

Filed on behalf of: Google 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
U.S. Patent 8,656,441

**PETITIONER'S RESPONSE TO PATENT OWNER'S
IDENTIFICATION OF ALLEGEDLY IMPROPER REPLY ARGUMENTS**

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

Patent Owner contends that four arguments in Petitioner's Reply constitute improper attempts to make a new *prima facie* case. In fact, as demonstrated below, all four arguments respond directly to Patent Owner's arguments. Thus, Petitioner properly included the arguments in its Reply. *See Nintendo of Am. Inc. v. Motion Games, LLC*, IPR2014-00164, Paper 51 at 24 (May 15, 2015) ("[t]he very nature of a reply is to respond to the opposition [and] [t]he need for relying on evidence not previously discussed in the Petition may not exist until a certain argument has been raised in the . . . Response.").

Arguments 1-2: The Petition explained that Ghias "locates a neighbor by determining 'a ranked list of approximately matching melodies.'" Paper 2 at 48. The Board construed "neighbor search" to mean "a search that identifies a close, but not necessarily exact or closest, match." Paper 6 at 8. Patent Owner's Response purported to accept this construction, while arguing for the first time that it should be read to exclude searches that "guarantee that . . . the closest match is identified each time the search is performed," and, therefore, that Ghias does not teach a "neighbor search." Paper 17 at 6, 44-48. Petitioner's Reply responds that, even if this reinterpretation were correct, Ghias discloses a "neighbor search" because it does not always locate the closest match given that (1) "Ghias' subsequent searches do not always consider, let alone identify, the closest match"; and (2) Ghias "cannot

always 'identify' the closest of a group of close matches." Paper 20 at 16-18

Patent Owner argues that *TRW Automotive v. Magna Electronics*, IPR2014-00262, Paper 37 prohibits consideration of Petitioner's argument. In fact, the *TRW* Board found a reply argument to be improper only because (1) "the proper construction of this term [was] sufficiently foreseeable"; and (2) Petitioner relied on a feature of the reference that it "allege[d], for the first time, correspond[ed] to the [disputed] limitation." *Id.* at 12-13. By contrast, here (1) Patent Owner's interpretation of the Board's construction was not foreseeable, especially given that the claims explicitly recite "neighbor" searches that always locate the closest match (Paper 20 at 4-5); and (2) Petitioner continues to argue that the same aspect of Ghias (the "ranked list") constitutes a "neighbor search" even as reinterpreted by Patent Owner, because it does not always locate the closest match. "Petitioner cannot anticipate every claim construction argument that Patent Owner may make in its response and is entitled to provide argument and evidence in its Reply to refute arguments and evidence in Patent Owner's Response." *Samsung Elecs. Co. v. Affinity Labs of Tx., LLC*, IPR2014-01181, 2016 WL 386738, at *31.

Argument 3: As Patent Owner has recognized, "the Board found [in its Institution Decision] that Ghias disclosed the non-exhaustive search because . . . the user can perform a 'new query on a restricted search list consisting of songs just retrieved.'" Paper 17 at 38 (citing Paper 6 at 14). The Board had full authority to

do so. *E.g., In re Cuozzo Speed Techs.*, 793 F.3d 1268, 1273 (Fed. Cir. 2015) ("the IPR statute . . . authorizes the Board to issue 'a final written decision with respect to the patentability of any patent claim challenged by the petitioner'"). Patent Owner's Response disputed the substance of this argument at length, arguing that "[t]he records that are not on the restricted list . . . are not possible matches." Paper No. 17 at 38-44. Petitioner's Reply merely rebuts Patent Owner's arguments, affirming the Board's understanding that "[t]he subsequent searches . . . do not consider all references, and are 'non-exhaustive.'" Paper 20 at 13-14.

Argument 4: The Petition raised an argument that Ghias employs a search that is faster than brute force, and therefore non-exhaustive. Paper 2 at 47-48. In support, the Petition cited Ghias' explanation that "[r]unning times have ranged from $O(mn)$ for the brute force algorithm to $O(kn)$ or $O(n\log(m))$. . ." *Id.* at 48, 51 (citing Ex. 1010 at 6:23-35) (emphasis in original). Patent Owner responded that "[t]his passage addresses comparing the work with a single record in the database," and therefore Ghias does not disclose a non-exhaustive search of multiple songs. Paper 17 at 37 (emphasis in original). Petitioner's Reply responds that, even if Patent Owner were correct that this disclosure describes comparison to a single record, Ghias discloses that multiple songs may be "pack[ed] . . . into one file," in which case Ghias would non-exhaustively search multiple songs. Paper 20 at 15.

Respectfully Submitted,

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§ 42.6(e) - CERTIFICATION OF SERVICE

The undersigned certifies service pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 on the Patent Owner of a copy of this PETITIONER'S RESPONSE TO PATENT OWNER'S IDENTIFICATION OF ALLEGEDLY IMPROPER REPLY ARGUMENTS by email at the corresponding address of record for Patent Owner's counsel in IPR2015-00347:

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