Filed on behalf of Patent Owner Network-1 Security Solutions, Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVAYA INC.
Petitioner

v.

NETWORK-1 SECURITY SOLUTIONS, INC.
Patent Owner

Case IPR2013-00071
Patent 6,218,930
Administrative Patent Judges Jameson Lee, Joni Y. Chang and Justin T. Arbes

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PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION FOR *INTER PARTES* REVIEW FOR U.S. PATENT NO. 6,218,930 PURSUANT TO 35 U.S.C. § 313 AND 37 C.F.R. § 42.107

I. Introduction.

The Patent Owner Network-1 Security Solutions, Inc. respectfully requests that the Board deny the Petition for *Inter Partes* Review filed by Avaya against Network-1's U.S. Patent No. 6,218,930 for two reasons.

Reason 1: The Petition fails to comply with Patent Office regulations because it fails to provide a mandatory claim construction.

A petition for *inter partes* review "must identify … (3) How the challenged claim is to be construed [and] (4) How the construed claim is unpatentable." 37 C.F.R. § 42.104(b), (b)(3)-(4) (emphasis added). For most claim terms, a petitioner could satisfy this requirement by simply stating that the terms have their ordinary and customary meaning to a person of ordinary skill in the art. But when terms do not have an ordinary meaning that can be applied to the prior art, the petitioner must go further and expressly set forth a proposed construction. One such circumstance is when a claimed phrase includes a word of degree (a relative term), such as "smooth," "slow," or "low."

Claim terms that are words of degree have no ordinary meaning apart from "some standard for measuring that degree" found in the specification. *Exxon Research & Engineering Co. v. United States*, 265 F.3d 1371, 1381 (Fed. Cir. 2001) (quoting *Seattle Box Co. v. Indus. Crating & Packaging, Inc.*, 731 F.2d 818,

826 (Fed. Cir. 1984)). Therefore, when a claim uses words of degree, a petitioner must identify a construction that includes the standard for measuring that degree.

A key phrase in steps [b] and [c] of Claim 6 of the '930 Patent (the single independent claim at issue) is "low level current." The word "low" in "low level current" is a word of degree. What is the standard for determining whether a current level is low enough to satisfy this claim element? Unless this question is answered, it is impossible to apply the phrase "low level current" to the prior art and, therefore, impossible for the Board to rule on the Petition. But Avaya's Petition is silent as to how the phrase "low level current" should be construed in the context of the '930 Patent. Accordingly, Avaya's Petition fails to meet the mandated requirements and should be denied.

Reason 2: The Petition fails to meet the minimum required threshold because Avaya does not demonstrate a reasonable likelihood of prevailing as to any challenged claim.

"The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged." 35 U.S.C. § 314(a).

If a material element of a challenged claim is not found in any asserted prior art reference, there is not a reasonable likelihood that the petitioner will prevail

with respect to that claim. If the material element is not found in any reference, no reference can anticipate that claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."). Moreover, if a combination of two (or more) references fails to teach an important claimed element, it is not possible for that combination to render the claim obvious. That is, assuming one of ordinary skill would have thought to combine prior art references, those references would still be missing an important element and therefore, even with the combination, one of ordinary skill would still not possess the invention. *See Microsoft Corp. v. Proxyconn, Inc.*, Case IPR2012-00026 at 19 (P.T.A.B. Dec. 21, 2012) ("To establish obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.") (citing *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)).

Here, when the phrase "low level current" is properly construed, none of Avaya's references disclose the claimed "low level current" and the claimed step [b] in which this phrase is found: "delivering a low level current from said main power source to the access device over said data signaling pair." Rather, as demonstrated below, Avaya's prior art references actually teach away from this element and the claimed step that incorporates this phrase.

In this Response, the Patent Owner: (1) as background, explains the invention claimed in the '930 Patent and the difference between the claimed "low level current" approach and the approach taken in the prior art; (2) demonstrates that Avaya's Petition should be denied for failing to identify a construction for the relative phrase "low level current"; and (3) demonstrates that Avaya's Petition should be denied because, when the phrase "low level current" is applied using the correct construction, none of Avaya's prior art references disclose the claimed "low level current" and the step in which the phrase is found.[1]

II. Background of the '930 Patent.

To understand the importance of "low level current" in Claim 6 of the '930 Patent, it is necessary to understand (a) the invention claimed in the '930 Patent, and (b) the differences between the "low level current" approach claimed in the '930 Patent and the approach taken in the prior art.

A. The '930 Patent.

Generally speaking, the '930 Patent teaches and claims a method in which an Ethernet data node (*e.g.*, switch) determines whether a connected access device

[1] While Avaya's references, two of which are not even analogous art, do not invalidate or establish the unpatentability of the challenged claims for other reasons, this Response only focuses on the missing "low level current" element.

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