

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VERIZON SERVICES CORP. and VERIZON BUSINESS NETWORK
SERVICES INC.,
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.

Case IPR2015-01407
Patent 6,131,121 C1

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

DESHPANDE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Verizon Services Corp. and Verizon Business Network Services Inc. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 3, 4, and 6–14 of U.S. Patent No. 6,131,121 C1 (Ex. 1001, “the ’121 patent”). Paper 1 (“Pet.”). With the Petition, Petitioner filed a Motion

for Joinder (Paper 3, “Mot.”), seeking to join this case with *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-00196. We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” After considering the Petition and associated evidence, we conclude that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing unpatentability of all the challenged claims. Thus, we authorize institution of an *inter partes* review of claims 3, 4, and 6–14 of the ’121 patent.

A. Related Proceedings

Petitioner indicates that the ’121 patent is the subject of *Straight Path IP Grp., Inc. v. Verizon Comm’ns, Inc.*, No. 1:14-cv-07798 (S.D. N.Y.). Pet. 5–6. Petitioner also indicates that the ’121 patent is the subject of *Certain Point-to-Point Network Commc’n Devices and Prods. Containing Same*, Inv. No. 337-TA-892 (USITC). *Id.* at 6. Petitioner indicates that the ’121 patent is also the subject of *Samsung Elecs. Co. v. Straight Path IP Grp., Inc.*, Case IPR2014-01368 (PTAB), *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, and Case IPR2015-00196 (PTAB). *Id.* at 4.

Petitioner further indicates that the ’121 patent is related to U.S. Patent No. 6,108,704 (“the ’704 patent”) and U.S. Patent No. 6,009,469 (“the ’469 patent”). *Id.* at 4. The ’704 patent was the subject of *Sipnet EU S.R.O. v. Straight Path IP Grp., Inc.*, Case IPR2013-00246 (PTAB) (“*Sipnet*”). *Id.* at 4. The ’704 patent and the ’469 patent are the subject of *Samsung Elecs., Co. v. Straight Path IP Grp., Inc.*, Case IPR2014-01366 (PTAB), and *Samsung Elecs., Co. v. Straight Path IP Grp., Inc.*, Case

IPR2014-01367 (PTAB), *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, Case IPR2015-00198 (PTAB), *LG Elecs., Inc. v. Straight Path IP Grp., Inc.*, and Case IPR2015-00209 (PTAB). *Id.* at 4.

B. Illustrative Claim

Petitioner challenges claims 3, 4, and 6–14 of the '121 patent. Pet. 30–59. Independent claim 6 is illustrative of the claims at issue and follows:

6. A computer program product for use with a computer system capable of executing a first process and connecting to other processes and a server process over a computer network, the computer program product comprising a computer usable medium having computer readable code means embodied in the medium comprising:
 - A. program code configured to, following connection of the first process to the computer network, forward to the server process a *dynamically assigned* network protocol address at which the first process is connected to the computer network;
 - B. program code configured to query the address server as to whether the second process is connected to the computer network;
 - C. program code configured to receive a *dynamically assigned* network protocol address of the second process from the address server, when the second process is connected to the computer network; and
 - D. program code configured to respond to the network protocol address of the second process, establish a point-to-point communication link with the second process over the computer network.

C. The Alleged Grounds of Unpatentability

The information presented in the Petition sets forth Petitioner’s contentions of unpatentability of claims 3, 4, and 6–14 of the ’121 patent under 35 U.S.C. § 103(a), as follows (*see* Pet. 7, 30–59):

References	Claims Challenged
WINS ¹ and NetBIOS ²	3, 4, and 6–14

II. ANALYSIS

Petitioner argues that claims 3, 4, and 6–14 are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS and NetBIOS. Pet. 30–59. Petitioner submits arguments and evidence identical to those submitted in IPR2015-00196. Mot. 2. Petitioner proposes the same claim construction and argues the same rationale of unpatentability of claims 3, 4, and 6–14 as presented in IPR2015-00196. Pet. 7, 27–59; *LG Elecs., Inc. v Straight Path IP Grp., Inc.*, Case IPR2015-00196, slip op. at 29–59 (Paper 1). Petitioner further relies on the same Declaration by Dr. Bruce M. Maggs in support of the alleged grounds of unpatentability. *Id.*; Ex. 1002. Petitioner filed a proposed order defining the parameters of joinder. *See* Mot. 8–9. Patent Owner did not file a Preliminary Response.

We determined that the petitioner in IPR2015-00196, LG Electronics, Inc., Toshiba Corp., VIZIO, Inc., and Hulu, LLC (collectively, “LG”),

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

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

demonstrated a reasonable likelihood of prevailing in establishing the unpatentability of claims 3, 4, and 6–14 of the '121 patent. *LG Elecs., Inc. v Straight Path IP Grp., Inc.*, Case IPR2015-00196, slip op. at 9–19 (PTAB May 15, 2015) (Paper 20). We granted that petition and instituted an *inter partes* review of claims 3, 4, and 6–14 as unpatentable under 35 U.S.C. § 103(a) as obvious over WINS and NetBIOS. *Id.* at 19.

Accordingly, we incorporate our previous analysis, including our claim interpretation analysis (*see id.* at 9–13) and our analysis regarding this asserted ground of unpatentability (*see id.* at 13–19), from IPR2015-00196, and we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of claims 3, 4, and 6–14 of the '121 patent in this Petition for the same reasons discussed in our Decision instituting *inter partes* review in IPR2015-00196.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in establishing unpatentability of claims 3, 4, and 6–14 of the '121 patent.

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

IV. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted as to the following proposed ground: obviousness of claims 3, 4, and 6–14 under 35 U.S.C. § 103(a) over WINS and NetBIOS;

FURTHER ORDERED that the trial is limited to the ground identified above and no other grounds are authorized; and

FURTHER ORDERED that 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; the trial commences on the entry date of this Decision.

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