UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.

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Case IPR2014-01367
Patent 6,009,469 C1

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

DESHPANDE, *Administrative Patent Judge*.

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

I.   INTRODUCTION

Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, "Petitioner") filed a Petition requesting an *inter partes* review of claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of U.S. Patent No. 6,009,469 C1[1] (Ex. 1001, "the '469 patent"). Paper 1 ("Pet."). Straight Path IP Group, Inc. ("Patent Owner") timely filed a Preliminary Response. Paper 10 ("Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." After considering the Petition, the Preliminary Response, and the associated evidence, we conclude that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing unpatentability of all the challenged claims. Thus, we authorize institution of an *inter partes* review of claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of the '469 patent.

A. Related Proceedings

Petitioner indicates that the '469 patent is the subject of the proceedings in *Straight Path IP Group, Inc. v. Samsung Electronics Co., Ltd.*, No. 6:13-cv-00606 (E.D. Tex.). Pet. 1–2. Petitioner further indicates that the '469 patent is related to U.S. Patent No. 6,108,704 ("the '704 patent") and the '704 patent was the subject of *Sipnet EU S.R.O. v. Straight Path IP Group, Inc.*, IPR2013-00246 (PTAB) ("*Sipnet*"). *Id.*

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[1] The '469 patent was reexamined resulting in an *ex parte* reexamination certificate issued under 35 U.S.C. § 307. Of the challenged claims, claims 1, 9, 14 and 17 were amended during reexamination. Thus, our citations to those claims refer to U.S. Patent No. 6,009,469 C1. *See* Ex. 1001, 67.

Additionally, Petitioner indicates that this Petition is related to
IPR2014-01366 and IPR2014-01368. *Id.*

B. The '469 Patent

The '469 patent (Ex. 1001) is titled "Graphic User Interface for
Internet Telephony Application" and generally relates to facilitating audio
communications over computer networks. Ex. 1001, 1:54–57. The patent
explains that a first processing unit automatically transmits its associated
e-mail address, and its IP address, to a connection server. *Id.* at 6:66–7:9.
The connection server stores the addresses in a database and, thus, the first
processing unit is established as an active on-line party available for
communication. *Id.* The first processing unit sends a query to the
connection server, which searches the database to determine whether a
second processing unit is active and on-line. *Id.* at 7:31–36. If the callee is
active and on-line, the connection server sends the IP address of the callee
from the database to the first processing unit, i.e., performs a point-to-point
Internet protocol communication. *Id.* at 7:36–40. The first processing unit
then directly establishes the point-to-point Internet communications with the
callee using the retrieved IP address. *Id.* at 7:40–43.

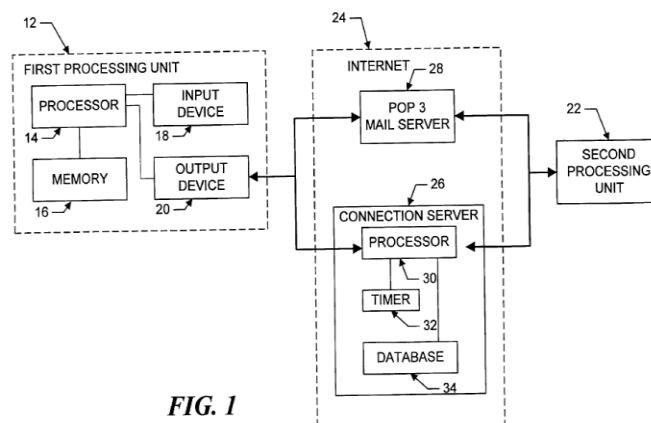Figure 1 of the '469 patent is reproduced below:

FIG. 1

Figure 1 above illustrates the architecture between first processing unit 12, second processing unit 22, and connection server 26. *Id.* at 6:56–7:3.

C. Illustrative Claim

Petitioner challenges claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of the '469 patent. Pet. 33–54. Claim 1 is illustrative of the claims at issue and is reproduced below:

> 1. A computer program product for use with a computer system having a display, 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, responsive to user input commands, for establishing a point-to-point communications with another process over the computer network.

Ex. 1001, 67 (1:28–50).

D. The Alleged Grounds of Unpatentability

The information presented in the Petition sets forth proposed grounds of unpatentability of claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of the '469 patent as follows (*see* Pet. 33–54):[2]

Reference(s)	Basis	Claims Challenged
Microsoft Manual[3]	§ 102(a)	1–3, 5, 6, and 9[4]
Microsoft Manual and NetBIOS[5]	§ 103(a)	1–3, 5, 6, and 9[6]
Microsoft Manual, NetBIOS, and Palmer[7]	§ 103(a)	9, 10, 14, 17, and 18
Microsoft Manual, NetBIOS, Palmer, and Pinard[8]	§ 103(a)	1, 9, and 14
Microsoft Manual, NetBIOS, Palmer, Pinard, and Pitkin[9]	§ 103(a)	3, 6, and 9[10]

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[2] Petitioner supports its challenge with four declarations. Ex. 1004 (Declaration of Henry Houth, Ph.D., executed August 22, 2014); Ex. 1005 (Declaration of Robert Cowart, executed August 20, 2014); Ex. 1019 (Declaration of Sandy Ginoza, executed August 7, 2014); Ex. 1033 (Declaration of Sandy Ginoza, executed August 19, 2014).

[3] MICROSOFT WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1012, "Microsoft Manual").

[4] Although Petitioner first identifies claim 17 as challenged under this ground, Petitioner's argument and claim charts do not include claim 17. Accordingly, we do not understand Petitioner to have challenged claim 17 under this ground. *Compare* Pet. 4 *with id.* at 34–43.

[5] THE OPEN GROUP, TECHNICAL STANDARD, PROTOCOLS FOR X/OPEN PC INTERWORKING:SMB, VERSION 2.0 (1992) (Ex. 1014, "NetBIOS").

[6] Although Petitioner first identifies claim 17 as challenged under this ground, Petitioner's argument and claim charts do not include claim 17. Accordingly, we do not understand Petitioner to have challenged claim 17 as part of this ground. *Compare* Pet. 4 *with id.* at 34–43.

[7] U.S. Patent No. 5,375,068, issued Dec. 20, 1994 (Ex. 1020, "Palmer").

[8] U.S. Patent No. 5,533,110, issued July 2, 1996 (Ex. 1021, "Pinard").

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