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 No. IPR2013-00246

U.S. Patent No. 6,108,704

PETITIONER'S RESPONSE TO PATENT OWNER'S OBSERVATION ON
CROSS-EXAMINATION OF PETITIONER'S DECLARANT VADIM
ANTONOV

INTRODUCTION

Pursuant to the Board's authorization on June 4, 2014 and the Office Trial Practice Guide, 77 Fed. Reg. 48767-68 (Aug. 14, 2012), Petitioner Sipnet EU S.R.O. respectfully submits the following responses to the observations submitted by the Patent Owner regarding the May 29, 2014 cross-examination of Petitioner's declarant Vadim Antonov.

RESPONSES TO PATENT OWNER'S OBSERVATIONS

A.   Response to Observations 1, 2 and 3

In response to Patent Owner's Observations 1, 2 and 3 and specifically that "Mr. Antonov's Anticipation Opinions Were Based On The Combination of Multiple References", "Mr. Antonov Rendered Anticipation Opinions Based On Multiple Sources That Are Not Of Record In This Proceeding" and "Mr. Antonov Relied on a Product To Form His Opinions," Petitioner respectfully notes that in Exhibit 2045, on Page 21, Lines 8-17; Page 28, Line 21 through Page 29, Line 3; Page 30, Line 13, through Page 31, Line 6; Page 31, Lines 16-24 and Page 32, Line 23 through Page 33, Line 19, Mr. Antonov testified that:

Ex. 2045, Page 21, Lines 8-17

8   Q. Where in your declaration do you

 9   demonstrate that each and every claim element is

10   rendered invalid by a piece of prior art?

11   A. This is described in subsequent sections,

12   and basically every section discusses a specific

13   claim made. And in the patent, in the original

14   '704 patent, or in declaration of expert witness,

15   Mr. Mayer-Patel, if I remember the name correctly,

16   and other of those claims. So the entirety of that

17   document is basically the answer.

Ex. 2045, Page 28, Line 21 through Page 29, Line 3

21   A. Not only that. By "obvious," I mean

22   obvious at that specific time in history, because

23   obvious -- what was obvious -- what is obvious now

24   is not the same as what was obvious 20 years ago.

25   So I made an effort to understand and

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 1   recall the state of the art at the time which is

 2   relevant to discuss obviousness of this specific

 3   patent.

Ex. 2045, Page 30, Line 13 through Page 31, Line 6

13   Q. So to confirm --

14   A. Yes.

15   Q. -- is that you do not provide an opinion

16   with respect to whether or not any of the claims

17   are obvious, is that correct?

18   A. I'm confused by legal usage of that term.

19   What I'm saying is that my declaration, all of it

20   depends on things being already known or

21   implemented by previous published documents or

22   products, and it didn't actually require any new

23   ideas or new things which would be not trivial.

24   For example, I consider substitution of

25   terms calling the same thing by different names to

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1   be trivial. And I find that a significant portion

2   of Mr. Mayer-Patel's declaration essentially

3   depends on making distinctions of -- by using terms

4   which mean exactly same thing. So terms means same

5   thing. He makes distinction saying that they're

6   different things, which I consider to be incorrect.

Ex. 2045, Page 31, Lines 16-24:

16   Q. You do not provide an opinion in your

17 declaration that any of the claims are rendered

18 obvious by the prior art, is that correct?

19   A. The foundation of my argument is that

20 everything is anticipated to the extent that

21 translation between prior existing art to what is

22 in the '704 patent is obvious and trivial. So

23 somebody skilled in this profession would

24 understand that they mean exactly same thing.

Ex. 2045, Page 32, Line 23 through Page 33, Line 19

23   Q. In your summary of opinions --

24   A. Uh-huh (affirmative).

25   Q. -- you only identify an opinion that the

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1 claims at issue are anticipated.

2   A. Yes.

3   MR. MORLOCK: Objection, asked and

4 answered.

5   MR. HOFFMAN:

6   Q. You do not --

7   Excuse me, Counsel.

8   And do you not provide an opinion that the

9   claims at issue are obvious.

10   MR. MORLOCK: Objection, asked and

11 answered.

