

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD.,  
SAMSUNG ELECTRONICS AMERICA, INC.,  
SAMSUNG TELECOMMUNICATIONS AMERICA, LLC,  
CISCO SYSTEMS, INC., and AVAYA, INC.,  
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.,  
Patent Owner.

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Case IPR2014-01366<sup>1</sup> (Patent 6,108,704 C1)

Case IPR2014-01367<sup>2</sup> (Patent 6,009,469 C1)

Case IPR2014-01368<sup>3</sup> (Patent 6,131,121 C1)

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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

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<sup>1</sup> IPR2015-01011 has been joined with this proceeding.

<sup>2</sup> IPR2015-01007 has been joined with this proceeding.

<sup>3</sup> IPR2015-01006 has been joined with this proceeding.

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IPR2014-01368 (Patent 6,131,121 C1)

## I. INTRODUCTION

### A. *Background*

Samsung Electronics Co., LTD., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, “Samsung”) filed three Petitions requesting *inter partes* review of claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704 C1 (66 Ex. 1001,<sup>4</sup> “the ’704 patent”), claims 1–3, 5, 6, 9, 10, 14, 17, and 18 of U.S. Patent No. 6,009,469 C1 (67 Ex. 1001, “the ’469 patent”), and claims 6, 8, 10, 11, 13, and 14 of U.S. Patent No. 6,131,121 C1 (68 Ex. 1001, “the ’121 patent”). 66 Paper 1 (“66 Pet.”); 67 Paper 1 (“67 Pet.”); 68 Paper 1 (“68 Pet.”). Straight Path IP Group, Inc. (“Patent Owner”) filed a Preliminary Response. 66 Paper 10 (“66 Prelim. Resp.”); 67 Paper 10 (“67 Prelim. Resp.”); 68 Paper 10 (“68 Prelim. Resp.”). On March 6, 2015, pursuant to 35 U.S.C. § 314, we instituted *inter partes* review of:

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<sup>4</sup> Citations may be preceded by “66” to designate IPR2014-01366, “67” to designate IPR2014-01367, or “68” to designate IPR2014-01368. Unless noted otherwise, all citations are to IPR2014-01366.

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Case	Claims Instituted	Basis	References
IPR2014-01366	1, 11, 12, 22, and 23	§ 103(a)	Microsoft Manual <sup>5</sup> and NetBIOS <sup>6</sup>
IPR2014-01366	14, 16, 27, 30, and 31	§ 103(a)	Microsoft Manual, NetBIOS, and Palmer <sup>7</sup>
IPR2014-01367	1–3, 5, 6, and 9	§ 103(a)	Microsoft Manual and NetBIOS
IPR2014-01367	10, 14, 17 and 18	§ 103(a)	Microsoft Manual, NetBIOS, and Palmer
IPR2014-01368	6, 8, 10, 11, 13, and 14	§ 103(a)	Microsoft Manual and NetBIOS

66 Paper 12 (“66 Dec.”); 67 Paper 12 (“67 Dec.”); 68 Paper 12 (“68 Dec.”).

After institution of *inter partes* review, Cisco Systems, Inc. (“Cisco”) and AVAYA, Inc. (“AVAYA”) filed three Petitions and Motions to Join the IPR2014-01366, IPR2014-01367, and IPR2014-01368 proceedings.

IPR2015-01011, Papers 2, 4; IPR2015-01007, Papers 3, 4; IPR2015-01006, Papers 2, 4. We granted these motions and joined Samsung, Cisco, and AVAYA (collectively, “Petitioner”) to these *inter partes* reviews.

66 Paper 26; 67 Paper 23; 68 Paper 25.

Patent Owner filed a Response in each case (66 Paper 28, “66 PO Resp.”; 67 Paper 24, “67 PO Resp.”; 68 Paper 27, “68 PO Resp.”), and

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<sup>5</sup> Microsoft Windows NT 3.5, TCP/IP User Guide (1994) (Ex. 1012, “Microsoft Manual”).

