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Paper 11
Entered: October 11, 2013

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

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

DESHPANDE, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. Background

Petitioner, Sipnet EU S.R.O. ("Sipnet"), filed a petition to institute an *inter partes* review of claims 1-7 and 32-42 of U.S. Patent 6,108,704 (the "'704 patent"). Paper 1 ("Pet."). Patent Owner, Straight Path IP Group ("Straight Path") (formerly known as Innovative Communications Technologies, Inc.), timely filed a preliminary response. Paper 8 ("Prelim. Resp."). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a) which provides as follows:

> THRESHOLD -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Petitioner contends that the challenged claims are unpatentable under 35 U.S.C. §§ 102 and/or 103 on the following specific grounds (Pet. 17-58):

Reference(s)	Basis	Claims challenged
Messenger – Ryan[1] and Messenger – NT Unleashed[2]	§ 102, § 103	1-7 and 32-42
NetBIOS[3] or WINS[4] in view of Messenger – Ryan and Messenger – NT Unleashed	§ 103	1-7 and 32-42

[1] Ralph Ryan, LAN MANAGER 2.0 (Megan E. Sheppard et al. eds. 1990) (Ex. 1011) ("Messenger – Ryan").
[2] Robert Cowart et al., WINDOWS NT UNLEASHED (Cindy Morrow et al eds., 1994) (Ex. 1012) ("Messenger – NT Unleashed").
[3] THE OPEN GROUP, TECHNICAL STANDARD – PROTOCOLS FOR X/OPEN PC INTERNETWORKING/SMB, VERSION 2 (1992) (Ex. 1003) ("NetBIOS").
[4] WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1004) ("WINS").

Reference(s)	Basis	Claims challenged
NetBIOS in view of WINS	§ 103	1-7 and 32-42
NetBIOS	§ 102	1-7 and 32-42
WINS	§ 102	1-7 and 32-42
DNS 1[5], DNS 2[6], and DNS Orig.[7]	§ 102, § 103	1-7 and 32-42
DEC '652[8]	§ 102	1, 2, and 4-6
DNS 1, DNS 2, and DNS Orig. in view of VocalTec[9], Taligent '278[10], or '704[11]	§ 103	1-7 and 32-42

For the reasons given below, we grant the petition and institute an *inter partes* review of claims 1-7 and 32-42.

B. 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 dynamically allocated IP address, to

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[5] Susan Thomson et al., DNS Dynamic Updates, IETF DNSIND WORKING GROUP, July 14, 1994 (Ex. 1006) ("DNS1").
[6] Susan Thomson et al., DNS Dynamic Updates, FOILS, July 1994 (Ex. 1007) ("DNS2").
[7] P. Mockapetris, RFC1034, Domain Names – Concepts and Facilities (Ex. 1013) ("DNS Orig.").
[8] U.S. 5,483,652 (Ex. 1010) ("DEC '652").
[9] VocalTec ware lets users make voice calls over 'Net, NETWORK WORLD, Feb. 13, 1995 (Ex. 1014) ("VocalTec").
[10] U.S. 5,566,278 (Ex. 1015) ("Taligent '278")
[11] U.S. 6,108,704 (Ex. 1001) ("'704").

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:

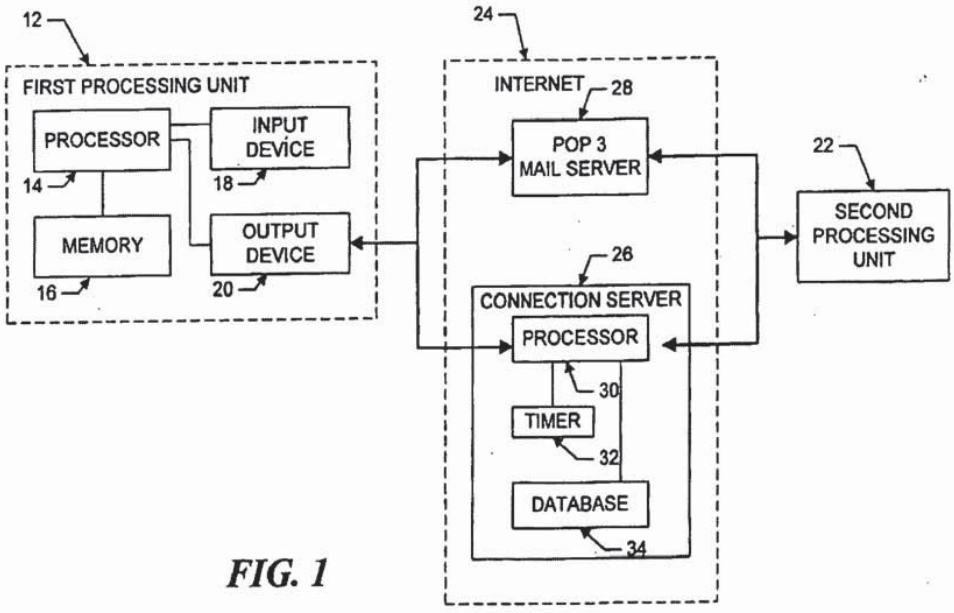

FIG. 1

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;
>
> 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. Claim Construction

Consistent with the statute and the legislative history of the AIA, the Board will interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012); 37 CFR § 42.100(b).

1. "connected to the computer network"

Petitioner, under the broadest reasonable construction, contends that "connected to a computer network" encompasses merely being "on-line." Pet. 5-6. Petitioner further contends that "connected to a 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 also* Ex. 1001 col. 5, ll. 31-38. Although Patent Owner argues generally that Petitioner has not set forth proper claim constructions, Patent Owner has not set forth any evidence or rationale to dispute Petitioner's construction of "connected to the computer network." *See* Prelim. Resp. 5-6, 9.

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 a 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. This disclosure provides that the context of "connected to a computer network" includes storing the processing unit address by the connection server database establishes the processing unit as active and on-line. Therefore, we agree with the Petitioner's construction of "connected to the computer network" because it is both reasonable and consistent with the '704 patent specification.

2. "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 evidence or rationale to dispute Petitioner's construction of "point-to-point communication link." *See* Prelim. Resp. 5-6, 9.

We agree with the 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 connected to a second point. The plain and ordinary meaning of "communication link" includes any structure or process that allow for communication. Accordingly, for the purposes of this decision, we construe "point-to-point communications link" to include direct communications between two processes over a computer network that are not intermediated by a server.

II. ANALYSIS

A. Anticipation of claims 1-7 and 32-42 by NetBIOS

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. While NetBIOS is concerned with X/Open LAN Manager ("LMX") architecture and Server Message Block ("SMB") protocol, NetBIOS also discloses NetBIOS services. Ex. 1003, 3, 359.[12] NetBIOS applications employ NetBIOS 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 acquire, defend, and locate the holders of NetBIOS names. *Id.* at 376. A

[12] Ex. 1003 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 and not the page numbers provided by Petitioner.

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 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

Petitioner contends that claims 1-7 and 32-42 are anticipated by NetBIOS. Pet. 27. We begin our analysis with independent claim 1.

a. Claim 1

Claim 1, in part, recites:

> program code for transmitting to the server a network protocol address received by the first process following connection to the computer network.

Petitioner argues that NetBIOS discloses a name registration request that is submitted by an end-node to a NetBIOS Name Server, and the server replies with a positive response. *Id.* at 35 (citing Ex. 1003, 385). Claim 1, in part, further recites:

> 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.

Petitioner argues that NetBIOS discloses a name query (discovery) that is initiated by end-nodes to obtain the IP addresses and other attributes associated with a NetBIOS name. *Id.* at 36-37 (citing Ex. 1003, 40, 377, 388, 390). Claim 1, in part, further recites:

> 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.

Petitioner argues that NetBIOS discloses a NetBIOS session service that involves directed (point-to-point) communications between end-nodes. *Id.* at 38 (citing Ex. 1003, 397).

Patent Owner has not provided any persuasive rationale or evidence to rebut Petitioner's presentation as to the application of NetBIOS to each claim limitation. Patent Owner broadly responds that Petitioner's arguments fail to establish a likelihood of prevailing on this ground because (1) Petitioner relies on conclusory assertions and unsubstantiated attorney arguments and fails to demonstrate that the NetBIOS reference discloses every limitation exactly as arranged or combined in the challenged claims, and (2) the NetBIOS reference and related arguments were previously the subject of *ex parte* reexamination proceedings and were not found to be persuasive by the Examiner. Prelim. Resp. 29.

