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 IPR2014-01366[1]
U.S. Patent No. 6,009,704

PATENT OWNER'S SUBMISSION OF ADDITIONAL BRIEFING FROM *STRAIGHT PATH IP GROUP, INC. V. SIPNET EU S.R.O.,* No. 15-1212 (FED. CIR.)

[1] IPR2015-01011 has been joined with this proceeding.

Pursuant to the Board's March 27, 2015 Conduct of the Proceeding Order (the "Order") in the above captioned case, Patent Owner Straight Path IP Group, Inc. ("Straight Path") hereby submits the following briefing and order (Attachments A – C) filed in *Straight Path IP Group, Inc. v. Sipnet EU S.R.O.*, No. 15-1212 (Fed. Cir.) ("the appeal"), which was Straight Path's appeal of the Final Written Decision in related case, *Sipnet EU S.R.O. v. Straight Path IP Group, Inc.*, IPR2013-00246:

1. Motion of Appellee Sipnet EU S.R.O. to take judicial notice (September 8, 2015) [Attachment A];
2. Motion of Appellant Straight Path IP Group, Inc. to take judicial notice (September 8, 2015) [Attachment B]; and
3. Order granting motions to take judicial notice filed by Appellant Straight Path IP Group, Inc. and Appellee Sipnet EU S.R.O. (November 25, 2015) [Attachment C].

Respectfully submitted,

Dated: December 17, 2015

/William Meunier/

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CERTIFICATE OF SERVICE

I certify that a copy of Patent Owner's Submission of *Amicus* Briefing from *Straight Path IP Group, Inc. v. Sipnet EU S.R.O.*, No. 15-1212 (Fed. Cir.) is being served by electronic mail on the following counsel for the Petitioners:

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ATTACHMENT A

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September 5, 2015

Daniel E. O'Toole
Circuit Executive & Clerk of Court
United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, D.C. 20439

RE: STRAIGHT PATH IP GROUP, INC., Appellant, v. SIPNET EU S.R.O., Appellee
Appeal No. 2015-1212

Dear Mr. O'Toole:

I am lead counsel for Appellee Sipnet EU S.R.O. ("Sipnet") in the above-referenced case, for which oral argument is scheduled for September 9, 2015.

On August 11, 2015, the Court granted a motion by Samsung Electronics America Inc, Samsung Electronics Co., Ltd. and Samsung Telecommunications America, LLC ("Samsung") for leave to file an *amicus curiae* brief in this case. Samsung's *amicus curiae* brief was filed on August 17, 2015.

Samsung's brief cites to three portions of the publicly available file history of the patent at issue in this appeal that are not in the Joint Appendix submitted by the parties. Those three portions are:

- the original claims of U.S. Application No. 08/533,115 *(cited at p.9 of the Samsung brief)*;
- the Amendment dated March 4, 1999 in the prosecution of U.S. Application No. 08/533,115 *(cited at p. 9 of the Samsung brief)*; and
- the Response to Final Rejection Dated July 12, 2010 in Reexamination No. 90/010,416 *(cited at p. 25 of the Samsung brief)*.

Samsung in a reply brief dated August 15, 2015 has requested consideration of the above-noted materials. However, in an abundance of caution to avoid any question as to the availability of such materials to the Court's consideration of this case, and in the interests of the convenience of the Court and the parties, appellee Sipnet requests that the court take judicial notice of the above-referenced prosecution history excerpts. The requested judicial notice is proper because the content of the file history is obtainable from a verifiable source (USPTO) and, therefore, is not in dispute. Thus, the judicial notice may be taken under F.R.E. 201(b)(2).

A copy of the above-noted excerpts is attached herewith.

Please feel free to let me know if you have any questions.

Respectfully submitted,

/s/ Sanjay Prasad
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POINT-TO-POINT INTERNET PROTOCOL

BACKGROUND OF THE INVENTION

1. Field of the Invention

This disclosure relates to network communication protocols, and in particular to a point-to-point protocol for use with the Internet.

2. Description of the Related Art

The increased popularity of on-line services such as AMERICA ONLINE™, COMPUSERVE®, and other services such as Internet gateways have spurred applications to provide multimedia, including video and voice clips, to online users. An example of an online voice clip application is VOICE E-MAIL FOR WINCIM and VOICE E-MAIL FOR AMERICA ONLINE™, available from Bonzi Software, as described in "Simple Utilities Send Voice E-Mail Online", MULTIMEDIA WORLD, VOL. 2, NO. 9, August 1995, p. 52. Using such Voice E-Mail software, a user may create an audio message to be sent to a predetermined E-mail address specified by the user.

B

Generally, devices interfacing to the Internet and other online services may communicate with each other upon establishing respective device addresses. One type of device address is the Internet Protocol (IP) address, which acts as a pointer to the device associated with the IP

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address. A typical device may have a Serial Line Internet Protocol or Point-to-Point Protocol (SLIP/PPP) account with a permanent IP address for receiving e-mail, voicemail, and the like over the Internet. E-mail and voicemail is generally intended to convey text, audio, etc., with any routing information such as an IP address and routing headers generally being considered an artifact of the communication, or even gibberish to the recipient.

Devices such as a host computer or server of a company may include multiple modems for connection of users to the Internet, with a temporary IP address allocated to each user. For example, the host computer may have a general IP address "XXX.XXX.XXX.~~XXX~~", and each user may be allocated a successive IP address of ~~XXX.XXX.XXX.XXX.10~~ XXX.XXX.XXX.10, ~~XXX.XXX.XXX.XXX.11~~ XXX.XXX.XXX.11, ~~XXX.XXX.XXX.XXX.12~~ XXX.XXX.XXX.12, etc. Such temporary IP addresses may be reassigned or recycled to the users, for example, as each user is successively connected to an outside party. For example, a host computer of a company may support a maximum of 254 IP addresses which are pooled and shared between devices connected to the host computer.

Permanent IP addresses of users and devices accessing the Internet readily support point-to-point communications of voice and video signals over the Internet. For example, realtime video teleconferencing has been implemented using dedicated IP addresses and mechanisms

known as reflectors. Due to the dynamic nature of temporary IP addresses of some devices accessing the Internet, point-to-point communications in realtime of voice and video have been generally difficult to attain.

SUMMARY OF THE INVENTION

A point-to-point Internet protocol is disclosed which exchanges Internet Protocol (IP) addresses between processing units to establish a point-to-point communication link between the processing units through the Internet.

A first point-to-point Internet protocol is disclosed which includes the steps of:

(a) storing in a database a respective IP address of a set of processing units that have an on-line status with respect to the Internet;

(b) transmitting a query from a first processing unit to a connection server to determine the on-line status of a second processing unit; and

(c) retrieving the IP address of the second unit from the database using the connection server, in response to the determination of a positive on-line status of the second processing unit, for establishing a point-to-point communication link between the first and second processing units through the Internet.

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A second point-to-point Internet protocol is disclosed, which includes the steps of:

(a) transmitting an E-mail signal, including a first IP address, from a first processing unit;

(b) processing the E-mail signal through the Internet to deliver the E-mail signal to a second processing unit; and

(c) transmitting a second IP address to the first processing unit for establishing a point-to-point communication link between the first and second processing units through the Internet.

BRIEF DESCRIPTION OF THE DRAWINGS

The features of the disclosed point-to-point Internet protocol and system will become more readily apparent and may be better understood by referring to the following detailed description of an illustrative embodiment of the present invention, taken in conjunction with the accompanying drawings, where:

FIG. 1 illustrates, in block diagram format, a system for the disclosed point-to-point Internet protocol;

FIG. 2 illustrates, in block diagram format, the system using a secondary point-to-point Internet protocol;

FIG. 3 illustrates, in block diagram format, the system of FIGS. 1-2 with the point-to-point Internet protocol established;

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FIG. 4 is another block diagram of the system of FIGS. 1-2 with audio communications being conducted;

FIG. 5 illustrates a display screen for a processing unit;

FIG. 6 illustrates another display screen for a processing unit;

FIG. 7 illustrates a flowchart of the initiation of the point-to-point Internet protocols;

FIG. 8 illustrates a flowchart of the performance of the primary point-to-point Internet protocols; and

FIG. 9 illustrates a flowchart of the performance of the secondary point-to-point Internet protocol.

DESCRIPTION OF THE PREFERRED EMBODIMENTS

Referring now in specific detail to the drawings, with like reference numerals identifying similar or identical elements, as shown in FIG. 1, the present disclosure describes a point-to-point Internet protocol and system 10 for using such a protocol.

In an exemplary embodiment, the system 10 includes a first processing unit 12 for sending at least a voice signal from a first user to a second user. The first processing unit 12 includes a processor 14, a memory 16, an input device 18, and an output device 20. The output device 20 includes at least one modem capable of, for example, 14.4 kbaud communications and operatively connected via wired

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and/or wireless communication connections to the Internet. One skilled in the art would understand that the input device 18 may be implemented at least in part by the modem of the output device 20 to allow input signals from the communication connections to be received. The second processing unit 22 may have a processor, memory, and input and output devices, including at least one modem and associated communication connections, as described above for the first processing unit 12. In an exemplary embodiment, each of the processing units 12, 22 may be a WEBPHONE™ unit, available from ~~INTERNET TELEPHONE COMPANY~~, capable of operating the disclosed point-to-point Internet protocol and system 10, as described herein.

The first processing unit 12 and the second processing unit 22 are operatively connected to the Internet 24 by communication devices and software known in the art. The processing units 12, 22 ~~are~~ may be operatively interconnected through the Internet 24 ~~by~~ to a connection server 26, and may also be operatively connected to a mail server 28 associated with the Internet 24.

The connection server 26 includes a processor 30, a timer 32 for generating timestamps, and a memory such as a database 34 for storing, for example, E-mail and Internet Protocol (IP) addresses of logged-in units. In an exemplary

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embodiment, the connection server 26 may be a SPARC 5 server or a SPARC 20 server, available from SUN MICROSYSTEMS, INC., Mountain View, CA, having a central processing unit (CPU) as processor 30 operating an operating system (OS) such as UNIX and providing timing operations such as maintaining the timer 32, a hard drive or fixed drive as well as dynamic ~~read-only~~ random access memory (DRAM) for storing the database 34, and a keyboard and display and/or other input and output devices (not shown in FIG. 1). The database 34 may be an SQL database available from ORACLE or INFOMIX.

In an exemplary embodiment, the mail server 28 may be a Post Office Protocol (POP) Version 3 mail server including a processor, memory, and stored programs operating in a UNIX environment, or alternatively ~~other~~ another OS, to process E-mail capabilities between processing units and devices over the Internet 24.

The first processing unit 12 may operate the disclosed point-to-point Internet protocol by a computer program described hereinbelow in conjunction with FIG. 6, which ~~are~~ may be implemented from compiled and/or interpreted source code in the C++ programming language and which may be downloaded to the first processing unit 12 from an external computer. The operating computer program may be stored in the memory 16, which may include about 8 MB RAM and/or a hard or fixed drive having about 8 MB. Alternatively, the

source code may be implemented in the first processing unit 12 as firmware, as an erasable read only memory (EPROM), etc. It is understood that one skilled in the art would be able to use programming languages other than C++ to implement the disclosed point-to-point Internet protocol and system 10.

The processor 14 receives input commands and data from a first user associated with the first processing unit 12 through the input device 18, which may be an input port connected by a wired, optical, or a wireless connection for electromagnetic transmissions, or alternatively may be transferable storage media, such as floppy disks, magnetic tapes, compact disks, or other storage media including the input data from the first user.

The input device 18 may include a user interface (not shown) having, for example, at least one button actuated by the user to input commands to select from a plurality of operating modes to operate the first processing unit 12. In alternative embodiments, the input device 18 may include a keyboard, a mouse, a touch screen, and/or a data reading device such as a disk drive for receiving the input data from input data files stored in storage media such as a floppy disk or, for example, an 8 mm storage tape. The input device 18 may alternatively include connections to

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other computer systems to receive the input commands and data therefrom.

The first processing unit 12 may include a visual interface as the output device 20 for use in conjunction with the input device 18 and embodied as one of the screens illustrated by the examples shown in FIGS. 5-6 and discussed below. It is also understood that alternative input devices may be used in conjunction with alternative output devices to receive commands and data from the user, such as keyboards, mouse devices, and graphical user interfaces (GUI) such as WINDOWS™ 3.1 available from MICROSOFT™ Corporation, Redmond, WA, executed by the processor 14 using, for example, DOS 5.0. One skilled in the art would understand that other operating systems and GUIs, such as OS/2 and OS/2 WARP, available from IBM CORPORATION, Boca Raton, FL, may be used. Other alternative input devices may include microphones and/or telephone handsets for receiving audio voice data and commands, with the first processing unit 12 including speech or voice recognition devices, dual tone multi-frequency (DTMF) based devices, and/or software known in the art to accept voice data and commands and to operate the first processing unit 12.

In addition, either of the first processing unit 12 and the second processing unit 22 may be implemented in a

personal digital assistant (PDA) providing modem and E-mail capabilities and Internet access, with the PDA providing the input/output screens for mouse interaction or for touchscreen activation as shown, for example, in FIGS. 4-5, as a combination of the input device 18 and output device 20.

For clarity of explanation, the illustrative embodiment of the disclosed point-to-point Internet protocol and system 10 is presented as having individual functional blocks, which may include functional blocks labelled as "processor" and "processing unit". The functions represented by these blocks may be provided through the use of either shared or dedicated hardware, including, but not limited to, hardware capable of executing software. For example, the functions of each of the processors and processing units presented herein may be provided by a shared processor or by a plurality of individual processors. Moreover, the use of the functional blocks with accompanying labels herein is not to be construed to refer exclusively to hardware capable of executing software. Illustrative embodiments may include digital signal processor (DSP) hardware, such as the AT&T DSP16 or DSP32C, read-only memory (ROM) for storing software performing the operations discussed below, and random access memory (RAM) for storing DSP results. Very large scale integration (VLSI) hardware

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embodiments, as well as custom VLSI circuitry in combination with a general purpose DSP circuit, may also be provided. Any and all of these embodiments may be deemed to fall within the meaning of the labels for the functional blocks as used herein.

The processing units 12, 22 are capable of placing calls and connecting to other processing units connected to the Internet 24, for example, via dialup SLIP/PPP lines. In an exemplary embodiment, each processing unit assigns an unsigned long session number, for example, a 32-bit ~~2^{32}~~ bit long sequence in a *.ini file for each call. Each call may be assigned a successive session number in sequence, which may be used by the respective processing unit to associate the call with one of the SLIP/PPP lines, to associate a <ConnectOK> response signal with a <ConnectRequest> signal, and to allow for multiplexing and demultiplexing of inbound and outbound conversations on conference lines.

For callee (or called) processing units with fixed IP addresses, the caller (or calling) processing unit may open a "socket", i.e. a file handle or address indicating where data is to be sent, and transmit a <Call> command to establish communication with the callee utilizing, for example, datagram services such as Internet Standard network layering as well as transport layering, which may include a

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Transport Control Protocol (TCP) or a User Datagram Protocol (UDP) on top of the IP. Typically, a processing unit having a fixed IP address may maintain at least one open socket and a called processing unit waits for a <Call> command to assign the open socket to the incoming signal. If all lines are in use, the callee processing unit sends a BUSY signal or message to the caller processing unit.

As shown in FIG. 1, the disclosed point-to-point Internet protocol and system 10 operate when a callee processing unit does not have a fixed or predetermined IP address. In the exemplary embodiment and without loss of generality, the first processing unit 12 is the caller processing unit and the second processing unit 22 is the called processing unit.

When either of processing units 12, 22 logs on to the Internet via a dial-up connection, the respective unit is provided a dynamically allocated IP address by ~~the~~ a source provider connection ~~server 26~~.

Upon the first user initiating the point-to-point Internet protocol when the first user is logged on to the Internet 24, the first processing unit 12 automatically transmits its associated E-mail address and its dynamically allocated IP address to the connection server 26. The connection server 26 then stores these addresses in the database 34 and timestamps the stored addresses using timer

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32. The first user operating the first processing unit 12 is thus established in the database 34 as an active on-line party available for communication using the disclosed point-to-point Internet protocol. Similarly, a second user operating the second processing unit 22, upon connection to the Internet 24 through ~~the~~ a connection service provider ~~server 26~~, is processed by the connection server 26 to be established in the database 34 as an active on-line party.

The connection server 26 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. Other predetermined time periods, such as a default value of 24 hours, may be configured by a systems operator.

The first user with the first processing unit 12 initiates a call using, for example, a Send command and/or a command to speeddial an N^{TH} stored number, which may be labelled [SND] and [SPD][N], respectively, by the input device 18 and/or the output device 20, such as shown in FIGS. 5-6. In response to either the Send or speeddial commands, the first processing unit 12 retrieves from memory 16 a stored E-mail address of the callee corresponding to the N^{TH} stored number. Alternatively, the first user may directly enter the E-mail address of the callee.

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The first processing unit 12 then sends a query, including the E-mail address of the callee, to the connection server 26. The connection server 26 then searches the database 34 to determine whether the callee is logged-in by finding any stored information corresponding to the callee's E-mail address indicating that the callee is active and on-line. If the callee is active and on-line, the connection server 26 then performs the primary point-to-point Internet protocol; i.e. the IP address of the callee is retrieved from the database 34 and sent to the first processing unit 12. The first processing unit 12 may then directly establish the point-to-point Internet communications with the callee using the IP address of the callee.

If the callee is not on-line when the connection server 26 determines the callee's status, the connection server 26 sends an OFF-LINE signal or message to the first processing unit 12. The first processing unit 12 may also display a message such as "Called Party Off-Line" to the first user.

When a user logs off or goes off-line from the Internet 24, the connection server 26 updates the status of the user in the database 34; for example, by removing the user's information, or by flagging the user as being off-line. The connection server 26 may be instructed to update

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the user's information in the database 34 by an off-line message, such as a data packet, sent automatically from the processing unit of the user prior to being disconnected from the connection server 26. Accordingly, an off-line user is effectively disabled from making and/or receiving point-to-point Internet communications.

As shown in FIGS. 2-4, the disclosed secondary point-to-point Internet protocol may be used as an alternative to the primary point-to-point Internet protocol described above, for example, if the connection server 26 is non-responsive, inoperative, and/or unable to perform the primary point-to-point Internet protocol, as a non-responsive condition. Alternatively, the disclosed secondary point-to-point Internet protocol may be used independent of the primary point-to-point Internet protocol. In the disclosed secondary point-to-point Internet protocol, the first processing unit 12 sends a <ConnectRequest> message via E-mail over the Internet 24 to the mail server 28. The E-mail including the <ConnectRequest> message may have, for example, the subject

[*wp#XXXXXXXX#nnn.nnn.nnn.nnn#emailAddr]

where nnn.nnn.nnn.nnn is the current (i.e. temporary or permanent) IP address of the first user, and XXXXXXXX is a session number, which may be unique and associated with the

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request of the first user to initiate point-to-point communication with the second user.

As described above, the first processing unit 12 may send the <ConnectRequest> message in response to an unsuccessful attempt to perform the primary point-to-point Internet protocol. Alternatively, the first processing unit 12 may send the <ConnectRequest> message in response to the first user initiating a SEND command or the like.

After the <ConnectRequest> message via E-mail is sent, the first processing unit 12 opens a socket and waits to detect a response from the second processing unit 22. A timeout timer, such as timer 32, may be set by the first processing unit 12, in a manner known in the art, to wait for a predetermined duration to receive a <ConnectOK> signal. The processor 14 of the first processing unit 12 may cause the output device 20 to output a Ring signal to the user, such as an audible ringing sound, about every 3 seconds. For example, the processor 14 may output a *.wav file, which may be labelled RING.WAV, which is processed by the output device 20 to output an audible ringing sound.

The mail server 28 then polls the second processing unit 22, for example, every 3-5 seconds, to deliver the E-mail. Generally, the second processing unit 22 checks the incoming lines, for example, at regular

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intervals to wait for and to detect incoming E-mail from the mail server 28 through the Internet 24.

Typically, for sending E-mail to users having associated processing units operatively connected to a host computer or server operating an Internet gateway, E-Mail for a specific user may be sent over the Internet 24 and directed to the permanent IP address or the SLIP/PPP account designation of the host computer, which then assigns a temporary IP address to the processing unit of the specified user for properly routing the E-mail. The E-mail signal may include a name or other designation such as a username which identifies the specific user regardless of the processing unit assigned to the user; that is, the host computer may track and store the specific device where a specific user is assigned or logged on, independent of the IP address system, and so the host computer may switch the E-mail signal to the device of the specific user. At that time, a temporary IP address may be generated or assigned to the specific user and device.

Upon detecting and/or receiving the incoming E-mail signal from the first processing unit 12, the second processing unit 22 may assign or may be assigned a temporary IP address. Therefore, the delivery of the E-mail through the Internet 24 provides the second processing unit 22 with

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a session number as well as IP addresses of both the first processing unit 12 and the second processing unit 22.

Point-to-point communication may then be established by the processing units 12, 22. For example, the second processing unit 22 may process the E-mail signal to extract the <ConnectRequest> message, including the IP address of the first processing unit 12 and the session number. The second processing unit 22 may then open a socket and generate a <ConnectOK> response signal, which includes the temporary IP address of the second processing unit 22 as well as the session number.

The second processing unit 22 sends the <ConnectOK> signal directly over the Internet 24 to the IP address of the first processing unit 12 without processing by the mail server 28, and a timeout timer of the second processing unit 22 may be set to wait and detect a <Call> signal expected from the first processing unit 12.

Realtime point-to-point communication of audio signals over the Internet 24, as well as video and voicemail, may thus be established and supported without requiring permanent IP addresses to be assigned to either of the users or processing units 12, 22. For the duration of the realtime point-to-point link, the relative permanence of the current IP addresses of the processing units 12, 22 is sufficient, whether the current IP addresses were permanent

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(i.e. predetermined or preassigned) or temporary (i.e. assigned upon initiation of the point-to-point communication).

In the exemplary embodiment, a first user operating the first processing unit 12 is not required to be notified by the first processing unit 12 that an E-mail is being generated and sent to establish the point-to-point link with the second user at the second processing unit 22. Similarly, the second user is not required to be notified by the second processing unit 22 that an E-mail has been received and/or a temporary IP address is associated with the second processing unit 22. The processing units 12, 22 may perform the disclosed point to-point Internet protocol automatically upon initiation of the ~~point-to-point~~ point-to-point communication command by the first user without displaying the E-mail interactions to either user. Accordingly, the disclosed point-to-point Internet protocol may be transparent to the users. Alternatively, either of the first and second users may receive, for example, a brief message of "CONNECTION IN PROGRESS" or the like on a display of the respective output device of the processing units 12, 22.

After the initiation of either the primary or the secondary point-to-point Internet protocols described above in conjunction with FIGS. 1-2, the point-to-point

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communication link over the Internet 24 may be established as shown in FIGS. 3-4 in a manner known in the art. For example, referring to FIG. 3, upon receiving the <ConnectOK> signal from the second processing unit 22, the first processing unit 12 extracts the IP address of the second processing unit 22 and the session number, and the session number sent from the second processing unit 22 is then checked with the session number originally sent from the first processing unit 12 in the <ConnectRequest> message as E-mail. If the session numbers sent and received by the processing unit 12 match, then the first processing unit 12 sends a <Call> signal directly over the Internet 24 to the second processing unit 22; i.e. using the IP address of the second processing unit 22 provided to the first processing unit 12 in the <ConnectOK> signal.

Upon receiving the <Call> signal, the second processing unit 22 may then begin a ring sequence, for example, by indicating or annunciating to the second user that an incoming call is being received. For example, the word "CALL" may be displayed on the output device of the second processing unit 22. The second user may then activate the second processing unit 22 to receive the incoming call.

Referring to FIG. 4, after the second processing unit 22 receives the incoming call, realtime audio and/or

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video conversations may be conducted in a manner known in the art between the first and second users through the Internet 24, for example, by compressed digital audio signals. Each of the processing units 12, 22 may also display to each respective user the words "IN USE" to indicate that the point-to-point communication link is established and audio or video signals are being transmitted.

In addition, either user may terminate the point-to-point communication link by, for example, activating a termination command, such as by activating an [END] button or icon on a respective processing unit, causing the respective processing unit to send an <End> signal which causes both processing units to terminate the respective sockets, as well as to perform other cleanup commands and functions known in the art.

FIGS. 5-6 illustrate examples of display screens 36 which may be output by a respective output device of each processing unit 12, 22 of FIGS. 1-4 for providing the disclosed point-to-point Internet protocol and system 10. Such display screens may be displayed on a display of a personal computer (PC) or a PDA in a manner known in the art.

As shown in FIG. 5, a first display screen 36 includes a status area 38 for indicating, for example, a

called user by name and/or by IP address or telephone number; a current function such as C2; a current time; a current operating status such as "IN USE", and other control icons such as a down arrow icon 40 for scrolling down a list of parties on a current conference line. The operating status may include such annunciators as "IN USE", "IDLE", "BUSY", "NO ANSWER", "OFFLINE", "CALL", "DIALING", "MESSAGES", and "SPEEDDIAL".

Other areas of the display screen 36 may include activation areas or icons for actuating commands or entering data. For example, the display screen 36 may include a set of icons 42 arranged in columns and rows including digits 0-9 and commands such as END, SND, HLD, etc. For example, the END and SND commands may be initiated as described above, and the HLD icon 44 may be actuated to place a current line on hold. Such icons may also be configured to substantially simulate a telephone handset or a cellular telephone interface to facilitate ease of use, as well as to simulate function keys of a keyboard. For example, icons labelled L1-L4 may be mapped to function keys F1-F4 on standard PC keyboards, and icons C1-C3 may be mapped to perform as combinations of function keys, such as CTRL-F1, CTRL-F2, and CTRL-F3, respectively. In addition, the icons labelled L1-L4 and C1-C3 may include circular regions which may simulate light emitting diodes (LEDs) which indicate that the

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function or element represented by the respective icon is active or being performed.

