

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
U.S. Patent No. 6,218,930

Before the honorable Jameson Lee, Joni Y. Chang, and Justin T. Arbes

**PETITIONER AVAYA INC'S RESPONSE TO MOTION
FOR JOINDER FILED BY THIRD PARTIES
SONY CORPORATION OF AMERICA, AXIS COMMUNICATION AB,
AXIS COMMUNICATIONS INC., AND HEWLETT-PACKARD CO.**

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I. INTRODUCTION

Pursuant to the Board's Order in Paper No. 27, Petitioner Avaya Inc. ("Avaya") partially opposes the Motion for Joinder of Sony Corporation of America ("Sony"), Axis Communications AB, Axis Communications Inc. (both Axis entities, "Axis"), and Hewlett-Packard Co. ("HP") (collectively, "the '386 Petitioners"). As set forth in greater detail below, Avaya opposes the joinder of HP, but consents to the joinder of Sony and Axis.

First, pursuant to 35 U.S.C. § 315(b), the '386 Petition, while timely for Sony and Axis, is untimely for HP. Accordingly, the joinder must be denied with respect to HP on that basis. Second, HP failed to act diligently in filing a petition, and the Board should deny the joinder request with respect to HP on those grounds. Finally, if the Board grants the '386 Petitioners' Motion, either in whole or in-part, Avaya requests the adoption of specific conditions identified in Section II.D., *infra*, to minimize the disruption to this Proceeding.

II. ARGUMENT

A. Factual Background

In the district court infringement action, Sony was served on December 19, 2011; Axis was served on December 27, 2011; and HP was served on December 15, 2011. *See* Exs. AV-1023, AV-1024 and AV-1025.

On December 19, 2012, Sony and Axis filed their first petition (“the ’092 Petition”) seeking an IPR review of Patent 6,218,930 (“the ’930 patent). *See* IPR2013-0092, Paper No. 9. Sony and Axis filed the ’092 Petition one year before Patent Owner Network-1 Security Solutions, LLC (“Network-1”) served either Sony or Axis with its complaint, and thus the petition was “properly filed.” *See* Section II.A, *supra*. The Board determined not to institute a proceeding in the ’092 Petition, and recently denied a request for rehearing. *See* IPR2013-0092, Paper Nos. 21 and 24. HP was not a petitioner to the ’092 Petition, and did not file any petitions on its own.

On June 24, 2013, Sony and Axis filed its second petition (“the ’386 Petition”). HP is also named as a petitioner, for the first time, in the ’386 Petition. HP’s petition is thus filed more than 18 months after Network-1 served HP with a complaint for infringement of the ’930 patent.

B. The ’386 Petition Is Untimely For HP, Timely For Sony and Axis

The ’386 Petitioners collectively assert that they timely filed because they filed within one month after the Board granted the petition in this proceeding (“’071 Petition”). *See* ’386 Petitioners’ Motion, p. 5.

Section 315(b)-(c) of Title 35 defines IPR petition timeliness:

(b) . . . An inter partes review may not be instituted if the petition requesting the proceeding is filed more than *l*

year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a *request for joinder* under subsection (c).

(c) JOINDER. - If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who *properly files a petition* under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(b)-(c) (emphasis added).

The plain language in subsection (b) mandates that an IPR petition is barred if filed more than one year after the petitioner was served with a complaint alleging infringement of the patent. While the final sentence of subsection (b) states that the one-year bar “shall not apply to a request for joinder under subsection (c),” that sentence relates to “*requests* for joinder,” not the filing of a new petition. But only a person who “*properly files a petition* under section 311” can request joinder. *See* 35 U.S.C. § 315(c); *see* also IPR2013-00319, Paper No. 16 (including authorities cited within). Put another way, a condition *precedent* to a request for joinder is that the party in question already have properly filed a petition (*i.e.*, a petition filed

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