

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AVAYA INC., DELL INC., SONY CORPORATION OF AMERICA,  
and HEWLETT-PACKARD CO.

Petitioners

v.

NETWORK-1 SECURITY SOLUTIONS, INC.

Patent Owner

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Case IPR2013-00071<sup>1</sup>  
Patent 6,218,930

Before JONI Y. CHANG, JUSTIN T. ARBES, and GLENN J. PERRY,  
*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 October 15,  
2013 among respective counsel for Petitioners and Patent Owner, and Judges

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<sup>1</sup> Cases IPR2013-00385 and IPR2013-00495 have been joined with this proceeding.

Arbes and Perry.<sup>2</sup> The call was requested by Patent Owner to seek authorization to file a second motion to amend. Patent Owner's first motion to amend (Paper 43) was filed on August 7, 2013.

Patent Owner stated that its second motion to amend would make one change to its proposed substitute claim 10, in particular changing the added limitation "determining whether the access device is capable of accepting remote power based on the sensed voltage" to "determining whether the access device is capable of accepting remote power based on the sensed voltage *level*." Patent Owner stated that during the deposition of Patent Owner's declarant, Dr. James Knox, counsel for Petitioners appeared to take issue with the original "sensed voltage" language as lacking proper antecedent basis. Therefore, while Patent Owner does not believe any change is necessary for the proposed substitute claim to have proper antecedent basis, Patent Owner's revised language would eliminate the potential issue. Patent Owner argued that good cause exists for a second motion to amend because Patent Owner took immediate steps to rectify the issue following the deposition and Petitioners would not be prejudiced by the minor change. Patent Owner also cited the Board's decision in Case CBM2013-00005, Paper 44, as supporting its position.

Avaya opposed Patent Owner's request, arguing that the Board's rules provide for only a single motion to amend and Patent Owner has not shown good cause for an additional motion. According to Avaya, there is a substantive difference between "sensed voltage" and "sensed voltage level"

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<sup>2</sup> A court reporter was present on the call. Petitioner Avaya Inc. ("Avaya") shall file the transcript of the call in due course as an exhibit in this proceeding.

such that the change is not merely correcting a typographical error. Avaya further argued that it would be prejudiced substantially if the Board were to grant Patent Owner's request because Avaya's opposition to the motion to amend is due on October 22, 2013, and permitting a second motion would delay the proceeding. After hearing from the parties, the Board took the matter under advisement.

A patent owner in an *inter partes* review is permitted one motion to amend. 37 C.F.R. § 42.121(a). An additional motion to amend may be authorized by the Board, but only when "there is a good cause showing or a joint request of the petitioner and the patent owner to materially advance a settlement." 37 C.F.R. § 42.121(c). Factors that the Board considers in determining whether to authorize an additional motion to amend include "whether a petitioner has submitted supplemental information after the time period set for filing a motion to amend," "the time remaining for the trial, the degree to which the additional evidence impacts the patentability of the claims being sought to be amended, and whether the additional evidence was known to the patent owner before the time period [for filing the motion to amend]." Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012).

Under the circumstances, we are not persuaded that good cause exists for a second motion to amend. No supplemental information or new evidence was submitted by Avaya after Patent Owner filed its motion to amend. Rather, Patent Owner's request appears to be based solely on the questions posed to Dr. Knox during his deposition. Permitting Patent Owner an additional motion to amend also would require delaying the remainder of the trial schedule, including the upcoming October 22, 2013 due date for

Avaya's opposition. *See* Paper 51 (Revised Scheduling Order). It also would require a second deposition of Dr. Knox, who testified regarding the language in Patent Owner's original motion to amend, not the proposed revised language.

Further, at least according to Avaya, there is a substantive difference between "sensed voltage" and "sensed voltage level." The facts in this proceeding, therefore, are different from those presented in Case CBM2013-00005, Paper 44, where the revised claim amendments merely corrected "typographical errors" and changed "a" to "the" to recite proper antecedent basis.

Finally, Patent Owner has not articulated sufficiently why the instant situation is any different from the typical scenario contemplated by the rules where a patent owner files a motion to amend with added claim language, the petitioner files an opposition arguing that the new language is improper for some reason, and the patent owner files a reply responding to those arguments. The fact that Avaya takes issue with Patent Owner's proposed substitute claims is not reason by itself to permit Patent Owner a second motion to amend. As set forth in the Scheduling Order, Patent Owner will have the opportunity to respond to Avaya's arguments in its reply to Avaya's opposition.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request is denied and Patent Owner is not authorized to file a second motion to amend.

Case IPR2013-00071  
Patent 6,218,930

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