

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP INC.,¹
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01668
Patent 8,724,622 B2

Before JENNIFER S. BISK, MIRIAM L. QUINN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 U.S.C. § 42.5

¹ Apple Inc., which filed a petition in Case IPR2018-00580, was previously joined as a petitioner but is understood to no longer be a party to this proceeding. *See infra* note 2.

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The Board issued a consolidated Final Written Decision pursuant to 35 U.S.C. § 318(a) in the above-referenced proceeding and related IPR2017-01667 on January 16, 2019, concluding that Petitioner had shown by a preponderance of the evidence that claims 3, 6–8, 10–35, 38, and 39 of U.S. Patent No. 8,724,622 B2 (“the ’622 patent”) are unpatentable but that Petitioner had not shown by a preponderance of the evidence that claims 4 and 5 of the ’622 patent are unpatentable. Paper 35. Petitioner appealed the decision to the United States Court of Appeals for the Federal Circuit, and Patent Owner filed a cross appeal. *See* Papers 38 (Facebook, Inc. and WhatsApp Inc. Notice of Appeal), 39 (Apple Inc. Notice of Appeal), 41 (Patent Owner Notice of Cross Appeal).

The Federal Circuit issued a decision on November 18, 2021, affirming the Board’s determinations with respect to claims 3, 6–8, 10–35, 38, and 39 but vacating and remanding for further consideration of the Board’s determinations with respect to claims 4 and 5. *Uniloc 2017 LLC v. Facebook, Inc.*, Nos. 2019-2159, 2019-2162, 2021 WL 5370480 (Fed. Cir. Nov. 18, 2021).

On January 25, 2022, counsel for Patent Owner notified the Board that the parties were meeting and conferring regarding remand procedures pursuant to the Board’s Standard Operating Procedure 9 but that they had not reached an agreement and jointly requested a conference call to discuss the same.

Pursuant to the parties' joint request, the panel held a conference call on February 9, 2022, with counsel for the parties.² Based on the discussion during the conference call, and having considered the parties' arguments, we determine that additional briefing is warranted. Specifically, we authorize Patent Owner to file an opening brief, not to exceed five pages, by no later than March 11, 2022; Petitioner to file a responsive brief, limited to responding to Patent Owner's opening brief and not to exceed five pages, by no later than April 11, 2022; and Patent Owner to file a reply brief, limiting to responding to Petitioner's responsive brief and not to exceed three pages, by no later than April 25, 2022. In accordance with the parties' agreement expressed during the conference call, the parties are not authorized to file or otherwise introduce any new evidence with the briefs, and no new arguments are to be presented in the briefs.

Accordingly, it is

ORDERED that Patent Owner is authorized to file an opening brief in accordance with this Order, not to exceed five pages, no later than March 11, 2022;

FURTHER ORDERED that Petitioner is authorized to file a responsive brief in accordance with this Order, not to exceed five pages, no later than April 11, 2022;

² Counsel for Apple Inc., which, as stated in note 1 above, was previously joined as a petitioner in this proceeding, did not participate in the conference call. According to a June 24, 2021, filing in the Federal Circuit (Ex. 3002), Apple Inc. entered into a settlement agreement with Patent Owner, and Apple Inc. and Patent Owner jointly moved to voluntarily dismiss Apple Inc. as a party to Patent Owner's appeal and to voluntarily dismiss Apple Inc.'s cross appeal. The Federal Circuit granted the joint motion in an Order dated August 13, 2021. Ex. 3003.

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FURTHER ORDERED that Patent Owner is authorized to file a reply brief in accordance with this Order, not to exceed three pages, no later than April 25, 2022; and

FURTHER ORDERED that no additional briefing is permitted except as specifically authorized herein, and the parties are not authorized to file or otherwise introduce any new evidence or to present any new arguments with or in the briefs.

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