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. Petitioner,

V.
STRAIGHT PATH IP GROUP, INC.
Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. 6,108,704 Case IPR No.: <u>Unassigned</u>

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 6,108,704 UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. §§ 42.1-80, 42.100 et seq.

Mail Stop "PATENT BOARD" Patent Trial & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450



Table of Contents

			Page		
I.	INT	RODUCTION	1		
II.	COMPLIANCE WITH FORMAL REQUIREMENTS				
	A.	Mandatory Notices Under 37 C.F.R. § 42.8(b)	1		
		1. Real Parties-in-Interest	1		
		2. Related Matters	1		
		3. Lead and Back-up Counsel	3		
		4. Power of Attorney and Service Information	4		
	B.	Proof of Service	4		
	C.	Grounds for Standing	4		
III.		ENTIFICATION OF CHALLENGES UNDER 37. C.F.R. § 104(B)	4		
IV.	OVI	OVERVIEW OF THE PRIOR ART			
	A.	Microsoft Windows NT Server version 3.5 TCPIP.HLP ("Microsoft Manual") (Exhibit 1012)	5		
	B.	Technical Standard: Protocols for X/Open PC Interworking: SMB, Version 2 ("NetBIOS") (Exhibit 1014)	6		
	C.	U.S. Pat. No. 5,375,068 ("Palmer") (Ex. 1020)	8		
	D.	U.S. Pat. No. 5,533,110 ("Pinard") (Ex. 1021)	8		
	E.	U.S. Patent No. 5,341,477 ("Pitkin") (Exhibit 1015)	10		
V.	LEV	VEL OF ORDINARY SKILL IN THE ART	11		
VI.	SUMMARY OF THE '704 PATENT11				
	A.	Point-to-Point Communications	16		
	B.	Look-Up Tables	17		
	C.	Prior Proceedings	18		
		1. Prosecution of the '704 Patent	18		
		2. The Sipnet Inter Partes Review	20		
1/11	CI A	AIM CONSTRUCTION	20		



Table of Contents (continued)

			Page
	A.	"point-to-point communication link" (claims 1, 11-12, 14, 16, 22-23, 27, 30-31	21
	B.	"network protocol address" (claims 1, 11, and 22)	22
	C.	"connected to the computer network" (claim 1) / "on-line status" (claims 11 and 22)	24
	D.	"transmitting to the server a network protocol address received by the first process following connection to the computer network" (claim 1)	30
VIII.	WILI	RE IS A REASONABLE LIKELIHOOD THAT PETITIONER L PREVAIL WITH RESPECT TO AT LEAST ONE CLAIM OF 121 PATENT	32
IX.	UNPA	AILED EXPLANATION OF GROUNDS FOR ATENTABILITY OF CLAIMS 1, 11-12, 16, 22-23, 27, AND	32
	A.	Ground 1: The Microsoft Manual in view of NetBIOS renders obvious claims 1, 11-12, and 22-23 under § 103	32
	В.	Ground 2: The Microsoft Manual in view of NetBIOS and Palmer renders claims 11-12, 14, 16, 22-23, 27, and 30-31 obvious under § 103	41
	C.	Ground 3: The Microsoft Manual in view of NetBIOS, Palmer, and Pinard renders claims 11-12, 14, 16, 22-23, 27, and 30-31 obvious under § 103	49
	D.	Ground 4: The Microsoft Manual in view of NetBIOS, Palmer, Pinard, and Pitkin renders 1, 11-12, 16, 22-23, 27, 30, and 31 obvious under § 103	53
X.	CON	CLUSION	55



TABLE OF AUTHORITIES

	Page
CASES	
Ex parte Papst-Motoren 1 USPQ2d 1655 (Bd. Pat. App. & Inter. 1986)	21
KSR Int'l Co. v Teleflex Inc. 550 U.S. 398 (2007)	33, 53
STATUTES	
35 U.S.C. § 42.22	32
35 U.S.C. § 102	5, 10
35 U.S.C. § 103p	assim
35 U.S.C. § 112	27
35 U.S.C. § 311	4, 55
35 U.S.C. §§ 311-19	1
OTHER AUTHORITIES	
37 C.F.R. § 42.1	1
37 C.F.R. § 42.6(e)	4
37 C.F.R. § 42.8(b)	1
37 C.F.R. § 42.100(b)	20
37 C.F.R. § 42.101	55
37 C.F.R. § 42.104(a)	4
37. C.F.R. § 42.104(b)	4
M.P.E.P. § 2143	53



TABLE OF EXHIBITS

EXHIBIT	DESCRIPTION
1001	U.S. Patent No. 6,108,704
1002	File History for U.S. Patent No. 6,108,704
1003	File History for Reexamination Control No. 90/010416
1004	Declaration of Henry Houh, Ph.D.
1005	Intentionally Omitted
1006	Declaration of Robert Cowart
1007	Petition for <i>Inter Partes</i> Review of U.S. Patent No. 6,108,704 by Sipnet EU S.R.O. (filed Apr. 11, 2013)
1008	Institution Decision in Sipnet EU S.R.O. v. Straight Path IP Group, Inc., IPR No. 2013-00246 (filed Oct. 11, 2013)
1009	Markman Order, <i>Innovative Communications Technologies, Inc. v. Stalker Software, Inc.</i> , 2:12-cv-00009-RGD-TEM, ECF No. 48 (E.D. Va. Oct. 26, 2012)
1010	Markman Order, <i>Straight Path IP Group, Inc. v. Bandwidth.com, Inc.</i> , et al., 1:13-cv-00932-AJT-IDD, Docket No. 107 (E.D. Va. Feb. 25, 2014)
1011	Deposition Transcript of Shane Mattaway from Net2Phone v. eBay et al. (2-06-cv-02469 (D.N.J.))
1012	Microsoft Windows NT version 3.5 TCPIP.HLP
1013	Droms, R., Dynamic Host Configuration Protocol, RFC 1541 (Oct. 1993)
1014	Technical Standard: Protocols for X/Open PC Interworking: SMB, Version 2
1015	U.S. Patent No. 5,341,477 ("Pitkin")
1016	Comer, D.E., "Internetworking with TCP/IP, Vol. 1, Principles, Protocol, and Architecture, Second Edition," (New Jersey: Prentice Hall, 1991)
1017	Postel, J., Ed., Transmission Control Protocol, DARPA Internet Program Protocol Specification, RFC 793 (September 1981)
1018	Postel, J., Ed., Internet Protocol, DARPA Internet Program Protocol Specification, RFC 791 (September 1981)



WEST\248731952.11

DOCKET

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

