

1 COOLEY LLP
HEIDI L. KEEFE (178960)
2 hkeefe@cooley.com
MARK R. WEINSTEIN (193043)
3 mweinstein@cooley.com
PHILLIP E. MORTON (*pro hac vice*)
4 pmorton@cooley.com
REUBEN H. CHEN (228725)
5 rchen@cooley.com
3175 Hanover Street
6 Palo Alto, CA 94304-1130
Telephone: (650) 843-5000
7 Facsimile: (650) 849-7400

8 Attorneys for Defendant Facebook, Inc.

9
10 UNITED STATES DISTRICT COURT
11 NORTHERN DISTRICT OF CALIFORNIA
12 SAN FRANCISCO DIVISION
13

14 WINDY CITY INNOVATIONS, LLC,
15 Plaintiff,
16 v.
17 FACEBOOK, INC.,
18 Defendant.

Case No. 4:16-cv-01730-YGR

**FACEBOOK, INC.’S ADMINISTRATIVE
MOTION REGARDING THE
IDENTIFICATION OF ASSERTED CLAIMS**

19
20 Nearly a year after filing this case, Windy City Innovations, LLC (“Windy City”) has refused
21 to identify which of the 830 claims in the four asserted patents are asserted against Facebook, Inc.
22 (“Facebook”). By this point, Windy City has no excuse to continue withholding which of the 830
23 claims it specifically intends to assert in this case.¹ Disclosure of asserted claims now will help to
24 avoid the unnecessary expense and burden of analyzing invalidity and non-infringement for claims
25

26
27 ¹ Facebook is not requesting early disclosure of infringement contentions, only an identification of
28 the claims Windy City intends to assert. Facebook anticipates that Windy City’s disclosure of
infringement contentions will likely proceed under the schedule set in the Patent Local Rules.

1 Windy City never intends to assert. Moreover, disclosure of asserted claims now may help to
2 narrow this litigation through the *inter partes* review process at the Patent and Trademark Office.
3 With the deadline for petitions for *inter partes* review fast approaching on June 3, 2016, 35 U.S.C. §
4 315(b)², Facebook respectfully moves for an administrative order requiring Windy City to identify
5 no more than forty asserted claims across the four asserted patents no later than May 16, 2016.³

6 **I. PROCEDURAL HISTORY**

7 On June 2, 2015, Windy City sued Facebook in the Western District of North Carolina,
8 alleging infringement of four asserted patents that collectively include a total of 830 claims.⁴
9 All four asserted patents share the same specification, the same named inventor, and are
10 continuations of the same parent patent. Under the complaint's "one count," Windy City did not
11 reveal a single asserted claim allegedly infringed by Facebook or clearly identify the accused
12 products beyond the entirety of "Facebook.com" and "Facebook apps."⁵ By refusing to identify any
13 specific asserted claims or accused products, Windy City left Facebook with the burden of guessing
14 what claims and products Windy City believes are infringing.

15 On July 24, 2015, Facebook filed a motion to dismiss under Rule 12(b)(6). As explained in
16 the motion to dismiss, Windy City's complaint failed to provide the notice required by the Federal
17 Rules and the standards set forth by the Supreme Court. (*E.g.*, Dkt. 20 at 2-7). In view of the recent
18 amendment of the Federal Rules eliminating Form 18, the deficiencies are even more striking.⁶ The

19
20 ² Congress created the *inter partes* review procedure to provide a "timely, cost-effective alternative
21 to litigation." Changes to Implement *Inter Partes* Review Proceedings, Post-Grant Review
22 Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680,
23 48,680 (Aug. 14, 2012) (codified at 37 C.F.R. § 42.100, *et seq.*). *Inter partes* review allows
petitioners to challenge the validity of patents under 35 U.S.C. §§ 102 and/or 103 based on prior art
patents and printed publications. 35 U.S.C. §§ 311(b), 316(a); 37 C.F.R. §§ 42.51, 42.53.

24 ³ On May 3, 2016, the parties met-and-conferred telephonically, and Windy City stated that it would
25 oppose this administrative motion. (Declaration of Phillip E. Morton in Support of Facebook, Inc.'s
Administrative Motion Regarding the Identification of Asserted Claims ("Morton Decl."), ¶ 3.)

26 ⁴ U.S. Patent No. 8,407,356 includes 37 claims. U.S. Patent No. 8,458,245 includes 58 claims.
U.S. Patent No. 8,473,552 includes 64 claims. U.S. Patent No. 8,694,657 includes 671 claims.

27 ⁵ Facebook's Rule 12(b)(6) motion is fully briefed and pending. (Dkt. 21, 22.)

