

2018-1400, -1401, -1402, -1403, -1537, -1540, - 1541

United States Court of Appeals
for the
Federal Circuit

Facebook, Inc.,
Appellant,

v.

Windy City Innovations, LLC,
Cross-Appellant.

Appeal from the Patent and Trademark Appeal Board
Case Nos. IPR2016-01156, -01157, -01158, and -01159

CROSS-APPELLANT'S RESPONSE BRIEF

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CERTIFICATE OF INTEREST

Counsel for Windy City Innovations, LLC certifies the following:

1. The full name of every party or amicus represented by me is:

Windy City Innovations, LLC

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

Windy City Innovations, LLC

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court and who are not already listed on the docket for the current case:

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5. The following cases are pending in a court or agency and will directly affect or be directly affected by this court's decision in the pending appeal:

Patent & Trademark Office - Patent Trial & Appeal Board in Inter Partes Review Nos. IPR2016-01156, IPR2017-00709, IPR2017-00659, IPR2016-01157, IPR2016-01158, and IPR2016-01159.

***Windy City Innovations, LLC v. Facebook, Inc.*, Case No. 4:16-cv-01730-
YGR, United States District Court, Northern District of California**

Dated: August 31, 2018

By: /s/ Vincent J. Rubino III

Vincent J. Rubino III
Brown Rudnick LLP

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STATEMENT OF RELATED CASES

In accordance with Federal Circuit Rule 47.5, counsel for Appellee/Cross-Appellant Windy City Innovations, LLC (“Windy City”) states:

1. Windy City is unaware of any other appeal in or from IPR proceeding Nos. IPR2016-01156, IPR2016-01157, IPR2016-01158, IPR2016-01159, IPR2017-00659 and IPR2017-00709 in this Court or any other appellate court.
2. The following cases are pending and may directly affect or be directly affected by the Court’s decision in the pending appeal:

Windy City Innovations, LLC v. Facebook, Inc., Case No. 4:16-cv-01730-YGR (N.D. Cal.) (“District Court Litigation”). The District Court Litigation is a currently ongoing patent suit in which U.S. Patent Nos. 8,407,356, 8,458,245, 8,473,552 and 8,694,657 are asserted by the patent owner/appellee Windy City Innovations, LLC.

JURISDICTIONAL STATEMENT

Windy City Innovations, LLC (“Windy City”) cross-appeals the Final Written Decisions by the Patent Trial and Appeal Board (“Board” or “PTAB”) in three *inter partes* review (“IPR”) Proceedings conducted pursuant to 35 U.S.C. §§ 6 and 318(a) for 8,694,657 (“’657 Patent”), 8,473,552 (“’552 Patent”), 8,407,356 (“’356 Patent”) (IPR2016-01159, IPR2016-01158, and IPR2016-01157, respectively). The Board issued Final Written Decisions in each Proceeding dated December 6, 2017, concluding that Facebook, Inc. (“Facebook”) had shown by a preponderance of the evidence that the following claims were unpatentable:

- (1) claims 189, 334, 342, 348, 465, 477, 482, 487, 492, 580, 584, and 592 of the ’657 Patent;
- (2) claims 2, 3, 5, 7, 10–17, 59, and 64 of the ’552 Patent; and
- (3) claims 1–9, 12, 15–28, 31, and 34–37 of the ’356 Patent.

Windy City filed timely notices of appeal on February 7, 2018. This Court has subject matter jurisdiction pursuant to 35 U.S.C. § 141(c) and 28 U.S.C. § 1295(a)(4)(A).

STATEMENT OF THE ISSUES

1. Is there substantial evidence to support the Board’s conclusion in IPR2016-01156 that claims 1-15, 17-19 and 22-25 of the ’245 Patent were not unpatentable as obvious under 35 U.S.C. § 103(a) over the instituted grounds?
2. Is there substantial evidence to support the Board’s conclusion in IPR2016-01159 that claims 203, 209, 215 and 221 of the ’657 Patent were not unpatentable as obvious under 35 U.S.C. § 103(a) over the instituted grounds?
3. Is there substantial evidence to support the Board’s conclusion in IPR2016-01158 that claims 1, 4, 6, 8, 9 and 18-58 of the ’552 Patent were not unpatentable as obvious under 35 U.S.C. § 103(a) over the instituted grounds?
4. Did the Board err when it found that a person of ordinary skill in the art would combine U.S. Patent No. 6,608,636 (“Roseman”) and EP 0621532 A1 (“Rissanen”) in Final Written Decisions in IPR2017-01157, IPR2017-01158 and IPR2017-01159?
5. Did the Board twice exceed its statutory authority and abuse its discretion when it granted joinder to Facebook — an otherwise-time-barred party that

was already the petitioner in the case — in order to add new claims and new issues to two instituted *inter partes* review.