Icons L1-L4 may represent each of 4 lines available to the caller, and icons C1-C3 may represent conference calls using at least one line to connect, for example, two or more parties in a conference call. The icons L1-L4 and C1-C3 may indicate the activity of each respective line or conference line. For example, as illustrated in FIG. 5, icons L1-L2 may have lightly shaded or colored circles, such as a green circle, indicating that each of lines 1 and 2 are in use, while icons L3-L4 may have darkly shaded or color circles, such as a red or black circle, indicating that each of lines 3 and 4 are not in use. Similarly, the lightly shaded circle of the icon labelled C2 indicates that the function corresponding to C2 is active, as additionally indicated in the status area 38, while darkly shaded circles of icons labelled C1 and C3 indicate that such corresponding functions are not active.

The icons 42 are used in conjunction with the status area 38. For example, using a mouse for input, a line that is in use as indicated by the lightly colored circle of the icon may be activated to indicate a party's name by clicking a right mouse button for 5 seconds until another mouse click is actuated or the [ESC] key or icon is

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actuated. Thus, the user may switch between multiple calls in progress on respective lines.

Using the icons as well as an input device such as a mouse, a user may enter the name or alias or IP address, if known, of a party to be called by either manually entering the name, by using the speeddial feature, or by double clicking on an entry in a directory stored in the memory, such as the memory 16 of the first processing unit 12, where the directory entries may be scrolled using the status area 38 and the down arrow icon 40.

Once a called party is listed in the status area 38 as being active on a line, the user may transfer the called party to another line or a conference line by clicking and dragging the status area 38, which is represented by a reduced icon 46. Dragging the reduced icon 46 to any one of line icons L1-L4 transfers the called party in use to the selected line, and dragging the reduced icon 46 to any one of conference line icons C1-C3 adds the called party to the selected conference call.

Other features may be supported, such as icons 48-52, where icon 48 corresponds to, for example, an ALT-X command to exit the communication facility of a processing unit, and icon 50 corresponds to, for example, an ALT-M command to minimize or maximize the display screen 36 by the output device of the processing unit. Icon 52 corresponds

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to an OPEN command, which may, for example, correspond to pressing the O key on a keyboard, to expand or contract the display screen 36 to represent the opening and closing of a cellular telephone. An "opened" configuration is shown in FIG. 5, and a "closed" configuration is shown in FIG. 6. In the "opened" configuration, additional features such as output volume (VOL) controls, input microphone (MIC) controls, waveform (WAV) sound controls, etc.

The use of display screens such as those shown in FIGS. 5-6 provided flexibility in implementing various features available to the user. It is to be understood that additional features such as those known in the art may be supported by the processing units 12, 22.

Alternatively, it is to be understood that one skilled in the art may implement the processing units 12, 22 to have the features of the display screens in FIGS. 5-6 in hardware; i.e. a wired telephone or wireless cellular telephone may include various keys, LEDs, liquid crystal displays (LCDs), and touchscreen actuators corresponding to the icons and features shown in FIGS. 5-6. In addition, a PC may have the keys of a keyboard and mouse mapped to the icons and features shown in FIGS. 5-6.

Referring to FIG. 7, the disclosed point-to-point Internet protocol and system 10 is initiated at a first processing unit 12 for point-to-point Internet

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communications by starting the point-to-point Internet protocols in step 54; initiating the primary point-to-point Internet protocol in step 56 by sending a query from the first processing unit 12 to the connection server 26; determining if the connection server 26 is operative to perform the point-to-point Internet protocol in step 58 by receiving, at the first processing unit 12, an on-line status signal from the connection server 26, which may include the IP address of the callee or a "Callee Off-Line" message; performing the primary point-to-point Internet protocol in step 60, which may include receiving, at the first processing unit 12, the IP address of the callee if the callee is active and on-line; and initiating and performing the secondary point-to-point Internet protocol in step 62 if the called party is not active and/or on-line.

Referring to FIG. 8 in conjunction with FIGS. 1 and 3-4, the disclosed point-to-point Internet protocol and system 10 operates using the connection server 26 to perform step 60 in FIG. 7 by starting the point-to-point Internet protocol in step 64; timestamping and storing E-mail and IP addresses of logged-in users and processing units in the database 34 in step 66; receiving a query at the connection server 26 from a first processing unit 12 in step 68 to determine whether a second user or second processing unit 22 is logged-in to the Internet 24, with the second user being

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specified, for example, by an E-mail address; retrieving the IP address of the specified user from the database 34 in step 70 if the specified user is logged-in to the Internet; and sending the retrieved IP address to the first processing unit in step 72 to establish point-to-point Internet communications with the specified user.

Referring to FIG. 9 in conjunction with FIGS. 2-4, the disclosed secondary point-to-point Internet protocol and system 10 operates at the first processing unit 12 to perform step 62 of FIG. 7. The disclosed secondary point-to-point Internet protocol operates as shown in FIG. 9 by starting the secondary point-to-point Internet protocol in step 74; generating an E-mail signal, including a session number and a first IP address corresponding to a first processing unit in step 76 using the first processing unit 12; transmitting the E-mail signal as a <ConnectRequest> signal to the Internet 24 in step 78; delivering the E-mail signal through the Internet 24 using a mail server 28 to a second processing unit 22 in step 80; extracting the session number and the first IP address from the E-mail signal in step 82; transmitting or sending the session number and a second IP address corresponding to the second processing unit 22 to the first processing unit 12 through the Internet 24 in step 84; verifying the session number received from the second processing unit 22 in step 86; and establishing a

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point-to-point Internet communication link between the first processing unit 12 and second processing unit 22 using the first and second IP addresses in step 88.

While the disclosed point-to-point Internet protocols and system have been particularly shown and described with reference to the preferred embodiments, it is understood by those skilled in the art that various modifications in form and detail may be made therein without departing from the scope and spirit of the invention. Accordingly, modifications such as those suggested above, but not limited thereto, are to be considered within the scope of the invention.

08/533,116

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WHAT IS CLAIMED IS:

1. A method for establishing point-to-point Internet communication comprising the steps of:

(a) storing in a database a respective Internet Protocol (IP) address of a set of processing units that have an on-line status with respect to the Internet;

(b) transmitting a query from a first processing unit to a connection server to determine the on-line status of a second processing unit; and

(c) retrieving the IP address of the second unit from the database using the connection server, in response to the determination of a positive on-line status of the second processing unit, for establishing a point-to-point communication link between the first and second processing units through the Internet.

2. The method of claim 1 wherein the step (b) of transmitting the query includes the step of:

(b1) transmitting the query to the connection server operatively connected to the database and the Internet; and

wherein the step (c) of retrieving the IP address includes the steps of:

(c1) searching the database using the connection server;

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(c2) determining the on-line status of the second processing unit;

(c3) retrieving the IP address of the second processing unit in response to the positive on-line status of the second processing unit; and

(c4) transmitting the IP address of the second processing unit to the first processing unit for establishing the point-to-point communication link between the first and second processing units through the Internet.

3. The method of claim 2 further comprising, after step (c2), the steps of:

(c5) generating an off-line message in response to a negative on-line status of the second processing unit; and

(c4) transmitting the off-line message to the first processing unit.

4. The method of claim 1 further comprising the step of:

(d) performing a secondary communication protocol in response to a non-responsive condition of the connection server.

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5. The method of claim 4 wherein the step (d) of performing the secondary communication protocol includes the steps of:

(d1) transmitting an E-mail signal, including a first IP address, from the first processing unit;

(d2) processing the E-mail signal through the Internet to deliver the E-mail signal to the second processing unit; and

(d3) transmitting a second IP address to the first processing unit for establishing a point-to-point communication link between the first and second processing units through the Internet.

6. An apparatus comprising:

a first processing unit including:

a program stored in a memory for performing a point-to-point Internet protocol; and

a processor for executing the point-to-point Internet protocol program to generate a query to receive an Internet Protocol (IP) address of a second processing unit, for transmitting the query through the Internet to a connection server for determining an on-line status of a second processing unit to the connection server, and for establishing a point-to-point communication link to the second processing unit using the IP address.

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7. A system for point-to-point communications over the Internet comprising:

a database for storing a set of Internet Protocol (IP) addresses of at least one processing unit that has on-line status with respect to the Internet;

a first processing unit including:

a first program for performing a first point-to-point Internet protocol; and

a first processor for executing the first program and for transmitting a query;

a connection server, responsive to the query, for determining the on-line status of a second processing unit by searching the database, and for transmitting an on-line message to the first processing unit for establishing a point-to-point communication link between the first and second processing units through the Internet.

8. The system of claim 7 wherein the connection server, responsive to a positive determination of the on-line status of the second processing unit, retrieves the respective IP address of the second processing unit from the database and transmits the on-line message, including the IP address, to the first processing unit; and

wherein the first processing unit establishes the point-to-point communication link between the first and

second processing units through the Internet in response to receiving the IP address of the second processing unit from the connection server.

9. The system of claim 7 wherein the connection server, responsive to a negative determination of the on-line status of the second processing unit, generates an off-line message, and transmits the off-line message to the first processing unit.

10. The system of claim 7 wherein the connection server further includes a timer for timestamping IP addresses of the set of processing units having a positive on-line status with respect to the Internet.

11. The system of claim 7 further comprising:

a mail server for processing a E-mail signal through the Internet to deliver the E-mail to a specified second processing unit for establishing a point-to-point communication link between the first and second processing units through the Internet; and

wherein the first processor of the first processing unit executes a second program to generate and transmit the E-mail signal, including a first IP address

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associated with the first processing unit, to the mail server.

12. A method for establishing point-to-point Internet communication comprising the steps of:

(a) transmitting an E-mail signal, including a first Internet Protocol (IP) address, from a first processing unit;

(b) processing the E-mail signal through the Internet to deliver the E-mail signal to a second processing unit; and

(c) transmitting a second IP address to the first processing unit for establishing a point-to-point communication link between the first and second processing units through the Internet.

13. The method of claim 12 further comprising the step of:

(a1) generating the E-mail signal from the first IP address corresponding to the first processing unit before the step (a) of transmitting the E-mail signal.

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14. The method of claim 12 further comprising the step of:

(a1) generating the E-mail signal from a session number before the step (a) of transmitting the E-mail signal.

15. The method of claim 12 wherein the step (b) of processing the E-mail signal further comprises the step of:

(b1) processing the E-mail signal using a mail server operatively connected to the second processing unit.

16. The method of claim 12 further comprising the step of:

(b1) generating a connection signal including the second IP address at the second processing unit before the step (c) of transmitting the second IP address to the first processing unit; and

wherein the step (c) of transmitting the second IP address includes the step (c1) of transmitting the connection signal from the second processing unit to the first processing unit.

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17. An apparatus comprising:

a first processing unit including:

a program stored in a memory for performing a point-to-point Internet protocol; and

a processor for executing the point-to-point Internet protocol program to generate an E-mail signal, including a first Internet Protocol (IP) address, and for transmitting the E-mail signal through the Internet to a second processing unit for establishing a point-to-point communication link to the first processing unit.

18. The apparatus of claim 17 wherein the processor is adapted to generate the E-mail signal from the first IP address corresponding to the first processing unit.

19. A system for point-to-point communications over the Internet comprising:

a first processing unit including:

a first program for performing a point-to-point Internet protocol; and

a first processor for executing the first program and for transmitting an E-mail signal, including a first Internet Protocol (IP) address; and

a mail server for processing the E-mail signal through the Internet to deliver the E-mail to a

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second processing unit for establishing a point-to-point communication link between the first and second processing units through the Internet.

20. The system of claim 19 further comprising:

the second processing unit including:

a second program for performing the point-to-point Internet protocol; and

a second processor for executing the second program and for receiving the E-mail signal from the mail server and for generating a connection signal, including a second IP address, for establishing the point-to-point communication link to the first processing unit.

Add A2
add B3

649-2

ABSTRACT

A point-to-point Internet protocol exchanges Internet Protocol (IP) addresses between processing units to establish a point-to-point communication link between the processing units through the Internet. A first point-to-point Internet protocol includes the steps of (a) storing in a database a respective IP address of a set of processing units that have an on-line status with respect to the Internet; (b) transmitting a query from a first processing unit to a connection server to determine the on-line status of a second processing unit; and (c) retrieving the IP address of the second unit from the database using the connection server, in response to the determination of a positive on-line status of the second processing unit, for establishing a point-to-point communication link between the first and second processing units through the Internet. A second point-to-point Internet protocol includes the steps of (a) transmitting an E-mail signal, including a first IP address, from a first processing unit; (b) processing the E-mail signal through the Internet to deliver the E-mail signal to a second processing unit; and (c) transmitting a second IP address to the first processing unit for establishing a point-to-point communication link between the first and second processing units through the Internet.

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AMENDMENT	Docket No. N0003/7000

Applicant: Glenn W. Hutton, et al.
Serial No. 08/533,115
Filed: September 25, 1995
For: METHOD AND APPARATUS FOR ESTABLISHING POINT-TO-POINT COMMUNICATIONS OVER A COMPUTER NETWORK
Examiner: M. Rinehart
Art Unit: 2756

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)
The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Assistant Commissioner for Patents, Box Non-Fee Amendment, Washington, DC 20231 on March 1, 1999.

Frances M. Cunningham
Frances M. Cunningham

Assistant Commissioner for Patents
Washington, D.C. 20231

In response to the office communication dated October 28, 1998, please amend the above-identified application as follows:

In the Specification:

Page 2, line 13, change "XXX.XXX.XXX.XXX" to --XXX.XXX.XXX--;

line 14, change "XXX.XXX.XXX.XXX.10" to --XXX.XXX.XXX.10--;

line 15, change "XXX.XXX.XXX.XXX.11" to --XXX.XXX.XXX.11--;

line 15, change "XXX.XXX.XXX.XXX.12" to --XXX.XXX.XXX.12--;

Page 11, line 10, change "2^{32} " to --32-bit--.

In the claims:

Please amend the claims as follows:

Please cancel claims 1-4 and 6-11, without prejudice.

21. (Amended) A computer program product for use with a computer system, the computer system executing a first process and operatively connectable to a

C

C 32

second process [having first and second processors] and a server [operatively coupled] over a computer network, the computer program product comprising:

a computer usable medium having program code [means] embodied in the medium [for establishing a point-to-point communications link between the first processor and the second processor over the computer network], the [medium further] 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 [means] for transmitting, [from the first processor] to the server, a query as to whether the second [processor] process is connected to the computer network;

program code [means] for receiving a network protocol address of the second [processor] process from the server, when the second [processor] process is connected to the computer network; and

program code [means], responsive to the network protocol address of the second [processor] process, for establishing a point-to-point communication link between the first [processor] process and the second [processor] process over the computer network.

2.

~~23.~~ (Amended) [A computer server] An apparatus for enabling point-to-point communications between a first and a second [processor] process over a computer network, the [server] apparatus comprising:

a [server] processor;

a network interface [means], operatively coupled to the [server] processor, for connecting the [server] apparatus to the computer network;

a memory, operatively coupled to the processor, for storing a network protocol address for selected of a plurality of [processors connected] processes, each network protocol address stored in the memory following connection of a respective process to the computer network;

means, responsive to a query from the first [processor] process, for determining the on-line status of the second [processor] process and for

transmitting [the] a network protocol address of the second [processor] process to the first [processor] process in response to a positive determination of the on-line status of the second [processor] process.

C7

3 2

~~24~~. (Amended) The computer server apparatus of claim ~~23~~ further comprising a timer [means], operatively coupled to the [server] processor, for time stamping the network protocol addresses stored in the memory.

4

~~26~~. (Amended) [In a connection server having a database and a computer network operatively coupled thereto, a] A method for enabling point-to-point communication between a first [processing unit] process and a second [processing unit] process over a computer network, the method comprising the steps of:

C3

A. receiving and storing into a computer memory [storing in the database,] a respective network protocol address for [each] selected of a plurality of [processing units] processes that have an on-line status with respect to the computer network, each of the network protocol addresses received following connection of the respective process to the computer network;

B. receiving a query from the first [processing unit] process to determine the on-line status of the second [processing unit] process;

C. determining the on-line status of the second [processing unit] process; and

D. transmitting an indication of the on-line status of the second [processing unit] process to the first [processing unit] process over the computer network.

5 4

~~27~~. (Amended) The method of claim ~~26~~ wherein step C further comprises the steps of:

c.1 searching the [database] computer memory for an entry relating the second [processing unit] process; and

c.2 retrieving [the] a network protocol address of the second [processing unit] process in response to a positive determination of the on-line status of the second [processing unit] process.

6 4
C3 28. (Amended) The method of claim 26 wherein step D further comprises the steps of:

d.1 transmitting the network protocol address of the second [processing unit] process to the first [processing unit] process when the second [processing unit] process is determined in step C to have a positive on-line status with respect to the computer network.

7 4
29. (Amended) The method of claim 26 wherein step D further comprises the steps of:

d.1 generating an off-line message when the second [processing unit] process is determined in step C to have a negative on-line status with respect to the computer network; and

d.2 transmitting the off-line message to the first [processing unit] process.

8 4
30. (Amended) The method of claim 26 further comprising the steps of:

E. receiving an E-mail signal comprising a first network protocol address from the first [processing unit] process; and

F. transmitting the E-mail signal over the computer network to the second [processing unit] process.

9 8
31. (Amended) The method of claim 30 wherein the E-mail signal further comprises a session number and wherein step F further comprises the step of:

f.1 transmitting the session number and network protocol address over the computer network to the second [processor] process.

10

32. (Amended) In a computer system, a [A] method for establishing a point-to-point communication link from a caller [processor] process to a callee [processor] process over a computer network, the caller [processor having] process having a user interface and being operatively [coupled] connectable to the callee [processor] process and a server over the computer network, the method comprising the steps of:

C3

A. [generating an] providing a user interface element representing a first communication line;

B. [generating an] providing a user interface element representing a first callee [processor] process; and

C. establishing a point-to-point communication link from the caller [processor] process to the first callee [processor] process, in response to a user associating the element representing the first callee [processor] process with the element representing the first communication line.

11 10

33. (Amended) The method of claim 32 wherein step C further comprises the steps of:

c.1 querying the server as to the on-line status of the first callee [processor] process and

E

c.2 receiving a network protocol address of the first callee [processor] process over the computer network from the server.

12 10

34. (Amended) The method of claim 32 further comprising the step of:

D. [generating] providing an element representing a second communication line.

13 12

E 35. (Amended) The method of claim 34 further comprising the step 5 of:

E. terminating the point-to-point communication link from the caller [processor] process to the first callee [processor] process, in response to the

36

user disassociating the element representing the first callee [processor] process from the element representing the first communication line; and

F. establishing a different point-to-point communication link from the caller [processor] process to the first callee [processor] process, in response to the user associating the element representing the first callee [processor] process with the element representing the second communication line.

14 10
36. (Amended) The method of claim 32 further comprising the steps of:

C3

D. [generating an] providing a user interface element representing a second callee [processor] process; and

E. establishing a conference point-to-point communication link between the caller [processor] process and the first and second callee [processors] process, in response to the user associating the element representing the second callee [processor] process with the element representing the first communication line.

15 10
37. (Amended) The method of claim 32 further comprising the step of:

F. removing the second callee [processor] process from the conference point-to-point communication link in response to the user disassociating the element representing the second callee [processor] process from the element representing the first communication line.

16 10
38. (Amended) The method of claim 32 further comprising the steps of:

D. [generating an] providing a user interface element representing a communication line having a temporarily disabled status; and

E. temporarily disabling a point-to-point communication link between the caller [processor] process and the first callee [processor] process, in response to the user associating the element representing the first callee [processor] process with the element representing the communication line having a temporarily disabled status.

17 16

~~39~~. (Amended) The method of claim ~~38~~ wherein the element [generated] provided in step D represents a communication line on hold status.

18 17

~~40~~. (Amended) The method of claim ~~39~~ wherein the element [generated] provided in step D represents a communication line on mute status.

C3

19 10

~~41~~. (Amended) The method of claim ~~32~~ wherein the caller [processor] process further comprises a visual display and the user interface comprises a graphic user interface.

C4

20 19

~~42~~. (Amended) The method of claim ~~41~~ wherein the steps of establishing a point-to-point link as described in step C is performed in response to [a user manipulating] manipulation of the graphic elements on the graphic user interface.

C5

21

~~43~~. (Amended) A computer program product for use with a computer system comprising:

a computer usable medium having program code [means] embodied in the medium for establishing a point-to-point communication link from a caller [processor] process to a callee [processor] process over a computer network, the caller [processor] process having a user interface and being operatively [coupled] connectable to the callee [processor] process and a server over the computer network, the medium further comprising:

program code [means] for generating an element representing a first communication line;

program code [means] for generating an element representing a first callee [processor] process;

program code [means], responsive to a user associating the element representing the first callee [processor] process with the element representing the first communication line, for establishing a point-to-point communication link from the caller [processor] process to the first callee [processor] process.

22 21

~~44~~. (Amended) The computer program product of claim ~~43~~ wherein the program code [means] for establishing a point-to-point communication link further comprises:

program code [means] for querying the server as to the on-line status of the first callee [processor] process; and

program code [means] for receiving a network protocol address of the first callee [processor] process over the computer network from the server.

C 23 21

~~45~~. (Amended) A computer program product of claim ~~43~~ further comprising:

program code [means] for generating an element representing a second communication line.

24 23

~~46~~. (Amended) The computer program product of claim ~~45~~ further comprising:

program code [means], responsive to the user disassociating the element representing the first callee [processor] process from the element representing the first communication line, for terminating the point-to-point communication link from the caller [processor] process to the first callee [processor] process; and

program code [means], responsive to the user associating the element representing the first callee [processor] process with the element presenting the second communication line, for establishing a different point-to-point communication link from the caller [processor] process to the first callee [processor] process.

25 21

~~47~~. (Amended) The computer program product of claim ~~43~~ further comprising:

program code [means] for generating an element representing a second callee [processor] process; and

program code means, responsive to the user associating the element representing the second callee [processor] process with the element representing the first communication line, for establishing a conference communication link between the caller [processor] process and the first and second callee [processors] process.

48. (Amended) The computer program product of claim 47 further comprising:

program code [means], responsive to the user disassociating the element representing the second callee [processor] process from the element representing the first communication line, for removing the second callee [processor] process from the conference communication link.

49. (Amended) The computer program product of claim 43 further comprising:

program code [means] for generating an element representing a communication line having a temporarily disabled status; and

program code [means], responsive [to user associating] association of the element representing the first callee [processor] process with the element representing the communication line having a temporarily disabled status, for temporarily disabling the point-to-point communication link between the caller [processor] process and the first callee [processor] process.

50. The computer program product of claim 49 wherein the communication line having a temporarily disabled status comprises a communication line on hold status.

51. The computer program product of claim 49 wherein the communication line having a temporarily disabled status comprises a communication line on mute status.

52. (Amended) A computer program product of claim 43 wherein the computer system [caller processor] further comprises a visual display and the user interface comprises a graphic user interface.

53. (Amended) The computer program product of claim 52 wherein the element representing the first communication line and the element representing the first callee [processor] process are graphic elements and wherein the

program code [means] for establishing a point-to-point communication link from the caller [processor] process to the first callee [processor] process further comprises:

program code [means], responsive to [a user manipulating] manipulation of the graphic elements on the graphic user interface, for establishing the point-to-point communication link from the caller [processor] process to the first callee [processor] process.

~~54~~. (Amended) A method of locating a [user] process over a computer network comprising the steps of :

a. maintaining an Internet accessible list having a plurality of selected entries, each entry comprising an [electronic mail address] identifier and a corresponding Internet protocol address [for] of a process currently connected to the Internet, the Internet Protocol address added to the list following connection of the process to the computer network; and

b. in response to identification of one of the list entries by a requesting process, providing one of the [electronic mail address] identifier and the corresponding Internet protocol address of the identified entry to the requesting process.

~~55~~. (Amended) A method for locating [users] processes having dynamically assigned network protocol addresses over a computer network, the method comprising the steps of:

a. maintaining, in a computer memory, a network accessible compilation of entries, [each entry] selected of the entries comprising a network protocol address and a corresponding identifier [for a user] of a process connected to the computer network[;], the network protocol address of the corresponding process assigned to the process upon connection to the computer network; and

b. in response to identification of one of the entries by a requesting process providing one of the identifier and the network protocol address to the requesting process.

34 33
56. (Amended) The method of claim 55 further comprising the step of:

c. modifying the compilation of entries.

35 34
57. (Amended) The method of claim 56 wherein step c further comprises:

c.1 adding an entry to the compilation upon the occurrence of a predetermined event.

36 35
58. (Amended) The method of claim 57 wherein the predetermined event comprises notification by a user process of an assigned network protocol address.

37 34
59. (Amended) The method of claim 56 wherein step c further comprises:

c.1 deleting an entry from the compilation upon the occurrence of a predetermined event.

38
60. (Amended) A computer program product for use with a [server apparatus] computer system having a memory and being operatively [coupled] connectable over a computer network to one or more computer processes, the computer program product comprising a computer usable medium having program code embodied in the medium the program code comprising:

a. program code configured to maintain, in [a] the computer memory, a network accessible compilation of entries, [each entry] selected of the entries comprising a network protocol address and a corresponding identifier [for] of a process connected to the computer network, the network protocol address of the corresponding process assigned to the process upon connection to the computer network; and

b. program code responsive to identification of one of the entries by a requesting process and configured to provide one of the identifier and the network protocol address to the requesting process.

