

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION

Petitioner

v.

INNOVATIVE COMMUNICATIONS TECHNOLOGIES, INC.

(now STRAIGHT PATH IP GROUP, INC.)

Patent Owner

Patent No. 6,009,469

Filing Date: September 25, 1996

Issue Date: December 28, 1999

Title: GRAPHIC USER INTERFACE FOR
INTERNET TELEPHONY APPLICATION

Inter Partes Review No. IPR2014-00231, Filing Date December 5, 2013

**PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW**

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Straight Path IP Group, Inc., formerly Innovative Communications Technologies, Inc. (“Patent Owner”), respectfully submits this Preliminary Response opposing the Petition for *Inter Partes* Review filed by Sony Corporation (“Petitioner” or “Sony”) concerning U.S. Patent No. 6,009,469 (“the ’469 Patent”).

INTRODUCTION

The ’469 Patent relates to point-to-point communication between two on-line processes, in which a first process queries a server to determine the on-line status of a second process before establishing this point-to-point communication. A 2010 *ex parte* reexamination confirmed claims 1-3, 9, and 17-18 of the ’469 Patent. Notwithstanding this confirmation, Petitioner now challenges the same claims (as well as claim 10) on the basis of three primary references: (1) the Microsoft Manual; (2) VocalChat; and (3) Little-1994. None of these references, whether alone or in combination with Sony’s other cited references, anticipate or render obvious these claims.

The Microsoft Manual only teaches a query into the address of a computer, rather than the claimed query into the *on-line status* of a process running on that computer. Likewise, Sony itself has admitted that VocalChat does not disclose a query into the on-line status of a process, and that it also does not disclose the dynamic addressing requirement of claims 1-3. Moreover, Petitioner has admitted that Little-1994 should not be considered by the Board, as its invalidity contentions

relating to Little-1994 require the adoption of an unsupported claim construction. Ultimately, Petitioner's conclusory arguments rest on hindsight, fail to account for the fact that the cited references do not disclose all the claims' requirements (even in combination), and ignore the difficulties that these references otherwise describe in combining the claimed features.

Therefore, Petitioner has not established a reasonable likelihood of prevailing on its invalidity contentions, as required by 35 U.S.C. § 314(a). Accordingly, Patent Owner respectfully submits that Petitioner's Request for *Inter Partes* Review be denied, for the reasons explained more fully below.

I. THE '469 PATENT

The '469 Patent is entitled "Graphic user interface for internet telephony application," and was filed September 25, 1996 and issued on December 28, 1999. As stated in the Abstract of the '469 Patent, the claimed invention relates generally to "[a] communication utility for establishing real-time, point-to-point communications between processes over a computer network."¹ To achieve the objective of facilitating a point-to-point communication link between the two processes, the '469 Patent teaches "transmitting from a client process to a server a query as to whether a second client process is connected to the computer

¹ '469 Patent at Abstract.

network.”² If the server determines that the second process is on-line, it will provide the requesting process with the network protocol address of the requested process in order to establish a point-to-point communication link between the two processes. Significantly, the invention of the ’469 Patent was explicitly created to facilitate this communication in the context of dynamically assigned addresses.³

II. THE ’469 PATENT *EX PARTE* REEXAMINATION

The ’469 Patent was previously the subject of a third-party request for *ex parte* reexamination initiated on February 23, 2009 (Control No. 90/010,422). The request challenged claims 1-3, 5-6, 8-9, and 14-18 on the basis of six groups of references, including VocalChat and the Pinard reference relied upon by Petitioner.⁴ On May 10, 2010, the Patent Office issued a Reexamination Certificate confirming the patentability of claims 5 and 6, and determining claims 1-3, 9, 14-18 to be patentable as amended.⁵ In the reexamination, Patent Owner demonstrated that claim 1’s limitation of “program code for determining the

² ’469 Patent at 3:19-21

³ ’469 Patent at 2:35-38. (“Due to the dynamic nature of temporary IP addresses of some devices accessing the Internet, point-to-point communications in real-time of voice and video have been generally difficult to attain.”).

⁴ Ex. 2002, Request for Ex Parte Reexamination at 1-3.

⁵ Ex. 2003, ’422 Reexamination Certificate at 16.

currently assigned network protocol address of the first process upon connection to the computer network” established a dynamic element not present in the prior art.⁶ The Examiner also noted that VocalChat did not teach dynamic addressing, and attempted to combine VocalChat with DHCP to allegedly render obvious the “dynamic addressing” limitation.⁷ The Examiner also stated that claim 9 was allowable because the “prior art does not explicitly teach a method for establishing a point-to-point communication including querying the server process as to the on-line status of the first callee process.”⁸

The reexamination thus established that the submitted prior art failed to disclose limitations of the challenged claims. The Examiner also ultimately dismissed VocalChat from consideration because the requestor had failed to establish the public availability of the references.⁹

⁶ Ex. 2004, Notice of Intent to Issue a Reexamination Certificate at 4-5; *see also* Ex. 2005, Final Rejection at 14 (“Examiner first notes that claim 8 does not require any dynamic addressing limitations, *unlike claims 1 and 5.*”) (emphasis added).

⁷ Ex. 2006, Reexam-Non-Final Action at 22.

⁸ Ex. 2004, Notice of Intent to Issue Ex Parte Reexamination Certificate at 5.

⁹ Ex. 2005, Final Rejection at 12-13.

III. PETITIONER’S REQUEST FOR *INTER PARTES* REVIEW

Sony’s Petition requests cancellation of claims 1-3, 9-10, and 17-18 as obvious in view of the following prior art references. Notably, Petitioner has asserted an obviousness argument for each of its invalidity contentions, although the Petition is devoid of any significant obviousness analysis. For ease of reference, Sony’s invalidity grounds are summarized below:

Primary Reference	Asserted Reference(s)	Claims
Microsoft Manual	(1) Microsoft Windows NT™ Version 3.5 TCPIP.HLP (“Microsoft Manual”); and (2) U.S. Patent No. 5,375,068 to Palmer et al. (“Palmer”)	1-3, 9-10, and 17-18
	(1) Microsoft Manual; (2) Palmer; and (3) U.S. Patent No. 5,533,110 to Pinard et al. (“Pinard”)	9-10 and 17-18
VocalChat References	(1) VocalChat Version 2.0 trouble.hlp; (2) VocalChat Version 2.0 readme.txt; (3) VocalChat Version 2.0 User’s Guide; (4) VocalChat Version 2.0 info.hlp; and (5) VocalChat Version 2.0 voelchat.hlp (collectively, “VocalChat References”)	1-3, 9-10, and 17-18
	(1) VocalChat References; and (2) Droms, R., Dynamic Host Configuration Protocol, RFC 1541 (Oct. 1993) (“RFC 1541”)	1-3
	(1) VocalChat References; and (2) Pinard	9-10 and 17-18

Little-1994	(1) Little, T.D.C., et al., "Client-Server Metadata Management for the Delivery of Movies in a Video-On-Demand System," First International Workshop on Services in Distributed and Networked Environments, June 27-28, 1994 ("Little-1994"); and (2) Postel, J., Internet Protocol, RFC 791 (Sept. 1981) ("RFC 791")	1-2, 3
	(1) Little-1994; (2) RFC 791; and (3) RFC 1541	1-3
	(1) Little-1994; and (2) Little, T.D.C., et al., "A Digital On-Demand Video Service Supporting Content-Based Queries," Proc. 1st ACM International Conference on Multimedia, August 1993 ("Little-1993"); and (3) RFC 791	9-10 and 17-18
	(1) Little-1994; (2) Pinard; and (3) RFC 791	9-10 and 17-18

As shown above, each obviousness contention is based on (1) the Microsoft Manual; (2) VocalChat; or (3) Little-1994. As more fully discussed below, these three references are missing significant limitations required by the '469 claims:

- The Microsoft Manual and VocalChat lack a query into the on-line status of a process. Each reference establishes connections with any computer or process that has previously been registered in its system, rather than determining whether that process is currently on-line. As will be shown below, a previous registration does not indicate the current on-line status of a process.
- The Microsoft Manual and VocalChat do not teach the transmission of a unique identifier of a computer process.
- Petitioner has admitted that Little-1994 should not be considered, because the Board should not consider Little-1994 unless it adopts an unsupported claim construction.

- Little-1994 only discloses communications between the first process and the server, rather than communications between the required first and second process.
- Neither VocalChat nor Little-1994 teach dynamic addressing.

As will be shown below, Petitioner’s invalidity contentions are based in large part on unsupported and flawed claim construction proposals and a selective reading of the prior art.

