

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 26, 2013 between Judges Chang and Arbes, respective counsel for Petitioner and Patent Owner, and counsel for third parties Sony Corporation of America, Axis Communications AB, Axis Communications Inc., and Hewlett-Packard

Co. (the “’386 Petitioners”). The purpose of the call was to discuss the ’386 Petitioners’ petition to institute an *inter partes* review of claims 6, 8 and 9 of Patent 6,218,930 (the “’930 patent”) and motion for joinder with this proceeding, which were filed on June 24, 2013 in Case IPR2013-00386.

The ’386 Petitioners stated their position during the call that joinder is proper under 35 U.S.C. § 315(c) and appropriate under the circumstances to ensure the efficient handling of all patentability issues. The ’386 Petitioners argued that this proceeding involves a small number of claims and that they were willing to have consolidated submissions and discovery in a joined proceeding, but acknowledged that the dates set forth in the Scheduling Order (Paper 19) for this proceeding would need to be extended.

Petitioner stated that it has not had enough time to evaluate the ’386 Petitioners’ petition to determine whether Petitioner opposes the motion for joinder, but requested a short time period to file an opposition if necessary. Patent Owner stated that it opposes the motion because joinder would affect the schedule in this proceeding, increase the burden on the parties, diminish the chances of settlement, and potentially affect the stay that has been entered in the related district court litigation.

As discussed during the call, Petitioner and Patent Owner will each be permitted to file an opposition to the ’386 Petitioners’ motion for joinder by July 3, 2013. The oppositions are to be filed separately from any oppositions the parties file to the motion for joinder in Case IPR2013-00385. Patent Owner in its opposition also should address the date(s) on which the ’386 Petitioners were served with a complaint alleging infringement of the ’930 patent. Patent Owner will be given two months to file a preliminary response in Case IPR2013-00386, should it choose to do so.

Case IPR2013-00071
Patent 6,218,930

Finally, given the briefing schedule set during the call regarding the '386 Petitioners' motion for joinder as well as the deposition of Petitioner's declarant scheduled to take place on July 9-10, 2013, Patent Owner requested a one-week extension of its time period for filing a preliminary response in Case IPR2013-00385 (from July 9, 2013 to July 16, 2013). Petitioner opposed the request, arguing that no additional time is needed because the grounds in the petition in Case IPR2013-00385 are duplicative of those raised in the Petition in this proceeding. Patent Owner will be given a three-day extension to July 12, 2013.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file in this proceeding an opposition to the '386 Petitioners' motion for joinder by July 3, 2013, limited to ten pages;

FURTHER ORDERED that Patent Owner is authorized to file in this proceeding an opposition to the '386 Petitioners' motion for joinder by July 3, 2013, limited to ten pages;

FURTHER ORDERED that no replies are authorized;

FURTHER ORDERED that a three-day extension for filing a patent owner preliminary response in Case IPR2013-00385 is authorized; and

FURTHER ORDERED that a copy of this Order be entered into the files of Cases IPR2013-00385 and IPR2013-00386.

Case IPR2013-00071
Patent 6,218,930

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Case IPR2013-00071

Patent 6,218,930

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