

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NETWORK-1 SECURITY SOLUTIONS, INC.
Patent Owner

CASE IPR2013-00071
U.S. Patent No. 6,218,930

Before the Honorable Joni Y. Chang, Justin T. Arbes, and Glenn J. Perry

OPPOSITION TO PATENT OWNER'S MOTION TO AMEND
UNDER 37 C.F.R. § 42.121

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I. Introduction

The Board should deny a motion to amend unless it:

- (1) shows that the added feature(s) distinguish the prior art of record;
- (2) shows that the added feature(s) distinguish other known prior art;
- (3) ensures that no claim is broadened in any way; and
- (4) addresses the basic skill level in the art.

Regarding the first and second requirements, the patent owner bears the burden of: “com[ing] forward with technical facts and reasoning about those [added] feature(s), including construction of new claim terms, sufficient to persuade the Board that the proposed substitute claim is *patentable over the prior art of record*, and *over the prior art not of record but known to the patent owner*.” *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00026, Paper 26 at p. 7 (*emphasis added*).

Network-1's claim 10 proposes the following two amendments:

- to specify that the data network and data node used in the method are “*Ethernet*” components (“Ethernet amendments”); and
- to add a step of “*determining whether the access device is capable of accepting remote power based on the sensed voltage*” (“determining step”).

For the “Ethernet amendments,” Network-1 offers no argument to distinguish Ground 2 (De Nicolo in view of Matsuno). And, Network-1 fails to

address how or why the “Ethernet amendments” are not obvious over Ground 1 (Matsuno).

For the “determining step,” Network-1’s argument: (1) hinges on an improper construction of the phrase “capable of accepting,” which lacks support in the ’930 patent; and (2) attempts to shift the focus away from the *added step*, and onto *other limitations* of claim 6—admitting that the added step was known.

Regarding the third requirement, the “determining step” broadly recites “voltage” instead of the “sensed” narrower feature of “voltage *level*.” This scope change, which Dr. Knox, agrees was not a mistake, impermissibly broadens the claim. Moreover, there is not an adequate written description to conclude that the inventors had possession of the broader invention.

Finally, regarding the fourth requirement, Network-1 fails to even acknowledge the basic skill level despite warnings from the Board that motions which fail to specifically consider skill level are unlikely to be successful.

Because Network-1’s Motion fails to satisfy *each* or even *any* of the requirements, along with 35 U.S.C. § 112, ¶ 1, it must be denied.

II. Requirement 1: Amendments Fail To Distinguish Prior Art Of Record

A. The “Ethernet Amendments” Fail To Distinguish Ground 2

Network-1’s Motion wrongly contends that “each proposed amendment directly responds to the two grounds of unpatentability.” Motion at 8. Its Motion,

however, makes no showing how the "Ethernet amendments" distinguish Ground

2. In fact, Dr. Knox agrees the "Ethernet amendments" do nothing to overcome it:

10	Q	The claims have been proposed to be amended in
11		two ways, adding "Ethernet" to "data network" and
12		"Ethernet" to "data node."
13	A	I agree.
14	Q	Do those two amendments distinguish the
15		combination of Matsuno and De Nicolo in any way?
16		MR. LYON: Objection. 403.
17		THE WITNESS: If I understand what you're
18		asking, no, they don't change anything, because De
19		Nicolo discloses Ethernet systems that still are of the
20		type that the change would apply to.

Depo. Transcript of Knox (AV-1028)("Knox Dep.") at 143:10-20; *see also* Second Declaration of Dr. Zimmerman (AV-1041) ("2nd Zim. Decl.") at ¶¶ 68-70 (concurring that De Nicolo is Ethernet-based).

Thus, Network-1's Motion should be denied *in toto* for failing to distinguish Ground 2. Alternatively, the "Ethernet amendments" must be stricken.

B. The "Determining Step" Fails To Distinguish Ground 1

Matsuno does exactly what Network-1 proposes to add —namely, it determines whether the access device will be able to accept applied remote power based on sensing a particular voltage condition on the data signaling pair.

1. *Proper Construction of "capable of accepting"*

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