

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,
Patent Owner.

Case IPR2017-00622
Patent 8,694,657 B1

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

McKONE, *Administrative Patent Judge.*

Institution of *Inter Partes* Review and
Order Granting Petitioner's Motion
for Joinder of IPR2017-00622 With IPR2016-01155
37 C.F.R. § 42.108
37C.F.R. § 42.122(b)

I. INTRODUCTION

On January 7, 2017, Facebook, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.” or “Joinder Petition”) for *inter partes* review of U.S. Patent No. 8,694,657 B1 (Ex. 1001, “the ’657 patent”). With its Petition, Petitioner filed a Motion for Joinder (Paper 3, “Mot.”) with *Microsoft Corp. v. Windy City Innovations, LLC*, Case No. IPR2016-01155 (“the Microsoft IPR”). Windy City Innovations, LLC (“Patent Owner”) filed an Opposition to Facebook’s Motion for Joinder (Paper 7, “Opp.”) and a Preliminary Response (Paper 9, “Prelim. Resp.”). Petitioner filed a Reply to Opposition to Motion for Joinder (Paper 8, “Reply”).

The Petition was filed after the one-year statutory time period set forth in 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b). Nevertheless, as Petitioner notes (Mot. 4), the time bar does not apply if the Petition is accompanied by a request for joinder and joinder is granted. *See* 35 U.S.C. § 315(b); 37 C.F.R. § 42.122(b). Since the filing of Petitioner’s Motion for Joinder, Microsoft and Patent Owner settled and, on April 24, 2017, moved to terminate the Microsoft IPR. Microsoft IPR, Paper 29. On May 10, 2017, we granted the motion to terminate as to Microsoft, but held the motion in abeyance as to Patent Owner pending the outcome of Petitioner’s Motion for Joinder. Microsoft IPR, Paper 31.

The Microsoft IPR involves challenges to approximately 150 claims of the ’657 patent. Microsoft IPR, Paper 1, 3–4 (“Microsoft Petition” or “Original Petition”). By contrast, Petitioner challenges only two of those claims, claims 189 and 465. Mot. 1. On May 4, 2017, we held a conference call with Petitioner and Patent Owner to discuss the impact of settlement between Microsoft and Patent Owner on the Motion for Joinder. In

preparation for the conference call, we asked the parties to be prepared to discuss how the Motion to Terminate in the Microsoft IPR changes or affects the Motion for Joinder, in particular with respect to the following issues if joinder were to be granted: (1) case schedules, (2) discovery, and (3) claims on which trial was instituted in IPR2016-01155 but which Petitioner does not challenge in its Petition. Below, we grant the Joinder Motion, explain why the Petition establishes a reasonable likelihood that Petitioner will prevail with respect to claims 189 and 465, and explain that the scope of the joined proceeding is limited to the patentability of claims 189 and 465.

II. ANALYSIS

A. Petitioner Has Shown that Joinder Is Appropriate

Other panels of this Board have counseled that a motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.

See, e.g., Kyocera Corp. v. Softview LLC, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

As explained below, the Petition is substantively the same as the Microsoft Petition as to claims 189 and 465; thus, there are no new grounds of unpatentability or new evidence asserted in the Petition. Also, we expect the impact of joinder on the existing schedule, briefing, and discovery to be minimal. Petitioner filed its Petition and Motion for Joinder months before Microsoft and Patent Owner settled; thus, continuation of the Microsoft IPR

after settlement was foreseeable and any prejudice to Patent Owner due to continuation is not undue. Thus, joinder is appropriate.

1. The Substance of the Petition Is the Same as the Microsoft IPR

As Petitioner argues (Mot. 6), we “routinely grant[] motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Electronics Co., Ltd. v. Raytheon Co.*, Case IPR2016-00962, slip op. at 9 (PTAB Aug. 24, 2016) (Paper 12) (emphases in original). The parties disagree whether the Petition advances the same substance for claims 189 and 465 as advanced in the Microsoft IPR.

According to Petitioner, “[t]he Joinder Petition [Paper 3] is substantively the same as the Original Petition [of IPR2016-01155] as to the subset of challenged claims, with only non-substantive differences such as those related to the formalities of the different party filing the petition.”

Mot. 7.

Patent Owner argues that Petitioner seeks to correct mistakes in the Microsoft Petition “by including nearly 18 pages worth of arguments against Claim 189” and “blatantly attempts to insert new arguments in its Joinder Petition.” Opp. 2. Patent Owner cites generally to pages 32–37 of the Petition, but identifies no examples of corrections or new arguments. *Id.* Patent Owner further argues that Petitioner “propos[ed] multiple claim constructions on the same ’657 Patent for each of the proposed terms in the Joinder Petition, positioning itself to improperly benefit from inconsistent and alternative constructions before the Board.” *Id.* at 3. Patent Owner does not list any examples of such inconsistencies. We note that Petitioner has

copied the claim construction arguments presented by Microsoft in the Microsoft IPR. *Compare* Microsoft Pet. 8–12 *with* Pet. 9–14.

In reply, Petitioner argues that “[t]he Original Petition devoted 14 pages to Claim 1 plus a few additional pages to Claim 189 because much of the Claim 189 analysis referred back to similar limitations of Claim 1,” and “[t]he Joinder Petition does not address Claim 1 and therefore presents the same substantive analysis as to Claim 189 in the first instance.” Reply 1. According to Petitioner, “the Original Petition accounted for this difference between Claims 1 and 189, and the Joinder Petition adopts the same analysis that the Original Petition presented on these limitations.” *Id.* at 2.

We have analyzed the Petition in this proceeding and the Microsoft Petition. In the Microsoft IPR, Microsoft presented its analysis primarily for claim 1. Microsoft Pet. 18–32. For claim 189, Microsoft referred back to its analysis of claim 1 for overlapping material and supplemented it with additional analysis particular to claim 189. *Id.* at 32–37. Petitioner’s analysis of claim 189 in the Petition in this proceeding appears simply to copy the substance presented for both claim 1 and claim 189 in the Microsoft Petition, albeit presented together for claim 189. Pet. 18–35. Patent Owner has not pointed to any examples where Petitioner has deviated from the analysis presented by Microsoft and we find no substantive differences. Accordingly, we agree with Petitioner that the Petition’s analysis of claim 189 in this proceeding is substantively the same as Microsoft’s analysis in the Microsoft proceeding, and we reject Patent Owner’s arguments to the contrary.

For claim 465, both the Microsoft Petition and the present Petition simply refer back to the respective analysis presented for claim 189.

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