

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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

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

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

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Straight Path IP Group, Inc., formerly Innovative Communications Technologies, Inc. (“Patent Owner”) respectfully submits this Response opposing the Petition for *Inter Partes* Review filed by SIPNET EU S.R.O. (“Petitioner”) in connection with U.S. Patent No. 6,108,704 (“the ’704 Patent”).

### INTRODUCTION

This response presents four issues for the Board’s consideration:

1. Under 37 C.F.R. § 42.101(b), a real party-in-interest is estopped from filing a petition for *inter partes* review if the entity had been served with a complaint for patent infringement more than one year earlier. Patent Owner served Stalker Software, Inc. with a complaint for patent infringement of the ’704 Patent more than a year prior to the filing of the instant petition. Although Petitioner represented that Sipnet is the only real party-in-interest of this proceeding, Petitioner has now admitted that Stalker Software provided Petitioner with the WINS reference that has been used to challenge the patentability of claims 1-7 and 32-42. Under *In re Guan*, an entity that provides the prior art on which the *inter partes* review is to be based is a real party-in-interest. Stalker Software is thus a real party-in-interest and the proceeding should be dismissed in its entirety pursuant to 37 C.F.R. § 42.101(b). In addition, sanctions are warranted in the form of a dismissal and attorney fees under 37 CFR § 42.12 as a result of Petitioner’s misrepresentation that Sipnet is the only real party-in-interest.

2. The challenged claims of the '704 Patent each require a query or a determination regarding the on-line status of a process in order to establish a point-to-point communication link between two processes. The NetBIOS and WINS references do not teach ascertaining the on-line status of a process (a computer program running on a computer), or even the on-line status of the computer itself. As confirmed by technical expert Professor Ketan Mayer-Patel, the references each teach that the identified query only requests the network address of a second computer, and in addition, that the response to the query is sent without determining whether the second computer is on-line with the network. WINS, which is an implementation of the NetBIOS protocol, specifically teaches that a query of its database is not a query or a determination as to the on-line status of a process running on a computer or whether the computer itself is running. WINS “does not ensure that the related device is currently running, only that a computer claimed the particular IP address” is in its database.<sup>1</sup> As a result, neither NetBIOS

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<sup>1</sup> Ex. 1004, Windows NT 3.5, TCP/IP User Guide (“WINS”) at 57. Ex. 1004 includes page numbers indicated by the publication itself and different page numbers provided by Petitioner. All references herein will be to the page numbers as printed in WINS itself, not the page numbers provided by Petitioner.

nor WINS alone or in combination teaches a query or a determination as to the on-line status of a process.

3. The challenged claims of the '704 Patent each require that the network address be assigned "following connection to the computer network." The Examiner in a previous reexamination concluded that this language required dynamic assignment of network addresses, and Professor Mayer-Patel agrees with that conclusion. The Board has already identified that the NetBIOS reference does not teach dynamic address assignment. Therefore, NetBIOS does not anticipate any challenged claim.

4. Petitioner has the burden to establish that the WINS reference was a publicly available document and therefore qualifies as prior art. Petitioner has admitted that it only obtained the WINS reference from Stalker Software. Patent Owner has requested confirmation from Petitioner that the WINS reference was a publicly available document. Petitioner has repeatedly failed to provide evidence to address the public availability of WINS. As Petitioner has been unable to satisfy its burden, the WINS reference cannot form the basis of Petitioner's anticipation and obviousness arguments

Accordingly, Straight Path respectfully requests confirmation of the challenged claims, for the reasons explained more fully below.



## I. BACKGROUND FACTS

The '704 Patent is entitled "Point-to-point internet protocol," and was filed September 25, 1995 and issued on August 22, 2000. As stated in the Abstract of the '704 Patent, the claimed invention relates generally to "[a] point-to-point Internet protocol [that] exchanges Internet Protocol (IP) addresses between processing units ... *that have an on-line status* with respect to the Internet ..., transmitting a query ... *to determine the on-line status* of a second processing unit, ... for establishing a point-to-point communication link between the first and processing units."<sup>2</sup>

The '704 Patent was previously the subject of *Ex Parte* Reexamination Control No. 90/010,416, initiated on February 17, 2009 (the "Previous Reexamination"). The Patent Office instituted the *ex parte* reexamination and initially rejected claims 1-7, 11-20, and 22-42 as being obvious over NetBIOS in combination with at least one other reference.<sup>3</sup> On October 26, 2010, the Patent Office issued a Reexamination Certificate confirming the patentability of claims 1-7 and 32-42 over NetBIOS.<sup>4</sup>

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<sup>2</sup> U.S. Patent No. 6,108,704 ("'704 Patent") at Abstract (emphasis added).

<sup>3</sup> Ex. 2002, Request for Ex Parte Reexamination at 1.

<sup>4</sup> Ex. 2003, Reexamination Certificate.

In the Previous Reexamination, Patent Owner demonstrated that the limitations including “network protocol address[es] received ... *following connection to the computer network*” established a dynamic element that was not present in the submitted prior art.<sup>5</sup> Specifically, Patent Owner noted that the asserted NetBIOS reference did not demonstrate actions “following connection to the computer network” as required by claims 1-7 and 32-42. The Patent Office ultimately confirmed the patentability of the claims under reexamination. The Office explained that the prior art did not teach or disclose the dynamic addressing limitation required by the challenged claims.<sup>6</sup>

## **II. PETITIONER’S REQUEST FOR *INTER PARTES* REVIEW AND THE BOARD’S DECISION TO INSTITUTE**

Sipnet’s Petition requested cancellation of claims 1-7 and 32-42 as anticipated and/or obvious in view of nine different references. The Board’s Decision narrowed the issues for *inter partes* review to (1) anticipation of claims 1-

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<sup>5</sup> See, e.g., Ex. 2004, Response to Non-Final Rejection in a Re-Examination at 7. (“NetBIOS does not provide dynamic addressing or on-line status...[T]he claim mapping does not allege, much less prove, that NetBIOS teaches ‘the network protocol address of each respective process forwarded to the database *following connection to the computer network.*’”) (emphasis in original).

<sup>6</sup> Ex. 2005, Notice of Intent to Issue Ex Parte Reexamination Certificate at 2-3.

7, 32, and 38-42 by NetBIOS, (2) anticipation of claims 1-7 and 32-42 by WINS,<sup>7</sup> and (3) obviousness of claims 33-37 by NetBIOS in view of WINS. The Board noted that an obviousness argument was required for claims 33-37 because independent claim 33 recited a “dynamic assignment of addresses,” which is not taught by the NetBIOS reference.

Petitioner requested that, under this broadest reasonable construction standard, “‘connected/online’ is simply ‘online.’”<sup>8</sup> The Board’s Decision to Institute stated that “‘connected to the computer network’ encompasses being ‘on-line.’”<sup>9</sup> The Board noted that “the ’704 Patent specification discloses ‘...the

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<sup>7</sup> The Board’s Decision to Institute concluded that the Petition was granted as to “Anticipation of claims 1-7 and 38-42 by WINS.” *See* Decision at 20. However, in the body of the Decision, the Board stated, “With respect to the remaining dependent claims 2-7 and 32-42, we have reviewed Petitioner’s supporting evidence and determine that Petitioner has met its burden under 35 U.S.C. § 314(a) [with respect to WINS].” *See* Decision at 14. Out of an abundance of caution, Patent Owner provides arguments that all of the challenged claims, including claims 32-37 are not anticipated by WINS.

<sup>8</sup> IPR2013-00246, Paper No. 1 Petition for *Inter Partes* Review (“Petition”) at 6.

<sup>9</sup> IPR2013-00246, Paper No. 11 Decision: Institution of *Inter Partes* Review (“Decision”) at 5.

second processing unit 22, upon connection to the Internet 24 through a connection service provider, is processed by the connection server 25 to be established in the database 34 as an active on-line party,” and that a construction of “connected to the computer network” as “being ‘on-line’” “is both reasonable and consistent with the ’704 patent specification.”<sup>10</sup> The Board also found that for the purposes of its Decision to Institute, “‘point-to-point communications link’...include[s] direct communications between two processes over a computer network that are not intermediated by a server.”<sup>11</sup>

### **ARGUMENT**

As explained below, challenged claims 1-7 and 32-42 should be confirmed as patentable because (1) Stalker Software, the real party-in-interest of the proceeding, is estopped from asserting an *inter partes* review against the ’704 Patent; (2) Petitioner has failed to demonstrate that NetBIOS and WINS teach a query or a determination as to the on-line status of the second process; (3) Petitioner has failed to demonstrate that NetBIOS teaches dynamic addressing; and (4) Petitioner has failed to establish WINS as a publicly available prior art reference.

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<sup>10</sup> Decision at 6.

<sup>11</sup> Decision at 6-7.

**I. STALKER SOFTWARE IS A REAL PARTY-IN-INTEREST IN THE PROCEEDING; THEREFORE THE PROCEEDING SHOULD BE DISMISSED**

Stalker Software, Inc. (“Stalker Software”) is a real party-in-interest in this proceeding. Because Stalker Software is estopped from participating in this proceeding and because Sipnet has misrepresented the real party-in-interest of the proceeding, Patent Owner respectfully requests that this *inter partes* review be dismissed in its entirety and that the Board sanction Petitioner by awarding attorney fees.