We are not persuaded by Patent Owner's arguments. First, as discussed above, Petitioner has provided sufficient evidence and has pointed particularly to where in NetBIOS each claim element is disclosed. Second, we are not required by statute to reject a petition based upon the fact that certain arguments or art were previously considered by the Office, and we decline to do so in this case. Specifically, in the reexamination proceedings, the limitation "connection to the

computer network" was given the narrow construction to require a dynamic element. Pet. 3 (citing Ex. 2004, 7). In addition, the "active" limitation in NetBIOS was not found to be the same as "on-line." *Id.* However, our construction of "connected to the computer network" does not require a dynamic element and merely registering the processing unit with a connection server encompasses a processing unit being active and on-line. Thus, we are not persuaded by the reexamination proceedings.

With respect to the remaining limitations of claim 1, we have reviewed Petitioner's supporting evidence and determine that Petitioner has met its burden under 35 U.S.C. § 314(a). On this record, we are persuaded by Petitioner's assertion that there is a reasonable likelihood that it will prevail in showing that claim 1 is anticipated by NetBIOS.

b. Claims 2-7 and 32-42

Independent claims 2, 4, 10, 32, and 38 recite similar limitations as claim 1 and, therefore, we are persuaded that there is a reasonable likelihood that Petitioner will prevail in showing that claims 2, 4, 10, 32, and 38 are anticipated by NetBIOS. With respect to the remaining dependent claims 3, 5-6, and 40-42, we have reviewed Petitioner's supporting evidence and determine that Petitioner has met its burden under 35 U.S.C § 314(a).

For example, claim 3 depends from claim 2 and recites "a timer, operatively coupled to the processor, for time stamping the network protocol addresses stored in the memory." Petitioner argues that NetBIOS discloses that the NetBIOS Name Server may impose a "time-to-live" on each name that is registered. Pet. 43 (citing Ex. 1003, 382). Patent Owner has not argued claim 3 separately, and, therefore, does not challenge this assertion. Accordingly, we are persuaded that there is a

reasonable likelihood that Petitioner will prevail in showing that claim 3 is anticipated by NetBIOS.

Independent claim 33 recites the limitation "[a] method for locating processes having dynamically assigned network protocol addresses over a computer network." Petitioner directs our attention to the claim chart presented for claim 32 to identify where in NetBIOS this limitation is disclosed. *Id.* at 52. However, claim 32 does not recite a similar limitation regarding dynamic assignment of addresses, and, therefore, Petitioner's challenge to claim 33 is unsupported by this citation. We are, therefore, not persuaded that there is a reasonable likelihood that Petitioner will prevail in showing that claim 33 is anticipated by NetBIOS. Dependent claims 34-37 incorporate this limitation from independent claim 33 by reference, and we are, for the same reason, not persuaded that there is a reasonable likelihood that Petitioner will prevail in showing that those claims are anticipated by NetBIOS.

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

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.[13] WINS further describes NetBIOS over TCP/IP, a session-layer network service that performs name-to-IP address mapping for name resolution. *Id.* at 50. P-node is a NetBIOS over TCP/IP

[13] 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 and not the page numbers provided by the Petitioner.

mode that uses point-to-point communications with a name server to resolve names. *Id.*

A computer's name is registered with the Windows Internet Name Service (WINS) server, and the WINS 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 WINS server and allows a client to establish a session based on the address mapping received from the WINS server. *Id.* at 56-57. For example, in a P-node environment, if a first computer wants to communicate with a second computer, the first computer queries the WINS server for the address of the second computer. *Id.* at 51. When the first computer receives the appropriate address from the WINS server, it connects directly to the second computer. *Id.*

2. Analysis

a. Claim 1

Claim 1, in part, recites:

> program code for transmitting to the server a network protocol address received by the first process following connection to the computer network.

Petitioner argues that WINS discloses a name registration request that is sent directly to the WINS server to be added to the database. Pet. 35 (citing Ex. 1004, 58). Claim 1, in part, further recites:

> 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.

