

1 PERKINS COIE LLP
Sarah Fowler (Bar No. 264838)
2 Amisha Manek (Bar No. 305163)
3150 Porter Drive
3 Palo Alto, CA 94304-1212
Phone: 650.838.4300
4 SFowler@perkinscoie.com
AManek@perkinscoie.com

5 PERKINS COIE LLP
6 Gene W. Lee (*pro hac vice*)
Thomas Matthew (*pro hac vice*)
7 1155 Avenue of the Americas, 22nd floor
New York, NY 10112-0015
8 212.262.6900
GLEe@perkinscoie.com
9 TMatthew@perkinscoie.com

10 *Attorneys for Plaintiff Twitter, Inc.*

11 UNITED STATES DISTRICT COURT
12 NORTHERN DISTRICT OF CALIFORNIA
13 SAN JOSE DIVISION

14
15 TWITTER, INC., a Delaware corporation,

16 Plaintiff,

17 v.

18 VOIP-PAL.COM, INC., a Nevada
19 corporation,

20 Defendant.

No. 20-cv-2397-LHK

**FIRST AMENDED COMPLAINT FOR
DECLARATORY JUDGMENT**

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I. INTRODUCTION

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2 1. This First Amended Complaint for declaratory judgment of noninfringement
3 (“Declaratory Judgment Complaint”) arises from a real and immediate controversy between
4 plaintiff Twitter, Inc. (“Twitter”), and defendant VoIP-Pal.com Inc. (“VoIP-Pal”), as to whether
5 Twitter infringes any claims of U.S. Patent 10,218,606 (“the ’606 patent”; Exhibit 1), entitled,
6 “Producing Routing Messages For Voice Over IP Communications,” and whether the ’606 patent
7 is valid.

8 2. The ’606 patent is a member of a family that includes six other patents that VoIP-
9 Pal has asserted in prior lawsuits in this Court against Twitter, Apple, AT&T, Verizon Wireless,
10 and Amazon (“first and second wave actions”). The ’606 patent shares a common specification
11 with the six previously-asserted patents. All six of the previously-asserted patents were found to
12 be invalid under 35 U.S.C. § 101 for claiming ineligible subject matter, including U.S. Patent
13 9,179,005 (“the ’005 patent”; Exhibit 2), which was asserted against Twitter.

14 3. During April 2-7, 2020, VoIP-Pal filed new lawsuits in the Western District of
15 Texas asserting the ’606 patent against Facebook, WhatsApp, Google, Amazon, and Apple. The
16 claims of the ’606 patent asserted in those new lawsuits are very similar to the claims of one or
17 more of the patents that VoIP-Pal previously asserted in the first and second wave actions and
18 were found to be invalid by this Court.

19 4. On April 8, 2020, VoIP-Pal issued a press release stating that VoIP-Pal is
20 considering taking further action and is not finished taking action in the wake of a recent decision
21 by the Court of Appeals for the Federal Circuit in favor of Twitter, Apple, AT&T, and Verizon
22 that affirmed this Court’s judgment that two of VoIP-Pal’s previously-asserted patents are invalid
23 under 35 U.S.C. § 101.

24 5. On April 24, 2020, VoIP-Pal filed new lawsuits in the Western District of Texas
25 asserting the ’606 patent against AT&T and Verizon Wireless. (VoIP-Pal’s lawsuits against
26 Facebook, WhatsApp, Google, Amazon, Apple, AT&T, and Verizon Wireless are referred to
27 herein as “the Texas lawsuits.”)
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1 12. Based on information and belief, including VoIP-Pal's complaints in the Texas
2 lawsuits, VoIP-Pal is the owner of the '606 patent.

3 **III. JURISDICTION AND VENUE**

4 13. This Declaratory Judgment Complaint includes a count for declaratory relief under
5 the patent laws of the United States, 35 U.S.C. §§ 1, *et seq.*

6 14. Twitter seeks declaratory relief under 28 U.S.C. §§ 2201 and 2202.

