

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC.,  
Petitioner,

v.

WINDY CITY INNOVATIONS LLC,  
Patent Owner.

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Case IPR2016-01067 (Patent 8,407,356 B1)<sup>1</sup>  
Case IPR2016-01141 (Patent 8,458,245 B1)<sup>2</sup>  
Case IPR2016-01155 (Patent 8,694,657 B1)<sup>3</sup>

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

LEE, *Administrative Patent Judge.*

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

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<sup>1</sup> Case IPR2017-00624 has been joined with IPR2016-01067.

<sup>2</sup> Case IPR2017-00655 has been joined with IPR2016-01141.

<sup>3</sup> Case IPR2017-00622 has been joined with IPR2016-01155.

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

Microsoft Corporation (“Microsoft”) initiated each of the above-captioned cases. *See, e.g.*, Paper 2 (original petition filed by Microsoft).<sup>4</sup> Following institution of trial in these cases, Facebook, Inc. (“Facebook” or “Petitioner”) filed petitions in IPR2017-00622, IPR2017-00624, and IPR2017-00655, with accompanying motions for joinder to the above-captioned cases. *See, e.g.*, Paper 33, 2. After Facebook filed its motions for joinder, Microsoft and Patent Owner, Windy City Innovations LLC, reached a settlement agreement and filed a Joint Motion to Terminate Proceeding in each of the present cases (“Motions to Terminate”). *See, e.g.*, Paper 30. On May 10, 2017, we granted the Motions to Terminate but only as to Microsoft; we exercised our discretion under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a) to hold in abeyance our ruling on the Motions as to Patent Owner and each proceeding as a whole in light of Facebook’s pending joinder motions. *E.g.*, Paper 32, 3. Ultimately, we granted the joinder motions and joined Facebook to the above-captioned cases. *E.g.*, Paper 33. As a result, Facebook is now the sole Petitioner in each proceeding. *See, e.g., id.* at 9.

We now return to the Motions to Terminate. As we have previously recognized, 35 U.S.C. § 317(a) provides that “[a]n 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” (emphases added). Pursuant to § 317(a), the present

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<sup>4</sup> All citations herein are to IPR2016-01067. Similar filings were made in all of the above-captioned cases.

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*inter partes* reviews have been terminated with respect to then-petitioner Microsoft upon the joint request of Microsoft and Patent Owner. The current Petitioner (Facebook), however, has not requested termination. In light of the fact that an active petitioner remains in each of these cases, we determine that termination of these proceedings is not warranted. Therefore, the Motions to Terminate are *denied* as to Patent Owner, and, as a result, each proceeding as a whole will not be terminated at this juncture.

#### ORDER

It is

ORDERED that the Motions to Terminate are *denied* as to Patent Owner, and each proceeding as a whole is not terminated at this time.

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

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