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Paper 11
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIPNET EU S.R.O.
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.
Patent Owner.

Case IPR2013-00246
Patent 6,108,704

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

DESHPANDE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Petitioner, Sipnet EU S.R.O. (“Sipnet”), filed a petition to institute an *inter partes* review of claims 1-7 and 32-42 of U.S. Patent 6,108,704 (the “’704 patent”). Paper 1 (“Pet.”). Patent Owner, Straight Path IP Group (“Straight Path”) (formerly known as Innovative Communications Technologies, Inc.), timely filed a preliminary response. Paper 8 (“Prelim. Resp.”). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a) which provides as follows:

THRESHOLD -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Petitioner contends that the challenged claims are unpatentable under 35 U.S.C. §§ 102 and/or 103 on the following specific grounds (Pet. 17-58):

Reference(s)	Basis	Claims challenged
Messenger – Ryan ¹ and Messenger – NT Unleashed ²	§ 102, § 103	1-7 and 32-42
NetBIOS ³ or WINS ⁴ in view of Messenger – Ryan and Messenger – NT Unleashed	§ 103	1-7 and 32-42

¹ Ralph Ryan, LAN MANAGER 2.0 (Megan E. Sheppard et al. eds. 1990) (Ex. 1011) (“Messenger – Ryan”).

² Robert Cowart et al., WINDOWS NT UNLEASHED (Cindy Morrow et al eds., 1994) (Ex. 1012) (“Messenger – NT Unleashed”).

³ THE OPEN GROUP, TECHNICAL STANDARD – PROTOCOLS FOR X/OPEN PC INTERNETWORKING/SMB, VERSION 2 (1992) (Ex. 1003) (“NetBIOS”).

⁴ WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1004) (“WINS”).

Reference(s)	Basis	Claims challenged
NetBIOS in view of WINS	§ 103	1-7 and 32-42
NetBIOS	§ 102	1-7 and 32-42
WINS	§ 102	1-7 and 32-42
DNS 1 ⁵ , DNS 2 ⁶ , and DNS Orig. ⁷	§ 102, § 103	1-7 and 32-42
DEC '652 ⁸	§ 102	1, 2, and 4-6
DNS 1, DNS 2, and DNS Orig. in view of VocalTec ⁹ , Taligent '278 ¹⁰ , or '704 ¹¹	§ 103	1-7 and 32-42

For the reasons given below, we grant the petition and institute an *inter partes* review of claims 1-7 and 32-42.

B. The '704 Patent

The '704 patent (Ex. 1001) is titled "Point-to-Point Internet Protocol" and generally relates to establishing a point-to-point communication link. Ex. 1001 col. 2, ll. 53-57. The patent explains that a first processing unit automatically transmits its associated e-mail address, and its dynamically allocated IP address, to

⁵ Susan Thomson et al., DNS Dynamic Updates, IETF DNSIND WORKING GROUP, July 14, 1994 (Ex. 1006) ("DNS1").

⁶ Susan Thomson et al., DNS Dynamic Updates, FOILS, July 1994 (Ex. 1007) ("DNS2").

⁷ P. Mockapetris, RFC1034, Domain Names – Concepts and Facilities (Ex. 1013) ("DNS Orig.").

⁸ U.S. 5,483,652 (Ex. 1010) ("DEC '652").

⁹ VocalTec ware lets users make voice calls over 'Net, NETWORK WORLD, Feb. 13, 1995 (Ex. 1014) ("VocalTec").

¹⁰ U.S. 5,566,278 (Ex. 1015) ("Taligent '278")

¹¹ U.S. 6,108,704 (Ex. 1001) ("'704").

a connection server. *Id.* at col. 5, ll. 25-38. The connection server stores the addresses in a database and, thus, the first processing unit is established as an active on-line party available for communication. *Id.* The first processing unit sends a query to the connection server, which searches the database to determine whether a second processing unit is active and on-line. *Id.* at col. 5, ll. 55-60. If the callee is active and on-line, the connection server sends the IP address of the callee from the database to the first processing unit, i.e., performs a point-to-point Internet protocol communication. *Id.* at col. 5, ll. 60-64. The first processing unit then directly establishes the point-to-point Internet communications with the callee using the retrieved IP address. *Id.* at col. 5, ll. 64-67.

Figure 1 of the '704 patent is reproduced below:

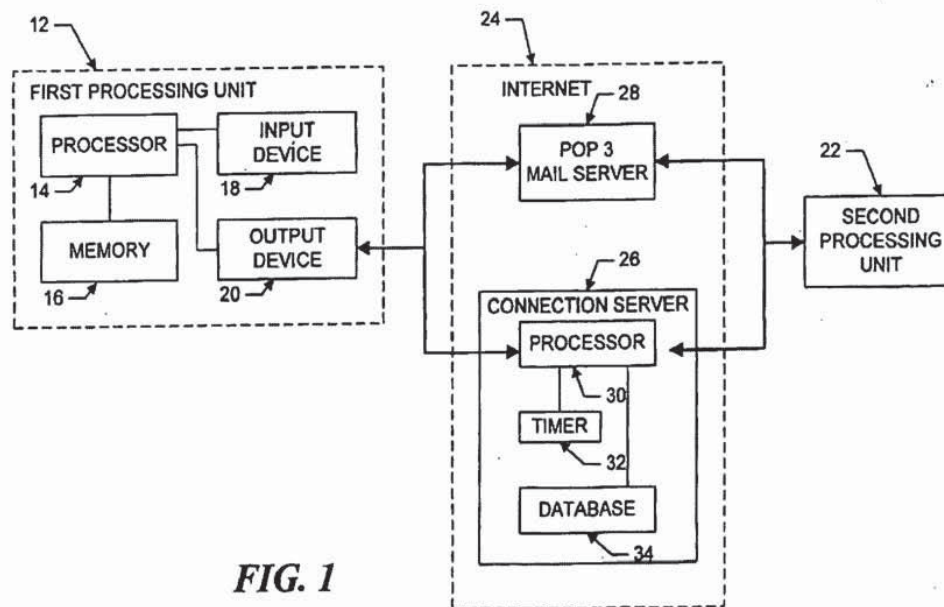


FIG. 1

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

Claim 1 illustrates the claimed subject matter and is reproduced below:

1. A computer program product for use with a computer system, the computer system executing a first process and operatively connectable to a second process and a server over a computer network, the computer program product comprising:

a computer usable medium having program code embodied in the medium, the program code comprising:

program code for transmitting to the server a network protocol address received by the first process following connection to the computer network;

program code for transmitting, to the server, a query as to whether the second process is connected to the computer network;

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

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

C. Claim Construction

Consistent with the statute and the legislative history of the AIA, the Board will interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012); 37 CFR § 42.100(b).

1. "connected to the computer network"

Petitioner, under the broadest reasonable construction, contends that "connected to a computer network" encompasses merely being "on-line." Pet. 5-6. Petitioner further contends that "connected to a computer network" simply requires being registered with the server based on the usage of this phrase in the '704 patent

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