

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC., TOSHIBA CORP.,
VIZIO, INC., HULU, LLC,
CISCO SYSTEMS, INC., AVAYA INC.,
VERIZON SERVICES CORP., and VERIZON BUSINESS NETWORK
SERVICES INC.,
Petitioners,

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.

Case No. IPR2015-00196¹
Patent No. 6,131,121 C1

PETITIONERS' NOTICE OF APPEAL

¹ IPR2015-01397 and IPR2015-01407 have been joined with this proceeding.

Petitioners LG Electronics, Inc., Toshiba Corp., VIZIO, Inc., Hulu, LLC, Cisco Systems, Inc., Avaya Inc., Verizon Services Corp., and Verizon Business Network Services Inc., hereby give notice pursuant to 35 U.S.C. § 142 and 37 C.F.R. § 90.2(a) that they appeal to the United States Court of Appeals for the Federal Circuit from the Board's Final Written Decision in IPR2015-00196, entered on May 9, 2016 (Paper No. 56), and from all orders, decisions, rulings, and opinions underlying the Final Written Decision. A copy of the Final Written Decision is attached to this Notice.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Petitioners further note that the issues on appeal will likely include, but are not limited to, the Board's claim construction; whether the Board erred when it ruled that claims 4 and 6–14 of U.S. Patent No. 6,131,121 C1 ("the Instituted Claims") are not obvious over the prior art of record; whether the Board erred when it determined that Petitioners had not met their burden of proving that the Instituted Claims are unpatentable; any finding or determination supporting or relating to those issues; and any other issues decided adversely to Petitioners in any orders, decisions, ruling, or opinions.

Copies of this Notice of Appeal are being filed simultaneously with the Director of the United States Patent and Trademark Office and the Patent Trial and Appeal Board. A copy of this Notice of Appeal and the \$500.00 fee required by

28 U.S.C. § 1913 and Federal Circuit Rule 52(a)(3)(A) are being electronically filed today in the United States Court of Appeals for the Federal Circuit.

A Notice of Appeal is also being filed concurrently in the related *inter partes* review proceedings IPR2015-00198 and IPR2015-00209.

Respectfully submitted,

DATED: May 20, 2016

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CERTIFICATE OF SERVICE AND FILING

I hereby certify that on May 20, 2016, I caused a true and correct copy of this **PETITIONERS' NOTICE OF APPEAL**, as well all other papers filed therewith, to be filed along with the filing fee via CM/ECF with the Clerk's Office of the United States Court of Appeals for the Federal Circuit, and also filed and served as set forth below:

ELECTRONIC FILING THROUGH PATENT REVIEW PROCESSING SYSTEM AND COPIES DELIVERED VIA EMAIL

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VERIZON BUSINESS NETWORK SERVICES INC.,
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v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.

Case IPR2015-00196¹ (Patent 6,131,121 C1)
Case IPR2015-00198² (Patent 6,009,469 C1)
Case IPR2015-00209³ (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
35 U.S.C. § 318(a); 37 C.F.R. § 42.73

¹ IPR2015-01397 and IPR2015-01407 were joined with this proceeding.

² IPR2015-01400 was joined with this proceeding.

³ IPR2015-01398 and IPR2015-01406 were joined with this proceeding.

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IPR2015-00198 (Patent 6,009,469 C1)
IPR2015-00209 (Patent 6,108,704 C1)

I. INTRODUCTION

A. *Background*

LG Electronics, Inc. (“LG”), Toshiba Corp. (“Toshiba”), VIZIO, Inc. (“VIZIO”), and Hulu, LLC (“Hulu”) filed three Petitions requesting *inter partes* review of claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704 C1 (209 Ex. 1001,⁴ “the ’704 patent”), claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of U.S. Patent No. 6,009,469 C1 (198 Ex. 1001, “the ’469 patent”), and claims 3, 4, and 6–14 of U.S. Patent No. 6,131,121 C1 (196 Ex. 1001, “the ’121 patent”). 209 Paper 1 (“209 Pet.”); 198 Paper 1 (“198 Pet.”); 196 Paper 1 (“196 Pet.”). Straight Path IP Group, Inc. (“Patent Owner”) filed a Preliminary Response. 209 Paper 15 (“209 Prelim. Resp.”); 198 Paper 19 (“198 Prelim. Resp.”); 196 Paper 15 (“196 Prelim. Resp.”). On May 15, 2015, pursuant to 35 U.S.C. § 314, we instituted *inter partes* review in each case as follows:

⁴ Citations are preceded by “209” to designate IPR2015-00209, “198” to designate IPR2015-00198, or “196” to designate IPR2015-00196. Unless noted otherwise, all citations are to IPR2015-00209.

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Case	Claims Instituted	Basis	References
IPR2015-00209	1	§ 103(a)	WINS ⁵ and NetBIOS ⁶
IPR2015-00209	11, 12, 14, 16, 19, 22, 23, 27, 30, and 31	§ 103(a)	WINS, NetBIOS, and Pinard ⁷
IPR2015-00198	1–3, 9, 10, 14, 17, and 18	§ 103(a)	WINS, NetBIOS, and Pinard
IPR2015-00198	5 and 6	§ 103(a)	WINS and NetBIOS
IPR2015-00196	3, 4, 6–14	§ 103(a)	WINS and NetBIOS

209 Paper 20 (“209 Dec.”); 198 Paper 24 (“198 Dec.”); 196 Paper 20 (“196 Dec.”).

After institution of *inter partes* review, Cisco Systems, Inc. (“Cisco”) and AVAYA, Inc. (“AVAYA”) filed three Petitions and Motions to Join the IPR2015-00209, IPR2015-00198, and IPR2014-00196 proceedings. IPR2015-01398, Papers 3, 4; IPR2015-01400, Papers 3, 5; IPR2015-01397, Papers 2, 3. Verizon Services Corp. and Verizon Business Network Services Inc. (collectively, “Verizon”) also filed two Petitions and Motions to Join the IPR2015-00209 and IPR2015-00196 proceedings. IPR2015-01406, Papers 1, 3; IPR2015-01407, Papers 1, 3. We granted these motions and joined Cisco, AVAYA, and Verizon to these *inter partes* reviews.

