

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,
Patent Owner.

Case IPR2017-00655
Patent 8,458,245 B1

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

LEE, *Administrative Patent Judge.*

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 12, 2017, Facebook, Inc. (“Facebook”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–15, 17, and 18 (“the 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 *Microsoft Corp. v. Windy City Innovations, LLC*, Case IPR2016-01141 (“1141 IPR”). Mot. 1. Patent Owner Windy City Innovations, LLC (“Windy City”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) but did not file an opposition to the Motion for Joinder.

Since the filing of Facebook’s Motion for Joinder, Windy City and the petitioner in the 1141 IPR (“Microsoft”) have settled and, on April 24, 2017, moved to terminate the 1141 IPR. 1141 IPR, Paper 25. We granted the motion to terminate as to Microsoft, but held the motion in abeyance as to Windy City pending the outcome of Facebook’s Motion for Joinder in the present case. 1141 IPR, slip op. at 3–4 (PTAB May 10, 2017) (Paper 27).

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

INSTITUTION OF *INTER PARTES* REVIEW

In the 1141 IPR, we instituted an *inter partes* review of claims 1–40 of the ’245 patent as allegedly unpatentable under 35 U.S.C. § 103(a) based on the combined teachings of Major BBS¹ and Higley². 1141 IPR, slip op.

¹ GALACTICOMM, INC., THE MAJOR BBS VERSION 6.2 SYSTEM OPERATIONS MANUAL (1994) (Ex. 1012, “Major BBS”). We note that the Preliminary Response refers to this reference as “Stein.”

at 32 (PTAB Dec. 12, 2016) (Paper 8) (“1141 Inst. Dec.”). Facebook represents that the Petition in this proceeding challenges claims 1–15, 17, and 18 on the same grounds of unpatentability, relying on the same evidence and arguments, as presented in the 1141 IPR. Mot. 1. According to Facebook, the only substantive difference between its Petition and the petition in the 1141 IPR is that Facebook does not challenge claims 16 and 19–40.³ *See id.* In addition, Facebook asserts it is not barred from filing the Petition because the one-year deadline to file a petition seeking *inter partes* review after being served with a complaint alleging infringement of the challenged patent does not apply when the petition is accompanied by a request for joinder. Pet. 2; *see* 35 U.S.C. § 315(b); 37 C.F.R. § 42.122(b).

Windy City does not dispute that the present Petition is substantively the same as the petition in the 1141 IPR with respect to the challenged claims, but argues that institution is not warranted because the Petition nonetheless fails to establish a reasonable likelihood of prevailing on any of its asserted grounds of unpatentability. *See* Prelim. Resp. 3–4; *see also* 35 U.S.C. § 315(c) (authorizing joinder only after a determination that the petition “warrants institution of an inter partes review under section 314”); 35 U.S.C. § 314(a) (prohibiting institution absent a determination that the information presented in the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the

² U.S. Patent No. 5,790,793, filed Apr. 4, 1995, issued Aug. 4, 1998 (Ex. 1010, “Higley”).

³ The petition in the 1141 IPR also challenged claims 41–58, which Facebook also does not challenge in the present Petition. *See* 1141 Inst. Dec. 5–6. An *inter partes* review was not instituted, however, with respect to those claims in the 1141 IPR. *See id.* at 32.

claims challenged in the petition”). Specifically, Windy City advances three arguments against the Petition: (1) the asserted prior art fails to teach or suggest certain limitations of the challenged claims; (2) the Petition fails to articulate a sufficient motivation to combine Major BBS and Higley; and (3) a person of ordinary skill would not have had a reasonable expectation of success in combining the asserted teachings of the prior art. *See* Prelim. Resp. 3–4.

Based on the evidence currently of record and the arguments presented in the Petition, we determine Facebook has demonstrated a reasonable likelihood of prevailing on each of its asserted grounds of unpatentability for essentially the same reasons as explained in our Decision on Institution in the 1141 IPR. *See* 1141 Inst. Dec. 14–25, 29–31. In reaching this determination, we consider the information presented in Windy City’s Preliminary Response, which includes arguments it did not present in the 1141 IPR prior to institution in that case, but Windy City’s positions are not persuasive on this record, as explained below.

As noted above, Windy City first argues the asserted prior art fails to teach or suggest certain limitations of the challenged claims. Prelim. Resp. 12–14. Claim 1 of the ’245 patent recites, “a controller computer system adapted to communicate responsive to a respective authenticated user identity corresponding respectively to each of a plurality of participator computers.” Claim 7, the only other challenged independent claim, recites, “a computer system communicatively connected to each of a plurality of participator computers responsive to communication of a respective login name and a password corresponding to a respective user identity.”

According to Windy City, Facebook fails to show how the computer system in Major BBS teaches these limitations. *See id.*

Specifically, Windy City faults Facebook for failing to “explain how the alleged authentication [in Major BBS] . . . results in adapting the controller computer system for communication.” *Id.* at 12–13. We disagree based on the present record. The Petition identifies teachings in Major BBS that describe an IBM compatible computer system that hosts the Major BBS software, which enables the system to communicate with user computers that connect to the system to provide services and content to the users. *See* Pet. 22. This showing is sufficient for purposes of institution to demonstrate that the system in Major BBS is “adapted to communicate” with the user computers, as recited in the challenged claims.

Further, as the Petition explains, Major BBS describes an authentication procedure whereby users must supply a User-ID and password to access services on the system. *See id.* at 23. Based on the cited evidence, the Petition shows sufficiently that the system is, thus, adapted to communicate with user computers “responsive to” authenticated user identities (i.e., users with identities verified through the system’s authentication procedure). To the extent Windy City is arguing that the Major BBS authentication procedure must result in the *installation* of the Major BBS software—i.e., that “adapted to” requires software *installation*, as opposed to its operation on the computer system—this argument is not persuasive because no evidence is presented to support such an interpretation of the claims, and it misconstrues the positions presented in the Petition as being limited to software installation.

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