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VIA ECF

Peter R. Marksteiner
Circuit Executive and Clerk of Court
United States Court of Appeals
for the Federal Circuit
717 Madison Place, N.W., Room 401
Washington, D.C. 20439

Re: *Network-1 Technologies, Inc. v. Hewlett-Packard Company, Hewlett Packard Enterprise Company*, Nos. 18-2338 (Lead), -2339, -2395, -2396

Dear Colonel Marksteiner:

This appeal was argued on November 4, 2019, before Chief Judge Prost and Judges Newman and Bryson. Pursuant to Rule 28(j), HP respectfully submits that *Facebook, Inc. v. Windy City Innovations, LLC*, No. 2018-1400 (Fed. Cir. Mar. 18, 2020), further confirms that the district court erred in holding that HP was estopped from asserting invalidity at trial.

AIA estoppel attaches to grounds that a petitioner "raised or reasonably could have raised during" an IPR. 35 U.S.C. § 315(e)(2). The district court ruled that "the fact that HP sought joinder with Avaya's [previously instituted] IPR does not mean that HP could not have reasonably raised different grounds from those raised by Avaya." Appx91. Network-1 defended that ruling on appeal, arguing that "[n]o statute ... limits a petition with a request for joinder to only the identical grounds already asserted in an existing proceeding." YB at 46 (citing *Proppant Express Invs., LLC v. Oren Techs., LLC*, IPR2018-00914 (PTAB Mar. 13, 2019)).

HP argued that, even under *Proppant*, joinder parties were rarely if ever permitted to raise new grounds, and thus HP could not "reasonably" have done so. RB at 56-61. In response to a question from the bench, HP further argued that 35 U.S.C. § 315(c) prohibits an otherwise time-barred party from raising any new grounds when joining an existing IPR. Oral Arg. at 36:30-37:35 (discussing *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1020 (Fed. Cir. 2017) (concurring opinion)).

Windy City disapproved *Proppant* and held, in accordance with the *Nidec* concurrence, that when a party joins a previously instituted IPR, Section 315(c) "does not authorize the

joined party to bring new issues from its new proceeding into the existing proceeding, particularly when those new issues are otherwise time-barred." Slip op. 18. It necessarily follows from *Windy City* that HP could *not* reasonably have raised the Fisher Patents Ground during the Avaya IPR, and therefore was not estopped from asserting that ground at trial. The district court committed legal error in concluding otherwise, and thus the jury's verdict of invalidity should be reinstated.

Respectfully submitted,

/s/ *Mark A. Perry*

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