

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AVAYA INC.  
Petitioner

v.

NETWORK-1 SECURITY SOLUTIONS, INC.  
Patent Owner

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Case IPR2013-00071  
Patent 6,218,930

Before Andrew Kellogg, *Trial Paralegal*

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**ERRATA**

PRPS shows Document 9 as Order Staying Reexamination. Therefore, the PDF paper is changed from 8 to 9. The date entered on Order Staying Reexamination is incorrect, the correct date is December 26, 2012, therefore, Order Staying Reexamination reads as follows:

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Patent 6,218,930

Before JAMESON LEE, JONI Y. CHANG, and JUSTIN T. ARBES,  
*Administrative Patent Judges.*

ARBES, *Administrative Patent Judge.*

**ORDER – STAYING CONCURRENT  
EX PARTE REEXAMINATION – 37 C.F.R. § 42.122(a)**

The petition for *inter partes* review of Patent 6,218,930 (the “‘930 patent”) in the above proceeding was filed on December 5, 2012. The petition challenges claims 6 and 9 of the ‘930 patent.

A request for *ex parte* reexamination of claims 6, 8, and 9 of the '930 patent (Reexamination Control No. 90/012,401) was filed on July 20, 2012 and granted on September 5, 2012. The reexamination is currently pending.

The Board will not ordinarily stay a reexamination because, in the absence of good cause, reexaminations are conducted with special dispatch. *See* 35 U.S.C § 305. Conducting the reexamination of the '930 patent concurrently with the instant proceeding, however, would duplicate efforts within the Office and could potentially result in inconsistencies between the proceedings. Claims 6 and 9 are being challenged in both the reexamination and the instant proceeding. Thus, Patent Owner could amend the claims in the reexamination and change the scope of the challenged claims while the Board is conducting its *inter partes* review (should a review be instituted). In addition, the Board is required to determine whether to institute an *inter partes* review within three months after receiving a preliminary response from Patent Owner, or the date on which such a response is due. *See* 35 U.S.C. § 314(b), as amended by the America Invents Act (AIA). The final determination of any review instituted will normally be issued no later than one year from institution. *See* 35 U.S.C. § 316(a)(11), as amended by the AIA; 37 C.F.R. § 42.100(c). Any Board decision on whether to institute a review or final written decision with respect to the patentability of the challenged claims may simplify the issues in the reexamination (e.g., claim interpretation) as well.

Further, while we recognize that the challenge in the instant proceeding is based on different prior art than that presented in the reexamination and was filed by a different party, these facts do not counsel in favor of concurrent Office proceedings given the fact that claims 6 and 9

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of the '930 patent are being challenged in both proceedings. *See* Petition, Paper 1 at 5 (“Petitioner was not the real party in interest [for the request for reexamination].”), 7. The possibility exists that if the proceedings are conducted concurrently, the claims could be amended during the reexamination at the same time the Board is conducting its review.

Based upon the facts presented in the instant proceeding and in the *ex parte* reexamination, the Board exercises its discretion under 35 U.S.C. § 315(d), as amended by the AIA, and 37 C.F.R. § 42.122(a), and orders that Reexamination Control No. 90/012,401 be stayed pending the termination or completion of the instant proceeding.

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