39 38

~~61~~. (Amended) The computer program product of claim ~~60~~ further comprising:

c. program code configured to modify the compilation of entries.

40 39

~~62~~. (Amended) The computer program product of claim ~~61~~ wherein program code configured to modify comprises:

c.1 program code configured to add an entry to the compilation upon the occurrence of a predetermined event.

41 40

~~63~~. (Amended) The computer program product of claim ~~62~~ wherein the predetermined event comprises notification by a process of an assigned network protocol address.

42 38

~~64~~. (Amended) The computer program product of claim ~~60~~ wherein step c further comprises:

c.1 program code configured to delete an entry from the compilation upon the occurrence of a predetermined event.

43

~~66~~. (Amended) A computer program product for use with a computer system, the computer system [including] executing a first process operatively coupled over a computer network to a second process and a server process , the computer program product comprising a computer usable medium having computer readable program code embodied therein, the program code [means] comprising:

a. program code configured to access a directory database, the database having a network protocol address for a selected plurality of processes having on-line status with respect to the computer network, the network protocol

address of each respective process forwarded to the database following connection to the computer network; and

b. program code responsive to one of the network protocol addresses and configured to establish a point-to-point communication link from the first process to the second process over the computer network.

44

~~67~~. (Amended) In a first computer process operatively coupled over a computer network to a second process and an address server, a method of establishing a point-to-point communication between the first and second processes comprising the steps of:

A. following connection of the first process to the computer network forwarding to the address server a network protocol address at which the first process is connected to the computer network;

[A.] B. querying the address server as to whether the second process is connected to the computer network;

[B.] C. receiving a network protocol address of the second process from the address server, when the second process is connected to the computer network; and

[C.] D. in [responsive] response to the network protocol address of the second process, establishing a point-to-point communication link with the second process over the computer network.

Remarks

Applicants have considered carefully the Office Action dated October 28, 1998 and the references cited therein. In response, the claims have been amended. Applicants respectfully request reexamination and reconsideration of the application.

Claims 1-4, 6-11, 21, 23-24, 26-64, 66 and 67 have been examined and are rejected over various combinations of U.S. Patent 5,608,786(Gordon); U.S. Patent 5,740,231 (Cohn); U.S. Patent 5,524,254 (Morgan); and excerpts from The World Wide Web Unleashed (December). Before responding to the

individual rejections set forth in the Office Action (Paper No. 23), Applicants request that the Examiner consider the following remarks.

In the office action, the Examiner has repeatedly stated that "[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to include a database and search retrieval mechanism to locate the needed network address because such mechanism permits the database to be modified over time to allow dynamic address assignment thus reducing the need to large address identifiers and thus the amount of data that needs to be transmitted with each packet of data."(Paper No. 23, paragraph 11). Applicants respectfully note that this mischaracterization of the motivation for the invention was first introduced by the prior Examiner (Paper 18, paragraph 7). Applicants' invention solves a fundamental problem associated with the Internet. The problem is not reducing the need for larger address identifiers. The problem is not the amount of data which needs to be transmitted with each packet over the network. The problem is: How can a global network user be located if he/she has no permanent network address?

Applicants have disclosed a solution to the above-described problem. The solution utilizes a client/ server system. In the disclosed system, a client process contacts a dedicated address directory server and forwards to the server the network protocol address to which it has been assigned upon connection to the computer network, along with other identification information. The dedicated address directory server maintains a compilation or list of entries, each of which contain a process identifier and the corresponding network protocol address forwarded to the server by the process itself. Other processes wishing to contact a desired target process simply query the address directory server to determine whether the target process is on-line and the current network protocol address at which the target process is located. The server forwards the network protocol address of the target process to the querying process. The querying process utilizes the information to establish a point-to-point communication with the target process.

The Examiner is relying primarily on Morgan to disclose a database containing one or more network addresses. The Examiner will note that although a database may be programmable or contain writable memory, such a database does not teach or suggest Applicants' inventive client/service system in which the client processes themselves update the database with their current information. This aspect distinguishes Applicants' system from the art of record.

Applicants have cancelled claims 1-4, and 6-11 without prejudice. Accordingly, any rejections of those claims are hereby deemed moot.

Applicants have made global amendments to the claims to ensure consistent use terminology throughout the claims and to conform the claims to 35 U.S.C. Section 112, 2nd paragraph. Specifically, the term "means" has been eliminated from the remaining pending claims. Also, all occurrences of "processors" have been changed to "process". Various other claims have been made for clarity sake. Such amendments are not necessitated by any reference cited by the Examiner but are offered to clarify the claim language and to more particularly point out and distinctly claim the subject matter which Applicants regard as their invention.

The Examiner has rejected the remaining pending claims under 35 USC §103 as being unpatentable over U.S. Patent 5,740,231 (Cohn et al.) in view of U.S. Patent 5,524,254 (Morgan et al.). Applicants respectfully assert that the claims, as amended, patentably distinguishes over the combined teachings of Cohn and Morgan for the following reasons. As stated by the Examiner, Cohn does not specify searching a database to match an address with a destination node. Although the sections of Morgan cited by the Examiner disclose an address recognition engine which reads each request and uses the address contained in the request as an index into an information database for look-up of a corresponding entry (Morgan, column 4, lines 44-56), the Examiner has failed to show where Morgan discloses a database in which the client process supply the database with their respective network addresses.

Claim 21 is directed to a computer program product for use with a computer system functioning as a client process in the inventive client/server

system of the subject application. Claim 21 has been amended to recite "program code for transmitting to the server a network protocol address received by the first process following connection to the computer network " (claim 21, lines 9-10). None of the references cited by the Examiner, whether considered singularly or in combination, disclose, teach or suggest a process or client process which forwards its network protocol address received upon connection to the computer network to a server. As discussed previously, the reporting or "logging-in" of a client process with an address directory server to provide the server with the current network protocol address at which the process can be located is not shown in the prior art.

Claim 23 is an apparatus claim directed to the server portion of Applicants' inventive system. Claim 23 has been amended to now recite an apparatus comprising a processor, a network interface and "a memory ... for storing a network protocol address for selected of a plurality of processes, each network protocol address stored in the memory following connection of the respective process to the computer network" (claim 23, lines 7-10). Claim 23 is believed patentable over the art of record, particularly the Morgan reference, as none of the references disclose or suggest, whether considered singularly or in combination the subject matter now claimed. Claim 24 includes all the limitations of claim 23 and is likewise believed patentable over the cited references for the same reasons as claim 23.

Claim 26 recites a method and has been amended similarly to claim 23. Specifically, claim 26 now recites a method for enabling point-to-point communication between a first process and a second process over a computer network including the step of "receiving and storing in a computer memory a respective network protocol address for selected of a plurality of processes that have an on-line status with respect to the computer network, each of the network protocol addresses received following connection of the respective process to the computer network" (claim 26, lines 6-11). As stated previously, none of the references of record, particularly Morgan et al., are believed to disclose a process for storing network protocol address in which the network protocol

address are received following connection of the process to the computer network. Claims 27-31 include all the limitations of claim 26 and are likewise believed patentable over the art of record for the same reasons as claim 26.

Applicants are puzzled by Examiner's assertion in Paragraphs 16 and 17 of the Office Action that claims 32-42 and 43-53 fail to teach or define beyond the subject matter of claims 1-4. Claims 32-42 are directed to a method for establishing a point-to-point communication link with the user interface of a client process by associating elements representing a communication line and various processes. None of the references cited by the Examiner, including Gordon, Morgan, Cohn and December disclose or suggest a user interface or a technique for establishing communications by manipulation of user interface elements. Claims 43-53 are computer program product claims and are directed to a computer program product containing program code for performing a process similar to the method defined in claims 32-42. Applicants respectfully assert that claims 32-53 with, or without the current amendments patentably distinguish over the cited references, whether considered singularly or in combination. Applicants respectfully assert that the Examiner has failed to disclose where any of the cited references teach or suggest a user interface for establishing point-to-point communications by associating user interface elements representing various processes and communication lines.

Claim 54 recites a method of locating a process over a computer network comprising the step of "maintaining an Internet accessible list having a plurality of selected entries, each entry comprising an identifier and a corresponding Internet protocol address of a process currently connected to the Internet, the Internet protocol address added to the list following connection of the process to the computer network" (claim 54, lines 3-7). For reasons similar to those stated with reference to claims 23 and 26, claim 54 is believed patentable over the art of record.

Claim 55 also recites a method of locating processes over a computer network. Claim 55 has been amended to include the step of "maintaining, in a computer memory, a network accessible compilation of entries, selected of the

entries comprising a network protocol address and a corresponding identifier of a process connected to the computer network, the network protocol address of the corresponding process assigned to the process upon connection to the computer network (claim 55, lines 4-9). Claim 60 is a computer program product claim having similar limitations to claim 55. Specifically, claim 60 recites a computer program product comprising "program code configured to maintain the computer memory, a network accessible compilation of entries, selected of the entries comprising a network protocol address and a corresponding identifier of a process connected to the computer network, the network protocol address of the corresponding process assigned to the process upon connection to the computer network" (claim 60, lines 6-11). Claims 55 and 60 and their subsequent dependent claims are believed patentable over the art of record. The Examiner has not shown where any of the cited references disclose or suggest a database for storing network protocol addresses where the network protocol addresses have been assigned to a process upon the processes connection to the computer network, as now claimed.

Claim 66 is directed to a computer program product for use with a client process in accordance with the inventive client/server system of the present invention. Specifically, claim 66 recites a computer program product comprising program code configured to access a directory database, the database having a network protocol address for a selected plurality of processes having online status with respect to the computer network, the network protocol address of each respective process forwarded to the database following connection to the computer network" (claim 66, lines 7-11). Claim 66 is believed patentable over the art of record substantially for the same reasons as claim 21.

Claim 67 is directed to a method of a client process in the inventive client/server system of the present invention, specifically, claim 67 recites a method of establishing a point-to-point communication between first and second processes comprising the step of "following connection of the first process to the computer network, forwarding to the address server a network protocol address at which the first process is connected to the computer network" (claim 67, lines

5-7). Applicants respectfully assert that claim 67 is patentably distinct over the art of record, whether considered singularly or in combination since none of the cited references disclose, teach or suggest a client process which forwards its network protocol address to an address server following connection of the process to the computer network.

Applicants' submit herewith a supplemental Information Disclosure Statement with this response containing references which have been made of record in co-pending application Serial No. 08/721,316.

In light of the foregoing amendments to the claims, Applicants respectfully assert that all claims currently under consideration now patentably distinguish over the art of record, including the cited references, whether considered singularly or in combination. The Examiner is respectfully requested to advance this case to issuance and send a notice to that effect. In the event that outstanding issues remain following the Examiner's review of this response, Applicants' attorney requests that the Examiner contact Applicants' attorney at the number listed below to set up a telephone interview to attempt to resolve any outstanding issues with the claims and before any further Office Actions are issued.

The Commissioner is hereby authorized to charge any fees or credits under 37 C.F.R. §1.16 and 1.17 to our deposit account No. 02-3038.

Respectfully submitted

Bruce D. Jobse Date: 3/1/99

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION OF:	Attorney Docket: 2655-0188
Net2Phone, Inc. (Patent No. 6,108,704)	Group Art Unit: 3992
Control No.: 90/010,416	Examiner: KOSOWSKI, Alexander
Issue Date: August 22, 2000	Date: July 12, 2010
Title: **POINT-TO-POINT INTERNET PROTOCOL**	Confirmation No.: 1061

RESPONSE TO FINAL REJECTION IN A RE-EXAMINATION

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated May 11, 2010, the Assignee hereby requests an automatic one-month extension of time so that the examiner may consider the filed response, and submits:

Claim Amendments starting on page 2; and

Remarks/Arguments beginning on page 3 of this paper.

Re-Examination of Patent No. 6,108,704
Control No.: 90/010,416
Filed: February 24, 2009
Reply to Office Action of May 11, 2010

AMENDMENTS TO THE CLAIMS

Please cancel the following claims in re-examination without prejudice as follows:

43. (Canceled)

44. (Canceled)

Re-Examination of Patent No. 6,108,704
Control No.: 90/010,416
Filed: February 24, 2009
Reply to Office Action of May 11, 2010

REMARKS/ARGUMENTS

Favorable reconsideration of the claims currently undergoing re-examination, in view of the present amendment and in light of the following discussion, is respectfully requested.

STATUS OF THE CLAIMS

Claims 1-7, 11-20 and 22-42 are pending and the subject of this re-examination. Claims 43 and 44 have been canceled herewith. No other claims have been added or amended. The cancellation of claims 43 and 44 is made without prejudice and in order to expedite prosecution as they are the only claims that remain rejected. However, the Assignee incorporates by references is remarks from the previously file rejection as to why the patentablity of those claims should have been confirmed.

RESPONSE TO REJECTIONS

In the outstanding office action, claims 43 and 44 remained rejected, but the patentability of all remaining pending claims was confirmed. The cancellation of claims 43 and 44 renders moot all remaining rejections, and this re-examination proceeding should now terminate.

Re-Examination of Patent No. 6,108,704
Control No.: 90/010,416
Filed: February 24, 2009
Reply to Office Action of May 11, 2010

Consequently, in light of the above discussions and the cancellation of claims 43 and 44, the patentability of the claims subject to re-examination should be indicated as confirmed. An early and favorable action to that effect is respectfully requested.

CHARGE STATEMENT: Deposit Account No. 501860, order no. **2655-0188**.
The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/ Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached. **This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.**

CUSTOMER NUMBER 42624	Respectfully submitted, By: / Michael R. Casey / Michael R. Casey, Ph.D. Registration No.: 40,294
Davidson Berquist Jackson & Gowdey LLP 4300 Wilson Blvd., 7th Floor, Arlington, Virginia 22203 Main: (703) 894-6400 • FAX: (703) 894-6430	

Re-Examination of Patent No. 6,108,704
Control No.: 90/010,416
Filed: February 24, 2009
Reply to Office Action of May 11, 2010

CERTIFICATE OF SERVICE

The undersigned hereby certifies that, on July 12, 2010, the RESPONSE TO FINAL REJECTION IN A RE-EXAMINATION filed in Re-examination Control No. 90/010,416 was served by U.S. First Class Mail, postage pre-paid, on Requestor as follows:

Blakely, Sokoloff, Taylor & Zafman LLP
1279 Oakmead Parkway
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/ Michael R. Casey /

Michael R. Casey, Ph.D.

ATTACHMENT B

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September 8, 2015

Daniel E. O'Toole
Circuit Executive & Clerk of Court
United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, D.C. 20439

Re: Straight Path IP Group, Inc. v. Sipnet EU S.R.O., Case No. 15-1212

Dear Mr. O'Toole:

I am lead counsel for Appellant Straight Path IP Group, Inc. ("Straight Path") in the above referenced matter and write in regard to a motion filed today by Appellee Sipnet EU S.R.O. ("Sipnet") requesting that the Court take judicial notice of certain portions of the file history for United States Patent No. 6,108,704 ("'704 patent"), the patent at issue in this case. These portions of the '704 patent file history are not part of the record below but were cited in the *amicus curiae* brief filed by Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, "Samsung") in this case on August 17, 2015.

In the event that the Court decides to take judicial notice of the portions of the '704 patent file history referenced in Sipnet's letter, Straight Path requests that the Court also take judicial notice of the following five documents, each of which are relevant to the documents referenced in Sipnet's motion for judicial notice and Samsung's arguments in its *amicus* brief, but are not included in the record below or the Joint Appendix filed by the parties:

1. November 25, 2009 Response to Non-Final Rejection from the reexamination file history of United States Patent No. 6,009,469 ("'469 patent");
2. May 10, 2010 Office Action from the '469 patent reexamination file history;
3. July 12, 2010 Response to Final Rejection from the '469 patent reexamination file history;
4. July 20, 2010 Advisory Action from the '469 patent reexamination file history; and
5. September 12, 2014 Patent Rule 4-3 Joint Claim Construction and Prehearing Statement from *Straight Path IP Group, Inc. v. Blackberry Ltd.*, C.A. No. 6:13-cv-604 (E.D. Tex.).

The first four of the above documents are portions of the reexamination file history for the '469 patent, which is a patent in the same family as the '704 patent. The fifth document above is a Joint Claim Construction and Prehearing Statement from a case pending in the United States District Court for the Eastern District of Texas involving the '704 and '469 patents, and to which Samsung is a party. The Joint Claim Construction and Prehearing Statement contains Samsung's claim construction positions regarding certain claim limitations at issue in that case and in this appeal.

Judicial notice of the above referenced documents is appropriate because their accuracy is not subject to reasonable dispute as the source of each document (the USPTO and the U.S. District Court for the Eastern District of Texas) cannot reasonably be questioned. *See* Fed. R. Evid. 201(b); *St. Clair Intellectual Prop. Consultants, Inc. v. Canon Inc.*, 412 Fed. App'x 270, 275 n.1 (Fed. Cir. 2011) ("[T]his court can take judicial notice of the reexamination record."); *Genentech, Inc. v. United States ITC*, 122 F.3d 1409, 1417 n.7 (Fed. Cir. 1997) ("The most frequent use of judicial notice of ascertainable facts is in noticing the content of court records.") (quoting *Colonial Penn Ins. Co. v. Coil*, 887 F.2d 1236, 1239 (4th Cir. 1989)).

A copy of each of the above referenced documents is attached to this letter.

Please do not hesitate to contact me with any questions.

Respectfully submitted,

/s/ James Wodarski
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DOCUMENT 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION OF:	Attorney Docket: 2655-0185
Net2Phone, Inc. (Patent No. 6,009,469)	Group Art Unit: 3992
Control No.: 90/010,422	Examiner: KOSOWSKI, Alexander
Issue Date: December 28, 1999	Date: November 25, 2009
Title: **GRAPHIC USER INTERFACE FOR INTERNET TELEPHONY APPLICATION**	Confirmation No.: 6565

RESPONSE TO NON-FINAL REJECTION IN A RE-EXAMINATION

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated August 25, 2009 (and having had the deadline for responding extended one month), the Assignee hereby submits:

Amendments to the Claims beginning on page 2 of this paper; and

Remarks/Arguments beginning on page 3 of this paper.

Re-Examination of Patent No. 6,009,469
Control No.: 90/010,422
Filed: February 24, 2009
Reply to Office Action of August 25, 2009

AMENDMENTS TO THE CLAIMS

In the re-examination, please amend claim 1 as follows:

1. (Amended) A computer program product for use with a computer system having a display and an audio transducer, the computer system capable of executing a first process and connecting to other processes and a server process over a computer network, the computer program product comprising a computer usable medium having computer readable code means embodied in the medium comprising:

a. program code for generating a user-interface enabling control of a first process executing on the computer system;

b. program code for determining the currently assigned network protocol address of the first process upon connection to the computer network;

c. program code responsive to the currently assigned network protocol address of the first process, for establishing a communication connection with the server process and for forwarding the assigned network protocol address of the first process and a unique identifier of the first process to the server process upon establishing a communication connection with the server process; and

d. program code means, responsive to user input commands, for establishing a point-to-point communications with another process over the computer network.

Re-Examination of Patent No. 6,009,469
Control No.: 90/010,422
Filed: February 24, 2009
Reply to Office Action of August 25, 2009

REMARKS/ARGUMENTS

Favorable reconsideration, in view of the present amendment and in light of the following discussion, is respectfully requested.

STATUS OF THE CLAIMS AND SUPPORT FOR THE CHANGES TO CLAIM 1

Upon entry of this amendment, the status of the claims will be as follows:

Claims 1-3, 5, 6, 8, 9 and 14-18 will be pending and are the subject of this re-examination. Claims 4, 7 and 10-13 are not subject to re-examination.

Claim 1 has been amended to provide a missing "of" between "control" and "a." The change is self-supporting and does not introduce any new matter. No claims other than claim 1 have been amended, and no claims have been added or canceled herewith.

RESPONSE TO REJECTIONS

In the outstanding Office Action, three rejections under 35 U.S.C 103(a) were made as follows:

1. Claims 1-3, 5, 6, 8, 9, and 14-18 were alleged to be obvious over the combination of NetBIOS and RFC 1531, Pinard and the VocalChat User's Guide;
2. Claims 1-3, 5, 6, 8, 9, and 14-18 were alleged to be obvious over the combination of the Etherphone papers in view of Vin and further in view of RFC 1531, Pinard and the VocalChat User's Guide; and
3. Claims 1-3, 5, 6, 8, 9, and 14-18 were alleged to be obvious over the combination of the VocalChat references in view of RFC 1531 and Pinard.

Each of those rejections is respectfully traversed for the reasons set forth below. Reference is made throughout this response to the Declaration Of Ketan Mayer-Patel Under 37 C.F.R. 1.132 (hereinafter the "Mayer-Patel Declaration") attached hereto as Exhibit 1.

The rejection of Claims 1-3, 5, 6, 8, 9, and 14-18 over the combination of NetBIOS, RFC 1531 Pinard and VocalChat User's Guide

Claims 1-3

Claim 1 recites "a. program code for generating a user-interface enabling control of a first process executing on the computer system." With respect to the limitation of "program code for generating a user-interface enabling control of a first process executing on the computer system," the Office Action alleges that "computers executing NetBIOS ***may contain*** DOS operating systems or may operate on other operating systems, which examiner notes inherently contain at least text-based user interfaces." That "inherency" argument is respectfully challenged. First, even stating that NetBIOS "may contain" DOS operating systems is an admission by itself that NetBIOS need not actually contain a DOS operating system, and, therefore, NetBIOS does not inherently contain at least text-based user interfaces. Furthermore, the recitation of "other operating systems" also does not inherently mean that "text-based user interfaces" are provided. For example, embedded systems need not have a display or a text interface even though they may have operating systems. The Office Action also has not asserted that this limitation is taught by RFC 1531. Thus, limitation (a) has not been shown to be taught by either applied reference. See Exhibit 1, Mayer-Patel Declaration, paragraphs 18-19.

Claim 1 also recites "b. program code for determining the currently assigned network protocol address of the first process upon connection to the computer network." With respect to that limitation, the Office Action admits that NetBIOS does not teach this limitation. To address the admitted deficiency, the Office Action alleges that such a limitation is taught by RFC 1531 because "RFC 1531 teaches dynamically assigning IP address on a TCP/IP network by an Internet access server." An examination of limitations (a) and (b) together, however, shows that the Office Action has not alleged, much less proven, that the currently assigned network protocol address is that of the first process which the Office Action alleged was the "text-based user interface." The Office Action has not even identified any motivation for the text-based interface to have its currently assigned network protocol address determined. Thus, limitation (b) has not

been shown to be taught by either applied reference. See Exhibit 1, Mayer-Patel Declaration, paragraph 20.

Claim 1 further recites "c. program code responsive … for forwarding the assigned network protocol address of the first process and a unique identifier of the first process to the server process upon establishing a communication connection with the server process." As the Office Action has not shown that the assigned network protocol address of the first process is determined, the Office Action also has not shown that the assigned network protocol address of the first process would be forwarded to the server upon establishing a communication connection with the server process. Similarly, the Office Action has not shown that the alleged text-based user interfaces would have a unique identifier to be forwarded to the server. The Office Action further has not shown that such a limitation is taught by RFC 1531. Accordingly, limitation (c) has not been shown to be taught by either applied reference. See Exhibit 1, Mayer-Patel Declaration, paragraph 21.

Claim 1 also recites "d. program code, responsive to user input commands, for establishing a point-to-point communications with another process over the computer network." The Office Action cites NetBIOS, pgs. 397-400, as teaching that "point-to-point communication is established upon initiation between nodes once target names and addresses have been found." This assertion, however, fails to allege, much less prove, that such code is "responsive to user input commands" as no user input commands have been identified. Even assuming that text-based user interfaces were taught by NetBIOS, the Office Action still would not have shown that point-to-point communications are inherently established "responsive to user input commands." The text-based user interfaces could have been used for non-communicating functions or even functions that use non-point-to-point communications. The Office Action further has not shown that such a limitation is taught by RFC 1531. Accordingly, limitation (d) has not been shown to be taught by either applied reference. See Exhibit 1, Mayer-Patel Declaration, paragraph 22.

Since none of the limitations of claim 1 have been shown to be taught by the applied combination of references, claim 1 and dependent claims 2 and 3 are not rendered obvious by the proposed combination. See Exhibit 1, Mayer-Patel Declaration, paragraph 23.

No Ability to Combine the References as in Claims 1-3, 5, 6, 8, 9, and 14-18

In addition, the Office Action has not proven that one of ordinary skill in the art would have been able to combine the references as proposed. The Office Action acknowledges that NetBIOS does not teach "program code for determining the currently assigned network protocol address of the first process upon connection to the computer network." The Office Action asserts that it would have been obvious to one skilled in the art at the time the invention was made to utilize dynamically assigned IP addresses from Internet access servers in the invention taught by NetBIOS. The Office Action further alleges that "it would have been obvious … to determine the currently assigned network address of the first process upon connection to the computer network in the invention taught by NetBIOS above since this allows for automatic reuse of an address … and since examiner notes the use of dynamic IP address assignment … are old and well known … and are useful to eliminate the burdensome task of manually assigning IP addresses for all networked computers." See Exhibit 1, Mayer-Patel Declaration, paragraph 24.

The assignee respectfully submits that the obviousness conclusion drawn by the Office Action is mistaken. The Office Action speculates, with hindsight, as to why a person of ordinary skill might want to combine the two references, but does not acknowledge the problems that would arise in doing so, and does not provide any prior art that would indicate how the problems that dynamic addressing would bring into a NetBIOS type system could be resolved by those of ordinary skill at the time the patent was filed. See Exhibit 1, Mayer-Patel Declaration, paragraph 24.

