

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)
Case IPR2014-01367² (Patent 6,009,469 C1)
Case IPR2014-01368³ (Patent 6,131,121 C1)

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

DESHPANDE, *Administrative Patent Judge*.

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

¹ IPR2015-01011 has been joined with this proceeding.

² IPR2015-01007 has been joined with this proceeding.

³ IPR2015-01006 has been joined with this proceeding.

IPR2014-01366 (Patent 6,108,704 C1)
IPR2014-01367 (Patent 6,009,469 C1)
IPR2014-01368 (Patent 6,131,121 C1)

I. INTRODUCTION

A. Background

Samsung Electronics Co., LTD., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, “Samsung”) filed three Petitions requesting *inter partes* review of claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704 C1 (66 Ex. 1001,⁴ “the ’704 patent”), claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of U.S. Patent No. 6,009,469 C1 (67 Ex. 1001, “the ’469 patent”), and claims 6, 8, 10, 11, 13, and 14 of U.S. Patent No. 6,131,121 C1 (68 Ex. 1001, “the ’121 patent”). 66 Paper 1 (“66 Pet.”); 67 Paper 1 (“67 Pet.”); 68 Paper 1 (“68 Pet.”). Straight Path IP Group, Inc. (“Patent Owner”) filed a Preliminary Response. 66 Paper 10 (“66 Prelim. Resp.”); 67 Paper 10 (“67 Prelim. Resp.”); 68 Paper 10 (“68 Prelim. Resp.”). On March 6, 2015, pursuant to 35 U.S.C. § 314, we instituted *inter partes* review of:

⁴ Citations may be preceded by “66” to designate IPR2014-01366, “67” to designate IPR2014-01367, or “68” to designate IPR2014-01368. Unless noted otherwise, all citations are to IPR2014-01366.

IPR2014-01366 (Patent 6,108,704 C1)

IPR2014-01367 (Patent 6,009,469 C1)

IPR2014-01368 (Patent 6,131,121 C1)

Case	Claims Instituted	Basis	References
IPR2014-01366	1, 11, 12, 22, and 23	§ 103(a)	Microsoft Manual ⁵ and NetBIOS ⁶
IPR2014-01366	14, 16, 27, 30, and 31	§ 103(a)	Microsoft Manual, NetBIOS, and Palmer ⁷
IPR2014-01367	1–3, 5, 6, and 9	§ 103(a)	Microsoft Manual and NetBIOS
IPR2014-01367	10, 14, 17 and 18	§ 103(a)	Microsoft Manual, NetBIOS, and Palmer
IPR2014-01368	6, 8, 10, 11, 13, and 14	§ 103(a)	Microsoft Manual and NetBIOS

66 Paper 12 (“66 Dec.”); 67 Paper 12 (“67 Dec.”); 68 Paper 12 (“68 Dec.”).

After institution of *inter partes* review, Cisco Systems, Inc. (“Cisco”) and AVAYA, Inc. (“AVAYA”) filed three Petitions and Motions to Join the IPR2014-01366, IPR2014-01367, and IPR2014-01368 proceedings.

IPR2015-01011, Papers 2, 4; IPR2015-01007, Papers 3, 4; IPR2015-01006, Papers 2, 4. We granted these motions and joined Samsung, Cisco, and AVAYA (collectively, “Petitioner”) to these *inter partes* reviews.

66 Paper 26; 67 Paper 23; 68 Paper 25.

Patent Owner filed a Response in each case (66 Paper 28, “66 PO Resp.”; 67 Paper 24, “67 PO Resp.”; 68 Paper 27, “68 PO Resp.”), and

⁵ Microsoft Windows NT 3.5, TCP/IP User Guide (1994) (Ex. 1012, “Microsoft Manual”).

⁶ The Open Group, Technical Standard, Protocols For X/Open Pc Interworking: SMB, Version 2.0 (1992) (Ex. 1014, “NetBIOS”).

⁷ U.S. Patent No. 5,375,068, issued Dec. 20, 1994 (Ex. 1020, “Palmer”).

