UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SIPNET EU S.R.O.
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.
Patent Owner.

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Case IPR2013-00246
Patent 6,108,704

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Before KALYAN K. DESHPANDE, THOMAS L. GIANNETTI, and
TRENTON A. WARD, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

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

I.   INTRODUCTION

A. Background

Sipnet EU S.R.O. ("Petitioner") filed a Petition to institute an *inter partes* review of claims 1-7 and 32-42 of U.S. Patent No. 6,108,704 (the "'704 patent"). Paper 1 ("Pet."). Straight Path IP Group ("Patent Owner") (formerly known as Innovative Communications Technologies, Inc.) filed a preliminary response. Paper 8 ("Prelim. Resp."). Pursuant to 35 U.S.C. § 314, we instituted *inter partes* review on October 11, 2013, as to claims 1-7 and 32-42 of the '704 patent on the following grounds of unpatentability: claims 1–7, 32, and 38–42 under 35 U.S.C. § 102 as anticipated by NetBIOS;[1] claims 1–7 and 32–42 under 35 U.S.C. § 102 as anticipated by WINS;[2] and claims 33–37 under 35 U.S.C. § 103 as obvious over NetBIOS and WINS. Paper 11 ("Dec.").

After institution of trial, Patent Owner filed a Response (Paper 30, "PO Resp.") and Petitioner filed a Reply (Paper 33, "Pet. Reply"). Oral hearing was held on July 11, 2014, and the hearing transcript has been entered in the record as Paper 61 ("Tr.").

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. For the reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that claims 1-7 and 32-42 of the '704 patent are unpatentable.

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[1] THE OPEN GROUP, TECHNICAL STANDARD – PROTOCOLS FOR X/OPEN PC INTERWORKING/SMB, VERSION 2 (1992) (Ex. 1003) ("NetBIOS").

[2] WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1004) ("WINS").

B. Related Proceedings

Petitioner identifies the following related district court proceedings involving the '704 patent: *Net2Phone, Inc. v. eBay Inc., Skype Inc.,* Civil Action No. 06-2469 (D.N.J.), filed June 1, 2006 ("the Skype Litigation"), and *Innovative Communications Technologies, Inc. v. Stalker Software, Inc.,* Civil Action No. 2:12-cv-00009-RGD-TEM (E.D. Va.), filed Jan. 4, 2012 ("the Stalker litigation"). Pet. 3.

Petitioner also identifies the '704 patent as the subject of Ex Parte Reexamination proceeding No. 90/010,416. Pet. 3.

C. The '704 Patent

The '704 patent (Ex. 1001) is titled "Point-to-Point Internet Protocol" and generally relates to establishing a point-to-point communication link. Ex. 1001, col. 2, ll. 53–57. The patent explains that a first processing unit automatically transmits its associated e-mail address, and its IP address, to a connection server. *Id.* at col. 5, ll. 25–38. The connection server stores the addresses in a database and, thus, the first processing unit is established as an active on-line party available for communication. *Id.* The first processing unit sends a query to the connection server, which searches the database to determine whether a second processing unit is active and on-line. *Id.* at col. 5, ll. 55–60. If the callee is active and on-line, the connection server sends the IP address of the callee from the database to the first processing unit, i.e., performs a point-to-point Internet protocol communication. *Id.* at col. 5, ll. 60–64. The first processing unit then directly establishes the point-to-point Internet communications with the callee using the retrieved IP address. *Id.* at col. 5, ll. 64–67.

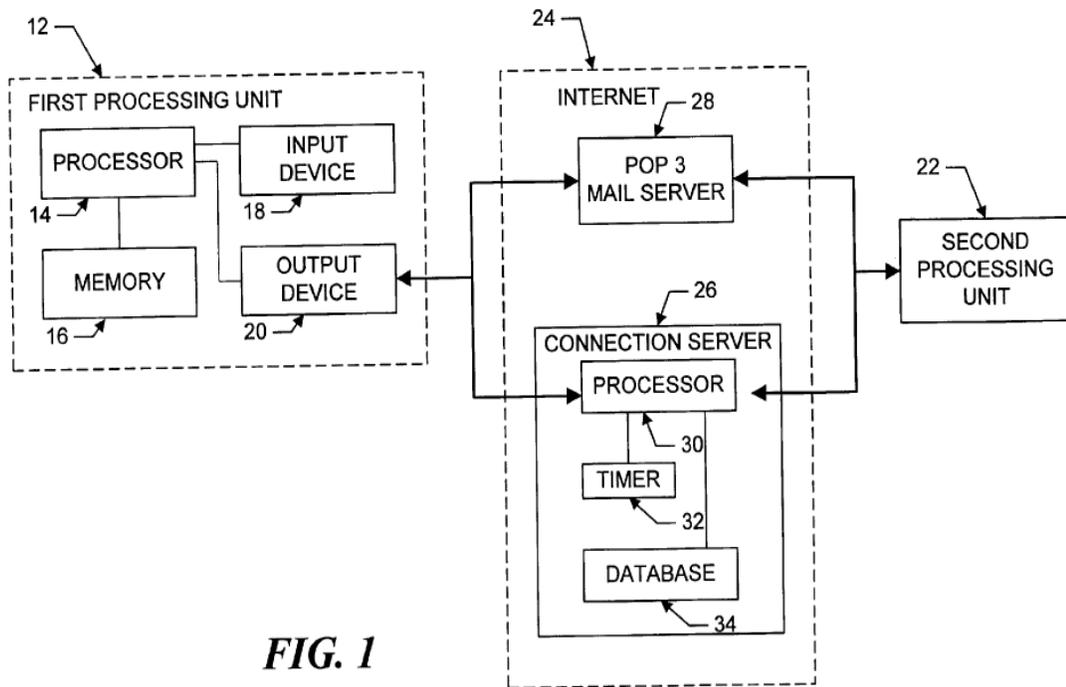Figure 1 of the '704 patent is reproduced below:

