

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

Before JAMESON LEE, JONI Y. CHANG, and JUSTIN T. ARBES,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

An initial conference call in the above proceeding was held on June 18, 2013 between respective counsel for Petitioner and Patent Owner, and Judges Lee, Chang, and Arbes. The purpose of the call was to discuss any proposed changes to the Scheduling Order (Paper 19) and any motions the

parties intend to file. Prior to the call, Petitioner and Patent Owner filed lists of proposed motions (Papers 22 and 23). The following issues were discussed during the call.

Schedule

The parties indicated that they do not have any issues with the Scheduling Order, subject to the Board's decision on Petitioner's request for rehearing (Paper 20) and any motions for joinder that may be filed. Petitioner's request will be decided in due course and no motions for joinder have yet been filed. Patent Owner also indicated that it opposes Petitioner's rehearing request and is prepared to brief the issues contained therein if desired by the Board. No further briefing is authorized.

Motion to Submit Supplemental Information

Petitioner stated that it may want to submit supplemental information, specifically an additional declaration from Dr. George A. Zimmerman regarding the "low level current" limitation of the claims. Petitioner's request is only speculative at this point. Petitioner further did not explain sufficiently during the call why it believes supplemental information is warranted under the circumstances or why such information could not have been presented earlier with its Petition. Thus, Petitioner is not authorized at this time to file a motion to submit an additional declaration from Dr. Zimmerman as supplemental information under 37 C.F.R. § 42.123(a).

Discovery Motions

Petitioner argued that certain materials, including (1) documents showing allegedly inconsistent claim interpretations proposed by Patent Owner in previous litigations involving the challenged patent, and (2) statements made by Patent Owner's Chief Executive Officer, are subject to routine discovery under 37 C.F.R. § 42.51(b)(1) and should be produced by Patent Owner. Petitioner also argued that should the materials not be considered routine discovery, Petitioner would seek them as additional discovery under 37 C.F.R. § 42.51(b)(2). Patent Owner stated that it believes it has provided all routine discovery required by rule, but will look into the specific materials that Petitioner mentioned during the call.

Patent Owner separately raised a concern with draft expert reports and expert communications with counsel. Patent Owner argued that such materials are not discoverable in district court litigation and should not be discoverable in an *inter partes* review, which allows only limited discovery and is designed to be a cost-effective alternative to litigation. Petitioner disagreed, arguing that the Federal Rules of Civil Procedure do not apply in this proceeding and Petitioner should be able to obtain such materials as a matter of fairness because Patent Owner has access to them via the previous litigations, whereas Petitioner, who was not a party to those cases, does not.

As discussed during the call, no motions regarding discovery are authorized at this time. Patent Owner confirmed that it complied with the rules for routine discovery. Petitioner has not presented any evidence indicating that Patent Owner failed to do so or identified any specific materials it believes should have been produced but were not. Further, to the extent Petitioner desires a broad class of information not produced by Patent

Owner as routine discovery, Petitioner has not demonstrated a basis for authorizing a motion for additional discovery as “necessary in the interest of justice” under 35 U.S.C. § 316(a)(5)(B) and 37 C.F.R. § 42.51(b)(2). We refer the parties to the Decision on Motion for Additional Discovery, Case IPR2012-00001, Paper 26, dated March 5, 2013, for a discussion of the relevant factors in determining whether additional discovery in an *inter partes* review is “necessary in the interest of justice.” Petitioner during the call did not articulate how the appropriate factors would apply to the circumstances of this proceeding.

We also encourage the parties, to the extent possible, to make requests for *specific* materials to which the opposing party can respond. The parties should confer and, if the opposing party refuses to produce the specific materials, the requester may arrange a conference call to explain why it believes discovery of those materials is warranted. Of course, the parties are free to agree amongst themselves as to what is and is not discoverable in this proceeding.

Motion to Amend

Patent Owner stated that it may file a motion to amend. As discussed during the call, the parties should note the guidance regarding motions to amend provided in the Board’s Trial Practice Guide and recent decisions, including Case IPR2012-00005, Paper 27, dated June 3, 2013, and Case IPR2012-00027, Paper 26, dated June 11, 2013. Patent Owner is encouraged to request another conference call to discuss specific proposed claim amendments prior to filing a motion to amend.

Patent Owner also asked how proposed amendments should be presented where an independent claim (e.g., claim 1) is being challenged in a proceeding but a dependent claim (e.g., claim 2) is not, and proposed amendments to the independent claim may necessitate changes in the corresponding dependent claims. In that scenario, Patent Owner should present a proposed substitute claim (e.g., claim 3) for the independent claim. The dependent claim not part of the proceeding will remain in the same form as it was issued in the patent, including its dependency from the original independent claim.

*Motions to Exclude Evidence and for Observation
on Cross-Examination*

Both parties indicated that they may file motions to exclude evidence and for observation on cross-examination, but have no specific issues at this time. The Scheduling Order provides due dates for such motions. The parties also were reminded of the obligation to object to evidence by the deadlines listed in 37 C.F.R. § 42.64.

Deposition of Dr. Zimmerman

Patent Owner requested authorization under 37 C.F.R. § 42.53(a) to video-record and submit the deposition of Dr. Zimmerman. Patent Owner argued that it would pay for all costs associated with video recording and that without video, there would be no opportunity to view the witness's testimony later should the Board desire to do so. Petitioner argued that video-recorded testimony is not necessary. By recording the deposition, Patent Owner is only preserving an opportunity for the Board to review the



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