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November 27, 2019

Via ECF

Hon. Paul G. Gardephe
United States District Court
Southern District of New York
40 Foley Square, Room 2204
New York, New York 10007

Re: **Network-1 Technologies, Inc. v. Google LLC and YouTube, LLC, Case Nos. 1:14-cv-2396-PGG-SN and 1:14-cv-9558-PGG-SN**

Dear Judge Gardephe:

I write on behalf of Defendants Google LLC and YouTube, LLC (collectively, “Google”). During the final minutes of the claim construction hearing on November 21, 2019, Plaintiff Network-1 Technologies, Inc. (“Network-1”) proffered a “Proposed Alternate Construction” of the claim term “non-exhaustive search,” a copy of which I have enclosed for reference. I informed the Court that although Network-1 clearly prepared this slide in advance, Google first received the “Proposed Alternate Construction” when Network-1’s counsel provided it to the Court, without explanation or justification, at the end of the hearing. The Court accordingly invited Google to submit a letter in a week’s time addressing Network-1’s “Proposed Alternate Construction.” See Nov. 21, 2019 Hearing Tr. at 115. In the meantime, on November 26, 2019, Network-1 filed an unsolicited letter brief rehashing the arguments that the parties advanced in two rounds of briefing earlier this year and over the course of approximately three hours of argument last week. See Case No. 1:14-cv-2396-PGG-SN (“Case I”) D.I. 201.

In response to the Court’s invitation, Google respectfully submits that Network-1’s attempt to pivot to a “Proposed Alternate Construction” of “non-exhaustive search” is grossly out of time and should be disregarded. The end of last week’s hearing marked the first time that Network-1 ever intimated that it intended to offer an alternative construction of “non-exhaustive search”—this, despite the fact that the parties first exchanged constructions on March 29, 2019, and that Network-1 submitted two briefs and two expert declarations defending its construction in the following months, without ever mentioning any alternative construction. See Case I D.I. 137, 148, and 158. Even if Network-1’s “Proposed Alternate Construction” were considered on its merits, however, it serves only to reinforce that the term “non-exhaustive search” is indefinite. Network-1’s consistent position has been that “non-exhaustive search is a term of art that was

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well understood by those skilled in the art....” *E.g.*, Network-1’s Opening Br. (Case I D.I. 148) at 13. That assertion is contradicted by Network-1’s own evidence, as Google explained at last week’s hearing, and it is now contradicted by Network-1 itself. The mere fact that Network-1 has advanced two different constructions for “non-exhaustive search” highlights that the claim term lacks any established, plain and ordinary meaning to persons of ordinary skill in the art. In short, Network-1’s proposed “alternate” construction of “non-exhaustive search” is not only untimely; it also underscores the indefiniteness all of the asserted claims in which this term appears.

With respect to the unsolicited letter brief that Network-1 filed on November 26 (Case I D.I. 201), Google does not wish to burden the Court with another round of argument on matters that have been thoroughly addressed, including most recently at the hearing on November 21. Because of Network-1’s highly unorthodox decision to submit an unauthorized brief retreading the merits of the parties’ dispute, however, I feel compelled to make the following brief observations regarding Network-1’s submission.

First, Network-1 filed its letter brief without leave of Court, in contravention of the Case Management Plan and Scheduling Order setting forth the framework for claim construction briefing, and in violation of the Court’s Individual Rules of Practice governing the length of letters. *See* Case I D.I. 189; Individual Rule I.A. Accordingly, Google respectfully requests that the Court strike Network-1’s letter brief in its entirety.

Second, the Supreme Court’s opinion in *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831 (2015), speaks for itself, and Google accurately conveyed its import in its claim construction briefs and at last week’s hearing. Network-1’s citation to the unpublished opinion in *Bombardier Recreational Prods. Inc. v. Arctic Cat Inc.*, No. 2018-2388, 2019 WL 4593479 (Fed. Cir. Sept. 20, 2019), simply lends further support to Google’s observation at the claim construction hearing that courts encounter two distinct species of indefiniteness arguments. In a case in which the pertinent claim terms have been construed, and the issue is whether the claim *as construed* is indefinite, any genuine disputes of material fact underlying that issue may be submitted to a jury. *Bombardier* is an example of such a case. *See, e.g., id.* at *3, *6–7 (explaining that “[t]he district court adopted in large part the definition of ‘seat position’ identified in the specification and proposed by Bombardier” and “denied partial summary judgment of invalidity to Arctic Cat, holding that it could not determine whether the term ‘seat position defined by the seat’ in claim 88 of the ’669 patent was indefinite because Arctic Cat had focused its indefiniteness argument on the ambiguity of the court’s construction, not on the term as used in the patent”).