FIG. 1

Figure 1 illustrates the architecture between first processing unit 12, second processing unit 22, and connection server 26. *Id.* at col. 5, ll. 15–29.

Claim 1 illustrates the claimed subject matter and is reproduced below:

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;

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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.

D. Claim Construction

The Board will interpret claims of an unexpired patent using the broadest

reasonable construction in light of the specification of the patent in which they

appear. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766

(Aug. 14, 2012); 37 C.F.R. § 42.100(b). Under the broadest reasonable

construction standard, claim terms are given their ordinary and customary

meaning, as would be understood by one of ordinary skill in the art in the context

of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed.

Cir. 2007).

1. "connected to the computer network"

Petitioner, under the broadest reasonable construction, contends that

"connected to the computer network" encompasses merely "being on-line." Pet.

5–6. Petitioner further contends that "connected to the computer network" simply

requires being registered with the server, based on the usage of this phrase in the

'704 patent specification. *Id.* at 13; *see* Ex. 1001 col. 5, ll. 31–38.

Patent Owner agrees that "connected to the computer network" encompasses

"being on-line," but argues that registering an address does not satisfy the

requirement of "being on-line." PO Resp. 26. Patent Owner specifically argues

that, although "a process may be on-line at the time of registration, it may

subsequently go off-line." *Id.* Patent Owner's expert, Dr. Ketan Mayer-Patel,

testifies that, although "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." Ex. 2018 ¶ 22.

We agree with Petitioner that "connected to the computer network" encompasses being "on-line," which can be done by registering an address with the server. The '704 patent specification and claims do not limit the scope of "connected to the computer network." Furthermore, the '704 patent specification discloses "the second processing unit 22, upon connection to the Internet 24 through a connection service provider, is processed by the connection server 26 to be established in the database 34 as an active on-line party." Ex. 1001, col. 5, ll. 35–38. Thus, the context of "connected to the computer network," as disclosed in the specification, includes storing the processing unit address by the connection server database, and storing the address establishes the processing unit as active and on-line.

This is consistent with the determination in our Initial Decision. Dec. 5–6. Patent Owner has not provided any evidence or rationale sufficient for us to disturb that claim construction. Furthermore, Patent Owner and Dr. Ketan Mayer-Patel agree that a second processing unit is "active and on-line at registration." PO Resp. 26; Ex. 2018 ¶ 22. Although Patent Owner argues that a process "being on-line" does not encompass registering an address because the process "may subsequently go off-line" (PO Resp. 26), Patent Owner has not provided any persuasive rationale or evidence to demonstrate that the limitation "connected to the computer network," or any other claim limitation, requires a specified duration of time that a processing unit is "active and on-line." Accordingly, we are not persuaded that the proper scope of the limitation "connected to the computer network" precludes a processing unit that is "active and on-line" but "may

subsequently go off-line." Therefore, under the broadest reasonable construction, "connected to the computer network" encompasses a processing unit that is "active and on-line at registration."

2. *"following connection to the network"*

Claim 1 recites, *inter alia*, program code for transmitting an address "following connection to the computer network." Claims 2, 4, 32, and 38 recite similar limitations. Patent Owner argues that "[i]f a computer system is configured to utilize dynamic address allocation, the system is assigned a unique IP address from the server during network initialization" and "IP addresses received 'following connection to the computer network' are inherently dynamically assigned protocol addresses." PO Resp. 50. Patent Owner argues that the claims require that an address be assigned "following connection to the computer network," and that by definition this is dynamic address allocation. PO Resp. 52 (citing Ex. 2018 ¶¶ 24, 26). Patent Owner's expert, Dr. Ketan Mayer-Patel, states that "[t]o one of ordinary skill in computer networking at the time of the '704 Patent invention, 'a network protocol address received by a process following connection to the computer network' unambiguously defines a dynamically allocated address." Ex. 2018 ¶ 24. Petitioner counters that reading the term "dynamic" into the claims "amounts to an attempt to read a limitation into the claim," because the claims do not include the word "dynamic." Tr. 12:11–20.