⁵ Microsoft Windows NT 3.5, TCP/IP User Guide (1994) (Ex. 1003, “WINS”).

⁶ The Open Group, Technical Standard, Protocols For X/Open Pc Interworking: SMB, Version 2.0 (1992) (Ex. 1004, “NetBIOS”).

⁷ U.S. Patent No. 5,533,110, issued July 2, 1996 (Ex. 1020, “Pinard”).

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209 Papers 36, 39; 198 Paper 40; 196 Papers 38, 41. We refer to LG, Toshiba, VIZIO, Hulu, Cisco, AVAYA, and Verizon collectively as “Petitioner.”

Patent Owner filed a Response in each case (209 Paper 30, “209 PO Resp.”; 198 Paper 34, “198 PO Resp.”; 196 Paper 32, “196 PO Resp.”), and Petitioner filed a Reply (209 Paper 37, “209 Pet. Reply”; 198 Paper 41, “198 Pet. Reply”; 196 Paper 39, “196 Pet. Reply”). Subsequent to Patent Owner’s Response and Petitioner’s Reply, the United States Court of Appeals for the Federal Circuit issued its decision in *Straight Path IP Grp., Inc. v. Sipnet EU S.R.O.*, 806 F.3d 1356 (Fed. Cir. 2015) (“*Straight Path*”). See Ex. 2042. Petitioner filed additional briefing in light of *Straight Path* (209 Paper 47, “209 Add’l Br.”; 198 Paper 50, “198 Add’l Br.”; 196 Paper 49, “196 Add’l Br.”) and Patent Owner filed a response to Petitioner’s additional briefing (209 Paper 50, “209 PO Add’l Resp.”; 198 Paper 53, “198 PO Add’l Resp.”; 196 Paper 52, “196 PO Add’l Resp.”). Oral hearing was held on February 9, 2016, and the hearing transcript was entered in the record. 209 Paper 53; 198 Paper 56; 196 Paper 55 (“Tr.”).⁸ Petitioner also filed a Motion to Exclude Evidence (209 Paper 45, “209 Mot.”; 198 Paper 48, “198 Mot.”; 196 Paper 47, “196 Mot.”), Patent Owner filed an Opposition to Petitioner’s Motion to Exclude Evidence (209 Paper 49, “209 Opp. Mot.”; 198 Paper 52, “198 Opp. Mot.”; 196 Paper 51, “196 Opp. Mot.”), and Petitioner filed a Reply to Patent Owner’s Opposition

⁸ The hearing transcript is the same for all three cases.

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to Petitioner’s Motion to Exclude Evidence (209 Paper 52, “209 Reply Mot.”; 198 Paper 55, “198 Reply Mot.”; 196 Paper 54, “196 Reply Mot.”).

The following table summarizes the papers filed by the parties:

Case No.	IPR2015-00209	IPR2015-00198	IPR2015-00196
Petition	Paper 1 (“209 Pet.”)	Paper 1 (“198 Pet.”)	Paper 1 (“196 Pet.”)
Preliminary Response	Paper 15 (“209 PO Resp.”)	Paper 19 (“198 PO Resp.”)	Paper 15 (“196 PO Resp.”)
Decision to Institute	Paper 20 (“209 Dec.”)	Paper 24 (“198 Pet.”)	Paper 20 (“196 Pet.”)
PO Response	Paper 30 (“209 PO Resp.”)	Paper 34 (“198 PO Resp.”)	Paper 32 (“196 PO Resp.”)
Petitioner’s Reply	Paper 37 (“209 Pet. Reply”)	Paper 41 (“198 Pet. Reply”)	Paper 39 (“196 Pet. Reply”)
Petitioner’s Additional Briefing	Paper 47 (“66 Add’l Br.”)	Paper 50 (“198 Add’l Br.”)	Paper 49 (“196 Add’l Br.”)
Patent Owner’s Response to Additional Briefing	Paper 50 (“209 PO Add’l Resp.”)	Paper 53 (“198 PO Add’l Resp.”)	Paper 52 (“196 PO Add’l Resp.”)
Petitioner’s Motion to Exclude	Paper 45 (“209 Mot.”)	Paper 48 (“198 Mot.”)	Paper 47 (“196 Mot.”)
Opposition to Motion to Exclude	Paper 49 (“209 Opp. Mot.”)	Paper 52 (“198 Opp. Mot.”)	Paper 51 (“196 Opp. Mot.”)
Reply to Opposition to Motion to Exclude	Paper 52 (“209 Reply Mot.”)	Paper 55 (“198 Reply Mot.”)	Paper 54 (“196 Reply Mot.”)

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.

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For the reasons discussed below, we are not persuaded that Petitioner has shown by a preponderance of the evidence that claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of the '704 patent, claims 3, 6, 9, 10, 14, 17, and 18 of the '469 patent, and claims 4 and 6–14 of the '121 patent are unpatentable. For the reasons discussed below, we are persuaded that Petitioner has shown by a preponderance of the evidence that claims 1, 2, and 5 of the '469 patent and claim 3 of the '121 patent are unpatentable.

B. Related Proceedings

Petitioner indicates that the '704, '469, and '121 patents are the subject of the proceedings in *Straight Path IP Grp., Inc. v. Vizio et. al*, No. 1:13-cv-00934 (E.D. VA.). Pet. 4. Petitioner further indicates that the '704 patent was the subject of a final written decision in *Sipnet EU S.R.O. v. Straight Path IP Grp., Inc.*, IPR2013-00246 (PTAB), which was subsequently reversed and remanded in *Straight Path*. Pet. 2. The remanded case in IPR2013-00246 is still pending before the Board as of the entry of this Decision.