Petitioner argues that WINS discloses a Windows Internet Name Service (WINS) for dynamically registering and querying computer names on a network and Dynamic Host Configuration Protocol (DHCP) service for automatically configuring TCP/IP on Windows NT computers. Pet. 37-39 (citing Ex. 1004, 3, 51, 57). Petitioner further argues that WINS discloses that a first computer queries the WINS server for the address of the second computer and establishes a direct (point-to-point) connection with the second computer. *Id.*

Patent Owner has not provided any persuasive rationale or evidence to rebut Petitioner's presentation as to the application of WINS to each claim limitation of claim 1. Patent Owner generally responds that Petitioner's arguments fail to establish a likelihood of prevailing on this ground because Petitioner relies on conclusory assertions and unsubstantiated attorney arguments and fails to demonstrate that the WINS reference discloses every limitation exactly as arranged or combined in the challenged claims. Prelim. Resp. 30.

We are not persuaded by Patent Owner's argument. Petitioner has provided claim charts that identify where in WINS each element of each claim is found and, thus, has provided sufficient evidence particularly as to where in WINS each element is disclosed. Pet. 33-58. Based on the evidence presented, we are persuaded that Petitioner has established a reasonable likelihood of prevailing on this ground.

With respect to the remaining limitations of claim 1, we have reviewed Petitioner's supporting evidence and determine that Petitioner has met its burden under 35 U.S.C § 314(a). On this record, we are persuaded that there is a

reasonable likelihood that Petitioner will prevail in showing that claim 1 is anticipated by WINS.

b. Claims 2-7 and 32-42

With respect to the remaining dependent claims 2-7 and 32-42, we have reviewed Petitioner's supporting evidence and determine that Petitioner has met its burden under 35 U.S.C § 314(a).

For example, claim 3 depends from claim 2 and recites "a timer, operatively coupled to the processor, for time stamping the network protocol addresses stored in the memory." Petitioner argues that WINS discloses that each address registration record includes a timestamp, where the timestamp shows when the record was registered or updated. Pet. 43 (citing Ex. 1004, 135). Patent Owner has not argued claim 3 separately and, therefore, does not challenge this assertion. Accordingly, we are persuaded that there is a reasonable likelihood that Petitioner will prevail in showing that claim 3 is anticipated by NetBIOS.

C. Obviousness of claims 1-7 and 32-42 over NetBIOS and WINS

As discussed above, we are persuaded that the Petitioner is reasonably likely to prevail on the challenge that claims 1-7, 32, and 38-42 are anticipated by NetBIOS. Accordingly, we determine that Petitioner's proposed ground of obviousness over NetBIOS and WINS for these same claims is redundant to the ground of unpatentability on which we initiate an *inter parties* review, namely, anticipation by NetBIOS. *See Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00003 (Paper No. 7), at *2 (PTAB Oct. 25, 2012) (not proceeding on redundant grounds in absence of meaningful distinction).

However, as stated above, we are not persuaded Petitioner is reasonably likely to prevail on the challenge that claims 33-37 are anticipated by NetBIOS,

because Petitioner did not provide sufficient evidence that NetBIOS discloses that the processes of having "dynamically assigned network protocol addresses."

With respect to Petitioner's challenge to claims 33-37 as obvious over NetBIOS and WINS, Petitioner argues that WINS discloses the dynamic assignment of protocol addresses missing from NetBIOS. Pet. 36-37 (citing Ex. 1004, 3, 51, 57). Specifically, Petitioner argues that WINS discloses that Microsoft TCP/IP includes NetBIOS for establishing logical names, a Windows Internet Name Service (WINS) for dynamically registering and querying computer names on a network, and Dynamic Host Configuration Protocol (DHCP) service for automatically configuring TCP/IP on Windows NT computers. *Id.* 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." Pet. 21.

