

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION

Petitioner,

v.

WINDY CITY INNOVATIONS LLC

Patent Owner.

U.S. Patent No. 8,694,657

TITLE: REAL TIME COMMUNICATIONS SYSTEM

Inter Partes Review No. IPR2017-00656

PETITIONER'S MOTION FOR JOINDER

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I. Introduction

Facebook, Inc. ("Facebook") filed a petition for *inter partes* review of U.S. Patent No. 8,694,657 ("657 patent"), in IPR2016-01159 ("Facebook IPR"). The Facebook IPR was accorded a filing date of June 3, 2016, and trial was instituted on December 12, 2016 on all challenged claims. Petitioner hereby moves under 35 U.S.C. § 315(c) to join the present proceeding to the Facebook IPR. Counsel for Petitioner has conferred with counsel for Facebook, who do not oppose Petitioner's motion.

II. Background and Related Proceedings

On June 2, 2015, Patent Owner filed a complaint alleging infringement of the '657 patent by Facebook. *Windy City Innovations, LLC v. Facebook, Inc.*, 16-cv-102 (W.D. N.C.). On June 3, 2016, Facebook filed a petition for *inter partes review* of the '657 patent, and trial was instituted on December 12, 2016 on all challenged claims. Concurrently with this motion, Petitioner has filed a petition for *inter partes review* of the '657 patent that is substantively identical to the Facebook IPR. *See* Paper 1.

On June 2, 2015, Patent Owner also filed a complaint alleging infringement of the '657 patent by Petitioner. *Windy City Innovations, LLC v. Microsoft Corporation*, 1:15-cv-103 (W.D.N.C.). On June 3, 2016, Petitioner filed a petition IPR2016-01155 for *inter partes review* of the '657 patent. *See* IPR2016-01155.

Trial was instituted in that proceeding on December 8, 2012. On January 7, 2017¹, Petitioner filed IPR202017-00606 concurrently with a motion for joinder to the IPR2016-01155 proceeding. On January 7, 2017, Facebook filed IPR2017-00622 also concurrently with a motion for joinder to the IPR2016-01155 proceeding.

III. Discussion

Petitioner respectfully requests the Board exercise its discretion to institute this IPR and grant its joinder with the Facebook IPR, pursuant to 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and 37 C.F.R. § 42.122(b). This IPR is substantively identical to the Facebook IPR. Both IPRs challenge the same claims on the same grounds, include the same claim constructions and the same arguments, rely on the same exhibits, and use the same expert and the same expert declaration. Petitioner therefore seeks (1) a determination that this IPR warrants institution; and (2) joinder of this IPR into the Facebook IPR. That would result in Petitioner joining the Facebook IPR without any change to its scope or schedule. In support of this motion, Petitioner proposes consolidated filings and other procedural accommodations designed to streamline the proceedings.

¹ Due to an error with filing through PTAB E2E, the filing date currently appears on PTAB E2E as January 9, 2017. Petitioner is working to have the filing date corrected.

A. Reasons Why Joinder is Appropriate

Joinder is appropriate because it is the most expedient way to secure the just, speedy and inexpensive resolution of the related proceedings. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). This IPR is substantively identical to the Facebook IPR, and thus would avoid multiplication of issues before the Board. Given the duplicative nature of these petitions, joinder of the related proceedings is appropriate. Further, Petitioner agrees to consolidated filings and discovery.

1. Substantively Identical Petitions

Petitioner represents that this IPR presents identical issues to the Facebook IPR in all substantive respects. They include identical grounds, analysis, and exhibits, and rely upon the same expert declarant and declaration. Accordingly, joining this IPR proceeding with the Facebook IPR proceeding would not entail any duplication of effort.

2. Consolidated Filings and Discovery

Because the grounds of unpatentability in this IPR and the Facebook IPR are the same, the case is amenable to consolidated filings. Petitioner agrees to consolidated filings for all substantive papers and to work with counsel for Facebook to incorporate Petitioner's positions into Facebook's efforts, so long as Facebook is a party to the joined proceedings. Specifically, Petitioner agrees to work with Facebook to incorporate Petitioner's positions with those of Facebook in

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