UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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CISCO SYSTEMS, INC. and AVAYA INC.,
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.
_____

Case IPR2015-01400
Patent 6,009,469 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 1–3, 5, 6, 9, 10, 14, 17, and 18 of U.S. Patent No. 6,009,469 C1 (Ex. 1001, "the '469 patent"). Paper 5 ("Pet."). With the Petition, Petitioner filed a Motion for Joinder (Paper 3, "Mot."), seeking to join this case with *LG Elecs., Inc. v. Straight*

Path IP Grp., *Inc.*, Case IPR2015-00198. 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 1–3, 5, 6, 9, 10, 14, 17, and 18 of the '469 patent.

A. *Related Proceedings*

Petitioner indicates that the '469 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. 4–5. Petitioner also indicates that the '469 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 6. Petitioner indicates that the '121 patent is also the subject of *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, Case IPR2014-01367 (PTAB), *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-00198 (PTAB), and *Cisco Sys., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-01007 (PTAB). *Id.* at 4.

Petitioner further indicates that the '121 patent is related to U.S. Patent No. 6,108,704 ("the '704 patent") and U.S. Patent No. 6,131,121 ("the '232 patent"). *Id.* at 4. 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. The '704 patent and the '121 patent are the subject of *Samsung Elecs., Co. v. Straight Path IP Grp., Inc.*, Case IPR2014-01366

(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

IPR2015-00209 (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 IPR2015-01011 (PTAB). *Id.* at 4.

B. Illustrative Claim

Petitioner challenges claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of the

'469 patent. Pet. 37–60. Independent claim 1 is illustrative of the claims at

issue and follows:

> 1. A computer program product for use with a computer system having a display, the computer system capable of executing a first process and connecting to other processes and a server process over a computer network, the computer program product comprising a computer usable medium having computer readable code means embodied in the medium comprising:
>
> a. program code for generating a user-interface enabling control of a first process executing on the computer system;
>
> b. program code for determining the currently assigned network protocol address of the first process upon connection to the computer network;
>
> 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 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; and
>
> d. program code, responsive to user input commands, for establishing a point-to-point communications with another 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 1–3, 5, 6, 9, 10, 14, 17, and 18 of the '469 patent under 35 U.S.C. § 103(a), as follows (*see* Pet. 37–60):

References	Claims Challenged
WINS,[1] NetBIOS,[2] and Pinard[3]	1–3, 9, 10, 14, 17, and 18
WINS and NetBIOS	5 and 6

II. ANALYSIS

Petitioner argues that claims 1–3, 9, 10, 14, 17, and 18 are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS, NetBIOS, and Pinard and claims 5 and 6 are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS and NetBIOS. Pet. 37–60. Petitioner submits arguments and evidence identical to those submitted in IPR2015-00198. Mot. 2. Petitioner proposes the same claim construction and argues the same rationale of unpatentability of claims 1–3, 5, 6, 9, 10, 14, 17, and 18 as presented in IPR2015-00198. Pet. 37–604; *LG Elecs., Inc. v Straight Path IP Grp., Inc.*, Case IPR2015-00196, Paper 1, 37–60. 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

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[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").

defining the parameters of joinder. *See* Mot. 9–10. Patent Owner did not file a preliminary response.

We determined that the petitioner in IPR2015-00198, LG Electronics, Inc., Toshiba Corp., VIZIO, Inc., and Hulu, LLC (collectively, "LG"), demonstrated a reasonable likelihood of prevailing in establishing the unpatentability of claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of the '469 patent. *LG Elecs., Inc. v Straight Path IP Grp., Inc.*, Case IPR2015-00198, slip op. at 9–23 (PTAB May 15, 2015) (Paper 24). We granted that petition and instituted an *inter partes* review of claims 1–3, 5, 6, 9, 10, 14, 17, and 18 as unpatentable under 35 U.S.C. § 103(a) as obvious over WINS and NetBIOS. *Id.* at 24.

Accordingly, we incorporate our previous analysis, including our claim interpretation analysis (*see id.* at 9–15) and our analysis regarding this asserted ground of unpatentability (*see id.* at 15–23), from IPR2015-00198, and we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of the '469 patent in this Petition for the same reasons discussed in our Decision instituting *inter partes* review in IPR2015-00198.

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 1–3, 5, 6, 9, 10, 14, 17, and 18 of the '469 patent.

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

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