STATEMENT OF THE CASE

I. PROCEDURAL HISTORY

This appeal arises from four separate *inter partes* review petitions filed by Facebook on June 3, 2016 relating to the 8,458,245 (“’245 Patent”), the ’356 Patent,¹ the ’552 Patent and the ’657 Patent. (IPR2016-1156, -1157, 1158 and -1159, respectively) Previously, Windy City had filed an action in district court asserting these four patents against Facebook on June 2, 2015. *Windy City Innovations, LLC v. Facebook Inc.*, Case No. 1:15-cv-00102-GCM, Dkt. No. 1 (W.D. N.C. Jun. 2, 2015). Process was served on Facebook the next day. *Windy City Innovations, LLC v. Facebook Inc.*, Case No. 1:15-cv-00102-GCM, Dkt. No. 13 (W.D. N.C. Jun. 22, 2015).

On December 12, 2016, the Board issued decisions instituting petitions with respect to claims 1-59 and 64 of the ’552 Patent and claims 189, 334, 342, 348, 465, 580, 584, and 592 of the ’657 Patent. *Facebook Inc. v. Windy City Innovations, LLC*, Case IPR2016-01158, Paper No. 7 at 36(P.T.A.B., Dec. 12, 2016) (Appx3873.); *Facebook Inc. v. Windy City Innovations, LLC*, Case IPR2016-01159, Paper No. 7 at 36(P.T.A.B., Dec. 12, 2016) (Appx5604.) Three

¹ Facebook appeals the Board’s decision regarding two claims from the ’356 Patent. However, those claims were invalidated by the PTAB in a separate Petition from which Windy City voluntarily dismissed its appeal. *Windy City Innovations, LLC v. Facebook Inc.*, 18-1543 No. 24 (Fed. Cir. 2018) (dismissing appeal of IPR2016-01067). Therefore, Facebook’s arguments regarding the ’356 Patent are moot and Windy City does not address them.

days later, it issued decisions instituting petitions with respect to claims 1–15, 17, and 18 of the '245 Patent and claims 1–9, 12, 14– 28, 31, and 33– 37 of the '356 Patent. *Facebook Inc. v. Windy City Innovations, LLC*, Case IPR2016-01156, Paper No. 7 at 30-31 (P.T.A.B., Dec. 15, 2016) (Appx566-Appx567.); *Facebook Inc. v. Windy City Innovations, LLC*, Case IPR2016-01157, Paper No. 7 at 26 (P.T.A.B., Dec. 15, 2016) (Appx2255.)

On January 12, 2017, Facebook filed a petition for *inter partes* review of claims 203, 209, 215, 221, 477, 482, 487, and 492 of the '657 Patent. *Facebook Inc. v. Windy City Innovations, LLC*, Case IPR2017-00659, Paper No. 2 (P.T.A.B., Jan. 12, 2017) (Appx7252.) With its petition, Facebook filed a motion for joinder with its own previously-filed petition, the -01159 IPR. *Id.* Paper No. 3 (Appx7329.) On January 17, 2017, Facebook filed another petition seeking review of claims 19 and 22-25 of the '245 Patent. *Facebook Inc. v. Windy City Innovations, LLC*, Case IPR2017-00709, Paper No. 2 at 1. (P.T.A.B., Jan. 17, 2017) (Appx8036.) With this petition, Facebook filed a motion for joinder with its own previously-filed petition, the -01156 IPR. *Id.* Paper No. 3 (Appx8101.)

