

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC
Patent Owner.

Case IPR2016-01159¹
Patent 8,694,657 B1

PROPOSED REMAND PROCEDURE

¹ Case IPR2017-00659 has been joined with this proceeding.

Petitioner submits this statement in response to the Board's February 11, 2021 email directing each party to propose the remand procedures that it desires to follow in view of the Federal Circuit's remand of this matter.

The challenged claims of the '657 patent remanded to the Board (claims 203, 209, 215, 221, 477, 482, 487, 492) involve IPR2017-00659, which the Federal Circuit found had been improperly joined to the earlier-filed IPR2016-01159 proceeding. *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1338-39, 1347 (Fed. Cir. 2020). The Board's Final Written Decision in IPR2016-01159 was otherwise affirmed. *Id.* Petitioner has not filed a writ of certiorari to the Supreme Court, and the deadline for doing so has passed.

Therefore, because the Board already terminated IPR2017-00659 in connection with joining that proceeding to IPR2016-01159 (*see* IPR2017-00659, Paper 11 at 15), and the Federal Circuit vacated the Final Written Decision in IPR2016-01159 only as it pertains to the joined claims, nothing remains for the Board on the merits regarding either of those proceedings. Petitioner requests that the Board terminate the proceedings as to the remanded claims of the '657 patent (claims 203, 209, 215, 221, 477, 482, 487, 492).

Dated: February 19, 2021

Respectfully submitted,

/Heidi L. Keefe/

Heidi L. Keefe

Reg. No. 40,673

Counsel for Petitioner Facebook, Inc.

CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. section 42.6, that a complete copy of the attached **PROPOSED REMAND PROCEDURE** is being served on the 19th day of February 2021 upon the patent owner's attorneys of record via email:

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