**A. Stalker Software is Estopped from Initiating an *Inter Partes* Review under 37 CFR § 42.101**

37 C.F.R. § 42.101(b) estops any entity from filing a petition for *inter partes* review regarding a particular patent one year after the entity is served with a complaint for patent infringement: “A person who is not the owner of a patent may file with the Office a petition to institute an *inter partes* review of the patent unless...[t]he petition requesting the proceeding is filed more than one year after the date on which the petitioner, the petitioner’s real party-in-interest, or a privy of the petitioner is served with a complaint alleging infringement of the patent.”

Stalker Software, Inc. sells CommuniGate Pro, a software product that utilizes the system of the ’704 Patent. Patent Owner’s predecessor in interest, Innovative Communication Technologies, Inc., filed a lawsuit against Stalker Software on January 4, 2012, alleging that Stalker Software infringed various

claims of the '704 Patent through the use of its CommuniGate Pro software.<sup>12</sup> The Complaint was served on February 21, 2012.<sup>13</sup> After nearly a year of contentious litigation, the parties settled. As a result of the litigation, under 37 C.F.R. § 42.101(b), Stalker is estopped from filing an *inter partes* review against the claims of the '704 Patent after February 21, 2013. The instant *inter partes* review was filed on April 11, 2013, and therefore Stalker Software was estopped from filing the current *inter partes* review.

**B. Stalker Software is a Real Party-in-Interest Because Stalker Software Provided the WINS Prior Art to Petitioner**

The Office Patent Trial Practice Guide identifies that, “[a]t a general level, the ‘real party-in-interest’ is the party that desires review of the patent itself.”<sup>14</sup> *In re Guan Inter Partes Reexamination Proceeding* sets out the standard for determining whether an entity is the real party-in-interest in *inter partes* review

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<sup>12</sup> Ex. 2021, Complaint against Stalker Software, Inc. at ¶ 3 (“Defendant CommuniGate has infringed and is infringing the '704 Patent, by at least selling, offering to sell, and using VoIP products and/or services, such as CommuniGate Pro Server, that infringe one or more claims of the '704 Patent.”).

<sup>13</sup> Ex. 2022, Summons Issued as to Stalker Software, Inc.

<sup>14</sup> Office Patent Trial Practice Guide at 16.

proceedings.<sup>15</sup> Specifically, *In re Guan* states that an entity “cannot do any of the following and not identify the other entity as real party in interest: . . . 3). Allow another entity to direct or control the content, (e.g., provide the prior patents/printed publications on which the reexam is to be based).”<sup>16</sup>

Petitioner Sipnet is a reseller of Voice over IP (“VOIP”) services in the Czech Republic, Russia and Ukraine.<sup>17</sup> Sipnet’s VOIP offerings are “Powered by CommuniGate Pro.”<sup>18</sup> Stalker Software and Sipnet have an ongoing business relationship through Sipnet’s use and reselling of the CommuniGate Pro software.<sup>19</sup> When the infringement litigation was filed against Stalker in January 2012, Stalker contacted Petitioner to inform the company of the impending

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<sup>15</sup> See *In re Guan Inter Partes Reexamination Proceeding*, Control No. 95/001,045, “Decision Vacating Filing Date,” (Aug. 25, 2008). The Patent Office has adopted the real party-in-interest analysis in *In re Guan* in the *inter partes* review proceedings. See Office Patent Trial Practice Guide at 14-19.

<sup>16</sup> *In re Guan*, “Decision Vacating Filing Date” at 8.

<sup>17</sup> See Ex. 2024, Sipnet-Contacts.

<sup>18</sup> See Ex. 2025, Sipnet.net.

<sup>19</sup> See Ex. 2025, Sipnet.net; see also Ex. 2026, Dec. 10, 2013 Petitioner’s Response to Patent Owner’s Narrowed Discovery Requests of Dec. 6, 2013 at 2.

litigation.<sup>20</sup> By Sipnet's own admission, Stalker Software then provided Petitioner with Exhibit 1004, the WINS reference.<sup>21</sup> Petitioner then utilized the WINS reference for the basis of its anticipation challenges to claims 1-7 and 32-42, and its obviousness challenges to claims 33-37.<sup>22</sup> Under *In re Guan*, the fact that WINS was provided to Sipnet by Stalker Software demonstrates that Stalker Software is a real party-in-interest of the current *inter partes* review.

Petitioner only revealed Stalker's involvement in the instant *inter partes* review after repeated discovery requests by Patent Owner. First, Patent Owner requested information on the real party-in-interest when the Petition was initially filed, but Petitioner refused, claiming that the request would only be proper after institution of *inter partes* review.<sup>23</sup> After institution, Patent Owner again attempted to understand the relationship between Sipnet and Stalker Software.<sup>24</sup> Petitioner

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<sup>20</sup> See Ex. 2026, Dec. 10, 2013 Petitioner's Response to Discovery, at 1.

<sup>21</sup> See Ex. 2026, Dec. 10, 2013 Petitioner's Response to Discovery, at 1.

<sup>22</sup> Paper No. 1, Petition.

<sup>23</sup> Ex. 2011, Correspondence from P. Haughey to P. Lee ("With regard to your letter's specific requests for discovery, these are all premature. The period for patent owner discovery will begin after the Patent Office initiates an Inter Partes Review.").

<sup>24</sup> See Ex. 2027, Oct. 28, 2013 Patent Owner's First Set of Interrogatories at 7.



again objected, this time claiming that Patent Owner's requests were overbroad.<sup>25</sup>

Patent Owner then narrowed its discovery requests, and Petitioner was finally forced to reveal that Stalker Software provided Sipnet with the WINS reference.<sup>26</sup>

Petitioner has continued to refuse to answer discovery requests regarding the financial relationship between Sipnet and Stalker Software, which would present further evidence establishing Stalker Software as the *inter partes* review's real party-in-interest.<sup>27</sup>

In addition, other circumstantial evidence strongly indicates that Stalker Software is controlling this *inter partes* review. First, two of Petitioner's evidentiary witnesses regarding the WINS reference have connections to Stalker Software that were not disclosed by Petitioner. German Myzovsky is the Sipnet

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<sup>25</sup> Ex. 2028, Nov. 26, 2013 Petitioner's Objections to Patent Owner's First Set of Interrogatories.

<sup>26</sup> Ex. 2026, Dec. 10, 2013 Petitioner's Response to Discovery, at 1 ("In October 2012 German Myzovsky contacted Stalker Software, Inc. and asked for a copy of the "Microsoft Windows NT Server 3.5, TCP/IP manual" referred to in the litigation. An electronic copy was provided to him."); *see also In re Guan*, "Decision Vacating Filing Date" at 8.

<sup>27</sup> Ex. 2029, Dec. 20, 2013 Petitioner's Response to Patent Owner's Supplemental Discovery Requests of Dec. 11, 2013 at 6.

employee who was provided the WINS reference by Sipnet. Petitioner stated that Mr. Myzovsky “has no relationship with Stalker Software, Inc. other than as a customer,” but Mr. Myzovsky had worked with Stalker Software at Tario Communications for several years before joining Sipnet.<sup>28</sup> Yuri Kolesnikov, the declarant who has attempted to establish the public availability of WINS, has no apparent connection to Sipnet but use to be featured on Stalker Software’s website as a promoter of its CommuniGate software.<sup>29</sup> Second, Sipnet is a Czech Republican company with offices in the Czech Republic, Russia, and Ukraine, but maintains no presence in the United States.<sup>30</sup> Sipnet has asserted that it is planning to expand into the U.S. market and as a result wants to invalidate the ’704 Patent.<sup>31</sup> However, Sipnet has rejected Straight Path’s offer of a license of the ’704 Patent

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<sup>28</sup> *See, e.g.*, Ex. 2030, CommuniGate- Tario Communications.

<sup>29</sup> *See* Ex. 2031, CommuniGate- Yuri Kolesnikov.

<sup>30</sup> *See* Ex. 2024, Sipnet- Contacts.

<sup>31</sup> Ex. 2032, Dec. 4, 2013 Telephonic Hearing Before the Administrative Patent Judges, at 18:9-17. Notably, Sipnet would in fact be a licensee of Straight Path if Sipnet wished to enter the U.S. market, as a result of the Stalker litigation, which resulted in a license to Stalker to the ’704 Patent for the CommuniGate Pro software. *See* Ex. 2026, Dec. 10, 2013 Petitioner’s Response to Discovery, at 1.

and instead demanded to receive money and an ownership interest in Straight Path in exchange for an agreement to dismiss the *inter partes* review.<sup>32</sup>

Patent Owner respectfully submits that Stalker Software, as the provider of the WINS reference, is a real party-in-interest of this proceeding. Dismissal of this *inter partes* review in its entirety is thus appropriate under 37 C.F.R. § 42.101, as real party-in-interest Stalker Software is unable to maintain this proceeding.