C. The '704, '469, and '121 Patents

The '704 patent is titled “Point-to-Point Internet Protocol” and generally relates to establishing a point-to-point communication link. 209 Ex. 1001, 2:53–57. The '469 patent is titled “Graphic User Interface for Internet Telephony Application” and generally relates to facilitating audio communications over computer networks. 198 Ex. 1001, 1:54–57. The '121 patent is titled “Point-to-Point Computer Network Communication Utility Utilizing Dynamically Assigned Network Protocol Addresses” and, similar to the '409 patent, relates to facilitating audio communications over

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computer networks. 196 Ex. 1001, 1:55–57. The '469 and '121 patents are continuations-in-part of the '704 patent. 198 Ex. 1001 at [63]; 196 Ex. 1001 at [63]. The specifications for the three challenged patents are very similar and, in some instances, duplicative.

Each patent explains that a first processing unit automatically transmits its associated e-mail address, and its IP address, to a connection server. 209 Ex. 1001, 5:25–38; 198 Ex. 1001, 6:66–7:9; 196 Ex. 1001, 6:60–7:3. 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. 209 Ex. 1001, 5:55–60; 198 Ex. 1001, 7:31–36; 196 Ex. 1001, 7:24–29. 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. 209 Ex. 1001, 5:60–64; 198 Ex. 1001, 7:37–40; 196 Ex. 1001, 7:30–34. The first processing unit then directly establishes the point-to-point Internet communication with the callee using the retrieved IP address. 209 Ex. 1001, 5:64–67; 198 Ex. 1001, 7:40–43; 196 Ex. 1001, 7:33–36.

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Figure 1 of the '704, '469, and '121 patents is reproduced below:

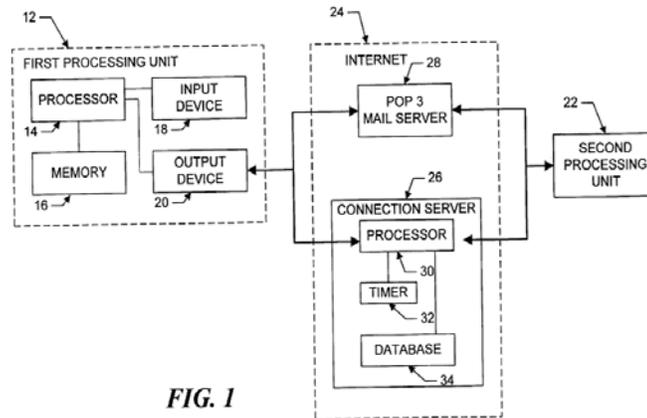


FIG. 1

Figure 1 above illustrates the architecture between first processing unit 12, second processing unit 22, and connection server 26. 209 Ex. 1001, 5:15–29, 198 Ex. 1001, 6:56–7:3; 196 Ex. 1001, 6:50–64.

D. Illustrative Claims

Petitioner challenges claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of the '704 patent, claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of the '469 patent, and claims 3, 4, and 6–14 of the '121 patent. 209 Pet. 36–60; 198 Pet. 37–60; 196 Pet. 29–59. Claim 1 of the '704 patent is illustrative of the claims at issue in that patent 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;

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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.

Claim 1 of the '469 patent is illustrative of the claims at issue in that patent and is reproduced below.⁹

1. A computer program product for use with a computer system having a display, the computer system capable of executing a first process and connecting to other processes and a server process over a computer network, the computer program product comprising a computer usable medium having computer readable code means embodied in the medium comprising:

a. program code for generating a user-interface enabling control *of* a first process executing on the computer system;

b. program code for determining the currently assigned network protocol address of the first process upon connection to the computer network;

c. program code responsive to the currently assigned network protocol address of the first process, for establishing a communication connection with the server process and for forwarding the assigned network protocol address of the first process and a unique identifier of the first process to the server

⁹ Italicized terms and limitations represent amendments to the claims as issued in the Ex Parte Reexamination Certificate. *See* 198 Ex. 1001.

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process upon establishing a communication connection with the server process; and

d. program code, responsive to user input commands, for establishing a point-to-point communications with another process over the computer network.

Claim 6 of the '121 patent is illustrative of the claims at issue in that patent and is reproduced below.¹⁰

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.

¹⁰ Italicized terms and limitations represent amendments to the claims as issued in the Ex Parte Reexamination Certificate. *See* 196 Ex. 1001.

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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 that 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.

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1. “*is connected to the computer network*” / “*on-line status*” / “*is accessible*”

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.” Dependent claims 3 and 6 of the '469 patent, independent claims 6, 7, 8, 12, 13, and 14 of the '121 patent, and dependent claim 4 of the '121 patent recite the similar limitations of a query as to whether a second process “*is connected to the computer network*” (emphasis added). Independent claims 11 and 22, and dependent claims 12, 14, 16, 19, 23, 27, 30, and 31 of the '704 patent recite “querying the server as to the *on-line status* of the first callee process” (emphasis added). Independent claim 9 and dependent claims 14, 17, and 18 of the '469 patent recite similar limitations as to a query whether the first callee process “*is accessible*,” and independent claims 9, 10, and 11 of the '121 patent recite a similar limitation as to the processes “having [an] *on-line status*” (emphasis added).