<sup>6</sup> The Open Group, Technical Standard, Protocols For X/Open Pc Interworking: SMB, Version 2.0 (1992) (Ex. 1014, “NetBIOS”).

<sup>7</sup> U.S. Patent No. 5,375,068, issued Dec. 20, 1994 (Ex. 1020, “Palmer”).

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Petitioner filed a Reply (66 Paper 33, “Pet. Reply”; 67 Paper 29, “67 Pet. Reply”; 68 Paper 32, “68 Pet. Reply”). Oral hearing was held on November 19, 2015, and the hearing transcript has been entered in the record. 66 Paper 45; 67 Paper 41; 68 Paper 44 (“Tr.”).<sup>8</sup> Subsequent to oral hearing, a Federal Circuit decision in *Straight Path IP Group, Inc. v. Sipnet EU S.R.O.*, 806 F.3d 1356 (Fed. Cir. 2015), issued. *See* Ex. 2024. Petitioner filed additional briefing in light of *Straight Path* (66 Paper 44, “66 Add’l Br.”; 67 Paper 40, “67 Add’l Br.”; 68 Paper 43, “68 Add’l Br.”) and Patent Owner filed a response to Petitioner’s additional briefing (66 Paper 46, “PO Add’l Resp.”; 67 Paper 42, “67 PO Add’l Resp.”; 68 Paper 45, “68 PO Add’l Resp.”).

The following table summarizes the papers filed by the parties:

<b>Case No.</b>	<b>IPR2014-01366</b>	<b>IPR2014-01367</b>	<b>IPR2014-01368</b>
<b>Petition</b>	Paper 1 (“66 Pet.”)	Paper 1 (“67 Pet.”)	Paper 1 (“68 Pet.”)
<b>Preliminary Response</b>	Paper 10 (“66 PO Resp.”)	Paper 10 (“67 PO Resp.”)	Paper 10 (“68 PO Resp.”)
<b>Decision to Institute</b>	Paper 12 (“66 Dec.”)	Paper 12 (“67 Pet.”)	Paper 12 (“68 Pet.”)
<b>PO Response</b>	Paper 28 (“66 PO Resp.”)	Paper 24 (“67 PO Resp.”)	Paper 27 (“68 PO Resp.”)
<b>Petitioner’s Reply</b>	Paper 33 (“66 Pet. Reply”)	Paper 29 (“67 Pet. Reply”)	Paper 32 (“68 Pet. Reply”)
<b>Petitioner’s Additional Briefing</b>	Paper 44 (“66 Add’l Br.”)	Paper 40 (“67 Add’l Br.”)	Paper 43 (“68 Add’l Br.”)

<sup>8</sup> The hearing transcript is the same for all three cases.

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<b>Patent Owner's Response to Additional Briefing</b>	Paper 46 ("66 PO Add'l Resp.")	Paper 42 ("67 PO Add'l Resp.")	Paper 45 ("68 PO Add'l Resp.")
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The Board has jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we are not persuaded that Petitioner has shown 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. 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 are unpatentable.

*B. Related Proceedings*

Petitioner indicates that the '704 patent, the '469 patent, and the '121 patent are the subject of the proceedings in *Straight Path IP Group, Inc. v. Samsung Electronics Co., Ltd.*, No. 6:13-cv-00606 (E.D. Tex.). 66 Pet. 1–2; 67 Pet. 1–2; 68 Pet. 1–2. 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 Group, Inc.*, IPR2013-00246 (PTAB), which was reversed and remanded by the United States Court of Appeals for the Federal Circuit. 66 Pet. 1–2; *Straight Path IP Group, Inc. v. Sipnet EU S.R.O.*, 806 F.3d 1356 (Fed. Cir. 2015) ("*Straight Path*") (reversing the determination of unpatentability of certain claims of the '704 patent and remanding for further proceedings consistent with the Federal Circuit's claim construction). The