We agree with Petitioner that the address received "following connection to the network" encompasses any type of assignment of address. Consistent with our Institution Decision, initially we determined that claims 1–7, 32, and 38–42 do not require the "dynamic" assignment of addresses, whereas claims 33–37 positively recite a method "for locating processes having *dynamically assigned* network protocol addresses." Dec. 10–11, 15 (quoting claim 33 (emphasis added)). Also,

we initially determined that independent claims 1, 2, 4, 32, and 38 do not limit how network addresses are received, stored, or assigned. Independent claim 33, on the other hand, limits how network addresses are received, stored, or assigned because independent claim 33 positively recites that addresses are "dynamically assigned." *Id*. Patent Owner has not provided any argument or evidence in response to our claim construction in our Institution Decision. Patent Owner has not addressed the distinction we identified between independent claim 33 and independent claims 1, 2, 4, 32, and 38.

Our construction of the limitation "following connection to the computer network" is also consistent with the '704 patent. The '704 patent explains that the primary point-to-point protocol operates when a "callee processing unit does not have a fixed or predetermined IP address." Ex. 1001, col. 5, ll. 15–17. The '704 patent further explains an alternative, secondary point-to-point protocol that utilizes an E-mail that includes the current IP address, where the current IP address can be either a temporary or permanent IP address. *Id.* at col. 6, ll. 17-36. The '704 patent explains that:

> Realtime point-to-point communication of audio signals over the Internet 24, as well as video and voicemail, may thus be established and supported without requiring permanent IP addresses to be assigned to either of the users or processing units 12, 22. For the duration of the realtime point-to-point link, the relative permanence of the current IP addresses of the processing units 12,22 is sufficient, whether the current IP addresses were *permanent* (i.e. predetermined or preassigned) or *temporary* (i.e. assigned upon initiation of the point-to-point communication).

Id. at col. 7, ll. 32–41 (emphasis added). Accordingly, the '704 patent contemplates addresses that are predetermined, pre-assigned, fixed, or static, and contrasts these static addresses with temporary or dynamic addresses. Based on

these descriptions of both static and dynamic addressing in the '704 patent, Patent Owner has not persuaded us to limit the scope of "following connection to the computer network" to only "dynamic address allocation."

3. *"point-to-point communication link"*

Petitioner contends that "point-to-point communication link," under the broadest reasonable interpretation, encompasses "communications between two processes over a computer network that are not intermediated by a connection server." Pet. 7. Although Patent Owner argues that Petitioner has not set forth proper claim constructions to be applied, Patent Owner has not provided any persuasive evidence or rationale to dispute Petitioner's construction of "point-to-point communication link." *See* Prelim. Resp. 5–6, 9.

We agree with Petitioner's construction of "point-to-point communication link." The '704 patent specification and claims do not provide for a specific definition of "point-to-point communication link." The plain and ordinary meaning of "point-to-point" means a first point directly linked to a second point.[3] The plain and ordinary meaning of "communication link" includes any software or hardware that allows for communication.[4] Accordingly, we construe "point-to-point communication link" to include direct communications between two processes over a computer network that are not intermediated by a server.

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[3] *See point-to-point*, DICTIONARY OF COMPUTING (2008)(available at http://search.credoreference.com/content/entry/acbcomp/point_to_point/0)("A direct link between two devices.").

[4] *See communication link*, WILEY DICTIONARY OF COMMUNICATIONS TECHNOLOGY (1998)(available at http://search.credoreference.com/content/entry/wileycommtech/communication_link/0)("The software and hardware, to include cables, connectors, converters, etc., required for two devices such as a computer and terminal to communication.").

II.   ANALYSIS

    A. *Real Party-in-Interest*

Patent Owner argues that Petitioner is estopped from initiating this
proceeding because Petitioner failed to identify Stalker Software, Inc. ("Stalker
Software") as a real party-in-interest. PO Resp. 8–16. Patent Owner asserts that
Stalker Software is estopped from initiating an *inter partes* review under 37 C.F.R.
§ 42.101. *Id.* Patent Owner argues that its predecessor in interest, Innovative
Communication Technologies, Inc., served a complaint on Stalker Software
charging infringement of the '704 patent on February 21, 2012, and therefore,
Stalker Software is estopped from seeking *inter partes* review of the '704 patent as
of February 21, 2013. *Id.* at 8–9. The Petition for this proceeding was filed on
April 11, 2013, over one year after Stalker Software was served with a complaint.
Id.