IV. LEGAL STANDARD

The applicable standard for instituting an *inter partes* review is set forth at 35 U.S.C. § 314(a), which provides in relevant part:

THRESHOLD—The Director may not authorize an *inter partes* review to be instituted unless the Director determines that . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

To anticipate a claim, the prior art reference “must disclose each and every limitation of the claimed invention.”¹⁰ To invalidate a claim by obviousness based on multiple references, the prior art still must disclose all the limitations of the claims.¹¹ Moreover, “a patent composed of several elements is not proved obvious

¹⁰ *Verizon Servs. Corp. v. Cox Fibernet Va., Inc.*, 602 F.3d 1325, 1336-37 (Fed. Cir. 2010).

¹¹ *See CFMT, Inc. v. YieldUp Int’l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)

merely by demonstrating that each of its elements was, independently, known in the prior art ... [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”¹²

ARGUMENT

I. PETITIONER’S PROPOSED CLAIM CONSTRUCTIONS ARE UNSUPPORTED AND CONTRADICTED BY THE CLEAR DISCLOSURES OF THE ’469 PATENT

In an *inter partes* review, claims are to be given their broadest reasonable interpretation in light of the specification.¹³ This broadest reasonable interpretation of the claims must be “consistent with the specification.”¹⁴ A claim construction may be “unreasonably broad” if it is not “read in light of the specification and teachings in the underlying patent.”¹⁵

(non-obviousness ruling proper when “no combination of the prior art, even if supported by a motivation to combine, would disclose all the limitations of the claims”).

¹² *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

¹³ 37 C.F.R. § 42.100(b).

¹⁴ *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010) (quoting *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)).

¹⁵ *In re Suitco*, 603 F.3d at 1260.

Given this standard, Petitioner has proposed a number of flawed claim constructions. For purposes of this Preliminary Response and as further described below, Patent Owner focuses on two key limitations, which are most relevant to the prior art asserted by Petitioner. First, Petitioner has proposed incorrect constructions for “transmitting, from the first process to the server process, a query as to whether the second process is connected to the computer network” / “querying the server process to determine if the first callee process is accessible.” Moreover, Petitioner has proposed improper constructions for “connected to the computer network” / “on-line” and “accessible,” which are part of the above limitations. Petitioner has improperly argued that “connected to the computer network” may be established by registration of a process, and effectively construed the above limitations as a query into *registration* rather than the required query into *on-line status* of a process. Second, Petitioner’s proposed construction of “program code for determining the currently assigned network protocol address of the first process upon connection to the computer network” eliminates the dynamic addressing requirement of the limitation by replacing relevant language of the limitation.

A. The Challenged Claims Require Either Querying into On-Line Status of a Second Process, Dynamic Addressing, or Forwarding a Unique Identifier of a Process to a Server

At issue in the Petition are claims 1-3, 9-10, and 17-18. Claims 3, 9-10, and

17-18 require a query as to the *on-line status* of a second process, not just a query into whether a computer or process is registered with a server. Each challenged claim also requires executing a process by the computer system, and claims 1-3 require that a unique identifier of that process be forwarded to the server process. Claims 1-3 further require dynamic addressing, as claimed by “determining the currently assigned network protocol address... upon connection to the computer network.” The relevant limitations of each challenged claim are set forth below.

Claim 1	<p>A computer program product for use with a computer system having a display, the computer system capable of <i>executing a first process</i> and <i>connecting to other processes and a server process</i> over a computer network, the computer program product comprising a computer usable medium having computer readable code means embodied in the medium comprising:</p> <ul style="list-style-type: none"> a. program code for generating a user-interface enabling control of <i>a first process executing on the computer system</i>; b. program code for <i>determining the currently assigned network protocol address</i> of the first process <i>upon connection to the computer network</i>; c. program code responsive to the currently assigned network protocol address of the first process, for establishing a communication connection with the server process and for <i>forwarding the assigned network protocol address of the first process and a unique identifier of the first process to the server process</i> upon establishing a communication connection with the server process; and d. program code, responsive to user input commands, for <i>establishing a point-to-point communications with another process</i> over the computer network.
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Independent claim 1 first identifies that the process of the challenged claims is a computer program, via the language “[a] computer program product for use

with a computer system..., the computer system capable of executing a first process.” It reiterates the execution of this process in step (a) (“a first process executing on the computer system”). Claim 1 further requires forwarding a “unique identifier” of this computer program to the server, rather than forwarding an identifier of the computer itself (“program code...for forwarding the assigned network protocol address of the first process and *a unique identifier of the first process* to the server process upon establishing a communication connection with the server process”). Claim 1 also requires dynamic address allocation, by claiming “program code for determining the *currently assigned* network protocol address of the first process *upon connection to the computer network.*” Last, claim 1 incorporates the ’469 Patent objective of establishing a point-to-point communication between two processes, rather than just a connection between a first process and a server (“executing a first process and connecting to other processes and a server process”; “establishing a point-to-point communications with another process over the computer network”). Claim 2 is dependent upon claim 1 and therefore incorporates the above limitations.

Claim 3	<p>The computer program product of claim 2 wherein the program code for establishing a point-to-point communication link further comprise:</p> <p>d.2 program code for transmitting, from the first process to the server process, <i>a query as to whether the second process is connected to the computer network</i>; and</p> <p>d.3 program code means for receiving a network protocol address of the second process from the server process, <i>when the second process is connected to the computer network.</i></p>
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Claim 3 requires “transmitting...a query as to whether the second process is connected to the computer network” and 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. Because it depends from claim 2, claim 3 also incorporates the limitations requiring (1) execution of a process, (2) transmission of a unique identifier of that process, (3) point-to-point communication between two processes, and (4) dynamic address allocation.

Claim 9 ¹⁶	<p>In a computer system having a display and capable of <i>executing a process</i>, a method for <i>establishing a point-to-point communication from a caller process to a callee process</i> over a computer network, the caller process capable of generating a user interface and being <i>operatively connected to the callee process and a server process</i> over the computer network, the method comprising the steps of:</p> <ul style="list-style-type: none"> A. generating a user-interface element representing a first communication line; B. generating a user interface element representing a first callee process; C. <i>querying the server process to determine if the first callee process is accessible</i>; and D. <i>establishing a point-to-point communication link</i> from the caller process to the first callee process, in response to a user associating the element representing the first callee process with the element representing the first communication line, wherein step C further comprises the steps of: <ul style="list-style-type: none"> C.1 <i>querying the server process as to the on-line status of the first callee process</i>; and C.2 receiving a network protocol address of the first callee
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¹⁶ Claim 17 depends from claim 9 and thus requires the following limitations.

Claim 18 depends from claim 17, and thus also requires the following limitations.

process over the computer network from the server process.

Independent claim 9 requires “querying the server process to determine if the first callee process is accessible” in order to “establish[] a point-to-point communication from a caller process to a callee process.” Claim 9 specifies that the query into the accessibility of the callee process is performed by “querying the server process as to the on-line status” of that process, and that the first caller process then receives a network protocol address of the first callee process.

Claim 9, like claim 1, also identifies that the process of the claim is a computer program rather than a computer itself (“a computer system...capable of executing a process”), and requires a point-to-point communication between two processes rather than just a connection between one process and the server (“establishing a point-to-point communication from a caller process to a callee process”; “establishing a point-to-point communication link from the caller process to the first callee process”).

Claim 10	<p>The method of claim 8 further comprising the step of:</p> <ul style="list-style-type: none">E. generating a user-interface element representing a second communication line. <p>Claim 8. In a computer system having a display and <i>capable of executing a process</i>, a method for <i>establishing a point-to-point communication from a caller process to a callee process</i> over a computer network, the caller process capable of generating a user interface and being <i>operatively connected to the callee process and a server process</i> over the computer network, the method comprising the steps of:</p> <ul style="list-style-type: none">A. generating a user-interface element representing a first
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	<p>communication line;</p> <p>B. generating a user interface element representing a first callee process;</p> <p>C. querying [sic, “<i>querying</i>”] <i>the server process to determine if the first callee process is accessible</i>; and</p> <p>D. <i>establishing a point-to-point communication link</i> from the caller process to the first callee process, in response to a user associating the element representing the first callee process with the element representing the first communication line.</p>
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Claim 10 depends from claim 8, which is not included in Petitioner’s request for *inter partes* review. Claim 8, as identified above, requires (1) querying whether a callee process is accessible, (2) executing a process, and (3) establishing point-to-point communication between a caller and callee process. Claim 10 therefore requires these same limitations.