7 15. This Court has subject matter jurisdiction over the claims alleged in this action
8 under 28 U.S.C. §§ 1331, 1332, 1338, 2201, and 2202 because this Court has exclusive
9 jurisdiction over declaratory judgment claims arising under the patent laws of the United States
10 pursuant to 28 U.S.C. §§ 1331, 1338, 2201, and 2202. Jurisdiction is also proper under 28 U.S.C.
11 § 1332 because Twitter and VoIP-Pal are citizens of different states, and the value of the
12 controversy exceeds \$75,000.

13 16. This Court can provide the declaratory relief sought in this Declaratory Judgment
14 Complaint because an actual case and controversy exists between the parties within the scope of
15 this Court's jurisdiction pursuant to 28 U.S.C. § 2201. An actual case and controversy exists at
16 least because VoIP-Pal previously filed lawsuits against Twitter and other defendants alleging
17 infringement of the '005 patent and other related patents; the '606 patent is a member of a family
18 that includes six other patents that VoIP-Pal previously asserted in the first and second wave
19 actions and shares a common specification with those six patents; the claims of the '005 patent
20 that were previously asserted in litigation against Twitter are very similar to claims of the '606
21 patent that VoIP-Pal is now asserting in the Texas lawsuits—including against Amazon, Apple,
22 AT&T, and Verizon Wireless, which were previously sued by VoIP-Pal. All six patents
23 previously asserted by VoIP-Pal were held invalid under 35 U.S.C. § 101 by this Court, and—
24 based on the substantial similarities between those invalid claims and the claims of the '606
25 patent—the '606 patent is invalid for at least the same reasons. Furthermore, VoIP-Pal's public
26 statements to the effect that it is considering taking further action and is not finished taking action
27 in the wake of recent decision by the Federal Circuit affirming the judgment that the claims of the
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1 '005 patent that VoIP-Pal previously asserted against Twitter are invalid; and Twitter does not
2 infringe and has not infringed any claims of the '606 patent.

3 17. On June 4, 2020, counsel for Twitter asked counsel for VoIP-Pal whether VoIP-
4 Pal would be willing to grant Twitter a covenant not to sue based on the '606 patent. On June 11,
5 2020, counsel for VoIP-Pal declined to discuss a covenant not to sue, responding as follows:
6 "VoIP-Pal's position is that Twitter's declaratory judgment complaint lacked subject matter
7 jurisdiction at the time it was filed and therefore should be dismissed. Accordingly, VoIP-Pal
8 does not believe that a covenant not to sue needs to be discussed under the present circumstances.
9 This response should not be construed as a refusal to grant a covenant not to sue." To date, VoIP-
10 Pal has declined to give Twitter a covenant not to sue based on the '606 patent.

11 18. This Court has personal jurisdiction over VoIP-Pal because VoIP-Pal has engaged
12 in actions in this District that form the basis of Twitter's claims against VoIP-Pal—namely,
13 prosecuting a prior patent infringement lawsuit involving the '005 patent against Twitter in this
14 District, voluntarily transferring to this District the first wave actions against Apple, AT&T, and
15 Verizon, and filing the second wave actions against Apple and Amazon in this District. VoIP-
16 Pal's actions have created a real, live, immediate, and justiciable case or controversy between
17 VoIP-Pal and Twitter.

18 19. As a result of VoIP-Pal's conduct described above, VoIP-Pal has consciously and
19 purposely directed allegations of infringement of the '606 patent at Twitter, a company that
20 resides and operates in this District.

21 20. In doing so, VoIP-Pal has established sufficient minimum contacts with the
22 Northern District of California such that VoIP-Pal is subject to specific personal jurisdiction in
23 the Northern District of California for this action. Further, the exercise of personal jurisdiction
24 based on those repeated and highly-pertinent contacts does not offend traditional notions of
25 fairness and substantial justice.