Patent Owner argues that Stalker Software is a real party-in-interest because
Petitioner is a reseller of Stalker Software's CommuniGate Pro software, and
because Stalker Software provided Petitioner with WINS relied upon in the
Petition. PO Resp. 9–11. Patent Owner suggests that *In re Guan*[5] controls and
establishes that a real party-in-interest "cannot do any of the following and not
identify the other entity as real party in interest: . . . 3). Allow another entity to
control or control the content, (e.g. provide prior patents/publications on which the
reexam is to be based)." PO Resp. 10 (quoting *In re Guan* at 8); *see* Office Patent
Trial Practice Guide, 77 Fed. Reg. at 48,759. Patent Owner further submits the
following "circumstantial evidence" to demonstrate Stalker Software exercised

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[5] *In re Guan*, Inter Partes Reexamination Proceeding, Control No. 95/001,045,
Decision Vacating Filing Date (Aug. 25, 2008).

control, or could have exercised control, of this proceeding: (1) Petitioner relies on the testimony of two evidentiary witnesses regarding the WINS reference that allegedly have connections to Stalker Software that were not disclosed by Petitioner, and (2) Petitioner maintains no presence in the United States and has refused Patent Owner's offer of a license of the '704 patent to expand in to the U.S. market. PO Resp. 12–14. Patent Owner further requests that sanctions be imposed on Petitioner for misrepresenting the real party-in-interest. *Id.* at 14–16.

Petitioner argues that *In re Guan* is not controlling on this issue. Pet. Reply 1–2. Petitioner argues that it initiated contact with Stalker Software only to obtain a copy of the WINS reference, and denies that Stalker Software controls Petitioner's participation in this proceeding. *Id*; Tr. 27:2-6, 27:17-22. Petitioner further argues that the vendor-reseller relationship characterized by Patent Owner and the "circumstantial evidence" provided by Patent Owner fail to demonstrate, alone or in combination, any control of this proceeding by Stalker Software. Pet. Reply 2–4.

We are not persuaded by Patent Owner that Stalker Software is a real party-in-interest. Whether a non-party is a "real party-in-interest" or "privy" for purposes of an *inter partes* review proceeding is a "highly fact-dependent question" that takes into account how courts generally have used the terms to "describe relationships and considerations sufficient to justify applying conventional principles of estoppel and preclusion." Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,759. Whether parties are real parties-in-interest or in privity, for instance, depends on whether the relationship between the party and its alleged real party-in-interest or privy is "sufficiently close such that both should be bound by the trial outcome and related estoppels." *Id*. A number of factors may be relevant to the analysis, including whether the non-party "exercised or could

have exercised control over a party's participation in a proceeding," and whether the non-party is responsible for funding and directing the proceeding. *Id*. "The concept of control generally means that 'it should be enough that the nonparty has the actual measure of control or opportunity to control that might reasonably be expected between two formal coparties.'" *Id.* (quoting 18A C. Wright, A. Miller & E. Cooper, Federal Practice & Procedure § 4451 (2d ed. 2011)).

Patent Owner has not demonstrated that Stalker Software exercised or could have exercised control over Petitioner's participation in this proceeding. The evidence of record establishes only that Stalker Software provided the WINS reference, at the request of Petitioner. Pet. Reply 1; Tr. 28:3-9. This alone is insufficient to demonstrate that Stalker Software exercised, or could have exercised, control over Petitioner's participation in this proceeding. Patent Owner's evidence of the existence of a vendor-reseller relationship between Stalker Software does not demonstrate Stalker Software exercised, or could have exercised, any control. When a patent holder sues a dealer, seller, or distributor of an accused product, the mere payment of counsel fees and minor participation by the vendor in the trial are insufficient to establish privity between the vendor and reseller. *Bros, Inc. v. W.E. Grace Mfg. Co.*, 261 F.2d 428, 430 (5th Cir. 1958); *See generally Broadcom Corp. v. Telefonaktiebolaget LM Ericsson,* Case IPR2013-00601, slip op. at 7, 8 (PTAB Jan. 24, 2014) (Paper 23). Patent Owner's assertions regarding witnesses with connections to both Stalker Software and Petitioner, and Petitioner's alleged lack of presence in the U.S. market, are statements of counsel unsupported by any record evidence, and, in any event, are not indicative of any control of this proceeding by Stalker Software. Considering the lack of probative evidence submitted by Patent Owner, we are not persuaded that the record establishes that Stalker Software is a real party-in-interest. Accordingly, we are

not persuaded that Petitioner is barred from initiating this proceeding, or that sanctions should be imposed on Petitioner.

B. Anticipation of claims 1-7, 32, and 38-42 by NetBIOS

Petitioner contends that claims 1–7, 32, and 38–42 are anticipated by NetBIOS. Pet. 27. Patent Owner argues against Petitioner's challenge based on NetBIOS on multiple grounds. PO Resp. 16–54.

1. Overview of NetBIOS (Ex. 1003)

NetBIOS ("Network Basic Input/Output System") is a software interface that allows applications on different computers to communicate within a computer network, such as a local area network or the Internet, and was originally designed for IBM's PC-Network. Ex. 1003, 359.[6] NetBIOS applications employ mechanisms to locate resources, establish connections, send and receive data with an application peer, and terminate connections. *Id*. at 359. A NetBIOS session is the exchange of messages between a pair of NetBIOS applications. *Id*. at 361.

