

***Network-1 Tech., Inc. v. Hewlett-Packard Co. et. al.*, Nos. 2018-2338, -2339, -2395, -2396, 2020 WL 6814481 (modified November 20, 2020) (Fed. Cir. 2020)**

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Network-1 sued HP, among others, for patent infringement. Another defendant then filed an *inter partes* review (IPR) petition. Following institution, HP filed its own petition on different grounds and a motion to join the instituted IPR. The Board denied HP's request. HP then filed another IPR petition containing only the grounds on which the Board had instituted and filed a motion to join the instituted IPR. The Board granted HP's motion and held that the claims were not unpatentable. The Federal Circuit affirmed.

Following the IPR, the district court held a jury trial. The jury found the asserted patent was both not infringed and invalid based on prior art that was not at issue in the IPR. But the district court then granted Network-1's motion for judgment as a matter of law that HP was estopped from raising the invalidity arguments under 35 U.S.C. § 315(e)(2) because it had joined in the IPR and the invalidity arguments "reasonably could have been raised" in the IPR. Network-1 appealed the district court decision and HP cross-appealed.

On appeal, HP argued that no validity ground raised at trial "reasonably could have [been] raised" through its joinder to the IPR. The Federal Circuit agreed and held that HP was not estopped from raising its validity challenges. It stated that "the joinder provision does not permit a joining party to bring into the proceeding new grounds that were not already instituted." It may only join the already-instituted IPR. Under 35 U.S.C. § 315(e)(2), "a party is only estopped from challenging claims in the final written decision based on grounds that it 'raised or reasonably could have raised' during the IPR." The court held that "[b]ecause a joining party cannot bring with it grounds other than those already instituted, that party is not statutorily estopped from raising other invalidity grounds." The Federal Circuit thus vacated the district court's judgment as a matter of law and remanded the case.

**Statutory estoppel for a party who joins an instituted IPR is limited to the validity arguments actually raised in the IPR.**

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#### **RELATED ESTOPPEL CASE**

- *Hologic, Inc. v. Minerva Surgical, Inc.*, 957 F.3d 1256 (Fed. Cir. 2020) (IPR provides patent assignors with a loophole for avoiding assignor estoppel. "Although [the company founded by the patent assignor] would have been estopped from challenging the validity of the [assigned] patent claims in district court, it was able to challenge their validity in an IPR proceeding and, hence, circumvent the assignor estoppel doctrine.").