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Paper 62
Entered: October 9, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIPNET EU S.R.O.
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.
Patent Owner.

Case IPR2013-00246
Patent 6,108,704

Before KALYAN K. DESHPANDE, THOMAS L. GIANNETTI, and TRENTON A. WARD, *Administrative Patent Judges.*

DESHPANDE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION

37 U.S.C. § 318(a); 37 C.F.R. § 42.73

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I. INTRODUCTION

A. Background

Sipnet EU S.R.O. ("Petitioner") filed a Petition to institute an *inter partes* review of claims 1-7 and 32-42 of U.S. Patent No. 6,108,704 (the "'704 patent"). Paper 1 ("Pet."). Straight Path IP Group ("Patent Owner") (formerly known as Innovative Communications Technologies, Inc.) filed a preliminary response. Paper 8 ("Prelim. Resp."). Pursuant to 35 U.S.C. § 314, we instituted *inter partes* review on October 11, 2013, as to claims 1-7 and 32-42 of the '704 patent on the following grounds of unpatentability: claims 1–7, 32, and 38–42 under 35 U.S.C. § 102 as anticipated by NetBIOS;[1] claims 1–7 and 32–42 under 35 U.S.C. § 102 as anticipated by WINS;[2] and claims 33–37 under 35 U.S.C. § 103 as obvious over NetBIOS and WINS. Paper 11 ("Dec.").

After institution of trial, Patent Owner filed a Response (Paper 30, "PO Resp.") and Petitioner filed a Reply (Paper 33, "Pet. Reply"). Oral hearing was held on July 11, 2014, and the hearing transcript has been entered in the record as Paper 61 ("Tr.").

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 determine that Petitioner has shown by a preponderance of the evidence that claims 1-7 and 32-42 of the '704 patent are unpatentable.

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[1] THE OPEN GROUP, TECHNICAL STANDARD – PROTOCOLS FOR X/OPEN PC INTERWORKING/SMB, VERSION 2 (1992) (Ex. 1003) ("NetBIOS").

[2] WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1004) ("WINS").

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B. Related Proceedings

Petitioner identifies the following related district court proceedings involving the ’704 patent: *Net2Phone, Inc. v. eBay Inc., Skype Inc.,* Civil Action No. 06-2469 (D.N.J.), filed June 1, 2006 (“the Skype Litigation”), and *Innovative Communications Technologies, Inc. v. Stalker Software, Inc.,* Civil Action No. 2:12-cv-00009-RGD-TEM (E.D. Va.), filed Jan. 4, 2012 (“the Stalker litigation”). Pet. 3.

Petitioner also identifies the ’704 patent as the subject of Ex Parte Reexamination proceeding No. 90/010,416. Pet. 3.

C. 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, col. 2, ll. 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 col. 5, ll. 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 col. 5, ll. 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 col. 5, ll. 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 col. 5, ll. 64–67.

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Figure 1 of the '704 patent is reproduced below:

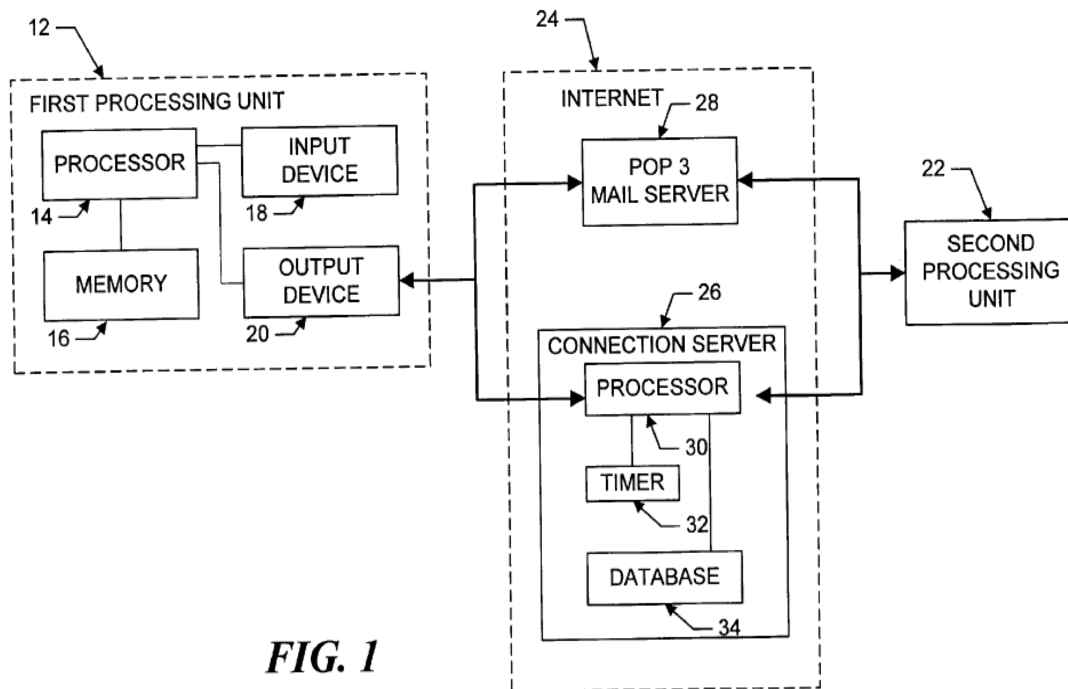

FIG. 1

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

Claim 1 illustrates the claimed subject matter 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;

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> 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. 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* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012); 37 C.F.R. § 42.100(b). 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 art in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. "connected to the computer network"

Petitioner, under the broadest reasonable construction, contends that "connected to the computer network" encompasses merely "being on-line." Pet. 5–6. Petitioner further contends that "connected to the computer network" simply requires being registered with the server, based on the usage of this phrase in the '704 patent specification. *Id.* at 13; *see* Ex. 1001 col. 5, ll. 31–38.

Patent Owner agrees that "connected to the computer network" encompasses "being on-line," but argues that registering an address does not satisfy the requirement of "being on-line." PO Resp. 26. Patent Owner specifically argues that, although "a process may be on-line at the time of registration, it may subsequently go off-line." *Id.* Patent Owner's expert, Dr. Ketan Mayer-Patel,

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