

Case No. IPR2015-00209

Patent No. 6,108,704

Paper No. \_\_\_\_\_

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., AND AVAYA INC.,  
Petitioner

v.

STRAIGHT PATH IP GROUP, INC.  
Patent Owner

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Case No. IPR2015-00209<sup>1</sup>  
Patent No. 6,108,704

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**PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE TO  
PETITION FOR INTER PARTES REVIEW OF U.S. PATENT  
6,108,704**

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<sup>1</sup> IPR2015-01398 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. 58–59.<sup>2</sup> Left with precious little territory on which to defend the '704 patent, Patent Owner must deploy four last-ditch arguments, each of which is contradicted by prior rulings, the '704 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 20 at 6–9. Several other panels are in accord. *See e.g., 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

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<sup>2</sup> This reply brief uses the following abbreviations: “the '704 patent” means U.S. Pat. No. 6,108,704; “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).

judgment of non-infringement is not a civil action challenging the validity of a 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” and “on-line” 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 ’704

patent itself teaches that one of ordinary skill in the art understood how to substitute one user interface for another. Pinard contains an express teaching that it may be combined with the Windows operating system.

Because each of Patent Owner's arguments lack merit, Petitioners respectfully request that the Board determine that claims 1, 11–12, 14, 16, 19, 22–23, 27, and 30–31 of the '704 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 20 at 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*, 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 describe *all* of the interests it shared with those partners, including those partners’ affirmative defenses and counterclaims of invalidity. *See, e.g.*, Ex. 2001 at 10–11 (describing commonalities between Hulu and its partners). But Hulu’s arguments in favor of intervention do not—indeed, cannot—alter the plain language of Hulu’s Complaint in Intervention, which explicitly and solely asserted causes of action for declaratory judgment of non-infringement and requested relief related to non-infringement. *See* Ex. 2003 at 2–5. Hulu’s complaint therefore complies with Section 315(a)(1), as the Board has already concluded. Paper 20 at 6–7.

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