With respect to both of these January 2017 petitions, Windy City opposed the proposed joinders including on the basis that such joinders “circumvent[. . . statutory limitations on petitioners.” *Facebook Inc. v. Windy City Innovations, LLC*, Case IPR2017-00659, Paper No. 8 at 6. (P.T.A.B. Feb. 13,

2017) (Appx7371.); *Facebook Inc. v. Windy City Innovations, LLC*, Case IPR2017-00709, Paper No. 8 at 8. (P.T.A.B., Feb. 17, 2017) (Appx8147.) Ultimately, the Board joined the -00659 IPR with the -01159 IPR and the -00709 IPR with the -01156 IPR. *Facebook Inc. v. Windy City Innovations, LLC*, Case IPR2017-00659, Paper No. 11 at 15. (P.T.A.B., Jul. 31, 2017) (Appx7399.); *Facebook Inc. v. Windy City Innovations, LLC*, Case IPR2017-00709, Paper No. 11 at 8. (P.T.A.B. Aug 1, 2017) (Appx8172.)

On December 6, the Board issued final written decisions. It found that petitioner had failed to show that claims 1–15, 17–19, and 22–25 of the '245 Patent were unpatentable. (Appx34.) It found that claims 1–9, 12, 15–28, 31, and 34–37 of the '356 Patent are unpatentable but that petitioner had failed to show that claims 14 and 33 were unpatentable. (Appx94.) It found that claims 2, 3, 5, 7, 10–17, 59, and 64 of the '552 Patent are unpatentable, but that petitioner had failed to show that claims 1, 4, 6, 8, 9, and 18–58 were unpatentable. (Appx154.) It found that claims 189, 334, 342, 348, 465, 477, 482, 487, 492, 580, 584, and 592 are unpatentable, but that petitioner had failed to show that claims 203, 209, 215, and 221 were unpatentable. (Appx211.)

On January 11, Facebook filed its appeal. On February 9, Windy City filed this cross-appeal.

II. THE PATENTS

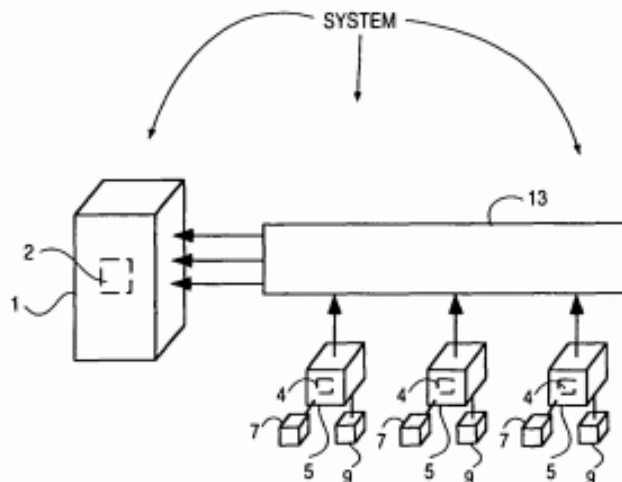
The '245 Patent, the '356 Patent, the '552 Patent, and the '657 Patent share a common specification and trace their priority to an application filed on April 1, 1996.² (Appx226, Appx263, Appx299, Appx337.) The '245 Patent was filed during the infancy of the Internet, over 20 years ago, long before real-time digital communications were as ubiquitous as they are today. (Appx637.) The inventor, Dr. Daniel Marks, recognized problems with available communications systems and disclosed a system that solved those problems and on whose relevance is still felt today. (Appx637.) The first problem identified by Dr. Marks was the difficulty in applying the “corporate” conference model to the Internet. (Appx250, 1:29-39.) In the corporate model, systems were often connected over private connections, such as leased lines, LANs, or WANs. (Appx637.) Because of the architecture of these corporate solutions, less emphasis was placed on security, privacy, and platform independence, and these solutions were ill-suited for real-time Internet communications. The second problem was that “chat rooms,” such as America Online (“AOL”), had not yet reached Internet maturity. (Appx638.) Chat rooms were closed platforms that provided limited options for users to access the systems. (Appx250, 1:47-56.) Additionally, these chat rooms utilized proprietary

² For convenience, references to the specification cite only to the '245 Patent. The '245 Patent, the '552 Patent and the '657 Patents are also referred to herein as the “Challenged Patents.”

connections and protocols and, prior to April 1996, AOL did not offer Internet-based real-time communications.

Prior systems exhibited shortcomings related to security, privacy, and real-time multimedia communication. Dr. Marks described a system to overcome the problems of both the “corporate” conference environment, such as those disclosed in prior art systems, as well as the problems with ISP environments, such as AOL. Dr. Marks’ solution focused on the control computer which included a database that stores tokens and which affords information to other programs, a concept that did not exist in the prior art. Figure 1 of the ’245 Patent shows System 1 that comprises a central computer with a connection 13 to a plurality of participator computers 5. (Appx251, 4:65-66; Appx252, 5:1-4; Appx252, 5:15-18.)

