

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,
Patent Owner.

IPR2017-00709, IPR2016-01156; Patent 8,458,245 B1
IPR2017-00659, IPR2016-01159; Patent 8,694,657 B1

Before KARL D. EASTHOM, DAVID C. McKONE, and
MELISSA A. HAAPALA, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

PROCEDURES FOLLOWING REMAND
37 C.F.R. § 42.5(a)

IPR2017-00709, IPR2016-01156; Patent 8,458,245 B1
IPR2017-00659, IPR2016-01159; Patent 8,694,657 B1

On July 31, 2017, we instituted a trial in IPR2017-00659 and joined it to IPR2016-01159. IPR2016-01159, Paper 34. On August 1, 2017, we instituted a trial in IPR2017-00709 and joined it to IPR2016-01156. IPR2016-01156, Paper 34. The later-filed petitions challenged additional claims of the '245 and '657 patents not challenged in the earlier-filed petitions. We issued Final Written Decisions in IPR2016-01156 and IPR2016-01159 on December 6, 2017, ruling on the claims challenged in both the earlier-filed petitions and the later-filed petitions. *See, e.g.*, IPR2016-01156, Paper 52. Petitioner appealed these decisions. *See, e.g.*, IPR2016-01156, Paper 53.

Patent Owner cross-appealed and, in particular, challenged our joinder decisions. *See Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1329–30 (Fed. Cir. 2020). The Federal Circuit determined that 35 U.S.C. § 315(c) does not authorize same-party joinder and does not authorize the joinder of new issues, and thus determined that the joinder of later-filed claims to the earlier-filed *inter partes* reviews was improper and vacated our Final Written Decisions as to those claims. *Id.* at 1330–44. As the Federal Circuit noted, by the time the later-filed petitions were filed, the time bar of 35 U.S.C. § 315(b) had passed. *Id.* at 1325. However, the Federal Circuit determined that it “lack[ed] authority to review the Board’s institution of the two late-filed petitions,” and “remand[ed] to the Board to consider whether the termination of those proceedings finally resolves them.” *Id.* at 1326.

The parties are invited to file short papers providing input regarding the proposed procedure on remand. *See Patent Trial and Appeal Board*

IPR2017-00709, IPR2016-01156; Patent 8,458,245 B1

IPR2017-00659, IPR2016-01159; Patent 8,694,657 B1

Standard Operating Procedure 9 (SOP 9), Appendix 2.¹ To that end, if the parties have not already done so, the parties are directed to meet and confer to discuss the proper course of action to implement the Federal Circuit's remand instructions. If the parties agree on the procedure, the parties are directed file a joint paper indicating their agreement. If the parties do not agree with each other, each party is authorized to file a paper, of not more than three pages in length, providing its proposal on remand procedures, such as whether additional briefing is necessary and, if so, the subject matter and length of briefing. *See* SOP 9. The parties' papers are due no later than November 20, 2020.

¹ Available at

https://www.uspto.gov/sites/default/files/documents/sop_9_%20procedure_f_or_decisions_remanded_from_the_federal_circuit.pdf.

IPR2017-00709, IPR2016-01156; Patent 8,458,245 B1
IPR2017-00659, IPR2016-01159; Patent 8,694,657 B1

PETITIONER:

Heidi L. Keefe
Phillip E. Morton
Andrew C. Mace
COOLEY LLP
hkeefe@cooley.com
pmorton@cooley.com
amace@cooley.com

PATENT OWNER:

Vincent J. Rubino, III
Peter Lambrianakos
FABRICANT LLP
vrubino@fabricantllp.com
plambrianakos@fabricantllp.com