The NetBIOS name service is the collection of procedures through which nodes of a network acquire, defend, and locate the holders of NetBIOS names. *Id*. at 376. A node registers a name with the NetBIOS Name Server, which stores the registered name in a database. *Id*. at 384–85, 394. A name query transaction can be initiated by an end-node in an attempt to obtain the IP address associated with a NetBIOS name. *Id*. at 388–89. If the NetBIOS Name Server has information regarding a queried node, the NetBIOS Name Server transmits a positive response. *Id*. at 389–90. If the NetBIOS Name Server does not have information regarding a queried node, the NetBIOS Name Server transmits a negative response. *Id*. Once

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[6] Ex. 1003 includes page numbers indicated by the publication itself, and different page numbers provided by Petitioner. Our references are to the page numbers printed on the publication itself.

the IP addresses have been found for a target name, a NetBIOS session service begins. *Id*. at 397. The NetBIOS session service involves directed (point-to-point) communications. *Id.*

2. Analysis

a. Claims 1-4, 32, and 38-42

Claim 1 recites, *inter alia*, "a query as to whether the second process is connected to the computer network," and claim 2 similarly recites, *inter alia*, "responsive to a query from the first process, for determining the on-line status of the second process." Independent claims 4, 32, 33, and 38 recite similar limitations. PO Resp. 22–25. Patent Owner argues that NetBIOS fails to disclose "a query or determination as to the on-line status of a process." *Id.* at 31–39. Patent Owner specifically argues that "[n]ames are registered in the NetBIOS system when a computer is first connected to the NetBIOS server, but the name may remain registered even after the computer that registered it is later disconnected from the network," and therefore, a query into the registration status of a name is not the same as a "query or determination as to whether a computer is on-line." PO Resp. 33. Petitioner argues that the Board's claim construction was correct because the '704 patent only describes registering the computer with the network as satisfying online status, and therefore, NetBIOS discloses "a query or a determination as to the on-line status of a process" based on the Board's claim construction. Pet. Reply 4–9.

Patent Owner's argument that "the name may remain registered even after the computer that registered it is later disconnected from the network" is not persuasive because the scope of the claims does not require any specific time "later" that the second process must be "on-line and active." As discussed above our claim construction of "connected to the computer network" encompasses a

second process that is "on-line" by registering an address with the server. As also discussed above, such constructions for "connected to the computer network" and "determining the on-line status of the second process" are consistent with the '704 patent, which specifies that "the second processing unit 22, upon connection to the Internet 24 through a connection service provider, is processed by the connection server 26 to be established in the database 34 as an active on-line party." Ex. 1001, col. 5, ll. 35–38. Furthermore, Patent Owner and Dr. Ketan Mayer-Patel agree that a second processing unit is "active and on-line at registration." PO Resp. 26; Ex. 2018 ¶ 22. In other words, Patent Owner and Dr. Ketan Mayer-Patel agree that NetBIOS discloses, at one point in time, a query or determination for a second processes' address is the same as a query or determination as to whether the second process is "active and on-line." *See* PO Resp. 26; Ex. 2018 ¶ 22. NetBIOS describes that at the time of registration, a query or determination for a second processing unit's address indicates a second processing unit is "active and on-line."

Patent Owner also argues that NetBIOS fails to teach "dynamic address allocation," as required by the claims. PO Resp. 50–54. As discussed above, Patent Owner argues that the claims require that an address be assigned "following connection to the computer network" and, by definition, this is dynamic address allocation. *Id.* at 52 (citing Ex. 2018 ¶¶ 24, 26). Petitioner argues that "dynamic address allocation" is anticipated by NetBIOS, and Patent Owner does not dispute that WINS anticipates dynamic address assignment to computers, as discussed below. Pet. Reply 12. We are not persuaded by Patent Owner's argument. As discussed above in our claim construction of "following connection to the computer network," we do not construe the claims 1–4, 32, and 38–42 as requiring "dynamic address allocation." Accordingly, Patent Owner's argument that

NetBIOS fails to teach "dynamic address allocation" does not persuade us that NetBIOS fails to anticipate claims 1–4, 32, and 38–42.

Patent Owner also argued, during Oral Hearing, that the prior art teaches a "transport layer construct" whereas the '704 patent "is an application layer piece of software." Tr. 40:16–19, 44:12–18. Petitioner responded that the claims do not include such limitations. Tr. 70:7–12. Petitioner also responded that this is not presented in the '704 specification. Tr. 70:13–15.

We are not persuaded by Patent Owner's argument that the claims require application layer software. First, the argument that the prior art describes "transport layer construct" whereas the claims require "application layer software" was first presented during Oral Hearing and was not presented in Patent Owner's Response or Preliminary Response. Tr. 40:16-19. Patent Owner contends that this is not a new argument and has been briefed, addressed, and discussed by both parties. Tr. 55:20–23. We are, however, unable to find a discussion of the argument on the record. Therefore, we determine that this argument is untimely. "A party may rely upon evidence that has been previously submitted in the proceeding and may only present arguments relied upon in the papers previously submitted. No new evidence or arguments may be presented at the oral argument." Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768.

