

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC., AVAYA, INC., VERIZON SERVICES CORP.,
and
VERIZON BUSINESS NETWORK SERVICES INC.,
Petitioner

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner

Case IPR2015–01962
Patent 6,701,365 B1

Before KALYAN K. DESHPANDE, TRENTON A. WARD, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Cisco Systems, Inc. (“Cisco”), AVAYA Inc. (“AVAYA”), Verizon Services Corp., and Verizon Business Network Services Inc. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–3 of U.S. Patent No. 6,701,365 B1 (Ex. 1001, “the ’365 patent”).¹ Paper 4 (“Pet.”). Straight Path IP Group, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). Patent Owner has disclaimed claims 1 and 2, leaving only claim 3 at issue. Ex. 2002, 1. We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

The United States Court of Appeals for the Federal Circuit issued a decision in *Straight Path IP Group, Inc. v. Sipnet EU S.R.O.*, 806 F.3d 1356 (Fed. Cir. 2015) (“*Straight Path*”), subsequent to the filing of the Petition. See Ex. 2005. *Straight Path* involves construction of claim 1 of U.S. Patent No. 6,108,704, which has the same specification as that of the ’365 patent. The Board authorized additional briefing by the parties (Paper 9); thus, Petitioner filed additional briefing in light of *Straight Path* (Paper 12, “Add’l Br.”) and Patent Owner filed a response to Petitioner’s additional briefing (Paper 14, “PO Add’l Resp.”).

¹ The ’365 patent was reexamined resulting in an *ex parte* reexamination certificate issued under 35 U.S.C. § 307. None of the challenged claims were amended during reexamination. See Ex. 1001, 14–29 (providing a copy of U.S. Patent No. 6,701,365 C1).

After considering the Petition, the Preliminary Response, and associated evidence, we conclude that there is not a reasonable likelihood that Petitioner would prevail in challenging claim 3 on the ground asserted in their Petition. Accordingly, we do not institute *inter partes* review of claim 3 of the '365 patent.

A. Related Proceedings

The '365 patent is related to U.S. Patent No. 6,131,121 ("the '121 patent"), U.S. Patent No. 6,108,704 ("the '704 patent"), and U.S. Patent No. 6,009,469 ("the '469 patent"). Pet. 3.

The '121 patent is the subject of *Cisco Systems, Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-01397 (PTAB), *Verizon Services Corp., et al. v. Straight Path IP Group, Inc.*, IPR2015-01407 (PTAB), *LG Elecs., Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-01014 (PTAB), *Cisco Systems, Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-01006 (PTAB), *LG Elecs., Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-00196 (PTAB), and *Samsung Elecs. Co., Ltd. et al. v. Straight Path IP Group, Inc.*, IPR2014-01368 (PTAB). *Id.* at 3–4.

The '704 patent is the subject of *Cisco Systems, Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-01398 (PTAB), *Verizon Services Corp., et al. v. Straight Path IP Group, Inc.*, IPR2015-01406 (PTAB), *LG Elecs., Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-01017 (PTAB), *Cisco Systems, Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-01011 (PTAB), *LG Elecs., Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-00209 (PTAB), and *Samsung Elecs. Co., Ltd. et al. v. Straight Path IP Group, Inc.*, IPR2014-01366 (PTAB). *Id.*

The '469 patent is the subject of *Cisco Systems, Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-01400 (PTAB), *LG Elecs., Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-01015 (PTAB), *Cisco Systems, Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-01007 (PTAB), *LG Elecs., Inc., et al. v. Straight Path IP Group, Inc.*, IPR2015-00198 (PTAB), and *Samsung Elecs. Co., Ltd. et al. v. Straight Path IP Group, Inc.*, IPR2014-01368 (PTAB). *Id.*

The '365 patent is the subject of *Straight Path IP Group, Inc. v. Cisco Systems, Inc.*, No. 3:14-cv-04312 (N.D. Cal.), *Straight Path IP Group, Inc. v. AVAYA Inc.*, No. 3:14-cv-04309 (N.D. Cal.), *Straight Path IP Group, Inc. v. Verizon Communications, Inc. et al.*, 1-14-cv-07798 (S.D.N.Y.), and *Point-to-Point Network Communication Devices and Products Containing Same*, Inv. 337-TA-892 (I.T.C.). *Id.* at 4–7. Petitioner indicates that the '365 patent is related to *Straight Path IP Group, Inc. v. SipNet EU S.R.O.*, No. 15-1212 (Fed. Cir.). *Id.* at 4.

