

Case No. IPR2015-00198

Patent No. 6,009,469

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC., TOSHIBA CORP.,
VIZIO, INC., HULU, LLC,
CISCO SYSTEMS, INC. and AVAYA INC.,

Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.
Patent Owner.

Case No. IPR2015-00198¹

Patent No. 6,009,469

**PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE TO
PETITION FOR INTER PARTES REVIEW OF U.S. PATENT
6,009,469**

¹ IPR2015-01400 has been joined with this proceeding.

I. INTRODUCTION

Patent Owner's opposition is remarkable for what it admits. Patent Owner concedes that WINS, NetBIOS, and Pinard disclose *all* of the following elements: “point-to-point communication;” “point-to-point communication link;” “program code for determining the currently assigned network protocol address . . . upon connection to the computer network;” and “determining the currently assigned network protocol address . . . upon connection to the computer network.” Resp. 57–58.² Left with precious little territory on which to defend the '469 patent, Patent Owner must deploy five last-ditch arguments, each of which is contradicted by prior rulings, the '469 patent itself, and the prior-art references.

First, Patent Owner recycles its statutory-bar argument that the Board already rejected in its Decision instituting trial. Paper 24 at 6–9. Several other panels are in accord. *See Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, Paper 166 at 14 (P.T.A.B. Sept. 2, 2014) (“A civil action for a declaratory judgment of non-infringement is not a civil action challenging the validity of a

² This reply brief uses the following abbreviations: “the '469 patent” means U.S. Pat. No. 6,009,469; “WINS” means the user manual for Version 3.5 of Microsoft's Windows NT Server software (Ex. 1003); “NetBIOS” means the NetBIOS Technical Standard (Ex. 1004); “Pinard” means U.S. Patent No. 5,533,110 to Deborah Pinard *et al.* (Ex. 1020).

patent.”); *Brinkman Corp. v. A&J Mfg., LLC*, IPR2015-00056, Paper 10 at 7–8 (P.T.A.B. Mar. 23, 2015) (holding that service of an International Trade Commission complaint does not trigger the one-year bar). Those decisions are correct, and Patent Owner offers no new reason to revisit them.

Second, although no construction of the term “process” is necessary, WINS and NetBIOS disclose a “process” even under Patent Owner’s proposed construction: “a running instance of a computer program or application.” WINS in combination with NetBIOS teaches a process for registering and tracking the on-line status of an instance of the Windows NT 3.5 or Windows for Workgroups 3.11 operating system running on a computer coupled to the network. An operating system is a computer program, and therefore constitutes a “process” under Patent Owner’s construction.

Third, Patent Owner’s proposed construction of the terms “connected to the computer network,” “on-line,” and “accessible” as excluding registration with a server impermissibly excludes every embodiment in the patent and is therefore erroneous as a matter of law. *See Kaneka Corp. v. Xiamen Kingdomway Grp. Co.*, 790 F.3d 1298, 1304 (Fed. Cir. 2015).

Fourth, a person of ordinary skill in the art would have been motivated to combine the user interface of Pinard with a WINS/NetBIOS system. The ’469 patent itself teaches that one of ordinary skill in the art understood how to

substitute one user interface for another. *See* Ex. 1001 at 15:34-39 (“[O]ther graphic user interface environments such as those compatible with the Macintosh, X-Windows or OS/2 operating systems, may be substituted via the Plug and Play protocol, as would be understood by those reasonably skilled in the arts.”). And Pinard contains an express teaching that it may be combined with the Windows operating system.

Fifth, the “unique identifier” limitation is disclosed by WINS and NetBIOS. Indeed, the WINS Manual states that the WINS name is a “unique identifier[.]” Ex. 1003 at 64. And NetBIOS—which WINS incorporates—discloses that “[a]n application, representing a resource, registers one or more names that it wishes to use.” Ex. 1004 at 378. Therefore, the WINS/NetBIOS name satisfies the unique identifier limitation under all proposed constructions.

Because each of Patent Owner’s arguments lack merit, Petitioner respectfully requests that the Board determine that claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of the ’469 patent are unpatentable.

II. PATENT OWNER’S STATUTORY BAR ARGUMENTS CONTRADICT PRIOR BOARD RULINGS.

As the Board concluded in its May 15, 2015 Decision instituting *inter partes* review, Petitioner was not barred from filing its Petition under 35 U.S.C. § 315.

Paper 24 6–9.

A. Hulu’s Complaint in Intervention sought only a declaration of non-infringement.

Patent Owner argues that Petitioner Hulu pled a cause of action for invalidity in its intervention complaint. Prelim. Resp. 4. That is demonstrably false. Hulu’s Complaint in Intervention *only* alleges a cause of action for noninfringement. *See, e.g.*, Ex. 2003 at 2 (“Hulu seeks a declaratory judgment of non-infringement”), 3–4 (describing Hulu’s three causes of action). Indeed, the words “invalid” and “invalidity” do not appear anywhere in Hulu’s Complaint in Intervention. *See generally* Ex. 2003. As the Board has explained, “[a] civil action for a declaratory judgment of non-infringement is *not* a civil action challenging the validity of a patent.” *Ariosa Diagnostics*, IPR2012-00022, Paper 166 at 14 (emphasis added). That is because the statutory bar applies only to a petitioner that “filed a civil action challenging the *validity* of a claim of the patent” before filing its petition for *inter partes* review. 35 U.S.C. § 315(a)(1) (emphasis added).

Patent Owner attempts to avoid the unambiguous language of Hulu’s Complaint in Intervention by selectively quoting Hulu’s Motion to Intervene. Patent Owner cites no decision holding that language in a motion to intervene can transform the allegations in a complaint, with good reason. Hulu bore the burden of demonstrating the propriety of its intervention in the district court case against its partners LGE, Toshiba, and VIZIO; it logically followed that Hulu would

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