

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.
Petitioner,

v.

NETWORK-1 TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2015-00345
Patent 8,205,237 B2

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

TURNER, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Google Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–27, 29, 30, 32–35, 37, 38, and 40 of U.S. Patent No. 8,205,237 B2 (Ex. 1001, “the ’237 Patent”). Network-1

Technologies, Inc. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 5 (“Prelim. Resp.”). We instituted the instant trial on June 23, 2015, with respect to claims 1–16, 21–27, 29, 30, 33–35, 37, and 38, pursuant to 35 U.S.C. § 314. Paper 6 (“Dec.”).

Subsequently, Patent Owner filed a Response (Paper 17, “PO Resp.”), and Petitioner filed a Reply (Paper 20, “Reply”). Further to authorization provided in a conference call, Patent Owner filed a paper identifying allegedly improper arguments in the Reply (Paper 24), and Petitioner filed a response thereto (Paper 25). Oral hearing¹ was held on March 9, 2016, and a transcript of the hearing was entered into the record. Paper 29 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons set forth below, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 9–16, 23, and 24 of the ’237 Patent are unpatentable, but has not shown that claims 1–8, 21, 22, 25–27, 29, 30, 33–35, 37, and 38 of the ’237 Patent are unpatentable.

A. Related District Court Proceedings

The parties inform us that the ’237 Patent is the subject of the following lawsuit: *Network-1 Technologies, Inc. v. Google Inc. and YouTube, LLC*, Case No. 1:14-cv-02396 (S.D.N.Y.). Pet. 1. YouTube, LLC is a subsidiary of Petitioner, and is acknowledged as a real party-in-interest. *Id.* In addition, three additional patents, U.S. Patent Nos. 8,640,179, 8,010,988, and 8,656,441, all issuing from applications related to the ’237

¹ The hearings for this review and IPR2015-00343, IPR2015-00347, and IPR2015-00348 were consolidated.

Patent, are subject to *inter partes* reviews, namely IPR2015-00343, IPR2015-00347, and IPR2015-00348, respectively.

B. The '237 Patent

The '237 Patent relates to identifying a work, such as a digital audio or video file, without the need to modify the work. Ex. 1001, 1:31–36, 4:25–31. This identification can be accomplished through the extraction of features from the work, and comparison of those extracted features with records of a database or library. *Id.* at Abstract. Thereafter, an action may be determined based on the identification determined. *Id.* at 4:24–25.

Figure 1, reproduced below, illustrates the steps of the claimed computer-implemented methods:

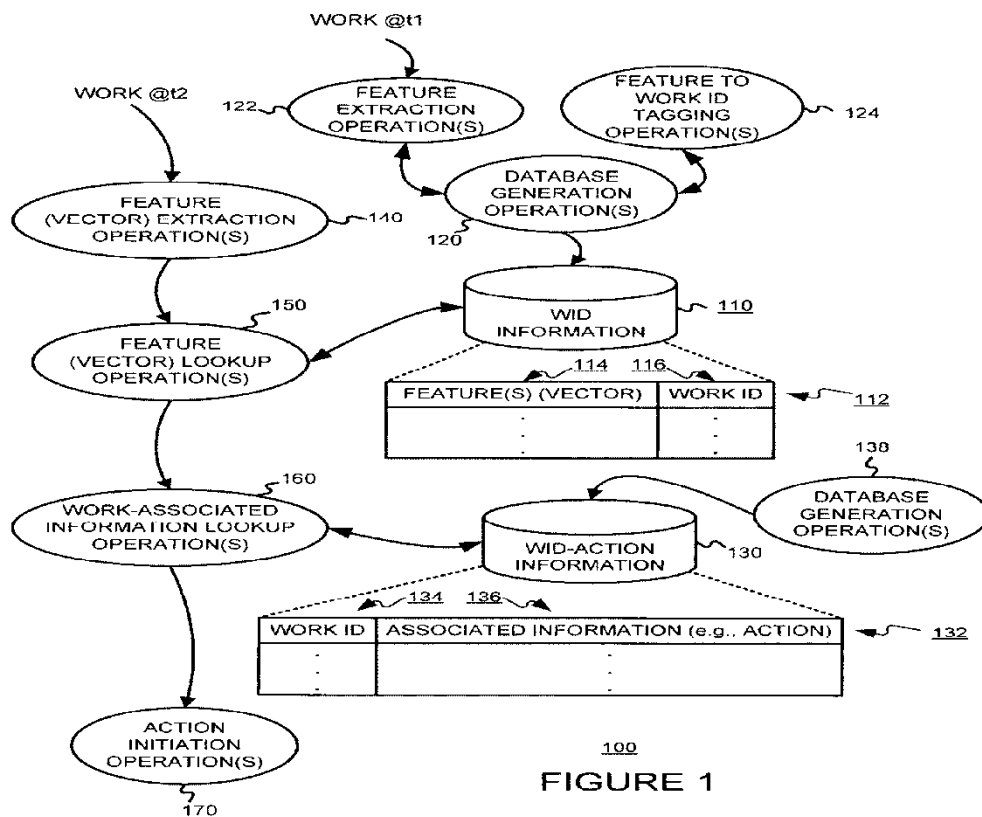


Fig. 1 of the '237 Patent illustrating the claimed method

C. Illustrative Claims

Claim 1 is independent, along with claims 5, 9, 13, 25, and 33.

Claims 1, 9, and 25 are considered representative of the claims challenged, and are reproduced below:

1. A computer-implemented method comprising:
 - a) receiving, by a computer system including at least one computer, features that were extracted from a media work by a client device;
 - b) determining, by the computer system, an identification of the media work using the received features extracted from the media work to perform a *sub-linear time search* of extracted features of identified media works to identify a neighbor; and
 - c) transmitting, by the computer system, information about the identified media work to the client device.

9. A computer-implemented method comprising:
 - a) receiving, by a computer system including at least one computer, features what were extracted from media work by a client device;
 - b) determining, by the computer system, an identification of the media work using the received features extracted from the media work to perform an *approximate nearest neighbor search* of extracted features of identified media works; and
 - c) transmitting, by the computer system, information about the identified media work to the client device.

25. 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 nonexhaustive search* of reference extracted features of reference media works to identify a near neighbor; and
- c) determining, by the computer system, an action based on the determined identification of the media work.

Ex. 1001, 25:2–13, 25:62–26:5, 27:11–22 (emphases added).

D. Prior Art Relied Upon

Based on the instituted grounds, Petitioner relies upon the following prior art references:

Reference or Declaration	Exhibit No.
U.S. Patent No. 7,444,353 (“Chen”)	Ex. 1008
U.S. Patent No. 5,874,686 (“Ghias”)	Ex. 1010
U.S. Patent No. 6,188,010 (“Iwamura”)	Ex. 1012

E. Grounds of Unpatentability

We instituted the instant trial based on the following grounds of unpatentability (Dec. 21–22):

Claims Challenged	Basis	Reference(s)
1, 3–5, 7–9, 11–13, 15, 16, 21–25, 29, 30, 33, 37, and 38	§ 102(e)	Iwamura
1–3, 5–7, 9–11, 13–15, and 21–24	§ 102(b)	Ghias
26, 27, 34, and 35	§ 103	Iwamura and Chen

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the

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