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Paper 38
Entered: July 22, 2013

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.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call in the above proceeding was held on July 19, 2013 between Judges Lee, Chang, and Arbes and respective counsel for Petitioner and Patent Owner. The call was initiated by Patent Owner to discuss a contingent motion to amend claims.

Patent Owner indicated that in its motion to amend it may propose new claims 10 and 11, with both claims contingent on independent claim 6 being determined unpatentable. Claim 10 would include all of the limitations of independent claim 6 and add a new limitation that Patent Owner believes distinguishes over the prior art. Claim 11 would depend from claim 10 and add the limitations of current claim 9. The Board explained that in this circumstance, claims 10 and 11 both would be considered substitutes for claim 6 because they contain all of the limitations of claim 6 and the only other challenged claim, claim 9, is being left unchanged. The presumption, however, is that "only one substitute claim would be needed to replace each challenged claim." 37 C.F.R. § 42.121(a)(3). Thus, as discussed during the call, Patent Owner would need to demonstrate a special circumstance for replacing challenged claim 6 with more than one claim. *See* IPR2012-00027, Paper 26 at 4-6. Patent Owner also would need to show a patentable distinction of additional claim 11 over claim 10, otherwise a special circumstance justifying more than one additional claim likely does not exist. *See id*. at 8-10.

Patent Owner further should explain in its motion why the new claims are patentable over not just the prior art of record, but also prior art not of record but known to Patent Owner. *See id*. at 7. This includes addressing the basic knowledge and skill set possessed by a person of ordinary skill in the art even without reliance on any particular item of prior art. To illustrate, if a feature Z is proposed to be added to a claim to render it patentably distinct from the prior art, it would be essential for Patent Owner to establish the significance of feature Z from the perspective of the level of ordinary skill in the art. It is of little value only to state that no prior art

teaches or suggests multiple claim elements including feature Z. Such a statement masks the specific issue concerning the significance of feature Z from the perspective of a person of ordinary skill in the art.

Instead, it would be helpful for Patent Owner to focus first on feature Z and indicate whether feature Z was known in any context, and if so, then explain why that context is so remote or different from that of the claimed invention that one with ordinary skill in the art would not have applied that teaching to arrive at the claimed invention. Similarly, it would be helpful to know why one with ordinary skill in the art would not have adapted relevant basic or general techniques taught in textbooks in the field of the invention to the particular use required by the claimed invention.

The Board also alerted the parties during the call that the due dates in the Scheduling Order would be extended by two weeks so that the Board may consider the joinder issues presented in Cases IPR2013-00385 and IPR2013-00386.

In consideration of the foregoing, it is hereby ORDERED that Patent Owner has met the requirement to confer with the Board prior to filing a motion to amend claims under 37 C.F.R. § 42.121(a).

Case IPR2013-00071
Patent 6,218,930

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