B. Petitioner’s Suggestion that “On-Line” Means “Registered with a Server” Is Improper

Petitioner acknowledged that the broadest reasonable construction is the proper standard to apply in an *inter partes* review, and that “connected to the computer network” and “on-line” should therefore be construed as “on-line, e.g., registered with a server.”¹⁷ This definition is not based on the specification, but instead misconstrues a prior Board Decision to Institute in a pending *inter partes* review involving related U.S. Patent 6,108,704 (“704 Patent”).¹⁸

¹⁷ Petition at 19.

¹⁸ Petition at 19.

In the pending *inter partes* review, the Board agreed, for at least the purposes of its Decision to Institute, that the '704 Patent specification (which is incorporated in its entirety into the '469 Patent) supports a construction of “connected to the computer network” as “being on-line.”¹⁹ Patent Owner agrees that the claims require and the specification confirms that “connected to the computer network” requires that a process “is on-line.” The Board, however, then stated that “being ‘on-line,’ [] can be done by registering an address with the server.”²⁰ Patent Owner respectfully disagrees with the Board’s conclusion that registration of a process can satisfy the '469 Patent’s on-line requirement. As will be demonstrated below, the '469 Patent does not teach that previous registration of a process is an indication of the current on-line status of that process. The Board therefore erred in determining that past registration of a process can be used in determining whether or not a process is currently on-line.

Petitioner has adopted this same flawed construction, proposing that “on-line” be construed as “on-line, e.g., registered with a server.” The reason for Petitioner’s construction is that the cited prior art only teaches initial registration, but does not teach determination of on-line status. In fact, the asserted prior art demonstrates that registration is a one-time, initial enrollment of a process or

¹⁹ Ex. 2007, IPR2013-00246 Paper No. 11, Decision to Institute at 5-6.

²⁰ Ex. 2007, IPR2013-00246 Paper No. 11, Decision to Institute at 6.

computer within a system. Specifically, the Microsoft Manual states that a computer “registers its name and IP address on the network *during system startup*.”²¹ Similarly, VocalChat specifies that its “Address Book contains the names of all the network users who have VocalChat installed,” and that “[t]his information is *set during installation*.”²² In both references, the server only relies upon this previous registration to establish connections to a second computer or process. In the Microsoft Manual, “[a]ny name-to-IP address mapping *registered with a WINS server* can be provided reliably as a response to a name query.”²³ In VocalChat, “users can open the Address Book...and access *any of the users listed*.”²⁴ Because these connections are based on initial registration, rather than current on-line status, each reference cautions that the requested computer or process may not be connected to the network at the time of the query. Specifically, in the Microsoft Manual, “a mapping in the database *does not ensure that the related device is currently running*,” and in VocalChat, calls are made “even when the user is away *and his system is not working*.”²⁵ Registration in a system thus

²¹ Ex. 1014, Microsoft Manual at 62 (emphasis added).

²² Ex. 1023, User Guide at 28 (emphasis added).

²³ Ex. 1014, Microsoft Manual at 69 (emphasis added).

²⁴ Ex. 1023, User Guide at 10 (emphasis added).

²⁵ Ex. 1014, Microsoft Manual at 69; Ex. 1023, User Guide at 10 (emphasis

does not indicate whether a process is currently on-line, and a response based on the previous registration of a process does not convey information regarding whether that process is on-line at the time of the query.

The '469 Patent, in contrast to the above references, requires more than a query into whether a process is simply registered in the server. Instead, as shown above, claims 3, 9-10, and 17-18 clearly require a query into whether the process is *currently on-line*, so that the two processes may engage in a point-to-point communication link. Because registration does not require that a process remains on-line with the network, a response based on the previous registration of a process does not satisfy the required query. Further, the '469 Patent specification repeatedly requires a specific query into or a determination of “on-line status.”

For example, the Summary of the Invention states that a “query” is transmitted from a process to a server to identify “whether a second client process is connected to the computer network” for establishing a point-to-point communication link:

[A] computer program product for use with a computer system comprises a computer usable medium having computer readable program code means ... for *transmitting from a client process to a server a query as to whether a second client process is connected to the computer network*, program code means for receiving the network

added).

protocol address of the second process from the server, and program code means responsive to the network protocol address of the second client process for establishing a point-to-point communication link between the first client process and the second client process.²⁶

The Figures of the '469 Patent also demonstrate that a query is performed to identify on-line status,²⁷ and the specification includes the following statements that emphasize a query is transmitted or a determination is made to determine the on-line status of a process with respect to the computer network:

- [A] need exists for a way to determine whether computer users are *actively connected* to a 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.

²⁶ '469 Patent at 3:16-27 (emphasis added).

²⁷ 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 states that the system will “receive [a] query from [the] first unit whether a specified second unit is logged-in,” and “retrieve [the] IP address from [the] database if the second unit is logged-in.”

- 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.
- 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*.
- First processing unit initiates the point-to-point Internet protocol by sending a query from the first processing unit to the connection server. If connection server is operative to perform the point-to-point Internet protocol, *first processing unit receives an on-line status signal from the connection server*... Next, first processing unit performs the primary point-to-point Internet protocol, which may include receiving, at the first processing unit, the IP address of the callee *if the callee is active and on-line*.²⁸

²⁸ '469 Patent at 2:51-53; 7:5-9; 7:31-38; 7:44-47; 7:49-59; 11:64-12:9 (emphases

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.²⁹

Expert analysis provided in the pending '704 Patent *inter partes* review demonstrated that simply registering an address with a server is not equivalent to being “connected to the computer network” or “on-line.”³⁰ While a process may be on-line at the time of registration, that process may subsequently go off-line or disconnect from the network and still remain registered with a server. As shown above, references asserted in this *inter partes* review unequivocally state that a computer’s registration on its server “does not ensure that the related device is

added).

²⁹ '469 Patent at 7:15-18.

³⁰ Ex. 2008, IPR2013-00246 Ex. 2018, Mayer-Patel Declaration at 12 (“The connection to the computer network required by the '704 Patent is not perpetual once it is initially established; a process may be initially connected to the network and subsequently disconnected. A process or computer program that has been initially registered with the network is therefore not inherently connected to the network after that registration is first established... While a processing unit is active and on-line at registration, it may subsequently go off-line and become inactive, but the process may maintain its registered status.”).

currently running.”³¹ Because a process may be off-line but still registered within a system, registration of a process within a system does not inherently require that the process is on-line. Petitioner’s proposal that “connected to the computer network” and “on-line” be construed as “on-line, e.g., registered with a server” is thus unsupported by the ’469 Patent and inconsistent with the asserted references.

Petitioner’s expert nevertheless relies on Petitioner’s incorrect claim construction and equates “registration” with “on-line status” in forming his conclusions regarding the references.³² Patent Owner respectfully notes that if the Board correctly construes “connected to the computer network” and “on-line” as “on-line,” the conclusions set forth by Petitioner’s expert should be disregarded because they are inconsistent with the proper construction of the claims. Patent Owner therefore respectfully submits that “connected to the computer network” and “on-line” be construed as “on-line,” consistent with the specification.

C. Petitioner’s Suggestion that “Accessible” Means “Registered with a Server” Is Baseless

Petitioner has admitted that “accessibility” is not “distinguished from ‘on-

³¹ Ex. 1014, Microsoft Manual at 69; *see also* Ex. 1025, Help File at 4 (describing how VocalChat users can leave messages for another user “even when [the user’s] *computer is turned off*”) (emphasis added).

³² Ex. 1004, Crovella Declaration at 27, 43-46.

line’ or ‘connected’ status,” and that “all three terms are ‘related’ with a common meaning.”³³ Petitioner has thus proposed that “accessible” “should be construed to mean ‘on-line, e.g., registered with a server.’”³⁴ Patent Owner agrees that being “accessible” is related to being “connected to the computer network” or “on-line.” But as demonstrated above, merely registering an address with a server is not equivalent to being “connected to the computer network” or “on-line.” For the reasons discussed above, and because Patent Owner and Petitioner are in agreement that “accessible,” “connected to the computer network,” and “on-line” have “a common meaning,” Patent Owner respectfully submits that “accessible” be construed as “on-line,” consistent with the ’469 Patent specification and claims.

D. Petitioner’s Alternative Constructions for “Query” Have No Basis in the Claims or Specification

Petitioner has offered not one, but two separate constructions for the limitations of “transmitting, from the first process to the server process, a query as to whether the second process is connected to the computer network” and “querying the server process to determine if the first callee process is accessible.” Both of Petitioner’s proposed constructions are inconsistent with the claim language and specification.

³³ Petition at 20.

³⁴ Petition at 20.

