UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

NETWORK-1 TECHNOLOGIES, INC.

Plaintiff,

- against -

GOOGLE LLC and YOUTUBE, LLC

Defendants.

14 Civ. 2396 (PGG)

14 Civ. 9558 (PGG)

DEFENDANTS' SUR-REPLY CLAIM CONSTRUCTION BRIEF

WILLIAMS & CONNOLLY LLP
Kevin Hardy, *pro hac vice*
Samuel Bryant Davidoff
Andrew V. Trask
Graham W. Safty, *pro hac vice*
725 12th Street, N.W.
Washington, DC 20005
Telephone: (202) 434-5000
Facsimile: (202) 434-5029

Counsel for Defendants Google LLC and YouTube, LLC

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Three issues are ripe for resolution by the Court at the *Markman* hearing in these actions.

First, the term "non-exhaustive search" renders indefinite the asserted claims of U.S. Patent Nos. 8,010,988 (the "'988 patent") and 8,904,464 (the "'464 patent"). Google's response brief explained that the term does not appear in the patents' specifications; is not described in their file histories; and has already been interpreted by the Federal Circuit, which identified two different yet "reasonable" constructions of the term and concluded that "the intrinsic and extrinsic evidence … [is] inconclusive as to the broader or narrower construction of the limitation 'non-exhaustive search.'" *Google LLC v. Network-1 Techs., Inc.*, 726 F. App'x 779, 786 (Fed. Cir. 2018). Accordingly, Google explained, the "claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). In its reply, Network-1 blows past the Federal Circuit's opinion yet again by asserting that the patents' specifications describe the contours "non-exhaustive search," *see* Reply Br. at 6–11, even though the appellate court concluded as a matter of law that the specifications do not "draw a clear line between 'exhaustive' and 'non-exhaustive' searching," *Google*, 726 F. App'x at 785.

Second, the term "correlation information" renders indefinite the asserted claims of the '464 patent. Even with a second bite at the apple, Network-1 cannot point to any portion of the specification that explicitly describes "correlation information" or any example of what the claim term might encompass or exclude. Because of the absence of anything that elucidates "correlation information," "[t]he claims when read in light of the specification and the prosecution history" do not "provide objective boundaries for those of skill in the art" and should be declared indefinite. *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014).

Third, the Court should reject Network-1's attempt to modify the construction of "extracted

features" and "extracting features." Network-1's reply brief all but admits that its new construction sweeps in countless "calculations" performed on data that are not within the purview of the "feature extraction operation" described by the patents. Reply Br. at 15. The Court should either adopt the parties' previously agreed-upon construction or clarify the construction in a manner that conforms to the language of the patents and the written testimony of Network-1's own declarant.

I. THE TERM "NON-EXHAUSTIVE SEARCH" IS INDEFINITE

A. The Federal Circuit Has Already Rejected Network-1's Reading of the Specifications of the Patents-In-Suit

Most of Network-1's arguments regarding the term "non-exhaustive search" are nothing more than an attempt to re-litigate the way in which the Federal Circuit—***as a matter of law***—read the specifications of the patents-in-suit. As the Supreme Court recently reiterated, when a "court reviews only evidence intrinsic to the patent (the patent claims and specifications, along with the patent's prosecution history), the judge's determination will amount solely to a determination of law." *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 841 (2015). In other words, "[t]he internal coherence and context assessment of the patent, and whether it conveys claim meaning with reasonable certainty, are questions of law." *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1342 (Fed. Cir. 2015). Thus, when Network-1 asserts in its reply brief that the specifications describe "an exhaustive search" through their reference to "a linear search of all N entries" and "provide[] several examples of non-exhaustive searches," Reply Br. at 6–7, it is making a legal argument. And when Network-1 insists that a skilled artisan would "know the patent is drawing a distinction between searches that compare to all records (exhaustive) and those that do not (non-exhaustive)," *id.* at 8, it is asking this Court to adopt a legal conclusion. *See Teva*, 789 F.3d at 1342 ("The meaning one of skill in the art would attribute to the term molecular weight in light of

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