In the context of point-to-point communication, widespread use of dynamically assigned addresses does not solve NetBIOS problems, it creates further problems. The assignee agrees

that dynamically assigned addresses were known, and the patent in re-examination specifically states in that regard, "Due to the dynamic nature of temporary IP addresses of some devices accessing the Internet, point-to-point communications in realtime of voice and video have been generally difficult to attain." Col. 2, lines 35-38. See Exhibit 1, Mayer-Patel Declaration, paragraph 25.

But it is not enough to prove that the cause of a problem existed, namely the problematic use of changing addresses. The Office Action must show by citation of prior art that the problem was recognized, and that the solution for NetBIOS was either known or trivially apparent from the known art. See *Innogenetics, N.V. v. Abbott Laboratories*, 512 F.3d 1363, 1373 (Fed Cir. 2008). ("The district court was nevertheless correct that knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references to reach the particular claimed method."). If the requester of reexamination had such prior art it would undoubtedly have been provided as part of its exhaustive reexamination request. The fact that there is none is testimony to the lack of teaching in the prior art sufficient to enable the person of ordinary skill to make the suggested combination.

The NetBIOS reference cited in the request, moreover, indicates the opposite. For example, Section 15.1.7 of the NetBIOS reference (entitled "Consistency of the NBNS Data Base") recognizes that the association between a node, a registered name and an IP address is tenuous, even in an environment that uses static IP addresses. "Even in a properly running NetBIOS scope the NBNS and its community of end-nodes may occasionally lose synchronization with respect to the true state of name registrations." To minimize the impact of this problem, the reference states, "Various approaches have been incorporated into the NetBIOS-over-TCP protocols" which it then proceeds to describe. See Exhibit 1, Mayer-Patel Declaration, paragraph 25.

However, by incorporating DHCP and adopting dynamic address allocation as used by Internet access providers, the synchronization problem would become more disruptive, not less. Dynamic addressing introduced a new uncertainty to the relationships among the NBNS and its

community of end-nodes and a new set of obstacles to NetBIOS synchronization that *are not addressed by the NetBIOS reference*. Consider the case of a node that is turned-off and then subsequently turned back on, or a node that has simply lost its Internet connection for some technical reason or whose DHCP lease has expired and then re-established a connection. In a dynamic addressing environment, such a node would most likely obtain a new IP address when it was turned back on that was different than the one it had when it registered its name. This change could lead to any number of node-name-IP address synchronization problems for the disclosed NetBIOS protocols. See Exhibit 1, Mayer-Patel Declaration, paragraph 26.

For example, because the NBNS does not know the node's new address, the NBNS would be unable to send to the node a Name Release Request or a Name Conflict Demand or request that the node send it a Name Status Request. Because communication from the node would be originating at a new address that was not recognized by the NBNS, a node's response to a Name Query Request (assuming it somehow knew that its name had been challenged, perhaps from before it lost network connectivity) would not be recognized. A node would also be unable to confirm its association with registered names by sending Name Refresh Request packets to the NBNS. If a session between two NetBIOS applications were cut-off, re-establishing the communication would be especially difficult where the ability of a called entity to obtain both its associated name and its associated IP address were in doubt. As a result, the Office Action has not demonstrated that a solution to the problems created by exposure of NetBIOS to DHCP and dynamic addressing has been addressed by any of the applied references.[1] See Exhibit 1, Mayer-Patel Declaration, paragraph 27.

[1] Besides dynamic addressing, Internet access would pose other challenges to a NetBIOS system. For example, because NetBIOS was designed for use on local area networks with small numbers of computers, trust among the network participants is assumed. That assumption cannot be transferred to a global Internet made up of unknown, and sometimes malevolent, entities. An implementation of NetBIOS on the public Internet would necessitate non-trivial adaptations to ensure that its services perform correctly and return accurate information. There is no discussion of security issues in the cited references. See Exhibit 2, from http://www.w3schools.com/Site/site_security.asp which instructs Microsoft Windows users whose computers access the Internet to disable NetBIOS over TCP/IP in order to solve their security problems. See Exhibit 1, Mayer-Patel Declaration, paragraph 27.

The Office Action also has not identified anything in the cited art that suggests how a person of ordinary skill is to go about the redesign of NetBIOS and the solving of obstacles to NetBIOS operation that are created by Internet access; *problems that were recognized and left as warnings unresolved in the NetBIOS reference*.[2] See Exhibit 1, Mayer-Patel Declaration, paragraph 28.

Merely citing to dynamic addressing, i.e., the source of those problems, is insufficient as the Supreme Court and the Federal Circuit have repeatedly made clear. See *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1326 (Fed. Cir. 2009) citing *inter alia KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) and U.S. v. Adams, 383 U.S. 39 (1966), for the proposition that obviousness requires not only "the expectation that prior art elements are capable of being physically combined, but also that the combination would have worked for its intended purpose," and also quoting *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007) as saying "[A] reference teaches away from a combination when using it in that combination would produce an inoperative result."

In view of the foregoing, the proposed rejection of claims 1-3 over the combination of NetBIOS and RFC 1531 can be compared to a patent that claims a vehicle that travels on water where one piece of prior art shows a land vehicle and another shows water. The fact that water creates a problem for the land vehicle does not disclose that the person of ordinary skill would know how to build a vehicle capable of crossing the water. Thus, claims 1-3 are patentable over the combination of NetBIOS and RFC 1531. See Exhibit 1, Mayer-Patel Declaration, paragraph 29.

[2] The cited references go out of their way *to avoid* describing how a NetBIOS protocol might work in inter-connected network environments that that are *less complex* than the Internet and that *predate* DHCP. See Section 4.6 ("The proposed standard recognizes the need for NetBIOS operation across a set of networks interconnected by network (IP) level relays (gateways.) However, the standard assumes that this form of operation will be less frequent than on the local MAC bridged-LAN.")

Claims 5 and 6

Claim 5 recites "determining the currently assigned network protocol address of the first process upon connection to the computer network." The Office Action admits that this limitation is not taught by NetBIOS but alleges that "RFC 1531 teaches dynamically assigning IP addresses on a TCP/IP network by an Internet access server." The Office Action further alleges that "it would have been obvious … to determine the currently assigned network address of the first process upon connection to the computer network in the invention taught by NetBIOS above since this allows for automatic reuse of an address … and since examiner notes the use of dynamic IP address assignment … are old and well known … and are useful to eliminate the burdensome task of manually assigning IP addresses for all networked computers." However, as described above with respect to claims 1-3 and the alleged motivation to combine NetBIOS and RFC 1531, the Office Action has only speculated, with hindsight, as to why a person of ordinary skill might want to combine the two references, and has neither addressed the problems that would arise in doing so, nor provided any prior art that would indicate how these problems could be designed-around or otherwise resolved by those of ordinary skill at the time the patent was filed. Thus, claim 5 and dependent claim 6 are patentable over the applied NetBIOS and RFC 1531 references. See Exhibit 1, Mayer-Patel Declaration, paragraph 30.

Claims 8, 9 and 14-18

Claim 8 recites "querying the server process to determine if the first callee process is accessible." The Office Action asserts that this limitation is taught by NetBIOS and cites pages 377, 388, 389 and 446 as supporting the proposition that "a query is sent to the NBNS to determine if another node is logged in and discover[s] the node[']s IP address." However, the Office Action has not shown how knowing that a name has been registered equates to "determin[ing] if the first callee process is accessible." While NetBIOS uses name entries with "active" statuses as part of its name management process, an analysis of how that "active" status is used shows that "an active name" is not synonymous with determining if the first callee

process is accessible. An active name simply refers to a name that has been registered and that has not yet been de-registered, independent of whether the associated computer is or is not accessible. As shown on page 447 (and reproduced below), the Node_Name entries stored with respect to a NetBIOS Name Server contain a series of fields including the "ACT" field. See Exhibit 1, Mayer-Patel Declaration, paragraph 31.

The NAME_FLAGS field:

											1	1	1	1	1	1
0	1	2	3	4	5	6	7	8	9	0	1	2	3	4	5
G	ONT		DRG	CNF	ACT	PRM	RESERVED									

The NAME_FLAGS field is defined as:

Symbol	Bit(s)	Description:
RESERVED	7-15	Reserved for future use. Must be zero (0).
PRM	6	Permanent Name Flag. If one (1) then entry is for the permanent node name. Flag is zero (0) for all other names.
ACT	5	Active Name Flag. All entries have this flag set to one (1).
CNF	4	Conflict Flag. If one (1) then name on this node is in conflict.
DRG	3	Deregister Flag. If one (1) then this name is in the process of being deleted.
ONT	1,2	Owner Node Type: 00 = B node 01 = P node 10 = M node 11 = Reserved for future use
G	0	Group Name Flag. If one (1) then the name is a GROUP NetBIOS name. If zero (0) then it is a UNIQUE NetBIOS name.

The ACT field is a single bit field (in bit 5) that signifies an "Active Name Flag. ***All entries have this flag set to one (1)***." (Emphasis added.) If all name entries have this flag set to one (1), then the NetBIOS name server cannot be using the Active Name Flag as a means of

separately tracking whether the entity that owns the name is "active," let alone what its "on-line" status might be. See Exhibit 1, Mayer-Patel Declaration, paragraph 32.

The NetBIOS reference also does not teach that the active status of a name in the NetBIOS server is an indication of the active status of the owner of that name. To the contrary, when information about whether the owner of a name is "active" may be relevant, for example when a new entity seeks to register a name that has already been registered in the NetBIOS name server, the NetBIOS reference describes an elaborate set of interactions used to test whether the existing owner of the registered name is active or inactive. It does not rely on the fact that the name is active in the NetBIOS name server (See Section 15.2.2.2 and 15.2.2.3 entitled "Existing Name and Owner is Inactive"). See Exhibit 1, Mayer-Patel Declaration, paragraph 33.

The NetBIOS reference also does not teach that an acquired IP address can be reasonably relied upon by a requesting end-node to confirm that an end-node associated with a sought name is, in fact, "accessible." The NetBIOS reference describes at least two different scenarios where a second end-node sends a rejection response to the first end-node notwithstanding the fact that an end-node is connected to the computer network and active with respect to the sought name. See Section 16.1.1 ("There exists a NetBIOS LISTEN compatible with the incoming call, but there are inadequate resources to permit establishment of a session…The called name does, in fact, exist on the called node, but there is no pending NetBIOS LISTEN compatible with the incoming call."). No distinction is made in the reference between the rejection response in these cases and the rejection response in cases where the called name does not exist on the called end-node. Section 16.1.1 also states "In all but the first case, a rejection response is sent back over the TCP connection to the caller." See Exhibit 1, Mayer-Patel Declaration, paragraph 34.

The Office Action also has not alleged that any of the remaining references teach this limitation missing from the NetBIOS reference. As such, claim 8 and its dependent claims (claims 9 and 14-18) are not rendered obvious by the cited combination of references. See Exhibit 1, Mayer-Patel Declaration, paragraph 35.

The rejection of claims 1-3 over the combination of the Etherphone papers in view of Vin and further in view of RFC 1531

Claims 1-3

Claim 1, as amended, recites "a. program code for generating a user-interface enabling control of a first process executing on the computer system" and "d. program code means, responsive to user input commands, for establishing a point-to-point communications with another process over the computer network." When read together, it can be seen that the Office Action has not alleged that these limitations are taught by the applied combination of references. See Exhibit 1, Mayer-Patel Declaration, paragraph 37.

With respect to the limitation "a. program code for generating a user-interface enabling control of a first process executing on the computer system," the Office Action cites Swinehart and Zellweger as teaching that "workstations include GUI's." Later, with respect to the limitation "d. program code means, responsive to user input commands, for establishing a point-to-point communications with another process over the computer network," the Office Action asserts that "after acquiring the network address of a callee, voice datagrams are transmitted directly amont [sic; among] the participants, bypassing the control server." However, by "participants" it appears that the Office Action is referring to Etherphones participating in a telephone call. As such, the Office Action has not shown that the datagrams are transmitted as part of a point-to-point communication from the workstation (which was alleged as having the first process) to one of the Etherphones. In fact, with respect to limitation (c), the Office Action confirms that its interpretation is that the "workstation address [is] transmitted to the Voice Control Server when connected" -- not the Etherphone's network address. See Exhibit 1, Mayer-Patel Declaration, paragraph 38.

Similarly, looking at it from the opposite perspective, if the voice datagrams are actually going from one Etherphone to another, then the Office Action has not shown how the "currently assigned network protocol address of the first process" is the address of the Etherphone and how

the Etherphone has a display or "a user-interface enabling control a first process" on that Etherphone. The Office Action also has not alleged that RFC 1531 teaches this limitation missing from the Etherphone references. Thus, claims 1-3 are not rendered obvious by the proposed combination. See Exhibit 1, Mayer-Patel Declaration, paragraph 39.

Claims 5 and 6

Claim 5 recites "A. determining the currently assigned network protocol address of the first process upon connection to the computer network" and "D. establishing a point-to-point communication with another process over the computer network." As described above with respect to claim 1, when these two limitations are examined together, it can be seen that the Office Action has not met its burden of showing that these limitations are met. See Exhibit 1, Mayer-Patel Declaration, paragraph 40.

With respect to the limitation "A. determining the currently assigned network protocol address of the first process upon connection to the computer network," the Office Action again cites the GUI's of the workstation as meeting this limitation. Then, with respect to the limitation "D. establishing a point-to-point communication with another process over the computer network," the Office Action again states "voice datagrams are transmitted directly amont [sic; among] the participants, bypassing the control server." Thus, as discussed above with respect to claim 1, the Office Action appears to have overlooked that the Etherphone, not the workstation with the GUI, is receiving the voice datagrams, so the Etherphone reference does not teach limitations (A) and (D). The Office Action also has not alleged that RFC 1531 teaches this limitation missing from the Etherphone references. Thus, claim 5 and dependent claim 6 are not rendered obvious by the proposed combination. See Exhibit 1, Mayer-Patel Declaration, paragraph 41.

Claims 8, 9 and 14-18

Claim 8 recites "a method for establishing a point-to-point communication from a caller process to a callee process over a computer network, the caller process capable of generating a user interface and being operatively connected to the callee process and a server process over the computer network." That method includes "querying the server process to determine if the first callee process is accessible" and "establishing a point-to-point communication link from the caller process to the first callee process." See Exhibit 1, Mayer-Patel Declaration, paragraph 42.

With respect to the limitation of "establishing a point-to-point communication link from the caller process to the first callee process," the Office Action asserts that Swinehart and Zellweger teach "voice datagrams are transmitted directly among participants." However, it appears that the Office Action means that the Etherphone are the "participants." If this is the case, there is no indication that the combination meets the limitation of "the caller process capable of generating a user interface" as the Office Action has not alleged that the Etherphone has such a capability. The Office Action has also not alleged that the other references overcome this deficiency of the Etherphone references. Thus, claim 8 and its dependent claims are patentable over the applied combination of references. See Exhibit 1, Mayer-Patel Declaration, paragraph 43.

The rejection of claims 1-3 over the combination of the VocalChat references in view of RFC 1531

Claims 1-3, 5, 6, 8, 9 and 14-18 stand rejected under 35 U.S.C. § 103(a) as obvious over VocalChat User's Guide in view of VocalChat Readme, VocalChat Networking, VocalChat Help File and VocalChat Troubleshooting Help file (collectively the "VocalChat References") and further in view of RFC 1531 and Pinard. As a preliminary matter, the Office Action has not established that the VocalChat references constitute printed publications as required by statute. See 35 U.S.C. §§ 301 and 302.

The VocalChat References Are Not Printed Publications

The Office Action appears to rely on, but does not expressly reference, Exhibit L of the Request for Re-examination (i.e., the Declaration of Alon Cohen), to establish that the VocalChat references are, in fact, printed publications. As found by the Federal Circuit in *Carella v. Starlight Archery*, 804 F.2d 135, 139, 231 USPQ 644, 646-7 (Fed. Cir. 1986), "one who wishes to characterize the information, in whatever form it may be, as a 'printed publication' … should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents." (Citing *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981) as quoting *Phillips Electronics & Pharmaceutical Industries Corp. v. Thermal & Electronic Industries, Inc.*, 450 F.2d 1164, 1171, 171 USPQ 641, 646 (3rd. Cir. 1971).

Mr. Cohen states in paragraph 3 of his declaration that "the first version of the VocalChat product was commercially released to the public in 1993." However, this provides no indication of what information was distributed with that version (or even what the version number was of that version).

In paragraph 4 of his declaration, Mr. Cohen alleged that VocalChat 1.01 Networking Information "was publicly distributed in 1994 as part of the VocalChat version 1.01 software, which was commercially released and on sale to the general public in 1994." Mr. Cohen did not, however, allege the facts necessary to show that the files are actually printed publications For example, to whom was the software distributed, if anyone, outside of VocalTec? Second, how many copies were distributed and under what conditions? For example, were the copies distributed under a confidentiality agreement such that the associated files were not available to the general public? Were they distributed in such a way as to have been sufficiently available to one of ordinary skill in the art that she/he could have found them when trying to solve a similar problem? Without evidence on these factors, the mere allegation that VocalChat 1.01 Networking Information "was publicly distributed in 1994 as part of the VocalChat version 1.01

software, which was commercially released and on sale to the general public in 1994" is insufficient to show that this reference constitutes a printed publication.

Similarly, with respect to the VocalChat Help File and the VocalChat Troubleshooting Help file, Mr. Cohen alleges in paragraph 6 of his declaration that "Electronic copies of these documents were publicly distributed in 1994 as part of the VocalChat version 2.02 software, which was commercially released and on sale to the general public as a boxed product in 1994." However, this too fails to provide the same relevant facts required to make a prima facie case that the VocalChat Help file and VocalChat Troubleshooting Help file constitute printed publications.

As also described in *Carella*, "Although in some circumstances unsupported oral testimony can be sufficient to prove prior knowledge or use, it must be regarded with suspicion and subject to close scrutiny." 804 F.2d at 138, 231 USQP at 646. Although not disclosed in the declaration, the declarant, Mr. Cohen, is a paid consultant for the Defendants in the litigation relating to the patent in re-examination. See Exhibit 3 where the Court found Mr. Cohen to be a "consultant[] who the defendant has paid, see Deposition of Alon Cohen…" Mr. Cohen also co-founded a company named BitWine that partners with Defendant Skype. See Exhibit 4 (from http://techaddress.wordpress.com/2006/12/06/interview-with-alon-cohen-co-founder-and-co-ceo-of-bitwine.). Mr. Cohen also offers personal services to the public through the BitWine-Skype partnership. See Exhibit 5 (from http://www.bitwine.com/search?query=alon+cohen&=). Moreover, Mr. Cohen's company, VocalTec, produced Internet Phone, and the original patentee, NetSpeak, produced a competing product called WebPhone, thereby creating a potential for bias -- especially when at least one person compared the two products and stated "WebPhone may well become the killer app that puts to shame similar offerings from VocalTec (Internet Phone) and Quarterdeck (WebTalk). See Exhibit 6 (N2P-001-00005919).

TheVocalChat References Do Not Teach All of the Claim Limitations

Even assuming that the VocalChat references constitute printed publications (which has not been established), the combination of references still does not render obvious the claims under re-examination.

Claims 1-3

Claim 1 recites "program code responsive to the currently assigned network protocol address of the first process, for establishing a communication connection with the server process and for forwarding the assigned network protocol address of the first process and a unique identifier of the first process to the server process upon establishing a communication connection with the server process." The Office Action admits that this limitation is not disclosed by the VocalChat references. However, the Office Action attempts to overcome this deficiency by combining the VocalChat references with RFC 1531. See Exhibit 1, Mayer-Patel Declaration, paragraph 45.

The assignee respectfully submits that the Office Action is mistaken. In the context of point-to-point communication, widespread use of dynamically assigned addresses is not the solution to a problem, it is the problem itself. See Exhibit 1, Mayer-Patel Declaration, paragraph 25. The assignee agrees that dynamically assigned addresses were known, and the patent in re-examination specifically states in that regard, "Due to the dynamic nature of temporary IP addresses of some devices accessing the Internet, point-to-point communications in realtime of voice and video have been generally difficult to attain." Col. 2, lines 35-38.

But it is not enough to prove that the cause of a problem existed. The Office Action must show by citation of prior art that the problem was recognized, and that the solution was either known or trivially apparent from the known art. See *Innogenetics, N.V. v. Abbott Laboratories*, 512 F.3d 1363, 1373 (Fed Cir. 2008). ("The district court was nevertheless correct that knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references to reach the particular claimed method.").

The development history of the VocalChat products indicates the opposite. See Exhibit 1, Mayer-Patel Declaration, paragraph 48. As the Examiner is aware, the Request cites a Generic version of the VocalChat client which, according to Mr. Cohen, was used on local area networks. See Cohen Declaration, paragraph 3. Absent from the Request, however, is any reference to the subsequent versions of VocalChat that were released by VocalTec to the public for use on the Internet. The first of those versions was relased in 1994, at least in beta, and was called VocalChat Gateway To Interent (or "VocalChat GTI"). This Internet version is believed to have required users to manually input callee addresses into static local address files. (See paragraph 393 of the Pre-Trial Order (filed with the IDS dated August 11, 2009) and Exhibit 7, SKYPE-N2P00286659.) Likewise, it is believed that VocalChat GTI did not utilize a server at all. See Pre-Trial Order at paragraph 390.

The use of manually input static addresses and the absence of a server suggests that the VocalTec designers—presumably software developers of at least ordinary skill in the art—did not consider the alleged combination of their own VocalChat references with RFC 1531, or it suggests that they did consider it but were unable to overcome the non-trivial obstacles to doing so. See Exhibit 1, Mayer-Patel Declaration, paragraph 50.

The next version of VocalChat was released soon thereafter and was also meant for use on the Internet. This version, again, did not combine the Request's disclosed versions of VocalChat with RFC 1531. Instead, it used the Internet Relay Chat (IRC) to help VocalChat clients with dynamically assigned IP addresses find one another. See Pre-Trial Order at paragraph 392 and Exhibit 7, SKYPE-N2P00286660. The development history of VocalChat—from the Generic version disclosed by the Request for use on local area networks to the GTI and IRC versions for use on the Interent—is strong, objective evidence of nonobviousness. If the designers of the VocalChat Generic implementation did not see fit to combine dynamic addressing with the implementation disclosed in the VocalChat references, it is respectfully submitted that one of ordinary skill in the art would not have done so either, *a fortiori*. See Exhibit 1, Mayer-Patel Declaration, paragraph 51.

Claim 1 also recites "forwarding the assigned network protocol address of the first process and a unique identifier of the first process to the server process upon establishing a communication connection with the server process." The VocalChat Generic implementation does not disclose such a limitation. In the VocalChat Generic implementation, a local process reads a "USERS" file or a Connections file in its entirety and writes it back in its entirety rather than "forwarding the assigned network protocol address of the first process and a unique identifier of the first process to the server process upon establishing a communication connection with the server process." This causes the VocalChat system to have to send an increasing amount of information as the number of users increases. Sending the whole file such that the new file replaces the old file also creates problems with consistency such that one user's changes could overwrite the changes of another user -- especially as networks got larger which would have increased the problem of inconsistent files being written. See Exhibit 1, Mayer-Patel Declaration, paragraph 47.

Accordingly, the subject matter of claim 1 is not rendered obvious by the combination of the VocalChat references and RFC 1531. Since claim 1 is not rendered obvious by the proposed combination, claims 2-3 are not rendered obvious as well. See Exhibit 1, Mayer-Patel Declaration, paragraph 52.

With respect to claim 3, claim 3 further recites "program code for transmitting, from the first process to the server process, a query as to whether the second process is connected to the computer network." As is discussed in greater detail below with respect to claim 8, the VocalChat references do not disclose querying whether processes are connected to the computer network. Thus, claim 3 is also separately patentable from claim 1. See Exhibit 1, Mayer-Patel Declaration, paragraph 53.

Claims 5 and 6

Claim 5 recites "A. determining the currently assigned network protocol address of the first process upon connection to the computer network" and "C. forwarding the assigned network

protocol address of the first process to the server process upon establishing a communication connection with the server process." As was discussed above with respect to claim 1, the combination of the VocalChat references and RFC 1531 does not disclose either of those elements. Thus, claim 5 and its dependent claim 6 are not rendered obvious by the combination of the VocalChat references and RFC 1531. See Exhibit 1, Mayer-Patel Declaration, paragraph 54.

Claims 8, 9 and 14-18

Claim 8 recites "C. querying the server process to determine if the first callee process is accessible." The Office Action cites the Help file, pgs. 2 and 26, and Network information, page 10, and asserts that "a server can receive[] queries to determine status and information of users." However, the Office Action has not identified what portion of those references teach the claimed "querying." At best, the references teach that a local process reads a "USERS" file or a Connections file. As can be seen from page 4 of the VocalChat Network Information (reproduced below), when the VocalChat system uses the Generic mode, a USERS file is used. See Exhibit 1, Mayer-Patel Declaration, paragraph 55.

2.5. Network parameters in the VocalChat INI files

These are the network parameters in the VocalChat VOCLCHAT.INI and VCSETUP.INI files (under the `NetWork` section).

```
[NetWork]
NetWork=              / description of the selected network
NetWorkUsers=         / user services: NetWare/WinWorkgroups/Generic*
NetWorkProtocol=      / network protocol: IPX/NetBIOS
NetWorkType=          / name of the selected network, for future use
UsersFile=            / path name of users file (when Generic is set)
MyUserName=           / the name of the user (when Generic is set)**
```

* When `Generic` is set, a USERS file is used.
** This line appears only in the VOCALCHAT.INI file of each user.

