

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

By: Robert G. Mukai, Esq.
Charles F. Wieland III, 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., DELL INC., SONY CORP. OF AMERICA, and
HEWLETT-PACKARD CO.
Petitioners

v.

NETWORK-1 SECURITY SOLUTIONS, INC.
Patent Owner

Case IPR2013-00071¹
Patent 6,218,930

Administrative Patent Judges Jameson Lee, Joni Y. Chang and Justin T. Arbes

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

¹ IPR2013-00385 and IPR2013-00495 have been joined with this proceeding.

In its Opposition, Avaya makes eight arguments. Each is addressed.

Argument 1: Whether the Ethernet amendments must, in themselves, distinguish Ground 2. Opp. at 2-3.

Avaya's argument is based on a made-up requirement that each proposed amendment distinguish all grounds at issue. That is not the rule. "A motion to amend may be denied where ... [t]he amendment does not respond to a ground of unpatentability involved in the trial." 37 C.F.R. §42.121. The Ethernet amendments respond to and distinguish "a ground of unpatentability involved in the trial" (Ground 1) because Matsuno does not disclose (a) an Ethernet data network or (b) an Ethernet data node. Knox Decl. ¶¶224-226.

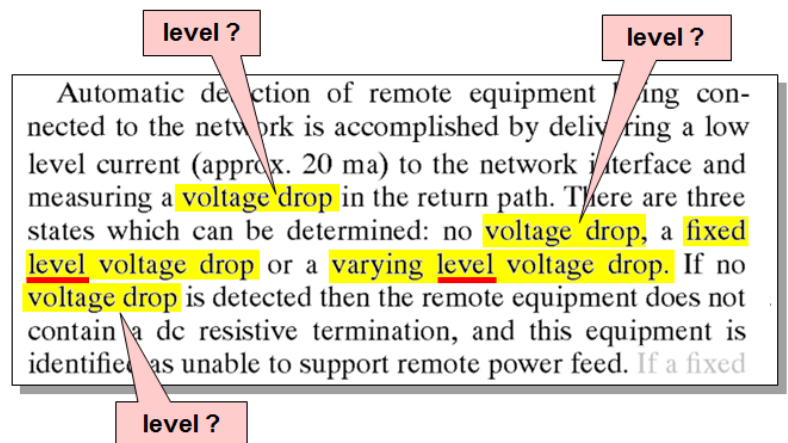
Argument 2: Whether the proposed determining step broadens the claim. Opp. at 13-14.

As a matter of law and logic, adding an additional limitation cannot broaden a claim's scope. Avaya asserts: "By re-wording the claim in a manner which would render one of its key terms less susceptible to a narrower interpretation, Network-1 is engaging in a *de facto* broadening." Opp. at 14. Avaya is wrong. *First*, Network-1 proposes adding limitations, not "re-wording the claim." *Second*, Avaya provides no legal support for its "*de facto*" broadening theory. *Idle Free*, cited by Avaya to support its theory, states: "a substitute claim may not enlarge the scope of the challenged claim it replaces by eliminating any feature." *Idle Free*, IPR2012-00027 (Paper 26) at 5. Network-1 did not "eliminat[e] any feature" of

the challenged claims. *Third*, Avaya provides zero analysis or factual support for its unsupported conclusion that adding the new step broadens the scope of the original claim. *Fourth*, the understanding of one of ordinary skill in the art (Knox Decl. ¶¶236-240), the relevant antecedent basis (*id.* ¶232), and the claim language and specification (*id.* ¶¶233-235) all demonstrate that “voltage” and “voltage level” mean the exact same thing in the context of the ‘930 Patent. Even Avaya’s expert uses “voltage” and “voltage level” interchangeably. *Id.* ¶240.

Argument 3: Whether there is adequate written description for “sensing a voltage.” Opp. at 14-15.

First, as set forth above, “the voltage” in the proposed new step refers to, and is the same as, the “voltage level” in the prior step. *Second*, the ‘930 Patent includes written description support for both “voltage” and “voltage level.” Avaya asserts: “The ‘930 patent consistently refers to sensing a voltage *level*.” Opp. at 14. Avaya is wrong. The Patent refers to sensing a “voltage” in addition to a “voltage level” (‘930, 2:66-3:7):



Argument 4: Whether Matsuno discloses the determining step. Opp. at 3-8.

“Determining whether the access device is capable of accepting remote power” means determining whether the device is designed to accept remote power.

The '930 Patent teaches "determining if a remote piece of equipment is capable of accepting remote power" ('930, 1:42-43), that is, whether the device is "known access equipment capable of accepting remote power" ('930, 3:26-27), based on the design of the access device:

Design:	Determination:
"does not contain a dc resistive termination"	"unable to support remote power"
"contains a dc resistive termination"	"unable to support remote power"
contains a "dc-dc switching supply"	"capable of accepting remote power"

'930, 3:2-27; Knox Decl. ¶¶250-252. Avaya adds an additional requirement to its construction of the determining step, such that its construction includes determining both whether the device [1] is designed to accept power, and, in addition, [2] "currently needs and would use power, if applied." Zimmerman 2nd Decl. ¶¶78-79; Knox Decl. ¶¶253-256; Opp. at 5. Avaya's additional requirement is wrong. Knox Decl. ¶¶257-258. It is also irrelevant because Avaya's construction includes the proper construction as its first requirement (*id.* ¶¶254-255) and, as demonstrated below, no reference discloses this first requirement.

Matsuno does not expressly or inherently teach "determining whether the device is designed to accept remote power." Unlike the '930 Patent, which addresses the problem of distinguishing devices that can and cannot accept remote power, all devices in Matsuno are designed to accept remote power. Knox Decl. ¶261; Zimmerman Depo. 305:15-18; 304:15-18. As a result, Matsuno does not teach a system that determines whether the attached device is capable of accepting

remote power; and such a system is not inherent. Knox Decl. ¶¶261-266. Rather, the system disclosed in Matsuno determines whether local power is being supplied based on whether the contract breaker points (8) are opened or closed. *Id.* If a device that cannot accept power (*e.g.*, a device with a Bob Smith termination which is “unable to support remote power feed” (‘930, 3:7-11)) is connected and if local power stops, then the Matsuno circuitry would still send high power to the device even though it is not capable of accepting remote power. Knox Decl. ¶¶263-265. Accordingly, the claimed determining step is not taught or inherent.

Argument 5: Whether Woodmas discloses the determining step. Opp. at 9-11.

First, because all devices disclosed in Woodmas were designed to accept remote power, Woodmas does not disclose the first part of the proposed step “determining whether a device is capable of accepting remote power.” Knox Decl. ¶¶292-295. *Second*, what Avaya relies on for the second part of the determining step (“based on the sensed voltage”) is not the voltage sensed in response to the low level current (as required by the claim) but rather a “power status signal.” Opp. at 10; Knox Decl. ¶¶296-297.

Argument 6: Whether the proposed claims would have been obvious in light of Matsuno and De Nicolo in view of Woodmas or Chang. Opp. at 12-13.

The proposed claims cannot be obvious in light of either combination because no reference teaches the new determining step. Knox Decl. ¶¶303; 317.

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