B. The '365 Patent

The '365 patent is titled “Point-to-Point Internet Protocol” and generally relates to establishing a point-to-point communication link. Ex. 1001, 1:66–67.

The '365 patent explains that a first processing unit automatically transmits its associated e-mail address, and its IP address, to a connection server. Ex. 1001, 5:35–49; Ex. 1001, 7:5–7:20; Ex. 1001, 7:5–7:15. The connection server stores the addresses in a database and, thus, the first processing unit is established as an active on-line party available for communication. *Id.* The first processing unit sends a query to the connection server, which searches the database to determine whether a

second processing unit is active and on-line. Ex. 1001, 5:66–6:4; Ex. 1001, 7:42–47; Ex. 1001, 7:37–41. If the callee is active and on-line, the connection server sends the IP address of the callee from the database to the first processing unit, i.e., performs a point-to-point Internet protocol communication. Ex. 1001, 6:4–8; Ex. 1001, 7:47–51; Ex. 1001, 7:41–45. The first processing unit then directly establishes the point-to-point Internet communication with the callee using the retrieved IP address. Ex. 1001, 6:8–11; Ex. 1001, 7:51–54; Ex. 1001, 7:43–66.

Figure 1 of the '365 patent is reproduced below:

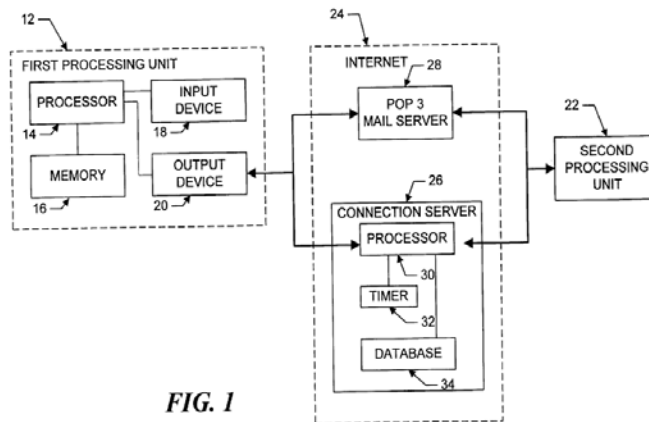


Figure 1 above illustrates the architecture between first processing unit 12, second processing unit 22, and connection server 26. Ex. 1001, 5:27–44, Ex. 1001, 7:21–8:3; Ex. 1001, 6:1–34.

C. Illustrative Claim

Claim 3, the only claim at issue, is reproduced below:

3. In a computer system operatively coupled over a computer network to a plurality of processes, a method comprising the steps of:

a. receiving the current network protocol address of a process coupled to the network, the network protocol address being received by the process from an Internet access server;

- b. receiving an identifier associated with said one process;
- c. receiving a query for one of the network protocol address and the associated identifier of said one process from another of the processes over the computer network at a connection server; and
- d. providing one of the network protocol address and the associated identifier of said one process to a said another process over the computer network, if the said one process is connected to the computer network, and to allow the establishment of a packet-based point-to-point communication between said one process and one of said another processes.

Ex. 1001, 12:13–33.

D. The Alleged Ground of Unpatentability

The information presented in the Petition sets forth the following proposed ground of unpatentability of claim 3 of the '365 patent (*see* Pet. 37–60):²

References	Basis	Claim Challenged
Microsoft Manual ³ and NetBIOS ⁴	§ 103(a)	3

II. ANALYSIS

A. 37 C.F.R. § 42.107(e) Statutory Disclaimer

Under 37 C.F.R. § 42.107(e), “[t]he patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this

² Petitioner supports its challenge with the Declaration of Dr. Bruce M. Maggs. Ex. 1002.

³ MICROSOFT WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1003, “Microsoft Manual”).

⁴ THE OPEN GROUP, TECHNICAL STANDARD, PROTOCOLS FOR X/OPEN PC INTERWORKING: SMB, VERSION 2.0 (1992) (Ex. 1004, “NetBIOS”).

chapter, disclaiming one or more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims.” Patent Owner has filed a statutory disclaimer, disclaiming claims 1 and 2. Ex. 2002, 1. Patent Owner argues that because Straight Path has disclaimed challenged claims 1 and 2 of the ’365 patent, under 37 C.F.R. § 42.107(e), the Board should not institute *inter partes* review of claims 1 and 2. Prelim. Resp. 2. On this record, we do not institute *inter partes* review of claims 1 and 2 because Patent Owner has successfully disclaimed claims 1 and 2. Remaining at issue is claim 3.