The VOCLCHAT.INI files are in the windows directory of each user. The VCSETUP.INI file is in the VOCLCHAT directory, where VocalChat was installed, and is used only to supply default values for the different installations.

The USERS file configuration parameter includes a "UsersFile" entry that specifies the "path name of users file (when Generic is set)." However, it is also stated that "The VOCLCHAT.INI files are in the windows directory of each user." Thus, this "UsersFile" entry is a local configuration parameter such that the local VocalChat client reads and writes the USERS file on its own -- without performing the claimed query. See Exhibit 1, Mayer-Patel Declaration, paragraph 55.

Similarly, page 8 of the VocalChat Help file states "If your network type is not NetWare or Windows for Workgroups, the Setup program creates a Connection List file which is used to identify and access users." The Connection List file and the USERS file apparently have the same function. Thus, the identification and access enabled by the Connection List is performed by the local client reading and writing the file itself -- without performing the claimed query. Accordingly, claims 8, 9 and 14-18 are not rendered obvious by the applied combination of references. See Exhibit 1, Mayer-Patel Declaration, paragraph 56.

Objective Evidence of Non-Obviousness

In addition to the reasons set forth above showing that all of the elements of the claims under re-examination are not taught by the applied references, it is respectfully submitted that objective evidence supports a finding that the claims are non-obviousness. Objective indicia of non-obviousness, which include commercial success, licenses showing industry respect, and the failure of others, "provide evidence of how the patented device is viewed by the interested public: not the inventor, but persons concerned with the product in the objective arena of the marketplace." *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *WMS Gaming Inc. v. International Game Tech.*, 184 F.3d 1339, 1359 (Fed. Cir. 1999); *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). Evidence supporting the objective indicia of non-obviousness is set out below.

Commercial Success

NetSpeak's WebPhone, an exemplary embodiment of the '469 patent (see, e.g., col. 4, ll. 44-49), was a commercial success as evidenced by the recognition it received in the industry. WebPhone's commercial success is attributable to the novelty and non-obviousness of the invention. *Demaco Corp. v. F. Von Langsdorff Licensing, Ltd.*, 851 F.2d 1387, 1393 (Fed. Cir. 1988) ("A prima facie case of nexus is generally made out when the patentee shows both that there is commercial success, and that the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent.").

NetSpeak's WebPhone won Internet Telephony's 1998 Product of the Year in the category of Internet Telephony Clients. Exhibit 8, page 6 (N2P-200-00012627).

NetSpeak's WebPhone product also won significant praise when compared to other products in the same timeframe. "WebPhone may well become the killer app that puts to shame

similar offerings from VocalTec (Internet Phone) and Quarterdeck (WebTalk). See Exhibit 6 (N2P-001-00005919).

The importance of the claimed invention can also be seen in its praise by other companies in the industry. In a joint press release of NetSpeak and Durand Communications Network ("Durand"), Durand's president and CEO stated "NetSpeak's WebPhone is hands-down the best PC-voice communications package available in the market today. … We wanted to work with a company whose leading edge technology would add value to our existing MindWire NT CommunityServer by offering unique telephony services so integral to fostering growth within online communities." Exhibit 9, page 1.

NetSpeak's WebPhone was also praised in the Computer Telephony Magazine. The July 1996 Edition included an article on the WebPhone trial version and stated "You've gotta try this Internet telephony package. NetSpeak … makes WebPhone. … Does it work? Yes." Exhibit 10 (N2P-200-00012630).

As set forth in the original Assignee's Amended S-1 Registration form (Exhibit 11), NetSpeak's technology was a commercial success as further evidenced by the investments made in the company. At least three different stock offerings were made which raised millions of dollars for the company. The Amended S-1 Registration form describes on numbered page 19:

> In January and February of 1996, the Company sold 1,204,000 shares of Common Stock at $2.50 per share in a private offering raising $2,992,028 ….
>
> In June 1996, the Company issued 207,679 shares of Common Stock to Creative at a price of $5.05 per share raising $943,698 ….
>
> In August 1996, the Company issued 769,853 shares of Common Stock and the Motorola Warrant to purchase up to an additional 452,855 shares of Common Stock at a price of $5.50 per share for a six year period expiring in August 2002 to Motorola raising $3,993,864….

Later, in 1998, Motorola took an even larger interest in NetSpeak by acquiring an additional 27% of the stock that it did not already own at a cost of $90 million. See Press Release, Exhibit 12 (N2P-200-00012891). See also March 30, 1998 article from Telephony online describing strategic alliance between Motorola and NetSpeak. See Exhibit 13 (N2P-102-00000048).

Also in 1998, the Company issued approximately 1.3 million shares of common stock to Bay Networks for $36.8 million. See Exhibit 14, NetSpeak Form 10-K for the Fiscal Year ending December 31, 1997.

See also, the 8-K related to the acquisition of NetSpeak by Net2Phone. Exhibit 15.

As more fully detailed in NetSpeak's 10-K for Fiscal Year 1997 (Exhibit 14), NetSpeak's communications technology was a commercial success as further evidenced by the strategic alliances it made with "with leaders in various segments of the telecommunications and networking industries," including Siemens (whereby Siemens agrees to market NetSpeak's "IP telephony server products"), Bay Networks (whereby the Company agrees "not to provide its source code to…competitors for a period of three years), Fujitsu and Rockwell International (whereby NetSpeak was "integrating its software into the[se] companies' proprietary hardware platforms"), MCI (see Exhibit 16 announcing that MCI signs contract with NetSpeak to incorporate WebPhone in networkMCI Click'NConnect Web-Based Service) and NTC (whereby NetSpeak would "supply IP telephony products and systems"), and others.

NetSpeak's WebPhone client software products were a commercial success as further evidenced by the number and extent of the channels through which they were sold, including "distribution agreements with over 900 ISPs worldwide." See Exhibit 14, 10-K cited above. Details of the operation of the WebPhone client can be found in Exhibits 17 and 18. For example, Exhibit 17 states "the CS [i.e., connection server] updates the user e-mail address, IP address, and online status fields, and uses them to

perform IP address resolution and track account activation information. … When a user calls … using a WebPhone, the CS is used to resolve the target e-mail address to an IP address." Similarly, Exhibit 18 states "Connection and Information servers are the addresses here at NetSpeak that your WebPhone uses to find and call other parties. …Connection Server: is used when you dial someone by e-mail address. If you try to dial someone by e-mail address, the WebPhone, calls the connection server, matches the desired e-mail address to an IP address, disconnects from the Connection server, and dials the IP address."

Licenses Showing Industry Respect

In connection with Motorola's 1998 investment described above, and as set forth more fully in the NetSpeak Form 10-K for the Fiscal Year 1997 (Exhibit 14), NetSpeak and Motorola entered into a joint development and licensing agreement pursuant to which the two companies would seek to join their technologies to enable Internet Protocol multimedia communications on wireless networks. Under that agreement, Motorola obtained a license to develop RF products using NetSpeak's technology, to include NetSpeak's technology in wireless devices such as cellular phones, pagers, satellite phones and two way radios to support real-time multimedia communications (voice, audio, video, data, etc.), and to manufacture and sell NetSpeak products. See description of NetSpeak's technology at page 6 of Exhibit 14 under the header "NETSPEAK'S CORE COMMUNICATIONS TECHNOLOGY" (reciting, *inter alia*, "allows users to connect to other users in a point-to-point fashion, rather than through an intermediate routing mechanism."). NetSpeak's licenses included a license to the WebPhone product and network address resolution technology, see Exhibit 14, which are commercial embodiments of the patented claims. NetSpeak's success in licensing is attributable to the novelty and non-obviousness of the invention. *Demaco Corp.*, 851 F.2d at 1393.

Failure of Others

The inventions claimed in the '469 Patent resolved the problem of locating a computer process connected to a network, where the computer process was assigned a temporary network address. See, e.g., specification at col. 1, line 67 to col. 2, line 3. Each time a particular computer process connected to the network, it would have a different address. Such addresses were largely a by-product of the near-universal adoption of the Dynamic Host Configuration Protocol ("DHCP"), described in RFC 1531 (Exhibit x0012). DHCP disclosed the dynamic allocation of scarce network addresses and permitted addresses to be reused when a computer process disconnected from the network. As shown in Exhibit x0013 and as discussed above, others, including the developers of the VocalChat references cited by the Request, attempted to resolve the problem of locating a computer process with a dynamically assigned address and failed to suggest the claimed steps using querying.

Recognition in the Patent Literature

The Federal Circuit has left itself open to acknowledging that the patent citations of later patent applicants and examiners can be objective evidence of an earlier patent's nonobviousness. See *In re: Mettke*, 570 F.3d 1356, 1361 (Fed. Cir. 2009). This position is supported by the academic literature. See, e.g., Trajtenberg, Manuel , "A Penny for Your Quotes: Patent Citations and the Value of Innovations," The RAND Journal of Economics, Vol. 21, No. 1 (Spring 1990), pp. 172-187 at 174. ("Thus, if citations keep coming, it must be that the innovation originating in the cited patent had indeed proven to be valuable.") (Exhibit 19.) The '469 patent under re-examination is a divisional of U.S. Patent No. 6,108,704. As shown in Exhibit 20, according to the USPTO's own records, the '704 patent and its continuations and divisionals have been cited in 76 issued patents. This supports an inference that the '469 patent in re-examination advanced the art in a nonobvious way that was neither cumulative of the art that came before it nor predictable in its view.

This inference of nonobviousness is especially compelling over the NetBIOS references. Not one issued patent that cites the patent in re-examination (or one of its related patents) also cites a NetBIOS reference. See Exhibit 21 (including variations on the name for NetBIOS such that it includes RFC 1001 and RFC 1002). This phenomenon is especially significant given that NetBIOS is a well known piece of networking art that has been cited frequently in the patent literature -- 33 times according to the USPTO's records.[3] The assignee respectfully submits that there is a simple explanation for this otherwise highly improbably dichotomy: NetBIOS and the patent in re-examination do not overlap because the scope and content of what they disclose are distinct.

The assignee also notes in this regard that the cover page of U.S. Patent No. 6,389,127, assigned to ICQ Inc., an unrelated company, and entitled "Telephone Status Notification System," references U.S. Patent No. 6,108,704 (of which the patent in re-examination is a continuation-in-part), but does not cite to any of the references submitted in the Request. Their absence from the ICQ patent is especially significant since both NetBIOS and Etherphone are well known pieces of art, and each has been cited frequently in the patent literature—33 times and 135 times, respectively. The assignee respectfully submits that there is a simple explanation for this difference: the references in the Request were not cited by the ICQ patent because they did not teach anything plausibly related to "Status Notification," whereas 6,108,704 was cited because it (and its continuation-in-part, the patent in re-examination) plainly did.

[3] In fact, there are 43 references to NetBIOS if the search includes any of: NetBIOS, RFC 1001, RFC 1002, NBT and NetBT (excluding references to "NBT" in the medical field). See Exhibit 22.

Consequently, in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome and the patentability of the claims subject to re-examination should be indicated as confirmed. An early and favorable action to that effect is respectfully requested.

CHARGE STATEMENT: Deposit Account No. 501860, order no. **2655-0185**.
The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/ Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached.
This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.

CUSTOMER NUMBER 42624	Respectfully submitted, By: / Michael R. Casey / _____ Michael R. Casey, Ph.D. Registration No.: 40,294

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DOCUMENT 2

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MAILED

MAY 10 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/010,422*.

PATENT NO. *6,009,469*.

ART UNIT *3992*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Office Action in Ex Parte Reexamination	Control No. 90/010,422	Patent Under Reexamination 6,009,469	
	Examiner ALEXANDER J. KOSOWSKI	Art Unit 3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

a☒ Responsive to the communication(s) filed on *25 November 2009* . b☒ This action is made FINAL.
c☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☒ Information Disclosure Statement, PTO/SB/08.
3. ☐ Interview Summary, PTO-474.
4. ☐ ____

Part II SUMMARY OF ACTION

1a. ☒ Claims *1-3,5,6,8,9 and 14-18* are subject to reexamination.
1b. ☒ Claims *4,7 and 10-13* are not subject to reexamination.
2. ☐ Claims ___ have been canceled in the present reexamination proceeding.
3. ☒ Claims *1-3,5 and 6* are patentable and/or confirmed.
4. ☒ Claims *8-9,14-18* are rejected.
5. ☐ Claims ___ are objected to.
6. ☐ The drawings, filed on ___ are acceptable.
7. ☐ The proposed drawing correction, filed on ___ has been (7a) ☐ approved (7b)☐ disapproved.
8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All b)☐ Some* c)☐ None of the certified copies have
   1☐ been received.
   2☐ not been received.
   3☐ been filed in Application No. ____.
   4☐ been filed in reexamination Control No. ____.
   5☐ been received by the International Bureau in PCT application No. ____.
   * See the attached detailed Office action for a list of the certified copies not received.
9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. ☐ Other: _____

cc: Requester (if third party requester)

DETAILED ACTION

1) This Office action addresses claims 1-3, 5-6, 8-9, 14-18 of United States Patent Number 6,009,469 (Mattaway et al), for which it has been determined in the Order Granting Ex Parte Reexamination (hereafter the "Order") mailed 3/13/09 that a substantial new question of patentability was raised in the Request for *Ex Parte* reexamination filed on 2/26/09 (hereafter the "Request"). Claims 4, 7, 10-13 are not subject to reexamination. This is a final office action in response to the amendment filed 11/25/09. The rejection of claims 8, 9, 14-18 are maintained below. Amended claims 1-3 and 5-6 are allowable and/or confirmed below.

IDS

2) With regard to the IDS's filed 12/14/09, 12/16/09, 1/26/10, 2/24/10, 3/5/10, 5/6/10:

Where the IDS citations are submitted but not described, the examiner is only responsible for cursorily reviewing the references. The initials of the examiner on the PTO-1449 indicate only that degree of review unless the reference is either applied against the claims, or discussed by the examiner as pertinent art of interest, in a subsequent office action. See Guidelines for Reexamination of Cases in View of In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), 64 FR at 15347, 1223 Off. Gaz. Pat. Office at 125 (response to comment 6).

Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.

Regarding IDS submissions MPEP 2256 recites the following: "Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information."

Accordingly, the IDS submissions have been considered by the Examiner only with the scope required by MPEP 2256, unless otherwise noted.

In addition, that which are not either prior art patents or prior art printed publications have been crossed out so as not to appear reprinted on the front page of the patent.

Claim Rejection Paragraphs

3) ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Issue 1

4) Claims 8-9, 14-15, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable by NetBIOS, further in view of Pinard.

Referring to **(Claim 8)**, NetBIOS teaches in a computer system having a display and capable of executing a process, a method for establishing a point-to-point communication from a caller process to a callee process over a computer network, the caller process capable of generating a user interface and being operatively connected to the callee process and a server process over the computer network (NetBIOS, pg. 356, 357, whereby the system is run on personal computers over TCP/IP networks, personal computers inherently containing a display), the method comprising the steps of: querying the server process to determine if the first callee process is accessible (NetBIOS, pg. 377, 388-389, 446, whereby a query is sent to the NBNS to determine if another node is logged in and discover the nodes IP address); and establishing a point-to-point communication link from the caller process to the first callee process (NetBIOS, pg. 397-400, whereby a point-point communication link is established between end nodes).

However, NetBIOS does not explicitly teach generating a user-interface element representing a first communication line, generating a user interface element representing a first callee process, and establishing the link in response to a user associating the element representing the first callee process with the element representing the first communication line

Pinard teaches a human machine interface for telephone feature invocation which is utilized on a personal computer and allows a user to make telephone calls by moving graphics around a screen. Pinard teaches a user interface element representing a first communication line and callee process (Pinard, Figure 6 and col. 5 lines 23-30), and also teaches clicking and dragging an icon representing a callee from a directory into a call setup icon to establish a call link (Pinard, Figure 3, col. 4 lines 38-51, Figure 6, col. 5 lines 36-37).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilizing the user-interface elements and interactions taught by Pinard in the invention taught by NetBIOS since Pinard teaches that the invention can be used with any system in which a personal computer in conjunction with a server operates (Pinard, col. 2 lines 43-46), since NetBIOS teaches that it can be implemented using different operating systems (NetBIOS, pg. 359), and since examiner notes that both NetBIOS and Pinard relate to communications between at least two users implemented in a computerized environment.

Referring to **(Claim 9)**, NetBIOS teaches the method of claim 8 wherein step C further comprises the steps of: querying the server process as to the on-line status of the first callee process (NetBIOS, pg. 377, 388-389, 446, 393-394, whereby name queries are used to discover if a node is connected and active); and receiving a network protocol address of the first callee

process over the computer network from the server process (NetBIOS, pg. 389, 440, 464-465, whereby the NBNS answers queries with a list of IP addresses of connected nodes).

Referring to **(Claims 14-15 and 17-18)**, NetBIOS teaches the above. However, NetBIOS does not explicitly teach generating a user interface element representing a communication line having a temporarily disabled status; and temporarily disabling the point-to-point communication between the caller process and the first callee process, in response to the user associating the element representing the first callee process with the element representing the communication line having a temporarily disabled status, wherein the element generated represents a communication line on hold status, wherein the display further comprises a visual display, and wherein the user interface is a graphic user interface and the user-interface elements generated in steps A and B are graphic elements.

Pinard teaches a "hard hold" icon to which saller/callees may be dragged to be put on hold status (Pinard, Figure 12, col. 6 lines 36-53), teaches a visual display (Pinard, col. 4 lines 10-11, Figure 2), and teaches a graphical user interface in which the elements are graphic elements (Pinard, Figures 2-16).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilizing the user-interface elements and interactions taught by Pinard in the invention taught by NetBIOS since Pinard teaches that the invention can be used with any system in which a personal computer in conjunction with a server operates (Pinard, col. 2 lines 43-46), since NetBIOS teaches that it can be implemented using different operating systems

(NetBIOS, pg. 359), and since examiner notes that both NetBIOS and Pinard relate to communications between at least two users implemented in a computerized environment.

5) Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable by NetBIOS, further in view of Pinard, further in view of VocalChat User's Guide.

Referring to **(Claim 16)**, NetBIOS teaches the above. However, NetBIOS does not explicitly teach wherein the element generated represents a communication line on mute status.

VocalChat User's Guide teaches the use of a MUTE option on a phone so that a user can talk without being heard by the other user's system (VocalChat User's Guide, pg. 57).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilize an element representing a communication line on MUTE status in the invention taught by NetBIOS and Pinard above since all three references relate to the field of communications over a computer network, since VocalChat and Pinard utilize a computer system for telephony features specifically, and since examiner notes that the use of a MUTE feature in telephone conversations is old and well known in the art.

Issue 2

6) Examiner notes the following will represent the Etherphone references utilized for the rejection below (All considered a single reference as published together):

"Zellweger": An Overview of the Etherphone System and its Applications

"Swinehart": Telephone Management in the Etherphone System

"Terry": Managing Stored Voice in the Etherphone System

7) Claims 8-9, 14-15, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable by Etherphone, further in view of Pinard.

Referring to **(Claim 8)**, Etherphone teaches in a computer system having a display and capable of executing a process, a method for establishing a point-to-point communication from a caller process to a callee process over a computer network, the caller process capable of generating a user interface and being operatively connected to the callee process and a server process over the computer network (Zellweger, pg. 1, 3, Figure 1, Swinehart Figures 1-10), the method comprising the steps of: querying the server process to determine if the first callee process is accessible (Swinehart, pg. 2, 4, Zellweger, pg. 5, whereby a query is transmitted to determine the location of a second Etherphone by contacting a server); and establishing a point-to-point communication link from the caller process to the first callee process (Swinehart, pg. 2, Zellweger, Figure 4, whereby voice datagrams are transmitted directly among participants).

However, Etherphone does not explicitly teach generating a user-interface element representing a first communication line, generating a user interface element representing a first callee process, and establishing the link in response to a user associating the element representing the first callee process with the element representing the first communication line

Pinard teaches a human machine interface for telephone feature invocation which is utilized on a personal computer and allows a user to make telephone calls by moving graphics around a screen. Pinard teaches a user interface element representing a first communication line and callee process (Pinard, Figure 6 and col. 5 lines 23-30), and also teaches clicking and

dragging an icon representing a callee from a directory into a call setup icon to establish a call link (Pinard, Figure 3, col. 4 lines 38-51, Figure 6, col. 5 lines 36-37).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilizing the user-interface elements and interactions taught by Pinard in the invention taught by Etherphone since Pinard teaches that the invention can be used with any system in which a personal computer in conjunction with a server operates (Pinard, col. 2 lines 43-46), and since examiner notes that both Etherphone and Pinard relate to communications between at least two users implemented in a computerized environment.

Referring to **(Claim 9)**, Etherphone teaches the method of claim 8 wherein step C further comprises the steps of: querying the server process as to the on-line status of the first callee process (Swinehart, pg. 2, 4, Zellweger, pg. 5, whereby queries are transmitted to Voice Control Server); and receiving a network protocol address of the first callee process over the computer network from the server process (Swinehart, pg. 2, whereby the server sends the network protocol address of the logged in user to caller process on request).

Referring to **(Claims 14-15)**, Etherphone teaches the above. However, Etherphone does not explicitly teach generating a user interface element representing a communication line having a temporarily disabled status; and temporarily disabling the point-to-point communication between the caller process and the first callee process, in response to the user associating the element representing the first callee process with the element representing the communication

line having a temporarily disabled status, and wherein the element generated represents a communication line on hold status.

Pinard teaches a "hard hold" icon to which saller/callees may be dragged to be put on hold status (Pinard, Figure 12, col. 6 lines 36-53).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilizing the user-interface elements and interactions taught by Pinard in the invention taught by Etherphone since Pinard teaches that the invention can be used with any system in which a personal computer in conjunction with a server operates (Pinard, col. 2 lines 43-46), and since examiner notes that both Etherphone and Pinard relate to communications between at least two users implemented in a computerized environment.

Referring to **(Claims 17-18)**, Etherphone teaches wherein the display further comprises a visual display (Swinehart, Fig. 1-10, Zellweger, Fig. 3-4, whereby computer displays are considered visual displays), and wherein the user interface is a graphic user interface and the user-interface elements generated in steps A and B are graphic elements (Swinehart, Fig. 1-10, Zellweger, Fig. 3-4, whereby a GUI is used showing graphic elements of call display).

8) Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable by Etherphone, further in view of Pinard, further in view of VocalChat User's Guide.

Referring to **(Claim 16)**, Etherphone teaches the above. However, Etherphone does not explicitly teach wherein the element generated represents a communication line on mute status.

VocalChat User's Guide teaches the use of a MUTE option on a phone so that a user can talk without being heard by the other user's system (VocalChat User's Guide, pg. 57).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilize an element representing a communication line on MUTE status in the invention taught by Etherphone and Pinard above since all three references relate to the field of communications over a computer network, since VocalChat and Pinard utilize a computer system for telephony features specifically, and since examiner notes that the use of a MUTE feature in telephone conversations is old and well known in the art.

Response to Arguments

9) In response to the amendment filed 11/25/09, some rejections are sustained as noted above, and others have been withdrawn. The following aspects of the current prosecution will be addressed as noted below:

a) VocalChat are not printed publications.

b) The 1.132 Declaration

c) Objective evidence of non-obviousness

d) Withdrawn rejections

e) Maintained rejections

a) The amendment submitted 11/25/09 includes arguments that the VocalChat references are not printed publications. The Patent Owner (PO) cites exhibit L of the Request (the declaration of Alon Cohen) as the only evidence provided by PO that the VocalChat references

are printed publications. Examiner notes that the Alon Cohen declaration fails to comply with 37 C.F.R. 1.68, including not setting forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true. Therefore, PO's arguments questioning the declaration as well as whether printed publication status has been established as set forth under statute are found persuasive. Examiner therefore withdraws all rejections utilizing the VocalChat references.

b) Examiner notes that all evidence presented has been considered in its entirety, including both PO's arguments, including secondary considerations, as well as the 1.132 Declaration submitted by expert Ketan Mayer-Patel.

c) Examiner notes that PO's arguments regarding objective evidence of non-obviousness, including commercial success and failure of others have been considered, however no nexus has been provided between the claimed invention and the submitted evidence as required by at least MPEP 716.03. Therefore, this evidence is not found persuasive.

d) In light of PO's arguments and amendments filed 11/25/09, as well as the declaration of expert Mayer-Patel, examiner withdraws the rejections of claims 1-3 and 5-6. Examiner finds the presented arguments to be persuasive.

With regard to the NetBios rejection, examiner agrees with declarant Mayer-Patel that bringing dynamic addressing into a NetBIOS type system would create a new set of obstacles that would need to be solved that are not obvious in view of the combination of references.

With regard to the rejection under Etherphone, examiner notes that a similar argument applies to Etherphone as to Netbios, namely that combining the system with dynamic addressing would create new, non obvious obstacles to overcome.

A reasons for confirmation for the claims discussed above will follow in a subsequent office action.

e) The rejection of claims 8, 9, 14-18 are maintained in view of NetBIOS and Etherphone.

With regard to the rejection of claim 8 under NetBIOS, maintained above:

Examiner first notes that claim 8 does not require any dynamic addressing limitations, unlike claims 1 and 5. Therefore, any arguments directed towards a combination with RFC 1531 do not apply to claim 8.