FIG. 1



The database and tokens provide security and privacy advantages over prior art systems in part, due to the persistence of the information which is necessary in a distributed environment such as the Internet.

One of the advantages of the claimed system is the flexibility to provide censorship via tokens. Censorship is described as follows:

Censorship, which broadly encompasses control of what is said in a group, is also arbitrated by means of the tokens. Censorship can control of access to system 1 by identity of the user, which is associated with the user's tokens. By checking the tokens, a user's access can be controlled per group, as well as in giving group priority, moderation privileges, etc.

Censorship also can use the tokens for real time control of data (ascii, text, video, audio) from and to users, as well as control over multimedia URLs--quantity, type, and subject.

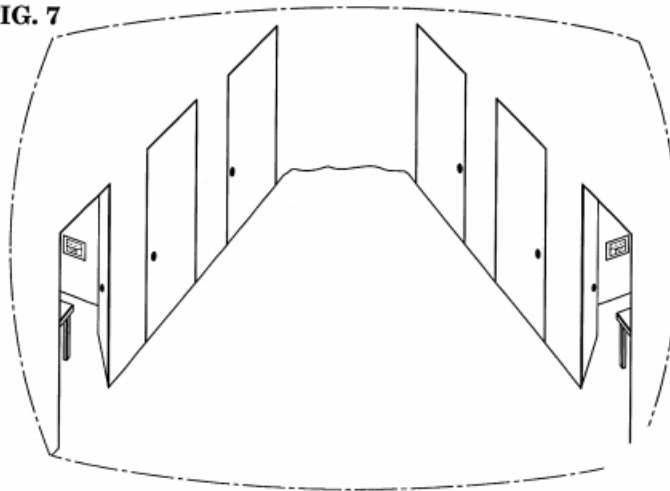
(Appx253, 8:36-44.)

III. THE ASSERTED PRIOR ART

A. Roseman

The Roseman reference, U.S. Patent No. 6,608,636, is entitled "Server Based Virtual Conference" and describes a system for multimedia conferencing, where parties are linked by both video and audio media. (Appx1195.) Roseman employs the "corporate" paradigm and does not teach the advantages of the Challenged Patents. (Appx1220, 4:47-50.) In Roseman, a conference is represented visually as a common virtual conference table on which each participant can place a document electronically, manipulate and write on the

document, write on a virtual notepad, and move a pointer to draw other users' attention. (Appx1219, 2:38–45.) Unlike the Challenged Patents, Roseman discloses that the common conference room is generated by the host computer, not the users' computers. (Appx1222, 7:54–60). For example, “[e]ach Invitee has a pointing device (or, alternately, a keyboard which can move a cursor). Each local computer transmits its cursor position to the host. The host positions each Invitee's cursor on the table, as appropriate.” (Appx1222, 7:61- 65). Roseman also discloses the host server manipulating the image seen on participants' local computers, even in the case where the image is customized to a particular user. For example, Roseman states that before a meeting occurs, a “Requester [of a meeting] can ‘walk the halls.’ The *host shows an image of a hallway*, as in FIG. 7.” (Appx1220, 4:54-55 (emphasis added).)

FIG. 7

Also, before the meeting can take place, the host server controls the image that appears on an invitee's screen and may be blocked by the invitee: "[t]he image placed onto the Invitee's screen is that seen by the Requester's close-up camera, and occupies a small portion of the invitee's display. The Invitee has the option of blocking such beckoning, by instructing the host computer to block such interruptions." (Appx1221, 5:26-30.)

In order to enter a closed conference room, a user needs an appropriate key. (Appx1221, 6:50-59.) Keys are essentially a block of data, or a code. (Appx1221, 6:60-61.) These keys are distributed electronically as part of invitations. (Appx1223, 9:54.) Certain types of keys may not be copied or transferred, while other types of keys may be passed to exactly one person, and a third type of key may be freely distributed and copied. (Appx1223, 9:43-47.)

