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Paper No. 34
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,
Patent Owner.

Case IPR2017-00709
Patent 8,458,245 B1

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

Opinion Concurring filed by *Administrative Patent Judge* LEE, in which *Administrative Patent Judge* McKONE joins.

PER CURIAM.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Motion for Joinder
37 C.F.R. § 42.122(b)

INTRODUCTION

On January 17, 2017, Facebook, Inc. ("Facebook") filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 19 and 22–25 ("the present challenged claims") of U.S. Patent No. 8,458,245 B1 (Ex. 1001, "the '245 patent"). Concurrently with the Petition, Facebook filed a Motion for Joinder (Paper 3, "Mot."), requesting that this proceeding be joined with *Facebook, Inc. v. Windy City Innovations, LLC*, Case IPR2016-01156 ("1156 IPR"). Mot. 1. Patent Owner Windy City Innovations, LLC ("Windy City") filed an Opposition to the Motion for Joinder (Paper 8, "Opp.") but did not file a Preliminary Response. Facebook filed a Reply to the Opposition to the Motion for Joinder (Paper 9, "Reply").

For the reasons discussed below, we institute an *inter partes* review of all of the present challenged claims and grant the Motion for Joinder.

BACKGROUND

In June 2015, Windy City filed suit against Facebook in the U.S. District Court for the Western District of North Carolina. *See* Ex. 1017 ("Complaint"). In the Complaint, Windy City identified four patents-in-suit, including the '245 patent, and alleged that "Facebook has infringed and continues to infringe the patents-in-suit." *See id.* at 2–3, 6–9. Although the asserted patents include over 800 total claims, no specific claims of the asserted patents were identified in the Complaint.

Facebook moved to dismiss the Complaint on July 24, 2015, arguing *inter alia* that the Complaint's infringement allegations were insufficiently specific to sustain the action. *See* Ex. 3001, 4 (Facebook's Memorandum in Support of Motion to Dismiss). While waiting for the court to decide its

Motion to Dismiss, Facebook also filed a Motion to Change Venue to the Northern District of California on August 25, 2015. *See* Ex. 3002, 2 (order granting Motion to Change Venue). The court did not decide Facebook's Motion to Dismiss and, on March 16, 2016, the court instead granted Facebook's Motion to Change Venue and transferred the case to the U.S. District Court for the Northern District of California. *Id.* at 7–8.

After the case was transferred, counsel for Facebook contacted counsel for Windy City to request that Windy City identify a subset of claims from the asserted patents and restrict its infringement contentions to only those claims, but earlier than the relevant deadlines provided in applicable patent local rules. *See* Ex. 1013, 1–5. Facebook noted that the deadline for filing *inter partes* review petitions was upcoming, and asserted that Windy City's refusal to identify specific claims would prejudice Facebook's ability to focus such petitions on only those claims actually in controversy. *See id.* at 2. Although Windy City expressed willingness to negotiate, ultimately, those discussions failed to produce an agreement. *See id.* at 1–4.

On May 4, 2016, Facebook filed a motion seeking an order requiring Windy City to identify no more than forty asserted claims across the patents-in-suit. Ex. 1014, 1–2. The court denied the motion, but indicated it would "require a preliminary election of asserted claims and prior art," ordering the parties to address the topic in their joint statement for the case management conference. Ex. 1015, 1. The case management conference was not held until July 25, 2016. *See* Ex. 3003.

Facebook filed its petition in the 1156 IPR on June 3, 2015, just prior to the one-year deadline set forth in 35 U.S.C. § 315(b). *See* 1156 IPR,

Paper 1 ("1156 Pet."). The petition in the 1156 IPR challenged claims 1–15, 17, and 18 of the '245 patent. *Id*. at 3.

After the case management conference, on October 19, 2016, Windy City served disclosures in the district court case, pursuant to applicable patent local rules, identifying claims 19 and 22–25 of the '245 patent as allegedly infringed by Facebook. Ex. 1016, 2. Subsequently, on December 15, 2016, we instituted an *inter partes* review of claims 1–15, 17, and 18 of the '245 patent in the 1156 IPR on the ground of unpatentability under 35 U.S.C. § 103(a) in view of Roseman,[1] Rissanen,[2] Vetter,[3] Pike,[4] and Westaway[5] (claims 1–5, 7, 9–14), and additionally Lichty[6] (claims 6, 8, 15, 17 and 18). 1156 IPR, slip op. at 30–31 (PTAB Dec. 15, 2016) (Paper 7, "1156 Inst. Dec."). Pursuant to 37 C.F.R. § 42.122(b), Facebook filed the present Petition and Motion for Joinder on January 17, 2017, seeking to challenge the claims of the '245 patent identified in Windy City's October 19, 2016 disclosures. *See* Mot. 7–8.

ANALYSIS

An *inter partes* review may be joined with another *inter partes* review, subject to certain statutory provisions:

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[1] U.S. Patent No. 6,608,636 B1, filed May 13, 1992, issued Aug. 19, 2003 (Ex. 1003, "Roseman").
[2] European Patent Application Pub. No. 0621532 A1, published Oct. 26, 1994 (Ex. 1004, "Rissanen").
[3] Ronald J. Vetter, *Videoconferencing on the Internet*, COMPUTER, Jan. 1995, at 77–79 (Ex. 1005, "Vetter").
[4] Mary Ann Pike et al., USING MOSAIC (1994) (Ex. 1006, "Pike").
[5] U.S. Patent No. 5,226,176, issued July 6, 1993 (Ex. 1007, "Westaway").
[6] Tom Lichty, THE OFFICIAL AMERICAN ONLINE® FOR MACINTOSH™ MEMBERSHIP KIT & TOUR GUIDE (1994) (Ex. 1008, "Lichty").

> (c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter parties review under section 314.

35 U.S.C. § 315(c); *see also* 37 C.F.R. § 42.122. As the moving party, Facebook bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

As an initial matter, the Motion for Joinder meets the requirements of 37 C.F.R. § 42.122(b) because the Motion was filed on January 17, 2017, which is not later than one month after the 1156 IPR was instituted on December 15, 2016.[7]

Although the Board frequently grants motions for joinder where the asserted grounds of unpatentability, and supporting arguments and evidence, are the same as in the preceding case, the Motion here seeks to join challenges to different claims than in the 1156 IPR. Facebook argues, however, that the present challenged claims are "substantially similar" to the claims challenged in the 1156 IPR and, thus, "do not raise any substantial new issues" given that Facebook relies on essentially the same evidence as in the 1156 IPR. Mot. 9–10. According to Facebook, this "substantial overlap between the instant proceeding and the [1156 IPR]" indicates joinder would promote the expedient and efficient resolution of the issues. *Id.* at 10, 12. Further, Facebook asserts that Windy City would not be unduly prejudiced because the present Petition does not raise substantial new

[7] January 15, 2017, was a Sunday, and January 16, 2017, was Martin Luther King, Jr. Day.

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