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November 13, 2018

**VIA CM/ECF**

Hon. Paul G. Gardephe  
United States District Court Judge  
United States District Court for the  
Southern District of New York  
40 Foley Square, Room 2204  
New York, New York 10007

Re: *Network-1 Technologies, Inc. v. Google LLC, et al.* Case No. 1:14-cv-2396 (PGG) (“Case 1”) (MHD), and *Network-1 Technologies, Inc. v. Google LLC, et al.*, Case No. 1:14-cv-9558 (PGG) (“Case 2”)

Dear Judge Gardephe:

We write to update the Court in response to its memo endorsement (ECF No. 116), dated November 16, 2016, ordering the parties “to advise the Court every 90 days as to the status of the Federal Circuit appeals” pertinent to the above-captioned proceedings.

As noted in previous letters to the Court, the relevant Federal Circuit appeals are No. 17-1379 (the “CBM Appeal”) and Nos. 16-2509, -2510, -2511, -2512 (the “Consolidated IPR Appeals”). In the CBM Appeal (relating to the sole patent at issue in Case 2), the Federal Circuit has issued a decision affirming the Patent Trial and Appeal Board’s final decision with respect to the only patent at issue in that appeal. The parties have made a joint submission regarding the stay in connection with that case (Case No. 14-cv-9558, Dkt. # 71).

In the Consolidated IPR Appeals (relating to the patents at issue in Case 1), the Federal Circuit has issued a decision vacating the Board’s final decisions with respect to two patents, vacating in part the Board’s final decisions with respect to the remaining two patents, and remanding all four decisions to the Board for further proceedings. Some claims in some of the asserted patents were upheld by the Board, but not challenged on appeal. Those claims were not the subject of the Federal Circuit’s remand. On July 10, 2018, the Federal Circuit denied a petition for panel rehearing or rehearing en banc filed by Network-1 Technologies, Inc. The Federal Circuit’s mandate issued on July 19, 2018, and the four decisions have now been remanded to the Board for further proceedings (except with respect to the claims that were

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upheld and not appealed). Those remanded proceedings remain pending before the Board, which has not yet issued a schedule governing the proceedings.

Network 1's Statement

Based on the above-reported status, there are a number of claims that have been confirmed as valid in the IPR's and either affirmed on appeal, or not appealed (the "Confirmed Claims"). Network 1 is prepared to proceed with its claims based on these Confirmed Claims and agree to dismiss the Remand Claims with prejudice from this litigation. Accordingly, Network 1 believes the stay should be lifted and these long-delayed cases should now proceed. Network 1 has been working with Google on a stipulation to lift the stay and limit the case to the Confirmed Claims. Network 1 intends to file either a stipulation or a letter motion to lift the stay by November 20, 2018. Network 1 requests a status conference at the Court's earliest convenience.

Defendants' Statement

At present the remanded IPR proceedings remain pending and there have been no changes that warrant lifting the stays in the cases. Google confirms that the parties are in discussions concerning potentially limiting these cases; those discussions may or may not lead to an agreement concerning the stays currently in place. To date, the parties have not reached agreement on an appropriate path forward, but their discussions are continuing.

\* \* \*

The parties are available for a telephone conference if the Court believes that would be helpful.

Sincerely,

*//Bruce Genderson//*

Bruce Genderson  
Counsel for Google LLC

*//Brian Ledahl//*

Brian Ledahl  
Counsel for Network-1 Technologies, Inc.