UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NETWORK-1 SECURITY SOLUTIONS, INC.
Patent Owner

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Case IPR2013-00071[1]
Patent 6,218,930 B1

Before JONI Y. CHANG, JUSTIN T. ARBES, and GLENN J. PERRY,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

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[1] Cases IPR2013-00385 and IPR2013-00495 have been joined with this
proceeding.

I. BACKGROUND

Petitioner Avaya Inc. ("Avaya") filed a Petition (Paper 1) ("Pet.) seeking *inter partes* review of claims 6 and 9 of U.S. Patent No. 6,218,930 B1 (Ex. 1001) ("the '930 patent") pursuant to 35 U.S.C. §§ 311-19. On May 24, 2013, we instituted an *inter partes* review of claims 6 and 9 on two grounds of unpatentability (Paper 18) ("-71 Dec. on Inst.").

This proceeding involves three other Petitioners in addition to Avaya. Subsequent to institution in Case IPR2013-00071, Dell Inc. ("Dell") filed a petition in Case IPR2013-00385 seeking *inter partes* review of claims 6 and 9 on the same grounds on which a trial was instituted in Case IPR2013-00071, and a motion for joinder with that proceeding. *See* IPR2013-00385, Papers 2, 4, 11. We instituted an *inter partes* review and joined Dell as a party to Case IPR2013-00071 in a limited capacity. *See* IPR2013-00385, Papers 16 ("-385 Dec. on Inst."), 17. Specifically, we ordered Avaya and Dell to file all papers, other than motions not involving the other party, as consolidated filings, and permitted Dell to file an additional paper addressing any points of disagreement with each consolidated filing if necessary. *See* IPR2013-00385, Paper 17 at 11. Over the course of this proceeding, Dell did not file any paper disagreeing with any filing made by Avaya.

Sony Corporation of America ("Sony") and Hewlett-Packard Co. ("HP") also filed a similar petition and motion for joinder in Case IPR2013-00495. *See* IPR2013-00495, Papers 3, 7. We instituted an *inter partes* review and joined Sony and HP as parties to Case IPR2013-00071 in a limited capacity. *See* IPR2013-00495, Papers 12, 13.

Avaya, Dell, Sony, and HP are all Petitioners for purposes of this proceeding. For ease of reference, however, we refer herein to arguments as being made by Avaya, the original Petitioner.

Patent Owner Network-1 Security Solutions, Inc. ("Network-1") filed a Patent Owner Response (Paper 44)[2] ("PO Resp."), and Avaya filed a Reply (Paper 56) ("Reply"). Along with its Patent Owner Response, Network-1 filed a Motion to Amend (Paper 43) ("Mot. to Amend"), proposing substitute claim 10 if the Board determines claim 6 to be unpatentable, and substitute claim 11 if the Board determines claim 9 to be unpatentable. Avaya filed an Opposition to the Motion to Amend (Paper 57), and Network-1 filed a Reply (Paper 65).

Avaya filed a Motion for Observation (Paper 80) ("Mot. for Obs.") on the cross-examination testimony of Network-1's declarant, James M. Knox, Ph.D., and Network-1 filed a Response (Paper 90) ("Obs. Resp.").

Avaya filed a Motion to Exclude (Paper 79) ("Pet. Mot. to Exclude") certain testimony of Dr. Knox submitted by Network-1 with Network-1's Reply to Avaya's Opposition to the Motion to Amend. Network-1 filed an Opposition to the Motion to Exclude (Paper 88), and Avaya filed a Reply (Paper 95). Network-1 also filed a Motion to Exclude (Paper 83) ("PO Mot. to Exclude") the expert report of Dr. Melvin Ray Mercer (Exhibit 1042) submitted by Avaya with its Reply to Network-1's Patent Owner Response. Avaya filed an Opposition to the Motion to Exclude (Paper 91), and Network-1 filed a Reply (Paper 94).

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[2] It appears that Network-1 filed two copies of its Patent Owner Response in the Patent Review Processing System (PRPS) as Papers 42 and 44. Paper 42 will be expunged.

