

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

NETWORK-1 TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2015-00348
Patent 8,656,441 B1

**PATENT OWNER'S UPDATED MANDATORY NOTICE
PURSUANT TO 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8, Patent Owner Network-1 Technologies, Inc. (“Patent Owner” or “Network-1”) hereby submits the following updated mandatory notice information.

Related Matters Under 37 C.F.R. § 42.8(b)(2)

The ‘441 Patent is the subject of litigation between Patent Owner and Petitioner in the U.S. District Court for the Southern District of New York, namely, *Network-1 Technologies, Inc. v. Google Inc. and YouTube, LLC*, Case No. 1:14-cv-02396 (“the Litigation”).

U.S. Patent No. 8,640,179 (“the ‘179 Patent”) issued from an application related to the ‘441 Patent family. The ‘179 Patent is also the subject of the Litigation. In addition, the ‘179 Patent is at issue in the *inter partes* review Case IPR2015-00343, which was requested by the Petitioner. The Board instituted *inter partes* review in this case on June 23, 2015 (*see Google, Inc. v. Network-1 Technologies, Inc.*, IPR2015-00343, Paper 6 (PTAB June 23, 2015)).

U.S. Patent No. 8,205,237 (“the ‘237 Patent”) issued from an application related to the ‘441 Patent family. The ‘237 Patent is also the subject of the Litigation. In addition, the ‘237 Patent is at issue in the *inter partes* review Case IPR2015-00345, which was requested by the Petitioner. The Board instituted *inter partes* review in this case on June 23, 2015 (*see Google, Inc. v. Network-1 Technologies, Inc.*, IPR2015-00345, Paper 6 (PTAB June 23, 2015)).

U.S. Patent No. 8,010,988 (“the ‘988 Patent”) issued from an application related to the ‘441 Patent family. The ‘988 Patent is also the subject of the Litigation. In addition, the ‘988 Patent is at issue in the *inter partes* review Case IPR2015-00347, which was requested by the Petitioner. The Board instituted *inter partes* review in this case on June 23, 2015 (*see Google, Inc. v. Network-1 Technologies, Inc.*, IPR2015-00347, Paper 6 (PTAB June 23, 2015)).

Pursuant to agreement between the parties, on July 2, 2015, the District Court stayed the Litigation until further order of the Court following the issuance of the Board’s final written decisions in IPR2015-00343, IPR2015-00345, IPR2015-00347, and IPR2015-00348. (Dkt. No. 85).

U.S. Patent No. 8,904,464 (“the ‘464 Patent”) issued from an application related to the ‘441 Patent family. The ‘464 Patent is the subject of litigation between Patent Owner and Petitioner in the U.S. District Court for the Southern District of New York, namely, *Network-1 Technologies, Inc. v. Google Inc. and YouTube, LLC*, Case No. 1:14-cv-09558 (“the ‘464 litigation”). The ‘464 Patent is also at issue in the covered business method patent review Case CBM2015-00113, which was requested by the Petitioner. The Board has not decided whether to institute this CBM patent review. Pursuant to agreement between the parties, on July 2, 2015, the District Court stayed the ‘464 litigation until further order of the

Court following the issuance of the Board's institution decision in CBM2015-00113. (Dkt. No. 35).

Lead and Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)

The Board has granted Patent Owner's motion for *pro hac vice* admission of Mr. Greg Dovel and authorized him to represent Patent Owner as back-up counsel in this proceeding. (Paper 14). Accordingly, the information relating to back-up counsel for Patent Owner is updated as follows. Lead counsel for Patent Owner remains the same.

Lead Counsel	Back-Up Counsel
Charles R. Macedo (Reg. No. 32,781) Amster, Rothstein & Ebenstein LLP 90 Park Avenue New York, NY 10016 Telephone: (212) 336-8074 Facsimile: (212) 336-8001 E-mail: cmacedo@arelaw.com	Brian A. Comack (Reg. No. 45,343) Amster, Rothstein & Ebenstein LLP 90 Park Avenue New York, NY 10016 Telephone: (212) 336-8098 Facsimile: (212) 336-8001 E-mail: N1-Google-IPR@arelaw.com
	Greg Dovel (Admitted <i>pro hac vice</i>) Dovel & Luner LLP 201 Santa Monica Boulevard, Suite 600 Santa Monica, CA 90941 Telephone: (310) 656-7066 E-mail: greg@dovellaw.com

Pursuant to 37 C.F.R. § 42.10(b), Patent Owner's Updated Power of Attorney accompanies this Updated Mandatory Notice.

Service Information Under 37 C.F.R. § 42.8(b)(4)

Service information (by e-mail, postal mailing, or hand-delivery) for lead and back-up counsel is provided in the above designation of lead and back-up counsel. Patent Owner consents to electronic service by e-mail at N1-Google-IPR@arelaw.com, with cc to cmacedo@arelaw.com and greg@dovellaw.com.

The Patent Trial and Appeal Board is hereby authorized to charge any fees associated with this submission by Patent Owner to Deposit Account No. 01-1785.

Respectfully submitted,

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Dated: August 7, 2015

By: /Charles R. Macedo/
Charles R. Macedo
Registration No. 32,781

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PATENT OWNER'S UPDATED MANDATORY NOTICE PURSUANT TO 37 C.F.R. § 42.8**, together with **PATENT OWNER'S UPDATED POWER OF ATTORNEY**, is being served by electronic mail this 7th day of August 2015 on counsel for Petitioner as follows:

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Dated: August 7, 2015

By: /Charles R. Macedo/
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