
From: Desperrt, Sonja [<mailto:Sonja.Desperrt@USPTO.GOV>] **On Behalf Of** Trials
Sent: Monday, July 01, 2013 5:39 AM
To: Cook, Elliot; Trials
Cc: 'robert.mukai@bipc.com'; 'charles.wieland@bipc.com'; Greg Dovel; Lavenue, Lionel; Gramenopoulos, C. Gregory; Weisenberger, Theresa; 'rwalters@mwe.com'; 'chawkins@mwe.com'; 'Gabriel, Ray'
Subject: RE: IPR2013-00071 & IPR2013-00386 - U.S. Patent No. 6,218,930

Counsel,

This is an improper submission and in the future you need to seek authorization from the Board prior to submitting something like this. If you have any further questions, please contact the Board.

Regards,
Sonja Desperrt

From: Cook, Elliot [<mailto:Elliot.Cook@finnegan.com>]
Sent: Wednesday, June 26, 2013 9:36 PM
To: Trials
Cc: 'robert.mukai@bipc.com'; 'charles.wieland@bipc.com'; 'greg@dovellaw.com'; Lavenue, Lionel; Gramenopoulos, C. Gregory; Weisenberger, Theresa; 'rwalters@mwe.com'; 'chawkins@mwe.com'; 'Gabriel, Ray'
Subject: IPR2013-00071 & IPR2013-00386 - U.S. Patent No. 6,218,930

Dear Members of the Patent Trial and Appeal Board,

Further to today's call in IPR2013-00071 and IPR2013-00386, Petitioners Sony, Axis, and HP provide, for the Board's reference and Network-1's counsel, the legislative history mentioned during that call. A copy is also provided.

"Sections 315(c) and 325(c) allow joinder of inter partes and post-grant reviews. The Office anticipates that joinder will be allowed as of right—if an inter partes review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments. If a party seeking joinder also presents additional challenges to validity that satisfy the threshold for instituting a proceeding, the Office will either join that party and its new arguments to the existing proceeding, or institute a second proceeding for the patent. The Director is given discretion, however, over whether to allow joinder. This safety valve will allow the Office to avoid being overwhelmed if there happens to be a deluge of joinder petitions in a particular case." 157 Cong. Rec. S1360, S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

Additionally, an issue was raised concerning the six references in the petition; namely, *Woodmas*, *Television Production*, *Smith*, *Lehr*, *Matsuno*, and *Lamb*. Of these references, *Woodmas*, *Lehr*, *Matsuno*, and *Lamb* were charted and/or listed in the December 2012 Invalidity Contentions served on Network-1 in the underlying litigation. In addition, *Woodmas*

and *Matsuno* are included in the other IPRs (IPR2013-00092 and IPR2013-00071) to which Network-1 has already provided their Preliminary Response. Thus, at most, only two references (*Television Production* and *Smith*) could possibly be new.

Best regards,
Elliot

Elliot C. Cook
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