Second, we also agree with Petitioner that the claims do not require any distinction between a "transport layer construct" and "application layer software." Tr. 70:7–12. Patent Owner argues that "[i]t is all over the claims because we talked about the process, first process and second process, not first node and second node." Tr. 56:4–9. Patent Owner, however, fails to provide persuasive argument or evidence to illustrate why the term "process" necessarily incorporates the limitations distinguishing "application layer software" from a "transport layer

construct." We find nothing, on this record, which limits the scope of the claims to "application layer software." Even further, NetBIOS discloses "[a]n application, representing a resource, registers one or more names," and, therefore, NetBIOS anticipates the claims even if the claims were construed to require "application layer software." Ex. 1003, 360. NetBIOS further discloses that applications request names, and a session is a reliable message exchange between a pair of NetBIOS applications. *Id.* at 360–361. Patent Owner agrees that "[i]t is possible in some instances for something in the transport layer to reach up to an application" and "[i]t may be possible from an application to reach all the way down, send something to the transport layer and send it back up." Tr. 59:10-17. Patent Owner, however, fails to provide persuasive evidence or rationale to distinguish the claims from the prior art based on a "transport layer construct" and "application layer software." Accordingly, we are not persuaded by Patent Owner's argument.

We agree with Petitioner that claims 1–4, 32, and 38–42 are anticipated by NetBIOS. *See* Pet. 27, 33–52, 56–58. For example, with respect to claim 1, NetBIOS discloses a software interface that allows applications on different computers to communicate within a computer network. Ex. 1003, 359. A name registration request connects a process to a network by registering the process with the network, and a name query, from a process, discovers the addresses of processes connected to the network. *Id.* at 359, 376–377, 385, 397. NetBIOS further discloses that once an address has been found through a name query, a point-to-point communication session is established between the processes. *Id.* We agree with Petitioner that this disclosure of NetBIOS meets the limitations of claim 1. *See* Pet. 27, 33–40. We similarly agree with Petitioner that NetBIOS discloses the limitations of claims 2–4, 32, and 38–42. *See* Pet. 27, 40–52, 56–58.

For the foregoing reasons and the reasons discussed in our Decision to Institute *inter partes* review of the '704 patent, we conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 1–4, 32, and 38–42 are anticipated by NetBIOS. *See* Dec. 7–11; *See* Pet. 27, 33–38.

b. Claims 5-7

Patent Owner contends that claims 5–7 are not anticipated by NetBIOS because, as argued in support of claims 1–4, 32, and 38–42, NetBIOS fails to disclose determining the on-line status of a process and accordingly cannot meet the limitations recited by claims 5–7. PO Resp. 46–49. However, as discussed above in our analysis of the anticipation of claim 1 by NetBIOS, we are not persuaded by Patent Owner's argument that NetBIOS fails to disclose determining the on-line status of a process and therefore we are not persuaded that NetBIOS fails to anticipate claims 5–7 for this reason.

Furthermore, claim 5 recites, *inter alia*, "retrieving a network protocol address of the second process in response to a positive determination of the on-line status of the second process." Claim 6 similarly recites, *inter alia*, "transmitting the network protocol address of the second process to the first process when the second process is determined in step C to have a positive on-line status with respect to the computer network." We agree with Petitioner that NetBIOS discloses that the NetBIOS Name Server ("NBNS") responds with a list of IP addresses in response to queries from a node, which meets these limitations of claims 5 and 6. Pet. 47–48 (citing Ex. 1003, 389). Claim 7 further recites, *inter alia*, "generating an off-line message" and "transmitting the off-line message." We agree with Petitioner that NetBIOS describes providing a negative response when the name query determines that a name is not registered, which meets these limitations of claim 7. Pet. 48–49 (citing Ex. 1003, 389). For the foregoing

reasons, we conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 5–7 are anticipated by NetBIOS.

C. Anticipation of claims 1-7 and 32-42 by WINS

Petitioner contends that claims 1–7 and 32–42 are anticipated by WINS. Pet. 27. Patent Owner argues against Petitioner's challenge based on WINS on multiple grounds. PO Resp. 16–54.

1. Overview of WINS (Ex. 1004)

WINS discloses how to install, configure, and troubleshoot Microsoft TCP/IP on a computer running the Microsoft Windows NT Workstation or Windows NT Server operation system. Ex. 1004, xi.[7] When a computer's name is registered with the Windows Internet Name Service server, the Windows Internet Name Service server accepts the entry with a timestamp, an incremental unique version number, and other information. *Id.* at 56–58. A name query request is received by the Windows Internet Name Service server and allows a client to establish a session based on the address mapping received from the Windows Internet Name Service server. *Id.* at 56–57. For example, if a first computer wants to communicate with a second computer, the first computer queries the Windows Internet Name Service server for the address of the second computer. *Id.* at 51. When the first computer receives the appropriate address from the Windows Internet Name Service server, it connects directly to the second computer. *Id.*

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[7] Ex. 1004 includes page numbers indicated by the publication itself, and different page numbers provided by Petitioner. Our references are to the page numbers as they are printed on the publication itself.