Patent Owner has not provided any persuasive rationale or evidence to rebut Petitioner's presentation as to the application of a combination of NetBIOS and WINS to each claim limitation. Furthermore, Patent Owner has not provided any evidence or rationale to rebut Petitioner's reasoning supporting the conclusion of obviousness. Patent Owner generally responds that Petitioner's arguments fail to establish a likelihood of prevailing on this ground because Petitioner relies on conclusory assertions and unsubstantiated attorney arguments and fails to demonstrate that the NetBIOS and WINS references render obvious the challenged claims. Prelim. Resp. 27-29.

We are not persuaded by Patent Owner's argument. As discussed above, Petitioner has provided sufficient evidence and particularly has pointed to where in NetBIOS and WINS each element is disclosed. Pet. 36-39. Furthermore, Petitioner 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 (citing Ex. 1004, 3). Petitioner has provided an articulated reasoning with a rational underpinning to support the conclusion of obviousness. *Id.* We are persuaded by Petitioner that the conclusion is reasonable because WINS demonstrates that Microsoft TCP/IP has combined the elements of NetBIOS and WINS in the same manner that Petitioner proposes to combine NetBIOS and WINS. Ex. 1004, 3. Because Microsoft TCP/IP includes this combination, we are persuaded by Petitioner's argument that it would have been obvious to a person with ordinary skill in the art to have combined these elements in the same way.

With respect to the remaining limitations of claims 33-37, we have reviewed Petitioner's supporting evidence and determine that Petitioner has met its burden under 35 U.S.C § 314(a). On this record, we are persuaded by Petitioner's assertion that there is a reasonable likelihood that it will prevail in showing that claims 33-37 are obvious over NetBIOS and WINS.

D. Anticipation of claims 1, 2, and 4-6 by DEC '652

1. Overview of DEC '652 (Ex. 1010)

DEC '652 discloses a method and apparatus facilitating the processing of a request from a client application for a service, or for access to a resource, in a distributed computing environment. Ex. 1010, Abstr. DEC '652 describes in a client-server connection, the server application exports binding information to a shared repository. *Id.* at col. 7, ll. 45-52. Binding information contains the location of servers. *Id.* at col 6, ll. 18-19. A client application imports the

exported binding information and establishes a logical connection with the server application based on the binding information. *Id.* at col. 7, ll. 52-56.

2. Analysis

Petitioner contends that claims 1, 2, and 4-6 are anticipated by DEC '652. Pet. 28-29. We begin our analysis with independent claim 1.

a. Claim 1

Claim 1 recites, in part, a "first process," a "second process," and "a point-to-point communication link between the first process and the second process." Petitioner argues that "a network entity accepting communication requests" corresponds to the first process and a "network entity initiating communications" corresponds to the second process. Pet. 28. Petitioner further argues that DEC '652 discloses the "client application 18 establishes a logical connection with the server application 10." Pet. 39 (citing Ex. 1010, col. 7, ll. 54-57). However, Petitioner has not provided any explanation as to how this "logical connection" is the same as "a point-to-point communication link between the first process and the second process," as required by claim 1. Thus, we are not persuaded that the Petitioner is reasonably likely to prevail on this challenge.

b. Claims 2 and 4-6

As to the challenge of claims 2 and 4-6 based on DEC '652, we are not persuaded that the Petitioner is reasonably likely to prevail on this challenge for the same reasons discussed above with respect to claim 1. Furthermore, the petition must identify with particularity, for each claim challenged, the grounds on which the challenge to the claim is based, and the evidence that supports the grounds for the challenge to each claim. *See* 35 U.S.C. § 312(a)(3). Under 37 C.F.R. § 42.22(a), each petition must include a statement of the precise relief requested and a full statement of the reasons for the relief requested, including a detailed

explanation of the significance of the evidence including material facts, the governing law, rules, and precedent. Under 37 C.F.R. § 42.104(b)(4), the petition must specify where each element of a challenged claim is found in the prior art patents or printed publications. Furthermore, in accordance with 37 C.F.R. § 42.104(b)(5), the relevance of the evidence supporting the challenge must be provided, including identification of specific portions of the evidence that support the challenge.

The Petitioner has not identified where each element of claims 2 and 4-6 is found in DEC '652. Petitioner provided a claim chart attempting to illustrate where in some of the references the elements of claims 2 and 4-6 can be found. Pet. 40-50. Petitioner has not included DEC '652, however, in the submitted claim chart for claims 2 and 4-6. Thus, Petitioner has failed to demonstrate where in DEC '652 each element of claims 2 and 4-6 is found. We are, therefore, not persuaded that the Petitioner is reasonably likely to prevail on this challenge.

