

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC. and AVAYA, INC.,
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.

Case IPR2015-01007
Patent 6,009,469 C1

Before KALYAN K. DESHPANDE, TRENTON A. WARD, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Cisco System, Inc. and AVAYA, Inc. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of U.S. Patent No. 6,009,469 C1 (Ex. 1001, “the ’469 patent”). Paper 3 (“Pet.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” After considering the Petition and associated evidence, we conclude that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing unpatentability of all the challenged claims. Thus, we authorize institution of an *inter partes* review of claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of the ’469 patent.

A. Related Proceedings

Petitioner indicates that the ’469 patent is the subject of *Straight Path IP Grp., Inc. v. Cisco Sys., Inc.*, No. 3:14-cv-04312 (N.D. Cal.) and *Straight Path IP Grp., Inc. v. AVAYA, Inc.*, No. 3:14-cv-04309 (N.D. Cal.). Pet. 2. Petitioner also indicates that the ’469 patent is the subject of *Certain Point-to-Point Network Commc’n Devices and Prods. Containing Same*, Inv. No. 337-TA-892 (USITC). *Id.* at 4. Petitioner indicates that the ’469 patent is also the subject of *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01367 (PTAB) and *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, IPR2015-00198 (PTAB). *Id.* at 1–2.

Petitioner further indicates that the ’469 patent is related to U.S. Patent No. 6,108,704 (“the ’704 patent”) and U.S. Patent No. 6,131,121 (“the ’121 patent”). *Id.* at 1. The ’704 patent was the subject of *Sipnet EU*

S.R.O. v. Straight Path IP Grp., Inc., IPR2013-00246 (PTAB) (“*Sipnet*”).
Id. at 2. The ’704 patent and the ’121 patent are the subject of *Samsung Elecs., Co. v. Straight Path IP Grp., Inc.*, IPR2014-01366 (PTAB), and *Samsung Elecs., Co. v. Straight Path IP Grp., Inc.*, IPR2014-01368 (PTAB), respectively. *Id.* at 1–2. The ’704 patent and ’469 patent are also the subject of *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, IPR2015-00209 (PTAB), and *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, IPR2015-00196 (PTAB), respectively. *Id.* at 2.

B. Illustrative Claim

Petitioner challenges claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of the ’469 patent. Pet. 37–60. Independent claim 1 is illustrative of the claims at issue and follows:

1. A computer program product for use with a computer system having a display, the computer system capable of executing a first process and connecting to other processes and a server process over a computer network, the computer program product comprising a computer usable medium having computer readable code means embodied in the medium comprising:
 - a. program code for generating a user-interface enabling control of a first process executing on the computer system;
 - b. program code for determining the currently assigned network protocol address of the first process upon connection to the computer network;
 - c. program code responsive to the currently assigned network protocol address of the first process, for establishing a communication connection with the server process and for forwarding the assigned network protocol address of the first process and a unique identifier of the first process to the server process upon establishing a communication connection with the server process; and

- d. program code, responsive to user input commands, for establishing a point-to-point communications with another process over the computer network.

C. The Alleged Grounds of Unpatentability

The information presented in the Petition sets forth Petitioner’s contentions of unpatentability of claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of the ’469 patent under 35 U.S.C. §§ 102, 103(a), as follows (*see* Pet. 7, 37–60):

Reference(s)	Basis	Claims Challenged
Microsoft Manual ¹	§ 102(a)	1–3, 5, 6, and 9 ²
Microsoft Manual and NetBIOS ³	§ 103(a)	1–3, 5, 6, and 9 ⁴
Microsoft Manual, NetBIOS, and Palmer ⁵	§ 103(a)	9, 10, 14, 17, and 18
Microsoft Manual, NetBIOS, Palmer, and Pinard ⁶	§ 103(a)	1, 9, and 14

¹ MICROSOFT WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1012, “Microsoft Manual”).

² Although Petitioner first identifies claim 17 as challenged under this ground, Petitioner’s argument and claim charts do not include claim 17. Accordingly, we do not understand Petitioner to have challenged claim 17 under this ground. *Compare* Pet. 7 *with id.* at 37–48.

³ THE OPEN GROUP, TECHNICAL STANDARD, PROTOCOLS FOR X/OPEN PC INTERWORKING:SMB, VERSION 2.0 (1992) (Ex. 1014, “NetBIOS”).

⁴ Although Petitioner first identifies claim 17 as challenged under this ground, Petitioner’s argument and claim charts do not include claim 17. Accordingly, we do not understand Petitioner to have challenged claim 17 as part of this ground. *Compare* Pet. 7 *with id.* at 37–48.

⁵ U.S. Patent No. 5,375,068, issued Dec. 20, 1994 (Ex. 1020, “Palmer”).

⁶ U.S. Patent No. 5,533,110, issued July 2, 1996 (Ex. 1021, “Pinard”).

Reference(s)	Basis	Claims Challenged
Microsoft Manual, NetBIOS, Palmer, Pinard, and Pitkin ⁷	§ 103(a)	3, 6, and 9 ⁸

II. ANALYSIS

Petitioner argues that claims 1–3, 5, 6, and 9 are unpatentable under 35 U.S.C. § 103 (a) as obvious over Microsoft Manual and NetBIOS, and claims 10, 14, 17, and 18 are unpatentable under 35 U.S.C. § 103 as obvious over Microsoft Manual, NetBIOS, and Palmer. Pet. 7, 37–54. Petitioner submits arguments and evidence identical to those submitted in IPR2014-01367. Pet. 5. Petitioner proposes the same claim construction and argues the same rationale of unpatentability of claims 1–3, 5, 6, 9, 10, 14, 17, and 18 as presented in IPR2014-01367. Pet. 7, 24–54; *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01367, Paper 1, 4–5, 21–49. Petitioner further relies on the same Declaration by Dr. Henry Houh in support of the alleged grounds of unpatentability. Pet. 37–54; Ex. 1004. Straight Path IP Group, Inc. (“Patent Owner”) and Petitioner filed a stipulated proposed order defining the parameters of joinder. *See* Paper 10.

We determined that the Petitioner in IPR2014-01367, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, “Samsung”),

⁷ U.S. Patent No. 5,341,477, issued Aug. 23, 1994 (Ex. 1015, “Pitkin”).

⁸ Although Petitioner first identifies claims 1 and 5 as challenged under this ground, Petitioner’s argument does not include claims 1 and 5. Accordingly, we do not understand Petitioner to have challenged claims 1 and 5 as part of this ground. *Compare* Pet. 5 *with id.* at 53–54.

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