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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, et al., Nos. 1:14-cv-2396-PGG-SN & 1:14-cv-9558-PGG-SN

Dear Judge Gardephe:

Plaintiff Network-1 Technologies, Inc. (“Network-1”) and Defendants Google LLC and YouTube, LLC (collectively “Google”) respectfully seek the Court’s guidance in setting a deadline for filing letters describing the grounds for proposed dispositive motions in accordance with Rule IV.A of the Court’s Individual Rules of Practice in Civil Cases.

The Court held an initial claim construction hearing in these cases on November 21, 2019. The Court has not yet set a date to continue that claim construction hearing. Since then, the parties have exchanged expert reports and agreed to a deadline of July 31, 2020 for completing expert discovery. *See* Dkt. No. 213 (order entering the parties’ stipulation).¹ The parties have been unable to reach agreement on the appropriate deadline for seeking leave to file motions for summary judgment or other dispositive motions pursuant to Rule IV.A. Both parties agree that the deadline for filing the letters described in Rule IV.A should be after the close of expert discovery. Network-1 submits that the deadline should be 14 days after the completion of expert discovery. Google submits that the deadline should be the later of 14 days after the completion of expert discovery or 14 days after the Court’s resolution of the outstanding claim construction issues.

The parties conferred about this issue by telephone on March 6, 2020, but were unable to reach agreement. The parties’ positions on the matter are set forth below.

¹ All citations to the docket refer to docket entries in Case No. 1:14-cv-2396-PGG-SN.



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Network-1's Position

In Network-1's view, the Court should not postpone the submission of letters concerning proposed dispositive motions until all claim construction issues are resolved.

First, prior to the Court entering the parties' stipulations to extend the expert discovery period (Dkt. Nos. 209, 211, 213), the Court's scheduling orders did not contemplate tying dispositive motion letter briefing deadlines to a resolution of all claim construction issues. *See, e.g.*, Dkt. Nos. 189, 200. Rather, the deadline for letters seeking leave to file dispositive motions was set for fourteen days after the close of expert discovery, with opposition letters due seven days later. *See, e.g.*, Dkt. No. 200 at 1. Network-1 sees no reason to deviate from the previously set forth schedule for letter briefing concerning proposed dispositive motions.

Second, proceeding with the dispositive motion letter briefing shortly after expert discovery is completed, as contemplated by the Court's prior scheduling orders, will not result in inefficiencies. Rather, the letter briefing process will allow the parties and the Court to evaluate whether the proposed summary judgment grounds are of the type that truly rest on the resolution of claim construction issues or not. At that time, there would be more information available to the Court to decide whether or not formal summary judgment briefing should proceed before a *Markman* order issues. Indeed, the parties may raise summary judgment issues that are entirely unrelated to claim construction, or may raise issues that in some sense involve terms yet to be construed, but for which briefing may efficiently proceed. Moreover, some Courts in this district elect to handle claim construction and summary judgment simultaneously, which depending on the issues raised, could be appropriate here. *See, e.g., Financeware, Inc. v. UBS Fin. Servs.*, No. 11-cv-5503, 2011 U.S. Dist. LEXIS 140608, at *9-10 (S.D.N.Y. Dec. 7, 2011) (Keenan, J.). It is impossible for the Court to fully evaluate whether formal summary judgment briefing should proceed if the letter briefing process is put on hold.

Third, it is unlikely that the Court's *Markman* order will moot the need for summary judgment briefing here. As Google recognizes, it challenges only two claims terms as indefinite, and those indefiniteness challenges only touch on two of the three patents involved in this case—the term “non-exhaustive search” appears in the '988 and '464 patent claims and the term “correlation information” appears in only the '464 patent claims. The claims of the '237 patent do not contain any terms that Google contends are indefinite. And the only other disputed term is “extracted features,” for which the parties offer similar constructions.

In sum, to avoid unnecessary delay in this case, Network-1 respectfully requests that the Court enter the proposed Scheduling Order attached as Exhibit A to this letter. This proposed Scheduling Order sets the deadline for the submission of letters concerning proposed dispositive motions for fourteen days after the close of expert discovery and the deadline for opposition letters seven days after the opening letter. These are the same timeframes contemplated by the Court's prior scheduling orders, before the expert discovery deadline was extended.



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Google's Position

In Google's view, the deadline to submit letters concerning proposed dispositive motions should be the later of 14 days after the close of expert discovery or 14 days after the Court resolves the claim construction disputes that the parties briefed last year. *See* Dkt. Nos. 148, 151–53, 158, 163–64, and 201–02. Google respectfully submits that it would be far more efficient for the parties to seek leave to file motions for summary judgment after the Court has resolved the three pending claim construction issues.

The claim construction arguments on November 21, 2019 focused principally on whether the claim term “non-exhaustive search” is indefinite. That term appears in most of the claims asserted by Network-1 and affects every asserted claim in two of the three patents at issue in this case. *See* Claim No. 17 of U.S. Patent No. 8,010,988 and Claim Nos. 1, 8, 10, 16, 18, 25, 27, and 33 of U.S. Patent No. 8,904,464. The Court's resolution of the parties' dispute concerning the “non-exhaustive search” term has the potential to significantly affect the scope of this case and the parties' summary judgment submissions. There is no reason for the parties and the Court to devote resources to briefing and evaluating potential grounds for summary judgment that may be affected or mooted by the Court's resolution of an issue that has already been fully briefed and argued.

The other two claim construction issues before the Court concern whether the term “correlation information” is indefinite and how the term “extracted features” should be construed. Although the former issue need not be decided if the Court determines that “non-exhaustive search” is indefinite, the latter term appears in asserted claims that do not contain the term “non-exhaustive search.” *See* Claim Nos. 33–35 of U.S. Patent No. 8,205,237. Thus, the Court's resolution of these issues could also affect the parties' summary judgment submissions, irrespective of how the Court resolves the dispute concerning the indefiniteness of “non-exhaustive search.”

There is no sound basis for Network-1's proposal to proceed with letter briefing and evaluating grounds for summary judgment before the outstanding claim construction disputes have been resolved. Network-1's proposal could lead to two rounds of summary judgment submissions—one that precedes resolution of the disputed claim construction issues and a second that follows it. At the very least, Network-1's proposal will force the parties and the Court to waste resources addressing grounds for summary judgment that may be affected or mooted by the Court's claim construction order.

To avoid these unnecessary inefficiencies, the deadline for requesting leave to file dispositive motions should follow the Court's resolution of the parties' outstanding claim construction disputes. Google respectfully requests that the Court enter the proposed Scheduling Order attached as Exhibit B to this letter.



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Dated: June 16, 2020

Respectfully submitted,

RUSS, AUGUST & KABAT

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