

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION,  
Petitioner,

v.

WINDY CITY INNOVATIONS LLC,  
Patent Owner.

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Case IPR2016-01155 (Patent 8,694,657 B1)  
Case IPR2016-01067 (Patent 8,407,356 B1)  
Case IPR2016-01141 (Patent 8,458,245 B1)

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Before KARL D. EASTHOM, DAVID C. MCKONE, and J. JOHN LEE,  
*Administrative Patent Judges.*

MCKONE, *Administrative Patent Judge.*

DECISION  
Motion to Terminate  
*37 C.F.R. § 42.74*

IPR2016-01155 (Patent 8,694,657 B1)  
IPR2016-01067 (Patent 8,407,356 B1)  
IPR2016-01141 (Patent 8,458,245 B1)

On April 24, 2017, Petitioner Microsoft Corporation and Patent Owner Windy City Innovations, LLC, filed a Joint Motion to Terminate Proceeding in each of the above-captioned proceedings (Paper 29<sup>1</sup>) and a Joint Motion to Treat Settlement Agreement as Business Confidential Information in each proceeding (Paper 30). The parties represent that they have reached a Settlement Agreement, which is in writing and a true copy of which has been filed in conjunction with the above motions as required under 37 C.F.R. § 42.74(b). Paper 28, 2; Ex. 2015. The parties also certify that no other agreements exist between the parties concerning these cases or the patents at issue. Paper 28, 2.

“An *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a). Pursuant to Section 317(a), we grant the Motions to Terminate as to Petitioner Microsoft.

Prior to the settlement between Microsoft and Windy City, Facebook, Inc., filed Petitions for *inter partes* review of U.S. Patent Nos. 8,694,657 B1, 8,407,356 B1, and 8,458,245 B1, along with corresponding Motions for Joinder with IPR2016-01155, IPR2016-01067, and IPR2016-01141, respectively. *See Facebook, Inc. v. Windy City Innovations LLC.*, Case IPR2017-00622, Papers 2, 3; *Facebook, Inc. v. Windy City Innovations LLC.*, Case IPR2017-00624, Papers 2, 3; *Facebook,*

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<sup>1</sup> Unless otherwise specified, we refer to the paper and exhibit numbering in IPR2016-01155. Similar filings were made in each of the above-captioned cases.

IPR2016-01155 (Patent 8,694,657 B1)

IPR2016-01067 (Patent 8,407,356 B1)

IPR2016-01141 (Patent 8,458,245 B1)

*Inc. v. Windy City Innovations LLC*, Case IPR2017-00655, Papers 2, 3.

Windy City filed its Preliminary Responses to Facebook's Petitions in IPR2017-0622 and IPR2017-00624 on April 17, 2017, and its Preliminary Response to Facebook's Petition in IPR2017-00655 on May 2, 2017. We have not yet ruled on Facebook's Petitions or its Motions for Joinder.

Under Section 317(a), if, after termination as to Microsoft, "no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a)." Our rules echo our discretion to terminate as to Patent Owner or to proceed with the trial. *See* 37 C.F.R. § 42.74(a) ("[T]he Board is not a party to the settlement and may independently determine any question of jurisdiction, patentability, or Office practice."). In exercise of this discretion, we hold in abeyance our rulings on the Motions to Terminate as to Windy City until we have ruled on Facebook's Petitions and Motions for Joinder in IPR2017-00622, IPR2017-00624, and IPR2017-00655.

We further determine that the Settlement Agreement filed by the parties constitutes business confidential information. Therefore, the parties' Joint Motions to Treat Settlement Agreement as Business Confidential Information are granted.

## **ORDER**

It is

ORDERED that the parties' Joint Motions to Terminate Proceedings are *granted* as to Petitioner Microsoft Corporation; and

FURTHER ORDERED that the parties' Joint Motions to Treat Settlement Agreement as Business Confidential Information are *granted*,

IPR2016-01155 (Patent 8,694,657 B1)

IPR2016-01067 (Patent 8,407,356 B1)

IPR2016-01141 (Patent 8,458,245 B1)

and Exhibit 2015 of IPR2016-01155, Exhibit 2015 of IPR2016-01067, and Exhibit 2011 of IPR2016-01141, shall be kept separate from the pertinent file consistent with 37 C.F.R. § 42.74(b).

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