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Paper 73
Entered: May 23, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIPNET EU S.R.O.,
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.

Case IPR2013-00246
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
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 C1 (the "'704 patent"). Paper 1 ("Pet."). Straight Path IP Group ("Patent Owner") filed a Preliminary Response. Paper 8. 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 was entered in the record as Paper 61 ("Tr."). We rendered a Final Written Decision and held that Petitioner had 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.

Patent Owner filed a Notice of Appeal (*see* Paper 67) and the United States Court of Appeals for the Federal Circuit issued a decision in *Straight*

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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").

Path IP Group, Inc. v. Sipnet EU S.R.O., 806 F.3d 1356 (Fed. Cir. 2015), reversing our cancellation of claims 1–7 and 32–42 and remanding for further proceedings consistent with the Federal Circuit's decision. *Straight Path*, 806 F.3d at 1363–64; *see* Paper 68.

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 not shown by a preponderance of the evidence that claims 1–7 and 32–42 of the '704 patent are unpatentable.

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 Control No. 90/010,416. Pet. 3. The '704 patent is also the subject of *inter partes* review in IPR2014-01366 and IPR2015-00209.

C. The '704 Patent

The '704 patent is titled "Point-to-Point Internet Protocol" and generally relates to establishing a point-to-point communication link. Ex. 1001, 2:53–57. The '704 patent explains that a first processing unit automatically transmits its associated e-mail address, and its IP address, to a connection server. Ex. 1001, 5:25–38. 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. Ex. 1001, 5:55–60. 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. Ex. 1001, 5:60–64. The first processing unit then directly establishes the point-to-point Internet communication with the callee using the retrieved IP address. Ex. 1001, 5:64–67.

Figure 1 of the '704 patent is reproduced below:

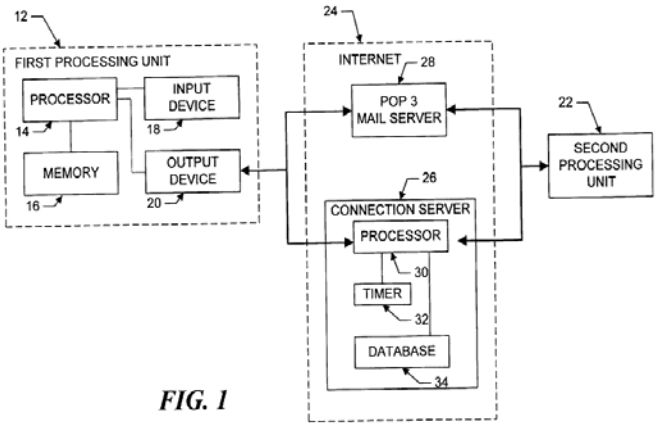

FIG. 1

Figure 1 above illustrates the architecture between first processing unit 12, second processing unit 22, and connection server 26. Ex. 1001, 5:15–29.

D. Illustrative Claim

Petitioner challenges claims 1–7 and 32–42 of the '704 patent. Pet. 5–10, 26–28, 33–58. Claim 1 of the '704 patent is illustrative of the claims at issue 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;
>
> 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.

E. Claim Construction

We construe expired patent claims according to the standard applied by the district courts. *See In re Rambus*, 694 F.3d 42, 46 (Fed. Cir. 2012). Specifically, we apply the principles set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc). "In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence." *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

The words of a claim are generally given their ordinary and customary meaning, and that is the meaning the term would have to a person of

ordinary skill at the time of the invention, in the context of the entire patent including the specification. *See Phillips*, 415 F.3d at 1312–13. Claims are not interpreted in a vacuum but are a part of and read in light of the specification. *See Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987). Although it is improper to read a limitation from the specification into the claims, *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993), the claims still must be read in view of the specification of which they are a part. *See Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1347 (Fed. Cir. 2004).

Only those terms which are in controversy need to be construed and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). We construe the following claim terms.

1. *"is connected to the computer network" / "on-line status" / "currently connected to the Internet"/ "connected to the computer network"*

Independent claim 1 of the '704 patent recites, "transmitting, to the server, a query as to whether the second process *is connected to the computer network*" (emphasis added). Independent claims 2 and 4 recite "determining the *on-line status* of the second process" (emphasis added). Dependent claims 3 and 5–7 incorporate the "on-line status" limitation from independent claims 2 and 4. Independent claims 32 and 33 recite maintaining a list of entries of processes "*currently connected to the Internet*" and "*connected to the computer network*" respectively (emphases added). Dependent claims 34–37 incorporate the "connected to the computer network" limitation from independent claim 33.