26 21. Venue is proper in this District under 28 U.S.C. §§ 1391 and 1400, including
27 because, under Ninth and Federal Circuit law, venue in declaratory judgment actions for
28 noninfringement of patents is determined under the general venue statute, 28 U.S.C. § 1391.

22. Under 28 U.S.C. § 1391(b)(1), venue is proper in any judicial district where a defendant resides. An entity with the capacity to sue and be sued, such as VoIP-Pal, is deemed to reside, if a defendant, in any judicial district in which such defendant is subject to the court's personal jurisdiction with respect to the civil action in question under 28 U.S.C. § 1391(c).

23. As discussed above, VoIP-Pal is subject to personal jurisdiction with respect to this action in the Northern District of California, and thus, for the purposes of this action, VoIP-Pal resides in the Northern District of California and venue is proper under 28 U.S.C. § 1391.

IV. FACTUAL BACKGROUND

A. VoIP-Pal's Prior Lawsuits (First And Second Wave Actions)

24. In 2016, VoIP-Pal filed lawsuits in the District of Nevada against Twitter, Apple, AT&T, and Verizon Wireless, alleging infringement of two patents, U.S. Patents 8,542,815 and 9,179,005 (the "'815 patent" and "'005 patent," respectively). Between August and November of 2018, all four of those actions were transferred to this Court and consolidated for pretrial purposes: Twitter (Case No. 5:18-cv-04523-LHK), Verizon Wireless (Case No. 18-cv-06054-LHK), AT&T (Case No. 3:18-cv-06177-LHK), and Apple (Case No. 3:18-cv-06217-LHK) (collectively, the "first wave actions").

25. Twitter and the other defendants in the first wave actions filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6) that the asserted claims of the '815 and '005 patents are invalid under 35 U.S.C. § 101. On March 25, 2019, this Court granted the motion to dismiss and found all asserted claims of the '815 and '005 patents to be invalid (Exhibit 10). VoIP-Pal appealed. On March 16, 2020, the Federal Circuit affirmed this Court's judgment of invalidity.

26. In October and November 2018, VoIP-Pal filed two additional lawsuits against Apple (Case No. 5:18-cv-06216-LHK) and Amazon (Case No. 5:18-cv-07020-LHK) (collectively, the "second wave actions"). In those lawsuits, VoIP-Pal alleged infringement of four patents, U.S. Patents 9,537,762; 9,813,330; 9,826,002; and 9,948,549. Those four patents are in the same family as and share a common specification with the two patents that were asserted in the first wave actions.

1 27. In the second wave actions, Apple and Amazon filed a motion to dismiss under
2 Fed. R. Civ. P. 12(b)(6) that the asserted claims of the four asserted patents are invalid under
3 35 U.S.C. § 101. On November 19, 2019, this Court granted the motion to dismiss and found all
4 asserted claims of the patents in the second wave actions to be invalid. VoIP-Pal has filed an
5 appeal, which is pending.

6 **B. VoIP-Pal's New Texas Lawsuits And Press Release**

7 28. During April 2-7, 2020, VoIP-Pal filed four new lawsuits in the Western District
8 of Texas, Waco Division, against defendants Facebook and WhatsApp (Civil Action No. 20-cv-
9 267) and Google (Civil Action No. 20-cv-269) and previously-sued defendants Amazon (Civil
10 Action No. 20-cv-272), and Apple (Civil Action No. 20-cv-275). On April 24, 2020, VoIP-Pal
11 filed new lawsuits in the Western District of Texas asserting the '606 patent against AT&T (Civil
12 Action No. 20-cv-325) and Verizon Wireless (Civil Action No. 20-cv-327). (Voip-Pal's lawsuits
13 against Facebook, WhatsApp, Google, Amazon, Apple, AT&T, and Verizon Wireless are referred
14 to herein as "the Texas lawsuits"; complaints attached as Exhibits 3-8.)