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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. 66 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. 67 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, it relates to facilitating audio communications over computer networks. 68 Ex. 1001, 1:55–57. The '469 patent and the '121 patent are continuations-in-part of the '704 patent. 67 Ex. 1001 at [63]; 68 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. 66 Ex. 1001, 5:25–38; 67 Ex. 1001, 6:66–7:9; 68 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. 66 Ex. 1001, 5:55–60; 67 Ex. 1001, 7:31–36; 68 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

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database to the first processing unit, i.e., performs a point-to-point Internet protocol communication. 66 Ex. 1001, 5:60–64; 67 Ex. 1001, 7:37–40; 68 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. 66 Ex. 1001, 5:64–67; 67 Ex. 1001, 7:40–43; 68 Ex. 1001, 7:33–36.

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

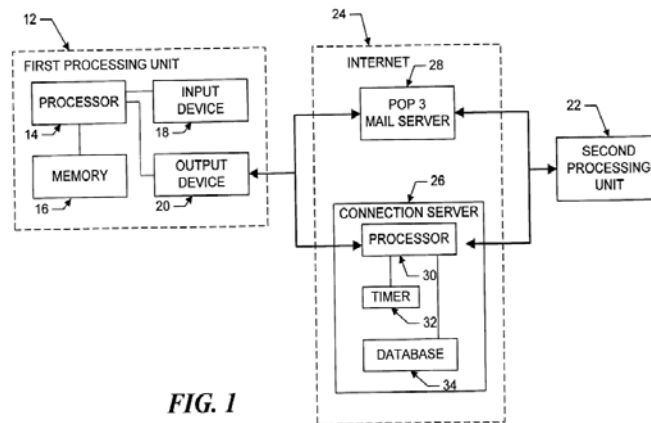


FIG. 1

Figure 1 above illustrates the architecture between first processing unit 12, second processing unit 22, and connection server 26. 66 Ex. 1001, 5:15–29, 67 Ex. 1001, 6:56–7:3; 68 Ex. 1001, 6:50–64.

#### *D. Illustrative Claims*

Petitioner challenges claims 1, 11, 12, 14, 16, 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 6, 8, 10, 11, 13, and 14 of the '121 patent. 66 Pet. 32–55; 67 Pet. 33–54, 68 Pet. 30–58. 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

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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.

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

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;

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<sup>9</sup> Italicized terms and limitations represent amendments to the claims as issued in the Ex Parte Reexamination Certificate. *See* 67 Ex. 1001.



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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 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.<sup>10</sup>

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

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<sup>10</sup> Italicized terms and limitations represent amendments to the claims as issued in the Ex Parte Reexamination Certificate. See 68 Ex. 1001.

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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.

#### *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).

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

1. “*is connected to the computer network*” / “*on-line status*” / “*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, and independent claims 6, 8, 13, and 14 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, 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 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.”

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*Straight Path*, 806 F.3d at 1360.<sup>11</sup> The Federal Circuit held that the query asks “whether the device ‘is’ connected, not whether it was connected or whether it is still registered as being connected even if that registration information is no longer accurate.” *Id.* The Federal Circuit further explained that “[i]t is not a reasonable interpretation of the claim language . . . to say that it is satisfied by a query that asks only for registration information, regardless of its current accuracy.” *Id.* The Federal Circuit explained, “[w]hen claim language has as plain a meaning on an issue as the language does here, leaving no genuine uncertainties on interpretive questions relevant to the case, it is particularly difficult to conclude that the specification reasonably supports a different meaning. The specification plays a more limited role than in the common situation where claim terms are uncertain in meaning in relevant respects.” *Id.* at 1361. Accordingly, the Federal Circuit construed the limitation “is connected to the computer network” as “is connected to the computer network at the time the query is transmitted to the server.” *Id.* at 1363.