In *Straight Path*, the Federal Circuit held that the claim language "is connected to the computer network" has a facially clear meaning, that "the query transmitted to the server seeks to determine whether the second unit is connected at that time, *i.e.*, connected at the time that the query is sent." *Straight Path*, 806 F.3d at 1360. The Federal Circuit held that the query asks "whether the device 'is' connected, not whether it was connected or whether it is still registered as being connected even if that registration information is no longer accurate." *Id.* The Federal Circuit further explained that "[i]t is not a reasonable interpretation of the claim language . . . to say that it is satisfied by a query that asks only for registration information, regardless of its current accuracy." *Id.* The Federal Circuit explained, "[w]hen claim language has as plain a meaning on an issue as the language does here, leaving no genuine uncertainties on interpretive questions relevant to the case, it is particularly difficult to conclude that the specification reasonably supports a different meaning. The specification plays a more limited role than in the common situation where claim terms are uncertain in meaning in relevant respects." *Id.* at 1361. Accordingly, the Federal Circuit construed the limitation "is connected to the computer network" as "is connected to the computer network at the time that the query is transmitted to the server." *Id.* at 1363.

Petitioner and Patent Owner argue that the limitations "on-line status," "currently connected to the Internet," and "connected to the computer network" have the same meaning as "is connected to the computer network." *See* Pet. 5–6; PO Resp. 25–33. Similar to "is connected to a computer network," the "on-line status," "currently connected to the Internet," and "connected to the computer network" status of the second process are recited

in the present tense, and, therefore, accordingly must be determined at the time of the query whether the second process "currently connected to the Internet" or "connected to the computer network," or selecting the process having an "on-line status." Therefore, we construe "on-line status," "currently connected to the Internet," and "connected to the computer network" as having the same meaning as "is connected to the computer network."

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 the WINS

reference relied upon in the Petition. PO Resp. 9–11. Patent Owner suggests that *In re Guan*[3] 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 direct or control the content, (e.g. provide the 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. 48,756, 48,759 (Aug. 14, 2012). Patent Owner further submits the following "circumstantial evidence" to demonstrate Stalker Software exercised 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 to the '704 patent to expand into 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

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

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 disagree 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. Claims 1–7 and 32–42

Petitioner challenges claims 1–7 and 32–42 of the '704 patent. Pet. 5–10, 26–28, 33–58. We have reviewed the Petition and supporting evidence and find that Petitioner has not shown by a preponderance of the evidence that the challenged claims are unpatentable.

1. 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, 377.[4] NetBIOS applications employ mechanisms to locate resources, establish connections, send and receive data with an application peer, and terminate connections. *Id.* A NetBIOS session is the exchange of messages between a pair of NetBIOS applications. *Id.* at 379.

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 394. A node registers a name with the NetBIOS Name Server, which stores the registered name in a database. *Id.* at 402–03, 412. 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 406–07. If the NetBIOS Name Server has information regarding a queried node, the NetBIOS Name Server transmits a positive response. *Id.* at 407–08. If the NetBIOS Name Server does not have information regarding a queried node, the NetBIOS Name Server transmits a negative response. *Id.* Once the IP addresses have been found for a target name, a NetBIOS session service begins. *Id.* at 415. The NetBIOS session service involves directed (point-to-point) communications. *Id.*

2. WINS (Ex. 1004)

WINS discloses how to install, configure, and troubleshoot Microsoft TCP/IP on a computer running the Microsoft Windows NT

[4] Exhibit 1003 includes page numbers indicated by the publication itself, and different page numbers provided by Petitioner. Our references are to the page numbers provided by Petitioner.

Workstation or Windows NT Server operating system. Ex. 1004, 12.[5] 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 74. 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 73. 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 67. When the first computer receives the appropriate address from the Windows Internet Name Service server, it connects directly to the second computer. *Id.*

3. 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

[5] Exhibit 1004 includes page numbers indicated by the publication itself, and different page numbers provided by Petitioner. Our references are to the page numbers provided by Petitioner.

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 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 was publicly available in 1994, and, therefore, qualifies as prior art under 35 U.S.C. § 102(a).

