

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
SAMSUNG TELECOMMUNICATIONS AMERICA, LLC,
CISCO SYSTEMS, INC., and AVAYA, INC.,
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.
Patent Owner

Case IPR2014-01366¹
Patent 6,108,704 C1

**PETITIONERS' BRIEF PURSUANT TO PAPER 42 REGARDING
FEDERAL CIRCUIT DECISION IN APPEAL OF IPR2013-00246**

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Patent Trial and Appeal Board
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¹ IPR2015-01011 has been joined with this proceeding.

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Pursuant to Paper 42, Petitioner hereby submits this brief to address the applicability of the Federal Circuit’s decision in *Straight Path IP Group, Inc. v. SipNet EU S.R.O.*, 806 F.3d 1356 (Fed. Cir. 2015) to this IPR.² The Court construed “is connected to the computer network” to mean “is connected to the computer network at the time that the query is transmitted to the server.” Because WINS and NetBIOS teach a system that uses the same mechanisms as those relied on by the Court to formulate its construction, WINS and NetBios obviate the challenged claims of the ’704 patent. Attachment B to Paper 38 at 20-21(amicus brief filed in this IPR by Patent Owner (“PO”)).

I. Federal Circuit’s Construction of “Is Connected To The Network”

The Court’s construction focused on the intent of the query to request the status of the queried process at the time of the request. Slip Op. at 13; *see also id.* at 7 (“The present tense ‘is’ in ‘is connected to the computer network’ plainly says that the query transmitted to the server *seeks to determine* whether the second unit is connected at that time, i.e., at the time the query is sent.”); *id.* (“***The question asked by the query*** is whether the device ‘is’ connected” (emphasis added)); *id.* at 8 (“The query required by the claim language *asks* if the callee ‘is’ online, which is a question about the status at the time of the query.”).

The Court also concluded that the present-tense requirement of the claimed query submitted by a first process was satisfied by steps undertaken *by the server*

² Citations herein use the following format: Petition, Paper 1 (“Pet.”); Patent Owner’s Response, Paper 28 (“POR”); and Reply, Paper 33 (“Reply”).

to provide accurate information in response to the query. *Id.* at 6. Straight Path agrees in this IPR. POR at 44 (“[T]he specification describes that the connection server [performs] at least a two-step protocol, to track (1) when the process connects to the computer; and (2) when the process disconnects from the computer network”).

Specifically, the Court identified two disclosures in the ’704 patent of how a server can accurately respond to the claimed query for the online status of the second process at the time of the query. First, the server “may use the timestamps to update the status of each processing unit; for example, after 2 hours, so that the on-line status information stored in the database 34 is relatively current.” Slip Op. at 3 (quoting ’704 patent 5:39-44). A second “even better means of keeping the database information accurate,” which can “*shrink if not completely eliminate* any gap between recorded status and true status,” is “[w]hen a user logs off or goes off-line from the Internet, the connection server 26 updates the status of the user in the database; for example, by removing the user’s information, or by flagging the user as being off-line.” *Id.* at 11 (quoting ’704 patent 6:6-14).

The Court’s reliance on these two disclosures to support its construction of “is connected to the network” means that a system with a server that practices these disclosures is within the scope of the claim as construed by the Federal Circuit.

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