UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SIPNET EU S.R.O.
Petitioner
v.

INNOVATIVE COMMUNICATIONS TECHNOLOGIES, INC.
(now STRAIGHT PATH IP GROUP, INC.)
Patent Owner

Patent No. 6,108,704

Filing Date: September 25, 1995

Issue Date: August 22, 2000

Title: POINT-TO-POINT INTERNET PROTOCOL

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Inter Partes Review No. IPR2013-00246, Filing Date April 11, 2013

DECLARATION OF KETAN MAYER-PATEL

I.   INTRODUCTION

1.   I have been retained as an independent expert witness by Straight Path IP Group, Inc. ("Patent Owner") for evaluation of U.S. Patent 6,108,704 (the "'704 Patent") and the asserted references in IPR2013-00246 (the present "*inter partes* review").

2.   I am an expert in the field of networking protocols, including networking protocols supporting multimedia streams.[1]

3.   I received Bachelors of Arts degrees in computer Science and Economics in 1992, a Masters of Science in 1997 from the Department of Electrical Engineering and Computer Science, and a Ph.D. in 1999 from the Department of Electrical Engineering and Computer Science, all from the University of California, Berkeley.

4.   I received the National Science Foundation CAREER Award in 2003 while an Assistant Professor at the University of North Carolina, Chapel Hill.

5.   I have had extensive experience in both industry and academia as it relates to the technical fields relevant here. For example, I have been a programmer, a visiting researcher, and an Assistant and Associate Professor.

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[1] *See* Curriculum Vitae, attached as Exhibit 2019.

6.   I am a co-author of numerous articles that have appeared in a number of referenced publications and proceedings.

7.   Governmental agencies, such as the National Science Foundation and the Office of Naval Research, have provided funding for my research.

II.   RETENTION AND COMPENSATION

8.   I have been retained to offer an expert opinion on (1) "The Open Group, Technical Standard – Protocols for X/Open PC Internetworking/SMB, Version 2" (Exhibit 1003) ("NetBIOS"), and (2) "Windows NT 3.5, TCP/IP User Guide" (Exhibit 1004) ("WINS") in relation to the claims of the '704 Patent and the validity of the claims in the current *inter partes* review.[2]

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[2] I was previously retained by Net2Phone, Inc., a previous assignee of the '704 Patent, to evaluate the patentability of the '704 Patent in Reexamination Control No. 90/010,416. My previous expert declaration, issued on November 27, 2009, stated in part that the challenged claims of the '704 Patent were not anticipated by the NetBIOS reference asserted by Petitioner in this *inter partes* review. I note that the Petition states, "The Patent Examiner agreed that NetBIOS provides the same address determining mechanism as described in the patent, but an expert declaration argued that 'bringing dynamic addressing into a NetBIOS type system would create a new set of obstacles that would need to be solved that are not

9.   My work on this case is being billed at a rate of $480 per hour, with reimbursement for actual expenses. My compensation is not contingent upon the outcome of the case.

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obvious in view of the combination of references.'" I assume Petitioner is referring to my expert declaration, although that quotation does not appear in my previous declaration. Beyond misquoting my declaration, it appears that Petitioner does not understand the technical distinctions that were explained in my declaration, and were confirmed by the Examiner at the conclusion of the Reexamination. My declaration did not "agree" that "NetBIOS provides the same address determining mechanism as described in the patent." My declaration instead explained that the "address determining mechanism" of NetBIOS was not equivalent to the determination of on-line status as required by the '704 Patent. (For example, I stated, "While NetBIOS uses name entries with 'active' statuses as part of its name management process, an analysis of how that 'active' status is used shows that 'an active name' is not synonymous with an 'on-line status with respect to the computer network.'") My position regarding NetBIOS remains unchanged, as explained in detail throughout this Declaration.

III. BASIS OF MY OPINION AND MATERIALS CONSIDERED

10.   In preparation for this report, I have considered and relied on data or other documents identified in this report, including (1) Paper No. 1, "Petition for *Inter Partes* Review" ("Petition"); (2) Paper No. 11, "Decision: Institution of *Inter Partes* Review" ("Decision"); (3) NetBIOS; (4) WINS; and (5) the '704 Patent.

11.   I have familiarized myself with the state of the art at the time the '704 Patent was filed by reviewing both patent and non-patent references from prior to the filing date of the application that became the '704 Patent.

12.   My opinions are also based upon my education, training, research, knowledge, and experience in this technical field.

IV. SUMMARY OF MY OPINIONS

13.   Based on my prior experience in the field of computer systems and networking, including network communication protocols, and based on my review of the documents relating to the pending *inter partes* review, I have developed an understanding of the '704 Patent and the claimed inventions.

14.   I have been asked to compare the instituted claims of the '704 Patent to the NetBIOS and WINS references applied in the pending *inter partes* review. The results of my comparisons are provided below. In general, it is my opinion that all of the claims subject to the current *inter partes* review (i.e., claims 1-7 and 32-42) are patentable over NetBIOS, WINS, and NetBIOS in view of WINS. As is

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