

EXHIBIT 3

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Paper No. 7
Filed: October 19, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.
Petitioner,

v.

NETWORK-1 TECHNOLOGIES, INC.,
Patent Owner.

Case CBM2015-00113
Patent 8,904,464 B1

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

TURNER, *Administrative Patent Judge*.

DECISION

Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

I. INTRODUCTION

A. Background

Google Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting a review under the transitional program for covered business method patents of U.S. Patent No. 8,904,464 B1 (Ex. 1001, “the ’464 Patent”). Network-1

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Technologies, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 5, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 324.

The standard for instituting a covered business method patent review is set forth in 35 U.S.C. § 324(a), which provides as follows:

THRESHOLD.—The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

Petitioner challenges the patentability of claims 1–34 (“the challenged claims”) of the ’464 Patent under 35 U.S.C. §§ 101, 103, and 112. Taking into account Patent Owner’s Preliminary Response, we determine that the Petition demonstrates that it is more likely than not that at least one of the challenged claims is unpatentable. Pursuant to 35 U.S.C. § 324, we institute a covered business method patent review of all of the challenged claims of the ’464 Patent.

B. Related Matters

The parties inform us that the ’464 Patent is the subject of the following lawsuit: *Network-1 Technologies, Inc. v. Google Inc. and YouTube, LLC*, Case No. 1:14-cv-09558 (S.D.N.Y.). Pet. 76–77; Paper 4, 2–3. YouTube, LLC is a subsidiary of Petitioner, and is acknowledged as a real party-in-interest. *Id.* In addition, four additional patents, U.S. Patent Nos. 8,640,179, 8,205,237, 8,010,988, and 8,656,441, all issuing from applications related to the ’464 Patent, are subject to pending trials for *inter partes* review, namely IPR2015-00343, IPR2015-00345, IPR2015-00347, and IPR2015-00348, respectively.

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C. The '464 Patent

The '464 Patent relates to identifying a work, such as a digital audio or video file, without the need to modify the work. Ex. 1001, 1:41–46, 4:42–51. This identification can be accomplished through the extraction of features from or about the work, and comparison of those extracted features with records of a database or library. *Id.* at Abs. Thereafter, an action may be determined based on the identification determined. *Id.* at 5:21–23. Patent Owner refers to Figure 1 as illustrating the steps of the claimed computer-implemented methods (Prelim. Resp. 3–4):

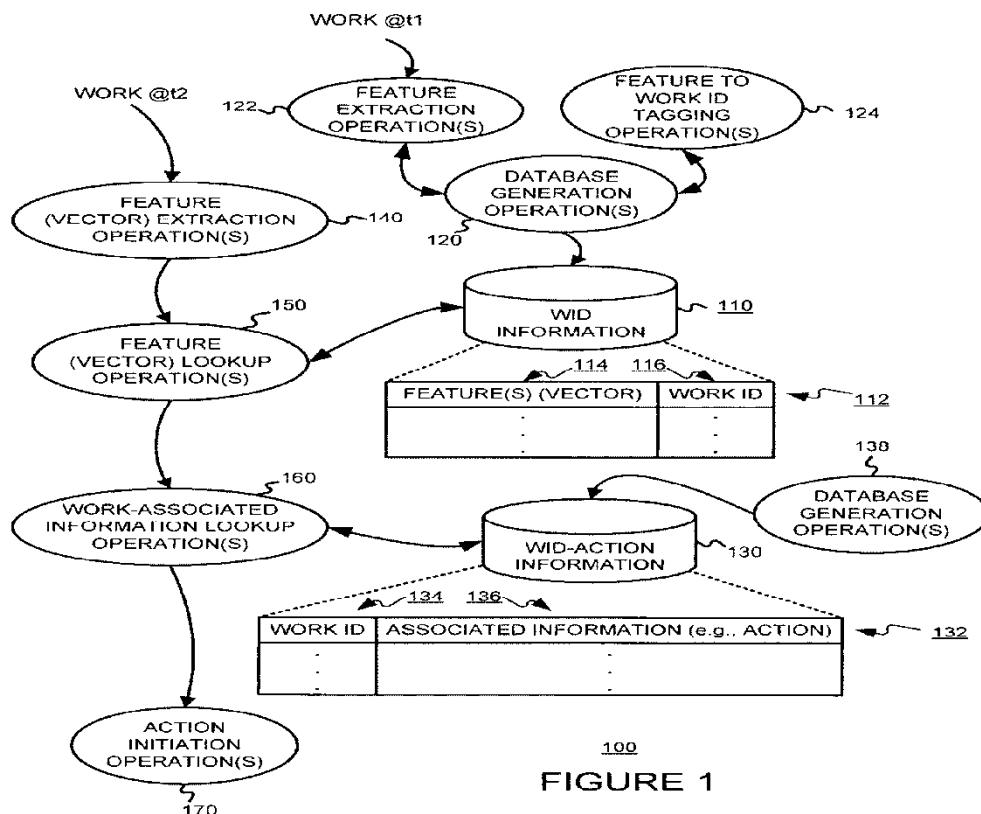


Fig. 1 of the '464 Patent illustrating the claimed method

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D. Illustrative Claim

Claims 1 and 18 are independent, claim 1 is considered representative of the claims challenged, and claim 1 is reproduced below:

1. A method comprising:
 - receiving, by a computer system including at least one computer, a first electronic media work;
 - correlating, by the computer system using a non-exhaustive, near neighbor search, the first electronic media work with an electronic media work identifier;
 - storing, by the computer system, correlation information associating the first electronic media work and the electronic media work identifier;
 - accessing, by the computer system, associated information related to an action to be performed in association with one or more electronic media works corresponding to the electronic media work identifier;
 - generating, by the computer system, a tag associated with the first electronic media work;
 - providing, from the computer system to a user electronic device, the first electronic media work and the associated tag;
 - obtaining, by the computer system from the user electronic device, a request related to the associated tag;
 - generating, using the computer system, machine-readable instructions based upon the associated information to be used in performing, at the user electronic device, the action; and
 - providing, from the computer system to the user electronic device, the machine-readable instructions to perform the action in response to the request.

Id. at 24:44–25:3.

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