Trials@uspto.gov
571-272-7822

Paper No. 11
Entered: July 31, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,
Patent Owner.

Case IPR2017-00659
Patent 8,694,657 B1

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

Opinion Concurring filed by *Administrative Patent Judge* MCKONE, in which *Administrative Patent Judge* Lee joins.

PER CURIAM

Institution of *Inter Partes* Review and
Order Granting Petitioner's Motion
for Joinder of IPR2017-00659 With IPR2016-01159
37 C.F.R. § 42.108
37C.F.R. § 42.122(b)

I. BACKGROUND

On January 12, 2017, Facebook, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") for *inter partes* review of claims 203, 209, 215, 221, 477, 482, 487, and 492 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 *Facebook, Inc. v. Windy City Innovations, LLC*, Case IPR2016-01159 ("the -01159 IPR"). In the -01159 IPR, Petitioner challenges claims 189, 334, 342, 348, 465, 580, 584, and 592 of the '657 patent. Windy City Innovations, LLC ("Patent Owner") filed an Opposition to Petitioner's Motion for Joinder (Paper 8, "Opp."). Petitioner filed a Reply to Opposition to Motion for Joinder (Paper 9, "Reply").

The Petition here 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). "An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent." 35 U.S.C. § 315(b). On June 2, 2015, more than one year prior to the filing of the Petition, Patent Owner filed a complaint (Ex. 1016, "Complaint") alleging infringement by Petitioner of the '657 patent. Patent Owner contends that Petitioner was served with the Complaint on June 2, 2015 (Opp. 1), a point that Petitioner does not dispute.

Nevertheless, as Petitioner notes (Mot. 4), the § 315(b) time bar does not apply if a petition is accompanied by a request for joinder and joinder is granted. *See* 35 U.S.C. § 315(b) ("The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c)."); 37 C.F.R. § 42.122(b) ("The time period set forth in § 42.101(b) shall

not apply when the petition is accompanied by a request for joinder."). Petitioner argues that the Petition is timely, as it was accompanied by its Motion for Joinder. Mot. 5.

The timing of Petitioner's earlier challenge of claims 189, 334, 342, 348, 465, 580, 584, and 592 (on which we instituted in the -1159 IPR) and new challenge of claims 203, 209, 215, 221, 477, 482, 487, and 492 stems from the history of the parties' underlying district court litigation in *Windy City Innovations, LLC v. Facebook, Inc.*, Case No. 4:16-cv-01730-YGR (N.D. Cal.) ("the District Court litigation").[1] Patent Owner originally filed an infringement complaint in the United States District Court for the Western District of North Carolina on June 2, 2015, alleging infringement of various patents, including the '657 patent. Ex. 1016. Patent Owner alleged, with little specificity, that various of Petitioner's products "infringed and continues to infringe the patents-in-suit" and "meet claims of the patents-in-suit." *Id.* ¶¶ 22–23. The '657 patent alone has 671 claims, none of which were identified with particularity in the Complaint.

In the District Court litigation, Petitioner moved to dismiss the Complaint, *inter alia*, because "[t]he four asserted patents collectively span hundreds of pages and include 830 claims" and "without identifying a single specific claim, the Complaint alleges that the entirety of 'Facebook.com' as well as 'Facebook apps' somehow infringe the patents." Ex. 3001 (Defendant Facebook, Inc.'s Memorandum in Support of Motion to Dismiss

[1] Patent Owner initially brought suit in the United States District Court for the Western District of North Carolina, Civil Action No. 15-cv-102. The case later was transferred to the United States District Court for the Northern District of California, Civil Action No. 4:16-cv-01730-YGR.

Pursuant to FRCP 12(b)(6)). The North Carolina court did not rule on the Motion to Dismiss, and instead transferred the case (pursuant to Petitioner's motion) to the Northern District of California on March 16, 2016. Mot. 2–3; Ex. 3002, 2 (Order granting Motion to Change Venue).

The parties then corresponded regarding Patent Owner focusing its dispute on a limited number of claims but failed to reach agreement. Ex. 1012. Petitioner filed an administrative motion with the California court, asking the court to require Patent Owner to "identify no more than forty asserted claims across the four asserted patents no later than May 16, 2016." Ex. 1013, 1–2. In a May 17, 2016, Order, the California court denied the administrative motion, but stated that it "will require a preliminary election of asserted claims and prior art and employ a form of order modeled by the Federal Circuit," and that "[t]he parties shall address the topic in their Joint Case Management Conference Statement." Ex. 1014. The case management conference was not held until July 25, 2016. Ex. 3003.

According to Petitioner, "without the benefit of knowing which claims Windy City asserted, Facebook filed a petition for *inter partes* review ('the Original [1159] Petition') requesting cancellation of claims 189, 334, 342, 348, 465, 580, 584, and 592 of the '657 Patent." Mot. 3; -1159 IPR, Paper 1 ("-1159 Pet."). On October 19, 2016, after the § 315(b) time bar for filing such a petition, Patent Owner formally identified claims 189, 203, 209, 215, 221, 465, 477, 482, 487, and 492 of the '657 patent in the District Court litigation. Mot. 4; Ex. 1015.

We instituted a trial in the -1159 IPR on December 12, 2016. Petitioner filed the instant Petition on January 12, 2017, within one month of the Institution Decision, consistent with 37 C.F.R. § 42.122(b).

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).

1. The Substance of the Petition Is Similar to that Already Addressed in the -1159 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 substance similar to that advanced in the -1159 IPR.

Claims 203, 209, 215, 221, 477, 482, 487 and 492 (challenged in this case) depend indirectly from claims 189 and 465, which have been instituted in the -1159 IPR. As Petitioner argues,

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.