**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**

Dismissal of this proceeding and sanctions are also appropriate pursuant to 37 C.F.R. § 42.12, which provides that a proceeding may be dismissed and sanctions may be imposed for “[m]isrepresentation of a fact,” as well as “[f]ailure to comply with an applicable rule.” Here, Sipnet misrepresented that it was the sole real party-in-interest of the proceeding.<sup>33</sup> Sipnet also violated 37 C.F.R. § 42.8(1) by failing to identify Stalker Software as a real party-in-interest.<sup>34</sup>

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<sup>32</sup> Ex. 2032, Dec. 4, 2013 Telephonic Hearing at 21:16-20; *see also* Ex. 2020, Declaration of David K. Callahan Pursuant to 37 C.F.R. § 42.53.

<sup>33</sup> Paper 1, Petition at 2. Petitioner has also maintained that Stalker and Sipnet have no relationship beyond the fact that “Stalker Software, Inc. is a vendor of the CommuniGate Pro communication product employed in some of Sipnet EU systems and offerings.” *See also* Ex. 2026, Dec. 10, 2013 Petitioner’s Response to

Further, Petitioner's refusal to acknowledge Stalker Software's involvement in the instant proceeding until several months into the discovery process has led to the incursion of additional and unnecessary fees by Patent Owner. Patent Owner attempted to resolve the issue of Stalker Software's involvement in this proceeding prior to institution of *inter partes* review. On June 11, 2013, Patent Owner requested information regarding any other entities that could be a real party-in-interest.<sup>35</sup> Petitioner refused to answer Patent Owner's inquiry and did not confirm Stalker Software's involvement in the proceeding until December 2013.<sup>36</sup> In contrast to Petitioner's actions, the Office requires the identification of a petition's real party-in-interest prior to institution of *inter partes* review to ensure "proper application of the statutory estoppel provisions," in order to "protect patent owners from harassment..., to prevent parties from having a 'second bite at the

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Discovery at 2.

<sup>34</sup> 37 C.F.R. § 42.8(b)(1).

<sup>35</sup> See Ex. 2010, June 11, 2013 Letter from P. Lee to P. Haughey.

<sup>36</sup> See Ex. 2011, June 17, 2013, Correspondence from P. Haughey to P. Lee ("Sipnet is the only real party in interest. With regard to your letter's specific requests for discovery, these are all premature. The period for patent owner discovery will begin after the Patent Office initiates an Inter Partes Review.").

apple,' and to protect the integrity of both the USPTO and Federal Courts."<sup>37</sup> Had Petitioner accurately represented Stalker Software's involvement in the Petition, the petition for *inter partes* review would have been dismissed pursuant to 37 C.F.R. § 42.101(b).

Patent Owner respectfully requests sanctions in the form of compensatory expenses, including attorney fees and dismissal of the petition in its entirety, as authorized by 37 C.F.R. § 42.12(b).

**II. 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**

Substantively, the challenged claims of the '704 Patent are patentable for at least the reason that neither NetBIOS nor WINS teach a query or a determination as to the on-line status of a process. One of the objectives of the '704 Patent is to establish a point-to-point communication link between a first and second process. In order to establish this point-to-point communication link, each challenged claim of the '704 Patent does more than simply provide that the network address of the second process be sent to the first process; instead, the challenged claims require a query or a determination of the on-line status of the second process (whether the second process is connected to the network) to ensure that the second process is

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<sup>37</sup> Office Patent Trial Practice Guide at 14.

indeed on-line. And notably, a process is not itself a computer but a program running on a computer.

As explained below, the NetBIOS and WINS prior art merely demonstrates a query as to whether the network address of a computer is registered in a database, and not a query or a determination as to whether a process is on-line. NetBIOS and WINS both provide a database in the form of a name server, which is designed to provide a directory of the network addresses of the computers that have registered their names in the database. Notably, WINS is an implementation of NetBIOS. But neither reference teaches a query or a determination as to whether the computer, let alone the process running on the computer, is on-line, which alone would ensure the establishment of a point-to-point communication link between the two processes. In fact, the WINS reference specifically teaches that a query of its database is not a query or a determination as to the on-line status of the process running on the computer, or even whether the computer itself is running, since a response from WINS “*does not ensure that the related device is currently running*, only that a computer claimed the particular IP address” in its database.<sup>38</sup> As the patent’s objective is to enable point-to-point communications between two on-line processes, a server that simply maintains a log of registered network addresses cannot achieve the objective and claimed inventions of the ’704 Patent.

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<sup>38</sup> WINS at 57 (emphasis added).

**A. Legal Standards**

In an instituted *inter partes* review, “the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”<sup>39</sup> A petition must identify, “in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.”<sup>40</sup> Every petition must include a “detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent,” and each claim challenge “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”<sup>41</sup> “The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”<sup>42</sup>

Claims are to be given their broadest reasonable interpretation in light of the specification. This broadest reasonable interpretation of the claims must be “consistent with the specification.”<sup>43</sup> Further, “claim language should be read in

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<sup>39</sup> 35 U.S.C. § 316(e).

<sup>40</sup> 35 U.S.C. § 312(a)(3).

<sup>41</sup> 37 C.F.R. § 42.22 (a)(2) & (c); 42.104(b)(4).

<sup>42</sup> 37 C.F.R. § 42.104 (b)(5).

<sup>43</sup> *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010) (quoting *In re*

light of the specification as it would be interpreted by one of ordinary skill in the art.”<sup>44</sup> A claim construction may be “unreasonably broad” if it is not “read in light of the specification and teachings in the underlying patent.”<sup>45</sup>

To anticipate a claim, the prior art reference “must disclose each and every limitation of the claimed invention.”<sup>46</sup> To invalidate a claim by obviousness based on multiple references, the prior art must disclose all limitations of the claims.<sup>47</sup>

**B. Each Challenged Claim Require a Query or a Determination as to On-Line Status of the Second Process**

At issue in this proceeding are claims 1-7 and 32-42. Each of the independent claims 1, 2, 4, 32, 33, and 38 require a query or a determination as to

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*Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)) (emphasis in original).

<sup>44</sup> *In re Suitco*, 603 F.3d at 1260 (quoting *In re Bond*, 910 F.2d at 833).

<sup>45</sup> *In re Suitco*, 603 F.3d at 1260.

<sup>46</sup> *Verizon Servs. Corp. v. Cox Fibernet Va., Inc.*, 602 F.3d 1325, 1337-38 (Fed. Cir. 2010).

<sup>47</sup> *See CFMT, Inc. v. YieldUp Int’l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (supporting a finding of no obviousness when “no combination of the prior art, even if supported by a motivation to combine, would disclose all the limitations of the claims”); *see also Bayer Healthcare Pharms., Inc. v. Watson Pharms., Inc.*, 713 F.3d 1369, 1375 (Fed. Cir. 2013).



the on-line status of the second process. As identified below, the claim language of the independent claims requires “a query as to whether the second process is connected to the computer network,” “determining the on-line status,” of the second process, or issuing a “response” when a process “is connected to the network.” Therefore, each claim requires a query or a determination whether the computer program is on-line, and not merely whether the network address of the computer program, or the computer itself, is registered in a database.

Claim 1	<p>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:</p> <ul style="list-style-type: none"><li>a computer usable medium having program code embodied in the medium, the program code comprising:<ul style="list-style-type: none"><li>program code for transmitting to the server a network protocol address received by the first process following connection to the computer network;</li><li>program code for transmitting, to the server, <i>a query as to whether the second process is connected to the computer network</i>;</li><li>program code for receiving a network protocol address of the second process from the server, <i>when the second process is connected to the computer network</i>; and</li><li>program code, responsive to the network protocol address of the second process, <i>for establishing a point-to-point communication link between the first process and the second process over the computer network</i>.</li></ul></li></ul>
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Independent claim 1 requires “a query as to whether the second process is connected,” receiving a response to the query “when the second process is connected” for the purpose of “establishing a point-to-point communication link”

between the two processes. Claim 1 also identifies that the process is a computer program (“A computer program product for use with a computer system, the computer system executing a first process”).

Claim 2 <sup>48</sup>	An apparatus <i>for enabling point-to-point communications between a first and a second process over a computer network</i> , the apparatus comprising: a processor; a network interface, operatively coupled to the processor, for connecting the apparatus to the computer network; a memory, operatively coupled to the processor, for storing a network protocol address for selected of a plurality of processes, each network protocol address stored in the memory following connection of a respective process to the computer network; means, <i>responsive to a query from the first process, for determining the on-line status of the second process</i> and for transmitting a network protocol address of the second process to the first process <i>in response to a positive determination of the on-line status of the second process</i> .
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Independent claim 2 requires a “query from the first process, for determining the on-line status of the second process” in order to enable “point-to-point communication” between the two processes.

Claim 4 <sup>49</sup>	A method <i>for enabling point-to-point communication between a first process and a second process over a computer network</i> , the method comprising the steps of:
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<sup>48</sup> Claim 3 is dependent on independent claim 2.

<sup>49</sup> Claims 5-7 are dependent on independent claim 4 and thus incorporate the above limitations.

