contains 3,894 words.

Dated: April 15, 2020

Respectfully submitted,

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**JUDGMENT**  
**FILED MARCH 16, 2020**

NOTE: This disposition is nonprecedential.

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

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

v.

**TWITTER, INC.,**  
*Defendant-Appellee*

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2019-1808

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Appeal from the United States District Court for the Northern District of California in No. 5:18-cv-04523-LHK, United States District Judge Lucy H. Koh.

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

v.

**CELLCO PARTNERSHIP, DBA VERIZON  
WIRELESS SERVICES LLC,**  
*Defendant-Appellee*

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2019-1812

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Appeal from the United States District Court for the Northern District of California in No. 5:18-cv-06054-LHK, United States District Judge Lucy H. Koh.

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

v.

**AT&T CORP.,**  
*Defendant-Appellee*

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2019-1813

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Appeal from the United States District Court for the Northern District of California in No. 5:18-cv-06177-LHK, United States District Judge Lucy H. Koh.

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

v.

**APPLE, INC.,**  
*Defendant-Appellee*

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2019-1814

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Appeal from the United States District Court for the Northern District of California in No. 5:18-cv-06217-LHK, United States District Judge Lucy H. Koh.

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**JUDGMENT**

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THIS CAUSE having been heard and considered, it is



ORDERED and ADJUDGED:

PER CURIAM (NEWMAN, LOURIE, and O'MALLEY, *Circuit Judges*).

**AFFIRMED. See Fed. Cir. R. 36.**

ENTERED BY ORDER OF THE COURT

March 16, 2020  
Date

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

### **CERTIFICATE OF SERVICE**

I hereby certify that on April 15, 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: April 15, 2020

Respectfully submitted,

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