B. Rissanen

The Rissanen reference, EP 0621532 A1, is entitled "Password Verification System" and discloses a system storing user passwords, and then using the stored password to *authenticate* a user when he accesses the system. (Appx1229, 1:21-28.) The user login and password may be stored in a database. (Appx1229, 2:22-29.) In one embodiment, a database 101, shown in Figure 2, stores a password file. (Appx1231, 5:24-28.) Each row in database 101 contains a user access code, a five number password, a model of each user's voice input for each password digit, and

an index to five different entries of reference voices stored in database 100. (Appx1231, 5:24-5:43; Appx1231, 6:13-6:22.) Database 100 contains one thousand different reference voices models, a “similarity score” between the reference voice and a particular user and a relative ranking of the similarity scores. (Appx1231, 5:52-6:12.) In the exemplary embodiment in Figure 2, database 101 stores indices to reference voice models that have an approximate 20th percentile rank order. (Appx1231, 6:16-19.)

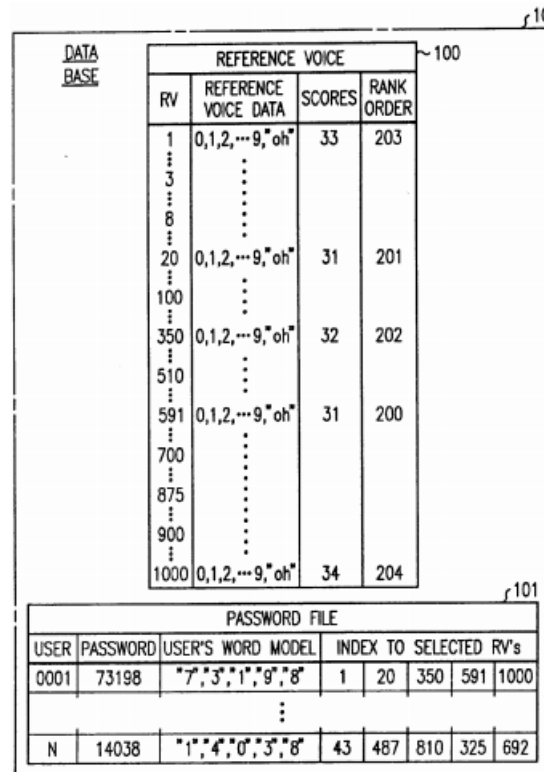


FIG. 2

Rissanen discloses a protocol in which a user logs onto the system and is prompted to speak the user’s password. (Appx1232, 8:3-6.) The system records the spoken password and compares it with the model of the user’s password to

create a first score. (Appx1232, 8:8-13.) The system also compares the spoken password with the each of the reference voice models and creates a second score. (Appx1232, 8:13-19.) The system then compares the difference between the first score and the second score to determine if it falls within an acceptable threshold. (Appx1232, 8:33-37.) This threshold can be “selected to provide a substantial degree of security while accommodating variations in a voice reply. . . .” (Appx1232, 8:37-40.) Based on the comparison of the two scores and the threshold, the system may *allow access* to the system, *deny access* or prompt the user to speak the password again. (Appx1232, 8:52-9:8.)

SUMMARY OF THE ARGUMENT

The Board’s decisions finding certain challenged claims not unpatentable should be upheld as Facebook cannot meet its high burden to overturn these rulings.

Regarding the ’245 Patent, Facebook’s argument before this Court is based on the incorrect premise that Roseman discloses functionality **within the user** computers related to generation of the conference room. The Board’s conclusion that Roseman discloses “process[ing] images at the host, not the local computers” was based on sound reasoning and analysis of the reference and pseudo-code cited by both Petitioner and Patent Owner. (Appx29.) Facebook fails to acknowledge that this pseudo-code indicates that, even in the context of a data file, images are rendered on the host. (Appx29; Appx1225, 14:53-62.) Moreover, the two “clear examples” identified by Facebook provide nothing more than speculation and attorney argument—nothing sufficient to disturb the Board’s findings of patentability.

Regarding the ’657 Patent, Facebook essentially seeks to rewrite the challenged claims relating to censorship. These claims include express “determining” limitations, such as “wherein the determining whether the first user identity is censored includes *determining that the first user identity is censored from the sending of the data presenting the video.*” Facebook on appeal seeks to

read out this second determination, arguing that indiscriminately censoring all communication is sufficient to accomplish this limitation. Facebook's new construction should be rejected.

Regarding the '552 Patent, Facebook seeks a claim construction at odds with its original Petition. According to Facebook, the limitation "storing each said user identity and a respective authorization to send multimedia data . . ." is met, so long as a user has authorization to participate indiscriminately, thus eliminating the claim language "to send multimedia data." Facebook's new construction should be rejected.