12   MR. HOFFMAN:

13   Q. You can answer the question.

14   A. Okay. Again, what I claimed, that

15 everything was anticipated, and that terminological

16 difference is that -- the fact that its only

17 terminological difference is, on its own, obvious.

18 So a practitioner in the art would know that those

19 different terms mean the same thing.

The above testimony is relevant to (1) Exhibit 1023, the Antonov

Declaration; and (2) Paper No. 33, the Petitioner's Reply. The above testimony is

relevant because it explains that the Antonov Declaration was provided from the

perspective of a technical expert (not a patent lawyer) who based his conclusions

from the point of view of a person skilled in the art.

B.   Response to Observation 4

In response to Patent Owner's Observation 4 and specifically that "Mr.

Antonov Stated That NetBIOS Does Not Disclose Dynamic Addressing,"

Petitioner respectfully notes that in Exhibit 2045, on Page 134, Line 12 through

Page 135, Line 5, Mr. Antonov testified that:

Ex. 2045, Page 134, Line 12 through Page 135, Line 5

12   Q. But the document itself, the NetBIOS

13   document itself, doesn't specifically disclose the

14   idea of dynamic addresses.

15   A. No, it doesn't. And, again, the fact that

16   it doesn't, it means precisely that it will work

17   with -- is that it is designed to work with any

18   method, that NetBIOS -- operation of NetBIOS is not

19   affected in any way by network of address

20   assignment.

21   Q. Does WINS disclose dynamic addressing?

22   A. I know that with WINS software, as it is

23   implemented, works with dynamic addresses. I am

24   sure -- with dynamically assigned addresses. I do

25   not recall if this is explicitly mentioned in the

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1   document attached as an exhibit. But we need to

2   understand that, as a document, WINS document

3   attached to exhibit is essentially a user manual.

4   It doesn't go into detail about what is exactly

5   inside. The actual software works.

The above testimony is relevant to (1) Exhibit 1023, the Antonov

Declaration; and (2) Paper No. 33, the Petitioner's Reply. The above testimony

regarding NetBIOS is relevant because it clearly demonstrates Mr. Antonov's

candid and unbiased perspective.

C.   Response to Observation 5

In response to Patent Owner's Observation 5 and specifically that "Mr.

Antonov Testified That He Did Not Provide An Obviousness Opinion," Petitioner

respectfully notes that in Exhibit 2045, on Page 32, Lines 8-20, Mr. Antonov

testified that:

Ex. 2045, Page 32, Lines 8-20

8   Q. So your declaration with respect to your

9   opinions in this matter are limited -- let me start

10   again.

11   Your declaration -- your opinions in this

12   declaration are limited to an opinion that the

13   claims at issue are anticipated by the prior art,

14   is that correct?

15   A. Yes, that is correct. But -- yeah, that

16   is substantially correct, plus I wanted to state

17   that the differences between anticipated art and

18   what is described in patent are mostly in -- are

19   terminological and not substantial, and that is

20   obvious.

The above testimony is relevant to (1) Exhibit 1023, the Antonov

Declaration; and (2) Paper No. 33, the Petitioner's Reply. The above testimony is

relevant because it clearly demonstrates that, contrary to Patent Owner's

observation, Mr. Antonov testified that he did consider obviousness in forming his

opinion.

D.   Response to Observation 6

In response to Patent Owner's Observation 6 and specifically that "Mr.

Antonov Testified That A Response To A Query In NetBIOS Indicates Only A

"Willingness" To Accept Communication Rather Than Availability For

Communication," Petitioner respectfully notes that in Exhibit 2045, on Page 63,

Line 2 through Page 64, Line 7, Mr. Antonov testified that:

Ex. 2045, Page 63, Line 2 through Page 64, Line 7

2   Q. Well, what about an idea of it being sort

3 of relatively current?

4   A. Ah, now we're talking. Relatively current

5 means that you want to be able to tell that a party

6 was willing to accept your communication, and

7 here's acknowledge to be within some predefined

8 time period, relatively current.

