

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  
COOLEY LLP  
5 3175 Hanover Street  
Palo Alto, CA 94304-1130  
6 Telephone: (650) 843-5000  
7 Facsimile: (650) 849-7400

BRADLEY W. CALDWELL (pro hac vice)  
bcaldwell@caldwellcc.com  
JASON D. CASSADY (pro hac vice)  
jcassady@caldwellcc.com  
JOHN AUSTIN CURRY (pro hac vice)  
acurry@caldwellcc.com  
WARREN J. MCCARTY, III (pro hac vice)  
wmccarty@caldwellcc.com  
CALDWELL CASSADY & CURRY  
2101 Cedar Springs Road, Suite 1000  
Dallas, Texas 75201  
Telephone: (214) 888-4848  
Facsimile: (214) 888-4849

8 MICHAEL G. RHODES (116127)  
(rhodesmg@cooley.com)  
9 COOLEY LLP  
10 101 California Street, 5<sup>th</sup> Floor  
San Francisco, CA 94111  
11 Telephone: (415) 693-2000  
12 Facsimile: (415) 693-2222

Christopher D. Banys (SBN 230038)  
Jennifer L. Gilbert (SBN 255820)  
cdb@banyspc.com  
jlg@banyspc.com  
BANYS, P.C.  
1032 Elwell Court, Suite 100  
Palo Alto, CA 94303  
Tel: (650) 308-8505  
Fax: (650) 353-2202

13 Attorneys for Defendant Facebook, Inc.

Attorneys for Plaintiff Windy City  
Innovations, LLC

14  
15 UNITED STATES DISTRICT COURT  
16 NORTHERN DISTRICT OF CALIFORNIA  
17 OAKLAND DIVISION

18 WINDY CITY INNOVATIONS, LLC

19 Plaintiff,

20 v.

21 FACEBOOK, INC.,

22 Defendant.

Case Nos. 4:16-cv-01730-YGR

**JOINT CASE MANAGEMENT  
STATEMENT**

Date: February 12, 2018

Time: 2:00 p.m.

Dept.: Courtroom 1

Judge: Honorable Yvonne Gonzalez Rogers

Date Filed: July 18, 2016

Trial Date: None Set

23  
24 Pursuant to Federal Rule of Civil Procedure 26(f), Civil Local Rule 16-9(a), Patent  
25 Local Rule 2-1, the Standing Order for All Judges of the Northern District of California –  
26 Contents of Joint Case Management Statement, and the Court’s January 24, 2018 Order  
27 Granting Plaintiff Windy City’s Motion to Lift Stay (Dkt. No. 92), the parties to the above-  
28

1 titled action jointly submit this Case Management Statement and Proposed Order.

2 **1. Jurisdiction and Service.**

- 3
- 4 • The Court has subject matter jurisdiction over this action.
  - 5 • Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b) and (c) and/or 1400(b).
  - 6 • No issues exist regarding personal jurisdiction or venue.
  - 7 • All named parties have been served with no unresolved service issues.

8 **2. Procedural History and Facts.**

9 (a) Case Activity Since the Transfer to the Northern District of California.

10 On April 6, 2016, this case was transferred from the Western District of North Carolina  
11 to the Northern District of California. (Dkt. No. 32.) On May 4, 2016, Facebook filed a motion  
12 seeking the identification of asserted claims in advance of Facebook's June 3, 2016 statutory  
13 deadline for filing IPRs. (Dkt. No. 46.) On May 17, 2016, the Court denied Facebook's  
14 motion, but in its Order stated that it would require the "preliminary election of asserted claims  
15 and prior art and employ a form of order modeled by the Federal Circuit." (Dkt. No. 50.) On  
16 July 25, 2016, the Court conducted a Case Management Conference. The Court entered a Case  
17 Management Scheduling Order on August 2, 2016, which adopted the Federal Circuit  
18 Advisory Council's Model Order Limiting Excess Patent Claims and Prior Art. (Dkt. No. 68.)

19 The parties thereafter served and responded to discovery requests and Windy City  
20 began review of Facebook's confidential source code. Pursuant to the Court's Order (1) out  
21 of 830 claims, Windy City elected thirty-two (32) claims to pursue and served infringement  
22 contentions on October 19, 2016 and (2) Facebook served invalidity contentions and narrowed  
23 its prior art to forty (40) references on December 5, 2016.

24 (b) The Stipulated Stay, PTAB Findings, and Order Lifting the Stay.

25 Facebook and Microsoft collectively filed eleven petitions for *inter partes* review  
26 ("IPR") of the patents-in-suit on June 3, 2016. By December 12, 2016, the PTAB instituted  
27 *inter partes* review on seven of the eleven petitions. The parties stipulated to stay the case  
28 pending the instituted IPR proceedings, which the Court ordered on December 28, 2016. (Dkt.

76). While the instituted IPR petitions were pending, Windy City and Microsoft reached a settlement and the Microsoft action was dismissed on April 21, 2017. (CV-01729 Dkt. 82).

