

Filed on behalf of NETWORK-1 TECHNOLOGIES, INC.

By: Charles R. Macedo (Reg. No. 32,781)  
Amster, Rothstein & Ebenstein LLP  
90 Park Avenue  
New York, NY 10016  
Telephone: (212) 336-8074  
Facsimile: (212) 336-8001  
[cmacedo@arelaw.com](mailto:cmacedo@arelaw.com)  
[N1-Google-IPR@arelaw.com](mailto:N1-Google-IPR@arelaw.com)

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 IPR2015-00345  
Patent 8,205,237 B2

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**PATENT OWNER NETWORK-1'S  
IDENTIFICATION OF IMPROPER REPLY ARGUMENTS**

The Board authorized this Paper in a conference call on February 24, 2016.

Petitioner has the burden of making out a *prima facie case* in its Petition, which “must specify where each element of the claim is found in the prior art.” 37 C.F.R. § 42.104(b)(4). Moreover, Petitioner’s “reply may only respond to arguments raised in the...patent owner response.” 37 C.F.R. § 42.23(b). Petitioner’s Reply in this IPR improperly raises five new theories and cites different sections of the art in an attempt to establish a new *prima facie case*. This Paper explains one example and identifies four others.

***New prima facie theory 1—Iwamura, “sublinear”***

<p><u>Petition</u>: “Iwamura discloses searching using the ‘Boyer-Moore algorithm’...which is sublinear.” Pet. 10-11.</p>	<p><u>Reply</u>: “Iwamura discloses a sublinear search when .wav files are added to a database of MIDI files.” Reply 16-18.</p>
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During cross examination, Petitioner’s declarant, confronted with the actual Boyer-Moore paper, admitted that his declaration was wrong and that Boyer-Moore is not sublinear. Moulin (Ex. A2006) 61:18-24; 74:20-24; 78:16-22.

In its Reply, Petitioner did not respond to Patent Owner’s demonstration that Boyer-Moore is not sublinear. Instead, Petitioner abandoned Boyer-Moore and shifted to a new *prima facie case*: “Iwamura discloses a sublinear search

when .wav files are added to a database of MIDI files.” Reply 17. This Reply assertion was the first time this theory was mentioned in the IPR record and therefore cannot be used to establish Petitioner’s *prima facie* case. *Eizo Corp. v. Barco N.V.*, IPR2014-00358, Paper 21 at 14 (PTAB July 14, 2015) (it is “a new argument, and we will not consider it for purposes of this Decision”).

Moreover, had Patent Owner been given the opportunity to present evidence on this new theory, Patent Owner would have demonstrated that it fails. In fact, Iwamura does not disclose adding .wav files to a database of MIDI files. The only reference to .wav files in Iwamura is found at 3:65-4:4 addressing the query—the melody file generated by the user that is compared to records in the music database. The “music melody database” (5:13) does not appear until two columns later (5:13-5:25), and MIDI files are the only file type in the database.

***New prima facie theory 2—Iwamura, “approximate nearest neighbor”***

<p><u>Petition</u>: Iwamura discloses an approximate nearest neighbor search because it discloses “input fault tolerance[s]” and “portions that should not be searched.” Pet. 12.</p>	<p><u>Reply</u>: Iwamura discloses an approximate nearest neighbor search because “Iwamura’s ‘peak notes’ search does not necessarily even consider the closest match, let alone identify it.” Reply 13-14.</p>
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***New prima facie theory 3—Iwamura, “non-exhaustive”***

<p><u>Petition</u>: Iwamura discloses a non-exhaustive search because it discloses using “peak notes” and a search that “can be accelerated by stopping the search when computations ‘exceed[] a certain limit.’” Pet. 15.</p>	<p><u>Reply</u>: Iwamura discloses a non-exhaustive search because “[t]he ‘possible matches’ in Iwamura are melody segments, not full songs” and “Iwamura does not consider all melody segments.” Reply 8-13.</p>
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***New prima facie theories 4 and 5—Ghias, “approximate nearest neighbor”***

<p><u>Petition</u>: Ghias discloses an approximate neighbor search because it generates “a ranked list of approximately matching melodies” or “the single most approximate matching melody.” Pet. 45.</p>	<p><u>Reply theory 4</u>: Ghias discloses an approximate nearest neighbor search because “when Ghias performs a second search on the second query considering only the results of the first search, it may not consider the reference(s) that would be the closest match to the second work.” Reply 20-22.</p> <p><u>Reply Theory 5</u>: “Ghias cannot always identify the closest match in a group of close matches” because “references with the same number of character mismatches may not be equal quality matches.” Reply 22-24.</p>
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Respectfully submitted,

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By: /Charles R. Macedo/  
Charles R. Macedo (Reg. No. 32,781)  
AMSTER, ROTHSTEIN & EBENSTEIN LLP  
90 Park Avenue  
New York, NY 10016  
(212) 336-8000  
[cmacedo@arelaw.com](mailto:cmacedo@arelaw.com)  
[N1-Google-IPR@arelaw.com](mailto:N1-Google-IPR@arelaw.com)

Gregory Dovel (admitted *pro hac vice*)  
Dovel & Luner, LLP  
201 Santa Monica Blvd., Suite 600  
Santa Monica, CA 90401  
(310) 656-7066

*Counsel for Patent Owner*

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