UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SONY CORPORATION OF AMERICA and HEWLETT-PACKARD CO.,
Petitioners

v.

NETWORK-1 SECURITY SOLUTIONS, INC.,
Patent Owner

_____

INTER PARTES REVIEW OF U.S. PATENT NO. 6,218,930

Case IPR: *To Be Assigned*

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**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c),
37 C.F.R. §§ 42.22, AND 42.122(b)**

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Sony Corporation of America and Hewlett-Packard Co. ("Petitioners") submit concurrently herewith a Petition for *Inter Partes* Review of U.S. Patent No. 6,218,930 ("the '930 Patent") ("Petition") based on identical grounds that form the basis for two pending and joined IPR proceedings, Case Nos. IPR2013-00071 ("the Avaya IPR") and IPR2013-00385 ("the Dell IPR"), both of which have been joined into a single, joined IPR, Case No. IPR2013-00071 ("the joined IPRs").

Pursuant to 35 US.C. § 315(c), Petitioners respectfully move that this Petition be instituted and joined with the joined IPRs. As the Dell IPR and the Avaya IPR have already been joined, joining the Petition by Petitioners to Dell's IPR will result in a consolidated IPR with four petitioners: Avaya, Dell, Sony, and HP. Petitioners merely request an opportunity to join with the joined IPRs as an "understudy" to Avaya and Dell, only assuming an active role in the event Avaya and/or Dell settle with Network-1. Thus, Petitioners do not seek to alter the grounds upon which the Board has already found support in instituting the joined IPRs, and joinder will have no impact on the existing schedule in the joined IPRs.

I. SPECIAL CIRCUMSTANCES WARRANT JOINDER

The following special circumstances warrant that the Board exercise its discretion and grant this Motion and the Petition, and join the resulting proceeding with the joined IPRs. In the event the Board deems it necessary, Petitioners also submit that the following special circumstances warrant invocation of waiver of

pertinent requirements (most notably the requirement of Rule 42.122 that motions

for joinder be filed no later than one month after the institution date of the IPR for

which joinder is requested) pursuant to Board's authority set forth in Rule 42.5(b):

- **The Petitioners, unlike any other party in related proceedings, have tried multiple times to participate in an inter partes review of the '930 patent.** Prior to filing their previous petition (IPR2013-00386), Petitioners recognized two potential routes to join Avaya's petition: (1) file a copy-and-paste version of Avaya's petition; or (2) raise new grounds of invalidity that—if joinder was denied—might be the grounds for a separate IPR. The Petitioners understood Option 2 to be more likely to succeed, particularly because that previous petition also included an invalidity ground instituted in Avaya's IPR (the 102 *Matsuno* argument). Just days before Petitioners efiled their first IPR and accompanying petition, the Board granted a joinder motion that employed Option 1. Paper No. 10, IPR2013-00256. Ultimately, the Board denied the Petitioners' IPR (in Case No. 386) under Option 2, declining to consider the previous petition for discretionary reasons alone.

- **The Petitioners are uniquely situated, so granting this request will not have lasting effects on future joinder motions.** PTAB decisions

now clearly indicate that Option 1, the copy-and-paste method

(recently used by Dell) is the preferred means to join an instituted

IPR. Thus, all future parties will have notice of the Board's preferred

way to join an IPR.

- **Petitioners will be greatly prejudiced if not joined.** If Network-1

   settles with Dell and Avaya, and if a final decision in the joined IPRs

   is not issued, then Petitioners will have to meet a much higher

   standard (clear and convincing) when arguing invalidity before the

   court than before the Board (preponderance of the evidence).

On the August 5, 2013 call with the Board, counsel for Network-1, counsel

for Petitioners, counsel for Avaya, and counsel for Dell, the Board noted that the

Dell IPR was terminated on the same day it was instituted, and thus the Dell IPR

was no longer available for purposes of being joined. As set forth below in Section

III. B, Petitioners respectfully submit that, since this motion is being filed within

30 days of the date that Dell's IPR was granted, this request is nonetheless timely,

irrespective of the termination of the Dell IPR. As the Dell IPR was joined with

the Avaya IPR, granting this motion will effectively join Petitioners' Petition with

the joined IPRs, which absorbed Dell's IPR.

In the event the Board believes that this motion for joinder is not timely,

Petitioners request a waiver of Rule 42.122 under Rule 42.5 (Conduct of the

proceeding), given the unique circumstances of the instant Motion outlined above.

II.   JOINDER WILL NOT PREJUDICE OR OTHERWISE BURDEN ANY OF THE OTHER PARTIES IN THIS IPR PROCEEDING

Since the Petitioners will minimize any additional cost or burden on other parties, the Board should exercise its discretion to grant Petitioners' request, and, if necessary, invoke its authority to waive the requirements of Rule 42.122.

- **No new arguments are presented.** The Petition asserts, word-for-word, only the arguments that the Board has already instituted in the joined IPRs. Thus, there are no new arguments to consider.

- **No schedule adjustments are necessary.** The only potential deadline that this motion will impact is the Patent Owner's preliminary response to the Petition, and Network-1 has already filed two preliminary responses to identical arguments included in the petitions for the Avaya IPR and the Dell IPR. Thus, Network-1 will not be prejudiced if the Board denies it a third opportunity to respond.

- **Petitioners agree to assume a limited "understudy" role.** As long as both Avaya and Dell remain in the joined IPRs, Petitioners agree to remain in a circumscribed role without a separate opportunity to actively participate. Thus, Petitioners will not file additional written submissions, nor will they pose questions at depositions or argue at oral hearing without the prior permission of Avaya or Dell. Only in

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