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 1360.¹¹ The Federal Circuit held that the query

¹¹ Petitioner argues that the relevant specifications do not include an embodiment that “guarantee[s]” that an entry in its database is online, and, therefore, Patent Owner’s argument does not distinguish the '704, '469, and '121 patents over the prior art. Add'l Br. 6–7. However, such an argument goes towards whether there is written description and enablement support for the claims. In *Straight Path*, the Federal Circuit did not offer a view as to the sufficiency of the written description or enablement based on the

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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” and “is accessible” have the same meaning as “is connected to the computer network.” *See* 209 Pet. 35–36; 209 PO Resp. 36–48; 198 Pet. 35–36; 198 PO Resp. 35–46; 196 Pet. 29; 196 PO Resp. 38–51. Similar to “is connected to a computer network,” the “on-line status” and “is accessible” of the second process are recited in the present tense, and therefore must be

claim construction provided by the Federal Circuit because “written-description and enablement challenges were not, and could not have been, part of the inter partes review.” *Straight Path*, 806 F.3d at 1363. We similarly do not determine whether this claim limitation is supported by the specifications of the ’704, ’469, and ’121 patents.

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determined at the time of the querying whether the second process “is accessible” or selecting of the process having an “on-line status.” Therefore, we construe “on-line status” and “is accessible” as having the same meaning as “is connected to the computer network.”

Petitioner argues that the Federal Circuit relied on two disclosures in the '704 patent in construing “is connected to the computer network” and “on-line status.” Add'l Br. 2. Petitioner argues that the Federal Circuit explained that the use of “timestamps” and the server’s maintenance of the database upon the user’s logging off are descriptions of “is connected to a computer network” and “on-line status.” *Id.* However, Petitioner did not raise these positions in its Petition. Nonetheless, we disagree with Petitioner. The Federal Circuit held that “[w]hen claim language has a plain meaning . . . leaving no genuine uncertainties on interpretive questions . . . [t]he specification plays a more limited role than in the common situation where claim terms are uncertain in meaning in relevant respects.” *Straight Path*, 806 F.3d at 1361. Although the Federal Circuit highlighted the same disclosures from the '704 patent specification argued by Petitioner, the Federal Circuit did not rely on the '704 patent specification in narrowing “is connected to the computer network” and “on-line status,” but rather held that the '704 patent specification did not contradict its claim construction of these terms. *See id.*

2. “process”

The claims recite a “query . . . as to whether the second *process* is connected to the computer network” (emphasis added). Patent Owner argues that the plain and ordinary meaning of the term “process” is “a

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running instance of a computer program or application.” PO Resp. 26–31. Petitioner accepts Patent Owner’s proposed construction. Pet. Reply 6; Tr. 20:1–4. Petitioner and Patent Owner, however, disagree as to whether a computer with an operating system is a computer program, and, therefore, a “process.” PO Resp. 26–36; Pet. Reply 7–10.

In *Ancora Technologies*, the Federal Circuit explained that “[t]he ordinary meaning of the word ‘program’ in the computer context encompasses both operating systems and the applications that run on them (as well as other types of computer programs)” and “‘to a computer programmer’ a program is merely a ‘set of instructions’ for a computer.” *Ancora Techs., Inc. v. Apple, Inc.*, 744 F.3d 732, 734 (Fed. Cir. 2014). Applying this guidance to the case before us, we agree with Petitioner and construe the term “process” to mean “a running instance of a computer program or application,” where a “computer program” is a set of instructions for a computer that encompasses both operating systems and the applications that run on them.

We further note that the ’704, ’469, and ’121 patent specifications interchange the terms “process” and “processing unit.” For example, the specifications explain that a first “processing unit” is “established in the database [] as an active on-line party.” Ex. 1001, 5:29–34. The claims recite the term “process.” Accordingly, our construction is also consistent with the specifications, such that a “process” includes a “processing unit” that is running a program (operating system) or application.

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II. ANALYSIS

A. 35 U.S.C. § 315 Statutory Bar

Patent Owner argues that the Petitions are barred under both 35 U.S.C. § 315(a)(1) and 35 U.S.C. § 315(b). 209 PO Resp. 2–6; 198 PO Resp. 2–6; 196 PO Resp. 2–6.

1. Section 315(a)(1)

Under 35 U.S.C. § 315(a)(1), “[a]n inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interested filed a civil action challenging the validity of a claim of the patent.”

Patent Owner argues that Hulu filed a civil declaratory judgment action challenging the validity of the ’704, ’469, and ’121 patents. 209 PO Resp. 2–3; 198 PO Resp. 2–3; 196 PO Resp. 2–3. Specifically, Patent Owner argues that Hulu sought to intervene in a civil action between Patent Owner and LG, Toshiba, and VIZIO, and in doing so Hulu challenged the validity of the ’704 patent, the ’469 patent, and the ’121 patent claims. *Id.* Patent Owner argues by challenging both “invalidity and non-infringement” in a civil action prior to filing its Petition for *inter partes* review, Hulu is barred under 35 U.S.C. § 315(a)(1) from filing its Petition. *Id.* (citing Ex. 2002, 6; Ex. 2001, 1, 9–10; Ex. 2003, 5). Patent Owner points to Hulu’s statement that “Hulu does not infringe . . . a valid claim, if any, of the ’704 Patent,” and asserts that Hulu has challenged explicitly the ’704 patent claims because the district court cannot resolve Hulu’s allegation without first determining the validity of the ’704 patent claims. *Id.* at 3 (quoting Ex. 2003, 5) (emphasis omitted).

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Hulu argues that its Complaint in Intervention only alleges a cause of action for non-infringement. Pet. Reply 3. Specifically, Hulu argues that Patent Owner selectively quotes Hulu’s Motion to Intervene, but Hulu’s Complaint does not include the terms “invalid” or “invalidity.” *Id.* at 3–4. Hulu further argues that the Board has held that a “civil action for a declaratory judgment of non-infringement is not a civil action challenging the validity of a patent.” *Id.* at 3–4 (quoting *Ariosa Diagnostics v. Isis Innovation Ltd.*, Case IPR2012-00022, slip op. at 14 (PTAB Sept. 2, 2014) (Paper 166) (emphasis omitted)). In *Ariosa*, the Board determined that Ariosa, a party that had previously filed a declaratory judgment action of non-infringement of a patent, was permitted to file a *inter partes* review petition against that same patent, and the Board stated that “allowing a party to file both a declaratory judgment of noninfringement and an *inter partes* review does not constitute harassment of a patent owner.” *Ariosa*, Paper 166, slip op. at 15.