As identified above, the proper standard for claim construction in an *inter partes* review is the “broadest reasonable construction,” and under such a standard, “words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification.”³⁵ A “query as to whether the second process is connected to the computer network” needs no construction, subject to the construction of “connected to the computer network” discussed above. Petitioner, however, has offered two constructions for the above limitations. Petitioner has stated that its first proposed construction is in fact unsupported by the ’469 Patent specification, and that Petitioner does *not* consider it “the broadest reasonable construction consistent with the specification.”³⁶ As a result, the first proposed construction should not be considered. Petitioner admitted that if the Board does not adopt this construction, as Petitioner suggests, then the invalidity contentions based upon primary reference Little-1994 should also not be considered.³⁷

³⁵ MPEP 2111.01; *see also* 37 C.F.R. § 42.100(b).

³⁶ Petition at 22-23. Petitioner’s first proposed construction is “[program code for] transmitting, to the server, a message seeking an indication whether a second process, identified either in the message or in another manner (e.g., by the server following receipt of the message), is connected to the computer network.”

³⁷ Petition at 22 (“Grounds 6-10, in which Little-1994 (disclosing a movie delivery system similar to Netflix or YouTube) is applied against the challenged claims,

Petitioner’s second construction is also improper, as it “unnecessarily import[s] limitations from the specification into the claims.”³⁸ Petitioner suggests that the query limitation should be defined as “transmitting, to the server, a message seeking an indication whether a specific process identified in the message is connected to the computer network.”³⁹ The ’469 Patent does not limit identification of the second process to a “specific process.” In fact, the specification provides that a process may be requested when it is not yet assigned its network protocol address.⁴⁰ In certain embodiments, “[t]he actual IP address utilized by the user’s processing unit is *immaterial*” during the querying process.⁴¹

thus depend on the Board adopting such a broad construction.”).

³⁸ *E-Pass Techs., Inc. v. 3COM Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003); *see also SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment”) and MPEP 2111.01 (“Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification.”).

³⁹ Petition at 23.

⁴⁰ ’469 Patent at 8:57-9:10.

⁴¹ ’469 Patent at 8:67-9:1 (emphasis added).

Petitioner's second proposed construction thus impermissibly narrows the scope of the claim language, and is even contradicted by disclosures within the '469 Patent.

Second, as identified above, the claim language and specification fully support that the challenged claims require a query into on-line status, as opposed to a "message" transmission as proposed by Petitioner. Patent Owner therefore respectfully submits that the term "query," as unambiguously required by the claim language, not be read out of the challenged claims, and that the claim limitations "transmitting, from the first process to the server process, a query as to whether the second process is connected to the computer network" and "querying the server process to determine if the first callee process is accessible" should instead be construed according to the plain and ordinary language of the claims.

E. Petitioner's Construction for "Determining the Currently Assigned Network Protocol Address [] Upon Connection to the Computer Network" Eliminates Claim 1's Dynamic Addressing Requirement

Claim 1 requires dynamic address allocation, as required by the claim language "program code for determining the *currently assigned* network protocol address of the first process *upon connection to the computer network.*" Petitioner has proposed that this limitation be construed as "program code that is capable of determining the current assigned network protocol address of a first process after

the process connects to the computer network.”⁴² This proposed limitation eliminates the language that specifies that a “network protocol address” is a dynamically assigned address, as demonstrated by the fact that it is determined “upon connection to the computer network.”

As explained by Petitioner’s own expert, “A device assigned a static network address retained that address each time it connected to the network. A device assigned a dynamic network address, on the other hand, received a potentially different network address each time it connected to the network.”⁴³ A network protocol address received upon its connection to a computer network is therefore, by definition, a dynamically assigned address.

As stated above, the Examiner of the ’469 reexamination credited this distinction between static and dynamic addresses, holding that dynamic addressing was required in claim 1.⁴⁴ Further, the Examiner noted that VocalChat alone did not teach this dynamic addressing element of claim 1, and instead combined the VocalChat References with RFC 1531, stating that, “VocalChat does not explicitly

⁴² Petition at 18.

⁴³ Ex. 1004, Crovella Declaration at 10.

⁴⁴ Ex. 2005, Final Rejection at 14 (“Examiner first notes that claim 8 does not require any dynamic addressing limitations, *unlike claims 1 and 5.*”) (emphasis added).

teach b. program code for *determining the currently assigned network protocol addresses* of the first process *upon connection to the computer network*. RFC 1531 teaches dynamically assigning IP addresses in a TCP/IP network by an Internet access server.”⁴⁵

Moreover, the '469 specification confirms that network protocol addresses received by processes “upon connection to the computer network” are dynamically assigned network addresses. One of the objectives of the '469 Patent was to create a system in which processes with dynamically assigned addresses could establish point-to-point communications. As described by the Background:

Permanent [‘static’] IP addresses of users and devices accessing the Internet readily support point-to-point communications of voice and video signals over the Internet... Due to the *dynamic* nature of *temporary IP addresses* of some devices accessing the Internet, point-to-point communications in realtime of voice and video have been generally difficult to attain.

The ability to locate users having *temporary or dynamically assigned* Internet Protocol address has been difficult without the user manually

⁴⁵ Ex. 2006, Reexam- Non-Final Action at 22-23 (emphasis added). The Examiner applied the same dynamic analysis to claim 5, which also included the limitation of “determining the currently assigned network protocol address of the first process upon connection to the computer network.” Ex. 2006, at 23-24.

initiating the communication. Accordingly, spontaneous, real-time communications with such users over computer networks have been impractical.⁴⁶

The specification clarifies that the system of the '469 Patent was designed in view of this difficulty: "When either of the processing units 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."⁴⁷ Further, "[a]s shown in FIG. 1, the disclosed point-to-point Internet protocol and system operate when a callee processing unit *does not have a fixed or predetermined IP address*."⁴⁸

Significantly, Petitioner's own expert admits that an address assigned "upon connection to the network" is a dynamically assigned address. In analyzing the system of the '469 Patent, Petitioner's expert states, "DHCP techniques were in use on both private networks and on the Internet before February 1995. In each case, the DHCP server assigned an address to the user *dynamically upon connection to the network*."⁴⁹ Petitioner's expert also acknowledges that claim 1 specifically teaches dynamic addressing in the limitation requiring "program code

⁴⁶ '469 Patent at 2:30-43.

⁴⁷ '469 Patent at 6:62-65 (emphasis added).

⁴⁸ '469 Patent at 6:56-59 (emphasis added).

⁴⁹ Ex. 1004, Crovella Declaration at 12 (emphasis added).

for determining the currently assigned network protocol address of the first process upon connection to the computer network.”⁵⁰

Because claim 1 specifies that a “currently assigned network protocol address of the first process” is “determin[ed] . . . upon connection to the computer network,” which by definition is a dynamically assigned network protocol address, Patent Owner respectfully submits that claims 1-3 require dynamic addressing.

II. PETITIONER HAS FAILED TO DEMONSTRATE THAT EACH LIMITATION OF THE CHALLENGED CLAIMS IS FOUND IN THE ASSERTED PRIOR ART

In addition to proposing unsupported and inaccurate claim constructions, Petitioner has failed to demonstrate the presence of key limitations in its asserted prior art. The plain language of the challenged claims of the ’469 Patent require (1) a query into whether the second process is on-line, (2) dynamic addressing, or (3) transmission of a unique identifier of a process, as well as point-to-point communication between two processes. Patent Owner respectfully submits that there are additional patentable limitations of the challenged claims, but will focus on the above limitations for the purposes of this Preliminary Response. As will be

⁵⁰ See Ex. 1004, Crovella Declaration at 38-40 (discussing the disclosures within the Microsoft Manual “that each device is dynamically assigned a network address by a DHCP server” in the analysis of claim 1, limitation b).

demonstrated through excerpts from the asserted references, Petitioner's asserted prior art does not anticipate or render obvious these limitations of the '469 claims.

More specifically, the Microsoft Manual does not disclose a query regarding on-line status of a process, but instead will transmit the address of any computer registered with its server. The Microsoft Manual also does not obtain a unique identifier of a computer process. Similarly, VocalChat will attempt a connection to any user registered in its system without a query into the on-line status of the called process, and only discloses static addresses. Last, Little-1994 discloses a video-on-demand system wherein one process communicates with a server; the reference does not disclose a communication between the process and a second, separate process. Little-1994 also only discloses static addresses.

A. The Challenged Claims are Patentable over the Microsoft Manual in View of Either Palmer or Pinard

Petitioner alleges that the Microsoft Manual in view of Palmer and/or Pinard renders obvious claims 1-3, 9-10, and 17-18. However, several key limitations of the challenged claims are missing from the Microsoft Manual, and are not supplied by either Palmer or Pinard. Claim 1 requires that a unique identifier of a computer program process be forwarded to the server. But the Microsoft Manual only discloses registering the name of a *computer* with the server, not registering the name of a *process* running on that computer. Claims 3, 9-10, and 17-18 further require transmitting a query as to whether a second process is connected to the

computer network. But the Microsoft Manual only discloses a query for the address of a registered computer, not a query into whether a process is on-line. Palmer and Pinard do not additionally disclose the missing unique identifier or query into on-line status, and Petitioner has not argued that Palmer or Pinard teach these limitations.

