

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

**PATENT OWNER'S MANDATORY NOTICES
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 mandatory notice information in connection with Petitioner Google Inc.’s Petition for *Inter Partes* Review of U.S. Patent No. 8,656,441 (Case IPR2015-00348).

A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)

The real party-in-interest is Network-1 Technologies, Inc., the assignee of record for U.S. Patent No. 8,656,441 (“the ‘441 Patent”).

B. 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 has not decided whether to institute this *inter partes* review.

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 has not decided whether to institute this *inter partes* review.

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 has not decided whether to institute this *inter partes* review.

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.

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

Pursuant to 37 C.F.R. §§ 42.8(b)(3) and 42.10(a), Patent Owner provides the following designation of lead and back-up counsel, as well as their respective service information.

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

The above designated counsel is already counsel of record in the ‘441 Patent. Accordingly, no additional power of attorney accompanies this designation of counsel pursuant to 37 C.F.R. § 42.10(b).

D. 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.

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,

AMSTER, ROTHSTEIN & EBENSTEIN
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Dated: December 22, 2014

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

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that on this 22nd day of December, 2014, a copy of the foregoing PATENT OWNER'S MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8 was served via EXPRESS MAIL[®] on counsel for Petitioner at the following correspondence address:

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