

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.

Case IPR2015-01398
Patent 6,108,704 C1

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

DESHPANDE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Cisco Systems, Inc. and AVAYA Inc. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704 C1 (Ex. 1001, “the ’704 patent”). Paper 4 (“Pet.”). With the Petition, Petitioner filed a Motion for Joinder (Paper 3, “Mot.”), seeking to join this case with *LG Elecs., Inc. v.*

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Straight Path IP Grp., Inc., Case IPR2015-00209. We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” After considering the Petition and associated evidence, we conclude that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing unpatentability of all the challenged claims. Thus, we authorize institution of an *inter partes* review of claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of the ’704 patent.

A. *Related Proceedings*

Petitioner indicates that the ’704 patent is the subject of *Straight Path IP Grp., Inc. v. Cisco Sys., Inc.*, No. 3:14-cv-04312 (N.D. Cal.), and *Straight Path IP Grp., Inc. v. AVAYA, Inc.*, No. 3:14-cv-04309 (N.D. Cal.). Pet. 5. Petitioner also indicates that the ’704 patent is the subject of *Certain Point-to-Point Network Commc’n Devices and Prods. Containing Same*, Inv. No. 337-TA-892 (USITC). *Id.* at 7. Petitioner indicates that the ’704 patent is also the subject of *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, Case IPR2014-01366 (PTAB), *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-00209 (PTAB), and *Cisco Sys., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-01011 (PTAB). *Id.* at 4–5. The ’704 patent was the subject of *Sipnet EU S.R.O. v. Straight Path IP Grp., Inc.*, Case IPR2013-00246 (PTAB) (“*Sipnet*”). *Id.* at 4–5.

Petitioner further indicates that the ’704 patent is related to U.S. Patent No. 6,131,121 (“the ’121 patent”) and U.S. Patent No. 6,009,469 (“the ’469 patent”). *Id.* at 4. The ’121 patent and the ’469 patent are the subject of *Samsung Elecs., Co. v. Straight Path IP Grp., Inc.*, Case IPR2014-

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01367 (PTAB), and *Samsung Elecs., Co. v. Straight Path IP Grp., Inc.*, Case IPR2014-01368 (PTAB), *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-00196 (PTAB), *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-00198 (PTAB), *Cisco Sys., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-01006 (PTAB), and *Cisco Sys., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-01007 (PTAB). *Id.* at 4.

B. Illustrative Claim

Petitioner challenges claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of the '704 patent. Pet. 36–60. Independent claim 1 is illustrative of the claims at issue and follows:

1. A computer program product for use with a computer system, the computer system executing a first process and operatively connectable to a second process and a server over a computer network, the computer program product comprising:
 - a computer usable medium having program code embodied in the medium, the program code comprising:
 - program code for transmitting to the server a network protocol address received by the first process following connection to the computer network;
 - program code for transmitting, to the server, a query as to whether the second process is connected to the computer network;
 - program code for receiving a network protocol address of the second process from the server, when the second process is connected to the computer network; and
 - program code, responsive to the network protocol address of the second process, for establishing a point-to-point communication link between the first process and the second process over the computer network.

C. The Alleged Grounds of Unpatentability

The information presented in the Petition sets forth Petitioner's contentions of unpatentability of claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30,

and 31 of the '704 patent under 35 U.S.C. § 103(a), as follows (*see* Pet. 34–60):

References	Claims Challenged
WINS ¹ and NetBIOS ²	1
WINS, NetBIOS, and Pinard ³	11, 12, 14, 16, 19, 22, 23, 27, 30, and 31

II. ANALYSIS

Petitioner argues that claim 1 is unpatentable under 35 U.S.C. § 103(a) as obvious over WINS and NetBIOS and claims 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS, NetBIOS, and Pinard. Pet. 34–60. Petitioner submits arguments and evidence identical to those submitted in IPR2014-01368. Mot. 2. Petitioner proposes the same claim construction and argues the same rationale of unpatentability of claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 as presented in IPR2015-00196. Pet. 34–60; *LG Elecs., Inc. v Straight Path IP Grp., Inc.*, Case IPR2015-00209, Paper 1, 36–60. Petitioner further relies on the same Declaration by Dr. Bruce M. Maggs in support of the alleged grounds of unpatentability. *Id.*; Ex. 1002. Petitioner filed a proposed order defining the parameters of joinder. *See* Mot. 9–10. Patent Owner did not file a preliminary response.

¹ MICROSOFT WINDOWS NT SERVER VERSION 3.5, TCP/IP USER GUIDE, © 1994 Microsoft Corporation (Ex. 1003, “WINS”).

² TECHNICAL STANDARD PROTOCOLS FOR X/OPEN PC INTERWORKING: SMB, VERSION 2, THE OPEN GROUP, © September 1992, X/Open Company Limited (Ex. 1004, “NetBIOS”).

³ U.S. Patent No. 5,533,110, issued July 2, 1996 (Ex. 1020, “Pinard”).

We determined that the petitioner in IPR2015-00209, LG Electronics, Inc., Toshiba Corp., VIZIO, Inc., and Hulu, LLC (collectively, “LG”), demonstrated a reasonable likelihood of prevailing in establishing the unpatentability of claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of the ’704 patent. *LG Elecs., Inc. v Straight Path IP Grp., Inc.*, Case IPR2015-00209, slip op. at 9–23 (PTAB May 15, 2015) (Paper 20). We granted that petition and instituted an *inter partes* review of claim 1 is unpatentable under 35 U.S.C. § 103(a) as obvious over WINS and NetBIOS and claims 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS, NetBIOS, and Pinard. *Id.* at 23.

Accordingly, we incorporate our previous analysis, including our claim interpretation analysis (*see id.* at 9–14) and our analysis regarding this asserted ground of unpatentability (*see id.* at 14–23), from IPR2015-00209, and we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of the ’704 patent in this Petition for the same reasons discussed in our Decision instituting *inter partes* review in IPR2015-00209.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in establishing unpatentability of claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of the ’704 patent.

We have not made a final determination on the patentability of any challenged claims.

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