1. The Microsoft Manual Only Discloses a Database of Registered Computer Names, and Does Not Query the On-Line Status of a Process

As stated above, the Microsoft Manual submitted by Petitioner merely maintains a list of computers that have been initially registered with its database. The Microsoft Manual does not forward a unique identifier of a process to the server upon connection with the server, and does not query as to whether a second process is on-line with the computer network.

Rather, the Microsoft Manual discloses a name server (Windows Name Server, or “WINS”) designed to provide a directory of the addresses of computers that have registered their names in the database. The Manual repeatedly emphasizes that the registry of names corresponds to the computer itself, rather than a process running on that computer. For example, it states that “Name registration ensures that the *computer’s name* and IP address are unique for each

device.”⁵¹ “During TCP/IP configuration, the *computer’s name* is registered with the WINS server.”⁵²

Further, the Microsoft Manual specifically teaches that a query of its database is not a query 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.⁵³ The ’469 Patent’s objective is to establish point-to-point communications between two processes when they are both on-line. A server that simply maintains a log of registered computer names and network addresses cannot achieve this objective.

In the WINS system, names are registered when a computer first connects to the WINS server, but the computer may remain registered even if it is later disconnected from the network. “WINS servers maintain a database that maps

⁵¹ Ex. 1014, Microsoft Manual at 69 (emphasis added).

⁵² Ex. 1014, Microsoft Manual at 68; *see also* Ex. 1014 at 11 (“Windows Internet Name Service (WINS) for dynamically registering and querying *computer names* on an internetwork.”); Ex. 1014 at 62 (“Configuring Windows NT with TCP/IP requires the IP address and *computer name*, which are unique identifiers for *the computer* on the network.”) (emphases added).

⁵³ Ex. 1014, Microsoft Manual at 69 (emphasis added).

computer names to IP addresses,” and WINS offers a “p-node” name resolution system, in which “point-to-point communications with a name server” is used “to resolve names.”⁵⁴ In p-node, however, a first computer merely “queries the WINS server for the address of [a second computer].”⁵⁵ The WINS server then provides the first computer with the registered address of the second computer.

Notably, WINS server does not determine whether the second computer is on-line prior to providing the address of the second computer to the first computer. WINS will instead provide an address for any registered name.⁵⁶ In WINS, this registration occurs at system startup, and will last until the registered name is explicitly released from the system.⁵⁷ In fact, WINS cautions users that a response to a name query “does not ensure that the related device is currently running”:

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.⁵⁸

⁵⁴ Ex. 1014, Microsoft Manual at 63.

⁵⁵ Ex. 1014, Microsoft Manual at 64.

⁵⁶ Ex. 1014, Microsoft Manual at 69.

⁵⁷ Ex. 1014, Microsoft Manual at 69-70.

⁵⁸ Ex. 1014, Microsoft Manual at 69.

The Microsoft Manual also specifies that (1) registration of a computer's name will persist in the WINS system unless and until a name is "challenged" by another computer, and (2) registered computer names remain in the server *even after* a name challenge is issued:

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...If that computer released its name during an orderly shutdown, the WINS server will not challenge the name. If 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.⁵⁹

Accordingly, a registration in the WINS database does not indicate whether the registered computer is connected to the network or "on-line" in the context of the '469 Patent. Petitioner's expert has argued that the "connected to the computer

⁵⁹ Ex. 1014, Microsoft Manual at 70.

network” limitations of the challenged claims are taught by disclosures regarding “registration” of a computer.⁶⁰ However, as stated above, this analysis is based on Petitioner’s improper claim construction proposal that “on-line” may be construed as “on-line, e.g., registered with a server.” The conclusions by Petitioner’s expert regarding the registration of a computer in WINS are therefore inapplicable to a proper analysis of the challenged claims. As demonstrated by the above teachings of the Microsoft Manual, WINS responds to queries based solely on the registration status of the computer, and does not perform a query as to whether a computer or a process is on-line. Further, the query sent to the WINS server is not a query as to the on-line status of a second computer, but is only a query for the address of that computer.

2. The Microsoft Manual in Combination with Palmer Does Not Render Obvious Claims 3, 9-10, and 17-18 Because the References Do Not Teach a Query into the On-Line Status of a Process

Petitioner has failed to establish that claims 3, 9-10, and 17-18 are rendered

⁶⁰ Ex. 1004, Crovella Declaration at 43-46 (“A device is registered with the WINS server until the device releases its name upon shutdown or fails to renew its name within an appropriate time period...Accordingly, the Microsoft Manual discloses that the WINS server maintains a database of devices that are connected to the computer network.”).

obvious by the Microsoft Manual in view of Palmer. As identified above, these claims each require a query into the on-line status of a process, and the Microsoft Manual instead only discloses a query for the address of a computer.

One of the objectives of the '469 Patent, as described above, is to establish a point-to-point communication link between a first and second process. To establish this point-to-point communication link, the challenged claims do more than simply provide that the network address of the second process be sent to the first process; a query is instead transmitted to the server for the on-line status of the second process to ensure that the second process is indeed on-line. As WINS responds to queries based only on the registration status of the computer, and does not perform functions to determine whether a computer is on-line, the Microsoft Manual does not disclose the required query into on-line status of claims 3, 9-10, and 17-18.

The Palmer reference asserted by Petitioner does not additionally disclose a query into the on-line status of a process. Palmer was submitted as an example of a “third party application that could run on Windows NT 3.5 and use the WINS directory server.”⁶¹ The Palmer application does not employ a query of on-line status of a second application before establishing the videoconferencing session.⁶²

⁶¹ Petition at 27.

⁶² See Ex. 1015, Palmer at 35 (9:6-34) (describing the process of “originat[ing] a

Patent Owner therefore respectfully submits that claims 3, 9-10, and 17-18 are not rendered obvious by the Microsoft Manual in combination with Palmer for at least the reason that the references do not teach a query into on-line status of a process.

3. The Microsoft Manual in Combination with Palmer and Pinard Does Not Render Obvious Claims 9-10 and 17-18 Because the References Do Not Teach a Query into the On-Line Status of a Process

Petitioner has also alleged that the Microsoft Manual in combination with Palmer and Pinard render obvious claims 9-10 and 17-18. As established above, the Microsoft Manual and Palmer do not teach the required query into on-line status and accessibility of a process. Pinard does not additionally teach the “querying” requirement of claims 9-10 and 17-18. Pinard has only been submitted by Petitioner to supply the “drag-and-drop” operation as allegedly required by the patent.⁶³ Claims 9-10 and 17-18 therefore are not rendered obvious by the Microsoft Manual in light of Palmer and Pinard at least because the references do not disclose “querying the server process to determine if the first callee process is accessible” or “querying the server process as to the on-line status of the first callee process.”

video teleconference call to another workstation” without mention of (1) a query or (2) consideration of the on-line status of the second workstation).

⁶³ Petition at 35-36.

4. The Microsoft Manual in Combination with Palmer Does Not Render Obvious Claims 1-3 Because the References Do Not Teach Transmitting a Unique Identifier of a Process

As demonstrated above, the Microsoft Manual does not disclose “program code...for forwarding the assigned network protocol address of *the first process* and a unique identifier of *the first process* to the server process upon establishing a communication connection with the server process.” The WINS server only assigns a unique identifier to a *computer*, not to a process running on that computer. This limitation, present in independent claim 1, is therefore not taught by the Microsoft Manual. Palmer does not additionally disclose forwarding a unique identifier of a process to a server, but instead is limited to transmission of audio and video teleconference data across a network.⁶⁴

Additionally, Petitioner has not established that both the assigned network protocol address and unique identifier of the process are forwarded to the server upon connection with the server. Instead, Petitioner’s expert offers the conclusory statement that “[o]nce a device (and therefore a process on the device) determines its dynamically assigned network address, it forwards that address and a unique

⁶⁴ See, e.g., Ex. 1015, Palmer at 31 (1:62-2:2); see also Petition at 30 (listing only Microsoft Manual disclosures for the relevant limitation).

computer name to the WINS server.”⁶⁵

Petitioner’s expert offers the following disclosures to establish that the address and name are forwarded to the server upon connection to the server:

- “During TCP/IP configuration, the computer’s name is registered with the WINS server.”
- “All computers register themselves with the WINS server, which is a NetBIOS Name Server (NBNS) with enhancements. The WINS server is responsible for knowing computer names and addresses and for ensuring no duplicate names exist on the network.”
- “Name registration ensures that the computer’s name and IP address are unique for each device.”⁶⁶

These statements cited by Petitioner’s expert only disclose that the WINS server employs a registration protocol for names in its system. They do not establish that both the “assigned network protocol address of the first process and a unique identifier of the first process” are “forward[ed]...to the server process upon establishing a communication connection” with the server. Further, the foregoing excerpts again emphasize that the WINS server only maintains a registration of *computer* names, not unique identifiers of computer program *processes*. Patent Owner therefore respectfully submits that claims 1-3 are not rendered obvious by

⁶⁵ Ex. 1004, Crovella Declaration at 40.