E. Remaining Anticipation Grounds

Petitioner contends that claims 1-7 and 32-42 are anticipated by Messenger, DNS1, DNS2, and DNS Orig. Pet. 38-55. We determine not to proceed on these grounds because they are redundant to the grounds of anticipation of claims 1-7, 32, and 38-42 by NetBIOS and anticipation of claims 1-7 and 32-42 by WINS. *See Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00003 (Paper No. 7), at *2 (PTAB Oct. 25, 2012) (not proceeding on redundant grounds in absence of meaningful distinction).

Petitioner describes Messenger as enabled with the NetBIOS Name Server and the NetBIOS name registration request service. *Id.* at 19. Similarly, DNS1, DNS2, and DNS Orig. describe the same name registration features of NetBIOS.

NetBIOS describes that a single NetBIOS Name Server can be implemented as a distribution entity, such as a Domain Name Service. Ex. 1003, 367. Thus, because they are redundant of NetBIOS, we do not proceed on the proposed grounds of anticipation by Messenger, DNS1, DNS2, and DNS Orig.

F. Remaining grounds obviousness of claims 1-7 and 32-42

Petitioner contends that claims 1-7 and 32-42 are obvious over (1) Messenger, (2) WINS or NetBIOS in view of Messenger, (3) DNS1, DNS2, and DNS Org., and (4) DNS1, DNS2, and DNS Orig. in view of VocalTec, Taligent, or Admitted Prior Art. Pet. 10-30. However, we are not persuaded that there is a reasonable likelihood that Petitioner will prevail in these challenges.

A petition must identify with particularity each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim. *See* 35 U.S.C. § 312(a)(3). As noted, under 37 C.F.R. § 42.22(a), each petition must include a statement of the precise relief requested and a full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, the governing law, rules, and precedent. As discussed in the *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007),

> [o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ('[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness').

Here, Petitioner has not provided an articulated reasoning with some rational underpinning to support the allegation of obviousness under *KSR*. While Petitioner has identified where in the cited art some of the elements of the challenged claims can be found (Pet. 18-58), Petitioner has not provided any reasoning to support the allegation of obviousness.

For Petitioner's contention that the claims are obvious over DNS1, DNS2, and DNS Orig. in view of VocalTec, Taligent, or Admitted Prior Art, Petitioner has argued generally that "it is obvious to combine, since . . . communicating with an entity such as DNS to obtain the addressing and registration (connected, on-line) information" is the intent of all of the cited prior art. *Id.* at 33. However, this general statement is insufficient to support an allegation of obviousness for it merely reiterates the claim language.

Furthermore, Petitioner has not provided any expert testimony as evidence that the claims are obvious over the cited prior art. Although not required, such testimony can be helpful in determining obviousness. Accordingly, we are not persuaded that there is a reasonable likelihood that Petitioner will prevail in showing that claims 1-7 and 32-42 are obvious in view of the combination of the cited prior art as presented by Petitioner.

III. SUMMARY

Petitioner has demonstrated that there is a reasonable likelihood of prevailing on its challenge to the patentability of claims 1-7 and 32-42 of the '704 patent.

The Petition is granted as to the following grounds proposed:

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

B. Anticipation of claims 1-7 and 38-42 by WINS; and

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

The Petition is denied as to all other grounds proposed. The Board has not made a final determination on the patentability of the challenged claims.

IV. ORDER

For the reasons given, it is

ORDERED that the Petition is *granted* as to claims 1-7 and 32-42.

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '704 patent is hereby *instituted* commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

FURTHER ORDERED that the trial is limited to the grounds identified above. No other grounds are authorized for the challenged claims.

FURTHER ORDERED that an initial conference call with the Board is scheduled for 2PM Eastern Time on October 30, 2013. The parties are directed to the Office Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012) for guidance in preparing for the initial conference call, and should come prepared to discuss any proposed changes to the Scheduling Order entered herewith and any motions the parties anticipate filing during the trial.

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