

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC., TOSHIBA CORP., VIZIO, INC.,
HULU, LLC, CISCO SYSTEMS, INC., AVAYA, INC.,
VERIZON SERVICES CORP., and
VERIZON BUSINESS NETWORK SERVICES INC.,
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.

Case IPR2015-00196¹ (Patent 6,131,121 C1)
Case IPR2015-00198² (Patent 6,009,469 C1)
Case IPR2015-00209³ (Patent 6,108,704 C1)

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

DESHPANDE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a); 37 C.F.R. § 42.73

¹ IPR2015-01397 and IPR2015-01407 were joined with this proceeding.

² IPR2015-01400 was joined with this proceeding.

³ IPR2015-01398 and IPR2015-01406 were joined with this proceeding.

IPR2015-00196 (Patent 6,131,121 C1)
IPR2015-00198 (Patent 6,009,469 C1)
IPR2015-00209 (Patent 6,108,704 C1)

I. INTRODUCTION

A. Background

LG Electronics, Inc. (“LG”), Toshiba Corp. (“Toshiba”), VIZIO, Inc. (“VIZIO”), and Hulu, LLC (“Hulu”) filed three Petitions requesting *inter partes* review of claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704 C1 (209 Ex. 1001,⁴ “the ’704 patent”), claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of U.S. Patent No. 6,009,469 C1 (198 Ex. 1001, “the ’469 patent”), and claims 3, 4, and 6–14 of U.S. Patent No. 6,131,121 C1 (196 Ex. 1001, “the ’121 patent”). 209 Paper 1 (“209 Pet.”); 198 Paper 1 (“198 Pet.”); 196 Paper 1 (“196 Pet.”). Straight Path IP Group, Inc. (“Patent Owner”) filed a Preliminary Response. 209 Paper 15 (“209 Prelim. Resp.”); 198 Paper 19 (“198 Prelim. Resp.”); 196 Paper 15 (“196 Prelim. Resp.”). On May 15, 2015, pursuant to 35 U.S.C. § 314, we instituted *inter partes* review in each case as follows:

⁴ Citations are preceded by “209” to designate IPR2015-00209, “198” to designate IPR2015-00198, or “196” to designate IPR2015-00196. Unless noted otherwise, all citations are to IPR2015-00209.

IPR2015-00196 (Patent 6,131,121 C1)
 IPR2015-00198 (Patent 6,009,469 C1)
 IPR2015-00209 (Patent 6,108,704 C1)

Case	Claims Instituted	Basis	References
IPR2015-00209	1	§ 103(a)	WINS ⁵ and NetBIOS ⁶
IPR2015-00209	11, 12, 14, 16, 19, 22, 23, 27, 30, and 31	§ 103(a)	WINS, NetBIOS, and Pinard ⁷
IPR2015-00198	1–3, 9, 10, 14, 17, and 18	§ 103(a)	WINS, NetBIOS, and Pinard
IPR2015-00198	5 and 6	§ 103(a)	WINS and NetBIOS
IPR2015-00196	3, 4, 6–14	§ 103(a)	WINS and NetBIOS

209 Paper 20 (“209 Dec.”); 198 Paper 24 (“198 Dec.”); 196 Paper 20 (“196 Dec.”).

After institution of *inter partes* review, Cisco Systems, Inc. (“Cisco”) and AVAYA, Inc. (“AVAYA”) filed three Petitions and Motions to Join the IPR2015-00209, IPR2015-00198, and IPR2014-00196 proceedings. IPR2015-01398, Papers 3, 4; IPR2015-01400, Papers 3, 5; IPR2015-01397, Papers 2, 3. Verizon Services Corp. and Verizon Business Network Services Inc. (collectively, “Verizon”) also filed two Petitions and Motions to Join the IPR2015-00209 and IPR2015-00196 proceedings. IPR2015-01406, Papers 1, 3; IPR2015-01407, Papers 1, 3. We granted these motions and joined Cisco, AVAYA, and Verizon to these *inter partes* reviews.

⁵ Microsoft Windows NT 3.5, TCP/IP User Guide (1994) (Ex. 1003, “WINS”).

⁶ The Open Group, Technical Standard, Protocols For X/Open Pc Interworking: SMB, Version 2.0 (1992) (Ex. 1004, “NetBIOS”).

⁷ U.S. Patent No. 5,533,110, issued July 2, 1996 (Ex. 1020, “Pinard”).