⁶⁶ Ex. 1004, Crovella Declaration at 40-41.

the Microsoft Manual in combination with Palmer for at least the reason that the references do not teach “forwarding the assigned network protocol address of the first process and a unique identifier of the first process to the server process upon establishing a communication connection with the server process.”

In light of the above, Patent Owner respectfully submits that claims 1-3, 9-10, and 17-18 are not rendered obvious by the Microsoft Manual in view of either Palmer or Palmer and Pinard, for at least the reason that the references in combination do not teach (1) a query into the on-line status of a process, or (2) transmission of a unique identifier of a process to the server.

B. The Claims Require Either a Query into On-Line Status or Dynamic Addressing, and are Therefore Patentable over VocalChat, Alone or in Combination with Pinard or RFC 1541

Petitioner argues that the five VocalChat references (in combination with each other) render obvious challenged claims 1-3, 9-10, and 17-18, that VocalChat in combination with RFC 1541 render obvious claims 1-3, and that VocalChat in combination with Pinard render obvious claims 9-10 and 17-18. As identified above, claims 3, 9-10, and 17-18 require a query into on-line status. Petitioner and Petitioner’s expert have acknowledged that VocalChat does not teach such a query, arguing instead that a person of ordinary skill would have understood VocalChat “to be disclosing, or at least strongly suggesting, obtaining [on-line status]

information by querying the server for that information.”⁶⁷ Pinard and RFC 1541 do not additionally teach a query into the on-line status of a process.

Further, claims 1-3 also require “a unique identifier of the first process.” VocalChat does not ensure unique identifiers of its processes, but instead allows a system user to assign its own name to a process. Claims 1-3 also require dynamic addressing, and Petitioner has acknowledged that VocalChat only manages static addresses and does not teach dynamic addressing. RFC 1541 does teach dynamic address allocation, but Petitioner has not identified how one of ordinary skill in the art would have implemented the management of dynamically assigned addresses into the static addressing system of VocalChat.

1. VocalChat Does Not Teach a Query into On-Line Status of a Process

The VocalChat References disclose a software program that facilitates “vocal communication and voice messaging between network users,”⁶⁸ but, as admitted by both Petitioner and its expert, does not disclose the required query of on-line status. As shown below, VocalChat allows users to call any user in its “Address Book,” which lists all users registered in the VocalChat network. Calls are initiated regardless of whether the selected user’s computer is running

⁶⁷ Petition at 41; *see also* Ex. 1004, Crovella Declaration at 78, 87.

⁶⁸ Ex. 1023, User Guide at 6.

VocalChat, connected to the network, or even turned on at all. Because the VocalChat calls are automatically transmitted, there is no query into the on-line status of the selected user.

The References state that during initial installation, VocalChat “creates a central directory [named the “Post Office”] on the network, shared by all users.”⁶⁹ VocalChat allows each user to access this central directory to leave messages for another user, “even when the user is away and *his system is not working*” or “even when [the user’s] *computer is turned off*.”⁷⁰

The Post Office contains an “Address Book,” which “contains the names of all the users on [the user’s] network that have VocalChat installed.”⁷¹

Significantly, a listing in the Address Book does not indicate whether that user is on-line, as “[a]ll users who have VocalChat *installed* are registered in VocalChat’s Address Book.”⁷² The user simply “open[s] the Address Book by clicking on a tool bar button, and [can] access any of the users listed.”⁷³ The caller may choose any of these registered users to contact, and VocalChat immediately initiates the

⁶⁹ Ex. 1022, Read Me at 2.

⁷⁰ Ex. 1023, User Guide at 10; Ex. 1025, Help File at 4 (emphases added).

⁷¹ Ex. 1025, Help File at 42.

⁷² Ex. 1023, User Guide at 10 (emphasis added).

⁷³ Ex. 1023, User Guide at 10.

call to the user without a query into whether that user is connected to the network. As VocalChat specifies, “a call” is merely “an *attempt* to reach a user through the network” because the user may be unavailable when the call is transmitted.⁷⁴

VocalChat describes this calling procedure as the following:

To call a user

1. Select Call from the Chat menu, or choose the tool bar Call button.

Click on the Call button.

The Address Book dialog box opens.

2. Select a user from the user list, and choose “OK”.

A message appears on the message line, accompanied by a dialing sound, indicating that the call is in progress.⁷⁵

VocalChat even provides a “Quick-Dial button,” which allows a user to initiate a call without locating a name in the Address Book: “Once a [Quick-Dial] button has been set, simply click on it to trigger a call to the user or to leave him a voice message. There is no need to locate his name in the Address Book each time.”⁷⁶

Because a “call is in progress” prior to any determination of the on-line status of the user, the first process does not “transmit[], from the first process to the server process, a query as to whether the second process is connected to the computer

⁷⁴ Ex. 1025, Help File at 50 (emphasis added).

⁷⁵ Ex. 1025, Help File at 8.

⁷⁶ Ex. 1023, User Guide at 25.

network.” Instead, VocalChat offers a system wherein calls are *automatically* transmitted from the caller to the callee, “even when the user is away and his system is not working.”⁷⁷ Clearly, if connections are established in VocalChat when a callee’s “computer is turned off” or “his system is not working,” VocalChat does not include a query into the on-line status of the callee process.

Petitioner has admitted that VocalChat does not disclose receiving a query from the first process as to the on-line status of the second process. Instead, Petitioner relies on the conclusory statement that a person of ordinary skill in the art would have understood VocalChat “to be disclosing, or at least *strongly suggesting*, obtaining [on-line status] information by querying the server for that information.”⁷⁸ Petitioner’s expert also acknowledges the absence of the required “query” in the VocalChat References, stating instead that “[the] description of an accessible source of information about correct address and current user status stored on a server discloses, *or at least strongly suggests* that, as part of a step of establishing a point-to-point communication link, VocalChat queries the server for the correct address and current status of the selected callee.”⁷⁹

⁷⁷ Ex. 1023, User Guide at 10.

⁷⁸ Petition at 41 (emphasis added).

⁷⁹ Ex. 1004, Crovella Declaration at 87 (emphasis added).

Petitioner's acknowledgement of the lack of a query would require the Petitioner to establish the inherency of such a query within VocalChat. To establish inherency, "the extrinsic evidence 'must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference.'"⁸⁰ Petitioner and Petitioner's expert are only willing to state that a query is "strongly suggest[ed]" by VocalChat, not that such a query to the server "necessarily occurs" before the connection between the two processes is established.⁸¹ Moreover, Petitioner has provided an eleven-page declaration from VocalChat's founder, Lior Haramaty, and is still unable to identify the required query within the VocalChat system.⁸² A careful review of all five references reveals that VocalChat does not disclose the capability of receiving any type of query from a user process, much less a query as to on-line status of a process. As explained above, VocalChat transmits calls regardless of the on-line status of the callee process, and explicitly discloses a system in which calls are initiated "even when the user is away and his system is not working" or the user's "computer is turned off."⁸³

⁸⁰ *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citing *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed Cir. 1991) (emphasis added)).

⁸¹ Petition at 41; Ex. 1004, Crovella Declaration at 87.

⁸² Ex. 1005, Haramaty Declaration at 2-12.

⁸³ *See, e.g.*, Ex. 1023, User Guide at 10; Ex. 1025, Help File at 4.

Petitioner has attempted to argue that the query into “on-line status” of a process is suggested by VocalChat’s “Connection List file,” which may be accessed in certain versions of VocalChat.⁸⁴ The “Connections List file” “contains a full list of the network users,” and places an asterisk (*) next to a user to “indicate[] that the user is currently running VocalChat.”⁸⁵ The references, however, do not specify the nature of the relationship between the Connections List file and the VocalChat server, how this file is maintained, or how the file characterizes a user as “currently running VocalChat.” It is apparent, though, that by preemptively providing a list of users running the VocalChat application, the server does not receive a “query” from the first process as to the on-line status of a second process. The user again may simply “[c]hoose the Dial button to both set the button and call the selected user”⁸⁶ from the list, without “transmitting, to the server, a query as to whether the second process is connected to the computer network.” Significantly, Petitioner has admitted that even within the context of the

⁸⁴ Petition at 37-38. The “Connection List file” relied upon by the Petitioner is only present in VocalChat programs running under “Generic” network parameters. *See* Ex. 1025, Help File at 127, 130.

