

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

**PATENT OWNER'S MANDATORY NOTICES
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 mandatory notice information in connection with Petitioner Google Inc.’s Petition for *Inter Partes* Review of U.S. Patent No. 8,205,237 (Case IPR2015-00345).

A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)

The real party-in-interest is Network-1 Technologies, Inc., the assignee of record for U.S. Patent No. 8,205,237 (“the ‘237 Patent”).

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

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 has not decided whether to institute this *inter partes* review.

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 has not decided whether to institute this *inter partes* review.

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 has not decided whether to institute this *inter partes* review.

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.

C. Lead and Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)

Pursuant to 37 C.F.R. §§ 42.8(b)(3) and 42.10(a), Patent Owner provides the following designation of lead and back-up counsel, as well as their respective service information.

Lead Counsel	Back-Up Counsel
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 E-mail: cmacedo@arelaw.com	Brian A. Comack (Reg. No. 45,343) Amster, Rothstein & Ebenstein LLP 90 Park Avenue New York, NY 10016 Telephone: (212) 336-8098 Facsimile: (212) 336-8001 E-mail: N1-Google-IPR@arelaw.com

The above designated counsel is already counsel of record in the '237 Patent. Accordingly, no additional power of attorney accompanies this designation of counsel pursuant to 37 C.F.R. § 42.10(b).

D. Service Information Under 37 C.F.R. § 42.8(b)(4)

Service information (by e-mail, postal mailing, or hand-delivery) for lead and back-up counsel is provided in the above designation of lead and back-up counsel.

The Patent Trial and Appeal Board is hereby authorized to charge any fees associated with this submission by Patent Owner to Deposit Account No. 01-1785.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN
LLP

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

Dated: December 22, 2014

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

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.