

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 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

A conference call in the above proceeding was held on June 24, 2013 between Judges Chang and Arbes, respective counsel for Petitioner and Patent Owner, and counsel for third party Dell Inc. (“Dell”). Dell requested the call to discuss its intent to file a petition to institute an *inter partes*

review of claims 6 and 9 of Patent 6,218,930 (the “’930 patent”) along with a motion for joinder with this proceeding.

Dell represented during the call that its petition would include only the grounds of unpatentability on which the Board instituted a trial in this proceeding. Dell further stated that it would be filing a declaration from the same declarant as Petitioner, Dr. George A. Zimmerman, and that the declaration would be the same except it would omit the portions of Petitioner’s declaration pertaining to non-instituted grounds. Dell indicated that its joinder would not require any changes to the Scheduling Order (Paper 19) in this proceeding.

Petitioner stated that it opposes Dell’s request for joinder, arguing that joinder of a party on identical grounds would be redundant and would increase the costs to Petitioner due to the additional coordination between the parties that would be required. Petitioner requested that if joinder is granted, similar conditions to those in Case IPR2013-00256, Paper 10, should be imposed, which would allow Petitioner to control this proceeding. Dell had no objection to this request. Patent Owner stated that it also opposes Dell’s request because Dell gave no excuse for its delay in filing, joinder would increase the costs to the parties and diminish the chances of settlement, and joinder is not permitted under 35 U.S.C. § 315.

Subsequently, on June 24, 2013, Dell filed its petition and motion for joinder in Case IPR2013-00385. Dell’s petition in Case IPR2013-00385 includes the grounds of unpatentability on which the Board instituted a trial in this proceeding, as well as the ground that claims 6 and 9 are unpatentable over Chang (Ex. 1006) in view of De Nicolo (Ex. 1007) under 35 U.S.C. § 103(a), which the Board denied. The additional ground is the subject of

Case IPR2013-00071
Patent 6,218,930

Petitioner's pending request for rehearing (Paper 20) in this proceeding.

As discussed during the call, Petitioner and Patent Owner will each be permitted to file an opposition to Dell's motion for joinder by July 1, 2013. The due date for Patent Owner to file a preliminary response in Case IPR2013-00385, should it choose to do so, will be set to July 9, 2013. The Board will then decide Dell's petition and motion for joinder in due course.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file in this proceeding an opposition to Dell's motion for joinder by July 1, 2013, limited to ten pages;

FURTHER ORDERED that Patent Owner is authorized to file in this proceeding an opposition to Dell's motion for joinder by July 1, 2013, limited to ten pages;

FURTHER ORDERED that no replies are authorized; and

FURTHER ORDERED that a copy of this Order be entered into the file of Case IPR2013-00385.

Case IPR2013-00071
Patent 6,218,930

PETITIONER:

Jeffrey D. Sanok
Jonathan Lindsay
CROWELL & MORING LLP
Intellectual Property Group
1001 Pennsylvania Avenue, N.W.
Washington, DC 20004-2595
JSanok@Crowell.com
JLindsay@Crowell.com

PATENT OWNER:

Robert G. Mukai
Charles F. Wieland III
BUCHANAN, INGERSOLL & ROONEY P.C.
1737 King St., Suite 500
Alexandria, VA 22314
Robert.Mukai@BIPC.com
Charles.Wieland@BIPC.com

THIRD PARTY DELL INC.:

Michael J. Scheer
Thomas M. Dunham
WINSTON & STRAWN LLP
200 Park Ave.
New York, NY 10166-4193
mscheer@winston.com
tdunham@winston.com