

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

STRAIGHT PATH IP GROUP, INC.,  
Patent Owner.

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Case IPR2014-01366  
Patent 6,108,704

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

DESHPANDE, *Administrative Patent Judge*.

DECISION  
Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

## I. INTRODUCTION

Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704 (Ex. 1001, “the ’704 patent”). Paper 1 (“Pet.”). Straight Path IP Group, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 10 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” After considering the Petition, the Preliminary Response, and associated evidence, we conclude that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing unpatentability of all the challenged claims. Thus, we authorize institution of an *inter partes* review of claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of the ’704 patent.

### A. Related Proceedings

Petitioner indicates that the ’704 patent is the subject of the proceedings in *Straight Path IP Group, Inc. v Samsung Electronics Co., Ltd.*, No. 6:13-cv-00606 (E.D. Tex.). Pet. 1–2. Petitioner further indicates that the ’704 patent was the subject of *Sipnet EU S.R.O. v. Straight Path IP Group, Inc.*, IPR2013-00246 (PTAB) (“*Sipnet*”). *Id.*

Additionally, Petitioner indicates that this Petition is related to IPR2014-01367 and IPR2014-01368. *Id.*

### B. The '704 Patent

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

Figure 1 of the '704 patent is reproduced below:

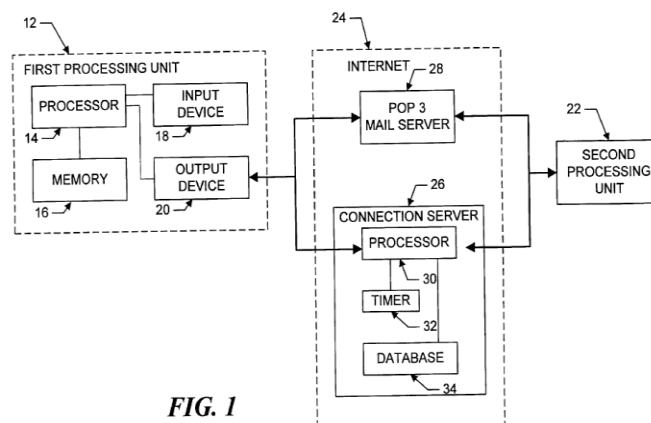


Figure 1 above illustrates the architecture between first processing unit 12, second processing unit 22, and connection server 26. *Id.* at 5:15–29.

*C. Illustrative Claim*

Petitioner challenges claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of the '704 patent. Pet. 20–55. Claim 1 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.

*D. The Alleged Grounds of Unpatentability*

The information presented in the Petition sets forth proposed grounds of unpatentability of claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of the '704 patent as follows (*see* Pet. 20–55):<sup>1</sup>

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<sup>1</sup> Petitioner supports its challenge with four declarations. Ex. 1006 (Declaration of Henry Houh, Ph.D., executed August 22, 2014); Ex. 1006 (Declaration of Robert Cowart, executed August 20, 2014); Ex. 1019

Reference(s)	Basis	Claims Challenged
Microsoft Manual <sup>2</sup>	§ 102(a)	1, 11, 12, 22, and 23
Microsoft Manual and NetBIOS <sup>3</sup>	§ 103(a)	1, 11, 12, 22, and 23
Microsoft Manual, NetBIOS, and Palmer <sup>4</sup>	§ 103(a)	11, 12, 14, 16, 22, 23, 27, 30, and 31
Microsoft Manual, NetBIOS, Palmer, and Pinard <sup>5</sup>	§ 103(a)	11, 12, 14, 16, 22, 23, 27, 30, and 31
Microsoft Manual, NetBIOS, Palmer, Pinard, and Pitkin <sup>6</sup>	§ 103(a)	1, 11, 12, 14, 16, 22, 23, 27, 30, and 31

## II. ANALYSIS

### A. Claim Construction

The Board will interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the

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(Declaration of Sandy Ginoza, executed August 7, 2014); Ex. 1030  
(Declaration of Sandy Ginoza, executed August 19, 2014).

<sup>2</sup> MICROSOFT WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1012, “Microsoft Manual”).

<sup>3</sup> THE OPEN GROUP, TECHNICAL STANDARD, PROTOCOLS FOR X/OPEN PC INTERWORKING: SMB, VERSION 2.0 (1992) (Ex. 1014, “NetBIOS”).

<sup>4</sup> U.S. Patent No. 5,375,068, issued Dec. 20, 1994 (Ex. 1020, “Palmer”).

<sup>5</sup> U.S. Patent No. 5,533,110, issued July 2, 1996 (Ex. 1021, “Pinard”).

<sup>6</sup> U.S. Patent No. 5,341,477, issued Aug. 23, 1994 (Ex. 1015, “Pitkin”).

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