

Filed on Behalf of NETWORK-1 TECHNOLOGIES, INC.

By: Charles F. Wieland III, Esq.  
Robert G. Mukai, Esq.  
BUCHANAN INGERSOLL & ROONEY PC  
1737 King Street, Suite 500  
Alexandria, Virginia 22314-2727  
Telephone (703) 836-6620  
Facsimile (703) 836-2021  
charles.wieland@bipc.com  
[robert.mukai@bipc.com](mailto:robert.mukai@bipc.com)

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SONY CORPORATION OF AMERICA  
Petitioner

v.

NETWORK-1 TECHNOLOGIES, INC.  
Patent Owner

---

Case CBM2015-00078  
Patent 6,218,930

---

**PATENT OWNER'S PRELIMINARY RESPONSE**

**Table of Contents**

I. Introduction.....1

II. The Board should exercise its discretion and deny Sony’s Petition. ....4

    A. This is Sony’s fourth Petition challenging the ‘930 Patent.....5

    B. Each factor the Board considers when evaluating second-try petitions demonstrates that the Board should deny this Petition. ....6

        1. The Petition should be denied because it presents the same art that Sony presented in its previous petitions.....9

        2. The Petition should be denied because it presents the same arguments that Sony presented in its previous petitions. ....11

        3. The Petition should be denied because Sony improperly attempts to bolster its challenges that were advanced unsuccessfully in its prior petitions. ....21

        4. The Petition should be denied because Sony provides no justification for filing its fourth Petition. ....24

III. The Petition should be denied because the ‘930 Patent is not a Covered Business Method patent. ....26

    A. The controlling legal standard for CBM eligibility. ....26

    B. Application to the ‘930 claims. ....35

    C. The Petition fails to satisfy its burden of demonstrating that the ‘930 Patent is a CBM. ....41

    D. Had the ‘930 Patent fallen under the CBM definition, the claims of the ‘930 Patent would fall within the “technological invention” exception of 37 C.F.R. § 42.301. ....44

IV. Sony is estopped from challenging the previously challenged claims.....47

A.	Sony is estopped because the requirements of 35 U.S.C. section 315(e)(1) are satisfied based on the Final Written Decision in <i>Sony III</i> . .....	47
B.	Sony's "recently discovered Hunter" argument fails.....	51
1.	Problem 1: Old references previously asserted by Sony in <i>Sony I</i> and <i>Sony II</i> are not "newly discovered prior art." .....	52
2.	Problem 2: Sony's representations to the Board that Hunter was "only recently discovered based on amendments in the reexamination that occurred after the prior petitions were filed" are false.....	52
a.	Sony was aware of Hunter and asserted it against the '930 Patent before Sony filed its <i>Sony III</i> Petition and long before the new claims issued. ....	52
b.	Sony's assertions that Hunter could not have been discovered until the new claims issued are also implausible.....	56
C.	Sony's "reasonably raised" argument fails. ....	57
V.	Sony's Petition fails on the merits.....	62
VI.	Conclusion. ....	67

**Exhibit List**

<b>Prior PTAB filings (<i>Sony I</i>, <i>Sony II</i>, and <i>Sony III</i>)</b>	
Exhibit 2001	<i>Sony I</i> : Decision on <i>Inter Partes</i> Review— <i>Sony v. Network-1</i> , IPR2013-00092 Paper 21 (May 24, 2013)
Exhibit 2002	<i>Sony I</i> : Decision Denying Request For Rehearing— <i>Sony v. Network-1</i> , IPR2013-00092 Paper 24 (July 2, 2013)
Exhibit 2003	<i>Sony II</i> : Petition for <i>Inter Partes</i> Review— <i>Sony v. Network 1</i> , IPR2013-00386 (June 24, 2013)
Exhibit 2004	<i>Sony II</i> : Decision on <i>Inter Partes</i> Review— <i>Sony v. Network-1</i> , IPR2013-00386 Paper 15 (July 29, 2013)
Exhibit 2005	<i>Sony III</i> : Petition for <i>Inter Partes</i> Review— <i>Sony v. Network-1</i> , IPR2013-000495 (August 6, 2013)
Exhibit 2006	<i>Sony III</i> : Motion for Joinder— <i>Sony v. Network-1</i> , IPR2013-000495 Paper 7 (August 6, 2013)
Exhibit 2007	<i>Sony III</i> : Exhibit N1-2027 (identifying Hunter as prior art) (excerpts)
Exhibit 2008	<i>Sony III</i> : Decision on <i>Inter Partes</i> Review— <i>Avaya v. Network-1</i> , IPR2013-0071 Paper 103 (May 22, 2014)
<b>Litigation Documents</b>	
Exhibit 2009	Infringement Contentions— <i>Network-1 v. Alcatel-Lucent et al</i> , Case No. 6:11-cv-492-LED (March 26, 2015)
Exhibit 2010	Invalidity Contentions— <i>Network-1 v. Alcatel-Lucent et al</i> , Case No. 6:11-cv-492-LED (December 19, 2012) (excerpts)

Exhibit 2011	Copy of Hunter provided to Network-1 (December 19, 2012)
<b>Other</b>	
Exhibit 2012	American Heritage Dictionary (5 <sup>th</sup> ed. 2011) (“raise”)
Exhibit 2013	Merriam –Webster’s Collegiate Dictionary (11 <sup>th</sup> ed. 2009) (“raise”)

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.