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<sup>11</sup> Petitioner argues that the relevant specifications do not include an embodiment that “‘guarantees’ or ‘ensures’ the availability of the second process at any given point in time” and the file histories of the challenged patents “expressly reject[] the notion that the claims contain any guarantee of perfect accuracy.” Add’l Br. 6. In *Straight Path*, the Federal Circuit did not offer a view as to the sufficiency of the written description or enablement based on the claim construction provided by the Federal Circuit because “written-description and enablement challenges were not, and could not have been, part of the inter parties review.” *Straight Path*, 806 F.3d at 1363. We similarly do not offer any determination as to whether this claim construction is supported by the specifications of the ’704 patent, ’469 patent, and the ’121 patent.

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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* 66 Pet. 24–30; 66 PO Resp. 32–35; 67 Pet. 25–31; 67 PO Resp. 30–34; 68 Pet. 24–29; 68 PO Resp. 36–42. 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 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.” 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

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the '704 patent specification did not contradict its claim construction of these terms.

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 running instance of a computer program or application.” PO Resp. 21. Petitioner accepts Patent Owner’s proposed construction. Tr. 7:5–7. 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. 25–35; Pet. Reply 3–13.

In *Ancora Techs.*, 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

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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.

## II. ANALYSIS

### A. *Claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of the '704 Patent, Claims 3, 6, 9, 14, 17, and 18 of the '469 Patent, and Claims 6, 8, 10, 11, 13, and 14 of the '121 Patent*

#### 1. *Overview*

Petitioner contends that claims 1, 11, 12, 22, and 23 of the '704 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual and NetBIOS. 66 Pet. 32–41. Petitioner contends that claims 14, 16, 27, 30, and 31 of the '704 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual, NetBIOS, and Palmer. *Id.* at 41–49. Petitioner contends that claims 3, 6, and 9 of the '469 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual and NetBIOS. 67 Pet. 34–43. Petitioner contends that claims 14, 17, and 18 of the '469 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual, NetBIOS, and Palmer. *Id.* at 43–49. Petitioner contends that claims 6, 8, 10, 11, 13, and 14 of the '121 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual and NetBIOS. 68 Pet. 30–43. We have reviewed the Petition and supporting evidence and find that Petitioner has not shown by a preponderance of the evidence that the challenged claims are unpatentable.

#### 2. *Microsoft Manual (66 Ex. 1012; 67 Ex. 1012; 68 Ex. 1012)*

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

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Windows NT Workstation or Windows NT Server operating system.

Ex. 1012, 3.<sup>12</sup> 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 (66 Ex. 1014; 67 Ex. 1014; 68 Ex. 1014)*

NetBIOS (“Network Basic Input/Output System”) is a software interface that allows applications on different computers to communicate within a computer network, such as a local area network or the Internet, and was originally designed for IBM’s PC-Network. Ex. 1014, 378.<sup>13</sup> NetBIOS applications employ mechanisms to locate resources, establish connections, send and receive data with an application peer, and terminate connections.

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<sup>12</sup> Ex. 1012 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.

<sup>13</sup> 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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*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. *Palmer (66 Ex. 1020; 67 Ex. 1020)*

Palmer discloses multi-way video teleconferencing among networked computer workstations. Ex. 1020, 1:41–45. Palmer discloses a graphical user interface for controlling a video conferencing session, where a session window appears on the user’s workstation monitor when a user invokes the application to begin a video conference. *Id.* at 16:48–65. The session window includes “pushbuttons” that cause the creation of a second level pop-up window to offer the user next level of functional choices associated with the “pushbutton.” *Id.* at 17:3–31. A “connections” pushbutton establishes video teleconference connections between workstations. *Id.* at

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18:36–38. The selection of the “connections” pushbutton causes the creation of a second level “call list” pop-up window that allows a user to add, delete, activate, or modify network video teleconferencing connections to other networked workstations. *Id.* at 18:38–43. To establish a connection with another workstation, a user enters the target workstation host name in to the “network host” field and activates the corresponding “connect” pushbutton. *Id.* at 19:22–27.