2. WINS as Prior Art

Patent Owner contends that Petitioner has failed to establish WINS was publicly available to qualify as prior art under 35 U.S.C. § 102(a). PO Resp. 54-60. Patent Owner argues that Petitioner's several supplemental documents fail to establish the public availability of WINS. *Id.* at 55–57. Patent Owner further contends that the declarations of Mr. Yuri Kolesnikov (Ex. 1017) and Ms. Leslie Ehrlich (Ex. 1018) fail to establish that WINS was publicly available and Petitioner's citation to case law does not support that Petitioner's evidence is sufficient to establish WINS as prior art. *Id.* at 57–60.

Petitioner provides the testimony of Mr. Kolesnikov that WINS was publically available and a CD version (Ex. 1019) was received by Mr. Kolesnikov in 1994. Pet. Reply 13–14; Tr. 19:5–19; *See* Ex. 1017. Mr. Kolesnikov testifies that he saw several Microsoft Windows NT 3.5 Server packages that included a print copy of WINS. Ex. 1017 ¶ 7. Petitioner further provides the testimony of Ms. Ehrlich to establish that the differences between WINS and the CD version are differences mostly as to formatting. Pet. Reply 13–14; *See* Ex. 1018. Ms. Ehrlich testifies that WINS and the CD version are substantially similar, noting differences in the glossaries and formatting. Ex. 1018 ¶ 6; Ex 2044 16:17–24.

We are persuaded that Petitioner has established WINS as prior art. We are persuaded that WINS was publically available in 1994. Mr. Kolesnikov testifies to seeing printed copies of WINS and the CD version in 1994. Ex. 1017 ¶ 7. Mr. Kolesnikov further testifies he recalls seeing printed copies of WINS during installations he did for clients in 1994, and is certain that it was 1994 because he had switched jobs in 1995. Ex. 2043, 29:1–10, 32:21–22. Additionally, we are persuaded that the portions of WINS relied upon by Petitioner are different from the CD version due to formatting only. Tr. 23:1 – 25:8. Patent Owner's argument

consists of alleging that Petitioner has failed to establish that WINS was publically available and does not offer any evidence contrary to that presented by Petitioner. Based on the evidence discussed above, we are persuaded that Petitioner has established that WINS is prior art.

3. Analysis

a. Claims 1-4 and 32-42

Claim 1 recites, *inter alia*, "a query as to whether the second process is connected to the computer network," and claim 2 similarly recites, *inter alia*, "responsive to a query from the first process, for determining the on-line status of the second process." Independent claims 4, 32, 33, and 38 recite similar limitations. PO Resp. 22–25. Patent Owner argues that WINS fails to disclose "a query or determination as to the on-line status of a process." *Id.* at 39–46. Patent Owner specifically argues that WINS is an implementation of NetBIOS, and like NetBIOS, "names are registered in WINS when a computer is first connected to the WINS server, but the computer may remain registered even after it is later disconnected from the network." *Id.* at 39.

This argument is substantially the same as that asserted by Patent Owner with respect to the anticipation of the claims by NetBIOS, discussed above. Accordingly, we are not persuaded by this argument for the same reasons discussed above in our claim construction and analysis of anticipation of the claims by NetBIOS.

Patent Owner also argued, during Oral Hearing, that the prior art teaches a "transport layer construct" whereas the '704 patent "is an application layer piece of software." Tr. 40:16–19, 44:12–18. As we discussed above in our analysis of the anticipation of the claims by NetBIOS, we are not persuaded by this argument.

Specifically, we are not persuaded that the '704 patent is distinguished from WINS for the same reasons discussed above with respect to NetBIOS.

We agree with Petitioner that claims 1–4 and 32–42 are anticipated by WINS. Pet. 27–28, 33–58. For example, with respect to claim 1, WINS, an implementation of NetBIOS, discloses a set of networking protocols that govern how data is passed between computers and provides support for application interfaces for communicating between systems. Ex. 1004, 3–4. WINS discloses a name registration request that connects a process to a network with dynamic name registration, and a name queries are responded to with the address of the second process. *Id.* at 3, 51, 57–58. WINS further discloses that once an address has been received in response to a name query, the first process directly communicates with the second process. *Id*. We agree with Petitioner that this disclosure of WINS meets the limitations of claim 1. *See* Pet. 27, 33-40. We similarly agree with Petitioner that WINS discloses the limitations of claims 2–4 and 32–42. *See* Pet. 27, 40–58.