⁸⁵ Ex. 1025, Help File at 130.

⁸⁶ Ex. 1025, Help File at 130.

Connections List, the required query is not disclosed by VocalChat.⁸⁷

2. VocalChat, Alone or in Combination with Pinard, Does Not Render Obvious the Query into On-Line Status of Claims 3, 9-10, and 17-18

As established above, the VocalChat references do not teach transmitting a query as to whether a second process is connected to the computer network. The VocalChat References alone therefore cannot render obvious challenged claims 3, 9-10, or 17-18. Petitioner has additionally asserted that VocalChat in view of Pinard renders obvious claims 9-10 and 17-18. However, the fact that Pinard may “supply the [‘associating’] limitation because it discloses a drag-and-drop operation identical to that described in the ’469 patent” does not remedy the “querying...as to the on-line status” deficiency of VocalChat. Patent Owner therefore respectfully submits that VocalChat does not render obvious claims 3, 9-10, and 17-18, and that the VocalChat References in view of Pinard do not render obvious claims 9-10 or 17-18 for at least the reason that the asserted references do not teach transmission of a query into the on-line status of a second process.

3. VocalChat, Alone or in Combination with RFC 1541, Does Not Render Obvious the Dynamic Addressing or Unique Identifier Requirement of Claims 1-3

Additionally, claims 1-3 are patentable over VocalChat, alone or in combination with RFC 1541, because the asserted references do not teach

⁸⁷ Petition at 40-41.

“program code for determining the currently assigned network protocol address of the first process upon connection to the computer network” or “a unique identifier of the first process.” As established above, the first limitation corresponds to dynamic addressing allocation. VocalChat does not disclose dynamic addressing, or the ability to manage dynamically assigned addresses. In addition, Petitioner has not identified how one of ordinary skill in the art would have combined VocalChat with RFC 1541 to create a VocalChat system that could manage dynamically assigned addresses. VocalChat also does not disclose unique identifiers of its processes, as required by claims 1-3.

a. The VocalChat References Do Not Render Obvious Claims 1-3 Because VocalChat Does Not Teach Dynamic Addresses or Unique Identifiers

The VocalChat server does not manage its user names, but instead allows a user to customize (1) its own name, and (2) names of other users as displayed in its Address Book. As stated by VocalChat, a user “can substitute a custom name for the default name of each user,” and the “details” of each user “can be changed later on by selecting the User Info option in the Options menu.”⁸⁸ VocalChat explicitly disclaims any responsibility for ensuring unique names on its system, instead stating that *the user* “should make sure that this name is not used by any other user

⁸⁸ Ex. 1023, User Guide at 31; Ex. 1024, Info at 4.

on the network,” and that VocalChat only “assumes that different users have different user names.”⁸⁹ VocalChat does not verify the uniqueness of the user names once they are chosen or changed by a user. By allowing users to manipulate the identifiers of processes within its system, VocalChat therefore does not disclose the “unique identifier of the first process” required by claims 1-3.

Further, as stated above, VocalChat does not disclose dynamic addressing, and instead was explicitly designed to manage static addresses. The network protocol address of a user is “entered during the user installation,” and can only be manually changed by the user through a series of steps.⁹⁰ Because VocalChat requires manual input of any changed network protocol address, it does not disclose “determining the currently assigned network protocol address of the first process upon connection to the computer network,” or “forwarding the assigned network protocol address of the first process...to the server process upon establishing a communication connection with the server process.”

⁸⁹ Ex. 1024, Info at 16, 24.

⁹⁰ Ex. 1025, Help File at 36; *see also* Ex. 1023, User Guide at 28 (“The Address Book contains the names of all the network users who have VocalChat installed. It also contains information about each user...This information is set during installation, and can be changed by each user.”), 30 (“Changing Your Address Book User Information”).

b. Petitioner Has Not Established the Obviousness of Combining RFC 1541 with VocalChat

Petitioner has acknowledged that VocalChat only manages static addresses, arguing instead for the combination of VocalChat with RFC 1541, which discloses dynamic address allocation. Petitioner stated it would have been obvious to combine the dynamic addressing of RFC 1541 with VocalChat, stating that “a person of ordinary skill in the art would have had a reason to implement the software described in the VocalChat References on a network with dynamically assigned addresses, in which case the connection list file stored on a network server would have received network addresses dynamically assigned to the computers on which VocalChat was running.”⁹¹ However, Petitioner does not take into account that VocalChat registers a network protocol address of a user at *installation*, and does not update the address of that user when the user runs the program after initial installation.

The '469 Patent acknowledged that dynamic addressing was known at the time of the patent, but notes that dynamic addressing in point-to-point communications created additional problems that were not addressed by the art.⁹²

⁹¹ Petition at 46-47.

⁹² '469 Patent at 2:39-43 (“The ability to locate users having temporary or dynamically assigned Internet Protocol address has been difficult without the user

Petitioner's expert agrees with Patent Owner on this point, stating that "[d]ynamically assigning network addresses...also introduced a further complication to the 'name resolution' problem: how to accurately map device names to network addresses that are constantly changing. Solving this added complication required developing mechanisms that enabled devices, such as computers, to update a name resolution database as new network addresses were assigned to devices on a computer network."⁹³ Although Petitioner's expert states that "[t]he computer network industry developed these mechanisms prior to February 1995,"⁹⁴ the development history of VocalChat indicates that its developers had problems implementing dynamic addressing into its system. For example, a beta version of VocalChat released in 1994, (VocalChat Gateway to Internet or "VocalChat GTI") was designed for use on the Internet and still only used static local address files. In VocalChat GTI, static callee addresses were manually input into the system. The manual inputting of static addresses suggests that the VocalChat product designers – presumably software developers of at least ordinary skill in the art – did not consider the combination of VocalChat with manually initiating the communication. Accordingly, spontaneous, real-time communications with such users over computer networks have been impractical.").

⁹³ Ex. 1004, Crovella Declaration at 16.

⁹⁴ Ex. 1004, Crovella Declaration at 16.

DHCP, or were unable to overcome the non-trivial obstacles of doing so.

Petitioner attempts to use hindsight to dictate whether a person of ordinary skill in the art would have combined the suggested prior art references. This is improper, for as stated in *KSR Int'l Co. v. Teleflex*, “a factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.”⁹⁵ The fact that VocalChat was not able to overcome the technical obstacles created by dynamic addressing indicates that a person of ordinary skill in the art would not or could not have combined VocalChat with the DHCP teachings of RFC 1541 at the time of the '469 invention. The dynamic addressing limitation of claims 1-3 is therefore not rendered obvious by the VocalChat References, either alone or in view of RFC 1541.

In light of the foregoing, Patent Owner respectfully submits that the challenged claims are patentable over the VocalChat References, alone or in combination with Pinard or RFC 1541, at least for the reasons that (1) the asserted references do not teach a process transmitting a query to the server as to the on-line status of a process, (2) VocalChat does not disclose unique identifiers of its processes, (2) VocalChat maintains only static addresses, and (3) Petitioner has not established how VocalChat could implement dynamic addressing into its system.

⁹⁵ *KSR Int'l Co. v. Teleflex*, 550 U.S. 398, 421 (2007).

C. Little-1994 in Combination with RFC 791, RFC 1541, Little-1993, or Pinard Does Not Teach the Required Point-to-Point Communication with a Second Process

First, as identified above, Petitioner has admitted that if the Board rejects Petitioner's first proposed construction for "query," then the grounds of the Petition that involve Little-1994 should be dismissed.⁹⁶

Second, each challenged claim explicitly requires a connection between a first process and a second process, not merely a first process and a server. Little-1994 fails to disclose the required key element of connection to a second process. As Little-1994 explicitly states, the connection established for movie playout is "set up between the video server and the client machine," and this "session between the client and the server lasts the entire playout duration of the movie."⁹⁷ Because the asserted prior art does not disclose a connection to the required additional process, the references also do not teach receiving a network protocol address of a second process, responding to the network protocol address of the second process, or enabling communication between a first and second process.

⁹⁶ Petition at 22 ("Grounds 6-10, in which Little-1994 (disclosing a movie delivery system similar to Netflix or YouTube) is applied against the challenged claims, thus depend on the Board adopting such a broad construction.").

