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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

WINDY CITY INNOVATIONS, LLC
Plaintiff,
v.
FACEBOOK, INC.
Defendant.

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

**JOINT STATEMENT REGARDING
STATUS OF *INTER PARTES* REVIEW
PROCEEDINGS**

1 In accordance with the Court's December 28, 2016 Order staying the above-captioned
 2 litigation (ECF No. 76) and the Court's June 26, 2017 Order continuing the June 30, 2017
 3 compliance hearing (ECF No. 80), Plaintiff Windy City Innovations LLC ("Windy City") and
 4 Defendant Facebook, Inc. ("Facebook") (together, "the Parties") hereby notify the Court that the
 5 PTAB issued Final Written Decisions in the *inter partes* reviews ("IPR") of U.S. Patent Nos.
 6 8,407,356 ("the '356 patent"), 8,458,245 ("the '245 patent"), 8,473,552 ("the '552 patent"), and
 7 8,694,657 ("the '657 patent") (collectively, "the Patents-in-Suit").

8 **Outcome of IPR Proceedings at PTAB.** The results of the Final Written Decisions, all
 9 having issued on December 6, 2017, are as follows:

Patent	Claims Found Unpatentable	Claims Not Found Unpatentable
8,407,356	1-9, 12, 14-28, 31, 33-37	None
8,458,245	1-15, 17, 18	19, 22-25
8,473,552	2, 3, 5, 7, 10-17, 59, 64	1, 4, 6, 8, 9, 18-58
8,694,657	189, 334, 342, 348, 465, 477, 482, 487, 492, 580, 584, 592	203, 209, 215, 221

14 Both Windy City and Facebook have the right to appeal the PTAB's decisions. The
 15 deadline to file Notices of Appeal is no later than February 7, 2018.

16 **Status of Asserted Claims.** In the Court's Scheduling Order, Windy City was required
 17 to make a Preliminary Election of Asserted Claims, asserting no more than ten claims from each
 18 patent and not more than a total of 32 claims across all four asserted patents (ECF No. 68). The
 19 chart below summarizes the status of all asserted claims asserted by Windy City against Facebook:

Patent	Asserted Claims Found Unpatentable	Asserted Claims Not Found Unpatentable
8,407,356	1, 2, 7, 14, 16, 19, 20, 26, 33, 35	None
8,458,245	None	19, 22-25
8,473,552	10, 14, 15, 16, 17, 59, 64	None
8,694,657	189, 465, 477, 482, 487, 492	203, 209, 215, 221

20 Windy City has reserved the right to seek leave of the Court to substitute or otherwise amend its
 21 list of asserted claims should circumstances, including the Court's claim constructions and the
 22 PTAB's decisions, so merit. Facebook does not agree that Windy City should be permitted to
 23 substitute any asserted claims.
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1 **Request for Joint Status Conference.** The Court's Order granting the parties'
2 Stipulation to Stay Litigation Pending IPR (Doc. No. 76) requires the parties to request a joint
3 status conference at the Court's convenience to be conducted no earlier than 60 days after all of
4 the Final Written Decisions have issued. Windy City and Facebook respectfully request that the
5 Court set this joint status conference on Monday, February 12, 2018 at 2:00 p.m., or as soon
6 thereafter as the Court's schedule permits.
7

8 **Motion to Lift Stay.** Plaintiff has informed Facebook that it intends to file a motion
9 asking the Court to lift the stay and set a schedule for this case. Facebook opposes any motion to
10 lift the stay at this time. Facebook intends to appeal the PTAB's findings that certain challenged
11 claims are not unpatentable to the United States Court of Appeals for the Federal Circuit.
12 Facebook understands that Windy City has not yet made any decision about appealing the PTAB's
13 findings that certain challenged claims are unpatentable.
14

15 **Compliance Hearing.** The Court has set a compliance hearing regarding the status of
16 the IPRs for Friday December 29, 2017 at 9:00 a.m. Should the Court wish to proceed with this
17 hearing, the Parties are happy to appear before the Court at that time. Subject to the Court's
18 preference, however, the Parties have agreed that the joint status conference required by the
19 Court's Order granting the parties' Stipulation to Stay Litigation Pending IPR (Doc. No. 76), as
20 requested above, is an appropriate time to address any issues relating to setting a schedule in this
21 case.
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1 Dated: December 21, 2017

Respectfully submitted,

2 CALDWELL CASSADY & CURRY

3
4 /s/ Warren J. McCarty, III

5 Warren J. McCarty, III
6 Attorneys for Plaintiff
WINDY CITY INNOVATIONS, LLC

7
8 Dated: December 21, 2017

COOLEY LLP

9
10 /s/ Heidi L. Keefe

11 Heidi L. Keefe
12 Attorneys for Defendant
FACEBOOK, INC.

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16 **FILER'S ATTESTATION**

17 Pursuant to Civil Local Rule 5.1(i)(3), the undersigned attests that all parties have
18 concurred in the filing of this Joint Statement Regarding Status of *Inter Partes Review*
19 Proceedings.

20
21 DATED: December 21, 2017

COOLEY LLP

22
23
24 By: /s/ Heidi L. Keefe
Heidi L. Keefe