

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 IPR2013-00071¹
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
November 27, 2013 among counsel for Petitioners Avaya Inc. (“Avaya”),

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

Sony Corporation of America, and Dell Inc. (“Dell”); counsel for Patent Owner; and Judges Chang, Arbes, and Perry. The call was requested by Avaya to seek authorization to file a motion to strike portions of a declaration submitted by Patent Owner’s declarant, Dr. James Knox.

Second Declaration of Dr. Knox

Patent Owner filed a motion to amend (Paper 43) and first declaration from Dr. Knox (Exhibit 2015). Avaya filed an opposition (Paper 57) to the motion to amend. Patent Owner then filed a five-page reply (Paper 65) and 56-page second declaration from Dr. Knox (Exhibit 2024). Avaya filed an objection (Paper 72) to the second declaration.

During the call, Avaya argued that certain portions of Dr. Knox’s testimony in the second declaration are improper new evidence because they could have been submitted earlier in the first declaration and go beyond the proper scope of what may be submitted in reply to an opposition. *See* 37 C.F.R. § 42.23(b) (a reply “may only respond to arguments raised in the corresponding opposition”); Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48612, 48620 (Aug. 14, 2012) (“Rules of Practice”) (“Oppositions and replies may rely upon appropriate evidence to support the positions asserted. Reply evidence, however, must be responsive and not merely new evidence that could have been presented earlier to support the movant’s motion.”). Patent Owner argued that the second declaration only responds to points raised in Avaya’s opposition and the declaration (Exhibit 1041) submitted by Avaya’s declarant, Dr. George A. Zimmerman, with Avaya’s opposition.

The Board explained that a motion to strike or motion to exclude is not the proper mechanism for raising the issue of whether a reply or reply evidence is beyond the proper scope permitted under the rules. In the absence of special circumstance, the Board will determine whether a reply and supporting evidence contain material exceeding the proper scope when the Board reviews all of the pertinent papers and prepares the final written decision. The Board may exclude all or portions of Patent Owner's reply and Dr. Knox's second declaration or, alternatively, decline to consider any improper argument and related evidence, at that time. Additional briefing on the issue is not necessary.

Further, as discussed during the call, Avaya will have an opportunity to address Dr. Knox's testimony when it cross-examines him and also to submit a motion for observation regarding that cross-examination if necessary. The parties are reminded that an observation (or response to an observation) is not an opportunity to raise new issues, re-argue issues, or pursue objections. Each observation should be in the following form:

In Exhibit ___, on page ___, lines ___, the witness testified ___. This testimony is relevant to the ___ on page ___ of ___. The testimony is relevant because ___.

The entire observation should not exceed one short paragraph. The Board may decline consideration or entry of excessively long or argumentative observations (or responses to observations).

Motions to Exclude

The parties also requested guidance regarding motions to exclude evidence. Avaya² and Patent Owner each may file a single motion to exclude, limited to fifteen pages. *See* 37 C.F.R. § 42.24(a)(1)(v). A motion to exclude must identify specifically each piece of evidence sought to be excluded, identify where in the record the evidence was relied upon by the opposing party, identify where in the record the corresponding objection was made, and explain the objection. *See* 37 C.F.R. § 42.64(c). A motion to exclude may only raise issues related to the admissibility of evidence (e.g., hearsay), not the credibility of witnesses or sufficiency of the evidence. *See* Rules of Practice, 77 Fed. Reg. at 48633; Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012).

In consideration of the foregoing, it is hereby:

ORDERED that Avaya's request for authorization to file a motion to strike portions of Dr. Knox's second declaration (Exhibit 2024) is denied.

² Dell's ability to file an additional paper to address points of disagreement with a consolidated filing is addressed in Paper 40. No other Petitioner may file a motion to exclude.

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