15 29. In the Texas lawsuits, VoIP-Pal alleges infringement of U.S. Patent 10,218,606
16 (the "'606 patent"; Exhibit 1), which is entitled, "Producing Routing Messages For Voice Over IP
17 Communications," and, on its face, issued on February 26, 2019.

18 30. The '606 patent is in the same family as and shares a common specification with
19 the six patents that VoIP-Pal asserted in the first and second wave actions and were found to be
20 invalid by this Court.

21 31. The complaints in the Texas lawsuits identify claims 1, 8, 15, and 19 of the '606
22 patent as examples of claims that are infringed by one or more defendants in the Texas lawsuits
23 (Exhibits 3-8). These exemplary claims of the '606 patent are very similar to claims of the '005
24 patent that VoIP-Pal asserted against Twitter, Apple, AT&T, and Verizon in the first wave actions
25 (for example, claim 74 of the '005 patent) and were held to be invalid.

26 32. VoIP-Pal's infringement allegations in the Texas lawsuits are similar to VoIP-
27 Pal's infringement allegations in the first wave and second wave actions (including against many
28 of the same prior defendants), and are directed to accused instrumentalities that are similar to

1 Twitter's products and services (for example, communications involving text, images, and
2 videos).

3 33. Twitter believes that it does not infringe and has not infringed any claims of the
4 '606 patent and that the claims of the '606 patent are invalid.

5 34. On April 8, 2020, VoIP-Pal issued a press release that announced the filing of the
6 Texas lawsuits (Exhibit 9 and <https://www.voip-pal.com/voip-pal-new-patent-lawsuits-april->).
7 The press release also mentioned the Federal Circuit's affirmance of this Court's judgment of
8 invalidity in the first wave lawsuits against Twitter, Apple, AT&T, and Verizon. The press
9 release states that, in the wake of the Federal Circuit decision, VoIP-Pal is considering taking
10 further action and "planning their next moves." VoIP-Pal's CEO is quoted as saying, "Our legal
11 team is assessing our next moves regarding this Alice decision and we expect to announce our
12 intentions soon. *I can tell you; we are not finished,*" and "We remain firm in our resolve to
13 achieve monetization for our shareholders and will continue to see this fight through until a
14 successful resolution is reached. Patience is a virtue." (Exhibit 9 (emphasis added).)

15 **FIRST CLAIM FOR RELIEF**
16 **(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '606 PATENT BY TWITTER)**

17 35. The facts and allegations contained in the preceding paragraphs are incorporated
18 by reference herein.

19 36. In view of the facts and allegations set forth above, there is an actual, justiciable,
20 substantial, and immediate controversy between Twitter, on the one hand, and VoIP-Pal, on the
21 other, regarding whether Twitter's products and services infringe any claims of the '606 patent.

22 37. For example, an actual case and controversy exists at least because VoIP-Pal
23 previously filed lawsuits against Twitter and other defendants alleging infringement of the '005
24 patent and other related patents in the first and second wave actions; the '606 patent is a member
25 of a family that includes six other patents that VoIP-Pal previously asserted in the first and second
26 wave actions and shares a common specification with those six patents; the claims of the '005
27 patent that were previously asserted in litigation against Twitter are very similar to claims of the
28 '606 patent that VoIP-Pal is now asserting in the new Texas lawsuits—including against Amazon,

1 Apple, AT&T, and Verizon Wireless, which were previously sued by VoIP-Pal; VoIP-Pal's
2 public statements to the effect that it is considering taking further action and is not finished taking
3 action in the wake of recent decision by the Federal Circuit affirming the judgment that the claims
4 of the '005 patent that VoIP-Pal previously asserted against Twitter are invalid; Twitter has asked
5 VoIP-Pal for a covenant not to sue for the '606 patent, but VoIP-Pal has declined to give Twitter
6 a covenant not to sue; and Twitter believes that it does not infringe and has not infringed any
7 claims of the '606 patent.

