

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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MICROSOFT CORPORATION

Petitioner,

v.

WINDY CITY INNOVATIONS LLC

Patent Owner.

Patent No. 8,407,356

Title: REAL TIME COMMUNICATIONS SYSTEM

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*Inter Partes* Review No. IPR2017-00605

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**PETITIONER'S MOTION FOR JOINDER**

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## **I. Introduction**

Facebook, Inc. ("Facebook") filed a petition for *inter partes* review of U.S. Patent No. 8,407,356 ("356 Patent"), in IPR2016-01157 ("Facebook IPR"). The Facebook IPR was accorded a filing date of June 3, 2016, and an IPR was instituted on December 15, 2016. Petitioner hereby moves under 35 U.S.C. § 315(c) to join the present proceeding to the Facebook IPR. Counsel for Petitioner has conferred with counsel for Facebook, who do not oppose Petitioner's motion.

## **II. Background and Related Proceedings**

On June 2, 2015, Patent Owner filed a complaint alleging infringement of the 356 Patent by Facebook. *Windy City Innovations, LLC v. Facebook, Inc.*, 16-cv-102 (W.D. N.C.). On June 3, 2016, Facebook filed a petition for *inter partes review* of the 356 Patent, and an IPR was instituted on December 15, 2016.

On June 2, 2015, Patent Owner also filed a complaint alleging infringement of the 356 Patent by Petitioner. *Windy City Innovations, LLC v. Microsoft Corporation*, 1:15-cv-103 (W.D. N.C.). On June 3, 2016, Petitioner filed a petition for *inter partes review* of the 356 Patent, and an IPR was instituted on December 8, 2016. *See* IPR2016-01067. Concurrently with this motion, Petitioner has filed a petition for *inter partes review* of the 356 Patent that is substantively identical to the Facebook IPR. *See* Paper 1.

### **III. Discussion**

Petitioner respectfully requests the Board exercise its discretion to institute this IPR and grant its joinder with the Facebook IPR, pursuant to 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and 37 C.F.R. § 42.122(b). This IPR is substantively identical to the Facebook IPR. Both IPRs challenge the same claims on the same grounds, include the same claim constructions and the same arguments, rely on the same exhibits, and use the same expert and the same expert declaration. Petitioner therefore seeks (1) a determination that this IPR warrants institution; and (2) joinder of this IPR into the Facebook IPR. That would result in Petitioner joining the Facebook IPR without any change to its scope or schedule. In support of this motion, Petitioner proposes consolidated filings and other procedural accommodations designed to streamline the proceedings.

#### **A. Reasons Why Joinder is Appropriate**

Joinder is appropriate because it is the most expedient way to secure the just, speedy and inexpensive resolution of the related proceedings. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). This IPR is substantively identical to the Facebook IPR, and thus would avoid multiplication of issues before the Board. Given the duplicative nature of these petitions, joinder of the related proceedings is appropriate. Further, Petitioner agrees to consolidated filings and discovery.

1. Substantively Identical Petitions

Petitioner represents that this IPR presents identical issues to the Facebook IPR in all substantive respects. They include identical grounds, analysis, and exhibits, and rely upon the same expert declarant and declaration. Accordingly, joining this IPR proceeding with the Facebook IPR proceeding would not entail any duplication of effort.

2. Consolidated Filings and Discovery

Because the grounds of unpatentability in this IPR and the Facebook IPR are the same, the case is amenable to consolidated filings. Petitioner agrees to consolidated filings for all substantive papers and to work with counsel for Facebook to incorporate Petitioner's positions into Facebook's efforts, so long as Facebook is a party to the joined proceedings. Specifically, Petitioner agrees to work with Facebook to incorporate Petitioner's positions with those of Facebook in consolidated filings, subject to the ordinary page limits for one party, and agrees not to make arguments separate from those advanced in the consolidated filings. This agreement thus avoids lengthy and duplicative briefing.

Consolidated discovery is also appropriate given that Petitioner and Facebook are using the same expert declarant who has submitted an identical declaration in the two proceedings. Petitioner therefore agrees that Facebook will be responsible for conducting cross and re-direct examination of witnesses and that

no additional depositions would be needed, if joinder is granted, and that it will work with Facebook prior to any deposition to incorporate Petitioner's positions into Facebook's questioning. Petitioner further agrees that depositions should take place in the normal time allotted with counsel for Facebook responsible for examination and defense of witnesses, albeit with attendance by Petitioner's counsel.

Petitioner further agrees to work with Facebook prior to any hearing to incorporate Petitioner's positions into Facebook's presentations, with counsel for Facebook responsible for making the presentation at the hearing, again with attendance by Petitioner's counsel at any such hearing. These procedures would remove or minimize any complication, duplication, or delay caused by joinder.

**B. No New Grounds of Unpatentability**

This IPR raises no new grounds of unpatentability from those of the Facebook IPR because the corresponding petitions are substantively identical.

**C. No Impact on IPR Trial Schedule**

The trial schedule for the Facebook IPR would not need to be delayed to effect joinder. Because Petitioner raises the same grounds based on the same evidence and the same expert declaration, Petitioner can join Facebook's proceeding without any change to the trial schedule. The joint proceeding would

allow the Board and the parties to focus on the merits in one consolidated proceeding in a timely manner.

**D. Briefing and Discovery Will Be Simplified**

Joinder will simplify briefing and discovery because Petitioner seeks an order similar to that issued in *The Gillette Company v. Zond, LLC*, IPR2014-01012 (PTAB October 23, 2014) (Paper 13). Petitioner and Facebook will engage in consolidated filings and discovery, which will simplify the briefing and discovery process. Petitioner will assume an “understudy” role, and only assume an active role in the event that Facebook settles with Patent Owner.

**E. No Prejudice to Patent Owner if Proceedings Are Joined**

Joinder with the Facebook IPR will not cause any prejudice to the Patent Owner. If Petitioner joins the Facebook IPR, there will be no additional issues or costs to the Board or Patent Owner above and beyond those presented by the Facebook IPR on its own.

Institution and joinder will also promote judicial efficiency. Congress created these proceedings as a more efficient way to litigate patent validity issues. Instituting trial and granting joinder will have no negative effect on the Board and Patent Owner's resources, and will instead promote administrative and judicial economy before the Board and in district court. Joinder of this proceeding with that of Facebook is thus fundamentally fair to all involved.

#### **IV. Conclusion**

For the foregoing reasons, Petitioner respectfully requests that the Board (1) determine that institution of trial is warranted; and (2) join the present proceeding into the Facebook IPR (IPR2016-01157).

Dated: January 9, 2017

Respectfully Submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 7th day of January, 2017, a true and correct copy of the foregoing document was served in its entirety in the manner indicated below on the following:

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