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

Patent No. 6,108,704

Filing Date: September 25, 1995

Issue Date: August 22, 2000

Title: POINT-TO-POINT INTERNET PROTOCOL

Inter Partes Review No. IPR2013-00246, Filing Date April 11, 2013

PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.120



Table of Contents

INTI	RODU	CTION	1		
I.	BAC	BACKGROUND FACTS			
II.		PETITIONER'S REQUEST FOR <i>INTER PARTES</i> REVIEW AND THE BOARD'S DECISION TO INSTITUTE			
ARC	SUME	NT	7		
I.	THE	LKER SOFTWARE IS A REAL PARTY-IN-INTEREST IN PROCEEDING; THEREFORE THE PROCEEDING SHOULD DISMISSED	8		
	A.	Stalker Software is Estopped from Initiating an <i>Inter Partes</i> Review under 37 CFR § 42.101	8		
	В.	Stalker Software is a Real Party-in-Interest Because Stalker Software Provided the WINS Prior Art to Petitioner	9		
	C.	Dismissal of the Proceeding and Sanctions are Appropriate Under 37 CFR § 42.12 Due to Sipnet's Misrepresentation of the Real Party-in-Interest	14		
II.	DET	THE PRIOR ART DOES NOT TEACH A QUERY OR A DETERMINATION AS TO THE ON-LINE STATUS OF A PROCESS, AS REQUIRED BY EACH CHALLENGED CLAIM			
	A.	Legal Standards	18		
	В.	Each Challenged Claim Require a Query or a Determination as to On-Line Status of the Second Process	19		
	C.	The Specification Fully Supports that the Challenged Claims Require a Query or a Determination as to On-Line Status	25		
	D.	Neither NetBIOS nor WINS Teaches a Query or a Determination as to the On-Line Status of the Second Process	31		



CASE NO. IPR2013-00246 US PATENT 6,108,704

		1.	In NetBIOS, Registration of a Node Does Not Teach a Query or a Determination as to the On- Line Status of the Second Process	33	
		2.	Petitioner Fails to Demonstrate That NetBIOS Teaches a Query or a Determination of the On- Line Status of the Second Process	36	
		3.	In WINS, Registration of a Computer Does Not Teach a Query or a Determination as to the On- Line Status of the Second Process	39	
		4.	Petitioner Fails to Demonstrate That WINS Teaches a Query or a Determination of the On- Line Status of the Second Process	44	
	E.	Neither NetBIOS Nor WINS Teach Additional Limitations Found in Dependent Claims 5, 6, and 7			
	F.		37 Are Not Rendered Obvious by NetBIOS in View	49	
III. NETBIOS DOES NOT TEACH DYNAMIC ADDRESS ALLOCATION, AS REQUIRED BY EACH CHALLENGED CLAIM					
	A.	The Claims and Specification Require Dynamic Address Allocation			
	B.	NetBIOS D	Ooes Not Teach Dynamic Addressing	53	
IV.	PETITIONER HAS FAILED TO ESTABLISH THAT WINS IS PRIOR ART				
CON	CHIS	ION		60	



Table of Authorities

Cases
Bayer Healthcare Pharms., Inc. v. Watson Pharms., Inc., 713 F.3d 1369 (Fed. Cir. 2013)
Bruckelmyer v. Ground Heaters, Inc., 445 F.3d 1374 (Fed. Cir. 2006)54
<i>CFMT, Inc. v. YieldUp Int'l Corp.</i> , 349 F.3d 1333 (Fed. Cir. 2003)
Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560 (Fed. Cir. 1988)58
Finjan, Inc. v. Symantec Corp., 2013 WL 5302560 (Sept. 19, 2013 D. Del.)
In re Bond, 910 F.2d 831 (Fed. Cir. 1990)
In re Guan Inter Partes Reexamination Proceeding, Control No. 95/001,045, "Decision Vacating File Date," (Aug. 25, 2008)
<i>In re Hall</i> , 781 F.2d 897 (Fed. Cir. 1986)58
<i>In re Suitco Surface, Inc.</i> , 603 F.3d 1255 (Fed. Cir. 2010)
In re Wyer, 655 F.2d 221 (CCPA 1981)54
Norian Corp. v. Stryker Corp., 363 F.3d 1321 (Fed. Cir. 2004)55
Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931 (Fed. Cir. 1990)54
Rackable Systems, Inc. v. Super Micro Computer Inc., 2007 WL 1223807 (April 25, 2007 N.D. Cal.)59



CASE NO. IPR2013-00246 US PATENT 6,108,704

ResQNet.com, Inc. v. Lansa, Inc., 533 F. Supp. 2d 397 (S.D.N.Y. 2008)	54
ResQNet.com, Inc. v. Lansa, Inc., 594 F.3d 860 (Fed. Cir. 2010)	55
Verizon Servs. Corp. v. Cox Fibernet Va., Inc., 602 F.3d 1325 (Fed. Cir. 2010)	19
Vizio, Inc. v. ITC, 605 F.3d 1330 (Fed. Cir. 2010)	49
Statutes 35 U.S.C. § 312	18
35 U.S.C. § 316	18
Regulations 37 C.F.R. § 42.101	1, 8, 9
37 C.F.R. § 42.104	18
37 C F R & 42 22	18

DOCKET

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

