

Filed on behalf of NETWORK-1 TECHNOLOGIES, INC.

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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 NETWORK-1'S
IDENTIFICATION OF IMPROPER REPLY ARGUMENTS**

The Board authorized this Paper in a conference call on February 24, 2016.

Petitioner had the burden of making out a *prima facie* case in its Petition, which “must specify where each element of the claim is found in the prior art.” 37 C.F.R. § 42.104(b)(4). Here, Petitioner’s Reply attempted to establish a new *prima facie* case by improperly raising four new theories and citing different sections of the prior art. This Paper addresses two examples and identifies two others.

New *prima facie* theories 1 and 2—Ghias, “neighbor”

<p><u>Petition</u>: Ghias discloses a neighbor search because it identifies “a ranked list of approximately matching melodies” or “the single most approximate matching melody.” Pet. 51.</p>	<p><u>Reply theory 1</u>: Ghias disclose a neighbor search because “Ghias’s subsequent searches do not always consider the closest match.” Reply 16-17.</p> <p><u>Reply theory 2</u>: Ghias discloses a neighbor search because “Ghias cannot always identify the closest match in a group of close matches.” Reply 17-18.</p>
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The Reply is the first time that Petitioner asserted these two theories for a neighbor search. Moreover, Petitioner cannot properly contend that it is entitled to present these two new theories to respond to Network-1’s construction of neighbor search. Patent Owner’s Response was the only opportunity for Patent Owner to address Petitioner’s arguments and provide responsive evidence. Patent Owner

would be prejudiced if Petitioner is permitted to introduce new issues and cite alternative passages from Ghias in its Reply:

[T]his argument is newly raised in the Reply, and is based on a portion [of the art] that [Petitioner] alleges, for the first time, corresponds to the enhanced limitation. Although the argument is based on [Patent Owner's] proposed claim construction rather than the construction that [Petitioner] proposes in its Reply, we consider the dispute over the proper construction of this term to be sufficiently foreseeable so that [Petitioner] should have presented the argument and evidence in the Petition. [Petitioner]'s failure to do so at that time has deprived [Patent Owner] of the opportunity to respond to it, as [Patent Owner] could not respond to [Petitioner]'s Reply. For this reason, we decline to consider it.

TRW Automotive v. Magna Electronics, IPR2014-00262, Paper 37 at 12-13 (PTAB June 25, 2015).

Moreover, the construction that the Board adopted (and Patent Owner applied in its Response) was Petitioner's proposed construction. *See* Reply 3 ("The parties agree that, in its Institution Decision, the Board correctly construed 'neighbor search'").

New *prima facie* theories 3 and 4—Ghias, “*non-exhaustive*”:

<p><u>Petition</u>: Ghias discloses a <i>non-exhaustive</i> search because it discloses an “efficient pattern matching algorithm.” Pet. 51.</p>	<p><u>Reply theory 3</u>: Ghias discloses a <i>non-exhaustive</i> search because “Ghias discloses subsequent searches,” “[t]he results of a first search for a first query may exclude results that are not matches to the first query, but are matches to a second query,” and a “subsequent search for the second query would not consider these excluded references.” Reply 13-14.¹</p> <p><u>Reply theory 4</u>: Ghias discloses a <i>non-exhaustive</i> search because all songs can be packed “into one file,” and the search of that single file is faster than brute force and is therefore non-exhaustive. Reply 14-15.</p>
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¹ Patent Owner addressed this issue in its Response; but that was in response to a concern raised by the Board, not in the Petition. Response (Paper 17) 37-44.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PATENT OWNER NETWORK-1'S IDENTIFICATION OF IMPROPER REPLY ARGUMENTS** is being served by electronic mail this 1st day of March 2016 on counsel for Petitioner as follows:

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