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Paper 12
Entered: September 16, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION OF AMERICA and
HEWLETT-PACKARD CO.
Petitioners

v.

NETWORK-1 SECURITY SOLUTIONS, INC.
Patent Owner

Case IPR2013-00495
Patent 6,218,930

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

ARBES, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Sony Corporation of America ("Sony") and Hewlett-Packard Co. ("HP") (collectively, "Petitioners") filed a Petition (Paper 3) ("Pet.") to institute an *inter partes* review of claims 6 and 9 of Patent 6,218,930 (the "'930 patent") pursuant to 35 U.S.C. § 311 *et seq*. and a motion for joinder with Case IPR2013-00071 (Paper 7) ("Mot."). Patent Owner Network-1 Security Solutions, Inc. did not file a preliminary response to the Petition by the deadline of August 16, 2013. *See* Paper 9. We have jurisdiction under 35 U.S.C. § 314. For the reasons that follow, the Board has determined to institute an *inter partes* review.[1]

I. BACKGROUND

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a):

> THRESHOLD—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Petitioners challenge claims 6 and 9 of the '930 patent as anticipated under 35 U.S.C. § 102(b) and as obvious under 35 U.S.C. § 103(a). Pet. 10-11. We grant the Petition as to claims 6 and 9 on the asserted grounds as discussed below.

[1] In a decision being entered concurrently, Petitioners' motion for joinder is granted under certain conditions and this proceeding is joined with Case IPR2013-00071.

A. Related Case IPR2013-00071

On December 5, 2012, Avaya Inc. ("Avaya") filed a petition to institute an *inter partes* review of claims 6 and 9 of the '930 patent, asserting five grounds of unpatentability. IPR2013-00071, Paper 1. On May 24, 2013, the Board granted the petition and instituted an *inter partes* review on the following grounds:

> Claims 6 and 9 under 35 U.S.C. § 102(b) as anticipated by Japanese Unexamined Patent Application Publication No. H10-13576 ("Matsuno"); and
>
> Claims 6 and 9 under 35 U.S.C. § 103(a) as unpatentable over Patent 6,115,468 ("De Nicolo") in view of Matsuno.

IPR2013-00071, Paper 18 at 29 ("'71 Dec.").

B. Related Case IPR2013-00385

On June 24, 2013, Dell Inc. ("Dell") filed a petition to institute an *inter partes* review of claims 6 and 9 on the same grounds on which a trial was instituted in Case IPR2013-00071 and a motion for joinder with that proceeding. IPR2013-00385, Papers 2, 4, 11. On July 29, 2013, the Board granted the petition and joined Dell as a party to Case IPR2013-00071. IPR2013-00385, Papers 16 ("'385 Dec."), 17.

C. The Prior Art

Petitioners rely on the following prior art:

> 1. Patent 6,115,468, filed Mar. 26, 1998, issued Sept. 5, 2000 ("De Nicolo") (Ex. 1007); and

2. Japanese Unexamined Patent Application Publication No. H10-13576, published Jan. 16, 1998 ("Matsuno") (Ex. 1004).[2]

D. The Asserted Grounds

Petitioners challenge claims 6 and 9 of the '930 patent on the following grounds:

Reference(s)	**Basis**	**Claims Challenged**
Matsuno	35 U.S.C. § 102(b)	6 and 9
De Nicolo and Matsuno	35 U.S.C. § 103(a)	6 and 9

E. Claim Interpretation

Petitioners make the same claim interpretation arguments that Avaya made in Case IPR2013-00071. *Compare* Pet. 11-14, *with* IPR2013-00071, Paper 1 at 7-10. We construed various limitations of claims 6 and 9 in Cases IPR2013-00071 and IPR2013-00385, and incorporate our previous analysis for purposes of this decision. *See* '71 Dec. 6-14; IPR2013-00071, Paper 21; '385 Dec. 7-13.

II. ANALYSIS

Petitioners in their Petition assert the same two grounds of unpatentability as those on which a trial was instituted in Case IPR2013-00071. *See* Pet. 10-11; '71 Dec. 29. Petitioners' arguments are

[2] We refer to "Matsuno" as the English translation (Ex. 1004) of the original reference (Ex. 1002). Petitioners provided an affidavit attesting to the accuracy of the translation. *See* Ex. 1003; 37 C.F.R. § 42.63(b).

identical to the arguments made by Avaya and Dell in their petitions. *Compare* Pet. 21-40, *with* IPR2013-00071, Paper 1 at 17-26, 36-45, *and* IPR2013-00385, Paper 2 at 17-35. Petitioners also submit the same declaration of Dr. George A. Zimmerman that Dell submitted in support of its petition, which itself was largely a copy of the declaration of Dr. Zimmerman submitted by Avaya. *See* Ex. 1011; IPR2013-00071, Ex. 1011; IPR2013-00385, Ex. 1011.

We incorporate our previous analysis regarding the two asserted grounds of unpatentability, *see* '71 Dec. 15-22; '385 Dec. 13-19, and conclude that Petitioners have demonstrated a reasonable likelihood of prevailing on the following grounds asserted in the Petition:

Claims 6 and 9 under 35 U.S.C. § 102(b) as being anticipated by Matsuno; and

Claims 6 and 9 under 35 U.S.C. § 103(a) as being unpatentable over De Nicolo in view of Matsuno.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is granted as to claims 6 and 9 of the '930 patent;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '930 patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; and

FURTHER ORDERED that the trial is limited to the grounds identified above and no other grounds as to claims 6 and 9 are authorized.

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