	<p>A. receiving and storing into a computer memory a respective network protocol address for a selected of a plurality of processes that <i>have an on-line status with respect to the computer network</i>, each of the network protocol addresses received following connection of the respective process to the computer network;</p> <p>B. receiving <i>a query from the first process to determine the on-line status of the second process</i>;</p> <p>C. <i>determining the on-line status of the second process</i>; and</p> <p>D. transmitting <i>an indication of the on-line status of the second process to the first process</i> over the computer network.</p>
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Independent claim 4 requires “receiving a query from the first process to determine the on-line status of the second process,” and then “determining the on-line status of the second process” before “transmitting an indication of the on-line status of the second process to the first process.”

Claim 32	<p>A <i>method of locating a process</i> over a computer network comprising the steps of:</p> <p>a. <i>maintaining an Internet accessible list</i> having a plurality of selected entries, <i>each entry comprising an identifier</i> and a corresponding Internet protocol address <i>of a process currently connected to the Internet</i>, the Internet protocol address added to the list following connection of the process to the computer network;</p> <p>b. <i>in response to identification of one of the list entries</i> by a requesting process, <i>providing</i> one of <i>the identifier</i> and the corresponding Internet protocol address <i>of the identified entry to the requesting process</i>.</p>
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Independent claim 32 requires a “method of locating a process” where “each entry [in a list] compris[es] an identifier . . . of a process currently connected to the Internet” and where identifiers are provided to the requesting process “in response

to identification of one of the list entries.” While claim 32 does not use the terminology of a “query” or “determination,” such a determination of on-line status necessarily occurs when the server identifies an entry on the list of processes currently connected to the network. Claim 32 also requires “maintaining an Internet accessible list,” where each entry on the list is “a process currently connected to the Internet.”

Claim 33 <sup>50</sup>	A <i>method for locating processes</i> having dynamically assigned network protocol addresses over a computer network, the method comprising the steps of: a. <i>maintaining</i> , in a computer memory, <i>a network-accessible compilation of entries, selected of the entries comprising a network protocol address and a corresponding identifier of a process connected to the computer network</i> ; b. <i>in response to identification of one of the entries</i> by a requesting process <i>providing one of the identifier and the network protocol address to the requesting process</i> .
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Independent claim 33 requires a “method for locating processes” where the selected entries in a compilation “compris[e] a corresponding identifier of a process connected to the computer network,” and where the identifier is provided to the requesting process “in response to identification of one of the list entries.” Like claim 32, claim 33 does not use the terminology of a “query” or “determination.” However, a determination of on-line status necessarily occurs when the server identifies an entry in the compilation of processes connected to the

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<sup>50</sup> Claims 34-37 are dependent on independent claim 33.

computer network. Claim 33 also requires “maintaining” a compilation of entries wherein each entry is “a process connected to the computer network.”

Claim 38 <sup>51</sup>	A computer program product for use with a computer system having a memory and being operatively connectable over a computer network to one or more computer processes, the computer program product comprising a computer usable medium having program code embodied in the medium the program code comprising: a. program code configured <i>to maintain</i> , in the computer memory, <i>a network accessible compilation of entries, selected of the entries comprising</i> a network protocol address and <i>a corresponding identifier of a process connected to the computer network</i> , the network protocol address of the corresponding process assigned to the process upon connection to the computer network; and b. program code <i>responsive to identification of one of the entries</i> by a requesting process <i>and configured to provide</i> one of <i>the identifier</i> and the network protocol address <i>to the requesting process</i> .
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Independent claim 38 requires a compilation of entries that “compris[e] . . . a corresponding identifier of a process connected to the computer network,” and where an identifier is provided to the requesting process “responsive to identification of one of the entries.” Claim 38 does not use the terminology of a “query” or “determination,” but such a determination of on-line status necessarily occurs upon identification of an entry in the compilation of entries connected to the computer network. Claim 38, like claims 32 and 33, requires a computer program

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<sup>51</sup> Claims 39-42 are dependent on independent claim 38.

that “maintain[s]” a compilation of entries, where each entry is “a process connected to the computer network.”

As identified above, each challenged independent claim requires a query or a determination whether the computer program is on-line, and not merely whether the network address of the computer program, or the computer itself, is registered in a database. Moreover, claims 32, 33, and 38 each require maintaining a list of processes that are connected to the network. The additional limitations of claims 32, 33, and 38 further emphasize that the processes of the '704 Patent are on-line with respect to the network, in order to achieve the claimed objective of enabling a point-to-point communication between the processes over a network.

**C. The Specification Fully Supports that the Challenged Claims Require a Query or a Determination as to On-Line Status**

As noted earlier, Petitioner acknowledged that the “broadest reasonable construction” is the proper standard to apply in an *inter partes* review, and that under such a standard, “connected to the computer network” requires a process being “on-line.”<sup>52</sup> The Board agreed, for at least the purposes of its Decision to Institute, that the '704 Patent specification supports a construction of “connected to the computer network” as “being on-line.”<sup>53</sup>

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<sup>52</sup> Paper 1, Petition at 5-6.

<sup>53</sup> Decision at 5-6.

Patent Owner agrees that the claims require and the specification confirms that “connected to the computer network” requires that a process “is on-line.” However, the Board went further and stated that “being ‘on-line,’ [] can be done by registering an address with the server.”<sup>54</sup> Patent Owner respectfully disagrees that registering an address satisfies the requirement of “being on-line.” While a process may be on-line at the time of registration, it may subsequently go off-line. Further, the specification makes no mention of “registration of a process” as sufficient for establishing the on-line status of a process. Indeed, the specification repeatedly requires a specific query into or a determination of the on-line status.

For example, the Abstract of the ’704 Patent identifies that a query is made “to determine the on-line status” in order to establish the point-to-point communication link:

A first point-to-point Internet protocol includes the steps of (a) storing in a database a respective IP address of a set of processing units *that have an on-line status with respect to the Internet*; (b) *transmitting a query* from a first processing unit to a connection server *to determine the on-line status* of a second processing unit; and (c) retrieving the IP address of the second unit from the database using the connection server, *in response to the determination of a positive on-line status* of the second processing unit, *for establishing a point-to-point*

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<sup>54</sup> Decision at 6.

*communication link* between the first and second processing units through the Internet.<sup>55</sup>

The Figures of the '704 Patent demonstrate that a query is performed to identify on-line status. For example, Figure 2 specifies that the mail server "POLLS EVERY 3-5 SECONDS" to the second processing unit to ensure a constant connection to the network. Figure 8 additionally states that the system will "receive [a] query from first unit whether a specified second unit is *logged-in*," and then "retrieve IP address from database *if the second unit is logged-in*."<sup>56</sup>

The Summary of the Invention again states that the '704 Patent covers a protocol that transmits a query "to determine the on-line status:"

A first point-to-point Internet protocol is disclosed which includes the steps of (a) storing in a database a respective IP address of a set of processing units *that have an on-line status* with respect to the Internet; (b) *transmitting a query* from a first processing unit to a connection server *to determine the on-line status* of a second processing unit, and (c) retrieving the IP address of the second unit from the database using the connection server, *in response to the determination of a positive on-line status* of the second processing

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<sup>55</sup> Ex. 1001, '704 Patent at Abstract (emphasis added).

<sup>56</sup> *Id.* at FIG. 2, FIG. 8.



unit, *for establishing a point-to-point communication link* between the first and second processing units.<sup>57</sup>

The Description of Preferred Embodiments includes the following statements that emphasize that the query or a determination is directed to determining whether the on-line status with respect to the computer network:

- The first user operating the first processing unit is thus *established in the database as an active on-line party available for communication* using the disclosed point-to-point Internet protocol. Similarly, a second user operating the second processing unit, *upon connection to the Internet* through a connection service provider, is processed by the connection server to be *established in the database as an active on-line party*.
- The first processing unit then sends a query, including the E-mail address of the callee, to the connection server. The connection server then searches the database to *determine whether the callee is logged-in* by finding any stored information corresponding to the callee's E-mail *address indicating that the callee is active and on-line. If the callee is active and on-line*, the connection server then performs the primary point-to-point Internet protocol.
- If the callee is *not on-line when the connection server determines the callee's status*, the connection server sends an OFF-LINE signal or message to the first processing unit.

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<sup>57</sup> *Id.* at 1:63-2:9 (emphasis added).

- When a user *logs off or goes off-line from the Internet*, the connection server updates the status of the user in the database... Accordingly, *an off-line user is effectively disabled from making and/or receiving point-to-point Internet communications*.
- The first processing unit and the second processing unit are *operatively connected to the Internet* by communication devices and software known in the art. The processing units may be *operatively interconnected* through the Internet to a connection server.
- The processing units are capable of placing calls and connecting to *other processing units connected to the Internet*, for example, via dialup SLIP/PPP lines.
- [T]he disclosed point-to-point Internet protocol and system is initiated at a first processing unit for point-to-point Internet communications by starting the point-to-point Internet protocol...by sending a query from the first processing unit to the connection server; *determining if the connection server is operative to perform the point-to-point Internet protocol by receiving, at the first processing unit, and on-line status signal from the connection server.*<sup>58</sup>

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<sup>58</sup> *Id.* at 5:31-38; 5:55-62; 6:1-4; 6:6-16; 3:11-13; 4:56-58; 10:4-11 (emphasis added).

