

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
U.S. Patent No. 6,218,930

Before the honorable Jameson Lee, Joni Y. Chang, and Justin T. Arbes

AVAYA'S REQUEST FOR REHEARING

I. STATEMENT OF RELIEF REQUESTED

In the “Decision on Institution of *Inter Parties* Review 37 C.F.R. § 42.108” (Paper 18, May 24, 2013) (“Decision”), Grounds 2, 4 and 5 were denied, while Grounds 1 and 3 were granted. Petitioner respectfully requests only a limited rehearing as to Ground 5 based on the combination of Chang (AV-1006) and De Nicolo (AV-1007) (Decision at 24-29).

Accordingly, this Request for Rehearing (“Request”) moves for rehearing of the Board’s decision to deny the Petition as to Ground 5 and for an order which expands the trial to include Ground 5 as a basis invalidating claims 6 and 9 of U.S. Patent No. 6,218,930 (“the ’930 Patent”).¹

II. INTRODUCTION

Chang delivers a low level current in the form of its presence request signal to detect whether a remote terminal (access device) is present. If detected, Chang then controls power (current) to the access device. The Patent Owner agrees that

¹ Separately, Petitioner notes an apparent typographical error in the Decision as to the claim construction of “low level current,” in which an incorrect exemplary current level of approximately “2 mA” is stated at times (Decision at 10, 17 and 23) rather than the correct “20 mA” disclosed in the ‘930 Patent and noted in the Decision at other times. (Decision at 9 (lines 6 and 26)). Clarification is requested.

“Chang actually addresses the problem addressed by the '930 Patent”² Even if Chang is read to do so by using different wire pairs than are used for data transmission in an Ethernet environment, De Nicolo, in such an Ethernet environment, teaches one skilled in the art how current can be supplied to an Ethernet access device *over the same wire pairs used for data transmission*. As such, it would be obvious to modify Chang's Ethernet network connections to supply Chang's low level current and operational power (current) to an Ethernet access device over the same wire pairs used for data transmission based on De Nicolo's teachings. One simple motivation is the savings in wire connections.

The above is the essence of Petitioner's Ground 5, which was amply supported in the Petition and by the declarant, Dr. Zimmerman, as will be discussed below. The Decision erred in denying Ground 5 by not applying De Nicolo in a manner consistent with its own application of De Nicolo with respect to granted Ground 3, which was based on the combination of De Nicolo (AV-1007) in view of Matsuno (AV-1004) (Decision at 18-22). In granting Ground 3, the Board agreed that one reference, Matsuno, could teach the “low level current” limitation found in the “delivering” step of claim 6 (as does Chang), while another reference, De Nicolo, could teach the delivery of current “over the

² Patent Owner's Preliminary Response, page 42.

same data signaling pair” limitation also found in the “delivering” step of claim 6. (Decision at 21). In combination, De Nicolo and Matsuno met the “delivering” step of claim 6.

In parallel fashion, the Petitioner argues in Ground 5 that the combination of Chang and De Nicolo renders claims 6 and 9 obvious, with one reference (Chang) being relied upon for disclosing the “low level current” limitation of the “delivering” step and the second reference (De Nicolo) being relied upon for generally disclosing the delivery of current (albeit operational current)³ over the same data signaling pair, such that Chang and De Nicolo *in combination* also teach the “delivering” step of claim 6.

De Nicolo, in fact, picks up exactly where Chang left off by disclosing a particular approach that would have been obvious to use in order for Chang to deliver both its presence request signal (low level current) and its operational power (perhaps a higher level current) to Ethernet-based devices over the same twisted pair lines used for data transmission. Petitioner’s Ground 5 thus modified Chang with the teachings of De Nicolo showing that “current” generally—whether

³ De Nicolo supplies operational *power* to the Ethernet access devices over the same wire pairs used for data transmission. Power (P), by definition is a function of current, as it is the product of voltage (V) and current (I): $P=VI$.

of a low or high level—may be supplied from Chang's network hub to an additional type of remote access device (i.e., an Ethernet-based device) in a manner which makes efficient use of the same twisted pair lines that are used to provide data. Petitioner respectfully submits that Ground 5, under the same logic applied by the Board with respect to granted Ground 3, should also be included in the trial.

III. ARGUMENTS

A. The Decision Erred In Finding That The Combination Of Chang And De Nicolo Does Not Teach The 'Delivering' Step of Claim 6

The Board concluded that the Petitioner had not met its burden with respect to Ground 5 for two reasons. First, the Board stated that:

“Petitioner has not demonstrated that Chang teaches the claim step of ‘delivering a low level current from said main power source to the access device over said data signaling pair.’ Petitioner also does not argue in the Petition that De Nicolo teaches the missing limitation.”

(Decision at p. 28, lines 6-9) (*emphasis added*).

Second, the Board stated that “Petitioner gives no explanation in the Petition . . . as to why the “delivering” step of claim 6 (missing from Chang) would be obvious based on the combination of Chang and De Nicolo” (Decision at 28). However, as set forth below, the Petitioner did in fact expressly argue that Chang and De Nicolo teach, in combination, the “delivering” step of claim 6, as well as

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