

EXHIBIT G

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Paper 30
Entered: June 20, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.
Petitioner,

v.

NETWORK-1 TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2015-00343
Patent 8,640,179 B1

Before KEVIN F. TURNER, LYNNE E. PETTIGREW, and
JON B. TORNQUIST, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Google Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–3, 6–14, 18, 19, 21–27, and 29–37 of U.S. Patent No. 8,640,179 B1 (Ex. 1001, “the ’179 Patent”). Network-1

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Technologies, Inc. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 5 (“Prelim. Resp.”). We instituted the instant trial on June 23, 2015, pursuant to 35 U.S.C. § 314. Paper 6 (“Dec.”).

Subsequently, Patent Owner filed a Response (Paper 17, “PO Resp.”), and Petitioner filed a Reply (Paper 20, “Reply”). Further to authorization provided in a conference call, Patent Owner filed a paper identifying allegedly improper arguments in the Reply (Paper 24), and Petitioner filed a response thereto (Paper 25). Oral hearing¹ was held on March 9, 2016, and a transcript of the hearing was entered into the record. Paper 29 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons set forth below, we determine that Petitioner has not shown, by a preponderance of the evidence, that claims of the ’179 Patent are unpatentable under 35 U.S.C. § 103(a).

A. Related District Court Proceedings

The parties inform us that the ’179 Patent is the subject of the following lawsuit: *Network-1 Technologies, Inc. v. Google Inc. and YouTube, LLC*, Case No. 1:14-cv-02396 (S.D.N.Y.). Pet. 1. YouTube, LLC is a subsidiary of Petitioner, and is acknowledged as a real party-in-interest. *Id.* In addition, three additional patents, U.S. Patent Nos. 8,205,237, 8,010,988, and 8,656,441, all issuing from applications related to the ’179 Patent, are subject to *inter partes* reviews, namely IPR2015-00345, IPR2015-00347, and IPR2015-00348, respectively.

¹ The hearings for this review and IPR2015-00345, IPR2015-00347, and IPR2015-00348 were consolidated.

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B. The '179 Patent

The '179 Patent relates to identifying a work, such as a digital audio or video file, without the need to modify the work. Ex. 1001, 1:35–40, 4:38–44. This identification can be accomplished through the extraction of features from the work, and comparison of those extracted features with records of a database or library. *Id.* at Abstract. Thereafter, an action may be determined based on the identification determined. *Id.* at 4:36–40.

Figure 1, reproduced below, illustrates the steps of the claimed computer-implemented methods:

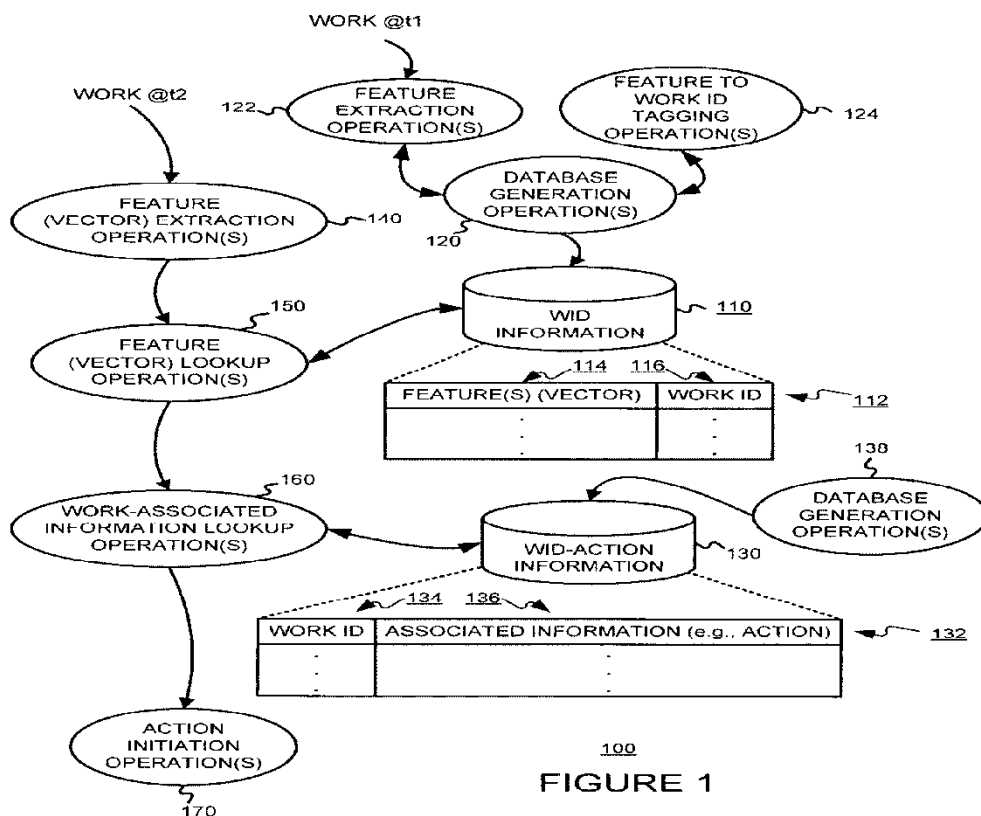


Fig. 1 of the '179 Patent illustrating the claimed method

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C. Illustrative Claim

Claim 1 is independent, along with claims 13 and 25, is considered representative of the claims challenged, and is reproduced below:

1. A computer-implemented method comprising:
 - (a) maintaining, by a computer system including at least one computer, a database comprising:
 - (1) first electronic data related to identification of one or more reference electronic works; and
 - (2) second electronic data related to action information comprising an action to perform corresponding to each of the one or more reference electronic works;
 - (b) obtaining, by the computer system, extracted features of a first electronic work;
 - (c) identifying, by the computer system, the first electronic work by comparing the extracted features of the first electronic work with the first electronic data in the database using a *non-exhaustive neighbor search*;
 - (d) determining, by the computer system, the action information corresponding to the identified first electronic work based on the second electronic data in the database; and
 - (e) associating, by the computer system, the determined action information with the identified first electronic work.

Ex. 1001, 25:22–42 (emphasis added).

D. Prior Art Relied Upon

Based on the instituted grounds, Petitioner relies upon the following prior art references:

Reference or Declaration	Exhibit No.
U.S. Patent No. 6,970,886 (“Conwell”)	Ex. 1009
U.S. Patent No. 5,874,686 (“Ghias”)	Ex. 1010
U.S. Patent No. 6,098,106 (“Philyaw”)	Ex. 1014

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