### 5. Analysis

As discussed in our claim construction analysis above, claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of the ’704 patent, claims 3, 6, 9, 14, 17, and 18 of the ’469 patent, and claims 6, 8, 10, 11, 13, and 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 Microsoft Manual discloses a first computer queries the WINS server for the address of a second computer, the WINS server determines whether the second computer has been registered, and returns the address of the second computer to the first computer if the second computer has been registered. 66 Pet. 36–37 (citing Ex. 1012, 62–63, 68–69); 67 Pet. 39–40, 47 (citing Ex. 1012, 62–63, 68–69); 68 Pet. 34–36 (citing Ex. 1012, 62–63, 67–69). Petitioner further argues that a computer is registered as active and on-line with the WINS server until “(i) it properly shuts down or (ii) it fails to renew its lease of the IP address.” *Id.* Petitioner also argues that NetBIOS discloses a name query (“discovery” or

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“resolution”) that is initiated by end-nodes to obtain the IP addresses and other attributes associated with a NetBIOS name. *Id.* at 36–38 (citing Ex. 1014, 396).

Patent Owner argues that these descriptions from Microsoft Manual and NetBIOS fail to determine whether a computer or process *is connected to the computer network*. PO Resp. 35, 49–51. In view of our construction of this claim limitation, we agree with Patent Owner. Microsoft Manual 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. 1012, 62–63, 68–69. Microsoft Manual 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. Microsoft Manual 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, Microsoft Manual discloses that the WINS database may include entries of computers that are not currently connected to the WINS network. Accordingly, a query to as to whether a second process “is connected to the computer network” in Microsoft Manual will not determine whether the second process *is connected* to the WINS network *at the time that the query is transmitted to the server*.

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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, 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. Microsoft Manual 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. 1012, 68, 150. As such, we determine that Microsoft Manual 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. 1014, 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

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provided to a requesting node. *See id.* at 409. However, similar to Microsoft Manual, NetBIOS discloses that the information stored by the NBNS may be incorrect, and, therefore, will not determine whether a second process is connected to the computer network at the time that the query is transmitted to the server. Therefore, NetBIOS also does not disclose the claimed “is connected to the computer network,” “on-line status,” or “is accessible.”

Given that the combination of Microsoft Manual 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, 14, 17, and 18 of the '469 patent, and claims 6, 8, 10, 11, 13, and 14 of the '121 patent are unpatentable.

#### *B. Claims 1, 2, 5, and 10 of the '469 patent*

##### *1. Overview*

Petitioner contends that claims 1, 2, and 5 of the '469 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual and NetBIOS, and claim 10 of the '469 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Microsoft Manual, NetBIOS, and Palmer. 67 Pet. 34–42, 47. For claims 1, 2, and 5, Petitioner provides citations for where each claim limitation is disclosed by Microsoft Manual 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

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combined the teachings of Microsoft Manual and NetBIOS. *Id.* We have reviewed the Petition and supporting evidence and find that Petitioner has shown by a preponderance of the evidence that claims 1, 2, and 5 would have been obvious over Microsoft Manual and NetBIOS. *See id.* We also determine that claim 10 depends from a cancelled claim, and, therefore is unpatentable.

## 2. *Analysis – Claims 1, 2, and 5*

Claims 1, 2, and 5 of the '469 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 separately.

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.” 67 Ex. 1001, 67 (1:28–34).<sup>14</sup> Petitioner argues that Microsoft Manual discloses how to install, configure, and troubleshoot Microsoft TCP/IP on a computer running Microsoft Windows NT, the software allows a first computer to communicate with a second computer by

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<sup>14</sup> A Reexamination proceeding amended some of the claims of the '469 and the Ex Parte Reexamination Certificate is included at pages 67 of 67 Ex. 1001.