28 ⁶ Applying the newly amended Federal Rules of Civil Procedure in this case is "just and
practicable." See H.R. Doc. No. 114-33, at 2 (2015). See also *Rembrandt Patent Innovations LLC*

1 complaint included broad allegations of indirect and willful infringement reciting boilerplate
2 language without any supporting facts. Facebook filed a motion to transfer, which was pending for
3 nearly six months before the case was transferred to the Northern District of California on March 16,
4 2016.⁷

5 **II. ARGUMENT**

6 It is well-established that courts may order plaintiffs to identify and limit the number of
7 asserted claims. *See Stamps.com v. Endicia*, 437 F. App'x 897, 902 (Fed. Cir. 2011), *reh'g denied*
8 (Aug. 1, 2011) (unpublished); *Rambus v. LSI*, No. 10-cv-05446 (N.D. Cal. Dec. 28, 2012) (Seeborg,
9 J.) (Morton Decl. Ex. A at 3) (“In the patent context, the Federal Circuit has approved of district
10 courts’ common practice of limiting the number of claims that can be asserted in order to streamline
11 the litigation.”) (*citing In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303 (Fed.
12 Cir. 2011)). For example in *Rambus*, this court initially limited the plaintiff to 35 claims, even
13 though there were nine asserted patents. (Morton Decl. Ex. A at 1-2.)

14 Facebook respectfully requests that the Court require Windy City identify no more than forty
15 asserted claims across the four asserted patents by May 16, 2016. To facilitate Windy City’s claim
16 selection process, Facebook has offered to make its source code available for review by Windy
17 City’s counsel and approved experts upon entry of a protective order, which Windy City rejected

18
19 *v. Apple Inc.*, No. 14-cv-05094, 2015 WL 8607390, at *2 (N.D. Cal. Dec. 13, 2015) (Alsup, J.)
20 (applying amended pleading standard in case filed prior to December 1, 2015, in the context of a
21 request to amend infringement contentions); *Dao v. Liberty Life Assurance Co.*, No. 14-cv-04749,
22 2016 WL 796095, at *3 (N.D. Cal. Feb. 23, 2016) (Laporte, J.) (applying amended rules in discovery
23 dispute). Given how long Windy City has had to analyze its infringement contentions and the
24 burden it would impose on Facebook to prepare invalidity and non-infringement defenses for 830
25 claims and an unknown number of potentially accused products, it would be just and practicable to
26 narrow the issues that will actually have to be tried, not only for judicial efficiency and streamlining
27 the discovery process, but also to permit Facebook to seek meaningful *inter partes* review by the
28 U.S. Patent and Trademark Office (“PTO”) of the patents and claims truly at issue.

⁷ On August 25, 2015, Facebook filed a motion to transfer this action to the Northern District of
California. (Dkt. 25.) Windy City filed an opposition, and on September 21, 2015, Facebook filed a
reply brief. (Dkt. 29, 30.) The motion to transfer remained fully briefed on the North Carolina
court’s docket for nearly six months. After the case was reassigned to a different judge, the North
Carolina court granted Facebook’s motion to transfer on March 16, 2016. (Dkt. 31.)

1 because it is not prepared to review Facebook's source code. (Morton Decl. Ex. B.)

2 As illustrated in the attached correspondence, Windy City would not consider any
3 identification of asserted claims unless the Defendants (Facebook and Microsoft) agreed to reduce
4 the prior art they may assert before Windy City has identified any information about the scope of the
5 case, including accused products, asserted claims, and infringement contentions. (Morton Decl. Ex.
6 B.) Facebook is willing to engage in meaningful efforts to narrow the scope of this case, including
7 reducing asserted prior art references, but such a reduction is more appropriate after Windy City
8 provides basic information about the asserted claims, accused products, and infringement
9 contentions explaining how Windy City is alleging infringement by Facebook.

10 Windy City should know which claims it intends to assert from its pre-filing diligence and
11 upcoming infringement contentions. Windy City should not be permitted to continue to keep
12 Facebook in the dark about the asserted claims, particularly in view of the upcoming deadline for
13 petitions for *inter partes* review petitions fast approaching. See *Adaptix, Inc. v. Dell, Inc.*, No. 5-14-
14 cv-01259-PSG, 2015 U.S. Dist. LEXIS 23134, at *25 (N.D. Cal. Feb. 24, 2015) (Grewal, M.J.)
15 (finding that defendants would be unduly prejudiced by amendment of infringement contentions
16 after statutory IPR deadline). Narrowing the case to forty asserted claims now will help to
17 streamline the parties' upcoming infringement and invalidity contentions, and focus any *inter partes*
18 review petitions that may be filed before the June 3, 2015 statutory deadline.

19 **III. CONCLUSION**

20 Accordingly, Facebook respectfully requests that the Court order Windy City to identify no
21 more than forty asserted claims by May 16, 2016.

1 Dated: May 4, 2016

COOLEY LLP

2

3

/s/ Heidi L. Keefe

4

Heidi L. Keefe

5

Mark R. Weinstein

Reuben H. Chen

Phillip E. Morton

COOLEY LLP

6

3175 Hanover Street

Palo Alto, CA 94304-1130

7

8

Attorneys for Defendant

FACEBOOK, INC.

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

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.