

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK INC.
Petitioner
v.

WINDY CITY INNOVATIONS, LLC
Patent Owner

U.S. Pat. No. 8,694,657
Issue Date: April 8, 2014
Title: REAL TIME COMMUNICATIONS SYSTEM

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

Case No. IPR2016-01155¹

¹ Case IPR2017-00622 has been joined to this proceeding.

I. INTRODUCTION

Pursuant to the Board's scheduling order² (Paper 13), Patent Owner Windy City Innovations, LLC respectfully submits this motion to exclude Petitioner Facebook Inc.'s evidence.

II. EX. 1100, REPLY DECLARATION OF CHRISTOPHER SCHMANDT

Certain portions of the reply declaration of Christopher Schmandt (Ex. 1100), particularly ¶ 21 at lines 4–17, ¶ 21 at lines 17–22, ¶ 22 at lines 1–14, ¶ 23 at lines 1–7, ¶¶ 26–30, 1100, 1100, ¶ 42 at lines 3–40, ¶¶ 45-51 should be excluded from evidence because the declaration includes evidence that exceeds the proposed scope of a petitioner's reply. FRE 401, 402, 403, and 37 C.F.R. § 42.23(b). Pursuant to 37 C.F.R. § 42.23(b), these certain portions of the reply declaration should be excluded because they contain citations, references, and arguments raised for the first time in the reply and they go beyond the permissible scope of a reply. These certain portions are not responsive to Patent Owner's response and could have been presented in the Petition. Instead, Petitioner used the Board's institution decision and Patent's Owner's responses to perfect its positions by impermissibly pivoting to new arguments, supporting its new arguments with new references and new citations, and ultimately presenting unauthorized grounds for trial. Accordingly, Petitioner's late inclusion of these

² Due Date 4 remains unaffected by the filing of the parties' scheduling stipulations and the Board's revised scheduling order in this case.

certain portions is unduly prejudicial to Patent Owner because Patent Owner would have addressed these new citations, references, and arguments in its responses. In addition to excluding the certain sections of the reply declaration identified herein, Patent Owner also respectfully requests that the Board exclude any other sections that impermissibly change the scope of Petitioner's challenges and/or are not responsive to the Patent Owner's response.

A. THE NEW "OTHER PROGRAMS" ARGUMENTS AND SUPPORTING CITATIONS SHOULD BE EXCLUDED FROM EVIDENCE.

Regarding Exhibit 1100, ¶ 21 at lines 4–17, Petitioner presents new arguments and new citations to the '356 Patent's specification supporting what appears to be a new written description or claim construction allegation. Not only do these completely new arguments exceed the scope of the petition, but the new arguments are irrelevant, confusing, and misleading with respect to the instituted grounds authorized for trial. The written-description arguments exceed the statutorily imposed scope of *inter partes* review proceedings. 37 CFR 42.104(b)(2). Additionally, this section amounts to an attempt to construe the "other programs" limitation with new argument not previously presented in the petition. Indeed, Petitioner did not provide a construction for "other programs" and any attempt to do so now would be improper. 37 CFR 42.104(b)(3).
Petitioner's new arguments amount to a drastic departure from its narrowly-

tailored arguments in the Petition, which are merely directed to “other programs” being edit, search, lookup commands typed on the controller and executed at the controller computer. Paper 2 at pp. 28-29. None of Petitioner’s new arguments are related to this original argument in the petition. Accordingly, the Board should exclude this narrowly-tailored section from evidence.

Regarding Exhibit 1100, ¶ 21 at lines 17–22, ¶ 22 at lines 1–14, and ¶ 23 at lines 1–7, Petitioner presents new arguments to allege the disclosure of the “other programs” limitations. Petitioner supports its new arguments with new citations which are absent, and lack suggestion, from the petition. Particularly, Petitioner attempts to support its new arguments alleging the disclosure of “other programs” at ¶ 21 at lines 17–22 with citations to Ex. 1001 at 8:30-32. Petitioner attempts to support its new arguments alleging the disclosure of “other programs” at Exhibit 1100, ¶ 22 at lines 1–17 with citations to Fig. 28, of “other programs” and new citations to Ex. 1001 at 4:55–57, 11:14–59, and Figs. 28–34. Further, Petitioner attempts to support its new arguments alleging the disclosure of “other programs at Exhibit 1100, ¶ 23 at lines 1–10 with new citations to Ex. 1001 at 7:60–61.

Petitioner’s new arguments amount to a drastic departure from its narrowly-tailored arguments in the Petition which are merely directed to “other programs” being edit, search, lookup commands typed on the controller and executed at the controller computer. Paper 2 at pp. 28-29. None of Petitioner’s new arguments are

related to this original argument in the petition. Accordingly, these narrowly-tailored sections of the reply declaration should be excluded from evidence.

B. THE NEW “DETERMINING WHETHER THE FIRST USER IDENTITY AND THE SECOND USER IDENTITY ARE ABLE TO FORM A GROUP TO SEND AND TO RECEIVE REAL-TIME COMMUNICATIONS” ARGUMENTS AND SUPPORTING CITATIONS SHOULD BE EXCLUDED FROM EVIDENCE.

Regarding Exhibit 1100, ¶¶ 26–30, Petitioner presents new arguments to allege the disclosure of “via the Internet” limitations. Petitioner supports its new arguments with new citations which are absent, and lack suggestion, from the petition. Particularly, Petitioner supports its new arguments with the ’657 patent to Ex. 1001, 7:60-8:4, 8:14-16, 8:57-9:23 and Ex. 1012 at 15:27-37, 31:5-21, 10:36-45 . Petitioner’s new arguments amount to a drastic departure from its narrowly-tailored arguments in the Petition, which are merely directed to (1) tools for “adding, deleting, and modifying chat rooms, (2) joining chat rooms, and (3) a general discussion of access rights, none of which were explained sufficiently to glean any semblance of a determination as to whether multiple identities are able to form a group. Paper 1 at pp. 25-26. Likely identifying these holes, Petitioner and Mr. Schmandt now attempt a drastic departure from the initial challenges. For the first time, Petitioner unilaterally limits the relevant disclosure of the ’657 patent to Ex. 1001, 7:60-8:4, 8:14-16, 8:57-9:23. Constituting new argument, this section amounts to an attempt to construe the terms of the limitation with new positions

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