

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 IPR2015-01011
Patent 6,108,704 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 Systems, Inc. and AVAYA, Inc. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704 C1 (Ex. 1001, “the ’704 patent”). Paper 2 (“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, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of the ’704 patent.

A. Related Proceedings

Petitioner indicates that the ’704 patent is the subject of *Straight Path IP Grp., Inc. v. Cisco Systems, 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 ’704 patent is the subject of *Certain Point-to-Point Network Commc’n. Devices and Products Containing Same*, Inv. No. 337-TA-892 (USITC). *Id.* at 4. Petitioner indicates that the ’704 patent is also the subject of *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01366 (PTAB) and *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, IPR2015-00209 (PTAB). *Id.* at 1–2. 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.

Petitioner further indicates that the '704 patent is related to U.S. Patent No. 6,009,469 (“the '469 patent”) and U.S. Patent No. 6,131,121 (“the '121 patent”). *Id.* at 1. The '469 patent and the '121 patent are the subject of *Samsung Elecs., Co. v. Straight Path IP Grp., Inc.*, IPR2014-01367 (PTAB), and *Samsung Elecs., Co. v. Straight Path IP Grp., Inc.*, IPR2014-01368 (PTAB), respectively. *Id.* at 1–2. The '121 patent and '469 patent are also the subject of *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, IPR2015-00196 (PTAB), and *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, IPR2015-00198 (PTAB), respectively. *Id.* at 2.

B. Illustrative Claim

Petitioner challenges claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of the '704 patent. Pet. 34–60. Independent claim 1 is illustrative of the claims at issue and follows:

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. The Alleged Grounds of Unpatentability

The information presented in the Petition sets forth Petitioner’s contentions of unpatentability of claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of the ’704 patent under 35 U.S.C. §§ 102, 103(a), as follows (*see* Pet. 7, 34–60):

Reference(s)	Basis	Claims Challenged
Microsoft Manual ¹	§ 102(a)	1, 11, 12, 22, and 23
Microsoft Manual and NetBIOS ²	§ 103(a)	1, 11, 12, 22, and 23
Microsoft Manual, NetBIOS, and Palmer ³	§ 103(a)	11, 12, 14, 16, 22, 23, 27, 30, and 31
Microsoft Manual, NetBIOS, Palmer, and Pinard ⁴	§ 103(a)	11, 12, 14, 16, 22, 23, 27, 30, and 31
Microsoft Manual, NetBIOS, Palmer, Pinard, and Pitkin ⁵	§ 103(a)	1, 11, 12, 14, 16, 22, 23, 27, 30, and 31

II. ANALYSIS

Petitioner argues that claims 1, 11, 12, 22, and 23 are unpatentable under 35 U.S.C. § 103 as obvious over Microsoft Manual and NetBIOS, and

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

² THE OPEN GROUP, TECHNICAL STANDARD, PROTOCOLS FOR X/OPEN PC INTERWORKING: SMB, VERSION 2.0 (1992) (Ex. 1014, “NetBIOS”).

³ U.S. Patent No. 5,375,068, issued Dec. 20, 1994 (Ex. 1020, “Palmer”).

⁴ U.S. Patent No. 5,533,110, issued July 2, 1996 (Ex. 1021, “Pinard”).

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

claims 11, 12, 14, 16, 22, 23, 27, 30, and 31 are unpatentable under 35 U.S.C. § 103 as obvious over Microsoft Manual, NetBIOS, and Palmer. Pet. 7, 35–54. Petitioner submits arguments and evidence identical to those submitted in IPR2014-01366. Pet. 5. Petitioner proposes the same claim construction and argues the same rationale of unpatentability of claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 as presented in IPR2014-01366. Pet. 7, 23–54; *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01366, Paper 1, 5, 20–49. Petitioner further relies on the same Declaration by Dr. Henry Houh in support of the alleged grounds of unpatentability. Pet. 35–54; 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 IPR2014-01366, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, “Samsung”), demonstrated a reasonable likelihood of prevailing in establishing the unpatentability of claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of the ’704 patent. *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, IPR2014-01366, slip op. at 11–20 (Paper 12). We granted that Petition and instituted an *inter partes* review of claims 1, 11, 12, 22, and 23 under 35 U.S.C. § 103 as obvious over Microsoft Manual and NetBIOS, and claims 14, 16, 27, 30, and 31 under 35 U.S.C. § 103 as obvious over Microsoft Manual, NetBIOS, and Palmer. *Id.* at 22.

Accordingly, we incorporate our previous analysis, including our claim interpretation analysis (*see id.* at 5–11) and our analysis regarding this asserted ground of unpatentability (*see id.* at 11–20), from IPR2014-01366,

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.