

IPR2016-01159  
U.S. Pat. No. 8,694,657

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

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

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**PATENT OWNER'S PROPOSED PROCEDURE ON REMAND**

Case No. IPR2016-01159

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On November 13, 2020, the Board authorized the parties to file short papers providing input regarding the proposed procedure on remand. Patent Owner Windy City Innovations LLC and Petitioner Facebook Inc. have conferred regarding this issue and do not agree on any proposed procedure. As the Board states in its November 13, 2020 notice to the parties, the Federal Circuit noted that the petitions filed in IPR2016-01156 and IPR2016-01159 are time-barred under 35 U.S.C. § 315(b). *See Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1325 (Fed. Cir. 2020). Because the petitions are statutorily time-barred, the Board is not authorized under the current statutory framework to review U.S. Patent Nos. 8,458,245 and 8,694,657 on any grounds petitioned in IPR2016-01156 and IPR2016-01159. Accordingly, there are no issues requiring supplemental briefing,<sup>1</sup> and the Board should issue an order terminating the actions so that the Board and the parties do not continue to unnecessarily expend resources.

Respectfully submitted,

Dated: November 20, 2020

/Vincent J. Rubino, III /

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<sup>1</sup> To the extent the Board requests or authorizes supplemental briefing on any issue, Patent Owner requests a responsive brief of equal pages due within a reasonable time period after the filing of Petitioner's brief.

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**CERTIFICATE OF SERVICE**

A copy of PATENT OWNER'S PROPOSED PROCEDURE ON REMAND

has been served on Petitioner at the correspondence of the Petitioner as follows:

<p><b>By Email:</b></p> <p>Heidi L. Keefe (Reg. No. 40,673) hkeefe@cooley.com zpatdcdocketing@cooley.com COOLEY LLP ATTN: Patent Group 1299 Pennsylvania Ave., NW, Suite 700 Washington, DC 20004</p>	<p><b>By Email:</b></p> <p>Phillip E. Morton (Reg. No. 57,835) pmorton@cooley.com zpatdcdocketing@cooley.com COOLEY LLP ATTN: Patent Group 1299 Pennsylvania Ave., NW, Suite 700 Washington D.C. 20004</p>
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November 20, 2020

*/Vincent J. Rubino, III/*

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