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ATTORNEYS FOR DEFENDANT  
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18 **UNITED STATES DISTRICT COURT**  
19 **NORTHERN DISTRICT OF CALIFORNIA**  
20 **OAKLAND DIVISION**

21 WINDY CITY INNOVATIONS, LLC,

22 Plaintiff,

23 v.

24 FACEBOOK INC.,

25 Defendant.

Case Nos.4:16-cv-01729-YGR  
4:16-cv-01730-YGR

Related Actions

**STIPULATION AND [PROPOSED]  
ORDER TO STAY LITIGATION  
PENDING INTER PARTES REVIEW**

**\*As Modified by the Court\***

1 WINDY CITY INNOVATIONS, LLC,  
2  
3 Plaintiff,  
4 v.  
5 MICROSOFT CORPORATION,  
6 Defendant.

7  
8 Pursuant to Local Rules 6-2 and 7-12, plaintiff Windy City Innovations, LLC (“Plaintiff”) and defendants Facebook Inc. (“Facebook”) and Microsoft Corporation (“Microsoft”) (collectively, “Defendants”) jointly submit this stipulated request for an order staying the present litigation pending *Inter Partes* Review (“IPR”) by the United States Patent and Trademark Office (“PTO”) of U.S. Patent Nos. 8,407,356 (“the ’356 patent”), 8,458,245 (“the ’245 patent”), 8,473,552 (“the ’552 patent”), and 8,694,657 (“the ’657 patent”) (collectively, “the Patents-in-Suit”). The parties jointly stipulate and submit as follows:

15 WHEREAS, Plaintiff asserts in the above-captioned actions that Defendants have infringed  
16 the Patents-in-Suit;

17 WHEREAS, the PTO recently instituted IPR proceedings regarding each of the Patents-in-  
18 Suit as follows (collectively, “Instituted IPR Proceedings”):

- 19
- 20 • On December 8, 2016, the PTO instituted IPR on ’657 Patent claims 1, 2, 18, 27, 35,  
21 43, 51, 65, 79, 93, 100, 108, 114, 126, 138, 150, 156, 168, 170, 172, 176, 178, 180,  
22 182-90, 202, 208, 214, 220, 226, 238, 250, 262, 268, 274, 280, 292, 304, 316, 322,  
23 328, 334, 336, 340, 342, 344, 346, 348, 350, 352-54, 362, 366, 370, 374, 378, 386,  
24 394, 402, 406, 410, 414, 422, 430, 438, 442, 450, 452, 454, 456, 458, 460, 462, 464-  
25 66, 476, 481, 486, 491, 496, 505, 515, 525, 530, 535, 545, 555, 565, 570, 580, 582,  
26 584, 586, 588, 590, 592, 594, 596-98, 606, 607, 615-17, 619, 621, 622, 624-26, 628,  
27 630, 632-34, 636, 638, 640-42, 644, 646, and 648-71 in IPR2016-01155;
  - 28 • On December 8, 2016, the PTO instituted IPR regarding ’356 Patent claims 1-37 in

1 IPR2016-01067;

- 2 • On December 12, 2016, the PTO instituted IPR regarding '245 patent claims 1-40 in  
3 IPR2016-01141;
- 4 • On December 12, 2016, the PTO instituted IPR regarding '552 patent claims 1-59 and  
5 64 in IPR2016-01158;
- 6 • On December 12, 2016, the PTO instituted IPR regarding '657 patent claims 189, 334,  
7 342, 348, 465, 580, 584, and 592 in IPR2016-01159;
- 8 • On December 15, 2016, the PTO instituted IPR regarding '356 patent claims 1-9, 12,  
9 14-28, 31, and 33-37 in IPR2016-01157; and
- 10 • On December 15, 2016, the PTO instituted IPR regarding '245 patent claims 1-15, 17,  
11 and 18 in IPR2016-01156.

12 WHEREAS, the PTO denied instituting IPR proceedings on the following IPR petitions:

- 13 • On November 29, 2016, the PTO denied institution regarding '552 patent claims 1-17,  
14 50-53, 58, and 64 in IPR2016-01137;
- 15 • On November 29, 2016, the PTO denied institution regarding '552 patent claims 18-  
16 49, 54-57, and 59-63 in IPR2016-01138;
- 17 • On November 29, 2016, the PTO denied institution regarding '552 patent claims 1-58  
18 in IPR2016-01146; and
- 19 • On November 29, 2016, the PTO denied institution regarding '552 patent claims 59-  
20 64 in IPR2016-01147.

21 WHEREAS, in the above-captioned actions, the Court has not yet conducted claim  
22 construction proceedings or scheduled the close of discovery or trial;

23 WHEREAS, pursuant to the Patent Statute, the PTO must issue a Final Written Decision in  
24 each Instituted IPR Proceeding within 1 year of the date of institution, which may be extended by no  
25 more than 6 months for good cause shown (35 U.S.C. §§ 316(a)(11), 318(a));

26 WHEREAS, the Court previously indicated its preference to stay the present litigation  
27 pending *Inter Partes* Review proceedings;

28

1           WHEREAS, for purposes of judicial economy and to avoid the unnecessary expenditure of  
2 resources, the parties desire to stay the present litigation pending Final Written Decisions of the  
3 Instituted IPR Proceedings;

4           WHEREAS, the parties agree that after the Final Written Decisions have issued in all of the  
5 Instituted IPR Proceedings, the parties shall jointly request that the Court schedule a joint status  
6 conference at the Court's convenience to be conducted no earlier than 60 days after all of the Final  
7 Written Decisions have issued;

8           NOW THEREFORE IT IS HEREBY STIPULATED by the parties through their respective  
9 counsel, subject to the approval of the Court, that the above-captioned actions are hereby stayed until  
10 further order of the Court. After the Final Written Decisions have issued in all of the Instituted IPR  
11 Proceedings, the parties shall jointly request that the Court schedule a joint status conference at the  
12 Court's convenience to be conducted no earlier than 60 days after all of the Final Written Decisions  
13 have issued.

14           IT IS SO STIPULATED.  
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1 Dated: December 23, 2016

CALDWELL CASSADY & CURRY

2 /s/ Bradley Caldwell

3 Bradley Caldwell

4 Attorneys For Plaintiff,  
5 Windy City Innovations, LLC

6 Dated: December 23, 2016

COOLEY LLP

7 /s/ Heidi L. Keefe

8 Heidi L. Keefe

9 Attorneys For Defendant,  
10 Facebook, Inc.

11 Dated: December 23, 2016

SIDLEY AUSTIN LLP

12 /s/ Irene Yang

13 Irene Yang

14 Attorneys For Defendant,  
15 Microsoft Corp.

16 **PURSUANT TO STIPULATION, IT IS SO ORDERED.**

17 The Court further **SETS** a compliance hearing regarding the status of the aforementioned *inter partes*  
18 *review* for **Friday, June 30, 2017 at 9:00 a.m.** in the Federal Building, 1301 Clay Street, Oakland,  
19 Courtroom 1. By **June 23, 2017**, the parties must file a Joint Statement updating the Court on the  
20 status of the *inter partes review*. If the Court is satisfied with the parties' submission, the  
21 compliance hearing may be taken off calendar and the parties need not appear.

22 DATED: December 28, 2016

23   
24 HON. YVONNE GONZALEZ ROGERS  
25 United States District Judge  
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27  
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