PO argues with regard to claim 8 that NetBIOS does not teach "determining if the first callee process is accessible". PO argues that having an "active name" is not synonymous with "determining if a first callee process is accessible", and that an "active name" simply refers to "a name that has been registered and that has not yet been de-registered". Examiner first notes that the term "accessible" is not specifically defined in PO's specification. Therefore, under a broadest reasonable interpretation, this limitation could simply mean that a user is registered with the system. In addition, examiner notes that PO's specification at col. 5 lines 39-44 teaches that the on-line status information may not always be current, and may be updated, for example, only every 24 hours based on operator configuration. Assuming a user being "accessible" is comparable to that user being "on-line", then the database of NetBIOS which contains active name information reads on claim 8, whether or not the user data is current.

PO also argues that NetBIOS does not teach "that the active status of a name in the NetBIOS server is an indication of the active status of the owner of that name". However, examiner notes that claim 8 only requires connecting to a callee process, not necessarily to a particular name.

With regard to the rejection under Etherphone, maintained above:

PO argues with regard to claim 8 that if the Etherphone are "participants", then "there is no indication that the combination meets the limitation of 'the caller process capable of generating a user interface'". Examiner notes that PO appears to be arguing that the Etherphones are not capable of generating user interfaces by themselves. If this is the case, examiner points to Zellweger, page 2. Zellweger teaches that workstations work in combination with the Etherphones and provided the enhanced user interface functionality. The Etherphones are only used separately to split up voice-processing functionality due to hardware processing requirements. Therefore, the caller process is a function of the workstation in combination with the Etherphone.

Therefore, the current arguments regarding claims 8-9 and 14-18 are not persuasive, and the rejections above are maintained.

Conclusion

THIS ACTION IS MADE FINAL.

Extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings. The provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings "will be conducted with special dispatch within the Office."

Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee set forth in 37 CFR 1.17(g). The mere filing of a request will not effect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted. In no event however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See MPEP § 2265.

All correspondence relating to this ex parte reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:

Mail Stop Ex Parte Reexam

ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand to:

Customer Service Window
Randolph Building
401 Dulany St.
Alexandria, VA 22314

By EFS-Web:

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/Alexander J Kosowski/

ESK

Primary Examiner, Art Unit 3992

DOCUMENT 3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION OF:	Attorney Docket: 2655-0185
Net2Phone, Inc. (Patent No. 6,009,469)	Group Art Unit: 3992
Control No.: 90/010,422	Examiner: KOSOWSKI, Alexander
Issue Date: December 28, 1999	Date: July 12, 2010
Title: **GRAPHIC USER INTERFACE FOR INTERNET TELEPHONY APPLICATION**	Confirmation No.: 6565

RESPONSE TO FINAL REJECTION IN A RE-EXAMINATION

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated May 10, 2010, the Assignee hereby requests the automatic one-month extension of time proscribed in MPEP 2265 for "a first timely response to an Office Action" after a final rejection in a re-examination and submits:

Remarks/Arguments beginning on page 2 of this paper.

Re-Examination of Patent No. 6,009,469
Control No.: 90/010,422
Filed: February 24, 2009
Reply to Office Action of May 10, 2010

REMARKS/ARGUMENTS

Favorable reconsideration, in light of the following discussion, is respectfully requested. In the outstanding Office Action, a number of previous grounds for rejection were withdrawn, the patentability of claims 1-3, 5 and 6 was confirmed, and claims 8, 9 and 14-18 were again rejected under 35 U.S.C 103(a) as follows:

1. Claims 8, 9, and 14-18 were alleged to be obvious over the combination of NetBIOS and Pinard (U.S. Patent No. 5,533,110), either alone or in combination with the VocalChat User's Guide; and
2. Claims 8, 9, and 14-18 were alleged to be obvious over the combination of the Etherphone papers in view of Pinard, either alone or in combination with the VocalChat User's Guide.

Each of those rejections is respectfully traversed for the reasons set forth below. Reference is made throughout this response to the Second Declaration Of Ketan Mayer-Patel Under 37 C.F.R. 1.132 (hereinafter the "Second Mayer-Patel Declaration") attached hereto as Exhibit 1. The Second Mayer-Patel Declaration is submitted herewith in response to the new argument in the final Office Action that "under a broadest reasonable interpretation, this [accessible] limitation could simply mean that a user is registered with the system." As this argument was not presented in the first Office Action, the Assignee was not able to know that such a position needed to be addressed. Accordingly, as the corresponding evidence could not have been presented earlier, it is respectfully requested that the Second Mayer-Patel Declaration be admitted into the record.

The Rejection of Claim 16 Over the Combination of the VocalChat User's Guide and Either (1) the Combination of NetBIOS and Pinard or (2) the Combination of the EtherPhone Papers and Pinard

With respect to claim 16 and the combination of NetBIOS, Pinard and the VocalChat User's Guide, the Office Action alleges, in section 5, that the "VocalChat User's Guide teaches

the use of a MUTE option on a phone so that a user can talk without being heard by the other user's system." Similarly, with respect to claim 16 and the combination of EtherPhone, Pinard and the VocalChat User's Guide, the Office Action alleges, in section 8, that the "VocalChat User's Guide teaches the use of a MUTE option on a phone so that a user can talk without being heard by the other user's system." However, as noted in section 9a of the Office Action, the use of this reference was withdrawn in light of the defect(s) in the Alon Cohen declaration. Specifically, the Office Action states "Examiner therefore withdraws all rejections utilizing the VocalChat references." Thus, the rejections of claim 16 are believed to be defective, and the rejections of claim 16 should be withdrawn.

The Rejection of Claims 8, 9, 14, 15, 17 and 18 Over the Combination of NetBIOS and Pinard

Claim 8

In addition to the reasons set forth in the previous response (which are incorporated herein by reference), the Assignee further submits the additional arguments set forth below for the patentability of claim 8 and its dependent claims.

With respect to the limitation of "determin[ing] if the first callee process is accessible," the Assignee previously argued that the Office Action had not shown that such a limitation was taught by NetBIOS. In section 9e, the Office Action now alleges that "under a broadest reasonable interpretation, this [accessible] limitation could simply mean that a user is registered with the system." However, users are not registered with a NetBIOS system, names are. Moreover, the registration of a name does not mean that a "first callee process is accessible."

As a preliminary matter, even the dictionary definitions of "accessible" and "registered" show that they are not synonymous with each other. See Exhibit 1 to the Second Mayer-Patel Declaration. According to the definitions, a system such as NetBIOS would indicate whether a name is "registered" (e.g., recorded or listed), but it would not indicate that a callee process is accessible (e.g., easy to reach or use or easily approached or entered). See Second Mayer-Patel Declaration, paragraphs 6 and 7.

NetBIOS explicitly provides for permanent registration of names. As described in Section 15.1.3.2 of RFC 1001, "Names held by an NBNS are given a lifetime during name registration." The same section further states "The lifetime period is established through a simple negotiation mechanism during name registration: In the name registration request, the end-node proposes a lifetime value or ***requests an infinite lifetime***. The NBNS places an actual lifetime value into the name registration response. The NBNS is ***always allowed to respond with an infinite actual period***." (Emphasis added.) Thus, in any number of cases, the NBNS may demand an infinite lifetime for names registered by nodes, with the effect that the NBNS would deliberately preserve the name and address information registered by a node permanently on the NBNS even though the node had stopped using the name or had gone off-line altogether years earlier. Therefore, the correspondence between a name and an IP address is not indicative of a first callee process being accessible. See Second Mayer-Patel Declaration, paragraph 8. This deliberate name preservation feature of NetBIOS teaches away from the limitation of a callee processing being accessible.

Moreover, the node requesting information on whether a name is registered does not receive an indication from the NBNS that the registered name corresponds to a name that has been given an infinite lifetime by the NBNS and could therefore be completely out-of-date. Section 4.2.13 of RFC 1002 describes the Positive Name Query Response (reproduced below) that is returned when a name has been registered, and there is no indication that the returned address is for a name associated with an identified lifetime, let alone an infinite lifetime:

Re-Examination of Patent No. 6,009,469
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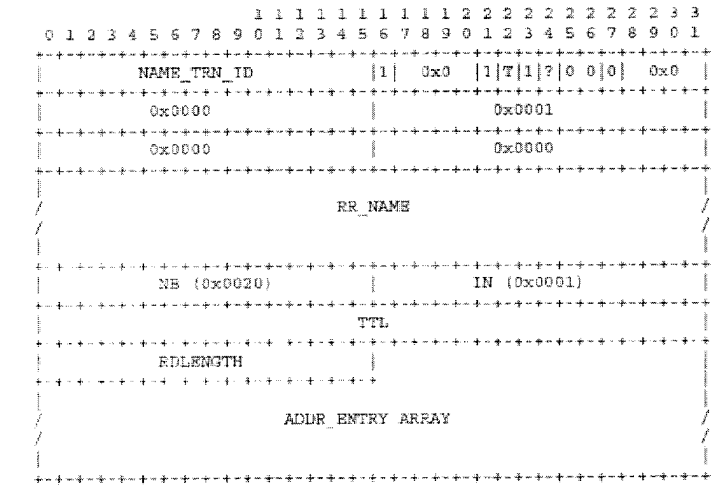
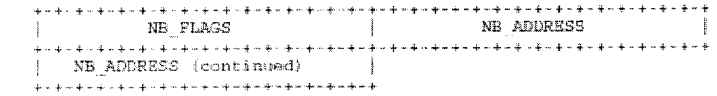
4.2.13. POSITIVE NAME QUERY RESPONSE



The ADDR_ENTRY ARRAY a sequence of zero or more ADDR_ENTRY records. Each ADDR_ENTRY record represents an owner of a name. For group names there may be multiple entries. However, the list may be incomplete due to packet size limitations. Bit 22, "T", will be set to indicate truncated data.

Each ADDR_ENTRY has the following format:

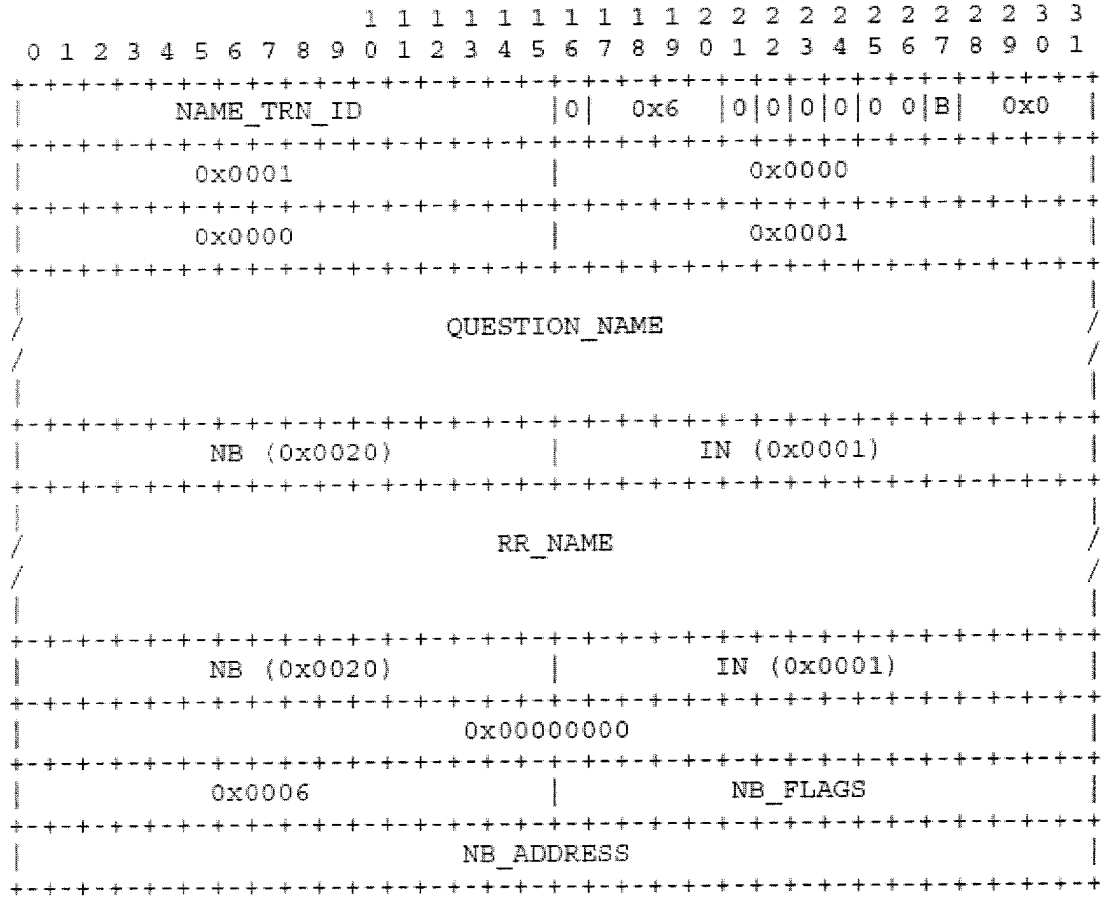


See Second Mayer-Patel Declaration, paragraph 9.

Also, there is no indication in the Positive Name Query Response disclosed by NetBIOS that the returned address necessarily corresponds with a computer or process that was ever accessible as asserted by the pending office action. For example, a first user could manually enter a dummy address in the NB_Address field associated with a claimed name that he wanted to register and still be compliant with the NetBIOS protocol standard since queries by other users for that name are "not necessarily a prelude to NetBIOS session establishment or NetBIOS datagram transmission." Section 15.3.1. See Second Mayer-Patel Declaration, paragraph 10.

RFC 1002 further shows that a name registration is not an indication of whether "a first callee process is accessible" given that a NetBIOS server may refuse to release registered names for policy reasons. As described in Section 4.2.9, a node may request that a name be released using a Name Release Request (reproduced below).

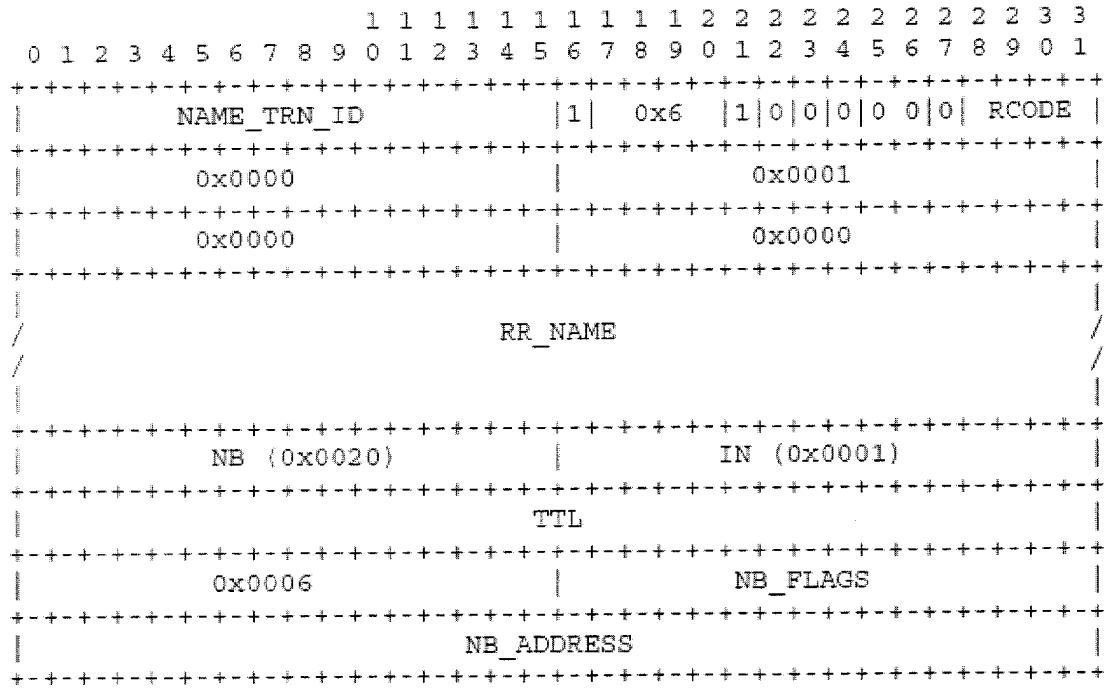
4.2.9. NAME RELEASE REQUEST & DEMAND



See Second Mayer-Patel Declaration, paragraph 11.

In response, as shown in Section 4.2.11, a server can generate a Negative Name Release Response, as shown below.

4.2.11. NEGATIVE NAME RELEASE RESPONSE



The RCODE field indicates the response from the server. One such response is RFS_ERR which is described as follows:

RFS_ERR	0x5	Refused error. For policy reasons server will not release this name from this host.

See Second Mayer-Patel Declaration, paragraph 12.

Thus, the registration of a name does not indicate that a corresponding process is accessible. Accordingly, the limitation of "determin[ing] if the first callee process is accessible" is not taught by NetBIOS. Since this limitation is not alleged to be taught by Pinard, the combination of references fails to teach this limitation that is not taught by the references individually. See Second Mayer-Patel Declaration, paragraph 13.

Claim 8 also recites "generating a user interface element representing a first callee process" and querying "the server process to determine if the first callee process is accessible." The Office Action admits that NetBIOS "does not explicitly teach ... generating a user interface representing a first callee process." In order to address this admitted deficiency, the Office Action alleges that "Pinard teaches a user interface element representing a first communication line and callee process (Pinard, Figure 6 and col. 5 lines 23-30), and also teaches clicking and dragging an icon representing a callee from a directory into a call setup icon to establish a call link." However, both the portion of Pinard in col. 5 cited by the Office Action and the Office Action itself show that the Office Action's assertion is incorrect.

Col. 5, lines 23-30 of Pinard states:

> Now what the local user Debbie sees on the screen is a call in progress between her and Mary, by noting the Debbie and Mary icons 13 and 29 in the call icon 29. She also sees a ghost 13A of her icon (indicating inactive) in the same call icon as John 23, which indicates that John's line is on hold. If desired, the John icon can be made to flash or change colors at some frequency (which could increase, if desired, with increase in time).

Nowhere in that section does it state that any of the icons are representative of a "callee process." Instead, as described in the Office Action, the icon represents "a callee from a directory" which does not inherently have a corresponding process. In fact, col. 4, lines 27-31, of Pinard states "The directory can be formed of alphanumeric characters, designating the names of persons listed in the directory (as shown), or the names and telephone numbers, or images of the faces of the persons listed in the directory, or combinations of the above." Thus, Pinard is directed to using a conventional telephone number and not a process.

As further described in col. 4, lines 43-48:

> The application software program then creates an icon 21 representing the party to be called (i.e. John) and places it with his name in the call setup icon. It looks up the directory number of John from directory (if it had not been typed in

> by the local subscriber), and causes the server to dial John's telephone number. As soon as John answers the call, the application software program changes the call setup icon to a call icon designated as 23, and establishes a new call setup icon 24 spaced from the icon 23.

The fact that the server that dials John's telephone number is a "server [that] contains telephone interface circuits 8, conference digital signal processing circuits 9, dialing circuits, trunk circuits, etc." (Pinard, col. 3, last paragraph) is also indicative that Pinard is not describing "generating a user interface element representing a first callee process." Thus, neither Pinard nor NetBIOS nor their combination teach "generating a user interface element representing a first callee process." Accordingly, the patentability of claim 8 and its dependent claims should be confirmed.

No Motivation to Combine the References as in Claims 8, 9, 14, 15, 17 and 18

The Office Action alleges that:

> it would have been obvious to one skilled in the art at the time the invention was made to utiliz[e] the user-interface elements and interactions taught by Pinard in the inventions taught by NetBIOS since Pinard teaches that the invention can be used in any system in which a personal computer in conjunction with a server operates..., since NetBIOS teaches that it can be implemented using different operating systems ..., and since examiner notes that both NetBIOS and Pinard relate to communications between at least two users implemented in a computerized environment.

The Office Action, however, provides no evidence to support this allegation. For example, the Office Action does not point to a problem identified in the art which was known to exist in one reference and for which the second references was the solution. Moreover, just because two

references could be combined does not mean that one of ordinary skill in the art would have been motivated to do so absent the teachings in the patentee's specification.

In addition, the fact that NetBIOS allegedly "teaches that it can be implemented using different operating systems" does not mean that NetBIOS should be combined with other, ***different*** systems. At best, it is an indication that the ***same*** unmodified services could be available under different operating systems.

Moreover, the use of a personal computer with "a server" is not a general discussion in col. 2 of Pinard, and the cited portion of col. 2 is taken out of context. That section states "Once the present invention is understood, it will be also understood that it is not restricted for use with those systems, but can be used with any system in which a telephony application on a personal computer or personal computer in conjunction with a server operates." Thus, it is the telephony application that can be used with a server, as is shown in, for example, figure 1 of Pinard. The cited section therefore is not an invitation to combine other services on other servers with Pinard but rather an indication that the telephony services can be implemented on a server instead of on the personal computer directly. Moreover, the server of Pinard is not a generic server but rather a "server [that] contains telephone interface circuits 8, conference digital signal processing circuits 9, dialing circuits, trunk circuits, etc." (Pinard, col. 3, last paragraph) which the Office Action has not shown to be relevant to a NetBIOS environment.

The last alleged motivation is that "both NetBIOS and Pinard relate to communications between at least two users implemented in a computerized environment"; however, this is incorrect (the callee in Pinard used a conventional telephone and need not have been implemented in a computerized environment), and it provides no evidence that the applied references are sufficiently related that one of ordinary skill in the art would have been motivated to combine them. The assertion is tantamount to a declaration that one of ordinary skill in the art would have been motivated to combine all computerized communication systems without regard for their use. Such a position has no support in the law. Accordingly, the patentability of claim 8 and its dependent claims should be confirmed.

The Rejection of Claims 8, 9, 14, 15, 17 and 18 Over the Combination of the Etherphone Papers in view of Pinard

Claim 8

Claim 8 recites "generating a user interface element representing a first callee process" and querying "the server process to determine if the first callee process is accessible." The Office Action admits that EtherPhone "does not explicitly teach ... generating a user interface representing a first callee process." In order to address this admitted deficiency, the Office Action alleges that "Pinard teaches a user interface element representing a first communication line and callee process (Pinard, Figure 6 and col. 5 lines 23-30), and also teaches clicking and dragging an icon representing a callee from a directory into a call setup icon to establish a call link." However, both the portion of Pinard in col. 5 cited by the Office Action and the Office Action itself show that the Office Action's assertion is incorrect.

Col. 5, lines 23-30 of Pinard states:

> Now what the local user Debbie sees on the screen is a call in progress between her and Mary, by noting the Debbie and Mary icons 13 and 29 in the call icon 29. She also sees a ghost 13A of her icon (indicating inactive) in the same call icon as John 23, which indicates that John's line is on hold. If desired, the John icon can be made to flash or change colors at some frequency (which could increase, if desired, with increase in time).

Nowhere in that section does it state that any of the icons are representative of a "callee process." Instead, as described in the Office Action, the icon represents "a callee from a directory" which does not inherently have a corresponding process. In fact, col. 4, lines 27-31, of Pinard states "The directory can be formed of alphanumeric characters, designating the names of persons listed in the directory (as shown), or the names and telephone numbers, or images of the faces of

the persons listed in the directory, or combinations of the above." Thus, Pinard is directed to using a conventional telephone number and not a process.

As further described in col. 4, lines 43-48:

> The application software program then creates an icon 21 representing the party to be called (i.e. John) and places it with his name in the call setup icon. It looks up the directory number of John from directory (if it had not been typed in by the local subscriber), and causes the server to dial John's telephone number. As soon as John answers the call, the application software program changes the call setup icon to a call icon designated as 23, and establishes a new call setup icon 24 spaced from the icon 23.

The fact that the server that dials John's telephone number is a "server [that] contains telephone interface circuits 8, conference digital signal processing circuits 9, dialing circuits, trunk circuits, etc." (Pinard, col. 3, last paragraph) is also indicative that Pinard is not describing "generating a user interface element representing a first callee process." Thus, neither Pinard nor EtherPhone nor their combination teach "generating a user interface element representing a first callee process." Accordingly, the patentability of claim 8 and its dependent claims should be confirmed.

No Motivation to Combine the References as in Claims 8, 9, 14, 15, 17 and 18

The Office Action alleges that:

> it would have been obvious to one skilled in the art at the time the invention was made to utiliz[e] the user-interface elements and interactions taught by Pinard in the invention taught by EtherPhone since Pinard teaches that the invention can be used in any system in which a personal computer in conjunction with a server operates..., and since examiner notes that both EtherPhone and Pinard relate to communications between at least two users implemented in a computerized environment.

The Office Action, however, provides no evidence to support this allegation. For example, the Office Action does not point to a problem identified in the art which was known to exist in one reference and for which the second references was the solution. Moreover, just because two references could be combined does not mean that one of ordinary skill in the art would have been motivated to do so absent the teachings in the patentee's specification.

Moreover, the use of a personal computer with "a server" is not a general discussion in col. 2 of Pinard, and the cited portion of col. 2 is taken out of context. That section states "Once the present invention is understood, it will be also understood that it is not restricted for use with those systems, but can be used with any system in which a telephony application on a personal computer or personal computer in conjunction with a server operates." Thus, it is the telephony application that can be used with a server, as is shown in, for example, figure 1 of Pinard. The cited section therefore is not an invitation to combine other services on other servers with Pinard but rather an indication that the telephony services can be implemented on a server instead of on the personal computer directly.

The last alleged motivation is that "both EtherPhone and Pinard relate to communications between at least two users implemented in a computerized environment"; however, this is incorrect (the callee in Pinard used a conventional telephone and need not have been implemented in a computerized environment), and it provides no evidence that the applied references are sufficiently related that one of ordinary skill in the art would have been motivated to combine them. The assertion is tantamount to a declaration that one of ordinary skill in the art would have been motivated to combine all computerized communication systems without regard for their use. Such a position has no support in the law. Accordingly, the patentability of claim 8 and its dependent claims should be confirmed.