For the foregoing reasons and the reasons discussed in our Decision to Institute *inter partes* review of the '704 patent, we conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 1–4 and 32–42 are anticipated by WINS. *See* Dec. 11-14; *See* Pet. 27-28, 33-38.

b. Claims 5-7

Patent Owner contends that claims 5–7 are not anticipated by WINS because, as argued in support of claims 1–4 and 32–42, WINS fails disclose determining the on-line status of a process and, accordingly, cannot describe the limitations recited by claims 5–7. PO Resp. 46–49. We, however, are not persuaded by Patent Owner's argument that WINS fails to disclose determining the

on-line status of a process, and therefore, we are not persuaded that WINS fails to anticipate claims 5–7 for this reason.

Furthermore, claim 5 recites, *inter alia*, "retrieving a network protocol address of the second process in response to a positive determination of the on-line status of the second process." Claim 6 similarly recites, *inter alia*, "transmitting the network protocol address of the second process to the first process when the second process is determined in step C to have a positive on-line status with respect to the computer network." We agree with Petitioner that WINS discloses that "[w]hen NT_PC1 gets the appropriate address from the WINS server, it goes directly to NT_PC2," which meets these limitations of claims 5 and 6. Pet. 47–48 (citing Ex. 1004, 51). Claim 7 further recites, *inter alia*, "generating an off-line message" and "transmitting the off-line message." We agree with Petitioner that WINS describes that servers respond to name queries and a negative response indicates an off-line message, which meets these limitations of claim 7. Pet. 48–50 (citing Ex. 1004, 57). For the foregoing reasons, we conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 5–7 are anticipated by WINS.

D. Obviousness of claims 33-37 over NetBIOS and WINS

Petitioner contends that claims 33–37 are obvious over NetBIOS and WINS. Pet. 27. Patent Owner argues against Petitioner's challenge based on NetBIOS and WINS on multiple grounds. PO Resp. 49–50.

Patent Owner contends that claims 33–37 are not obvious over NetBIOS and WINS because, as argued in support of claims 1–7 and 32–42, NetBIOS and WINS individually fail to disclose determining the on-line status of a process and, therefore, the combination of NetBIOS and WINS fails to describe this limitation. PO Resp. 49–50. As discussed above, however, we are not persuaded by Patent

Owner's argument that NetBIOS or WINS fail to disclose determining the on-line status of a process.

Patent Owner further contends that the combination of NetBIOS and WINS fails to teach or suggest "maintaining . . . [a] compilation of entries . . . comprising a network protocol address and a corresponding identifier of a process connected to the computer network," as recited by claim 33. PO Resp. 49–50. Patent Owner specifically argues that there is no "assurance" in NetBIOS and WINS that registered computers are connected to the computer network. *Id.* Patent Owner further argues that the entries in NetBIOS and WINS correspond to registered nodes or computers, not processes running on a computer, as required by claim 33. *Id.* We are not persuaded by Patent Owner's arguments. As discussed above, we determined that both NetBIOS and WINS describe nodes or computers that are connected to the computer network. We further determined that the nodes and computers are running processes that are used to create a point-to-point communication link. Ex. 1003, 397; Ex. 1004, 56–57.

We agree with Petitioner that claims 33-37 are obvious over NetBIOS and WINS. Pet. 26–27, 52–56. For example, with respect to claim 33, the combination of WINS and NetBIOS discloses all of the limitations of claim 33, including WINS disclosing "dynamic addressing." Ex. 1003, 359, 376-377, 385, 397; Ex. 1004, 3, 51, 57–58; *See* Pet. 26–27, 52–56. We similarly agree with Petitioner that the combination of NetBIOS and WINS discloses the limitations of claims 34–37. *See* Pet. 26–27, 53–56. Petitioner further argues that

> it is clearly obvious to combine the dynamic addressing of WINS with NetBIOS to produce the invention, and this was in fact done [in Microsoft TCP/IP] . . . Microsoft TCP/IP includes . . . NetBIOS for establishing logical names and sessions on the network . . . [and]

> Windows Internet Name Service (WINS) for dynamically registering
> and querying computer names on an internetwork .

Pet. 21–22 (citing Ex. 1004, 3); *See* Dec. 15–16. We agree with Petitioner's rationale for combining NetBIOS and WINS because WINS describes a Windows implementation of NetBIOS. Pet. 21–22 (citing Ex. 1004, 3). Accordingly, we agree with Petitioner's conclusion of obviousness.

For the foregoing reasons and the reasons discussed in our Decision to Institute *inter partes* review of the '704 patent, we conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 33–37 are obvious over NetBIOS and WINS. *See* Dec. 14-16; *See* Pet. 21-22, 26-27.

III. CONCLUSION

We conclude that Petitioner has demonstrated by a preponderance of the evidence that (1) claims 1–7, 32, and 38–42 are anticipated by NetBIOS, (2) claims 1-7 and 32–42 are anticipated by WINS, and (3) claims 33–37 are obvious over NetBIOS and WINS.

This is a final written decision of the Board under 35 U.S.C. § 318(a). Parties to the proceeding seeking judicial review of this decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IV. ORDER

Accordingly, it is hereby:

ORDERED that claims 1–7 and 32–42 of U.S. Patent No. 6,108,704 are held unpatentable.

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