We agree with Petitioner. Hulu’s Complaint only alleges a cause of action for noninfringement, not invalidity, and therefore is not considered a filing of a civil action for invalidity under 35 U.S.C. § 315(a)(1). Although *Ariosa* is not precedential, we find it instructive and on point to the facts of this case. *See Ariosa*, Paper 166, slip op. at 14. Accordingly, we are not persuaded by Patent Owner that Hulu is barred from filing its Petition under 35 U.S.C. § 315(a)(1).

2. Section 315(b)

Under 35 U.S.C. § 315(b), “[a]n *inter partes* review may not be instituted if the petition requesting the proceedings is filed more than 1 year

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after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.”

Patent Owner argues that Petitioner filed its Petition more than one year after Petitioner was served a complaint filed with the United States International Trade Commission (“ITC”). PO Resp. 4–6. Petitioner responds that § 315(b) only applies to service of a complaint in a civil action and not to administrative proceedings such as an ITC investigation. Pet. Reply 5–6 (citing *Alcon Research, Ltd. v. Dr. Joseph Neev*, Case IPR2014-00217, Paper 21, 9 (PTAB May 9, 2014); *Amkor Tech., Inc. v. Tessera, Inc.*, Case IPR2013-00242, Paper 98, slip op. at 10–12 (PTAB Jan. 31, 2014)). Petitioner specifically argues that the Board has rejected similar arguments as those raised by Patent Owner and held that § 315(b) only covers civil actions brought in federal district court. Paper 17, 3–5 (citing *Amkor*, Paper 98, 7–8). Patent Owner argues that *Amkor* is directed to administrative proceedings such as arbitration, and any discussion in *Amkor* regarding an ITC investigation is not relevant. Prelim. Resp. 13, n. 1.

Patent Owner’s argument is not persuasive. We agree with Petitioner that 35 U.S.C. § 315(b) applies only to civil actions for patent infringement, and not to an administrative proceeding, including an ITC investigation. See *Amkor*, Paper 98, slip op. at 6–18; *Brinkman Corp. v. A&J Mfg., LLC*, Case IPR2015-00056, slip op. at 7–8 (PTAB Mar. 23, 2015) (Paper 10).

Although *Amkor* and *Brinkman Corp.* are not precedential, we find them instructive and directly on point. In *Amkor*, the Board determined that “had Congress intended for arbitration, ITC, or other non-judicial proceedings to trigger the time bar of section 315(b), it would have used more

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encompassing language than ‘Patent Owner’s Action’ and ‘served with a complaint,’ which are harmonious with a civil action.” *Amkor*, Paper 98, slip op. at 11 (determining that the time bar is limited to being triggered by the service of a complaint *in a civil action*). A similar decision by the Board in *Brinkman Corp.* reaches the same result and specifically is directed toward an ITC investigation. Accordingly, we are not persuaded by Patent Owner that Petitioner is barred under 35 U.S.C. § 315(b).

B. Claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of the '704 Patent, Claims 3, 6, 9, 10, 14, 17, and 18 of the '469 Patent, and Claims 4 and 6–14 of the '121 Patent

1. Overview

Petitioner contends that claim 1 of the '704 patent is unpatentable under 35 U.S.C. § 103(a) as unpatentable over WINS and NetBIOS, and claims 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of the '704 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS, NetBIOS, and Pinard. 209 Pet. 37–60. Petitioner contends that claims 3, 9, 14, 17, and 18 of the '469 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS, NetBIOS, and Pinard, and claim 6 as unpatentable under 35 U.S.C. § 103(a) as unpatentable over WINS and NetBIOS. 198 Pet. 37–60. Petitioner contends that claims 4 and 6–14 of the '121 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS and NetBIOS. 196 Pet. 29–60. We have reviewed the Petition and supporting evidence and determine that Petitioner has not shown by a preponderance of the evidence that the challenged claims are unpatentable.

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2. *WINS (209 Ex. 1003; 198 Ex. 1003; 196 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 operating system. Ex. 1003, 3.¹² 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 67–69. 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 67–68. 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 62–63. When the first computer receives the appropriate address from the Windows Internet Name Service server, it connects directly to the second computer. *Id.*

3. *NetBIOS (209 Ex. 1004; 198 Ex. 1004; 196 Ex. 1004)*

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

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 provided by Petitioner.

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was originally designed for IBM's PC-Network. Ex. 1004, 378.¹³ 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 380.

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 395. A node registers a name with the NetBIOS Name Server, which stores the registered name in a database. *Id.* at 403–04, 413. 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 407–08. If the NetBIOS Name Server has information regarding a queried node, the NetBIOS Name Server transmits a positive response. *Id.* at 408–09. 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 416. The NetBIOS session service involves directed (point-to-point) communications. *Id.*

4. *Pinard (209 Ex. 1020; 198 Ex. 1020)*

Pinard discloses a method of indicating the status of various calls to a user. Ex. 1020, 1:6–8. A personal computer, containing a telephone application software program, displays an icon representing a local user of a

¹³ Ex. 1014 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.

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telephone. *Id.* at 4:1–3, 4:10–13. The display further includes a “call setup” icon that establishes a call when a user drags the icon of the user to the “call setup” icon to establish an outgoing call. *Id.* at 4:16–22. The software then displays a subscriber directory, allowing the user to drag the icon of a person to be called to the call setup icon. *Id.* at 4:23–28, 4:38–42. The application software program then causes the server to dial the number for the person to be called and establishes a call, as designated by the call icon. *Id.* at 4:48–51.