The specification notes that, in a preferred embodiment, the determination of on-line status may be achieved by the use of an ongoing timestamp application, which the server may use to actively check whether a process is still connected to the network.<sup>59</sup>

In addition, the specification confirms that each process is a computer program, rather than the computer itself:

The first processing unit 12 may operate the disclosed point-to-point Internet protocol *by a computer program* described hereinbelow in conjunction with FIG. 6, which may be implemented from compiled and/or interpreted source code in the C++ programming language and which may be downloaded to the first processing unit 12 from an external computer. The *operating computer program* may be stored in the memory 16, which may include about 8 MB RAM and/or a hard or fixed drive having about 8 MB.<sup>60</sup>

Therefore, the specification confirms that the '704 Patent claims an invention that requires a query or a determination of on-line status in order to enable the claimed point-to-point communication between the first and second processes. Further, this query or a determination is not whether the computer

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<sup>59</sup> *Id.* at 5:39-40 (“The connection server 26 may use the timestamps to update the status of each processing unit.”).

<sup>60</sup> *Id.* at 3:39-47 (emphasis added).

associated with a network address is on-line, but whether the computer program or process is on-line.

**D. Neither NetBIOS nor WINS Teaches a Query or a Determination as to the On-Line Status of the Second Process**

Neither NetBIOS nor WINS teaches a query or a determination as to the on-line status of a process. NetBIOS and WINS only disclose a query as to the network address of a computer. This query is not a query into the on-line status of that computer, let alone a query into the on-line status of a computer program. Moreover, neither NetBIOS nor WINS disclose any additional determination as to the on-line status of a registered computer.

It is undisputed that both NetBIOS and WINS disclose a database of registered computers. The database of both NetBIOS and WINS maintains a registry of network addresses associated with particular nodes (computers), and both references provide a method for one computer to ask for and receive from the server the network address of a second computer. But mere registration of the network address of a computer does not teach that the computer is on-line with respect to the network and available for establishment of a point-to-point communication link. And mere registration of a computer does not teach that a

computer program is on-line with the network and available for establishment of a point-to point communication link.<sup>61</sup>

In fact, NetBIOS and WINS do not check the on-line status of a computer or computer program. Both the NetBIOS and WINS references confirm that each system keeps a computer registered in its database after the computer has been disconnected from the network.<sup>62</sup> In addition, the WINS reference, which utilizes the NetBIOS system, explicitly teaches that registration in the database does not ensure that the computer is on-line with the network:

Any name-to-IP address mapping registered with a WINS server can be provided reliably as a response to a name query. However, *a mapping in the database does not ensure that the related device is currently running*, only that a computer claimed the particular IP address and it is a currently valid mapping.<sup>63</sup>

This is not simply attorney argument, but the teachings of NetBIOS and WINS that have been confirmed by networking expert Professor Ketan Mayer-Patel. Professor Mayer-Patel is a qualified expert in the field of networking protocols, including networking protocols supporting multimedia streams.

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<sup>61</sup> Ex. 2018, Ketan Mayer-Patel Declaration (“K. Mayer-Patel Decl”) at ¶¶ 34-39, 62-69.

<sup>62</sup> *Id.* at ¶¶ 36, 65-68.

<sup>63</sup> WINS at 57 (emphasis added).

Currently, he is an Associate Professor in the Department of Computer Science at the University of North Carolina at Chapel Hill. Professor Mayer-Patel has also had extensive experience in the industry as it relates to the technical fields of the '704 Patent and asserted prior art. Specifically, Professor Mayer-Patel has been a programmer, a visiting researcher, and an Assistant and Associate Professor, with research focused on multimedia systems, networking, and multicast applications. He has submitted a declaration in support of the conclusion that neither NetBIOS nor WINS invalidates the challenged claims of the '704 Patent.<sup>64</sup>

**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**

Names are registered in the NetBIOS system when a computer is first connected to the NetBIOS server, but the name may remain registered even after the computer that registered it is later disconnected from the network. A query into the registration status of name is thus not a query or a determination as to whether a computer is on-line, nor is it a query or a determination as to whether an associated computer program is on-line. NetBIOS therefore does not teach queries or determinations as to whether the second computer is on-line, nor does NetBIOS

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<sup>64</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶ 14.

teach queries or determinations as to whether a second computer program is on-line.<sup>65</sup>

In NetBIOS, “[b]efore a name may be used, the name must be registered by a node.” For a new name, the procedure “is rather simple: the end-node sends a NAME REGISTRATION REQUEST, the NBNS [“NetBIOS Name Server”] responds with a POSITIVE NAME REGISTRATION RESPONSE.” This registration may extend *indefinitely*, regardless of whether the node remains connected to the computer network. NetBIOS states that the end-node may “request[] an infinite lifetime” of its name registration, and the NBNS server, which determines the “lifetime” of the registered name, “is always allowed to respond with an infinite actual period” of registration for the requesting node. The registered node may thus remain registered in NetBIOS for an indefinite period of time once it is initially registered.<sup>66</sup>

Once the node is registered, NetBIOS specifies that its status does not change in the system unless it is “challenged” by a new node requesting the same registered name as the original node. In this “name challenge” process, a new node issues a “NAME QUERY REQUEST [to] an end-node to verify that it actually owns a name.” If the registered node fails to respond to the issued NAME

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<sup>65</sup> *Id.* at ¶¶ 41, 47, 50, 58, 60.

<sup>66</sup> *Id.* at ¶ 34.

QUERY REQUEST, the NBNS “consider[s] that the end-node has released the name in question.” NetBIOS “releases” the original node by merely marking it as “in conflict.” The “conflict” flag *does not alter the registered status* of the original node; it will remain registered in the NetBIOS system.<sup>67</sup>

NetBIOS specifies that names in its system are marked based on whether it is (1) in conflict, or (2) in the process of being deleted by a node. Further, there is no indication in a registered name of whether a computer or a computer program is on-line or connected to the network at the time of querying.<sup>68</sup> NetBIOS explicitly states that it only monitors whether (1) the name is assigned for a group or a single node, (2) the name has been marked as in conflict, and (3) the node has requested its own deletion:

Each node maintains state information for each name it has registered.

This information includes:

- Whether the name is a group or unique name

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<sup>67</sup> *Id.* at ¶ 35.

<sup>68</sup> *Id.* at ¶ 38; *see, also*, Ex. 1003, The Open Group, Technical Standard – Protocols for X/Open PC Internetworking/SMB, Version 2 (“NetBIOS”) (1992) at 447.

Ex.1004 includes page numbers indicated by the publication itself and different page numbers provided by Petitioner. All references herein will be to the page numbers as printed in NetBIOS itself, not the page numbers provided by Petitioner.



- Whether the name is “in conflict”
- Whether the name is in the process of being deleted<sup>69</sup>

NetBIOS thus *does not monitor the “on-line status” of the node or a computer program*. It has no check in its system to ensure that registered nodes are on-line with the network, and will not determine whether a node or a computer program is on-line with the network when it receives a query.<sup>70</sup> NetBIOS therefore does not “query” into or “determine” the on-line status of a process, as required by every challenged claim. Moreover, because there is no assurance that the nodes which are in the NetBIOS database are connected to the network, NetBIOS does not “maintain” a list of processes “connected to the network” as required by claims 32 and 38. Further, the list or compilation in NetBIOS contains only the corresponding identifier of a node, rather than a corresponding identifier of a process as required by the ’704 claims.

## **2. Petitioner Fails to Demonstrate That NetBIOS Teaches a Query or a Determination of the On-Line Status of the Second Process**

The disclosures provided by the Petitioner confirms that NetBIOS only performs a query as to the network address of a second computer. These disclosures do not teach a query or a determination regarding the on-line status of

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<sup>69</sup> NetBIOS at 376.

<sup>70</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶¶ 35-36, 38.

the second computer, and do not teach a query or a determination regarding the on-line status of a second computer program.

Petitioner's claim charts allege that the "query as to whether a second process is connected to the computer network" and "receiving a network protocol address of the second process from the server, when the second process is connected to the computer network" are disclosed by the following statements from NetBIOS:

- 1) Name query (also known as 'resolution' or 'discovery') is the procedure by which the IP address(es) associated with a NetBIOS name are discovered.
- 2) Name query transactions are initiated by end-nodes to obtain the IP address(es) and other attributes associated with a NetBIOS name.
- 3) The next diagram illustrates interaction between the end-node and the NBNS when the NBNS does have information about the name.
- 4) An NBNS answers queries from a P node with a list of IP address and other information for each owner of the name.
- 5) The NetBIOS session service begins after one or more IP addresses have been found for the target name...NetBIOS session service transactions, packets, and protocols are identical for all end-node types. They involve only directed (point-to-point) communications.
- 6) The NBNS (or any other node) may 'challenge' (using a NAME QUERY REQUEST) an end-node to verify that it actually owns a

name. Such a challenge may occur at any time. Every end-node must be prepared to make a timely response.<sup>71</sup>

