

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC.,  
Petitioner,

v.

WINDY CITY INNOVATIONS, LLC,  
Patent Owner.

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IPR2016-01156; Patent 8,458,245 B1<sup>1</sup>  
IPR2016-01159; Patent 8,694,657 B1<sup>2</sup>

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Before KARL D. EASTHOM, DAVID C. MCKONE, and J. JOHN LEE,  
*Administrative Patent Judges.*

MCKONE, *Administrative Patent Judge.*

AMENDED SCHEDULING ORDER

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<sup>1</sup> Case IPR2017-00709 has been joined with this proceeding.

<sup>2</sup> Case IPR2017-00659 has been joined with this proceeding.

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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. On August 2, 2017, via email, we directed the parties to meet and confer to propose, by August 9, 2017, agreed reasonable adjustments to the schedule of the joined cases to accommodate the claims newly challenged in the joinder petitions, and an agreed proposal on the scope of additional discovery, if requested, or, if the parties could not reach agreement, to submit competing proposals. The parties did not reach agreement and submitted competing proposals by email. The parties propose as follows:

#### **Petitioner's Proposal**

Patent Owner shall submit a Supplemental Response (no more than three pages) by September 11, followed by the Petitioner's Supplemental Reply (no more than three pages) on September 25. The Supplemental Response and Supplemental Reply shall be limited to the joined claims and, with respect to those claims, identifying where in previously-filed Patent Owner Responses or Petitions the limitations recited in those claims were addressed. No new evidence may be presented.

#### **Patent Owner's Proposed Modifications to the Schedule**

Patent Owner proposes no changes to the existing due dates, including the hearing date. Patent Owner proposes the following additions to the schedule for supplemental briefing, which shall be limited solely to the newly-added claims from IPR2017-00709 and -00659, now joined to IPR2016-01156, -01159, respectively.

Patent Owner will submit a Supplemental Response (20-pages limit) by September 11. Petitioner may submit a Supplemental Reply (10-page limit) by September 25. Depending on whether Patent Owner and/or Petitioner submit supporting evidence with

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their briefs, additional dates are provided for motions and responses regarding observations and excluding evidence.

Patent Owner's proposed schedule is outlined in the table below.

<b>Proposed Schedule in IPR2016-01156, -01159</b>		
Due Date 5 (unchanged)	-Resp. to Observations -Reply to Mot. to Exclude	8/16/2017
Due Date 6 (unchanged)	-Reply to Mot. to Exclude (DD6);	8/23/2017
Due Date 1A	-PO Supplemental Response, -PO Motion to Amend Joined Claims	9/11/2017
Due Date 2A	-Petitioner's Supplemental Reply -Petitioner's Supplemental Opposition to Supplemental Motion to Amend	9/25/2017
Due Date 4A	-Motion for Observations on supplemental cross- examinations -Motion to Exclude evidence submitted with supplemental briefing	10/5/2017
Due Date 5A	-Response to supplemental observations -Opposition to motion to exclude evidence submitted with supplemental briefing	10/12/2017
Due Date 6A	-Reply to opposition to motion to exclude evidence submitted with supplemental briefing	10/17/2017

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Due Date 7 (unchanged)	Oral Hearing	10/19/2017
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As can be seen, the parties agree on dates for submitting Patent Owner's response to the petitions submitted in IPR2017-00659 and IPR2017-00709 ("the joinder petitions") and Petitioner's corresponding replies to those responses (September 11, 2017, and September 25, 2017, respectively). The parties also agree that any additional briefing and discovery will be limited to the claims newly challenged in the joinder petitions. The parties do not agree, however, on page limits for those papers or the allowed scope. The parties also do not agree on the scope of additional discovery to accommodate the joinder petitions. Petitioner would preclude new evidence and limit Patent Owner to identifying where, in Patent Owner's previous responses, particular claim limitations were addressed. Patent Owner's proposal contemplates additional evidence and depositions, but does not provide specificity. It also limits Patent Owner to addressing the newly-challenged claims, but does not limit Patent Owner to referencing its earlier responses. Patent Owner's proposal also provides adjustments to the schedule for a motion to amend, observations (in the event of new depositions), and motions to exclude as to the joinder petitions, while Petitioner is silent as to those dates.

We conclude that Patent Owner's proposal is reasonable and Petitioner's proposal is unreasonable. Focusing on IPR2016-01159 and IPR2017-00659, Petitioner filed 68 pages of briefing and over eighty pages of declaration testimony as part of the joinder petition.<sup>3</sup> IPR2017-00659,

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<sup>3</sup> The same issues are present in IPR2016-01156 and IPR2017-00709.

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Paper 2, Ex. 1002. In granting joinder, we noted that the joinder petition raised issues very similar to those raised in the original petition. IPR2017-01159, Paper 34, 8–9. Nevertheless, the issues are not identical. The newly-challenged claims are similar to those previously challenged, but not the same. Likewise, the new testimonial evidence Petitioner advances is similar, but not the same as, that previously introduced. Patent Owner should be given an opportunity to respond, introduce evidence of its own, and challenge Petitioner’s new evidence. *See* 35 U.S.C. § 316(a)(8). A response limited to 3 pages with no additional evidence and limited to referencing prior papers effectively would deny Patent Owner a response under these circumstances. Thus, Petitioner’s proposal is unreasonable on its face.

On the other hand, Patent Owner’s proposed limit of 20 pages allows for a meaningful response without significantly adding to the complexity of the case. Patent Owner’s proposed schedule also provides timing for additional discovery, provides for objections to that discovery, and contemplates Patent Owner’s right to file a motion to amend the claims first challenged in IPR2017-00709.<sup>4</sup> *See* 35 U.S.C. §§ 316(a)(5), 316(a)(9).

As to limits on any additional depositions, we direct the parties to meet and confer and reach agreement on the time and location. *See* 37 C.F.R. § 42.53(d)(2). We remind Petitioner that, in granting its joinder petitions, we accepted its representations that it would agree to “reasonable and appropriate” adjustments to the schedule. IPR2016-01159, Paper 34, 10. Given the tight time frames remaining in these proceedings, we recognize that the requirement that cross-examination should take place

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<sup>4</sup> Because the ’657 patent is expired, no motion to amend is available in IPR2016-01159.

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