An oral hearing was held on January 9, 2014, and a transcript of the hearing is included in the record (Paper 102) ("Tr.").

We have 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 that follow, we determine that Avaya has not shown by a preponderance of the evidence that claims 6 and 9 of the '930 patent are unpatentable.

A. The '930 Patent

The '930 patent relates to "the powering of 10/100 Ethernet compatible equipment," specifically "automatically determining if remote equipment is capable of remote power feed and if it is determined that the remote equipment is able to accept power remotely then to provide power in a reliable non-intrusive way." Ex. 1001, col. 1, ll. 13-19. The '930 patent describes how it generally was known in the prior art to power telecommunications equipment, such as telephones, remotely, but doing so had not "migrated to data communications equipment" due to various problems, such as the high power levels required by data communications equipment. *Id*. at col. 1, ll. 22-32. The '930 patent describes a need in the art to power data communications equipment remotely and to "reliably determin[e] if a remote piece of equipment is capable of accepting remote power." *Id*. at col. 1, ll. 42-43.

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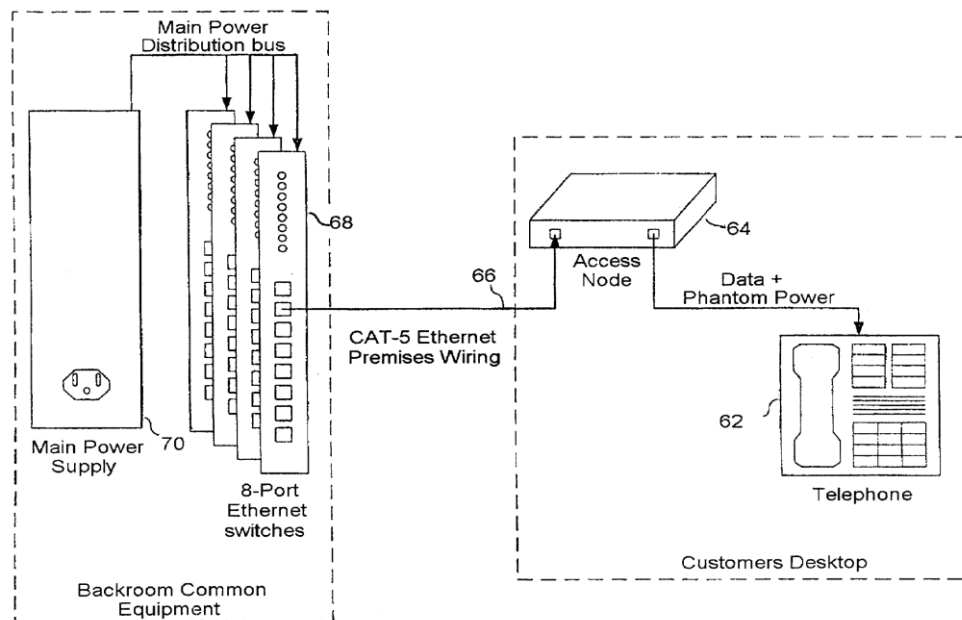Figure 3 of the '930 patent is reproduced below.

Fig. 3

Figure 3 depicts remote telephone 62 capable of receiving and transmitting both voice and data. *Id*. at col. 3, ll. 60-66. Telephone 62 is connected to access node 64 at the customer's premises, and access node 64 is connected to one of the ports of Ethernet switch 68 via wiring 66 comprising "a Category 5 Ethernet 100BaseX cable of 4 sets of unshielded twisted pairs." *Id*. Ethernet switch 68 comprises automatic remote power detector 22 (shown in Figure 1) and remote power supply 34 (shown in Figure 2). *Id*. at col. 4, ll. 1-4.

The preferred embodiment described in the '930 patent operates as follows. A remote access device, such as the telephone shown in Figure 3, normally is powered by "an [alternating current] ac transformer adapter plugged in to the local 110 volt supply," but may or may not be capable of being powered remotely. *Id*. at col. 2, ll. 40-44. The system detects whether the access device is capable of being powered remotely by "delivering a low level current (approx. 20 [milliamperes (mA)])" over existing twisted pairs

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