These six statements do not teach a query or a determination of the on-line status of the second process. The first statement establishes that NetBIOS teaches a name query, which is simply a query to the NetBIOS Name Server for the IP address associated with a particular node (computer). The second statement confirms that end nodes make the name query request. The third statement refers to a diagram that illustrates the interaction between the end node and the NetBIOS Name Server when a name request is made. The diagram does not disclose a query or a determination of the on-line status of the node. The fourth statement confirms that the NetBIOS Name Server answers the name query with a list of IP addresses. The fifth statement points out that sessions are established after the IP address is found for the name, which will occur for any registered computer. Lastly, the sixth statement confirms the presence of a “challenge” procedure, but this procedure does not occur in response to a request for the on-line status of a process. Nothing

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<sup>71</sup> Paper 1, Petition at 36-37, 42. Petitioner also states, “As explained above, a registered address indicates a process is online.” Paper 1, Petition at 41. As discussed above, and as explained in more detail in the following sections, this statement is incorrect. A registered address does not indicate the current on-line status or connection of a computer or computer program to the network.

in these six statements teach a query or a determination regarding the on-line status of the second computer, and do not teach a query or a determination regarding the on-line status of a second computer program.<sup>72</sup>

**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**

WINS is an implementation of NetBIOS. Like NetBIOS, names are registered in WINS when a computer is first connected to the WINS server, but the computer may remain registered even after it is later disconnected from the network. WINS thus does not teach queries or determinations as to whether the second computer is on-line, nor does WINS teach queries or determinations as to whether a second computer program is on-line.<sup>73</sup>

WINS, like NetBIOS, does not receive a query or perform a determination to ensure that previously-registered computers are on-line. WINS only is a system that (1) registers and (2) resolves assigned names to their corresponding IP addresses. According to the WINS reference, “*Registration* is the process used to acquire a unique name for each node (computer system) on the network,” and “*Resolution* is the process used to determine the specific address for a computer

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<sup>72</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶¶ 42-45, 48, 51, 60.

<sup>73</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶¶ 62-69.

name.”<sup>74</sup> The WINS server registers an IP address to a unique name. In the WINS system, “WINS servers maintain a database that maps computer names to IP addresses.” And, “[t]he WINS server is responsible for knowing computer names and addresses and for ensuring no duplicate names exist on the network.”<sup>75</sup>

One approach by which names are resolved is known as “p-node,” which “uses point-to-point communications with a name server to resolve names.” In p-node, if a first computer wishes to communicate with a second computer, “it queries the WINS server for the address of [the second computer].” The WINS server then provides the first computer with the address of the second computer.<sup>76</sup>

Because the WINS server merely searches for an entry in its database, it has no assurance that a registered computer is on-line. In fact, WINS explicitly states that it does not ensure that the computer is currently active and on-line:

Any name-to-IP address mapping registered with a WINS server can be provided reliably as a response to a name query. However, *a mapping in the database does not ensure that the related device is currently running*, only that a computer claimed the particular IP address and it is a currently valid mapping.<sup>77</sup>

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<sup>74</sup> WINS at 50 (emphasis in original).

<sup>75</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶ 62; WINS at 51.

<sup>76</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶ 63.

<sup>77</sup> WINS at 57 (emphasis added); Ex. 2018, K. Mayer-Patel Decl. at ¶ 64.

Registration (or the “claim[ing of] the particular IP address”) occurs during system startup. As the WINS reference states, “To ensure that both name and address are unique, the Windows NT computer using TCP/IP registers its name and IP address on the network during system startup.”<sup>78</sup> “A computer typically registers itself when it starts.”<sup>79</sup>

A registered computer retains its registration until it is released. The WINS reference clearly describes its “name release” procedure as the following:

When a computer finishes with a particular name (such as when the Workstation service or Server service is stopped), it ***no longer challenges other registration requests*** for the name. This is referred to as *releasing a name*.

If WINS is enabled: Whenever a computer is shut down properly, it releases its name to the WINS server, which marks the related database entry as *released*. If the entry remains released for a certain period of time, the WINS server marks it as *extinct*, and the version number is updated so that the database changes will be propagated among the WINS servers. ***Extinct entries remain in the database for a designated period of time*** to enable the change to be propagated to all WINS server....If that computer released its name during an orderly shutdown, the WINS server will not challenge the name. If

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<sup>78</sup> WINS at 49.

<sup>79</sup> *Id.* at 50; Ex. 2018, K. Mayer-Patel Decl. at ¶ 65.

the computer restarts because of a system reset, the name registration with a new address will cause the WINS server to challenge the registration, but the challenge will fail and the registration will succeed, because the computer no longer has the old address.<sup>80</sup>

The above excerpt specifies, *first*, that like NetBIOS, WINS will still recognize a name as registered until it is challenged by a new computer. A name that is not connected to the network will remain in its default, “registered” state unless and until a new computer contacts the WINS server requesting the same name for a different address than the first computer. *Second*, the above disclosure specifies that registered names will remain registered in the database *even after it is challenged*, and the WINS server will simply “mark” registered names as “released” until “a certain period of time” has elapsed. The names are then merely “marked” as “extinct,” and even these “extinct” names will “remain in the database for a designated period of time.”<sup>81</sup>

The WINS reference offers other examples of registered names for computers that are not connected to the network. For example, the reference instructs that “The local WINS database should periodically be cleared of released entries and old entries that were registered at another WINS server but did not get

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<sup>80</sup> WINS at 58-59 (emphasis added); Ex. 2018, K. Mayer-Patel Decl. at ¶ 66.

<sup>81</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶ 67.

removed from this WINS database for some reason.”<sup>82</sup> The reference then states that before manually removing these names from the database (a procedure known as “scavenging”), there may be “owned extinct names for which the Extinct timeout has expired,” “replicas of extinct names for which the Extinct timeout has expired,” or “replicas of extinct or deleted names” still listed in the WINS database.<sup>83</sup>

According to the above disclosures, it is clear that a registration in the WINS system does not ensure that a computer is on-line with the network. Registered computers are not inherently connected to the network, and WINS clearly describes numerous instances in which computers remain registered with the network when they are not actively connected to the network. WINS explicitly points this out in its disclosure that “a mapping in the database does not ensure that the related device is currently running, only that a computer claimed the particular IP address and it is a currently valid mapping.” Because WINS responds to queries based solely on the registration status of a computer, it does not and cannot perform functions to query or determine whether a computer is on-line. Moreover, WINS does not teach that a query or a determination is performed as to whether a

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<sup>82</sup> WINS at 132.

<sup>83</sup> WINS at 133; Ex. 2018, K. Mayer-Patel Decl. at ¶¶ 68-69.



second computer program is on-line.<sup>84</sup> WINS also cannot teach maintaining a list of processes that are “connected to the network,” as required by claims 32 and 38, because WINS merely maintains a list of computers that have been initially registered with the database. Further, because an identifier in WINS only corresponds to a registered computer, it does not identify correspond to a process running on the computer as required by the ’704 Patent.

**4. Petitioner Fails to Demonstrate That WINS Teaches a Query or a Determination of the On-Line Status of the Second Process**

As with NetBIOS, the disclosures provided by the Petitioner only teach that WINS performs a query as to the network address associated with a name that was registered by a second computer. These disclosures do not teach a query or a determination regarding the on-line status of the second computer, and do not teach a query or a determination regarding the on-line status of a second computer program.

Petitioner’s claim charts allege that the “query as to whether a second process is connected to the computer network” and “receiving a network protocol address of the second process from the server, when the second process is connected to the computer network” are disclosed by the following three statements from WINS:

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<sup>84</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶¶ 69-72, 76-77.

- 1) Microsoft TCP/IP includes the following:...NetBIOS for establishing logical names and sessions on the network...Windows Internet Name Service (WINS) for dynamically registering and querying computer names on an internetwork, Dynamic Host Configuration Protocol (DHCP) service for automatically configuring TCP/IP on Windows NT computers.
- 2) In this [WINS] environment, when NT\_PC1 wants to communicate with NT\_PC2, it queries the WINS server for the address of NT\_PC2. When NT\_PC1 gets the appropriate address from the WINS server, it goes directly to NT\_PC2.
- 3) A name query request is sent first to the WINS server [...]. If the name is found in the WINS database, the client can establish a session based on address mapping received from WINS.<sup>85</sup>

These three statements do not teach a query or a determination of the on-line status of the second process. The first statement identifies that WINS uses dynamic host configuration protocol. The second statement establishes that like NetBIOS, when one computer wants to communication with a second computer, the first computer queries the WINS (Windows Name Server) server for the address of the second computer. The third statement confirms that the WINS server will provide the address of the second computer “[i]f the name is found in

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<sup>85</sup> Paper 1, Petition at 33-39.

the WINS database” and that the computer can use the address to establish a session with the second computer. Nothing in these three statements teach a query or a determination regarding the on-line status of the second computer, and do not teach a query or a determination regarding the on-line status of a second computer program.<sup>86</sup>

**E. Neither NetBIOS Nor WINS Teach Additional Limitations Found in Dependent Claims 5, 6, and 7**

Dependent claim 5 is not anticipated by either NetBIOS or WINS via its limitation of “retrieving a network protocol address of the second process in response to a positive determination of the on-line status of the second process.” As discussed, NetBIOS cannot determine the on-line status of a process, and so cannot (1) positively determine the on-line status of a process, or (2) respond in any way to a determination of the on-line status of a process. NetBIOS does not

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<sup>86</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶¶ 69-72, 76-77. The Petitioner also asserted in its claim charts that “a registered address indicates a process is online.” Paper No. 1, Petition at 41. As discussed above, and as explained in more detail in the following section, this statement is incorrect. A registered address does not indicate the current on-line status or connection of a computer or computer program to the network.

send this information “in response to a positive determination of the on-line status” of a process, but will send this information for any node registered with its server.<sup>87</sup>

WINS also cannot positively or negatively determine the on-line status of a process, because it only determines whether a computer is registered on the WINS server. WINS therefore does not disclose actions “in response” to any designation of the “on-line status” of a process. Petitioner stated that this limitation is taught by the disclosure that “When NT\_PC1 gets the appropriate address from the WINS server, it goes directly to NT\_PC2.” However, this statement does not establish that the address is sent to PC1 “in response to a positive determination of the on-line status of the second process.”<sup>88</sup>

Similarly, dependent claim 6 is not anticipated by either NetBIOS or WINS via its limitation of “transmitting the network protocol address of the second process to the first process when the second process is determined in step C to have *a positive on-line status* with respect to the computer network.” As discussed, NetBIOS and WINS cannot determine the on-line status of a process. As the NetBIOS and WINS servers do not respond based on the on-line status of the process, this limitation is not taught by either NetBIOS or WINS.<sup>89</sup>

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<sup>87</sup> *Id.* at ¶ 73.

