

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

**WINDY CITY INNOVATIONS, LLC'S OPPOSITION TO
FACEBOOK INC.'S MOTION FOR JOINDER**

Case No. IPR2017-00622

I. INTRODUCTION

Absent joinder, this Petition is statutorily barred from institution because Petitioner Facebook Inc. waited more than one year after being served with a complaint alleging infringement of the '657 Patent.¹ On June 3, 2016, Petitioner filed a petition in IPR2016-01155 to challenge the '657 Patent, including Claims 189 and 465 ("Facebook's Original Petition"). On the same day, Microsoft petitioned the Board to challenge the same patent in IPR2016-01155 ("Microsoft's Original Petition"). Petitioner now appeals to the Board's discretion to join this Petition ("Joinder Petition") with Microsoft's Original Petition. Patent Owner, Windy City Innovations, LLC, respectfully opposes Petitioner's Motion for Joinder (Paper 3) because Petitioner has not met its burden and is not entitled to the requested relief.

II. PETITIONER HAS NOT MET ITS BURDEN

Petitioner sets forth two reasons why joinder is appropriate: (1) the similarity

¹ On June 2, 2015, Facebook was served with a complaint alleging infringement of the '657 Patent in Windy City Innovations, LLC v. Facebook Inc., 1:15-cv-00102 (W.D.N.C.), later transferred to the Northern District of California (4:16-cv-01730). On June 2, 2015, Microsoft was served with a complaint alleging infringement of the '657 Patent in Windy City Innovations, LLC v. Microsoft Corporation, 1:15-cv-00103 (W.D.N.C.), later transferred to the Northern District of California (4:16-cv-01729).

of the petitions, and (2) to maintain Microsoft’s Original IPR in the event of that Microsoft settles or otherwise ceases participation. The latter reason is insufficient as baseless and speculative. As explained below, the petitions are not “substantively the same” as alleged by Petitioner.

III. PETITIONER’S NEW ARGUMENTS

Petitioner advances *alternative facts* when it states that the Joinder Petition is “substantively the same” as Microsoft’s Original Petition. In Microsoft’s Original Petition, Microsoft used five (5) pages to broadly address Claim 189, largely citing back to Claim 1 arguments, repeating claim language, and broadly asserting obviousness. *See* Orig. Pet. at 32–37. Given the differences in coverage and perspective between the two claims—for one, Claim 1 is directed to censoring from *receiving* data, while Claim 189 covers censoring from *sending* data—Patent Owner has justifiably relied on Microsoft’s wave of the hand in forming its defense to Microsoft’s Original Petition. Seeking to correct the mistakes of Microsoft’s Original Petition by including nearly 18 pages² worth of arguments against Claim 189, Petitioner blatantly attempts to insert new arguments in its Joinder Petition. *See* Join. Pet. at 18–35. Granting joinder would result in both Petitioner Facebook and Microsoft circumventing estoppel doctrines and statutory limitations on petitioners, all within the Board’s familiarity and not belabored here.

² Based on a 230-word page, this amounts to an estimated additional 4140 words.

IV. PETITIONER'S NEW CLAIM CONSTRUCTIONS

Moreover, Petitioner now admits to proposing multiple claim constructions on the same '657 Patent for each of the proposed terms in the Joinder Petition³, positioning itself to improperly benefit from inconsistent and alternative constructions before the Board. In addition to estoppel considerations, Facebook and Microsoft are employing gamesmanship tactics, using the Board's decisions as a roadmap to develop their positions and overcome their shortcomings.

V. JOINDER WOULD PREJUDICE PATENT OWNER

Benefits appear to be illusory here, as Petitioner projects some delay and a "reasonable adjustment" to the schedule. Any efficiency related to joining this already statutorily-barred petitioner must be outweighed by the inefficiencies of additional analyses and briefing, increased expenditures of party and Board resources, and delayed resolution of the proceedings. Petitioner further fails to identify any burdens arising from Facebook and Microsoft's collective blitz of second bites at the apple: ten concurrently-filed new petitions, each with motions to join one of the seven of eleven surviving IPRs against Patent Owner.⁴ Petitioner

³ See Joinder Pet. at p. 9.

⁴ Between January 7th and 17th, Facebook and Microsoft have collectively filed 10 new petitions with accompanying joinder motions in in IPR2017-00603, -00605, -00606, -00622, -00624, -00655, -00656, -00659, -00669, and -00709, seeking

has not identified any reasons why it elected to delay joining these new proceedings until the last minute, despite having every opportunity to advance these grounds before the one-year window.

VI. CONCLUSION

Statutory estoppel provisions were designed to address the very circumstances of this case to “protect patent owners from harassment via successive petitions by the same or related parties, to prevent parties from having a second bite at the apple, and to protect the integrity of both the PTO and Federal Courts by assuring that all issues are promptly raised and vetted.” 77 FR 48759. In light of the particular facts of this case, Patent Owner respectfully requests that the Board use its discretion to deny Petitioner’s Motion for Joinder.

Dated: February 6, 2017

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joinder to one of IPR2016-01067, -01141, -01155, -01156, -01157, -01158, and -01159.

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