B. Claim Construction

The Board construes expired patent claims according to the standard applied by the district courts. *See In re Rambus*, 694 F.3d 42, 46 (Fed. Cir. 2012). Specifically, we apply the principles set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

The words of a claim are generally given their ordinary and customary meaning, and that is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent, including the specification. *See Phillips*, 415 F.3d at 1312–13. Claims are not interpreted in a vacuum but are a part of and read in light of the specification. *See Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987). Although it is improper to read a limitation from the

specification into the claims, *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993), the claims still must be read in view of the specification of which they are a part. *See Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1347 (Fed. Cir. 2004).

Only those terms that are in controversy need to be construed and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). We construe the following claim term:

“is connected to the computer network”

Independent claim 3 of the '365 patent recites, “providing one of the network protocol address and the associated identifier of said one process to a said another process over the computer network, if the said one process *is connected to the computer network*” (emphasis added).

In *Straight Path*, the Federal Circuit held that the claim language “is connected to the computer network” has a facially clear meaning, that “the query transmitted to the server seeks to determine whether the second unit is connected at that time, *i.e.*, connected at the time that the query is sent.” *Straight Path*, 806 F.3d at 1360.⁵ The Federal Circuit held that the query

⁵ Petitioner argues that the specification does not include an embodiment that guarantees the availability of the second process at any given point in time and that the file histories of the challenged patents expressly reject the notion that the claims contain any guarantee of perfect accuracy. Add'l Br. 4, 6. In *Straight Path*, the Federal Circuit did not offer a view as to the sufficiency of the written description or enablement based on the claim construction provided by the Federal Circuit because “written-description and enablement challenges were not, and could not have been, part of the inter parties review.” *Straight Path*, 806 F.3d at 1363. We similarly do not make any determination as to whether the claim as so construed meets the written description or enablement requirement. *See* 35 U.S.C. § 311(b).

asks “whether the device ‘is’ connected, not whether it was connected or whether it is still registered as being connected even if that registration information is no longer accurate.” *Id.* The Federal Circuit further explained that “[i]t is not a reasonable interpretation of the claim language . . . to say that it is satisfied by a query that asks only for registration information, regardless of its current accuracy.” *Id.* The Federal Circuit explained, “[w]hen claim language has as plain a meaning on an issue as the language does here, leaving no genuine uncertainties on interpretive questions relevant to the case, it is particularly difficult to conclude that the specification reasonably supports a different meaning. The specification plays a more limited role than in the common situation where claim terms are uncertain in meaning in relevant respects.” *Id.* at 1361. Accordingly, the Federal Circuit construed the limitation “is connected to the computer network” as “is connected to the computer network at the time the query is transmitted to the server.” *Id.* at 1363.

Petitioner argues that the specification “makes clear that on-line status information need only be ‘relatively current’” and the specification discloses the use of timestamps, timeouts, and polling to maintain the “relatively current” information.⁶ Pet. 36–37. We disagree with Petitioner. The Federal Circuit held that “[w]hen claim language has as plain a meaning . . .

⁶ Petitioner further notes that claim 3 requires “receiving a query,” whereas claim 1 of the ’704 patent recite “transmitting . . . a query.” Add’l Br. 2. This argument was not raised in the Petition, and, therefore, Petitioner is improperly raising a new argument in the additional briefing. Regardless, although Petitioner correctly notes that this is a difference between the two claims, we determine that the present tense recitation of “is connected to the computer network” is the same between the two claims, and, therefore, we must construe the limitations the same.

leaving no genuine uncertainties on interpretive questions . . . [t]he specification plays a more limited role than in the common situation where claim terms are uncertain in meaning in relevant respects.” *Straight Path*, 806 F.3d at 1361. Although the Federal Circuit highlighted the same disclosures from the ’704 patent specification argued by Petitioner, the Federal Circuit did not rely on the ’704 patent specification in narrowing “is connected to the computer network” and “on-line status,” but rather held that the ’704 patent specification did not contradict its claim construction of these terms.

