UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.
Petitioner

v.

WINDY CITY INNOVATIONS, LLC
Patent Owner

Case No. IPR2017-00659
Patent No. 8,694,657

_____

REPLY TO OPPOSITION TO MOTION FOR JOINDER

Petitioner respectfully submits this Reply in support of Petitioner's Motion

for Joinder (Paper 3) ("Motion") and in reply to Patent Owner's opposition (Paper

8) ("Opposition"). Patent Owner does not demonstrate any reason why the Board

should deny joinder in view of the substantial good cause shown in the Motion.

I.   PETITIONER REQUESTS JOINDER FOR NEWLY-ASSERTED CLAIMS

Patent Owner incorrectly asserts that its "district court complaint alleged and

asserted infringement of all claims of the '657 Patent." (Paper 8 at 2 (emphasis

added).)   In fact, Patent Owner's 10-page boilerplate complaint asserted four

patents-in-suit and alleged that "Facebook's Accused Instrumentalities meet claims

of the patents-in-suit"—some unspecified "claims," not "all claims." (*Windy City*

Innovations, LLC v. Facebook Inc., Case No. 4:16-cv-01730-YGR, ECF No. 1,

¶ 23 (Ex. 1016).) Patent Owner never provided any specific infringement assertion

for all 671 claims of the '657 Patent, either in its complaint or otherwise.

Patent Owner does not dispute that it did not disclose its litigation

infringement contentions and specific asserted claims until October 19, 2016, long

after the expiration of the original one-year IPR bar in early June 2016. (Paper 3 at

2-4, 7-8.)   This case is thus analogous to other joinder cases where the patent

owner first identified its asserted claims after the one-year bar. (*Id*. at 5-6 (citing

cases).) The *Par Pharmaceutical* case is inapposite. *Par Pharmaceutical, Inc. v*

Novartis AG, IPR2016-01059, Paper No. 18. In that case, the Board denied joinder

as to one claim because the petitioner admitted that the only reason it had not included that claim in its original petition was an "inadvertent omission," which was not sufficient justification. *Id*. at 15-16. By contrast here, the four patents-in-suit contain 830 claims, and Petitioner filed IPR petitions challenging dozens of claims prior to the one-year deadline without knowing which specific claims Patent Owner would assert. (Paper 3 at 2-4.) Patent Owner then strategically chose to assert claims that were not subject to an IPR petition. (*Id*.) Petitioner now seeks joinder only as to several newly-asserted dependent claims that are largely redundant of other already instituted claims from the original Petition, and are based on the same prior art as the original Petition. Joinder is thus appropriate to fulfill the objectives of a "just, speedy, and inexpensive resolution" in IPR (37 C.F.R. §42.1(b)), rather than forcing the parties to litigate these claims' invalidity in district court litigation.

The *Arris* case is also distinguishable. *Arris Group, Inc. et al. v. Cirrex Systems LLC,* Case No. IPR2015-00530, Paper 12. In *Arris*, the complaint alleged infringement of "one or more claims" of a 51-claim patent, nowhere near the 830 claims across all four patents-in-suit, including the 671 claims in just the '657 patent. It would have been unreasonable here to burden the Board and parties with petitions on all 671 claims or all 830 claims. Moreover, unlike this case, the *Arris* joinder raised "new prior art references" and "combinations … not previously

considered by the Board." *Id*. at 7.

A more analogous case is *Sony Corporation v. Yissum Research Development Company of the Hebrew University of Jerusalem*, IPR2013-00326, Paper 15 (PTAB Sept. 24, 2013). There, the complaint against Petitioner Sony alleged infringement of "one or more claims" of a patent with 155 claims. *Id.* at 3; *see HumanEyes Technologies Ltd. v. Sony Electronics, Inc.*, C.A. No. 12-398, Dkt. No. 1 at ¶29 (D. Del. Mar. 29, 2012). Sony filed an initial IPR petition on certain claims. IPR2013-00326, Paper 15 at 2. Later, the patent owner asserted three claims that were not challenged in IPR, and Sony filed a second petition against those claims and moved for joinder. *Id.* at 6. The Board granted joinder, finding that because "no specific … infringement assertions were made originally" with respect to those three additional claims, "Petitioner's challenge … [was] a reasonable and timely response to Patent Owner's litigation posture, as opposed to a dilatory, unilateral action." *Id.* Likewise here, Petitioner challenges only newly-asserted dependent claims that were not identified until after the original Petition and expiration of the original one-year bar. Joinder is fully appropriate.

II. THE JOINDER PETITION ADDRESS ONLY MINOR DEPENDENT CLAIM LIMITATIONS BASED ON THE SAME PRIOR ART

Patent Owner incorrectly alleges that Petitioner's motion for joinder "states that the Joinder Petition contains 'no new substantive issues' as compared to the Original Petition." (Paper 8 at 4.) In fact, that purportedly quoted language is not

contained in Petitioner's Motion or Petition. Instead, Petitioner's Motion shows

that the Joinder Petition presents "similar" issues as the Original Petition and

"addresses only minor dependent claim limitations that are disclosed and obvious

in view of the same prior art disclosures." (Paper 3 at 1, 8-11.) Patent Owner does

not address Petitioner's explanation, and only incorrectly asserts that the Petition

and expert declaration contain 17 pages and 20 pages, respectively, of alleged

"new positions" and "new analyses and arguments." (Paper 8 at 4.) But Patent

Owner's page-counting exercise fails to discuss those pages' substantive content.

Apple Inc. v. VirnetX Inc., IPR2016-00063, Paper 13 at 5 (PTAB Jan. 25, 2016)

(discounting patent owner's complaints of unexplained and unsupported

"additional issue[s]" due to joinder). In fact, the vast majority of the cited content

merely reiterates the same analysis that Petitioner previously presented for already-

instituted claims 189 and/or 465, or shows how the same "two client software

alternatives" limitation repeats throughout these dependent claims. (Paper 2 at 51-

68; Ex. 1002 at 61-79.) Given that Patent Owner first asserted these claims after

the filing of the original Petition, as noted previously, good cause exists to address

these claims and their minor additional limitations based on the same prior art.

III.   JOINDER WILL NOT PREJUDICE PATENT OWNER GIVEN THE SUBSTANTIAL OVERLAP IN THE PROCEEDINGS

Finally, Patent Owner alleges that there may be "undue delay," "prejudice,"

"additional analyses and briefing" and "increased expenditures" (Paper 8 at 5), but

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