

# Exhibit 16

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Paper 6  
Entered: June 23, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC.,  
Petitioner,

v.

NETWORK-1 TECHNOLOGIES, INC.,  
Patent Owner.

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Case IPR2015-00347  
Patent 8,010,988 B2

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

PETTIGREW, *Administrative Patent Judge*.

DECISION  
Institution of *Inter Partes* Review  
*37 C.F.R. § 42.108*

I. INTRODUCTION

Petitioner, Google Inc., filed a Petition for *inter partes* review of claims 1–3, 7–17, 21–34, 37, 38, 40–43, 46, 47, and 49–52 of U.S. Patent No. 8,010,988 B2 (Ex. 1001, “the ’988 patent”). Paper 2 (“Pet.”). Patent

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Owner, Network-1 Technologies, Inc., filed a Preliminary Response. Paper 5 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and the Preliminary Response, we conclude the information presented shows there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 15–17, 21–28, 31–33, 38, 51, and 52 of the ’988 patent.

#### A. *Related Matters*

The parties state that Patent Owner has asserted the ’988 patent against Petitioner in *Network-1 Technologies, Inc. v. Google Inc. and YouTube, LLC*, No. 1:14-cv-02396 (S.D.N.Y.) (filed Apr. 4, 2014). Pet. 1; Paper 3, 2 (Patent Owner’s Mandatory Notice). Petitioner states that YouTube, LLC, is a subsidiary of Petitioner and a real party-in-interest with respect to the Petition. Pet. 1. Petitioner has filed petitions for *inter partes* review of three related patents that also are at issue in that district court proceeding: IPR2015-00343 (U.S. Patent No. 8,640,179 B1), IPR2015-00345 (U.S. Patent No. 8,205,237 B2), and IPR2015-00348 (U.S. Patent No. 8,656,441 B1). Paper 3, 2–3.

#### B. *The ’988 Patent*

The ’988 patent relates to identifying a work, such as a digital audio or video file, without the need to modify the work. Ex. 1001, 1:23–28, 4:43–49. This identification can be accomplished by extracting features from the work and comparing the extracted features with records in a

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database. *Id.* at Abstract. Thereafter, an action associated with the work may be determined based on the identification of the work. *Id.* at 4:42–44.

Patent Owner refers to Figure 1 as illustrating the steps of the claimed method (Prelim. Resp. 4):

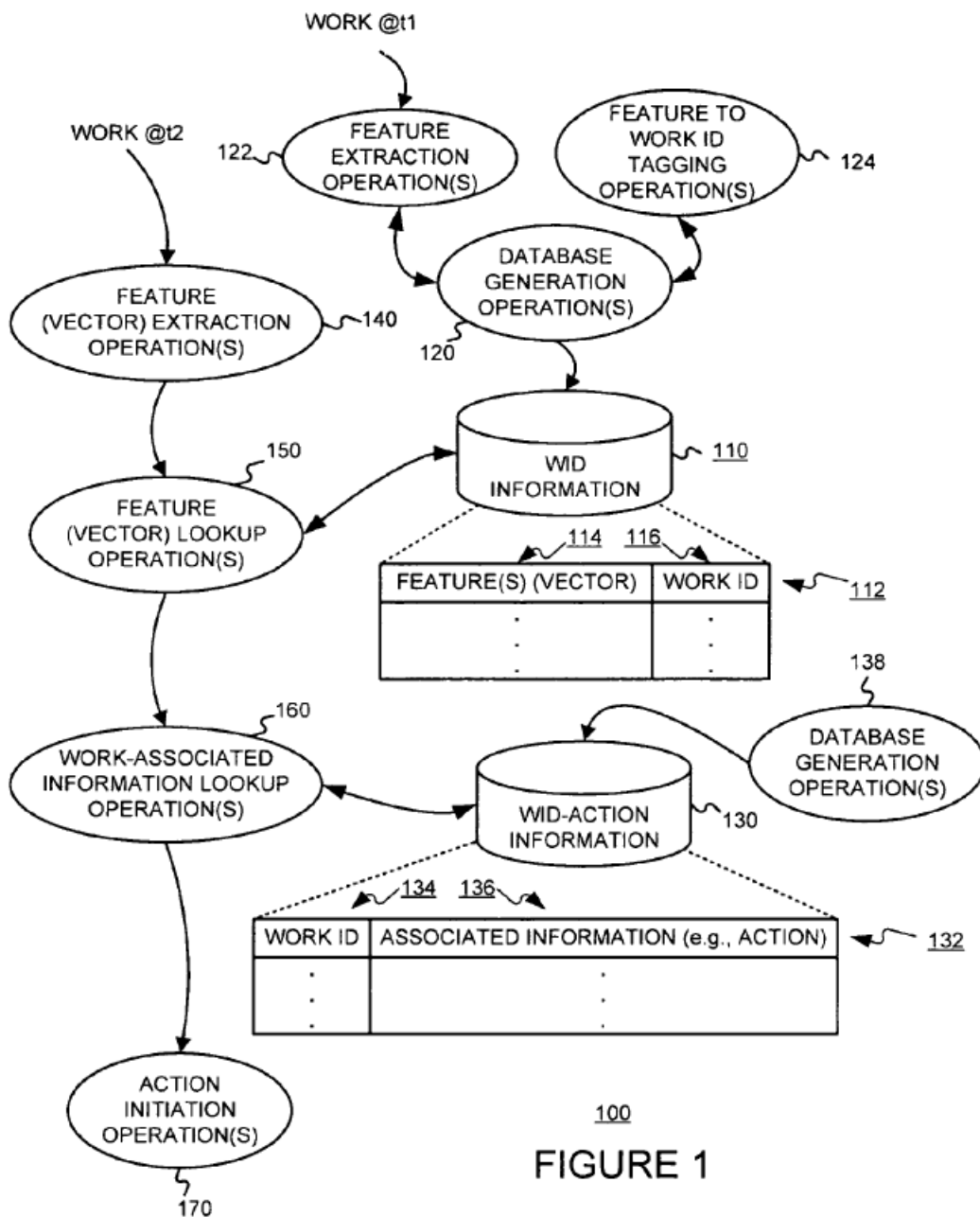


Figure 1 of the '988 patent illustrates steps of the claimed method.

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*C. Illustrative Claims*

Claims 1 and 15 are the only independent claims in the '988 patent and are illustrative of the subject matter of the challenged claims:

1. A method for associating an electronic work with an action, the electronic work comprising at least one of audio and video, the method comprising:
  - a) electronically extracting within a portable client device features from the electronic work;
  - b) transmitting the extracted features from the portable client device to one or more servers;
  - c) receiving at the portable client device from the one or more servers an identification of the electronic work based on the extracted features, wherein the identification is based on a non-exhaustive search identifying a neighbor;
  - d) electronically determining an action based on the identification of the electronic work; and
  - e) electronically performing the action on the portable client device.
  
15. A method for associating an electronic work with an action, the electronic work comprising at least one of audio and video, the method comprising:
  - a) electronically extracting features from the electronic work;
  - b) electronically determining an identification of the electronic work based on the extracted features, wherein the identification is based on a non-exhaustive search identifying a neighbor;
  - c) electronically determining an action based on the identification of the electronic work; and
  - d) electronically performing the action.

Ex. 1001, 25:14–29; 25:65–26:9.

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