<sup>88</sup> Paper 1, Petition at 47-48.

<sup>89</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶ 74.

Finally, dependent claim 7 is not anticipated by either NetBIOS or WINS via its limitations of (1) “generating an off-line message” and (2) “transmitting an off-line message.” *First*, as discussed, NetBIOS cannot determine whether a process is off-line versus on-line, but can merely indicate if a node is registered versus being de-registered. *Second*, if a node is challenged according to the protocol discussed above, the node is simply marked as “in conflict,” which does not indicate whether the node is “off-line.”<sup>90</sup>

WINS, like NetBIOS, does not teach the limitations in claim 7 of “generating an off-line message” or “transmitting an off-line message.” First, as discussed, WINS does not determine whether a process is off-line, only whether a computer has been registered and subsequently de-registered with the network. Further, WINS does not “generate” or “transmit” a message conveying the connection status of a process. If the WINS server is informed that a name has been “released” to the WINS server, the server will merely “mark[] the related database entry as released.”<sup>91</sup> This “marking” is not equivalent to a “message” that is then transmitted to a requesting computer, and indeed WINS does not disclose the transmission of any message when an entry is marked as “released” or “extinct.” Petitioner even acknowledges this deficiency, in arguing that this

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<sup>90</sup> *Id.* at ¶¶ 35-38.

<sup>91</sup> WINS at 70.

limitation is disclosed by WINS because “A negative (offline) response is inherent. One of skill in the art would recognize that a response where no address is found would be sent, and as noted above, that indicates it is offline.”<sup>92</sup> The generation and transmission of an off-line message is certainly not “inherent,” and WINS does not disclose any protocol for conveying to a requesting process that the second process has “a negative on-line status with respect to the computer network.”<sup>93</sup>

**F. Claims 33-37 Are Not Rendered Obvious by NetBIOS in View of WINS**

Claim 33 and its dependent claims 34-37 have been challenged as obvious over a combination of both NetBIOS and WINS. However, as neither the NetBIOS nor the WINS system teach a query or a determination as to the on-line status of the second process, the two references taken together do not teach the limitations of claims 33 and 34-37.<sup>94</sup> Further, claim 33 requires maintaining a compilation of entries, wherein each entry is “a process connected to the computer network.” As there is no assurance in either NetBIOS or WINS that its registered

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<sup>92</sup> Paper 1, Petition at 49-50.

<sup>93</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶ 75.

<sup>94</sup> *See Vizio, Inc. v. ITC*, 605 F.3d 1330, 1343 (Fed. Cir. 2010) (When “all of the elements of the claimed invention were not disclosed in the prior art references,” the patent was not obvious in light of the prior art references).

computers are connected to the computer network, NetBIOS and WINS in combination do not teach this required limitation. The “entries” in NetBIOS and WINS also only correspond to registered nodes or computers, not processes running on a computer as required by the ’704 Patent.

### **III. NETBIOS DOES NOT TEACH DYNAMIC ADDRESS ALLOCATION, AS REQUIRED BY EACH CHALLENGED CLAIM**

The properly construed claims of the ’704 Patent each require dynamic address allocation, as covered by the various limitations in independent claims 1, 2, 4, 32, and 38 that recite “a network protocol address received by [a] process following connection to the computer network.”

#### **A. The Claims and Specification Require Dynamic Address Allocation**

If a computer system is configured to utilize dynamic address allocation, the system is assigned a unique IP address from the server during network initialization. IP addresses received “following connection to the network” are inherently dynamically assigned protocol addresses, and to one of ordinary skill in computer networking, “a network protocol address received by a process following connection to the computer network” unambiguously defines the concept of dynamic addressing.<sup>95</sup>

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<sup>95</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶ 24.

The following table illustrates that dynamic address allocation language of each challenged independent claim:<sup>96</sup>

Claim 1	“program code for transmitting to the server a network protocol address received by the first process following connection to the computer network”
Claim 2	“each network protocol address stored in the memory following connection of a respective process to the computer network”
Claim 4	“each of the network protocol addresses received following connection of the respective process to the computer network”
Claim 32	“a corresponding Internet Protocol address of a process..., the Internet Protocol address added to the list following the connection of the process to the computer network”
Claim 38	“the network protocol address of the corresponding process assigned to the process upon connection to the computer network”

The Examiner in the Previous Reexamination found that the language “a network protocol address received by [a process] following connection to the computer network” corresponded to a dynamic element in the claims.<sup>97</sup>

The Board in the instant *inter partes* review previously found that independent claim 33 required dynamic addressing,<sup>98</sup> as the claim expressly uses

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<sup>96</sup> Ex. 1001, '704 Patent at 11:9-11; 11:31-33; 11:50-52; 14:61-65; 15:40-42.

<sup>97</sup> Ex. 2005, Notice of Intent to Issue Ex Parte Reexamination Certificate at 2-3.

<sup>98</sup> Paper 11, Decision at 11 (“claim 33 recites the limitation “[a] method for locating processes having dynamically assigned network protocol addresses over a computer network”), 14-15.



the term “dynamic assigned network protocol addresses” in its preamble. Notably, the body of the claim requires the same defining language that the network address is assigned following connection to the computer network: the computer memory maintains “the network protocol address of the corresponding process assigned to the process upon connection to the computer network.”<sup>99</sup>

However, the Board stated in its Decision that “the limitation ‘connection to the computer network’ does not require a dynamic element.” Straight Path respectfully submits that the dynamic element is incorporated into the ’704 claims via the language “*following connection* to the computer network,” not merely “connection to the computer network.” The fact that an address is assigned upon connection to the network is, by definition, dynamic address allocation.<sup>100</sup>

The specification also explicitly incorporates dynamic addressing into the claimed system. For example, the descriptions of the patented invention describe dynamic, rather than static, addressing: “When either of processing units 12, 22 logs on to the Internet via a dial-up connection, *the respective unit is provided a dynamically allocated IP address* by a connection service provider.”<sup>101</sup>

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<sup>99</sup> Ex. 1001, ’704 Patent at 15:10-12.

<sup>100</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶¶ 24, 26.

<sup>101</sup> Ex. 1001, ’704 Patent at 5:21-24 (emphasis added).

Patent Owner respectfully submits that the challenged claims each require dynamic addressing. The claims each specify that network protocol addresses are “received by [processes] *following connection to the computer network,*” which by definition is dynamic allocation of network protocol addresses.

**B. NetBIOS Does Not Teach Dynamic Addressing**

The Petitioner’s claim charts generally allege that the dynamic addressing limitations are met by the statement, “The interaction is rather simple: the end-node sends a NAME REGISTRATION REQUEST, the NBNS responds with a POSITIVE NAME REGISTRATION RESPONSE.”<sup>102</sup> The disclosures listed in Petitioner’s claim charts make no mention of network protocol addresses being assigned to a process after its connection to the network, and so do not disclose dynamic address allocation. The Examiner in the Reexamination confirmed that NetBIOS does not teach dynamic address allocation, as did the Board in its Decision to Institute.<sup>103</sup> Patent Owner therefore respectfully submits that each of the challenged claims is not anticipated by NetBIOS for at least the reason that

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<sup>102</sup> Paper 1, Petition at 35.

<sup>103</sup> Paper 11, Decision at 15 (“Petitioner did not provide sufficient evidence that NetBIOS discloses the process of having ‘dynamically assigned network protocol addresses.’”).

NetBIOS does not disclose “network protocol address[es] of the corresponding process[es] assigned to the process upon connection to the computer network.”<sup>104</sup>

#### **IV. PETITIONER HAS FAILED TO ESTABLISH THAT WINS IS PRIOR ART**

As identified above, Exhibit 1004, “WINS,” is a reference that Petitioner received from Stalker Software. Petitioner has been unable to establish that WINS was a publicly available reference, despite several requests for supplemental evidence from Patent Owner.