⁹⁷ Ex. 1017, Little-1994 at 9, 6.

Finally, Little-1994 does not utilize dynamic addressing. Little-1994 therefore cannot render obvious the dynamic addressing requirement of claims 1-3.

1. Petitioner Has Admitted that Little-1994 Should Not Be Considered by the Board

As noted above, Petitioner has offered alternative constructions for the “query” limitation of the challenged claims. Petitioner has stated that its first proposed construction is inconsistent with the ’469 Patent specification, and that Petitioner does not consider it “the broadest reasonable construction consistent with the specification.”⁹⁸ Accordingly, this first proposed construction should not be considered. Petitioner admits that if the Board does not adopt this construction, then all invalidity grounds involving Little-1994 should not be considered.⁹⁹

2. The Asserted References Do Not Teach the Required Connection Between Two Processes

Little-1994 discloses “a metadata mechanism for location, identification, and delivery of continuous media in the form of digital motion pictures and in the context of a distributed system.”¹⁰⁰ The “video-on-demand” (“VOD”) application disclosed by Little-1994 comprises a “session” of a “single, truly interactive

⁹⁸ Petition at 23.

⁹⁹ Petition at 22.

¹⁰⁰ Ex. 1017, Little-1994 at 3.

connection from the system to the user.”¹⁰¹ This one-way multimedia playout of Little-1994 occurs between a first process and a server, without a connection between the first process and a second process. The remaining references, as asserted by the Petitioner and as described below, do not teach the required communication between a first and second process.

a. Little-1994 Does Not Teach a Point-to-Point Communication with a Second Process, Receiving the Network Protocol Address of a Second Process, or Establishing a Communication Responsive to the Network Protocol Address

Little-1994 forms the basis of Petitioner’s challenges to claims 1-3, 9-10, and 17-18. Little-1994, however, only discloses a connection between one process and a server. Because the video connection only exists between the client and the server, the first process also does not receive a network protocol address of a second process, and the server does not establish a communication “responsive” to the network protocol address of a second process. Specifically, Little-1994 describes its connection process as follows:

The connection establishment phase begins when the user decides on the movie to view....When a specific movie is requested for playout, a client process sends a request to the resource server for the establishment of a connection. The connection supports real-time

¹⁰¹ Ex. 1017, Little-1994 at 3.

video delivery and playout. The *session between the client and the server* lasts the entire playout duration of the movie.¹⁰²

Little-1994 again states in its summary that “connections are set up between *the video server and the client machine*,” and that “[t]he connection-setup phase establishes a dedicated *client-server* UDP connection to facilitate continuous media data transfer.”¹⁰³ As a result, there is clearly no point-to-point communication between a first and second process as required by the ’469 Patent claims.

Petitioner has proposed that the “point-to-point communication link” present in each challenged claim should be construed as a “direct connection between two processes over a computer network that is not intermediated by a server.”¹⁰⁴ Patent Owner disputes this claim construction; however, if the Board evaluates Little-1994 under this construction, the challenged claims are clearly patentable over Little-1994. As noted above, Little-1994 repeatedly states that the connection for movie playout is established and maintained between the client and the resource server throughout the duration of the connection. The resource server therefore necessarily intermediates the connection of the first process to the streaming media

¹⁰² Ex. 1017, Little-1994 at 6 (emphasis added).

¹⁰³ Ex. 1017, Little-1994 at 9 (emphasis added).

¹⁰⁴ Petition at 16.

content. There is no point-to-point communication link between two processes, because any connection to the user is intermediated by the resource server.

Little-1994 therefore does not at least teach the following limitations regarding communication with a second process:

- “the computer system capable of executing a first process and connecting to other processes and a server process over a computer network” (claim 1);
- “program code, responsive to user input commands, for establishing a point-to-point communications with another process over the computer network” (claim 1);
- “program code, responsive to the network protocol address of a second process, for establishing a point-to-point communication link between the first process and the second process over the computer network” (claim 2);
- “program code means for receiving a network protocol address of the second process from the server process” (claim 3);
- “a method for establishing a point-to-point communication from a caller process to a callee process over a computer network” (claim 9);
- “the caller process...being operatively connected to the callee process and a server process over the computer network” (claim 9);
- “establishing a point-to-point communication link from the caller process to the first callee process” (claim 9); and
- “receiving a network protocol address of the first callee process over the computer network from the server process” (claim 9).

b. Little-1994 in Combination with RFC 791, RFC 1541, Little-1993, or Pinard Do Not Render Obvious Claims 1-3, 9-10, or 17-18 Because the References Do Not Teach Communication with a Second Process

Petitioner has argued that (1) claims 1-2 and 3 are rendered obvious by Little-1994 in view of RFC 791; (2) claims 1-3 are rendered obvious by Little-1994 in view of RFC 791 and RFC 1541; (3) claims 9-10 and 17-18 are rendered obvious by Little-1994 in view of Little-1993 and RFC 791; and (4) claims 9-10 and 17-18 are rendered obvious by Little-1994 in view of Pinard and RFC 791. As demonstrated above, each of the challenged claims require multiple limitations regarding communication with a second process. The additional references asserted by Petitioner do not teach such a communication. RFC 791 describes the protocol used in transmitting data across the Internet, and does not additionally disclose communication between two processes.¹⁰⁵ RFC 1541, as described above in the context of VocalChat, only discloses DHCP, which allows a server to provide dynamically assigned network addresses to its network clients.¹⁰⁶ Little-1993 only introduces a graphical user interface element that may be combined with the multimedia streaming system of Little-1994.¹⁰⁷ It does not additionally

¹⁰⁵ Petition at 14, 48, 51; *see also* Ex. 1020, RFC 971 at 40.

¹⁰⁶ Petition at 13, 54; *see also* Ex. 1019, RFC 1541 at 2-3.

¹⁰⁷ Petition at 13, 55-56; *see also* Ex. 1018, Little-1993 at 1-2, 21.

disclose connection to a second process. Pinard merely discloses a “drag-and-drop” element on a display screen.¹⁰⁸ Further, Pinard discloses that conventional telephones connected to a telephony server via telephony interface circuits make calls to other conventional telephones. These telephones are not caller and callee processes within the context of a computer networking system. This difference is illustrated by FIG. 1 of Pinard, which identifies, instead of a caller and callee process, two people (“Mary” and “John”). In light of the above, claims 1-3, 9-10, and 17-18 are not rendered obvious by Little-1994 in view of (1) RFC 791, (2) RFC 791 and RFC 1541, (3) Little-1993 and RFC 791, or (4) Pinard and RFC 791.

3. Little-1994 in Combination with RFC 791 and RFC 1541 Does Not Render Obvious Claims 1-3 Because Petitioner Has Not Established the Obviousness of Combining RFC 1541 with Little-1994

In addition to only teaching communication between the first process and the server, Little-1994 does not teach dynamic addresses. As discussed above, the ’469 Patent system was designed explicitly to function with dynamically assigned addresses. The addresses of Little-1994 are static, and Petitioner provided only the conclusory assertion that it would have been obvious to combine the DHCP of RFC 1541 with Little-1994 to teach the ’469 dynamic addressing limitation. Petitioner’s expert stated that “Little-1994’s functionality would have worked in a

¹⁰⁸ Petition at 12, 59-60.

system that dynamically assigned network addresses without any modification to its functionality.”¹⁰⁹ However, dynamic addresses were known at the time of Little-1994, and the Patent clarifies that using dynamic addressing in such a system was a problem to be addressed rather than just a simple modification.¹¹⁰ Further, as explained above, it is improper to use hindsight to assert it would have been obvious to combine suggested prior art, as Petitioner has done here.¹¹¹

Patent Owner therefore respectfully submits that the invalidity challenges based upon Little-1994 should be dismissed at least because (1) Petitioner has admitted that its first proposed construction for query is unsupported, and that the Board should not consider Little-1994 if it does not adopt this unsupported construction; (2) Little-1994 in combination with any asserted reference does not teach communication between a first and second process, and (3) it would not have been obvious to implement dynamically assigned addresses into Little-1994.

CONCLUSION

For the foregoing reasons, Patent Owner respectfully submits that the Petition for *Inter Partes* Review fails to establish a reasonable likelihood that the challenged claims are unpatentable in light of the asserted references.

¹⁰⁹ Ex. 1004, Crovella Declaration at 114.

¹¹⁰ *See, e.g.*, ’469 Patent at 2:30-38.

¹¹¹ *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. at 418-419 (2007).

Respectfully Submitted,

Date: March 21, 2014

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that this PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW was served, by agreement of the parties, by electronic mail on counsel for the Petitioner on March 21, 2014 as follows:

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