4. Analysis

As discussed in our claim construction analysis above, claims 1–7 and 32–42 recite the limitations "is connected to the computer network," "on-line status," "currently connected to the Internet," and "connected to the computer network." *See* Section I.E.1. As also discussed above, we construe these limitations as "is connected to the computer network at the time that the query is transmitted to the server."

Petitioner argues that WINS discloses the use of NetBIOS for establishing logical names and sessions on a network, and a Windows Internet Name Service (WINS) server registers names on a network. Pet. 37, 42, 44–45, 51 (citing Ex. 1004, 67, 73, 115). Petitioner further argues that NetBIOS discloses name query functionality that allows nodes to determine the address of a queried node based on whether the node has been requested with the NetBIOS Name Server (NBNS). *Id.* at 36–37, 42, 44, 50 (citing Ex. 1003, 395, 406, 408).

Patent Owner argues that these descriptions from WINS and NetBIOS fail to determine whether a computer or process *is connected to the computer network*. PO Resp. 31–46. In view of our construction of this claim limitation, we agree with Patent Owner. WINS discloses that once a computer is registered with the WINS server (which is a NetBIOS Name Server (NBNS)) as active and on-line, the WINS server maintains a database of names and addresses as active and on-line by (1) releasing names once a computer is shut down properly and (2) requiring a renewal time period in which a computer must reregister. Ex. 1004, 62–63, 75, 84, 130. WINS discloses that in response to User Datagram Protocol (UDP) name queries, "a mapping in the database does not ensure that the related device is

currently running." *Id.* at 73. WINS further explains that a "local WINS database should periodically be cleared of released entries and old entries that were registered at another WINS server but did not get removed from this WINS database for some reason." *Id.* at 148. In other words, WINS discloses that the WINS database may include entries of computers that are not currently connected to the WINS network. *See id*. at 73, 148. Accordingly, a query as to whether a second process "is connected to the computer network" in WINS will not determine whether the second process *is connected* to the WINS network *at the time that the query is transmitted to the server*.

As discussed above in our claim construction analysis (*see* Section I.E.1), a query as to whether a process "is connected to a computer network" or has an "on-line" status asks "whether the device 'is' connected, not whether it was connected or whether it is still registered as being connected even if that registration information is no longer accurate. It is not a reasonable interpretation of the claim language . . . to say that it is satisfied by a query that asks only for registration information, regardless of its current accuracy." *Straight Path*, 806 F.3d at 1360. WINS discloses that the WINS server has information that a process "was" connected to the computer network, and that information may no longer be accurate. *See* Ex. 1004, 84, 166. As such, we determine that WINS does not disclose the claimed "is connected to the computer network," "on-line status," "currently connected to the Internet," and "connected to the computer network," as construed herein.

Similarly, NetBIOS discloses a registration process for resources or nodes to receive a unique name by registering a name. Ex. 1003, 378.

During a name query (discovery), a datagram is sent requesting the name and address of another resource. *Id.* at 395. The NBNS maintains a database of resource names through explicit name deletion, where the node specifies a deletion function and implicit name deletion, which occurs when a node ceases operation. *Id.* at 378. NetBIOS explains that implicit name deletion "is a frequent occurrence." *Id.* Implicit name deletion is managed by assigning nodes a specified lifetime for registered names, where a name is silently released if a node fails to refresh the registered name before the lifetime expires. *Id.* at 396. NetBIOS further discloses a mechanism where the NBNS may correct the information stored after an incorrect response is provided to a requesting node. *See id.* at 409. However, similar to WINS, NetBIOS discloses that the information stored by the NBNS may be incorrect, and, therefore, will not determine whether a second process is connected to the computer network at the time that the query is transmitted to the server. Therefore, NetBIOS also does not disclose the claimed "is connected to the computer network," "on-line status," "currently connected to the Internet" and "connected to the computer network."

Given that the combination of WINS and NetBIOS fails to teach or suggest the claims as construed, we need not reach the remaining arguments presented by Petitioner and Patent Owner.

III. CONCLUSION

We are not persuaded that Petitioner has demonstrated by a preponderance of the evidence that claims 1–7 and 32–42 are unpatentable.

IV. ORDER

Accordingly, it is hereby:

ORDERED that, based on the grounds under review, claims 1–7 and 32–42 of U.S. Patent No. 6,108,704 C1 have not been shown by a preponderance of the evidence by Petitioner to be unpatentable; and

FURTHER ORDERED that this is a Final Written Decision of the Board under 35 U.S.C. § 318(a), and 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.

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