

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

**PATENT OWNER'S UPDATED MANDATORY NOTICE
PURSUANT TO 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8, Patent Owner Network-1 Technologies, Inc. (“Patent Owner” or “Network-1”) hereby submits the following updated mandatory notice information.

Related Matters Under 37 C.F.R. § 42.8(b)(2)

U.S. Patent No. 8,205,237 (“the ‘237 Patent”) is the subject of litigation between Patent Owner and Petitioner in the U.S. District Court for the Southern District of New York, namely, *Network-1 Technologies, Inc. v. Google Inc. and YouTube, LLC*, Case No. 1:14-cv-02396 (“the Litigation”).

U.S. Patent No. 8,640,179 (“the ‘179 Patent”) issued from an application related to the ‘237 Patent family. The ‘179 Patent is also the subject of the Litigation. In addition, the ‘179 Patent is at issue in the *inter partes* review Case IPR2015-00343, which was requested by the Petitioner. The Board instituted *inter partes* review in this case on June 23, 2015 (*see Google, Inc. v. Network-1 Technologies, Inc.*, IPR2015-00343, Paper 6 (PTAB June 23, 2015)).

U.S. Patent No. 8,010,988 (“the ‘988 Patent”) issued from an application related to the ‘237 Patent family. The ‘988 Patent is also the subject of the Litigation. In addition, the ‘988 Patent is at issue in the *inter partes* review Case IPR2015-00347, which was requested by the Petitioner. The Board instituted *inter partes* review in this case on June 23, 2015 (*see Google, Inc. v. Network-1 Technologies, Inc.*, IPR2015-00347, Paper 6 (PTAB June 23, 2015)).

U.S. Patent No. 8,656,441 (“the ‘441 Patent”) issued from an application related to the ‘237 Patent family. The ‘441 Patent is also the subject of the Litigation. In addition, the ‘441 Patent is at issue in the *inter partes* review Case IPR2015-00348, which was requested by the Petitioner. The Board instituted *inter partes* review in this case on June 23, 2015 (*see Google, Inc. v. Network-1 Technologies, Inc.*, IPR2015-00348, Paper 6 (PTAB June 23, 2015)).

Pursuant to agreement between the parties, on July 2, 2015, the District Court stayed the Litigation until further order of the Court following the issuance of the Board’s final written decisions in IPR2015-00343, IPR2015-00345, IPR2015-00347, and IPR2015-00348. (Dkt. No. 85).

U.S. Patent No. 8,904,464 (“the ‘464 Patent”) issued from an application related to the ‘237 Patent family. The ‘464 Patent is the subject of litigation between Patent Owner and Petitioner in the U.S. District Court for the Southern District of New York, namely, *Network-1 Technologies, Inc. v. Google Inc. and YouTube, LLC*, Case No. 1:14-cv-09558 (“the ‘464 litigation”). The ‘464 Patent is also at issue in the covered business method patent review Case CBM2015-00113, which was requested by the Petitioner. The Board instituted CBM patent review in this case on October 19, 2015 (*see Google Inc. v. Network-1 Technologies, Inc.*, CBM2015-00113, Paper 7 (PTAB Oct. 19, 2015)). Pursuant to agreement between

the parties, on November 3, 2015, the District Court stayed the '464 litigation pending the Board's final written decision in CBM2015-00113. (Dkt. No. 39).

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN
LLP

Attorneys for Patent Owner
90 Park Avenue
New York, NY 10016
(212) 336-8000

Dated: November 5, 2015

By: /Charles R. Macedo/
Charles R. Macedo
Registration No. 32,781

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PATENT OWNER'S UPDATED MANDATORY NOTICE PURSUANT TO 37 C.F.R. § 42.8** is being served by electronic mail this 5th day of November 2015 on counsel for Petitioner as follows:

James J. Elacqua
Douglas R. Nemec
Skadden, Arps, Slate, Meagher & Flom LLP
525 University Avenue
Suite 1400
Palo Alto, California 94301
Telephone: (650) 470-4510
Facsimile: (650) 798-6564
DLGOOGLE1N@skadden.com
James.Elacqua@skadden.com
Douglas.Nemec@skadden.com

Dated: November 5, 2015

By: /Charles R. Macedo/
Charles R. Macedo
Registration No. 32,781