On December 6, 2017, the PTAB issued its Final Written Decisions on each of the IPRs instituted against the patents-in-suit. The results of the IPRs is summarized below:

Patent	Claims Found Unpatentable	Claims Not Found Unpatentable	Preliminary Elected Asserted Claims Not Found Unpatentable
8,407,356	1-9, 12, 14-28, 31, 33-37	None	None
8,458,245	1-15, 17, 18	19, 22-25	19, 22-25
8,473,552	2, 3, 5, 7, 10-17, 59, 64	1, 4, 6, 8, 9, 18-58	None
8,694,657	189, 334, 342, 348, 465, 477, 482, 487, 492, 580, 584, 592	203, 209, 215, 221	203, 209, 215, 221

Windy City moved to lift the stay on December 22, 2017. (Dkt. 83). The Court granted Windy City's motion on January 24, 2018 (Dkt. 92) and set this case management conference for February 12, 2018.

### 3. Legal Issues.<sup>1</sup>

The principal disputed legal issues are:

- Whether Defendants directly or indirectly infringe any claim of the asserted patents;
- Construction of any disputed patent claim terms;
- Whether Windy City is entitled to damages, and if so, the amount;
- Whether any or all of the claims of the asserted patents are invalid;
- Whether any or all of the claims of the asserted patents are patent-ineligible;
- Whether this case is exceptional under 35 U.S.C. § 285; and
- Whether other appropriate forms of relief are due to either party, including monetary relief under 35 U.S.C. §284.

<sup>1</sup> Windy City does not agree that Facebook may challenge the validity or subject-matter eligibility of the patents-in-suit, and thus those legal issues are no longer in dispute in this action. To the extent Facebook pursues invalidity defenses, counterclaims, or otherwise challenges the validity of the patents-in-suit, Windy City reserves its right to seek appropriate relief (*e.g.*, in a motion to strike and/or motion for summary judgment) as warranted by law, including statutory and common law estoppel.

1                   **4. Motions and/or Pending Matters.**

2                   **(a) Motions**

3                   There are no pending motions at this time.

4                   **(b) Anticipated Motions**

5                   Facebook believes that this case should be stayed while the Parties pursue appeals of  
6                   the PTAB's Final Written Decisions. Facebook may file a motion to renew the stay of this  
7                   litigation pending appeal.

8                   Windy City intends to request leave to substitute claims.

9                   **(c) Pending Matters**

10                  On January 10, 2018, Facebook filed four Notices of Appeal to the U.S. Court of  
11                  Appeals for the Federal Circuit appealing, among other issues, the PTAB's finding that the  
12                  nine remaining asserted claims were not unpatentable. Fed. Cir. Appeal Nos. 18-1400, -1401,  
13                  -1402, -1403. All of Facebook's appeals have been consolidated under Case No. 18-1400.

14                  To date, Windy City has not filed any notice of appeal. The deadline to file Notices of  
15                  Appeal is February 7, 2018.

16                  **5. Amendment of Pleadings, Addition of Parties, Etc.**

17                  None at this time.

18                  **6. Evidence Preservation.**

19                  The parties have reviewed the Guidelines Relating to the Discovery of Electronically  
20                  Stored Information ("ESI"). Additionally, the parties have discussed with their counsel and  
21                  met and conferred at their F.R.C.P. 26(f) conference regarding reasonable and proportionate  
22                  steps to preserve evidence relevant to the issues reasonably evident in this action. Each party  
23                  has implemented a litigation hold with respect to ESI and hardcopy documents and media that  
24                  is believed to be reasonably related to the claims and defenses in this action.

25                  **7. Initial Disclosures.**

26                  The parties served initial disclosures pursuant to Federal Rule of Civil Procedure  
27                  26(a)(1) on July 18, 2016.

28

1           **8. Discovery.**

2                   **(a) Discovery to Date**

3           Due to the stay pending Facebook's IPR petitions, only minimal written discovery and  
4 document production has occurred to date and no depositions have been taken in this case.

5                   **(b) Scope of anticipated discovery**

6           The parties anticipate that the scope of discovery will encompass the factual and legal  
7 issues identified in Sections 3 above, and the requested relief discussed in Section 11 below,  
8 including all related, ancillary, and subsidiary factual and legal issues and matters.

9                   **(c) Report on Stipulated E-Discovery Order**

10           The parties have reviewed the Northern District of California's Model Stipulation and  
11 Order Re: Discovery of Electronically Stored Information For Patent Litigation and the Court  
12 entered the parties' stipulated ESI Order on August 16, 2016. *See* Dkt. 70.

13                   **(d) Discovery Plan/Changes to Discovery Limitations**

14           The Court entered a case scheduling order on August 2, 2016 (Dkt. 68) setting forth  
15 discovery limitations in this matter. The parties ask that the Court to carry forward the  
16 discovery limitations as set forth in the § I of that Order.

17           **9. Class Actions.**

18           Not applicable.

19           **10. Related Pending Cases.**

20           None.

21           **11. Relief.**

22           Windy City's Statement:

23           Windy City seeks judgment that Defendants have infringed and continue to infringe  
24 the patents in-suit. Windy City seeks damages under 35 U.S.C. § 284, attorney fees under 35  
25 U.S.C. § 285, and such relief at law and in equity as the Court may deem just and proper.

26           Defendants' Statement:

# 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.