Petitioner further argues that “is connected to the computer network” is satisfied by a “two-step protocol.” Add’l Br. 3. Petitioner argues that the “two-step protocol” includes the steps of (1) tracking “when the process connects to the computer [network]; and (2) [tracking] when the process disconnects from the computer network.” Add’l Br. 3–5. However, Petitioner’s “two-step protocol” was not raised in the Petition, and, therefore, is improperly raised in the Additional Briefing for the first time. Regardless, we are not persuaded that the Federal Circuit has articulated a “two-step protocol” that satisfies the claim limitation “is connected to the computer network.” Rather, the Federal Circuit held that the query asks “whether the device ‘is’ connected, not whether it was connected or whether it is still registered as being connected even if that registration information is no longer accurate.” *Straight Path*, 806 F.3d at 1360. Accordingly, the Federal Circuit determined “is connected to the computer network” means “is connected to the computer network at the time the query is transmitted to the server.” *Id.* at 1363.

C. Claim 3 — Obviousness over Microsoft Manual and NetBIOS

Petitioner contends that claim 3 is unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual and NetBIOS. Pet. 37–39, 53–60. We have reviewed the Petition and supporting evidence and find that there is not a reasonable likelihood that Petitioner would prevail in challenging claim 3.

1. Microsoft Manual (Ex. 1003)

Microsoft Manual discloses how to install, configure, and troubleshoot Microsoft TCP/IP on a computer running the Microsoft Windows NT Workstation or Windows NT Server operation system. Ex. 1003.⁷ When a computer's name is registered with the Windows Internet Name Service server, the Windows Internet Name Service server accepts the entry with a timestamp, an incremental unique version number, and other information. *Id.* at 56–58. A name query request is received by the Windows Internet Name Service server and allows a client to establish a session based on the address mapping received from the Windows Internet Name Service server. *Id.* at 56–57. For example, if a first computer wants to communicate with a second computer, the first computer queries the Windows Internet Name Service server for the address of the second computer. *Id.* at 51. When the first computer receives the appropriate address from the Windows Internet Name Service server, it connects directly to the second computer. *Id.*

⁷ Exhibit 1003 includes page numbers indicated by the publication itself, and different page numbers provided by Petitioner. Our references are to the page numbers indicated by the publication itself.

2. *NetBIOS (Ex. 1004)*

NetBIOS (“Network Basic Input/Output System”) is a software interface that allows applications on different computers to communicate within a computer network, such as a local area network or the Internet, and was designed originally for IBM’s PC-Network. Ex. 1004, 359.⁸ NetBIOS applications employ mechanisms to locate resources, establish connections, send and receive data with an application peer, and terminate connections. *Id.* A NetBIOS session is the exchange of messages between a pair of NetBIOS applications. *Id.* at 361.

The NetBIOS name service is the collection of procedures through which nodes of a network acquire, defend, and locate the holders of NetBIOS names. *Id.* at 376. A node registers a name with the NetBIOS Name Server, which stores the registered name in a database. *Id.* at 384–85, 394. A name query transaction can be initiated by an end-node in an attempt to obtain the IP address associated with a NetBIOS name. *Id.* at 388–89. If the NetBIOS Name Server has information regarding a queried node, the NetBIOS Name Server transmits a positive response. *Id.* at 389–90. If the NetBIOS Name Server does not have information regarding a queried node, the NetBIOS Name Server transmits a negative response. *Id.* Once the IP addresses have been found for a target name, a NetBIOS session service begins. *Id.* at 397. The NetBIOS session service involves directed (point-to-point) communications. *Id.*

⁸ Exhibit 1004 includes page numbers indicated by the publication itself, and different page numbers provided by Petitioner. Our references are to the page numbers indicated by the publication itself.

3. Analysis

The evidence set forth by Petitioner does not indicate that there is a reasonable likelihood that Petitioner will prevail in showing that claim 3 is unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual and NetBIOS. Pet. 36–45.

As discussed in our claim construction analysis above, claim 3 of the '365 patent recites the limitation “is connected to the computer network.” As also discussed above, consistent with the Federal Circuit’s decision in *Straight Path*, we construe this limitation as “is connected to the computer network at the time that the query is transmitted to the server.”

Petitioner argues that Microsoft Manual discloses a first computer queries the WINS server for the address of a second computer, the WINS server determines whether the second computer has been registered, and returns the address of the second computer to the first computer if the second computer has been registered. Pet. 25 (citing Ex. 1003, 69, 70); Pet. 26 (citing Ex. 1003, 72–73, 122); Pet. 26–27 (citing Ex. 1003, 67, 73, 121, 266). Petitioner further argues that a computer is registered as active and on-line with the WINS server until (i) it properly shuts down or (ii) it fails to renew its lease of the IP address. Pet. 25 (citing Ex. 1003, 75). Petitioner also argues that NetBIOS discloses a name query (“discovery” or “resolution”) that is initiated by end-nodes to obtain the IP addresses and other attributes associated with a NetBIOS name. *Id.* at 31 (citing Ex. 1004, 395, 406).

