

U.S. Patent No. 6,218,930
IPR2013-00092
Customer Number 22,852

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

SONY CORPORATION OF AMERICA; AXIS COMMUNICATIONS AB; and
AXIS COMMUNICATIONS INC.
Petitioners

v.

NETWORK-1 SECURITY SOLUTIONS, INC.
Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. 6,218,930
Case IPR2013-00092

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

**PETITIONERS' OPPOSITION TO PATENT OWNER'S
MOTION FOR *PRO HAC VICE* ADMISSION OF
GREG DOVEL, ESQ. PURSUANT TO 37 C.F.R. 42.10**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioners Sony Corporation of America, Axis Communications AB, and Axis Communications, Inc. (collectively, “Petitioners”) respectfully oppose the Patent Owner’s Motion for *Pro Hac Vice* Admission of Greg Dovel, Esq. Pursuant to 37 C.F.R. 42.10 (“the Motion”) and ask that the Motion be denied.

Mr. Dovel cannot be admitted *pro hac vice* in this matter under the terms of the Stipulated Protective Order for a district court litigation in which he is lead counsel for the Patent Owner. The Stipulated Protective Order prohibits him from being “counsel of record” in the present *inter partes* review. The applicable section of the Stipulated Protective Order exists to prevent precisely what the Motion requests—counsel with access to Petitioners’ confidential information from serving as counsel of record in a Patent Office proceeding involving the patent-in-suit, U.S. Patent No. 6,218,930 (“the ’930 patent”).

In addition, although Mr. Dovel has experience litigating the ’930 patent, the Motion fails to demonstrate that he has “established familiarity” with all of the prior art and validity issues involved in this *inter partes* review. Indeed, two of the prior art references presented for *inter partes* review were not asserted in any of the prior litigations handled by Mr. Dovel. Moreover, the Patent Owner is already represented by registered patent counsel.

II. STATEMENT IDENTIFYING MATERIAL FACTS IN DISPUTE

In accordance with 37 C.F.R. § 42.23(a), Petitioners identify the following purported statements of fact in the Motion which are disputed.

1. Petitioners dispute the statement in the Motion that its “statement of facts shows that there is good cause for the Board to recognize Mr. Dovel *pro hac vice*.” See Motion, p. 1. As discussed herein, sufficient good cause is absent in view of the restrictions of the Stipulated Protective Order, which the Motion fails to even acknowledge or address.

2. Petitioners dispute the statement in the Motion that Mr. Dovel “has a well-established familiarity with the subject matter at issue in this proceeding.” See Motion, p. 3. This *inter partes* review involves prior art and validity issues that were not presented in any of the prior litigations related to the ’930 patent.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

The Patent Owner’s Motion should be denied for two reasons. The primary reason is that Mr. Dovel’s appearance as counsel of record in this *inter partes* review would violate the Stipulated Protective Order (Ex. 1016) entered in *Network-1 Security Solutions, Inc. v. Alcatel-Lucent USA Inc., et al.*, No.: 6:11-cv-00492-LED-JDL (E.D. Tex.) (“the Litigation”). Secondly, the Motion fails to demonstrate Mr. Dovel’s “established familiarity” with the subject matter at issue in this *inter partes* review and that there is good cause for granting the Motion,

despite the restrictions in the Stipulated Protective Order. 37 C.F.R. §§ 42.10(c), 42.20(c).

A. The Stipulated Protective Order Prohibits Mr. Dovel From Being Counsel of Record in This *Inter Partes* Review

The Stipulated Protective Order (Ex. 1016) was entered in the Litigation on September 7, 2012. It allows the Patent Owner's outside litigation counsel to participate in Patent Office proceedings involving the '930 patent, subject to two important restrictions. *See* Ex. 1016, ¶ 12. First, the counsel cannot be "counsel of record" in the Patent Office proceeding. Second, the counsel cannot divulge confidential technical information received from any of the defendants (including the Petitioners) to the Patent Owner's patent counsel or agents in the Patent Office proceeding. In particular, according to the Stipulated Protective Order:

[T]he plaintiff shall create an ethical wall between those persons with access to technical information (e.g., information relating to the functionality of the disclosing parties' products rather than confidential economic information relating to such products) designated "CONFIDENTIAL" or "HIGHLY CONFIDENTIAL" and those individuals who prepare, prosecute, supervise, or assist in the prosecution of any patent application pertaining to Power over Ethernet technology. Outside litigation counsel for the plaintiff who obtains, receives, accesses, or otherwise learns of, in whole or in part, technical information designated "CONFIDENTIAL" or "HIGHLY CONFIDENTIAL," however, may participate in any reexamination proceeding of the patent at issue in this Action, except that outside

counsel for the plaintiff may not act as counsel of record in any reexamination proceeding and may not reveal the contents of any “CONFIDENTIAL” or “HIGHLY CONFIDENTIAL” information to reexamination patent counsel or agents.

Id. (emphases added).¹ The Stipulated Protective Order also mandates that confidential materials “shall be used solely for the purposes of [the Litigation]” and not for any other purpose. *Id.* at ¶ 23.

Mr. Dovel is “outside counsel” for the “plaintiff” (the Patent Owner) in the Litigation. Indeed, the Motion and accompanying declaration state that he is “lead counsel.” *See* Motion, p. 2; Ex. 2001, p. 2. Mr. Dovel is thus prohibited from participating as “counsel of record” in any Patent Office proceeding involving the ’930 patent. Although the language of Stipulated Protective Order does not specifically identify “*inter partes* review” proceedings, the phrase “*any* reexamination proceeding” is used broadly to encompass all forms of Patent Office

¹ Petitioners acknowledge that this provision in the Stipulated Protective Order is not completely reciprocal and that counsel for the Petitioners also serve as counsel in the Litigation. *See* Ex. 1016, ¶ 13. This is not inconsistent because, as explained below, the primary purpose of the provision is to protect defendants’ confidential information and any unauthorized disclosure or use thereof (inadvertent or otherwise) during a Patent Office proceeding for the ’930 patent.

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