IPR2014-01366 (Patent 6,108,704 C1)
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Petitioner filed a Reply (66 Paper 33, “Pet. Reply”; 67 Paper 29, “67 Pet. Reply”; 68 Paper 32, “68 Pet. Reply”). Oral hearing was held on November 19, 2015, and the hearing transcript has been entered in the record. 66 Paper 45; 67 Paper 41; 68 Paper 44 (“Tr.”).⁸ Subsequent to oral hearing, a Federal Circuit decision in *Straight Path IP Group, Inc. v. Sipnet EU S.R.O.*, 806 F.3d 1356 (Fed. Cir. 2015), issued. *See* Ex. 2024. Petitioner filed additional briefing in light of *Straight Path* (66 Paper 44, “66 Add’l Br.”; 67 Paper 40, “67 Add’l Br.”; 68 Paper 43, “68 Add’l Br.”) and Patent Owner filed a response to Petitioner’s additional briefing (66 Paper 46, “PO Add’l Resp.”; 67 Paper 42, “67 PO Add’l Resp.”; 68 Paper 45, “68 PO Add’l Resp.”).

The following table summarizes the papers filed by the parties:

Case No.	IPR2014-01366	IPR2014-01367	IPR2014-01368
Petition	Paper 1 (“66 Pet.”)	Paper 1 (“67 Pet.”)	Paper 1 (“68 Pet.”)
Preliminary Response	Paper 10 (“66 PO Resp.”)	Paper 10 (“67 PO Resp.”)	Paper 10 (“68 PO Resp.”)
Decision to Institute	Paper 12 (“66 Dec.”)	Paper 12 (“67 Pet.”)	Paper 12 (“68 Pet.”)
PO Response	Paper 28 (“66 PO Resp.”)	Paper 24 (“67 PO Resp.”)	Paper 27 (“68 PO Resp.”)
Petitioner’s Reply	Paper 33 (“66 Pet. Reply”)	Paper 29 (“67 Pet. Reply”)	Paper 32 (“68 Pet. Reply”)
Petitioner’s Additional Briefing	Paper 44 (“66 Add’l Br.”)	Paper 40 (“67 Add’l Br.”)	Paper 43 (“68 Add’l Br.”)

⁸ The hearing transcript is the same for all three cases.

IPR2014-01366 (Patent 6,108,704 C1)
IPR2014-01367 (Patent 6,009,469 C1)
IPR2014-01368 (Patent 6,131,121 C1)

Patent Owner's Response to Additional Briefing	Paper 46 ("66 PO Add'l Resp.")	Paper 42 ("67 PO Add'l Resp.")	Paper 45 ("68 PO Add'l Resp.")
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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 are not persuaded that Petitioner has shown by a preponderance of the evidence that claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of the '704 patent, claims 3, 6, 9, 10, 14, 17, and 18 of the '469 patent, and claims 6, 8, 10, 11, 13, and 14 of the '121 patent are unpatentable. For the reasons discussed below, we are persuaded that Petitioner has shown by a preponderance of the evidence that claims 1, 2, and 5 of the '469 patent are unpatentable.

B. Related Proceedings

Petitioner indicates that the '704 patent, the '469 patent, and the '121 patent are the subject of the proceedings in *Straight Path IP Group, Inc. v. Samsung Electronics Co., Ltd.*, No. 6:13-cv-00606 (E.D. Tex.). 66 Pet. 1–2; 67 Pet. 1–2; 68 Pet. 1–2. Petitioner further indicates that the '704 patent was the subject of a final written decision in *Sipnet EU S.R.O. v. Straight Path IP Group, Inc.*, IPR2013-00246 (PTAB), which was reversed and remanded by the United States Court of Appeals for the Federal Circuit. 66 Pet. 1–2; *Straight Path IP Group, Inc. v. Sipnet EU S.R.O.*, 806 F.3d 1356 (Fed. Cir. 2015) ("*Straight Path*") (reversing the determination of unpatentability of certain claims of the '704 patent and remanding for further proceedings consistent with the Federal Circuit's claim construction). The

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