Further, at the heart of each of Facebook's IPRs is a prior art combination of two references, Roseman and Rissanen. While Facebook and its expert asserted that a person of ordinary skill in the art would have combined these two widely differing systems, they failed to explain how this would be accomplished. In contrast, Windy City's expert explained that the difficulty of combining these systems would have discouraged a person of ordinary skill in the art from making (or attempting to make) the combination. Accordingly, this Court should reverse all unpatentability findings for the Challenged Patents.

Finally, the Board exceeded its authority and abused its discretion when it allowed Facebook to join its own previously-filed IPRs more than one year after the original filing date on two separate occasions in contravention of the plain

language of 35 U.S.C. § 315(c). While Windy City ultimately prevailed with regard to most of the improperly joined claims, Facebook now asks this Court to reverse the PTAB's findings of invalidity. Accordingly, in the alternative, should Facebook prevail in its challenge to the PTAB's validity findings, this Court should instead reverse and dismiss as to those improperly joined claims. This Court has previously expressed concerns about other PTAB panels engaging in the same behavior and this appeal provides an opportunity to settle a split amongst the PTAB panels.

ARGUMENT AND STANDARD OF REVIEW

IV. STANDARD OF REVIEW

This Court reviews the Board's claim construction *de novo* while reviewing the underlying factual determinations concerning extrinsic evidence for substantial evidence. *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1061 (Fed. Cir. 2016) (citing *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1280 (Fed. Cir. 2015), *aff'd sub nom. Cuozzo Speed Techs., LLC v. Lee*, — U.S. —, 136 S. Ct. 2131, 195 L. Ed. 2d 423 (2016)). “The Board's legal conclusion of obviousness is reviewed *de novo*; its factual findings concerning extrinsic evidence are reviewed for substantial evidence.” *Id.* (citing *Cuozzo*).

Substantial evidence “means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Id.* (citing *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229, 59 S.Ct. 206, 83 L.Ed. 126 (1938)).

“An abuse of discretion occurs when the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *Stevens v. Tamai*, 366 F.3d 1330 (Fed. Cir. 2004) (quoting *Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1266-67 (Fed. Cir. 2003)).

V. THE PATENTABILITY FINDING FOR THE '245 PATENT SHOULD BE UPHELD

Facebook argues that the Board’s rationale for finding the ’245 Patent valid is flawed because it assumes that only the host generates images in the Roseman system. Facebook’s reasoning should be rejected as it relies on speculative attorney arguments, not previously presented to the Board, and it ignores other aspects of the Roseman system in which the host creates images beyond the common image representing the conference room. When the Roseman reference is viewed as a whole, there is sufficient evidence to support the Board’s conclusion.

First, Facebook concedes (as it must) that the Roseman reference discloses a central host that generates a common image displayed to all conference participants. Indeed, the Roseman reference is entitled “*Server Based Virtual*

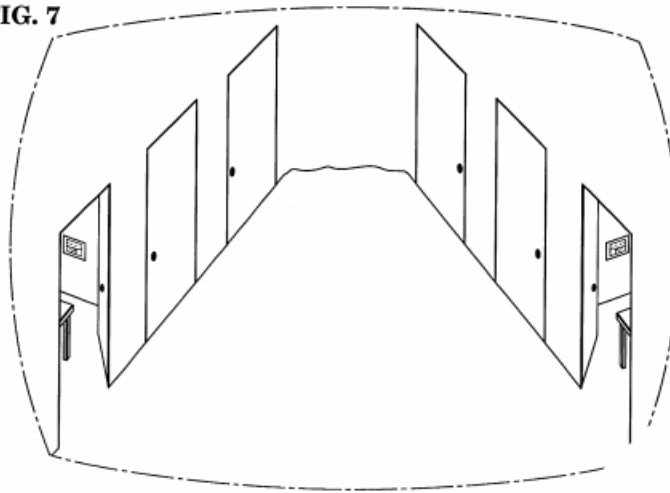
Conferencing.” (Appx1195 (emphasis added).) However, Roseman also discloses two other instances where the host (or server) generates an image for a single participant computer that is not shared with other participants. These examples provide further evidence to support the Board’s rationale that the host is responsible for images seen on a participant’s computer.

