

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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LG ELECTRONICS, INC., TOSHIBA CORP.,  
VIZIO, INC., HULU, LLC,  
CISCO SYSTEMS, INC., AVAYA INC.,  
VERIZON SERVICES CORP., and VERIZON BUSINESS NETWORK  
SERVICES INC.,  
Petitioner,  
v.

STRAIGHT PATH IP GROUP, INC.  
Patent Owner.

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Case IPR2015-00198<sup>1</sup>  
Patent No. 6,009,469 C1

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**PETITIONER'S SUPPLEMENTAL BRIEF IN SUPPORT OF PETITION  
FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 6,009,469**

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<sup>1</sup> IPR2015-01397 and IPR2015-01407 have been joined with this proceeding.

Pursuant to the Board’s Order (Paper No. 43), Petitioner respectfully submits this brief to explain the impact of the Federal Circuit’s decision in *Straight Path IP Group, Inc. v. Sipnet EU S.R.O.* on this proceeding. In its decision, the Federal Circuit construed a single term in U.S. Patent No. 6,108,704. The prior art references of record render the instituted claims obvious under that construction. Indeed, the prior art ensures that a queried process “is connected to the computer network at the time that the query is transmitted to the server” in precisely the same way as and using the same methods disclosed in the patent. Because the instituted claims of the ’469 patent recite elements found entirely within the prior art, the instituted claims are obvious, and therefore unpatentable.

## I. LEGAL STANDARD

“The ultimate test of patent validity is one of law, but resolution of the obviousness issue necessarily entails several basic factual inquiries.” *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 280 (1976). The Board’s factual determinations in support of obviousness are reviewed for substantial evidence. *Randall Mfg. v. Rea*, 733 F.3d 1355, 1362 (Fed. Cir. 2013).

## II. FEDERAL CIRCUIT CONSTRUCTION

In its decision in the *Sipnet* appeal, the Federal Circuit concluded that “is connected to the computer network” means “is connected to the computer network at the time that the query is transmitted to the server.” Slip Op. at 13. In

construing the term, the Federal Circuit relied upon four particular features disclosed in the specification. **First**, the Federal Circuit analyzed the disclosure of registration.

**Second**, the Federal Circuit relied on the '704 patent's disclosure of timestamps. The Federal Circuit noted that the connection server "may use [] timestamps to update the status of each processing unit' over time to try to keep the 'on-line status information stored in the database [] relatively current." *Id.* at 10 (citing the '704 patent at 5:39-42).

**Third**, the Federal Circuit relied on the specification's disclosure of searching the database at the time of the query. The Court explained that "when a first unit sends a query to the connection server, the latter 'searches the database 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." *Id.* at 11 (citing the '704 patent at 5:57-60).

**Fourth**, the Federal Circuit cited to the disclosure of deregistration when a user logs off or goes off-line. The Court noted that "[w]hen a user logs off or goes off-line from the Internet, the connection server updates the status of the user in the database; for example, by removing the user's information, or by flagging the user as being off-line." *Id.* (citing the '704 patent 6:6-9). The Federal Circuit also

cited the patent’s disclosure that the “server [] may be instructed to update the user’s information in the database by an offline message . . . sent automatically from the processing unit of the user prior to being disconnected from the connection server.’ *Id.* (citing the ’704 patent at 6:10–14).

The term the Federal Circuit construed—“is connected to the computer network”—is absent from a number of the claims over which the Board instituted review in this proceeding. In particular, Claims 1, 2, and 5 of the ’469 patent do not contain the construed limitation or any equivalent.

### III. PRIOR ART

The combination of WINS and NetBIOS render the instituted claims of the ’469 patent obvious under the Federal Circuit’s construction. Reply 21; Ex. 1041 ¶¶ 34-44. Indeed, each of the features to which the Court referred in formulating its construction are disclosed in the prior art. *First*, in WINS and NetBIOS, a “unit is active and online—available for communication—at the time it registers.” Slip Op. at 9. WINS “provides a distributed database for registering and querying dynamic computer name-to-IP address mappings in a routed network environment.” (Ex. 1003 at 69; *see also* Pet. 15-22; Ex. 1002 ¶¶ 55-59.) NetBIOS discloses that “[a]n application . . . registers one or more names that it wishes to use.” (Ex. 1004 at 378; *see also* Reply 8-9; Ex. 1041 ¶¶ 30-33.)

**Second**, the WINS Server and NetBIOS Name Server (“NBNS”) use “‘timestamps to update the status of each processing unit’ over time to try to keep the ‘on-line status information stored in the database [] relatively current.’” Slip Op. at 10. “The name registration request is sent directly to the WINS server to be added to the database. . . . WINS accepts the entry and adds it to its local database together with a timestamp . . . .” (Ex. 1003 at 74; *see also* Pet. 18-22; Ex. 1002 ¶¶ 55-59.) If a network device fails to re-register its name within the set renewal time, “the WINS server will mark the name as released and available for use.” (Ex. 1003 at 75; *see also* Pet. 18-22; Ex. 1002 ¶¶ 55-59.) Likewise, “[n]ames held by an NBNS are given a lifetime during name registration. The NBNS will consider a name to have been silently released if the end-node fails to send a name refresh message to the NBNS before the lifetime expires.” (Ex. 1004 at 396; *see also* Pet. 26-27; Ex. 1002 ¶¶ 65-66.)

**Third**, “when a first unit sends a query to the [WINS/NetBIOS] server, the latter ‘searches the database to determine whether the callee is logged-in by finding any stored information corresponding to the callee’s [WINS or NetBIOS name] indicating that the callee is active and on-line.’” Slip Op. at 11 (citing ’704 patent at 5:57–60). WINS discloses that “a name query request is sent first to the WINS server . . . . If the name is found in the WINS database, the client can establish a

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