



**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

NETWORK-1 TECHNOLOGIES, INC.,

Plaintiff,

v.

GOOGLE LLC and YOUTUBE, LLC,

Defendants.

14 Civ. 2396 (PGG-SN)

14 Civ. 9558 (PGG-SN)

**PLAINTIFF NETWORK-1 TECHNOLOGIES, INC.'S
OBJECTIONS TO THE MAGISTRATE'S ORDER STRIKING PORTIONS OF ITS
EXPERT'S SUPPLEMENTAL EXPERT REPORT**

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I. INTRODUCTION

Pursuant to Federal Rule of Civil Procedure 72(a), Plaintiff Network-1 Technologies, Inc. objects to Dkt. No. 283¹ (“Magistrate’s Order”) granting a motion to strike brought by Defendants Google LLC and YouTube LLC (collectively, “Google”). The Magistrate’s Order strikes portions of Network-1’s supplemental expert report addressing one reason why the late-proposed non-infringing alternative that Google was allowed to introduce through the supplemental discovery authorized by the Magistrate is not viable—because it would have infringed another, non-asserted Network-1 patent, U.S. Patent No. 9,538,216 (“the ’216 patent”). To avoid any confusion on this point, Network-1 is not attempting to assert the ’216 patent against Google via this supplemental report and is not seeking damages for infringement of this patent in the presently pending cases; rather, infringement of the ’216 patent by Google’s proposed alternative is simply one of many reasons why the alternative that was the subject of the supplemental discovery is not a viable *non-infringing* alternative to products that infringe the asserted patents. Network-1 also notes that neither the Magistrate’s Order, nor this Objection, bear on the parties’ pending motions for summary judgment, which are fully briefed.

Network-1 respectfully requests this Court overrule the Magistrate’s Order in its entirety.

First, the Magistrate Judge clearly erred in granting Google’s motion to strike Dr. Mitzenmacher’s analysis concerning the ’216 patent because the *primary factual predicate* underlying the order (that the ’216 patent was not disclosed prior to the close of the supplemental fact discovery period) *is false*. Rather, Google’s own expert analyzed multiple documents disclosing the ’216 patent in his initial expert report. The Magistrate’s Order should be set aside in its entirety on this basis alone.

¹ Citations to the docket are to the docket of Case No. 14 Civ. 2396 (PGG-SN).

The Magistrate Judge also clearly erred by finding that Google would be unduly prejudiced if the motion to strike were not granted; this finding was based on the same false factual predicate, and in any event, Google would not be prejudiced if Dr. Mitzenmacher's analysis were not struck because its expert had ample time to respond to it.

In addition, the Magistrate Judge clearly erred in striking Dr. Mitzenmacher's '216 patent analysis by not recognizing that (a) he could not have presented his opinions concerning the '216 patent in his initial report because he needed information disclosed in the supplemental discovery period in order to do that under the governing law, and (b) his '216 patent analysis thus did indeed rely on information only disclosed during the supplemental discovery period.

Finally, the Magistrate Judge clearly erred by deciding these complex issues via an abbreviated letter briefing process, which caused confusion of the issues and prejudiced Network-1 because it did not have ample opportunity to fully present the facts and law underlying the motion to the Court. If Google wishes to raise this issue, it needs to be addressed with full briefing, for example, at the *in limine* stage, as this is when Network-1 will seek to exclude Google's late-disclosed non-infringing alternative contentions, which necessitated supplemental discovery and the portions of the supplemental expert report that Google now seeks to strike in the first place.

II. FACTUAL BACKGROUND

A. Overview of Asserted Patents, Accused Products, and Google's Initial Damages Theories Concerning Purported Non-Infringing Alternatives

A brief overview of the patents and technology involved is useful to understand the instant dispute. In the presently pending cases, Network-1 has asserted three patents against Google's Content ID systems. As noted above, this does not include the '216 patent. For purposes of understanding this dispute, claim 33 of U.S. Patent No. 8,205,237 ("the '237 patent") can serve as a representative patent claim:

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