UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

NETWORK-1 TECHNOLOGIES, INC.,

Plaintiff,

-against-

GOOGLE LLC and YOUTUBE, LLC,

Defendants.

MEMORANDUM OPINION & ORDER

14 Civ. 2396 (PGG)
14 Civ. 9558 (PGG)

PAUL G. GARDEPHE, U.S.D.J.:

Plaintiff Network-1 Technologies, Inc. alleges that Defendants Google LLC and YouTube LLC (collectively, "Defendants" or "Google") have infringed three of Plaintiff's patents in connection with Defendants' "Content ID system and its implementation . . . [on] the YouTube [web]site." (Cmplt. (Dkt. No. 2) ¶¶ 28, 34; 14 Civ. 9558 Cmplt. (Dkt. No. 1) ¶ 28)[1] Plaintiff alleges that Defendants have infringed the following patents: United States Patent No. 8,010,988 (the "'988 Patent"); U.S. Patent No. 8,205,237 (the "'237 Patent"); and U.S. Patent No. 8,904,464 (the "'464 Patent").

Pending before the Court are (1) the parties' proposed construction of claims; (2) Defendants' motion for summary judgment on grounds of non-infringement; (3) Plaintiff's cross-motion for summary judgment as to certain affirmative defenses; and (4) Plaintiff's appeal from an October 14, 2022 discovery order issued by Magistrate Judge Sarah Netburn.

For the reasons stated below, the Court concludes that the asserted claims of the '988 and '464 Patents are invalid as indefinite, and that Defendants are entitled to summary judgment on Plaintiff's infringement claim premised on the asserted claims of the '237 Patent.

[1] Unless otherwise noted, all citations refer to the docket in 14 Civ. 2396.

Plaintiff's cross-motion for summary judgment will be denied, and Plaintiff's appeal from Judge Netburn's discovery order will be denied as moot.

I. FACTS[2]

A. Plaintiff's Patents

All three patents at issue were originally issued to Dr. Ingemar Cox, a professor of computer science at University College London. These patents are now owned by Plaintiff. (See Cmplt. (Dkt. No. 2) ¶¶ 7-10)

The patents at issue "link[] traditional media to new interactive media, such as that provided over the [i]nternet," and address the "identif[ication] [of] a [media] work without the need of inserting an identification code into a [media] work." ('988 Patent (Dkt. No. 148-4) col. 1, 4); '237 Patent (Dkt. No. 148-5) col. 1, 4 (same); '464 Patent (Dkt. No. 148-6) col. 1, 4 (same))[3] "[E]mbodiments consistent with the [patents at issue] provide a computer-implemented method, apparatus, or computer-executable programs for linking a media work to an action. Such embodiments might (a) extract features from the media work, (b) determine an identification of the media work based on the features extracted using a sub-linear time search, such as an approximate nearest neighbor search for example, and (c) determine an action based

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[2] To the extent that this Court relies on facts drawn from a party's Local Rule 56.1 statement, it has done so because the opposing party has either not disputed those facts or has not done so with citations to admissible evidence. See Giannullo v. City of New York, 322 F.3d 139, 140 (2d Cir. 2003) ("If the opposing party . . . fails to controvert a fact so set forth in the moving party's Rule 56.1 statement, that fact will be deemed admitted." (citations omitted)). Where the non-moving party disputes the moving party's characterization of cited evidence, and has presented an evidentiary basis for doing so, the Court relies on the non-moving party's characterization of the evidence. See Cifra v. Gen. Elec. Co., 252 F.3d 205, 216 (2d Cir. 2001)

[3] Except as to deposition transcripts and patents, the page numbers of documents referenced in this Order correspond to the page numbers designated by this District's Electronic Case Files ("ECF") system. With respect to deposition transcripts, the Court cites to the page numbers originally assigned by the court reporter. With respect to patents, the Court cites to the internal sheet, figure, and column numbers.

on the identification of the media work determined." ('237 Patent (Dkt. No. 148-5) col. 4; '464 Patent (Dkt. No. 148-6) col. 4 (same); '988 Patent (Dkt. No. 148-4) col. 4 (same))

Claim 15 of the '988 Patent concerns:

> 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.

('988 Patent (Dkt. No. 148-4) col. 25-26)

Claim 17 of the '988 Patent concerns "[t]he method of claim **15**, wherein the non-exhaustive search is sublinear." (Id. at col. 26 (emphasis in original))

Claim 33 of the '237 Patent concerns:

> A computer-implemented method comprising:
>
> a) obtaining, by a computer system including at least one computer, media work extracted features that were extracted from a media work, the media work uploaded from a client device;
>
> b) determining, by the computer system, an identification of the media work using the media work extracted features to perform a sublinear approximate nearest neighbor search of reference extracted features of reference identified media works; and
>
> c) determining, by the computer system, an action based on the determined identification of the media work.

('237 Patent (Dkt. No. 148-5) col. 28)

Claim 34 of the '237 Patent concerns "[t]he method of claim **33**, wherein the action comprises providing to and/or displaying, at another client device, additional information in association with the media work." (Id. (emphasis in original))

Claim 35 of the '237 Patent concerns "[t]he method of claim **34** wherein the additional information is an advertisement." (Id. (emphasis in original))

Claim 1 of the '464 Patent concerns:

> A method comprising:
>
> receiving, by a computer system including at least one computer, a first electronic media work;
>
> correlating, by the computer system using a non-exhaustive, near neighbor search, the first electronic media work with an electronic media work identifier;
>
> storing, by the computer system, correlation information associating the first electronic media work and the electronic media work identifier;
>
> accessing, by the computer system, associated information related to an action to be performed in association with one or more electronic media works corresponding to the electronic media work identifier;
>
> generating, by the computer system, a tag associated with the first electronic media work;
>
> providing, from the computer system to a user electronic device, the first electronic media work and the associated tag;
>
> obtaining, by the computer system from the user electronic device, a request related to the associated tag;
>
> generating, using the computer system, machine-readable instructions based upon the associated information to be used in performing, at the user electronic device, the action; and
>
> providing, from the computer system to the user electronic device, the machine-readable instructions to perform the action in response to the request.

('464 Patent (Dkt. No. 148-5) col. 24-25)

Claim 8 of the '464 Patent concerns "[t]he method of claim **1**, wherein the first electronic media work is received from a first electronic device, the associated information is received from a second electronic device, and the first electronic device, the second electronic device, and the user electronic device are different from one another." (Id. at col. 25 (emphasis in original))

Claim 10 of the '464 Patent concerns "[t]he method of claim **1**, wherein the associated information is related to an advertisement." (Id. (emphasis in original))

Claim 16 of the '464 Patent concerns "[t]he method of claim **1**, wherein the machine-readable instructions comprise a hyperlink to a URL." (Id. (emphasis in original))

Claim 18 of the '464 patent concerns:

> A method comprising:
>
> receiving, by a computer system including at least one computer, associated information related to an action to be performed in association with a first electronic media work identifier;
>
> receiving, by the computer system, a first electronic media work;
>
> correlating, by the computer system using a non-exhaustive, near neighbor search, the first electronic media work with the first electronic media work identifier;
>
> storing, by the computer system, correlation information associating the first electronic media work and the first electronic media work identifier;
>
> generating, by the computer system, a tag associated with the first electronic media work;
>
> providing, from the computer system to a first user electronic device, the first electronic media work and the tag;
>
> receiving, at the computer system, a request generated at the first user electronic device and related to the tag;
>
> generating, using the computer system, machine-readable instructions based upon the associated information to be used in performing, at the user electronic device, the action; and

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