

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIPNET EU S.R.O.,
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.

Case IPR2013-00246
Patent 6,108,704 C1

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

DESHPANDE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
37 U.S.C. § 318(a); 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Sipnet EU S.R.O. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–7 and 32–42 of U.S. Patent No. 6,108,704 C1 (the “’704 patent”). Paper 1 (“Pet.”). Straight Path IP Group (“Patent Owner”) filed a Preliminary Response. Paper 8. Pursuant to 35 U.S.C. § 314, we instituted *inter partes* review on October 11, 2013, as to claims 1–7 and 32–42 of the ’704 patent on the following grounds of unpatentability: claims 1–7, 32, and 38–42 under 35 U.S.C. § 102 as anticipated by NetBIOS;¹ claims 1–7 and 32–42 under 35 U.S.C. § 102 as anticipated by WINS;² and claims 33–37 under 35 U.S.C. § 103 as obvious over NetBIOS and WINS. Paper 11 (“Dec.”).

After institution of trial, Patent Owner filed a Response (Paper 30, “PO Resp.”) and Petitioner filed a Reply (Paper 33, “Pet. Reply”). Oral hearing was held on July 11, 2014, and the hearing transcript was entered in the record as Paper 61 (“Tr.”). We rendered a Final Written Decision and held that Petitioner had demonstrated by a preponderance of the evidence that (1) claims 1–7, 32, and 38–42 are anticipated by NetBIOS; (2) claims 1–7 and 32–42 are anticipated by WINS; and (3) claims 33–37 are obvious over NetBIOS and WINS.

Patent Owner filed a Notice of Appeal (*see* Paper 67) and the United States Court of Appeals for the Federal Circuit issued a decision in *Straight*

¹ THE OPEN GROUP, TECHNICAL STANDARD – PROTOCOLS FOR X/OPEN PC INTERWORKING/SMB, VERSION 2 (1992) (Ex. 1003) (“NetBIOS”).

² WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1004) (“WINS”).

Path IP Group, Inc. v. Sipnet EU S.R.O., 806 F.3d 1356 (Fed. Cir. 2015), reversing our cancellation of claims 1–7 and 32–42 and remanding for further proceedings consistent with the Federal Circuit’s decision. *Straight Path*, 806 F.3d at 1363–64; *see* Paper 68.

The Board has jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–7 and 32–42 of the ’704 patent are unpatentable.

B. Related Proceedings

Petitioner identifies the following related district court proceedings involving the ’704 patent: *Net2Phone, Inc. v. eBay Inc., Skype Inc.*, Civil Action No. 06-2469 (D.N.J.), filed June 1, 2006 (“the Skype Litigation”), and *Innovative Communications Technologies, Inc. v. Stalker Software, Inc.*, Civil Action No. 2:12-cv-00009-RGD-TEM (E.D. Va.), filed Jan. 4, 2012 (“the Stalker litigation”). Pet. 3.

Petitioner also identifies the ’704 patent as the subject of Ex Parte Reexamination proceeding Control No. 90/010,416. Pet. 3. The ’704 patent is also the subject of *inter partes* review in IPR2014-01366 and IPR2015-00209.

C. The ’704 Patent

The ’704 patent is titled “Point-to-Point Internet Protocol” and generally relates to establishing a point-to-point communication link. Ex. 1001, 2:53–57. The ’704 patent explains that a first processing unit automatically transmits its associated e-mail address, and its IP address, to a connection server. Ex. 1001, 5:25–38. 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, 5:55–60. 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, 5:60–64. The first processing unit then directly establishes the point-to-point Internet communication with the callee using the retrieved IP address. Ex. 1001, 5:64–67.

Figure 1 of the '704 patent is reproduced below:

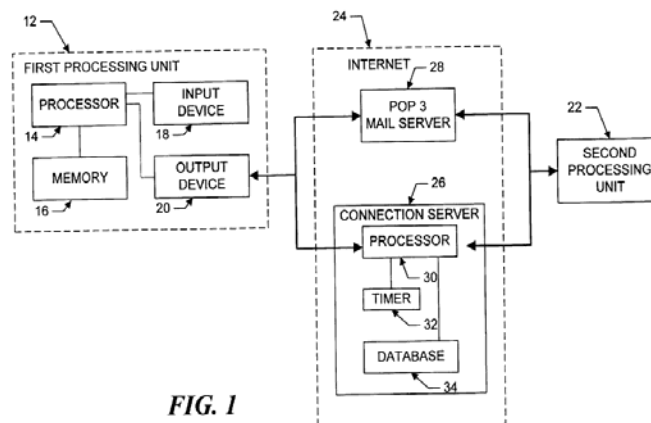


FIG. 1

Figure 1 above illustrates the architecture between first processing unit 12, second processing unit 22, and connection server 26. Ex. 1001, 5:15–29.

D. Illustrative Claim

Petitioner challenges claims 1–7 and 32–42 of the '704 patent. Pet. 5–10, 26–28, 33–58. Claim 1 of the '704 patent is illustrative of the claims at issue and is reproduced below.

1. A computer program product for use with a computer system, the computer system executing a first process and

operatively connectable to a second process and a server over a computer network, the computer program product comprising:

a computer usable medium having program code embodied in the medium, the program code comprising:

program code for transmitting to the server a network protocol address received by the first process following connection to the computer network;

program code for transmitting, to the server, a query as to whether the second process is connected to the computer network;

program code for receiving a network protocol address of the second process from the server, when the second process is connected to the computer network; and

program code, responsive to the network protocol address of the second process, for establishing a point-to-point communication link between the first process and the second process over the computer network.

E. Claim Construction

We construe 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

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