IPR2015-00196 (Patent 6,131,121 C1)
IPR2015-00198 (Patent 6,009,469 C1)
IPR2015-00209 (Patent 6,108,704 C1)

209 Papers 36, 39; 198 Paper 40; 196 Papers 38, 41. We refer to LG, Toshiba, VIZIO, Hulu, Cisco, AVAYA, and Verizon collectively as “Petitioner.”

Patent Owner filed a Response in each case (209 Paper 30, “209 PO Resp.”; 198 Paper 34, “198 PO Resp.”; 196 Paper 32, “196 PO Resp.”), and Petitioner filed a Reply (209 Paper 37, “209 Pet. Reply”; 198 Paper 41, “198 Pet. Reply”; 196 Paper 39, “196 Pet. Reply”). Subsequent to Patent Owner’s Response and Petitioner’s Reply, the United States Court of Appeals for the Federal Circuit issued its decision in *Straight Path IP Grp., Inc. v. Sipnet EU S.R.O.*, 806 F.3d 1356 (Fed. Cir. 2015) (“*Straight Path*”). See Ex. 2042. Petitioner filed additional briefing in light of *Straight Path* (209 Paper 47, “209 Add’l Br.”; 198 Paper 50, “198 Add’l Br.”; 196 Paper 49, “196 Add’l Br.”) and Patent Owner filed a response to Petitioner’s additional briefing (209 Paper 50, “209 PO Add’l Resp.”; 198 Paper 53, “198 PO Add’l Resp.”; 196 Paper 52, “196 PO Add’l Resp.”). Oral hearing was held on February 9, 2016, and the hearing transcript was entered in the record. 209 Paper 53; 198 Paper 56; 196 Paper 55 (“Tr.”).⁸ Petitioner also filed a Motion to Exclude Evidence (209 Paper 45, “209 Mot.”; 198 Paper 48, “198 Mot.”; 196 Paper 47, “196 Mot.”), Patent Owner filed an Opposition to Petitioner’s Motion to Exclude Evidence (209 Paper 49, “209 Opp. Mot.”; 198 Paper 52, “198 Opp. Mot.”; 196 Paper 51, “196 Opp. Mot.”), and Petitioner filed a Reply to Patent Owner’s Opposition

⁸ The hearing transcript is the same for all three cases.

IPR2015-00196 (Patent 6,131,121 C1)
 IPR2015-00198 (Patent 6,009,469 C1)
 IPR2015-00209 (Patent 6,108,704 C1)

to Petitioner’s Motion to Exclude Evidence (209 Paper 52, “209 Reply Mot.”; 198 Paper 55, “198 Reply Mot.”; 196 Paper 54, “196 Reply Mot.”).

The following table summarizes the papers filed by the parties:

Case No.	IPR2015-00209	IPR2015-00198	IPR2015-00196
Petition	Paper 1 (“209 Pet.”)	Paper 1 (“198 Pet.”)	Paper 1 (“196 Pet.”)
Preliminary Response	Paper 15 (“209 PO Resp.”)	Paper 19 (“198 PO Resp.”)	Paper 15 (“196 PO Resp.”)
Decision to Institute	Paper 20 (“209 Dec.”)	Paper 24 (“198 Pet.”)	Paper 20 (“196 Pet.”)
PO Response	Paper 30 (“209 PO Resp.”)	Paper 34 (“198 PO Resp.”)	Paper 32 (“196 PO Resp.”)
Petitioner’s Reply	Paper 37 (“209 Pet. Reply”)	Paper 41 (“198 Pet. Reply”)	Paper 39 (“196 Pet. Reply”)
Petitioner’s Additional Briefing	Paper 47 (“66 Add’l Br.”)	Paper 50 (“198 Add’l Br.”)	Paper 49 (“196 Add’l Br.”)
Patent Owner’s Response to Additional Briefing	Paper 50 (“209 PO Add’l Resp.”)	Paper 53 (“198 PO Add’l Resp.”)	Paper 52 (“196 PO Add’l Resp.”)
Petitioner’s Motion to Exclude	Paper 45 (“209 Mot.”)	Paper 48 (“198 Mot.”)	Paper 47 (“196 Mot.”)
Opposition to Motion to Exclude	Paper 49 (“209 Opp. Mot.”)	Paper 52 (“198 Opp. Mot.”)	Paper 51 (“196 Opp. Mot.”)
Reply to Opposition to Motion to Exclude	Paper 52 (“209 Reply Mot.”)	Paper 55 (“198 Reply Mot.”)	Paper 54 (“196 Reply Mot.”)

The Board has jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Explore Litigation Insights

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

Real-Time Litigation Alerts



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

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

Advanced Docket Research



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

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

Analytics At Your Fingertips



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

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

API

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

LAW FIRMS

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

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

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.