Consequently, in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome and the patentability of the claims subject to re-examination should be indicated as confirmed. An early and favorable action to that effect is respectfully requested.

CHARGE STATEMENT: Deposit Account No. 501860, order no. **2655-0185.**
The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/ Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached. **This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.**

CUSTOMER NUMBER 42624	Respectfully submitted, By: / Michael R. Casey / _____ Michael R. Casey, Ph.D. Registration No.: 40,294
Davidson Berquist Jackson & Gowdey LLP 4300 Wilson Blvd., 7th Floor, Arlington, Virginia 22203 Main: (703) 894-6400 • FAX: (703) 894-6430	

Re-Examination of Patent No. 6,009,469
Control No.: 90/010,422
Filed: February 24, 2009
Reply to Office Action of May 10, 2010

CERTIFICATE OF SERVICE

The undersigned hereby certifies that, on July 12, 2010, the RESPONSE TO FINAL REJECTION IN A RE-EXAMINATION filed in Re-examination Control No. 90/010,422 was served by U.S. First Class Mail, postage pre-paid, on Requestor as follows:

Blakely, Sokoloff, Taylor & Zafman LLP
1279 Oakmead Parkway
Sunnyvale, CA 94085-4040

/ Michael R. Casey /

Michael R. Casey, Ph.D.

EXHIBIT 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION OF:
Net2Phone, Inc. (Patent No. 6,009,469)
Control No.: 90/010,422
Issue Date: December 28, 1999
Title: **GRAPHIC USER INTERFACE FOR INTERNET TELEPHONY APPLICATION**

Attorney Docket: 2655-0185
Group Art Unit: 3992
Examiner: KOSOWSKI, Alexander
Confirmation No.: 6565

SECOND DECLARATION OF KETAN MAYER-PATEL UNDER 37 C.F.R. 1.132

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. INTRODUCTION

1. I am the same Ketan Mayer-Patel that filed a Declaration in response to the first Office Action in the re-examination of U.S. Patent No. 6,009,469 (hereinafter "the '469 patent").

2. I have reviewed the outstanding Office Action dated May 10, 2010.

3. I understand that claims 8, 9, and 14-18 were alleged to be obvious over the combination of NetBIOS and Pinard (U.S. Patent No. 5,533,110), either alone or in combination with the VocalChat User's Guide, and claims 8, 9, and 14-18 were alleged to be obvious over the combination of the Etherphone papers in view of Pinard, either alone or in combination with the VocalChat User's Guide.

4. I understand that in response to evidence presented in my first Declaration the Office Action now alleges "under a broadest reasonable interpretation, this [accessible] limitation could simply mean that a user is registered with the system." As this argument was not presented in the first Office Action, I was not able to know that such a position needed to be addressed.

5. I do not believe that one of ordinary skill in the art at the time the invention was made would have believed that the definitions proposed by the Office Action are proper -- even under a "broadest reasonable interpretation" standard.

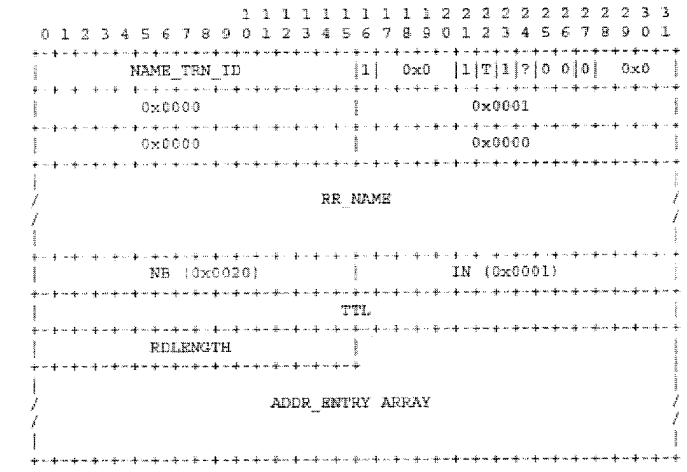
6. The dictionary definitions of "accessible" and "registered" show that they are not synonymous with each other. See Exhibit 1 attached hereto. According to the definitions, a system such as NetBIOS would indicate whether a name is "registered" (e.g., recorded or listed), but it would not indicate that a callee process is accessible (e.g., easy to reach or use or easily approached or entered).

7. Accordingly, I do not agree that "under a broadest reasonable interpretation, this [accessible] limitation could simply mean that a user is registered with the system."

8. In fact, NetBIOS explicitly provides for permanent registration of names. As described in Section 15.1.3.2 of RFC 1001, "Names held by an NBNS are given a lifetime during name registration." The same section further states "The lifetime period is established through a simple negotiation mechanism during name registration: In the name registration request, the end-node proposes a lifetime value or ***requests an infinite lifetime***. The NBNS places an actual lifetime value into the name registration response. The NBNS is always allowed to respond with an infinite actual period." (Emphasis added.) Thus, in any number of cases, the NBNS may demand an infinite lifetime for names registered by nodes, with the effect that the NBNS would deliberately preserve the name and address information registered by a node permanently on the NBNS even weeks, months or years after the node had stopped using the name or had gone off-line altogether. Therefore, the correspondence between a name and an IP address is not indicative that a first callee process is accessible.

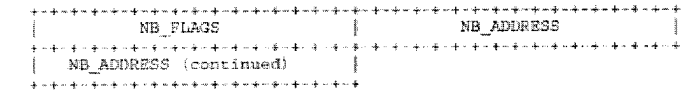
9. Moreover, the node requesting information on whether a name is registered does not receive an indication from the NBNS that the registered name corresponds to a name that has been given an infinite lifetime and could therefore be completely out-of-date. Section 4.2.13 of RFC 1002 describes the Positive Name Query Response (reproduced below) that is returned when a name has been registered, and there is no indication that the returned address is for a name associated with an identified lifetime, let alone an infinite lifetime.

4.2.13 POSITIVE NAME QUERY RESPONSE



The ADDR_ENTRY ARRAY a sequence of zero or more ADDR_ENTRY records. Each ADDR_ENTRY record represents an owner of a name. For group names there may be multiple entries. However, the list may be incomplete due to packet size limitations. Bit 22, "T", will be set to indicate truncated data.

Each ADDR_ENTRY has the following format:



10. In addition, there is no indication in the Positive Name Query Response disclosed by NetBIOS that the returned address necessarily corresponds with a computer or process that was ever accessible as asserted by the pending office action. For example, a first user could manually enter a dummy address in the NB_Address field associated with a claimed name that he wanted to register and still be compliant with the NetBIOS protocol standard since queries by other users for that name are "not necessarily a prelude to NetBIOS session establishment or NetBIOS datagram transmission." Section 15.3.1.

11. Furthermore, RFC 1002 further shows that a name registration is not an indication of whether a first callee process is accessible since a NBNS can refuse to release registered names for policy reasons. As described in Section 4.2.9, a node may request that a name be released using a Name Release Request (reproduced below).

Re-Examination of Patent No. 6,009,469
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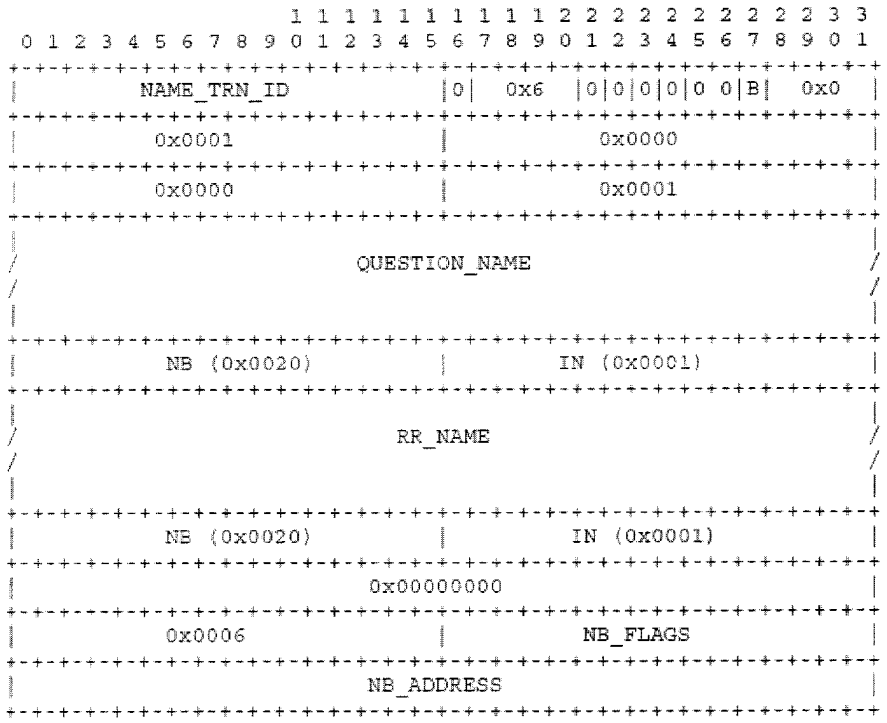
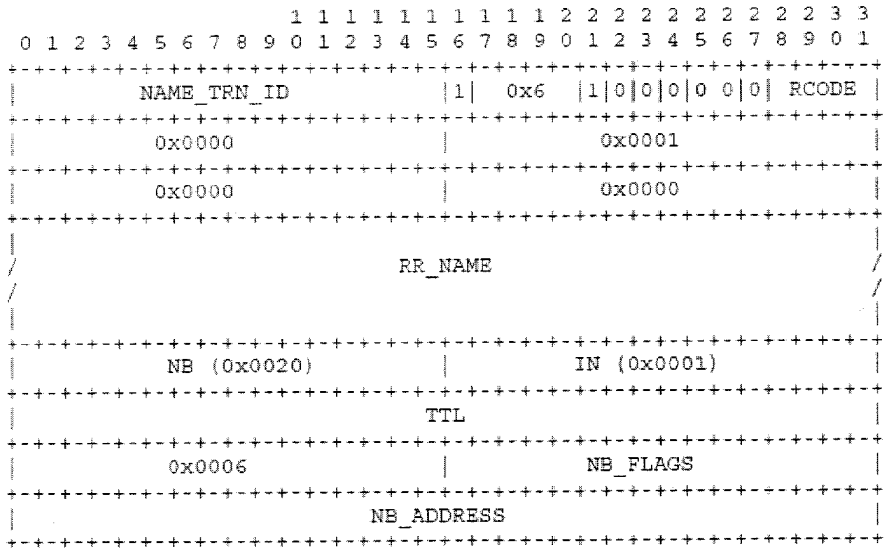
Filed: February 24, 2009
Second Declaration of Ketan Mayer-Patel under 37 C.F.R. 1.132

4.2.9. NAME RELEASE REQUEST & DEMAND



12. In response, as shown in Section 4.2.11, a server can generate a Negative Name Release Response, as shown below.

4.2.11. NEGATIVE NAME RELEASE RESPONSE



The RCODE field indicates the response from the server. One such response is RFS_ERR which is described as follows:

RFS_ERR	0x5	Refused error. For policy reasons server will not release this name from this host.

13. Thus, the registration of a name does not indicate that NetBIOS discloses that a "first callee process is accessible."

Re-Examination of Patent No. 6,009,469
Control No.: 90/010,422
Filed: February 24, 2009
Second Declaration of Ketan Mayer-Patel under 37 C.F.R. 1.132

14. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: July 12, 2010

Ketan Mayer-Patel, Ph.D.

DOCUMENT 4

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

EWIN H. TAYLOR
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SUNNYVALE, CA 94085-4040

Date: MAILED

JUL 20 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010422
PATENT NO. : 6009469
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Ex Parte Reexamination Advisory Action *Before the Filing of an Appeal Brief*	**Control No.** 90/010,422	**Patent Under Reexamination** 6,009,469	
	Examiner ALEXANDER J. KOSOWSKI	**Art Unit** 3992	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE PROPOSED RESPONSE FILED *12 July 2010* FAILS TO OVERCOME ALL OF THE REJECTIONS IN THE FINAL REJECTION MAILED *10 May 2010*.

1. ☒ Unless a timely appeal is filed, or other appropriate action by the patent owner is taken to overcome all of the outstanding rejection(s), this prosecution of the present *ex parte* reexamination proceeding WILL BE TERMINATED and a Notice of Intent to Issue *Ex Parte* Reexamination Certificate will be mailed in due course. Any finally rejected claims, or claims objected to, will be CANCELLED.

   THE PERIOD FOR RESPONSE IS EXTENDED TO RUN 4 MONTHS FROM THE MAILING DATE OF THE FINAL REJECTION. Extensions of time are governed by 37 CFR 1.550(c).

NOTICE OF APPEAL

2. ☐ An Appeal Brief is due two months from the date of the Notice of Appeal filed on . to a void dismissal of the appeal. See 37 CFR 41.37(a). Extensions of time are governed by 37 CFR 1.550(c). See 37 CFR 41.37(e).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final action, but prior to the date of filing a brief, will not be entered because:
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____ (See 37 CFR 1.116 and 41.33(a)).
4. ☐ Patent owner's proposed response filed ___has overcome the following rejection(s): _____
5. ☐ The proposed new or amended claim(s) ___would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☐ For purposes of appeal, the proposed amendment(s) a)☐ will not be entered, or b)☐ will be entered and an explanation of how the new or amended claim(s) would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) patentable and/or confirmed: _____
   Claim(s) objected to: _____
   Claim(s) rejected: _____
   Claim(s) not subject to reexamination: _____

AFFIDAVIT OR OTHER EVIDENCE

7. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because patent owner failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
8. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence fails to overcome all rejections under appeal and/or appellant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
9. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

10. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.
11. ☐ Note the attached Information Disclosure Statement(s), PTO/SB/08, Paper No(s) _____
12. ☐ Other:_____

/Alexander J Kosowski/ Primary Examiner, Art Unit 3992		

cc: Requester (if third party requester)

Continuation of 10.

The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

Examiner begins by noting the amendment and declaration filed 7/12/10 have been entered and considered.

1) Examiner notes that claim 16 was improperly rejected in the final office action. The rejection relied upon VocalChat as a secondary reference, however this reference has been removed from consideration. Therefore, examiner notes claim 16 is hereby confirmed.

2) Examiner notes that the amendment and declaration filed 7/12/10 are found persuasive with regard to the rejection of claims 8-9 and 14-18 under NetBIOS and Pinard. The NetBIOS name registration system does not mean that a "first callee process is accessible" as name registration is often permanent and the correspondence between name and IP address would not always be indicative of accessibility. Therefore, the rejection of claims 8-9 and 14-18 under the combination of NetBIOS and Pinard is hereby withdrawn.

3) The rejection of claims 8-9, 14-15 and 17-18 under the combination of the Etherphone Papers and Pinard is maintained. The rejection of claim 16 has been withdrawn due to utilization of the withdrawn VocalChat reference as noted above.

With regard to the rejection of claim 8 utilizing Etherphone and Pinard:

Patent Owner (PO) argues that Pinard does not "state that any of the icons are representative of a "callee process", and that the icon represents "a callee from a directory which does not inherently have a corresponding process". PO argues that Pinard is directed to using a conventional telephone number and not a process.

In Response, examiner notes that the callee process itself has been taught by Etherphone, and the graphical icon representing this is taught by Pinard. Pinard shows that a callee (for instance, an employee in a directory) can be graphically represented and manipulated visually though a graphical user interface on a computer associated with a telephony server. A user manipulating this callee icon to place a call can therefore, when considered in combination with Etherphone, be considered to be manipulating the callee process as this manipulation leads to placing the call. In addition, examiner notes that the term "callee process" does not appear to be defined anywhere in PO's specification. Therefore, no strict definition can be given to this term, and a graphical icon representing a callee which enables placement of a call utilizing a callee process taught by Etherphone can be considered a "user interface element representing a first callee process".

PO also argues that there is no motivation to combine the references, since Pinard does not have a general discussion of personal computers and since Pinard utilizes a conventional telephone.

In response, examiner notes that Pinard teaches the use of a telephony server in combination with a personal computer. The computer is utilized for its graphical user interface to control the calling process of the telephony server. Etherphone utilizes a personal computer and graphical user interface to place telephone calls over a network. Therefore, both pieces of prior art relate to communications between users in a computerized environment, and are therefore combinable.

Conclusion: Claims 8-9, 14-15 and 17-18 remain rejected under Etherphone and Pinard. Claim 16 is confirmed.

DOCUMENT 5

UNITED STATES DISTRICT COURT
for the
Eastern District of Texas
Tyler Division

STRAIGHT PATH IP GROUP, INC., *Plaintiff*, v. BLACKBERRY LTD., et al. *Defendants.*	C.A. No. 6:13-cv-604

PATENT RULE 4-3 JOINT CLAIM CONSTRUCTION AND PREHEARING STATEMENT

Pursuant to Local Patent Rule 4-3 and the Docket Control Order entered in these cases, Plaintiff Straight Path IP Group, Inc. ("Straight Path") and Defendants Huawei Investment & Holding Co., Ltd., Huawei Technologies Co., Ltd., Huawei Technologies USA Inc., and Huawei Device USA, Inc. (together, "Huawei"); Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (together, "Samsung"); and ZTE Corporation and ZTE USA, Inc. (together, "ZTE") (collectively, "Defendants"), hereafter, "the Parties," hereby submit this Joint Claim Construction and Prehearing Statement.

This Statement addresses the parties' claim construction positions regarding the asserted claims of the Patents-in-Suit, U.S. Patent Nos. 6,009,469; 6,108,704; and 6,131,121. The Parties have met and conferred for the purposes of narrowing the issues and finalizing preparation of the Statement. The Parties agree that the Court need not construe terms that do not appear in this Statement.

A. Construction of those claim terms, phrases, or clauses on which the Parties agree

The Parties stipulate to constructions of the claim terms, phrases, and/or clauses attached hereto as Exhibit A.

B. Proposed constructions of disputed claim terms, phrases, and clauses, with extrinsic evidence

Straight Path's proposed construction for each disputed claim term and identification of supporting evidence is set forth in Exhibit B. The Defendants' proposed construction for each disputed claim term and identification of supporting evidence is set forth in Exhibit C.

C. Anticipated length of time necessary for the Claim Construction Hearing

The Parties believe that three (3) hours will suffice for the Claim Construction Hearing, with time being split evenly between Straight Path and Defendants.

D. Identity of witnesses the Parties intend to call at the Claim Construction Hearing

Straight Path may rely upon the expert opinion of Dr. Stuart Stubblebine to support its proposed claim constructions in the form of declarations filed with the Court and live testimony at the claim construction hearing, should the Court so desire. Dr. Stubblebine will testify, if permitted, that one of ordinary skill in the art during the relevant time periods would have construed the claim terms identified by the parties for construction in the manner Straight Path has proposed, and that Straight Path's proposed constructions are derived from the intrinsic extrinsic evidence. Dr. Stubblebine's testimony may also relate to the technology of the Asserted Patents, including any topics Defendants' experts may opine upon. Dr. Stubblebine may also rebut any testimony or allegations concerning prior art or other documents identified by any party regarding the general field or background of the inventions produced by the parties and/or any third parties in the case, including but not limited to the documents identified in the parties' P.R. 4-2 and 4-3 disclosures. Additionally, Straight Path may offer Dr. Stubblebine for the purposes of any tutorial that the Court may choose to conduct.

Straight Path reserves the right to offer expert testimony in rebuttal to any expert testimony Defendants may offer. Straight Path also reserves its right to identify additional extrinsic evidence, not limited to the areas of expert testimony, in response to or to rebut proposed claim constructions from Defendants. To the extent Defendants propose a construction for any term not identified in Exhibit B, Straight Path reserves the right to propose additional constructions within a reasonable time after receiving Defendants' proposed construction.

Defendants' may rely upon the expert opinion of Dr. Bruce Maggs to rebut expert testimony that Straight Path may offer, including but not limited to:

- testimony to support Straight Path's proposed claim constructions that one of ordinary skill in the art during the relevant time periods would have construed the claim terms identified by the parties for construction in the manner Straight Path has proposed,
- that Straight Path's proposed constructions are derived from the intrinsic and extrinsic evidence, and
- the technology of the Asserted Patents.

Defendants may rely upon Dr. Maggs' expert opinion in the form of declarations filed with the Court and live testimony at the claim construction hearing, should the Court so desire. Additionally, Defendants may offer Dr. Maggs for the purpose of any tutorial that the Court may choose to conduct. Defendants may also offer Dr. Maggs' expert opinions for supporting its proposed claim constructions, including support for Defendants' proposed claim constructions that one of ordinary skill in the art during the relevant time periods would have construed the claim terms identified by the parties for construction in the manner Defendants have proposed, and that Defendants' proposed constructions are derived from the intrinsic and extrinsic evidence.

To the extent Straight Path proposes a construction for any term not identified in Exhibit C, Defendants reserve the right to propose additional constructions within a reasonable time after receiving Straight Path's proposed construction(s).

E. Other issues that might appropriately be taken up at a prehearing conference prior to the Claim Construction Hearing

The following motion is pending before the Court. To the extent this motion is pending at the time of the scheduled claim construction hearing, Straight Path requests that the Court allow the parties to address them at the scheduled claim construction hearing:

- Straight Path's Motion to for Leave to Amend Its Infringement Contentions, *Straight Path IP Group, Inc. v. Samsung Electronics Co., Ltd., et al.*, C.A. No. 13-cv-606, Docket No. 85 (July 11, 2014).

DATED: September 12, 2014

Respectfully submitted,

By: */s/ Michael C. Newman*

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CERTIFICATE OF SERVICE

The undersigned certifies that on this 12th day of September, 2014, all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5(a)(3). Any other counsel of record will be served by a facsimile transmission and/or first class mail.

/s/ Michael C. Newman
Michael C. Newman

EXHIBIT A

Term or Phrase	Agreed Upon Construction
"process" / "processes" The '704 Patent, Claims 1, 11, 14, 16, 22, 27 and 31 The '469 Patent, Claims 1, 2, 3, 5, 6, 9 and 14 The '121 Patent, Claims 6, 8, 10, 11, 13 and 14	"running instance[s] of a computer program or application"
"dynamically assigned" The '121 Patent, Claims 6, 8, 10, 11 and 13	"assigned for a limited period of time, or until explicitly relinquished"

EXHIBIT B

Claim Term	Straight Path's Proposed Construction	Support for Straight Path's Proposed Construction
"point-to-point" The '704 Patent, Claims 1, 11, 14, 16, 22, 27 and 31 The '469 Patent, Claims 1, 2, 3, 5, 9 and 14 The '121 Patent, Claims 6, 8, 10, 11, 13 and 14	"communications between two processes over a computer network that are not intermediated by the [server process]/[server]/[address server]/[directory database]/ [directory database server process]"	**Intrinsic Evidence** '469 Patent at Claims 1, 2, 3, 5, 9 and 14; '469 Patent Figs. 3, 4, 7, 8, 9, 10, 15; '469 Patent at Abstract; '469 Patent at 1:5-51; '469 Patent at 2:30-41; '469 Patent at 3:14-27; '469 Patent at 6:66 – 7:43; '469 Patent at 9:10-34; '469 Patent at 9:64-10:3; '469 Patent at 26:31-38; '469 Patent at 12:48-53; '469 Patent at 18:26-37; '469 File History at STRAIGHTPATH-ITC-0000431-433; '469 File History at STRAIGHTPATH-ITC-0000739-744; '704 Patent at Claims 1, 11, 14, 16, 22, 27 and 31; '704 Patent Figs. 3, 4, 7, 8; '704 Patent Abstract; '704 Patent at 1:38-56; '704 Patent at1:59 – 2:9; '704 Patent at 5:24 – 6:16; '704 Patent at 7:32-41; '704 Patent at 7:60 – 8:27; '704 Patent at 10:22-37; '704 File History at STRAIGHTPATH-ITC-0000864; '704 Patent, Dec. 4, 1997, Amendment, at 8 (STRAIGHTPATH-ITC-00006139); '704 Patent, Dec. 4, 1997, Amendment, at 8-9 (STRAIGHTPATH-ITC-1723126-1723128); '121 Patent at Claims 6, 8, 10, 11, 13 and 14;

Claim Term	Straight Path's Proposed Construction	Support for Straight Path's Proposed Construction
		'121 Patent Figs. 3, 4, 7, 8, 9, 10; '121 Patent at 26:23-30; '121 Patent at 12:41-46. **Extrinsic Evidence** Dr. Stuart Stubblebine may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. The following is a brief description of the substance of Dr. Stubblebine's testimony about the term "**point-to-point**": 1. How one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit as clearly supporting Straight Path's construction of the term "**point-to-point**" 2. Explanation of what constitutes a point-to-point communication 3. The potential for intermediation of a point-to-point communication by certain network hardware and the specific servers that do not intermediate the point-to-point communication claimed in the patents-in-suit 4. The nature of the end points of the point-to-point communication claimed in the patents-in-suit 5. Dr. Stubblebine may also offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents
"on-line" The '704 Patent, Claims 11 and 22	"available for communication"	**Intrinsic Evidence** '469 Patent at Claim 9; '469 Patent at 2:45-54; '469 Patent at 6:66 – 7:48; '469 Patent at 11:64-12:12;

Claim Term	Straight Path's Proposed Construction	Support for Straight Path's Proposed Construction
The '469 Patent, Claim 9		'469 Patent at 20:27-44; '469 Patent at 22:57-23:5; '469 Patent at 23:17-40; '469 Patent at Table 2; '469 Patent at 22:57-61; '469 Patent at TABLE 1; '469 File History at STRAIGHTPATH-ITC-0000739-744; '469 File History at STRAIGHTPATH-ITC-0000748-756; '704 Patent at Claims 11 and 22; '704 Patent at 5:24-48; '704 Patent at 1:59-2:9; '704 Patent at 5:24-48; '704 Patent at 5:60-62; '704 Patent at 10:4-20; '704 File History at STRAIGHTPATH-ITC-0000864; '121 Patent at 6:60-7:7; '121 Patent at 7:29-31; '121 Patent at 11:58-12:6; '121 Patent at 20:19-46; '121 Patent at 22:50-65; '121 Patent at 23:10-33; '121 Patent at 22:50-54. **Extrinsic Evidence** Dr. Stuart Stubblebine may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. The following is a brief description of the substance of Dr. Stubblebine's testimony about the term "**on-line**":

Claim Term	Straight Path's Proposed Construction	Support for Straight Path's Proposed Construction
		1. How one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit as clearly supporting Straight Path's construction of the term "**on-line**" 2. The relationship between being "**on-line**" and being able to engage in the point-to-point communication protocol claimed in the patents-in-suit 3. Dr. Stubblebine may also offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents
"accessible" The '469 Patent, Claim 9	"on-line and available for communication with the caller process"	**Intrinsic Evidence** '469 Patent, Claim 9; '469 Patent at 2:45-54; '469 Patent at 6:66-7:13; '469 Patent at 7:30-59; '469 Patent at 19:7-11; '469 Patent at 20:45-54; '469 Patent at 22:54-23:5; '469 Patent at 23:35-40; '469 Patent at 24:7-14; '469 Patent at 24:50-54; '469 Patent at TABLE 2; '469 File History at STRAIGHTPATH-ITC-0000748-756; '121 Patent at 20:37-46; '121 Patent at 22:50-65; '121 Patent at 23:28-33. **Extrinsic Support** Dr. Stuart Stubblebine may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents.