The Federal Circuit requires that “[a] document, to serve as a ‘printed publication,’ must be generally available.”<sup>105</sup> A reference will only be considered generally available and publicly accessible “upon a satisfactory showing that such a document has been disseminated or otherwise made available” to the public.<sup>106</sup> Procedurally, the “party seeking to introduce the reference ‘should produce sufficient proof of its dissemination or that it has otherwise been available and accessible.’”<sup>107</sup> In the instance where a printed publication has allegedly been

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<sup>104</sup> Ex. 2018, K. Mayer-Patel Decl. at ¶¶ 33, 40, 46, 49, 57, 59.

<sup>105</sup> *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 936 (Fed. Cir. 1990).

<sup>106</sup> *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006).

<sup>107</sup> *ResQNet.com, Inc. v. Lansa, Inc.*, 533 F. Supp. 2d 397, 414 (S.D.N.Y. 2008) (quoting *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)).

distributed with a corresponding product, the document's public availability must be established independently of the product's release.<sup>108</sup> For example, in *ResQNet.com, Inc.*, an accused infringer attempted to submit user manuals of a software product as invalidating printed publications, while only submitting evidence of the *product's* release. The Federal Circuit refused to consider the manuals as prior art, for absent evidence as to the "source, publication, or public accessibility of either *manual*," the documents were not established as publicly available printed publications.<sup>109</sup>

Like in *ResQNet.com, Inc.*, the WINS reference is a specific manual that discusses a computer product (the Microsoft Windows NT 3.5 system), and is labeled "For Distribution With a New PC." Petitioner has confirmed that it only obtained the WINS reference from Stalker Software, a company that was previously involved in litigation with Patent Owner concerning the '704 Patent.<sup>110</sup> Understanding that the WINS reference itself did not establish the reference as

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<sup>108</sup> *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 865-66 (Fed. Cir. 2010); *see also Norian Corp. v. Stryker Corp.*, 363 F.3d 1321, 1330 (Fed. Cir. 2004) (publication must be established with specific evidence of actual availability, despite "general practice" to make such documents available).

<sup>109</sup> *ResQNet.com, Inc.*, 594 F.3d at 866 (emphasis added).

<sup>110</sup> *See* Ex. 2026, Dec. 10, 2013 Petitioner's Response Discovery Request

publically available, Petitioner relied on a Wikipedia entry (Exhibit 1005) in its Petition that discussed the release of the Microsoft Windows NT 3.5 System.<sup>111</sup> This Wikipedia entry did not discuss the WINS reference itself. Patent Owner objected to the Wikipedia entry, in part, because both courts and the Board have repeatedly held that Wikipedia is an “unreliable source of information” for purposes of resolving legal disputes, because it is “not peer reviewed, the authors are unknown, and apparently anyone can contribute” to its content.<sup>112</sup>

Petitioner responded with service of several documents (“Nov. 6 Supplemental Documents”) that again only discussed the Microsoft Windows NT 3.5 server product.<sup>113</sup> None of the Nov. 6 Supplemental Documents mentioned Exhibit 1004 or its public dissemination.<sup>114</sup> After another objection by Patent

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<sup>111</sup> Paper No. 1, Petition at ii.

<sup>112</sup> Ex. 2033, Oct. 25, 2013 Patent Owner’s Objections to Exhibits Pursuant to 37 C.F.R. § 42.64(b)(1).

<sup>113</sup> See Ex. 2034, Nov. 6, 2013 Petitioner’s Supplemental Evidence.

<sup>114</sup> Document (A)(6) mentioned an “NT Resource Kit” that would eventually be released as an upgrade manual. However, this NT Resource Kit is not the same document as Ex. 1004. See Ex. 2035, NT Resource Kit. Patent Owner further notes that these Supplemental Documents even failed to establish the general availability of the NT 3.5 server product, as they only discuss the “unveiling” of

Owner to the relevancy of the evidence, Petitioner provided additional submissions (“Nov. 27 Supplemental Documents”).<sup>115</sup>

Each of the Nov. 27 Supplemental Documents similarly failed to address the public availability of the WINS reference. Exhibit 1016 of the Petitioner submissions (the “Kolesnikov Declaration”) discusses the alleged release of the WINS document, but does not establish that the WINS document was ever publicly available or publicly distributed. The Kolesnikov Declaration includes an attachment depicting the typical contents of the Windows NT 3.5 Server product as allegedly distributed in the fall of 1994. These contents of the Server product, as shown by Petitioner’s declarant, do not include Exhibit 1004 or any printed manual other than the “Installation Guide.”<sup>116</sup> The remaining Nov. 27 Supplemental Documents were either re-submissions of the Nov. 6 Supplemental Documents or

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the product, not a date on which the product would be available for purchase by the general public. *See, e.g.*, Ex. 2039, Nov. 6, 2013 Petitioner’s Supplemental Evidence (A)(1) (“Microsoft debuts NT 3.5,” Nov. 1994 (“NT Workstation 3.5, priced at US\$319 (US\$99 for NT 3.1 upgrades), ***should be available*** by the time you read this.”) (emphasis added).

<sup>115</sup> Ex. 2036, Nov. 27, 2013 Petitioner’s Supplemental Evidence.

<sup>116</sup> Ex. 2037, November 27, 2013 Petitioner Decl. of Yuri Kolesnikov at 4.

articles that similarly failed to address the release or publication of WINS.<sup>117</sup>

Patent Owner expects that Petitioner will argue its Supplemental Documents are sufficient evidence of public availability under the standards of various cases that were cited in its service of the Supplemental Documents. However, the cited cases merely highlight the Petitioner's own deficiencies its submitted Supplemental Documents. For example, the prior art submitted in *Finjan, Inc. v. Symantec Corp.*,<sup>118</sup> was a computer product, not a printed publication. The challenger merely had to present evidence that the product itself was known, used, sold, or on sale prior to the critical date in that case. In *Constant v. Advanced Micro-Devices, Inc.*,<sup>119</sup> the challenger submitted "extensive uncontroverted evidence of business practice" to prove that a piece of prior art was accessible to the public. The court cited *In re Hall*<sup>120</sup>, in its analysis, where routine business practice was established via affidavits of the director and manager of the business in question. The affidavits listed "express facts regarding the specific dissertation of interest and his description of the routine treatment of dissertations in general, in the ordinary course of business." The remaining cited cases are inapplicable. Both

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<sup>117</sup> See Ex. 2036, Nov. 27, 2013 Petitioner's Supplemental Evidence.

<sup>118</sup> 2013 WL 5302560 (Sept. 19, 2013 D. Del.),

<sup>119</sup> 848 F.2d 1560 (Fed. Cir. 1988)

<sup>120</sup> 781 F.2d 897, 899 (Fed. Cir. 1986)

*Rackable Systems, Inc. v. Super Micro Computer Inc.*,<sup>121</sup> and *Finjan, Inc.* were denials of summary judgment motions, which carry a different burden of proof than Petitioner's in this *inter partes* review. Petitioner has the burden to establish a proposition of unpatentability by a preponderance of the evidence, whereas summary judgment on a motion is appropriate only "when the evidence shows there is no genuine issue of material fact."<sup>122</sup> The court in *Rackable*, for example, held that a copyright date on a datasheet, in combination with several affidavits claiming the public distribution of the papers, merely created a triable issue of fact as to the public availability of the submitted papers.

Patent Owner encountered an analogous situation in the Previous Reexamination, in which the third party requester submitted software manuals and claimed that the documents were publicly available printed publications.<sup>123</sup> The requester then attempted to date the documents by submitting a declaration that stated the release date of the associated software product. The declaration also stated that "Electronic copies of these documents were publicly distributed in 1994 as part of the [asserted prior art] software, which was commercially released and

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<sup>121</sup> 2007 WL 1223807 (April 25, 2007 N.D. Cal.)

<sup>122</sup> *Rackable Systems, Inc.*, 2007 WL 1223807 at \*10-11.

<sup>123</sup> *See* Ex. 2038, May 11, 2010 Office Action in Reexamination, at 4 ("VocalChat are not printed publications.").



on sale to the general public as a boxed product in 1994.”<sup>124</sup> After Patent Owner pointed out that the declaration and submitted documents merely stated the release date of (1) the associated software product, or (2) an electronic copy of the documents not submitted as prior art, rather than the piece of prior art itself, the Examiner dismissed the piece of prior art as an inappropriate reference. Here, as in the Previous Reexamination, Petitioner has not submitted evidence of the release date of the WINS manual asserted as prior art.

As Petitioner has been unable to satisfy its burden of demonstrating that the WINS reference was accessible to the public, Patent Owner respectfully submits that the WINS reference cannot form the basis of Petitioner’s anticipation and obviousness arguments.

### **CONCLUSION**

For the foregoing reasons, Patent Owner respectfully submits that the proceeding should be dismissed in its entirety and that the patentability of claims 1-7 and 32-42 should be confirmed.

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<sup>124</sup> See Ex. 2004, Response to Non-Final Rejection in a Re-Examination, at 29-31.

Respectfully Submitted,

Date: January 30, 2013

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that this PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.120 was served, by agreement of the parties, by electronic mail on counsel for the Petitioner on January 30, 2014 as follows:

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