5. *Analysis*

As discussed in our claim construction analysis above, claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of the ’704 Patent, claims 3, 6, 9, 10, 14, 17, and 18 of the ’469 patent, and claims 4 and 6–14 of the ’121 patent recite the limitations “is connected to the computer network,” “on-line status,” and “is accessible.” *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 a dynamic database mapping computer names to IP addresses, software running on a first process requests the IP address of a second process by sending a name query request to the WINS server, and the server responds by providing the first process with the IP address of the second process if the name and IP address are registered in the database. 209 Pet. 39–43 (citing 209 Ex. 1003, xii, 46, 49, 53, 56, 57, 97). Petitioner further argues that the server keeps the mapping of names to IP addresses relatively current by tracking which users are still connected to the network. *Id.* (citing Ex. 1003, 56, 59). Petitioner further argues that

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NetBIOS discloses that the IP address of a second process is received from the directory server. *Id.* (citing Ex. 1002 ¶ 94).

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. 48–51. 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. 1003, 62–63, 68–69. 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 68. 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 150. In other words, WINS discloses that the WINS database may include entries of computers that are not currently connected to the WINS network. 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 above (*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,

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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. 1003, 68, 150. As such, we determine that WINS does not disclose the claimed “is connected to the computer network,” “on-line status,” or “is accessible,” as construed herein.

Similarly, NetBIOS discloses a registration process for resources or nodes to receive a unique name by registering a name. Ex. 1004, 379. During a name query (discovery), a datagram is sent requesting the name and address of another resource. *Id.* at 396. 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 379. 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.* 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

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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,” or “is accessible.”

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.

6. Conclusion

Accordingly, we determine that Petitioner has not demonstrated by a preponderance of the evidence that claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of the ’704 patent, claims 3, 6, 9, 10, 14, 17, and 18 of the ’469 patent, and claims 6, 8, 10, 11, 13, and 14 of the ’121 patent are unpatentable.

C. Claims 1, 2, and 5 of the ’469 Patent and Claim 3 of the ’121 Patent

1. Overview

Petitioner contends that claims 1 and 2 of the ’469 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over WINS, NetBIOS, and Pinard, and claim 5 of the ’469 patent is unpatentable under 35 U.S.C. § 103(a) as obvious over WINS, NetBIOS, and Palmer. 198 Pet. 37–47, 54–55, 58–59. For claims 1, 2, and 5, Petitioner provides citations for where each claim limitation is disclosed by WINS and NetBIOS. *Id.* Petitioner also articulates reasoning with rational underpinnings why a person of ordinary skill in the art at the time of the invention would have combined the teachings of WINS and NetBIOS. *Id.* See *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). We determine the record supports Petitioner’s contentions and adopt

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Petitioner's contentions discussed below as our own. Furthermore, we have reviewed the Petition and supporting evidence and determine that Petitioner has shown by a preponderance of the evidence that claims 1, 2, and 5 of the '469 patent would have been obvious over WINS and NetBIOS. *See id.*

Petitioner also contends that claim 3 of the '121 patent is unpatentable under 35 U.S.C. § 103(a) as obvious over WINS and NetBIOS.

196 Pet. 29–38. Petitioner provides citations for where each claim limitation is taught by WINS and NetBIOS. *Id.* Petitioner also articulates reasoning with rational underpinnings why a person of ordinary skill in the art at the time of the invention would have combined the teachings of WINS and NetBIOS. *Id. See KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d at 988). We determine the record supports Petitioner's contentions and adopt Petitioner's contentions discussed below as our own. Furthermore, we have reviewed the Petition and supporting evidence and determine that Petitioner has shown by a preponderance of the evidence that claim 3 of the '121 patent would have been obvious over WINS and NetBIOS. *See id.*

2. Analysis – Claims 1, 2, and 5 of the '469 Patent and Claim 3 of the '121 Patent

Claims 1, 2, and 5 of the '469 patent and claim 3 of the '121 patent are distinguished from the other challenged claims in these proceedings because these three claims do not recite the limitations “is connected to the computer network,” “on-line status,” or “is accessible.” Since this issue was dispositive as to the other challenged claims in these proceedings, we review claims 1, 2, and 5 of the '469 patent and claim 3 of the '121 patent separately.

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Claim 1 recites a “computer program product for use with a computer system having a display, the computer system capable of executing a first process and connecting to other processes and a server process over a computer network” and “the computer program product comprising a computer usable medium having computer readable code means embodied in the medium.” 198 Ex. 1001, 67 (1:28–34).¹⁴ Petitioner argues that WINS discloses a computer program product comprising a computer useable medium having computer code embodied in that medium for use with a computer system. 198 Pet. 39–40 (citing 198 Ex. 1003, 121, 155). Petitioner argues that WINS discloses a computer can execute a first process on a first computer and communicate with a second process on a second computer, a directory server, and a mail server process on a computer network. *Id.* at 40 (citing 198 Ex. 1003, 29, 76, 118–119). Petitioner additionally contends that NetBIOS discloses a software interface to a set of services. *Id.* (citing 198 Ex. 1004, 374, 377). Petitioner further argues that Pinard discloses a telephone application software program for use with a personal computer and a server, and provides a human machine interface (HMI). *Id.* at 41 (citing 198 Ex. 1020, 2:9–13, 2:23–25, 2:33–38). As discussed above in our claim construction, “process” includes a “processing unit” that is running a program (operating system) or application (*see* Section I.E.2), and WINS describes the Windows NT operating system,

¹⁴ A Reexamination proceeding amended some of the claims of the ’469 patent and the Ex Parte Reexamination Certificate is included at page 67 of 198 Ex. 1001.

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NetBIOS includes applications, and Pinard further discloses a program or application.

