

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.
Petitioner,

v.

NETWORK-1 TECHNOLOGIES, INC.,
Patent Owner.

Cases IPR2015-00343, IPR2015-00345, IPR2015-00347, and IPR2015-00348¹
Patents 8,640,179, 8,205,237, 8,010,988, and 8,656,441

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

TURNER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ We use this caption in this paper to indicate that this Order applies to, and is entered in all indicated cases. The parties are not authorized to use this caption.

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An initial conference call in *inter partes* reviews IPR2015-00343, IPR2015-00345, IPR2015-00347, and IPR2015-00348 occurred on July 24, 2015. Respective counsel for Petitioner and Patent Owner, and Judges Turner, Pettigrew, and Tornquist were in attendance. The purpose of the call was to discuss proposed changes to the Scheduling Order (Paper 7) and any motions that the parties intend to file. Neither party filed a proposed motions list prior to the initial conference call.

The parties had no specific issues with the Scheduling Order. The parties indicated that there was a protective order in place in the ongoing, stayed litigation, but no material that requires such protection has been made of record in the instant proceedings. The parties also indicated that, while some settlement discussions may have occurred because of required mediation in the district court litigation, there is presently no current path to settlement between the parties at this time.

The parties are reminded that prior authorization is required for all motions filed with the Board. Petitioner further indicated that it did not oppose the Patent Owner's Motion for Pro Hac Vice admission of Greg Dovel (Paper 10), and we indicated that a decision on that Motion would be forthcoming. Patent Owner also indicated that no decision on whether to file a Motion to Amend had yet been made.

The Board directs the attention of the parties to *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper Nos. 27 and 68; *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper Nos. 26 and 66; and *ZTE Corporation and ZTE (USA) Inc. v. Contentguard Holdings, Inc.*,

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IPR2013-00136, Paper No. 33, which discuss the requirements of a motion to amend claims. *See also Microsoft Corp. v. Proxycorr, Inc.*, No. 14-1542, -1543 (Fed. Cir. June 16, 2015) (establishing that patent owner has the burden of establishing that it is entitled to the proposed amended claims) and *MasterImage 3D, Inc. v. RealD Inc.*, IPR2015-00040, Paper 42 (PTAB July 15, 2015) (providing further guidance on the meaning of “prior art of record” and “prior art known to the patent owner” in the context of motions to amend). If the Patent Owner should decide to file a motion to amend claims, it must initiate a conference call with the Board prior to such filing to confer about the intended motion.

We also indicated the criticality of the date for Oral Hearing (Paper 7, Due Date 7: March 9, 2016), given the large number of post-grant proceedings, such that changes to that Due Date are often difficult to accommodate. We further indicated that the total time devoted to the Oral Hearing, if requested, would be dependent on the number of issues in the proceedings, as briefed in Patent Owner’s Response and Petitioner’s Reply.

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