Patent Owner argues that these descriptions from Microsoft Manual and NetBIOS fail to determine whether a computer or process *is connected to the computer network*. PO Resp. 2. In view of the Federal Circuit’s

construction of this claim limitation, we agree with Patent Owner. Microsoft Manual discloses that once a computer is registered with the WINS server (which is a NetBIOS Name Server (NBNS)) as active and on–line, the WINS server maintains a database of names and addresses as active and on–line by (1) releasing names once a computer is shut down properly and (2) requiring a renewal time period in which a computer must reregister. Ex. 1003, 62–63, 68–69. Microsoft Manual discloses that in response to User Datagram Protocol (UDP) name queries, “a mapping in the database does not ensure that the related device is currently running.” *Id.* at 68. Microsoft Manual further explains that a “local WINS database should periodically be cleared of released entries and old entries that were registered at another WINS server but did not get removed from this WINS database for some reason.” *Id.* at 150. In other words, Microsoft Manual discloses that the WINS database may include entries of computers that are not currently connected to the WINS network. Accordingly, a query to as to whether a process “is connected to the computer network” in Microsoft Manual will not determine whether the process *is connected* to the WINS network *at the time that the query is transmitted to the server*.

As discussed in our claim construction analysis above, the query asks “whether a device ‘is’ connected, not whether it was connected or whether it is still registered as being connected even if that registration information is no longer accurate. It is not a reasonable interpretation of the claim language . . . to say that it is satisfied by a query that asks only for registration information, regardless of its current accuracy.” *Straight Path*, 806 F.3d at 1360. Microsoft Manual discloses that the WINS server has

information that a process “was” connected to the computer network, and that information may no longer be accurate. *See* Ex. 1003, 68, 150.

Similarly, NetBIOS discloses a registration process for resources or nodes to receive a unique name by registering a name. Ex. 1004, 379. During a name query (discovery), a datagram is sent requesting the name and address of another resource. *Id.* at 396. The NBNS maintains a database of resource names through explicit name deletion, where the node specifies a deletion function and implicit name deletion, which occurs when a node ceases operation. *Id.* at 379. NetBIOS explains that implicit name deletion “is a frequent occurrence.” *Id.* Implicit name deletion is managed by assigning nodes a specified lifetime for registered names, where a name is silently released if a node fails to refresh the registered name before the lifetime expires. *Id.* NetBIOS further discloses a mechanism where the NBNS may correct the information stored after an incorrect response is provided to a requesting node. *See id.* at 409. However, similar to Microsoft Manual, NetBIOS discloses that the information stored by the NBNS may be incorrect, and, therefore, will not determine whether a process is connected to the computer network at the time that the query is transmitted to the server. *See id.* at 379, 409. Therefore, NetBIOS also does not disclose the claimed “is connected to the computer network.”

Given that the combination of Microsoft Manual and NetBIOS fails to teach or suggest claim 3 as construed, we need not reach the remaining arguments presented by Petitioner and Patent Owner.

III. CONCLUSION

We conclude that Petitioner has not demonstrated a reasonable likelihood that at least one of the challenged claims of the ’365 patent is

unpatentable based on the asserted grounds. Therefore, we do not institute an *inter partes* review on the asserted ground as to any of the challenged claims.

IV. ORDER

For the foregoing reasons, it is

ORDERED that the Petition is *denied*; and

FURTHER ORDERED that no *inter partes* review will be instituted pursuant to 35 U.S.C. § 314(a) with respect to any of the challenged claims of the '365 patent on the ground of unpatentability asserted in the Petition.

For PETITIONER:

David L. Cavanaugh

Jason D. Kipnis

WILMER CUTLER PICKERING HALE AND DORR LLP

david.cavanaugh@wilmerhale.com

jason.kipnis@wilmerhale.com

Dorothy P. Whelan

Christopher O. Green

FISH & RICHARDSON PC

whelan@fr.com

cgreen@fr.com

For PATENT OWNER:

Vandana Koelsch

North Ealing LLC

northealinglaw@gmail.com

William Meunier

StraightPathIPRs@mintz.com