

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.*

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

Introduction

Petitioner filed a request for rehearing (Paper 20, “Rehearing Request”) of the Board’s decision (Paper 18, “Decision”) instituting an *inter partes* review of claims 6 and 9 of Patent 6,218,930 (the “’930 patent”). In the Decision, the Board ordered a trial on two grounds of unpatentability asserted in the Petition:

Claims 6 and 9 under 35 U.S.C. § 102(b) as being anticipated by Matsuno (Ex. 1004); and

Claims 6 and 9 under 35 U.S.C. § 103(a) as being unpatentable over De Nicolo (Ex. 1007) in view of Matsuno.

Dec. 29. Petitioner contends that the Board erred in not also instituting a trial based on the combination of Chang (Ex. 1006) and De Nicolo under 35 U.S.C. § 103(a). For the reasons stated below, Petitioner’s request is *denied*.

Analysis

In determining whether to institute an *inter partes* review of a patent, the Board may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b). When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing an abuse of discretion, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

We determined in the Decision that Petitioner had not established a reasonable likelihood of prevailing on its assertion that claims 6 and 9 are unpatentable over Chang in view of De Nicolo under 35 U.S.C. § 103(a). Dec. 24-29. Specifically, independent claim 6 recites the step of “delivering

a low level current from said main power source to the access device over said data signaling pair.” We interpreted “data signaling pair” to mean a pair of wires used to transmit data, and concluded that Petitioner had not shown that Chang discloses the “delivering” step because the wires connected to pins 7 and 8 in Chang, which are used to provide presence request signal 619 (identified by Petitioner as the claimed “low level current”), are not used to transmit data and therefore are not a “data signaling pair.” *Id.* at 12-13, 26-29. We also noted Chang’s disclosure that the reason device presence detector 414 does not use signal lines to send presence request signal 619 is to ensure that the detection signaling “perform[s] detection that is continuous and does not interfere with the normal transmit and receive.” *Id.* at 27 (citing Chang, col. 10, ll. 3-7).

Petitioner does not challenge our claim interpretation or our determination that Chang does not disclose the full “delivering” step of claim 6. Rather, Petitioner contends that the “delivering” step has “two distinct sub-limitations” and that Petitioner relied on De Nicolo for one of those limitations. Rehearing Req. 6-10. Petitioner asserts that Chang discloses the portion of the “delivering” step dealing with “low level current” and De Nicolo discloses the other portion dealing with “over said data signaling pair.” *Id.* According to Petitioner, this was the “essence” of Petitioner’s asserted ground of unpatentability based on Chang and De Nicolo, which the Board overlooked. *Id.* at 2-3. Petitioner further disputes the Board’s conclusion that Petitioner had not shown sufficient support for why it would have been obvious to combine the teachings of Chang and De Nicolo, given the “sub-limitation” argument allegedly made in the Petition. *Id.* at 10-12 (citing Dec. 28).

We could not have misapprehended or overlooked something not explained adequately in the initial Petition. Petitioner addressed the “delivering” step of claim 6 with respect to the asserted ground of unpatentability based on Chang and De Nicolo at two points in its Petition: in an introductory discussion on page 51 and in a claim chart section on page 56. Petitioner explained on page 51 of the Petition (emphasis added):

In Chang, the presence detector in the network hub sends a presence request signal over the twisted pair cable to the remote terminal. *See infra* § V.E.3, claim element 6(b). Chang’s presence request signal is a modulated form of an electrical current flowing through the wires, and therefore would be understood by a PHOSITA as a low level current. *See Ex. AV-1011, ¶ 82. Therefore, Chang discloses “delivering a low level current from said main power source to the access device over said data signaling pair.”*

Similarly, in the claim chart section devoted to the “delivering” step on page 56, the only prior art reference cited by Petitioner was Chang. Petitioner in the claim chart also referenced its earlier Section V.C.3, “claim element 6(b),” of the Petition, but that section argues that the “delivering” step is disclosed by Matsuno. *See Pet. 43, 56.* Thus, in both of these discussions in the Petition, which address the “delivering” step directly, Petitioner relied on Chang alone, not Chang for one portion of the step and De Nicolo for another. Moreover, contrary to Petitioner’s position now that the “delivering” step should be viewed as two distinct “sub-limitations,” the relevant portions of the Petition address the “delivering” step as a single limitation “(b)” allegedly taught by Chang. *See id.* at 51, 56. This is in contrast to the “providing” step of claim 6, which Petitioner divided into sub-limitations “(a1)” to “(a5)” and analyzed separately throughout the Petition. *See, e.g., id.* at 53-56.

In support of its view that the Board overlooked its “sub-limitation” argument regarding Chang and De Nicolo, Petitioner cites other portions of the Petition. These portions, however, are directed to other steps of claim 6 or other combinations of references. *See, e.g.*, Rehearing Req. 6-10 (citing Pet. 49-50 (addressing the “providing” step), 39 (Section V.C.2 addressing the combination of De Nicolo and Matsuno), and 42 (addressing the “providing” step as to the combination of De Nicolo and Matsuno)). They do not explain clearly the position now advocated by Petitioner, i.e., that Chang discloses the “low level current” aspect of the “delivering” step and De Nicolo discloses the “over said data signaling pair” aspect. Petitioner also points to paragraphs 80-81 of the Declaration of Dr. George A. Zimmerman (Ex. 1011). Rehearing Req. 11-12. These paragraphs, however, were cited in the Petition’s discussion of the “providing” step of claim 6, not in the context of the “determining” step. Pet. 49-50. Moreover, the mere citation to these paragraphs does not demonstrate that Petitioner made its “sub-limitation” argument in the Petition itself.

It is not for the Board to attempt to piece together a petitioner’s position based on other, unrelated arguments in a petition, particularly in circumstances like this where the most relevant portions of the Petition state clearly that Chang discloses the entire “delivering” step. A request for rehearing is not an opportunity to supplement the initial Petition. *See* 37 C.F.R. § 42.104(b)(4) (a petition must identify “[h]ow the construed claim is unpatentable under the statutory grounds identified” and “where each element of the claim is found in the prior art patents or printed publications relied upon”).

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