Filed on behalf of Patent Owner Network-1 Security Solutions, Inc.

By: Robert G. Mukai, Esq.
BUCHANAN INGERSOLL & ROONEY PC
1737 King Street, Suite 500
Alexandria, Virginia 22314-2727
Telephone (703) 836-6620
Facsimile (703) 836-2021
robert.mukai@bipc.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVAYA INC. and DELL INC.
Petitioners

v.

NETWORK-1 SECURITY SOLUTIONS, INC.
Patent Owner

Case IPR2013-00071[1]
Patent 6,218,930
Administrative Patent Judges Jameson Lee, Joni Y. Chang, and Justin T. Arbes

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PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTION FOR JOINDER FILED IN IPR2013-00495

[1] Case IPR2013-00385 has been joined with this proceeding.

Sony and Axis filed an IPR Petition. IPR2013-00092. The Board rejected it on the merits. Sony and Axis brought a motion for rehearing. It was denied by the Board. Sony, Axis, and HP, tried to institute a second late-filed IPR (IPR2013-00386) and join it into the existing Avaya IPR (IPR2013-00071). Because their proposed IPR would dramatically expand the scope of the Avaya IPR, increase complexity, and cause significant delays, the Board denied their motion and IPR Petition. Sony and HP are now petitioning a third time and again moving to join their proposed IPR with the existing Avaya IPR. As the moving party, Petitioners have the burden of establishing that they are entitled to the requested relief. 37 C.F.R. § 42.20(c). Petitioners cannot satisfy this burden and their Motion and Petition should be denied for at least two reasons.[1]

I. Reason 1: Petitioners' Motion is time barred.

A. Petitioners' Motion is time barred because it was filed more than one month after the institution date of the IPR for which joinder is requested.

The controlling regulation states that a "request for joinder must be filed … no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b) (emphasis added). Petitioners are requesting to join the Avaya '071 IPR. Mot. at 1. The institution date of the Avaya '071 IPR was May 24, 2013. Petitioners' pending motion was filed August

[1] Avaya may identify additional reasons in its opposition to this Motion.

6, 2013. Accordingly, Petitioners' filing is "later than one month after the institution date of [the IPR] for which joinder is requested" and is time barred under Rule 42.122(b).

B. Petitioners' argument that their Motion is timely fails.

Petitioners argue that their Motion is timely because it was filed within one month of the date that the Dell '385 IPR was instituted. Mot. at 9. The controlling rule clearly states that "request for joinder must be filed . . . no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b) (emphasis added). The institution date of the Dell IPR would only be relevant if the Petitioners were moving to join the Dell IPR. Petitioners cannot move to join the Dell IPR because it was terminated. Mot. at 3 ("the Board noted that the Dell IPR was terminated"). Because they are not moving to join the Dell IPR, their argument fails.

Petitioners' argument would only have merit if the Rule were redrafted to include the following addendum: "…or that has been terminated and joined with the *inter partes* review for which joinder is requested." Petitioners' attempt to redraft the Rule fails. As with statutes, if a reading of a rule is not found in the text of the rule and is contrary to the purpose of the rule, then that reading is incorrect. *See United States v. James*, 478 U.S. 597, 606 (1986) ("the language of the statute itself must ordinarily be regarded as conclusive" unless there is "a clearly

expressed legislative intention to the contrary"); *Alaska Trojan P'ship v. Gutierrez*, 425 F.3d 620, 628 (9th Cir. 2005) ("An agency's interpretation of a regulation must conform with the wording and purpose of the regulation."); *Pfizer, Inc. v. Heckler*, 735 F.2d 1502, 1507 (D.C. Cir. 1984) (finding that a reading of a rule was incorrect because it followed neither the text nor purpose of the rule). Petitioners' reading of Rule 42.122(b) is not found in the text and is contrary to its purpose.

First, Petitioners' reading is not found in the text of Rule 42.122(b). The Rule clearly states that the relevant institution date is "the institution date of any *inter partes* review for which joinder is requested." The text of the Rule makes no reference to terminated IPRs or IPRs that were previously joined to an IPR for which joinder is requested.

Second, Petitioners' reading is contrary to the purpose of Rule 42.122(b). Deadlines provide predictability in an IPR and ensure the timely and efficient administration of the proceeding, consistent with the purpose of the regulations. 35 U.S.C. § 316(b). Under Petitioners' reading, future petitioners in multi-defendant litigation could prolong IPRs by joining another party's IPR every month, ignoring the deadlines, adding costs, and reducing efficiency – all of which are contrary to the purpose of the deadlines. Accordingly, Petitioners' redraft of Rule 42.122(b) is incorrect.

C. Rule 42.5(b) is not a basis for waiving the Rule 42.122(b) time bar in this case.

Petitioners argue that the Board, under Rule 42.5(b), should waive the time bar. Mot. at 1-2. Rule 42.5(b) provides: "The Board may waive or suspend a requirement of parts 1, 41, and 42 ..." 37 C.F.R. § 42.5(b). In general, it might be appropriate for an agency to waive a promulgated rule if there are (1) "special circumstances" that (2) "warrant a deviation from the general rule" and (3) "such deviation will serve the public interest." *Northeast Cellular Tel. Co., L.P. v. FCC*, 897 F.2d 1164, 1166 (D.C. Cir. 1990). Here, none of these three conditions exist.

1. Petitioners' circumstances are not "special circumstances."

In general, "special circumstances" are circumstances that would not have been contemplated during the creation of a rule and therefore justify an exception. Here, the circumstances (as identified by Petitioners) are that Petitioners "have tried multiple times to participate in an inter partes review" but the Board denied their Petitions. Mot. at 2. The Rules contemplate that some petitions would be denied. 37 C.F.R. 42.71(a) ("The Board …may . . . deny . . . any petition"). The Rules also contemplate that losing petitioners may still want to participate in an IPR. *See* 37 C.F.R. 42.71(d) (rehearing rule). The legislative history also demonstrates that late-filed motions for joinder were specifically considered and addressed. 157 Cong. Rec. §5429 (daily ed. Sept. 8, 2011) ("[T]he Office has made clear that it intends to use this authority to encourage early requests for

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