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querying a server for the address of the second computer, and establishing a direct connection with the second computer using the received second computer address. 67 Pet. 36 (citing 67 Ex. 1012, 3, 62–63). Petitioner further contends that NetBIOS discloses NetBIOS applications that allow for point-to-point communication between nodes. *Id.* at 36–38 (citing 67 Ex. 1014, 378, 384). 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 and NetBIOS includes applications.

Claim 1 further recites “program code for generating a user-interface enabling control of a first process executing on the computer system.” 67 Ex. 1001, 67 (1:35–37). Petitioner argues that Microsoft Manual discloses “software generating multiple user interfaces enabling control of the Windows NT or Windows for Workgroups operation system.” 67 Pet. 37 (citing 67 Ex. 1012, 249). Petitioner argues that, for example, Microsoft Manual discloses that a “Telnet” window is generated to control a “Telnet” session when a user selects the “Telnet” icon or types “telnet <Enter>” at a command prompt, where the “Telnet” window is a user-interface. *Id.*

Claim 1 also recites “program code for determining the currently assigned network protocol address of the first process upon connection to the computer network.” 67 Ex. 1001, 67 (1:38–40). Petitioner contends that Microsoft Manual discloses that a computer receives a dynamically assigned IP address from the server, and the computer registers its dynamically assigned IP address with the WINS server. 67 Pet. 37 (citing 67 Ex. 1012,

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59–63). Petitioner also contends that NetBIOS also discloses that every node has a unique name and IP address. *Id.* (citing 67 Ex. 1014, 384, 395, 417).

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.

67 Ex. 1001, 67 (1:41–47).

Petitioner contends that Microsoft Manual discloses a computer that receives a dynamically assigned IP address from the server, and the computer registers its IP address with the WINS server. 67 Pet. 36–37 (citing 67 Ex. 1012, 62–63). Microsoft Manual specifically discloses that the “WINS server is responsible for knowing computer names and addresses.” 67 Ex. 1012, 62. Petitioner alternatively argues that Microsoft Manual discloses that each IP packet includes the source IP address and destination IP address, and this disclosure in Microsoft Manual also meets the claim limitation. 67 Pet. 37–38 (citing 67 Ex. 1012, 58). 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 36–39 (citing 67 Ex. 1014, 384, 395, 396, 417).

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.” 67 Ex. 1001, 67 (1:48–50). Petitioner



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argues that Microsoft Manual discloses that the first computer goes directly to the second computer upon receiving the address of the second computer. 67 Pet. 38 (citing 67 Ex. 1012, 62–63). Petitioner also argues that NetBIOS discloses the use of point-to-point nodes that communicate using only directed UDP datagrams and TCP sessions. *Id.* (citing 67 Ex. 1014, 384–85). We are persuaded by Petitioner’s contentions with respect to claim 1, and we adopt them as our own.

Petitioner contends that “WINS is an implementation of NetBIOS” and, therefore, Petitioner contends that “one having skill in the art would have known about and been motivated to combine Microsoft Manual with NetBIOS.” *Id.* at 34 (citing 67 Ex. 1004 ¶¶ 88–89). We are persuaded by Petitioner that the combination is reasonable because Microsoft Manual demonstrates that Microsoft TCP/IP has combined the elements of NetBIOS and Microsoft Manual in the same manner in which Petitioner proposes to combine NetBIOS and Microsoft Manual. *See* 67 Ex. 1012, 3, 11. Microsoft Manual discloses that Microsoft TCP/IP for Windows NT provides support for application interfaces, including NetBIOS for establishing logical names and sessions on the network. *Id.* at 11. Microsoft Manual describes that “[w]hen WINS servers are in place on the network, NetBIOS over TCP/IP resolves names on a client computer by communication with the WINS server.” 67 Pet. 34 (quoting 67 Ex. 1012, 62). We are persuaded that Microsoft TCP/IP for Windows NT utilizes NetBIOS features for name resolution, as disclosed by Microsoft Manual, and a person with ordinary skill in the art would have readily combined the disclosures of Microsoft Manual and Microsoft Manual.