Claim 1 further recites “program code for generating a user-interface enabling control *of* a first process executing on the computer system.”

198 Ex. 1001, 67 (1:35–37). Petitioner argues that WINS discloses “software generating multiple user interfaces enabling control of the Windows NT or Windows for Workgroups operation system.” 198 Pet. 41 (citing 198 Ex. 1003, 26, 38, 41, 43, 46, 48, 50, 87–89, 92, 94, 96, 97, 104, 105, 124, 125, 127, 129, 133, 135, 137, 138, 140, 141, 146, 150, 152, 174, 176, 178, 188, 203–205, 236).

Claim 1 also recites “program code for determining the currently assigned network protocol address of the first process upon connection to the computer network.” 198 Ex. 1001, 67 (1:38–40). Claim 1 additionally recites:

program code responsive to the currently assigned network protocol address of the first process, for establishing a communication connection with the server process and for forwarding the assigned network protocol address of the first process and a unique identifier of the first process to the server process upon establishing a communication connection with the server process.

198 Ex. 1001, 67 (1:41–47).

Petitioner argues that WINS discloses that the DHCP server dynamically assigns IP addresses to processes upon connection to the network, and these dynamically assigned addresses are forwarded to the WINS/NetBIOS server. 198 Pet. 42–43 (citing Ex. 1003, 40, 65, 66, 67, 72, 74). Petitioner further argues that WINS discloses a dynamic database

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mapping computer names to IP addresses, software running on a first process requests the IP address of a second process by sending a name query request to the WINS server, and the server responds by providing the first process with the IP address of the second process if the name and IP address are registered in the database. *Id.* at 48 (citing Ex. 1003, 41, 65, 67, 69, 72, 73–74, 75). Petitioner contends that the server keeps the mapping of names to IP addresses relatively current by tracking which users are still connected to the network. *Id.* (citing 198 Ex. 1003, 69, 75). Petitioner further argues that NetBIOS discloses that every node has a permanent unique name. *Id.* (citing 198 Ex. 1004, 383, 394, 416).

Claim 1 further recites “program code, responsive to user input commands, for establishing a point-to-point communications with another process over the computer network.” 198 Ex. 1001, 67 (1:48–50). Petitioner argues WINS discloses that in a p-node environment, a first process queries the WINS server for the address of a second process and establishes a point-to-point session with the second process. 198 Pet. 45–46 (citing 198 Ex. 1003, 67, 266). Petitioner further argues that NetBIOS discloses p-nodes are point-to-point nodes that establish a point-to-point connection with a remote party or second process. *Id.* at 46 (citing 198 Ex. 1004, 383, 415–416). Petitioner additionally argues that Pinard discloses a human machine interface used to establish calls between two network devices. *Id.* (citing 198 Ex. 1020, 2:9–11, 2:59–3:9). We are persuaded by Petitioner’s contentions with respect to claim 1, and we adopt them as our own.

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Petitioner further contends that WINS discloses that NetBIOS is incorporated into the WINS system and expressly discloses that WINS should be combined with NetBIOS. *Id.* at 37–38 (citing 198 Ex. 1002 ¶ 81; Ex. 1003, 65). Accordingly, Petitioner concludes that one of ordinary skill in the art would have known about and been motivated to combine the references. *Id.* Petitioner further contends that a person with ordinary skill in the art would have been motivated similarly to combine WINS and NetBIOS with Pinard because Pinard discloses a telephony application with a graphical user interface that allows a user to establish and manage telephone calls. *Id.* at 38–39. Petitioner specifically argues that Pinard references Windows 3.1 and WINS references Windows 3.11 and Windows NT, and, therefore, a person with ordinary skill in the art would have known how to adapt the graphical user interfaces in Pinard to the system in WINS. *Id.* We are persuaded that Microsoft TCP/IP for Windows NT utilizes NetBIOS features for name resolution, as disclosed by WINS, and Pinard’s program is compatible with a Windows operating system, and, therefore, a person with ordinary skill in the art would have readily combined the disclosures of WINS, NetBIOS, and Pinard.

Claim 2 of the ’469 patent recites

[t]he computer program product of claim 1 wherein the program code for establishing a point-to-point communication link further comprises:

d.1 program code, responsive to the network protocol address of a second process, for establishing a point-to-point communication link between the first process and the second process over the computer network

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198 Ex. 1001, 41:48–54. Petitioner argues WINS discloses that in a p-node environment, a first process queries the WINS server for the address of a second process and establishes a point-to-point session with the second process. 198 Pet. 45–46 (citing 198 Ex. 1003, 67, 249). Petitioner further argues that NetBIOS discloses p-nodes are point-to-point nodes that establish a point-to-point connection with a remote party or second process. *Id.* at 46 (citing 198 Ex. 1004, Ex. 1004, 383, 415–416). Petitioner additionally argues that Pinard discloses a human machine interface used to establish calls between two network devices. *Id.* (citing 198 Ex. 1020, 2:9–11, 2:59–3:9). We are persuaded by Petitioner’s contentions with respect to claim 2, and we adopt them as our own.

Independent claim 5 of the ’469 patent recites limitations similar to those recited in independent claim 1 of the ’469 patent, and, therefore, Petitioner presents the same contentions for independent claim 5 as presented for independent claim 1 of the ’469 patent. We are persuaded by Petitioner’s contentions with respect to claim 5 of the ’469 patent, and we adopt them as our own.

Independent claim 3 of the ’121 patent recites limitations similar to those recited in independent claim 1 of the ’469 patent, and, therefore Petitioner presents similar contentions for independent claim 3 of the ’121 patent. We are persuaded by Petitioner’s contentions with respect to claim 3 of the ’121 patent, and we adopt them as our own.