9   So you want to know, for example, that

10 within the last five minutes it was willing to

11 accept communications. That is the common practice

12 in the field, is to achieve that effect by having

13 either -- the party accepting communication to send

14 you periodic updates, saying I am willing, I am

15 willing, I am willing, and if you don't hear those

16 updates, let's say, that party is no longer

17 willing. Or to periodically ask that party are you

18 still willing, are you still willing, are you still

19 willing.

20   That time period between those periodical

21 updates is essentially your time guarantee of

22   freshness of that data. In '704, there is a

23   mention of timeout in claim 3, and timestamps,

24   which I take to mean using time since previous

25   status update to indicate the current on-line

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1   status.

2   In NetBIOS we have exactly same mechanism,

3   specified in a lot more detail, including which

4   messages to exchange and what format of messages is

5   used, to do essentially the same thing, to

6   periodically check if the other side is still

7   registered or on-line, which is the same.

The above testimony is relevant to (1) Exhibit 1023, the Antonov

Declaration; and (2) Paper No. 33, the Petitioner's Reply. The above testimony is

relevant because it clearly demonstrates that Mr. Antonov testified that NetBIOS

and the '704 Patent disclose the same mechanism to indicate availability for

communication.

E.   Response to Observation 7

In response to Patent Owner's Observation 7 and specifically that "Mr.

Antonov Did Not Render His Own Opinion on Claim Construction," Petitioner

respectfully notes that in Exhibit 2045, on Page 65, Lines 13-23, Mr. Antonov

testified that:

Ex. 2045, Page 65, Lines 13-23

13   Q. Right. And, then, but there has to be a

14 separate -- in C, a separate determination of

15 positive on-line status, correct?

16   A. Again, positive on-line status, you cannot

17 guarantee that the other party is -- will accept

18 your communication for the reasons we already

19 discussed. So positive determination of on-line

20 status, I take that to mean positive determination

21 of willingness -- of declared willingness of the

22 other party to accept the communication, not as a

23 guarantee that it will accept communications.

The above testimony is relevant to (1) Exhibit 1023, the Antonov

Declaration; and (2) Paper No. 33, the Petitioner's Reply. The above testimony

directly contradicts Patent Owner's observation and is relevant because it

demonstrates that Mr. Antonov clearly expressed his opinion on the meaning of the

term "on-line."

B.   Response to Observation 8

In response to Patent Owner's Observation 8 and specifically that "Mr.

Antonov's Testimony Offered a New Characterization of the Patent," Petitioner

respectfully notes that in Exhibit 2045, on Page 47, Line 19 through Page 49, Line

7, Mr. Antonov testified that:

Ex. 2045, Page 47, Line 19 through Page 49, Line 7

19   A. Okay. Let me orient myself to what the

20 first process means here. Ah, the first process

21 here means the name server.

22   Is it correct? Is my understanding

23 correct?

24   Q. Are you saying the first process here,

25 your equivalent -- you're saying the first process

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1   is named by the name server?

2   Is that what you're saying?

3   A. Yeah, what I'm saying is that first

4   process in this claim is the same as network server

5   in technical language of NetBIOS documents,

6   technical. First process is legal language because

7   that doesn't provide specific technical term.

8   Technical documents will refer to specific things

9   by their function. Like name server keeps track of

10 names.

11 So I prefer to use technical language,

12 obviously. So first process is a name server, and

13 second process is general server process which

14 could be used to establish communication to, like,

15 a party which can be called or a party which can be

16 connected to.

17   Q. All right. Let's just make sure I

18 understand your opinions. The first process

19 referred to in claim 2 you're saying is a server,

20 correct?

21   A. Okay. A server is any persistent process

22 which is used to answer questions or to accept

23 connections. And client is -- in technical terms,

24 client is a party which initiates connections or

25 send the questions up to the server.

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1   So in layman terms, if you take phone

2 calls, you're a server. If you initiate them,

3 you're a client. So to eliminate confusion, the

4 first process in this claim means server, and

5 second process means another server which is

6 subject -- which registers itself is the first

7 server.

The above testimony is relevant to (1) Exhibit 1023, the Antonov

Declaration; and (2) Paper No. 33, the Petitioner's Reply. This testimony

contradicts Patent Owner's observation set forth above and shows that Mr.

