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Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@law360.com

Straight Path Patents Mostly Survive Samsung-Led AIA Review

By **Matthew Bultman**

Law360, New York (March 7, 2016, 8:00 PM ET) -- The Patent Trial and Appeal Board has upheld the validity of two widely asserted Straight Path IP Group networking patents, dealing a blow to Samsung Electronics Co. Ltd. and other companies accused of infringement.

In a final written decision on Friday, the PTAB ruled that Samsung, Cisco Systems Inc. and Avaya Inc. had failed to prove that any of the disputed claims in the two patents were invalid because they were obvious.

The board's decision, which consolidated six American Invents Act inter partes reviews, also found that just four of the 10 claims challenged in a third Straight Path patent were invalid.

Straight Path, a patent licensing firm, has filed numerous suits over the patents in various courts over the years. It has also engaged in years of litigation at the International Trade Commission over allegedly infringing imports.

The lawsuits have prompted a host of challenges from the accused infringers, including the Samsung group. Separately, a mix of electronics companies, including LG Electronics Inc., and carriers, like Verizon Inc., have launched their own attempt to invalidate certain claims.

The LG group **made arguments** last month before the board and a final decision has yet to be issued. But if the board's ruling Friday is any indication, they could be in for an uphill battle.

William Meunier, an attorney for Straight Path, said many of the issues the board decided Friday overlap with those in the other AIA challenges, as both involve the same three patents and the same core prior art — a 1992 technical standard and 1994 Microsoft Windows user guide.

"We would expect, in light of the decisions last week, that all of the pending [inter partes review] challenges, that the Straight Path patents will outlast those, which will open the door for Straight Path to resume its district court litigation," he said.

A representative for the petitioners could not immediately be reached for comment Monday.

One of the patents involved in Friday's decision — U.S. Patent No. 6,108,704 — was **revived** by the Federal Circuit last November, after it ruled an earlier PTAB panel had misinterpreted the meaning of the word "is" in the claims. It was only the second time the Federal Circuit has reversed a PTAB decision invalidating claims of a patent in an AIA

proceeding.

That case was remanded to the PTAB for further proceedings, where it is still pending. In the Federal Circuit's decision, Circuit Judge Richard G. Taranto wrote that the limitation was central to distinguishing the patent from the prior art.

"The present tense 'is' in 'is connected to the computer network' plainly says 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," the judge wrote.

That issue crept up in Friday's decision, when the board decided that with respect to a vast majority of the challenged claims, Samsung and the others had failed to show that the combination of prior art "teach or suggest the claims as construed."

Three of the claims that were invalidated, all in U.S. Patent No. 6,009,469, were found to be obvious in light of those same prior art references. The fourth was invalid because it depended on a canceled claim.

The patents at issue are U.S. Patent Nos. 6,108,704; 6,009,469; and 6,131,121.

Straight Path is represented by William Meunier, Michael Newman, Michael McNamara, Michael Renaud, James Wodarski, and Nick Armington of Mintz Levin Cohn Ferris Glovsky & Popeo PC.

Samsung and the others are represented by Brian Erickson and Jeff Cole of DLA Piper LLP; and David Cavanaugh and Jason Kipnis of WilmerHale.

The cases are Samsung Electronic Co. Ltd. et al., v. Straight Path IP Group Inc., case numbers IPR2014-013661, IPR2014-013672, and IPR2014-013683, each before the Patent Trial and Appeal Board.

--Editing by Kelly Duncan.