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Claim 2 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

67 Ex. 1001, 41:48–54. Petitioner contends that Microsoft Manual discloses a computer that receives a dynamically assigned IP address from the server, and the computer registers its IP address with the WINS server. 67 Pet. 37–38 (citing 67 Ex. 1012, 62–63). Petitioner argues that Microsoft Manual discloses that the first computer goes directly to the second computer upon receiving the address of the second computer. *Id.* at 38 (citing 67 Ex. 1012, 62–63). We are persuaded by Petitioner’s contentions with respect to claim 2, and we adopt them as our own.

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

Patent Owner argues that (a) Microsoft Manual and NetBIOS fail to disclose the “process” elements and (b) Microsoft Manual and NetBIOS fail to disclose “a unique identifier of the first process.” 67 PO Resp. 25–35, 56–57.

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*a. “process” elements*

Claim 1 recites that the assigned network protocol address and the unique identifier of the “first process” is forwarded to the server. 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 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.* Microsoft Manual describes the Windows NT operating system and NetBIOS includes applications. *See* 67 Pet. 36 (citing 67 Ex. 1012, 3, 62–63; 67 Ex. 1014, 378, 384). Furthermore, both Microsoft Manual and 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 Microsoft Manual and NetBIOS fail to disclose a “unique identifier,” as recited by claim 1 of the ’469 patent. 67 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 67 Ex. 2011, 3). Patent Owner contends that Microsoft Manual and

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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 Microsoft Manual and NetBIOS disclose the registration of computer names, and “more than one computer can have the same name.” 67 PO Resp. 57 (citing 67 Ex. 1014, 419). We disagree with Patent Owner. NetBIOS discloses that a “unique name should be held by only one station at a time.” 67 Ex. 1014, 379. Microsoft Manual discloses that “[n]ame registration ensures that the computer’s name and IP address are unique for each device.” 67 Ex. 1012, 68.

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

#### *7. Analysis - Claim 10*

Claim 10, as written, depends from claim 8. 67 Ex. 1001, 43:1–3. Claim 8 was cancelled during the Reexamination proceeding. 67 Ex. 1001, 67 (1:18). During Reexamination, claims 14 and 17 were amended to depend from independent claim 9. *Id.* at 67 (2:15–26, 2:59–60). Claim 10 was not amended and still depends from canceled claim 8. Accordingly, we

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determine claim 10 to be unpatentable because it depends from a cancelled claim.

#### 8. *Conclusion*

We have reviewed the Petition and supporting evidence and find that Petitioner has shown by a preponderance of the evidence that claims 1, 2, and 5 of the '469 patent are obvious over Microsoft Manual and NetBIOS, and claim 10 is unpatentable because it depends from a cancelled claim. Accordingly, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, 5, and 10 of the '469 patent are unpatentable.

### III. CONCLUSION

We are not persuaded that Petitioner has 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, 14, 17, and 18 of the '469 patent, and claims 6, 8, 10, 11, 13, and 14 of the '121 patent are unpatentable.

We are persuaded that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, 5, and 10 of the '469 patent are unpatentable.

### IV. ORDER

Accordingly, it is hereby:

ORDERED that, based on the grounds under review, claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704 C1, claims 3, 6, 9, 14, 17, and 18 of U.S. Patent No. 6,009,469 C1, and claims 6, 8, 10, 11, 13, and 14 of U.S. Patent No. 6,131,121 C1 have not been shown by a preponderance of the evidence to be unpatentable; and

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FURTHER ORDERED that, based on the grounds under review, claims 1, 2, 5, and 10 of U.S. Patent No. 6,009,469 C1 have been shown by a preponderance of the evidence to be unpatentable; and

FURTHER ORDERED that this is a Final Written Decision of the Board under 35 U.S.C. § 318(a), and parties to the proceeding seeking judicial review of this decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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