Patent Owner argues that (a) WINS and NetBIOS fail to disclose the “process” elements with respect to both the ’469 patent and ’121 patent, and (b) WINS and NetBIOS fail to disclose “a unique identifier of the first

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process” with respect to the ’469 patent.¹⁵ 198 PO Resp. 25–35, 56–57;
196 PO Resp. 27–38.

a. “process” elements

Claim 1 of the ’469 patent recites that the assigned network protocol address and the unique identifier of the “first process” is forwarded to the server. Claims 2 and 5 of the ’469 patent, and claim 3 of the ’121 patent recite the same “process” element. Patent Owner contends that the claimed “process” does not include a computer. *Id.* at 25–35. However, as discussed above in our claim construction, “process” includes a “processing unit” that is running a program (operating system) or application, and we further note that the ’469 patent specification and ’121 patent specification interchangeably uses the terms “process” and “processing unit.”

See Section I.E.2. We reject Patent Owner’s claim construction for the term “process” for the reasons discussed above. *Id.* WINS describes the Windows NT operating system and NetBIOS includes applications. *See* 198 Ex. 1003, 3, 62–63; Ex. 1004, 378, 384). Furthermore, both WINS and

¹⁵ Patent Owner also argues that claims 1–3, 9, 10, 14, 17, and 18 recite an “interface element representing a first callee process,” and an “interface element representing a second callee process,” and “Petitioner fails to identify any evidence supporting its conclusory assertion that it would be obvious to combine WINS and NetBIOS with Pinard” based on these “interface elements.” 198 PO Resp. 50–56. However, claims 1 and 2 do not recite these limitations. Accordingly, we are not persuaded by Patent Owner’s arguments with respect to claims 1 and 2. Furthermore, we are persuaded by Petitioner’s rationale for combining WINS, NetBIOS, and Pinard for the reasons discussed above, and adopt Petitioner’s rationale as our own. *See* Section II.B.2.

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NetBIOS disclose processing units or computers that are running an instance of the Windows NT operating system and NetBIOS. *Id.* Accordingly, we disagree with Patent Owner’s argument.

b. “unique identifier”

Claim 1 recites “forwarding the assigned network protocol address . . . and a unique identifier” of the first process to the server. Patent Owner contends that WINS and NetBIOS fail to disclose a “unique identifier” as recited by claim 1 of the ’469 patent. 198 PO Resp. 56–57. Patent Owner argues that the term “unique” means “being the only one” and identifier means “one that identifies” and, therefore, a “unique identifier” of the first process means “something that identifies only the first process.” *Id.* (citing 198 Ex. 2013, 3). Patent Owner contends that WINS and NetBIOS disclose a registration system that registers the names and IP address for computers, not the applications running thereon, and, therefore, the “registered name of that computer would not be unique to any process on that computer.” *Id.* As discussed above, we reject Patent Owner’s construction of the term “process” to exclude a running instance of an operating system and a computer. *See* Sections I.E.2, II.B2.b.

Patent Owner further argues that WINS and NetBIOS disclose the registration of computer names, and “more than one computer can have the same name.” 198 PO Resp. 57 (citing 198 Ex. 1004, 418). We disagree with Patent Owner. NetBIOS discloses that a “unique name should be held by only one station at a time.” 198 Ex. 1004, 379. WINS discloses that “[n]ame registration ensures that the computer’s name and IP address are unique for each device.” 198 Ex. 1003, 68.

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Accordingly, we disagree with Patent Owner that WINS and NetBIOS fail to disclose a “unique identifier” as required by independent claim 1.

7. Conclusion

We have reviewed the Petition and supporting evidence and determine that Petitioner has shown by a preponderance of the evidence that claims 1, 2, and 5 of the '469 patent are obvious over WINS and NetBIOS, and claim 3 of the '121 patent is obvious over WINS, NetBIOS, and Pinard. Accordingly, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, and 5 of the '469 patent and claim 3 of the '121 patent are unpatentable.

III. MOTION TO EXCLUDE

Petitioner filed a Motion to Exclude, seeking to exclude Exhibits 2021, 2028, 2031, 2033, 2034, 2035, 2036, and 2039. Mot. 1. Petitioner specifically argues that Exhibits 2021, 2028, 2031, 2033, 2034, 2035, and 2036 should be excluded because these Exhibits are irrelevant under Federal Rule of Evidence 401. *Id.* at 1–5. Petitioner also argues that Exhibits 2028 and 2033 have not been authenticated under Federal Rules of Evidence 901(b)(1). *Id.* at 1–3. Petitioner additionally argues that Exhibits 2028, 2033, and 2039 should be excluded as hearsay under Federal Rules of Evidence 802. *Id.*

Because our decision does not rely on any of the challenged Exhibits, we dismiss Petitioner’s Motion to Exclude as moot.

IV. CONCLUSION

We are not persuaded that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 11, 12, 14, 16, 19, 22, 23, 27,

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30, and 31 of the '704 patent, claims 3, 6, 9, 10, 14, 17, and 18 of the '469 patent, and claims 4 and 6–14 of the '121 patent are unpatentable.

We are persuaded that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, and 5 of the '469 patent and claim 3 of the '121 patent are unpatentable.

Petitioner's Motion to Exclude is dismissed as moot.

V. ORDER

Accordingly, it is hereby:

ORDERED that, based on the grounds under review, claims 1, 11, 12, 14, 16, 19, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704 C1, claims 3, 6, 9, 10, 14, 17, and 18 of U.S. Patent No. 6,009,469 C1, and claims 4 and 6–14 of U.S. Patent No. 6,131,121 C1 have not been shown by a preponderance of the evidence to be unpatentable;

FURTHER ORDERED that, based on the grounds under review, claims 1, 2, and 5 of U.S. Patent No. 6,009,469 C1 and claim 3 of U.S. Patent No. 6,131,121 C1 have been shown by a preponderance of the evidence to be unpatentable;

FURTHER ORDERED that Petitioner's Motion to Dismiss is dismissed as moot; 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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