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Paper 15
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION OF AMERICA; AXIS COMMUNICATIONS AB; AXIS COMMUNICATIONS INC.; and HEWLETT-PACKARD COMPANY
Petitioners

v.

NETWORK-1 SECURITY SOLUTIONS, INC.
Patent Owner

Case IPR2013-00386
Patent 6,218,930

Before JAMESON LEE, JONI Y. CHANG, and JUSTIN T. ARBES, *Administrative Patent Judges.*

ARBES, *Administrative Patent Judge.*

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

Sony Corporation of America, Axis Communications AB, Axis Communications Inc., and Hewlett-Packard Company (collectively, "Petitioners") filed a Petition (Paper 1) ("Pet.") to institute an *inter partes* review of claims 6, 8, and 9 of Patent 6,218,930 (the "'930 patent") pursuant to 35 U.S.C. § 311 *et seq*. and a motion for joinder with Case IPR2013-00071 (Paper 5) ("Mot."). Patent Owner Network-1 Security Solutions, Inc. ("Network-1") has not yet filed a preliminary response to the Petition. We have jurisdiction under 35 U.S.C. § 314. For the reasons that follow, the Board has determined not to institute an *inter partes* review.[1]

I. BACKGROUND

A. Related Matters

Case IPR2013-00071

On December 5, 2012, Avaya Inc. ("Avaya") filed a petition to institute an *inter partes* review of claims 6 and 9 of the '930 patent, asserting five grounds of unpatentability. IPR2013-00071, Paper 1. On May 24, 2013, the Board granted the petition and instituted an *inter partes* review of the '930 patent on the following grounds:

> Claims 6 and 9 under 35 U.S.C. § 102(b) as anticipated by Japanese Unexamined Patent Application Publication No. H10-13576 ("Matsuno"); and
>
> Claims 6 and 9 under 35 U.S.C. § 103(a) as unpatentable over Patent 6,115,468 ("De Nicolo") in view of Matsuno.

IPR2013-00071, Paper 18 at 29. Avaya's request for rehearing as to a portion of the Board's decision was denied. IPR2013-00071, Paper 32.

[1] In a decision entered concurrently, Petitioners' motion for joinder with Case IPR2013-00071 is denied.

The Board entered subsequently a Revised Scheduling Order setting various due dates for the trial. IPR2013-00071, Paper 39.

Case IPR2013-00092

On December 19, 2012, Sony Corporation of America, Axis Communications AB, and Axis Communications Inc. filed a petition to institute an *inter partes* review of claims 6, 8, and 9 of the '930 patent, asserting the following grounds of unpatentability:

> Claims 6, 8, and 9 under 35 U.S.C. §§ 102(a) and (e) as anticipated by Patent 5,991,885 ("Chang");
>
> Claims 6, 8, and 9 under 35 U.S.C. § 103(a) as unpatentable over Patent 5,994,998 ("Fisher") in view of Chang;
>
> Claims 6, 8, and 9 under 35 U.S.C. § 102(b) as anticipated by Patent 5,345,592 ("Woodmas"); and
>
> Claims 6, 8, and 9 under 35 U.S.C. § 102(b) as anticipated by Japanese Unexamined Patent Application Publication No. 6-189535 ("Satou").

IPR2013-00092, Paper 8. On May 24, 2013, the Board denied the petition, concluding that the petitioners had not demonstrated a reasonable likelihood that at least one of the challenged claims is unpatentable based on the asserted grounds. IPR2013-00092, Paper 21. The petitioners' request for rehearing as to a portion of the Board's decision was denied. IPR2013-00092, Paper 24.

B. The '930 Patent (Ex. 1001)

The '930 patent, entitled "Apparatus and Method for Remotely Powering Access Equipment Over a 10/100 Switched Ethernet Network,"

issued on April 17, 2001 based on Application 09/520,350, filed March 7, 2000, which claims priority to Provisional Application 60/123,688, filed Mar. 10, 1999.

C. The Prior Art

Petitioners rely on the following prior art:

1. Patent 5,345,592, issued Sept. 6, 1994 ("Woodmas") (Ex. 1011);

2. Patent 6,473,608, issued Oct. 29, 2002, claims priority to Provisional Application 60/115,628, filed on Jan. 12, 1999 ("Lehr") (Ex. 1014);

3. Japanese Unexamined Patent Application Publication No. H10-13576, published Jan. 16, 1998 ("Matsuno") (Ex. 1016);[2]

4. Patent 6,449,348, issued Sept. 10, 2002, filed May 29, 1997 ("Lamb") (Ex. 1017);

5. Patent 5,982,456, issued Nov. 9, 1999, filed Mar. 25, 1997 ("Smith") (Ex. 1012); and

6. Ron Whittaker, TELEVISION PRODUCTION, pp. 232-56 (1993) ("TELEVISION PRODUCTION") (Ex. 1013).

D. The Asserted Grounds

Petitioners challenge claims 6, 8, and 9 of the '930 patent on the following grounds:

Claims 6, 8, and 9 under 35 U.S.C. § 103(a) as unpatentable over Woodmas in view of Smith and/or TELEVISION PRODUCTION;

[2] We refer to "Matsuno" as the English translation (Ex. 1016) of the original reference (Ex. 1015). Petitioners provided an affidavit attesting to the accuracy of the translation. *See* Ex. 1021; 37 C.F.R. § 42.63(b).

Claims 6, 8, and 9 under 35 U.S.C. § 103(a) as unpatentable over Lehr in view of Woodmas;

Claims 6, 8, and 9 under 35 U.S.C. § 102(b) as anticipated by Matsuno; and

Claims 6, 8, and 9 under 35 U.S.C. § 103(a) as unpatentable over Lamb in view of Matsuno.

II. ANALYSIS

Network-1 argues in its opposition to Petitioners' motion for joinder that the Petition should be denied as time-barred under 35 U.S.C. § 315(b) because Petitioners were served with a complaint alleging infringement of the '930 patent more than one year before filing the Petition in the instant proceeding. IPR2013-00071, Paper 33 at 2. As explained in the Board's decision denying Petitioners' motion for joinder, which is being entered concurrently, the exception in the second sentence of Section 315(b) applies and the Petition is not time-barred. *See* 37 C.F.R. § 42.122(b).

In any event, however, we do not institute an *inter partes* review based on the Petition. In determining whether to institute an *inter partes* review, the Board may "deny some or all grounds for unpatentability for some or all of the challenged claims." 37 C.F.R. § 42.108(b); *see* 35 U.S.C. § 314(a). Upon consideration of Petitioners' motion for joinder and the oppositions filed by Network-1 and Avaya, the Board in a separate decision denies the motion for joinder. *See* Mot.; IPR2013-00071, Papers 33, 35. As explained in that decision, the Petition introduces (1) a new challenged claim, (2) three new grounds of unpatentability, (3) one new ground of unpatentability as to the new challenged claim, and (4) five new prior art

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