8 38. Twitter does not infringe and has not infringed any claims of the '606 patent
9 because, for example, no Twitter product or service meets or embodies the limitation of
10 "processing the new second participant identifier, using the at least one processor, to determine
11 whether the second network element is the same as the first network element," "when the second
12 network element is determined to be the same as the first network element, producing a routing
13 message identifying a first network address associated with the first network element," and "when
14 the second network element is determined not to be the same as the first network element,
15 producing a routing message identifying a second network address associated with the second
16 network element."

17 39. In view of the foregoing, there is an actual, justiciable, substantial, and immediate
18 controversy between Twitter, on the one hand, and VoIP-Pal, on the other, regarding whether
19 Twitter's products and services infringe any claims of the '606 patent.

20 40. Twitter is entitled to a judgment declaring that no Twitter products or services
21 infringe the '606 patent.

22 **SECOND CLAIM FOR RELIEF**
23 **(DECLARATORY JUDGMENT OF INVALIDITY OF THE '606 PATENT BY TWITTER)**

24 41. The facts and allegations contained in the preceding paragraphs are incorporated
25 by reference herein.

26 42. In view of the facts and allegations set forth above, there is an actual, justiciable,
27 substantial, and immediate controversy between Twitter, on the one hand, and VoIP-Pal, on the
28 other, regarding whether any claim of the '606 patent is valid.

1 43. The '606 patent, which on its face issued on February 26, 2019, during the
2 pendency of VoIP-Pal's lawsuit against Twitter in this Court, is in the same family as and shares
3 a common specification with the '005 patent that VoIP-Pal asserted in earlier litigation against
4 Twitter. This Court held that the asserted claims of the '005 patent and five other related patents
5 were all invalid under 35 U.S.C. § 101.

6 44. Like those already-invalidated claims, the claims of the '606 patent are invalid
7 under 35 U.S.C. § 101. For example, the claims of the '606 patent (including claim 15) are
8 directed to the abstract idea of routing a communication based on characteristics of the
9 participants—an idea that this Court held was abstract in analyzing VoIP-Pal's previously-
10 asserted patents, including representative claim 74 of the '005 patent that was asserted against
11 Twitter. (*See* Exhibit 10 at 34-39 (finding claim 74 of the '005 patent to be directed to the
12 abstract idea of “routing a call based on the characteristics of a caller and callee”).) Furthermore,
13 consistent with this Court's earlier judgments concerning related patents, none of the claims of
14 the '606 patent recites an inventive concept when their elements are considered either
15 individually or as an ordered combination. (*See* Exhibit 10 at 39-42 (finding that claim 74 of the
16 '005 patent does not contain an inventive concept).) For example, the claims of the '606 patent
17 (including claim 15) recite generic computer components (like a “packet switched communication
18 system,” a “processor,” and a “database”) that the specification admits were not invented by
19 VoIP-Pal and that operate in their expected manner.

20 45. In view of the foregoing, there is an actual, justiciable, substantial, and immediate
21 controversy between Twitter, on the one hand, and VoIP-Pal, on the other, regarding whether any
22 claim of the '606 patent is valid.

23 46. Twitter is entitled to judgment declaring that the claims of the '606 patent are
24 invalid at least under 35 U.S.C. § 101.

25 **PRAYER FOR RELIEF**

26 Twitter respectfully requests that this Court enter judgment against VoIP-Pal as follows:

27 A. A declaration that the Twitter products and services do not infringe any claims of
28 the '606 patent;

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- B. A declaration that the claims of the '606 patent are invalid;
- C. For attorney's fees and costs;
- D. Such other and further relief as this Court or a jury may deem just and proper.

DATED: June 26, 2020

PERKINS COIE LLP

By: /s/ Gene Lee
 Sarah Fowler
 Amisha Manek
 Gene Lee
 Thomas Matthew

Attorneys for Plaintiff Twitter, Inc.