Conversely, in a case like this one, where the issue is whether the pertinent claim term can be construed at all, the Court can and should decide whether the claims at issue are indefinite in connection with the claim construction process. *Teva* is a paradigmatic example of such a case. *See Teva*, 135 S. Ct. at 835–36, 841–42; *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 789 F.3d

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1335, 1342, 1344–45 (Fed. Cir. 2015). In deciding whether the claims at issue are susceptible to construction or are indefinite, the Court can and should resolve any disputes regarding the “subsidiary facts” that are part of this inquiry, including whether the extrinsic evidence informs the meaning of the terms used in the patents. *See Teva*, 135 S. Ct. at 841 (“In some cases, however, the district court will need to look beyond the patent’s intrinsic evidence and to consult extrinsic evidence in order to understand, for example, the background science or the meaning of a term in the relevant art during the relevant time period. In cases where those subsidiary facts are in dispute, *courts* will need to make subsidiary factual findings about that extrinsic evidence.” (internal citation omitted, emphasis added)).

Third, neither the assertions of Network-1’s declarant, Dr. Michael Mitzenmacher, nor any other “extrinsic evidence” supply “genuine issues of fact” that “preclude[] summary judgment of indefiniteness.” Network-1’s Letter Brief (Case I D.I. 201) at 5–6. Dr. Mitzenmacher’s assertions that “a skilled artisan would have understood with reasonable certainty what searches were within the scope of the claims based on the specification’s focus on efficient searching,” *id.* at 5, do not create disputes of fact at all. *See Teva*, 789 F.3d at 1342 (“To the extent that Teva argues that the meaning of ‘molecular weight’ in the context of patents-in-suit is itself a question of fact, it is wrong. A party cannot transform into a factual matter the internal coherence and context assessment of the patent simply by having an expert offer an opinion on it.” (citing *Teva*, 135 S. Ct. at 841–42)). Moreover, Dr. Mitzenmacher’s assertions that the phrase “non-exhaustive search” “had a clear, ordinary meaning to persons skilled in the art,” Network-1’s Letter Brief (Case I D.I. 201) at 5, are belied by both his deposition testimony and the references submitted by Network-1, which establish that “the definition of exhaustive search is vague” because, among other things, “[e]ach problem has its own way of trying everything, and often many different ways.” Jon Orwant, et al., *Mastering Algorithms with Perl* (1999) (Case I D.I. 148-20; Network-1’s Ex. 9) at 183. And try as Network-1 might to explain away Dr. Mitzenmacher’s testimony that a search can be “exhaustive” even if, contrary to Network-1’s argument, it does *not* compare the query to each record in the dataset, his testimony was clear and unambiguous on this point. Deposition Tr. of Dr. Mitzenmacher (Case I D.I. 153-12; Google’s Ex. K) at 174:3–175:13. In any case, all of the testimony and references provided by Dr. Mitzenmacher in this matter have been submitted to the Court, which can decide whether Network-1’s extrinsic evidence is “contradictory” or “inconsistent” without further characterization from the parties. Network-1’s Letter Brief (Case I D.I. 201) at 6.

Fourth, there is nothing unclear about the Federal Circuit’s opinion concerning the term “non-exhaustive search” and its examination of the specifications of the patents-in-suit, and the parties addressed the import of the Court’s opinion at length in their briefs and at the claim construction hearing. Rather than reiterating those points, Google respectfully directs the Court to the Federal Circuit’s opinion, its two claim construction briefs, and the answers it provided in response to the Court’s questions at last week’s hearing. *See Google LLC v. Network-1 Techs., Inc.*, 726 F. App’x 779 (Fed. Cir. 2018); Google’s Response Br. (Case I D.I. 151) at 10–16; Google’s Sur-Reply Br. (Case I D.I. 163) at 2–6; Nov. 21, 2019 Hearing Tr. at 76–84.

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Fifth, Network-1’s request for “a live evidentiary hearing with Dr. Mitzenmacher,” Network-1’s Letter Brief (Case I D.I. 201) at 7, is both unwarranted and untimely. In August 2019 the parties reached agreement on the framework for the claim construction hearing, and at Network-1’s suggestion they advised the Court in a joint letter that “the parties do not intend to present expert testimony as part of the tutorial or at the remainder of the hearing.” Case I D.I. 169 at 1. The Court has permitted the parties ample opportunity to present their arguments and evidence, including two declarations from Dr. Mitzenmacher and a wide-ranging oral argument from Network-1’s counsel at last week’s hearing. The question whether the term “non-exhaustive search” is indefinite is ripe for determination, and Network-1 is not entitled to yet another bite at the apple, whether through a live evidentiary hearing or otherwise.

If the Court wishes to hear argument on the remaining claim terms—“correlation information” and “extracted features”—Google will be available at the Court’s convenience.

Sincerely,

/s/ Kevin Hardy

Kevin Hardy

Enclosure