

STRAIGHT PATH IP GROUP, INC. v. SIPNET EU S.R.O., Appeal No. 2015-1212 (Fed. Cir. November 25, 2015). Before Dyk, Taranto, and Hughes. Appealed from P.T.A.B.

Background:

Straight Path owns a patent directed to a "Point-to-Point Internet Protocol." Claim 1 of Straight Path's patent includes a limitation of "program code for transmitting, to the server, *a query as to whether the second process is connected to the computer network*" (emphasis added). Straight Path argued that this limitation refers to a present-tense status of the second process. However, the Board adopted Sipnet's view that this limitation merely requires a query as to whether the second process was active and on-line at registration, regardless of whether the second process is on-line at the time of the query.

In response to Sipnet's petition for *inter partes* review of Straight Path's patent, the Patent Trial and Appeal Board canceled claims 1-7 and 32-42 of Straight Path's patent based on anticipation and obviousness over two prior art references. Straight Path appealed.

Issues/Holdings:

Did the Board err in the claim construction upon which it relied in reaching its decision? Yes, reversed and remanded.

Discussion:

The Federal Circuit looked at the plain language of the claim, which uses the present tense "is" in reciting "is connected to the computer network." The Federal Circuit determined that it is not reasonable to interpret the claim to merely require that the query ask only whether the second process was active and on-line at registration, regardless of whether the second process is on-line at the time of the query.

The Federal Circuit found that the Board improperly turned immediately to the specification without addressing the facially clear meaning of the claim. The Federal Circuit held that unless there is a redefinition or disclaimer in the specification, proper construction must stay true to the claim language. The Federal Circuit found that the specification did not provide such a redefinition or disclaimer.

In a partial dissent, Judge Dyk, relying on the Federal Circuit's 2005 decision in *Phillips v. AWH Corp.*, opined that the specification is always highly relevant to a claim construction analysis. Judge Dyk agreed with the Board's interpretation that "is" merely requires that the query determine whether the second process's connection to the computer network was "relatively current," which he argued is more consistent with the specification than the majority's interpretation.