Antonov's testimony further explained his declaration and the relevant technology

in response to counsel's questions.

B.   Response to Observation 9

In response to Patent Owner's Observation 9 and specifically that "Mr.

Antonov's Testimony Demonstrates a Connection Between Petitioner's Expert and

Stalker Software," Petitioner respectfully notes that in Exhibit 2045, on Page 173,

Line 12 through Page 174, Line 23, Mr. Antonov testified that:

Ex. 2045, Page 173, Line 12, through, Page 174, Line 23

12   Q. How do you know Mr. Butenko?

13   MR. MORLOCK: Objection, outside the scope

14 of direct.

15   THE WITNESS: We studied in the same

16 university on different departments. And I was at

17 Department of Computer Science. He was at

18 Department of Physics. And we met because we were

19 both active in systems programming community. And

20 we kept in contact since then.

21   MR. HOFFMAN:

22   Q. So you're friends with him today?

23   MR. MORLOCK: Objection, outside the scope

24 of direct.

25   THE WITNESS: You could say that we're

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1 friends. I would say acquaintances.

2   MR. HOFFMAN:

3   Q. So are you familiar with Stalker Software?

4   MR. MORLOCK: Objection, outside the scope

5 of direct.

6   THE WITNESS: I know that he founded that

7 company, and I know, roughly, what as a company is

8 doing. I didn't use Stalker Software products. I

9   do not know details of what's in them. And we

10   never discussed our -- talked about current

11   operations of the company, and -- and we never did

12   any business together.

13   MR. HOFFMAN:

14   Q. Have you had any discussions with

15   Mr. Butenko about this matter?

16   MR. MORLOCK: Objection, outside the scope

17   of direct.

18   THE WITNESS: No, we didn't. And I --

19   I've heard that he's involved in some kind of

20   patent litigation. I didn't know what this is

21   about and why it was there. I only learned about

22   involvement of Stalker Software when I was reading

23   the documents related to this case.

The above testimony is relevant to (1) Paper 30, Pages 8-16; and (2) Paper 33, Pages 1-4. This testimony contradicts Patent Owner's observation regarding a "relationship" between Petitioner and Stalker Software and it is relevant to demonstrate that Mr. Antonov's testimony showed nothing more than his mere knowledge of Stalker Software and a friendship with stalker's CEO.

Respectfully Submitted,

Dated: June 20, 2014

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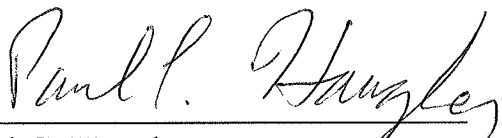Tel.: 650-469-3750
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that this PETITIONER'S RESPONSE TO PATENT OWNER'S OBSERVATION ON CROSS-EXAMINATION OF PETITIONER'S DECLARANT VADIM ANTONOV was served, by agreement of the parties, by electronic mail on counsel for the Patent Owner on June 20, 2014 as follows:

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Case No. IPR2013-00246
U.S. Patent No. 6,108,704

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of

    PETITIONER'S LIST OF ISSUES FOR ORAL ARGUMENT

PURSUANT TO 37 C.F.R. §42.70

    PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO

EXCLUDE UNDER 37 C.F.R. 42.64(c)

    PETITIONER'S RESPONSE TO PATENT OWNER'S OBSERVATION

ON CROSS-EXAMINATION OF PETITIONER'S DECLARANT

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ON CROSS-EXAMINATION OF PETITIONER'S DECLARANT
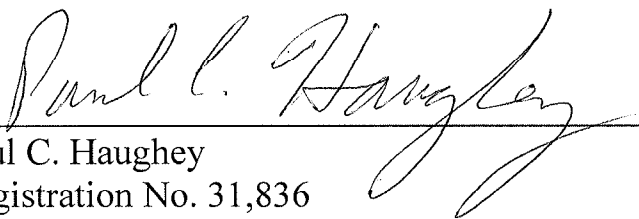
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    PETITIONER'S RESPONSE TO PATENT OWNER'S OBSERVATION

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