Trials@uspto.gov
Tel: 571-272-7822

Paper 15
Entered: April 13, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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*.

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

On July 31, 2017, we instituted a trial in IPR2017-00659, joined it to IPR2016-01159, and terminated IPR2017-00659 under 37 C.F.R. § 42.72. IPR2017-00659, Paper 11; IPR2016-01159, Paper 34. On August 1, 2017, we instituted a trial in IPR2017-00709, joined it to IPR2016-01156, and terminated IPR2017-00709 under Rule 72. IPR2017-00709, Paper 11; 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 Final Written 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; thus, the Federal Circuit 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.[1]

We invited the parties to file short papers providing input regarding the proper procedure on remand. IPR2016-001156, Paper 56.[2] Patent Owner filed its statement proposing post-remand procedures. IPR2016-01156, Paper 57. Patent Owner argues:

> Because the [P]etitions are statutorily time-barred, the Board is not authorized under the current statutory framework to review U.S. Patent Nos. 8,458,245 and 8,694,657 on any grounds petitioned in IPR2016-01156 and IPR2016-01159. Accordingly, there are no issues requiring supplemental briefing, and the Board should issue an order terminating the actions so that the Board and the parties do not continue to unnecessarily expend resources.

Id. at 1 (footnote omitted).[3]

Petitioner filed a paper requesting that we hold any remand decision in abeyance until after the time had expired for it to petition the Supreme Court for certiorari. IPR2016-01156, Paper 58. After that time expired, Petitioner filed its statement of proposed remand procedures. IPR2016-01156, Paper 59. Petitioner argues:

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[1] The claims challenged in the later-filed petitions, subject to the Federal Circuit's vacate and remand, are claims 19 and 22–25 of the '245 patent and claims 203, 209, 215, 221, 477, 482, 487, and 492 of the '657 patent. *See Facebook*, 973 F.3d at 1342, 1344.

[2] We cite to the parties' papers filed in IPR2016-01156 because virtually identical papers are filed in IPR2016-01159.

[3] We presume Patent Owner intended to argue that we are not authorized to review the challenged patents on any grounds petitioned in IPR2017-00659 and IPR2017-00709, as the two later-filed cases, not the two earlier-filed cases, are subject to the time bar of 35 U.S.C. § 315(b).

> [B]ecause the Board already terminated IPR2017-00709 in connection with joining that proceeding to IPR2016-01156 (*see* IPR2017-00709, Paper 11 at 11), and the Federal Circuit vacated the Final Written Decision in IPR2016-01156 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.

Id. at 1.

As noted above, the Federal Circuit "conclude[d] that the clear and unambiguous language of § 315(c) does not authorize same-party joinder, and also does not authorize joinder of new issues, including issues that would otherwise be time-barred." *Facebook*, 973 F.3d at 1338. Accordingly, the Federal Circuit determined as follows:

> In light of the foregoing, we hold that the Board's joinder decisions, which allowed Facebook to join itself to a proceeding in which it was already a party, and to add otherwise time-barred issues to the IPRs, were improper under § 315(c). We therefore vacate-in-part the Board's final written decisions with respect to the improperly added claims. Specifically, the Board's final written decision on the '245 patent is vacated with respect to claims 19 and 22–25, and the Board's final written decision on the '657 patent is vacated with respect to claims 203, 209, 215, 221, 477, 482, 487, and 492, all of which were added to the proceedings through improper joinder. With respect to these claims, we remand to the Board, in order for the Board to consider whether the termination of the instituted proceedings related to the two late-filed petitions finally resolves those proceedings.

Id. at 1338–39.

In light of the Federal Circuit's ruling and instructions, and after having considered the parties' input, we determine that the proper course of action is to vacate our Joinder Orders (IPR2017-00659, Paper 11 and

IPR2017-00709, Paper 11)[4] and to deny Petitioner's Motions for Joinder in these two proceedings (Paper 3 in both IPR2017-00659 and IPR2017-00709) as improper under § 315(c). *See Facebook*, 973 F.3d at 1338–39. Petitioner admits that the Petition in each of these proceedings was filed more than one year after Petitioner was served with a complaint alleging infringement of the patent challenged in the respective Petition. *See* IPR2017-00659, Paper 2, 5; IPR2017-00709, Paper 2, 5. Because we deny Petitioner's Motions for Joinder, and § 315(c) is not applicable to either proceeding, we determine that both Petitions are time barred. *See* 35 U.S.C. § 315(b) ("An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c)."). Accordingly, we vacate the previous institutions of *inter partes* review and deny the requests for *inter partes* review in IPR2017-00659 and IPR2017-00709.

It is

ORDERED that the Institution and Joinder Orders (IPR2017-00659, Paper 11; IPR2017-00709, Paper 11) are vacated;

FURTHER ORDERED that Petitioner's Motions for Joinder (IPR2017-00659, Paper 3; IPR2017-00709, Paper 3) are denied;

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[4] Copies of the Joinder Orders filed in IPR2017-00659 and IPR2017-00709 were filed as Paper 34 in IPR2016-01159 and IPR2016-01156, respectively.

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