Claim Term	Straight Path's Proposed Construction	Support for Straight Path's Proposed Construction
		The following is a brief description of the substance of Dr. Stubblebine's testimony about the term "**accessible**": 1. How one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit as clearly supporting Straight Path's construction of the term "**accessible**" 2. How one of ordinary skill in the art at the time of the invention would interpret the specifications of the patents-in-suit as clearly supporting an interpretation of the term "**accessible**" to represent both the on-line status of the callee process and the callee process' availability for communication with the caller process 3. Dr. Stubblebine may also offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents

Claim Term	Straight Path's Proposed Construction	Support for Straight Path's Proposed Construction
"network protocol address" The '704 Patent, Claims 1, 11 and 22 The '469 Patent, Claims 1, 2, 3, 5, 6 and 9 The '121 Patent, Claims 6, 8, 10, 11, 13 and 14	Plain and ordinary meaning.	**Support:** *Innovative Communication Technologies, Inc. v. Vivox, Inc.*, Civil No. 2:12cv7, Civil No. 2:12cv9, Opinion and Order (E.D. Va. Oct. 26, 2012) '704 Patent, Claims 1, 11 and 22 '704 Patent at Abstract '704 Patent at 1:1-35 '704 Patent at 5:1-14 '704 Patent at 6:16 – 7:25 '469 Patent, Claims 1, 2, 3, 5, 6 and 9 '469 Patent at Abstract '469 Patent at 1:53 – 2:4 '469 Patent at 3:15-27 '469 Patent at 4:27-50 '469 Patent at 12:48 – 13:8 '121 Patent, Claims 6, 8, 10, 11, 13 and 14 '121 Patent at Abstract '121 Patent at 1:1-12 '121 Patent at 3:1 - 19 '121 Patent at 12:41 – 13:1

Claim Term	Straight Path's Proposed Construction	Support for Straight Path's Proposed Construction
"a query as to whether [the/a] second process is connected to the computer network" The '704 Patent, Claim 1 The '469 Patent, Claims 3 and 6 The '121 Patent, Claims 6, 8, 13 and 14	Plain and ordinary meaning, except to the extent that "**process**" requires construction. See Straight Path's proposed construction of "**process**"	**Support:** *Innovative Communication Technologies, Inc. v. Vivox, Inc.*, Civil No. 2:12cv7, Civil No. 2:12cv9, Opinion and Order (E.D. Va. Oct. 26, 2012) See Straight Path's support for proposed construction of "on-line" and "process"/"processes" Dr. Stuart Stubblebine may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Stubblebine's rebuttal testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; why a person of ordinary skill in the art would understand the terms "query as to whether" and "connected to the computer network" to be given their plain and ordinary meaning in the field of computer science and network communications. Dr. Stubblebine may also offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents

Claim Term	Straight Path's Proposed Construction	Support for Straight Path's Proposed Construction
"querying the [server/server process] as to the on-line status of the first [callee]/[called] process" "query the [server process/address server] as to whether [a/the] second process is connected to the computer network" The '704 Patent, Claims 11 and 22 The '469 Patent, Claim 9 The '121 Patent, Claims 6 and 8	Plain and ordinary meaning, except to the extent that "**on-line**" and "**process**" require construction. See Straight Path's proposed construction of "**on-line**" and "**process**"	**Support:** *Innovative Communication Technologies, Inc. v. Vivox, Inc.*, Civil No. 2:12cv7, Civil No. 2:12cv9, Opinion and Order (E.D. Va. Oct. 26, 2012) See Straight Path's support for proposed construction of "on-line" and "process"/"processes" '704 Patent, Claims 11 and 22 '469 Patent, Claim 9 '469 patent at 6:43-65 '121 Patent, Claims 6 and 8 Dr. Stuart Stubblebine may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Stubblebine's rebuttal testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; why a person of ordinary skill in the art would understand the terms "querying", "status", "callee process" and "caller process" to be given their plain and ordinary meaning in the field of computer science and network communications. Dr. Stubblebine may also offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents

"having on-line status with respect to the computer network" The '121 Patent, Claims 10 and 11	Plain and ordinary meaning, except to the extent that "**on-line** requires construction. See Straight Path's proposed construction of "**on-line**."	**Support:** *Innovative Communication Technologies, Inc. v. Vivox, Inc.*, Civil No. 2:12cv7, Civil No. 2:12cv9, Opinion and Order (E.D. Va. Oct. 26, 2012) See Straight Path's support for proposed construction of "on-line" '121 Patent, Claims 10 and 11 Dr. Stuart Stubblebine may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Stubblebine's rebuttal testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; why a person of ordinary skill in the art would understand the terms "having…status with respect to the computer network" to be given their plain and ordinary meaning in the field of computer science and network communications. Dr. Stubblebine may also offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents

"[a/the] user associating [two or more elements]"/"association of [two or more elements]" The '704 Patent, Claims 11, 14, 16, 22 and 27 The '469 Patent, Claims 9 and 14	Plain and ordinary meaning.	**Support:** *Innovative Communication Technologies, Inc. v. Vivox, Inc.*, Civil No. 2:12cv7, Civil No. 2:12cv9, Opinion and Order (E.D. Va. Oct. 26, 2012) '704 Patent, Claims 11, 14, 16, 22 and 27 '469 Patent, Claims 9 and 14 '469 patent at 11:43-26 Dr. Stuart Stubblebine may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Stubblebine's rebuttal testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; why a person of ordinary skill in the art would understand these terms to be given their plain and ordinary meaning in the field of computer science and network communications. Dr. Stubblebine may also offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents

"caller process" / "callee process" The '704 Patent, Claims 11, 14, 16, 22, 27 and 31 The '469 Patent, Claims 9 and 14	Plain and ordinary meaning, except to the extent that "**process**" requires construction. See Straight Path's proposed construction of "**process**"	**Support:** *Innovative Communication Technologies, Inc. v. Vivox, Inc.*, Civil No. 2:12cv7, Civil No. 2:12cv9, Opinion and Order (E.D. Va. Oct. 26, 2012) See Straight Path's support for proposed construction of "process"/"processes" 469 patent at 6:43-65 Dr. Stuart Stubblebine may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Stubblebine's rebuttal testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; why a person of ordinary skill in the art would understand the terms "caller process" and "callee process" to be given their plain and ordinary meaning in the field of computer science and network communications. Dr. Stubblebine may also offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents

"temporarily disabling point -to-point communications" The '704 Patent, Claims 16 and 27 The '469 Patent, Claim 14	Plain and ordinary meaning, except to the extent that "**point-to-point**" requires construction. See Straight Path's proposed construction of "**point-to-point**"	**Support:** *Innovative Communication Technologies, Inc. v. Vivox, Inc.*, Civil No. 2:12cv7, Civil No. 2:12cv9, Opinion and Order (E.D. Va. Oct. 26, 2012) See Straight Path's support for proposed construction of "point-to-point" 469 patent, 10:46-51 and 28:41-48 121 patent, 10:40-45 and 28:33-40 Dr. Stuart Stubblebine may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Stubblebine's rebuttal testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; why a person of ordinary skill in the art would understand the terms "temporarily disabling" and "communications" to be given their plain and ordinary meaning in the field of computer science and network communications. Dr. Stubblebine may also offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents

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EXHIBIT C

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
1	"network protocol address" "network protocol addresses" '704 Patent Claims: 1, 11, 22 '469 Patent Claims: 1-3, 5-6, 9 '121 Patent Claims: 6, 8, 10-11, 13-14	"address assigned according to a network-layer protocol, such as an IP address." "addresses assigned according to a network-layer protocol, such as an IP address."	*See also* evidence cited for "point-to-point." *Intrinsic Evidence:* '704 Patent Figs. 7-9, 1:21-26, 1:27-55, 5:24-38, 6:61-7:59, 8:3-10, 8:3-10, '469 Patent Figs. 7-9, 2:5-50, 6:43-7:3, 8:39-9:52, 9:66-10:3, 18:33-37, 24:7-11. '121 Patent Figs. 7-9, 2:6-54, 6:37-65, 8:32-9:46, 9:60-64, 18:25-29, 23:67-24:2. File History '704, 6/2/97 Office Action at 3-4;

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			'704, 10/28/98 Office Action at 4; '704, 3/1/99 Resp. at 14-15; '704 Reexam, 11/27/09 Resp. at 21; '469, 4/20/98 Office Action at 8. ("containing a network protocol address (IP address)"; '469, 10/26/98 Resp. at 7-8; '469, 3/3/99 Response at 8; '121 Reexam, 11/25/09 Resp. at 14; '121, 9/7/99 Resp. at 19-20. *Extrinsic Evidence:* Dr. Bruce Maggs may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Maggs' rebuttal testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; explanation of what constitutes a network protocol address.

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			March 7, 2014 Rebuttal Expert Report of Dr. Stuart Stubblebine, at pp. 1-73; Responsive Expert Report of Kevin Jeffay, Ph.D, in *Net2Phone v. Skype*. pp. 9-35 and the May 20, 2008, Deposition of Kevin Jeffay, Ph.D. RFC 793 (TCP protocol spec.), RFC 791 (IP protocol spec.), and RFC 768 (UDP protocol specification). Douglas Comer, Internetworking with TCP/IP – Principles, Protocols, and Architecture, Vol. I (New Jersey: Prentice-Hall, 1991), e.g., Chapter 7 ("Internet Protocol: Connectionless Datagram Delivery"), Chapter 8 ("Internet Protocol: Routing IP Datagrams"), Chapter 10 ("Protocol Layering"), Chapter 11 ("User Datagram Protocol"), Chapter 12 ("Reliable Stream Transport Service (TCP)"), and Chapter 21 ("The Socket Interface"). W. Richard Stevens, UNIX Network Programming (New Jersey: Prentice-Hall, Inc., 1990), e.g., Chapter 4 ("A Network Primer"), Chapter 5 ("Communication Protocols") and Chapter 6 ("Berkeley Sockets").

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			W. Richard Stevens, TCP/IP Illustrated, Volume 1 – The Protocols (Boston: Addison-Wesley, 1994), e.g., Chapter 1 ("Introduction"), Chapter 3 ("IP: Internet Protocol"), Chapter 9 ("IP Routing"), Chapter 11 ("UDP: User Datagram Protocol"), Chapter 17 ("TCP: Transmission Control Protocol"), Chapter 18 ("TCP Connection Establishment and Termination"), and Chapter 19 ("TCP Interactive Data Flow").
2	"having on-line status with respect to the computer network" '121 Patent Claims: 10-11	"that are currently registered with the server"	*See also* evidence cited for "query" terms *Intrinsic Evidence:* '704 Patent Abstract, 1:59-2:9, 3:19-32, 5:33-37, 5:39-42, 5:24--6:16, 10:10-37. '469 Patent 4:59-5:6, 6:66-7:59, 11:64-12:28, 18:26-19:63,

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			20:49-54, 22:54-23:34, 23:41-24:49, 25:61-26:24. '121 Patent 4:51-65, 6:60-753, 11:28-12:21, 18:18-19:55, 20:21-54, 22:47-23:27, 23:34-24:42, 25:54-26:16. File History '704, 12/2/97 Hutton Dec. at Ex. A; '704 Reexam 11/27/09 Resp. at 11-18, 21, 27-28; '704 Reexam Mayer-Patel Dec. at 10-11, 13-15; '121 Reexam, 5/7/10 Office Action at 6; '121 Reexam 11/25/09 Resp. at 8; '121 Reexam 11/25/05 Resp. at 10-11; '121 Reexam Meyer-Patel Dec. at 7-8; '469 10/26/98 Resp. at 7-8; '469 3/3/99 Resp. at 8-9; '469 Reexam 11/25/09 Resp. at 11-12;

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			'469 Reexam Mayer-Patel Dec. at 8; *Extrinsic Evidence:* Dr. Bruce Maggs may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Maggs' testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; and the relationship between being "on-line" or "connected to the computer network" and being able to engage in the point-to-point communication protocol claimed in the patents-in-suit. March 7, 2014 Rebuttal Expert Report of Dr. Stuart Stubblebine, at pp. 1-73 ; Responsive Expert Report of Kevin Jeffay, Ph.D, in Net2Phone v. Skype. pp. 9-35 and the May 20, 2008, Deposition of Kevin Jeffay, Ph.D.

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
3	"a query as to whether [the/a] second process is connected to the computer network" '704 Patent Claims: 1 '469 Patent Claims: 3, 6 '121 Patent Claims: 6, 8, 13-14	"a message requesting a response from the [server] [server process] [address server] whether the second process is currently registered with the [server]"	*See also* evidence cited for "having on-line status with respect to the computer network" and "querying" terms *Intrinsic Evidence:* '704 Patent Figs. 1-2, 8-9, 5:25-6:16; 10:4-59. '469 Patent Figs. 1-2, 8-9, 15A-17B, 2:66-3:27, 6:66-7:59, 11:64-12:53, 18:26-19:63, 22:54-23:34, 23:48-24:49, 25:61-26:24. '121 Patent Figs. 1-2, 8-9, 15A, 17B, 3:2-20, 6:60-7:53, 11:58-12:46, 18:18-19:55, 22:47-23:27, 23:41-24:42, 25:54-26-16.

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			File History '704, 3/4/99 Resp. at 14. ("Other processes wishing to contact a desired target process simply query the address directory server to determine whether the target process is on-line and the current network protocol address at which the target process is located.") '704, 12/2/97 Resp. at 8-9; '469, 10/26/98 Resp. at 8-9. *Extrinsic Evidence:* Dr. Bruce Maggs may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Maggs' testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; and the relationship between being "on-line" or "connected to the computer network" and be-

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			ing able to engage in the point-to-point communication protocol claimed in the patents-in-suit. March 7, 2014 Rebuttal Expert Report of Dr. Stuart Stubblebine, at pp. 1-73; Responsive Expert Report of Kevin Jeffay, Ph.D, in Net2Phone v. Skype. pp. 9-35 and the May 20, 2008, Deposition of Kevin Jeffay, Ph.D.
4	"querying the [server/server process] as to the on-line status of the first [called/callee] process" "query the [server process/address server] as to whether [a/the] second process is connected to the computer network"	"transmit[ting] a message to the server requesting a response from the server whether the second process is currently registered with the server"	*See also* evidence cited for "having on-line status with respect to the computer network" *Intrinsic Evidence:* <u>'704 Patent</u> Figs. 1-2, 8-9, 5:25-6:16, 10:4-59. <u>'469 Patent</u> Figs. 1-2, 8-9, 15A-17B, 2:66-3:27, 6:66-7:59, 11:64-12:53, 18:26-19:63, 22:54-23:34, 23:48-

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
	'704 Patent Claims: 11, 22 '469 Patent Claims: 9 '121 Patent Claims: 6, 8		24:49, 25:61-26:24. '121 Patent Figs. 1-2, 8-9, 15A, 17B, 3:2-20, 6:60-7:53, 11:58-12:46, 18:18-19:55, 22:47-23:27, 23:41-24:42, 25:54-26-16. File History '704, 3/4/99 Resp. at 14; '704, 12/2/97 Resp. at 8-9; '469, 10/26/98 Resp. at 8-9. *Extrinsic Evidence:* Dr. Bruce Maggs may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents.

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			Dr. Maggs' testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; and the relationship between being "on-line" or "connected to the computer network" and being able to engage in the point-to-point communication protocol claimed in the patents-in-suit. March 7, 2014 Rebuttal Expert Report of Dr. Stuart Stubblebine, at pp. 1-73 ; Responsive Expert Report of Kevin Jeffay, Ph.D, in Net2Phone v. Skype. pp. 9-35 and the May 20, 2008, Deposition of Kevin Jeffay, Ph.D.
5	"point-to-point" '704 Patent Claims: 1, 11, 14, 16, 22, 27, 31 '469 Patent Claims: 1-3, 5, 9, 14	"between two processes, not intermediated by any server"	*Intrinsic Evidence*: '704 Patent 8:4-10, Figs. 3-4, 8-9, 2:35-37, 7:32-41. '469 Patent Figs. 3-4, 8-9, 3:39-43, 9:24-42, 9:64-10:3, 12:42-47, 24:7-11, 26:31-38.

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
	'121 Patent Claims: 6, 8, 10-11, 13-14		'121 Patent Figs. 3-4, 8-9, 3:32-34, 9:19-28, 9:58-64, 12:38-45, 23:67-24:2, 26:23-30. File History '704, 3/4/99 Resp. at 14; '704, 12/2/97 Hutton Dec. at Ex. A; '704, 12/2/97 Resp. at 8; '704, 7/14/99 Strickland Dec., Fig. 38; '469, 6/2/97 Office Action at 6; '469, 10/26/98 Resp. at 7-9; '469 Reexam, 11/25/09 Resp. at 13; '469 Reexam, Meyer-Patel Dec. at 11; '121, 6/12/99 Resp. at 20. *Extrinsic Evidence:*

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			Dr. Bruce Maggs may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Maggs' testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; explanation of what constitutes a point-to-point communication; the potential for intermediation of a point-to-point communication by certain network hardware and the specific servers that do not intermediate the point-to-point communication claimed in the patents-in-suit; and the nature of the end points of the point-to-point communication claimed in the patents-in-suit. March 7, 2014 Rebuttal Expert Report of Dr. Stuart Stubblebine, at pp. 1-73; Responsive Expert Report of Kevin Jeffay, Ph.D, in Net2Phone v. Skype. pp. 9-35 and the May 20, 2008, Deposition of Kevin Jeffay, Ph.D. IEEE Standard Dictionary of Electrical and Electronic

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			Terms, 6th ed. (1996). Newton's Telecom Dictionary, 6th ed. (1993). RFCs 793 at 5, 7, 10, 15, 84 (TCP protocol spec.), 791 at11 (IP protocol spec.), and 768 at 1 (UDP protocol specification). Douglas Comer, Internetworking with TCP/IP – Principles, Protocols, and Architecture, Vol. I (New Jersey: Prentice-Hall, 1991) at 125, 156, 161, 166, 178-80, 183. W. Richard Stevens, UNIX Network Programming (New Jersey: Prentice-Hall, Inc., 1990) at 182, 191, 194, 206-09. W. Richard Stevens, TCP/IP Illustrated, Volume 1 – The Protocols (Boston: Addison-Wesley, 1994) at 10-13.

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
6	"caller process" "callee process" <u>'704 Patent Claims:</u> 11, 14, 16, 22, 27, 31 <u>'469 Patent Claims:</u> 9, 14	"process that places/receives a call for real-time audio and/or video conversations"	*Intrinsic Evidence:* <u>'704 Patent</u> 5:11-13. <u>'469 Patent</u> Figs. 14-18D, 10:12-15, 2:28-42, 2:58-64, 2:66-3:3, 6:54-55, 9:25-29, 11:19-49, 12:48-53, 15:66-16:49, 25:39-41. <u>'121 Patent</u> Figs. 14-18D, 2:42-46, 2:62-67, 3:2-7, 6:48-50, 9:19-23, 10:5-9, 11:13-43, 12:41-46, 12:59-13:42, 25:32-34. <u>File History</u> '704, 12/2/97 Hutton Dec. at Ex. A; '704 Reexam, 11/27/09 Resp. at 18-19; '704 Reexam, Mayer-Patel Dec. at 17-18.

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			Dr. Bruce Maggs may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Maggs' rebuttal testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; explanation of what constitutes a caller process and a callee process, and how a caller and/or callee process is distinguished from a process.
7	"[a/the] user associating [two or more elements]" "association of [two or more elements]" '704 Patent Claims: 11, 14, 16, 22, 27, 31 '469 Patent Claims:	"[a/the] user connecting together, e.g. dragging and dropping, [two or more elements]"	*Intrinsic Evidence:* '704 Patent 9:34-42 '469 Patent 11:27-35, 26:43-46, 27:65-28:3, 31:6-15. '121 Patent 11:21-29, 26:35-37, 27:57-62, 30:65-31:7.

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
	9, 14		File History '704, 7/14/99 Strickland Dec. Ex. B at 5. *Extrinsic Evidence:* March 7, 2014 Rebuttal Expert Report of Dr. Stuart Stubblebine, at pp. 1-73; Responsive Expert Report of Kevin Jeffay, Ph.D, in Net2Phone v. Skype. pp. 9-35 and the May 20, 2008, Deposition of Kevin Jeffay, Ph.D. Webster's New Collegiate Dictionary, 9th Ed. (1991) Dr. Bruce Maggs may offer expert testimony regarding the view of one of ordinary skill in the art at the time of the Asserted Patents. Dr. Maggs' rebuttal testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; explanation of what constitutes a user interface element, what constitutes associating two or more elements, and other features of the graphical user interface disclosed in the asserted patents.

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
8	"temporarily disabling point-to-point communications" "temporarily disabling the point-to-point communication link" '704 Patent Claims: 16, 27 '469 Patent Claims: 14	"to render incapable of making and/or receiving point-to-point communications"	*Intrinsic Evidence:* '469 Patent 7:49-59, 28:41-48. '121 Patent 7:43-53, 28:33-40. File History '704, 12/2/97 Resp. at 8 ("The first technique utilizes a dedicated server which acts as a network address/information directory from which calling processes can obtain information.") '704, 3/4/99 Resp. at 14; '121, 9/7/99 Resp. at 19, 21. Dr. Bruce Maggs may offer expert testimony regarding the view of one of ordinary skill in the art at the time

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
			of the Asserted Patents. Dr. Maggs' rebuttal testimony may include, but is not limited to: how one of ordinary skill in the art at the time of the invention would read the specifications of the patents-in-suit; explanation of what constitutes a point-to-point communications, how point-to-point communications are disabled, and what constitutes temporary disabling of point-to-point communications.
9	"accessible" '469 Patent Claim: 9	This term does not need to be construed. To the extent that this claim term needs to be construed, this claim term should be construed as "currently registered with the server."	*See* evidence cited for "query" and "querying" terms and "having on-line status with respect to the computer network" term.
10	"on-line" '704 Patent Claims: 11, 22	This claim term should be construed in context with claim terms (2) and (4), see proposed construction for the "querying" term and "having on-line status with respect to the computer network" term. To the extent that this claim term needs to be construed separately from claim terms (2)	*See* evidence cited for "query" and "querying" terms and "having on-line status with respect to the computer network" term.

No.	Claim Term	Defendants' Proposed Construction	Support for Defendants' Proposed Construction
	'469 Patent Claim: 9	and (4), the Court should construe the claim term "on-line status," which should be construed to mean "currently registered with the server."	

United States Court of Appeals
for the Federal Circuit

Straight Path IP Group, Inc. v. Sipnet EU S.R.O., 2015-1212

CERTIFICATE OF SERVICE

I, Robyn Cocho, being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

Counsel Press was retained by MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO P.C, attorneys for Appellant to print this document. I am an employee of Counsel Press.

On **September 8, 2015,** counsel has authorized me to electronically file the foregoing **Motion with attachments re: Judicial Notice** with the Clerk of Court using the CM/ECF System, which will serve via e-mail notice of such filing to all counsel registered as CM/ECF users, including any of the following:

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.

September 8, 2015

/s/Robyn Cocho
Robyn Cocho
Counsel Press

ATTACHMENT C

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

STRAIGHT PATH IP GROUP, INC.,
Appellant

v.

SIPNET EU S.R.O.,
Appellee

2015-1212

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2013-00246.

ON MOTION

PER CURIAM.

O R D E R

Appellee Sipnet EU S.R.O and appellant Straight Path IP Group, Inc. move for the Court to take judicial notice.

Upon consideration thereof,

IT IS ORDERED THAT:

The motions are granted.

FOR THE COURT

November 25, 2015
Date

/s/ Daniel E. O'Toole
Daniel E. O'Toole
Clerk of Court