A. Roseman Discloses Additional Embodiments of the Host Computer Generating Images on Participant’s Screens Beyond the Common Image

Roseman discloses two instances where the host computer generates images on the participant’s computer. As these are conventional events, they indicate the extensive nature of the host computer generating images for participant computers.

One example occurs even before a meeting takes place in which the user of a specific participant computer decides to walk the hallways of the virtual office environment. In this scenario, the “Requester can ‘walk the halls.’ The *host shows an image of a hallway*, as in FIG. 7.” (Appx1220, 4:54- 55(emphasis added).) The image that this Requester sees is, therefore, customized, based on where he or she has chosen to walk:

FIG. 7



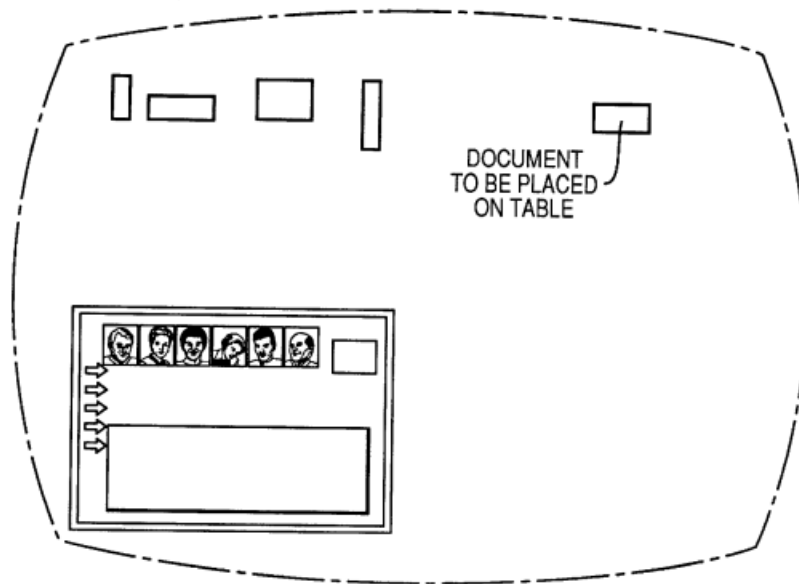
A second example where a participant computer may display different images also occurs before a meeting takes place. In this context, the host server controls the image that appears on an Invitee's screen and may be blocked by the Invitee: "[t]he image placed onto the Invitee's screen is that seen by the Requester's close-up camera, and occupies a small portion of the invitee's display. The Invitee has the option of blocking such beckoning, by instructing the host computer to block such interruptions." (Appx1221, 5:26-30.) Notably, the host computer must keep track of whether a specific Invitee (corresponding to a participant computer) has instructed it to not send such images. In this manner, the host computer knows how different participant computers have customized their displays and adjusts the images it presents to them accordingly.

B. The Note Passing and Document Drag-and-Drop Features Do Not Disclose Participant Computers Creating Their Own Images

Facebook, in order to succeed, must show that Roseman should be read as generating the images associated with note passing and document drag-and-drop features at the participant computer. There is nothing in the record that necessitates such a reading. Facebook did not advance this argument in its Petition and cannot now prevail on appeal through pure conjecture. Each of the scenarios it cites does not clearly show images generated locally. Instead, consistent with the Board’s reading of Roseman, these images are generated by the host computer.

First, Facebook suggests that the “note-passing” feature disclosed in Roseman implies that a local computer controls the image seen on its display. However, this is based on the assumption that the documents shown at the top of FIG. 10 exist outside the Roseman software system:

FIG. 10



In fact, the entire screen shown in FIG. 10 may correspond to the Roseman system as a whole, while the window at the lower left-hand corner may correspond to a specific meeting room within the Roseman system. Roseman's disclosure specifically refers to non-'meeting-room' windows: "This might be done by dragging an icon of the object from the outside (users non-'meeting room' windows) onto the table." (Appx1224, 11:20-22.) Roseman does not state that the area at top right of FIG. 10 is "outside the system" or "outside the software." Further, once "the other party sees the note on his picture, as in FIG. 12, he can drag it to a private viewing area, double-click it and read it." (Appx1223, 9:28-31.) By specifically referring to the "private area" and describing its operation, it is clear that this is part of the Roseman system, even though it is distinct from the meeting-room. Therefore, the host can create the images seen in this private area which contradicts Facebook's premise that these images are created locally. Further, Facebook does not cite to any expert testimony to support its speculative interpretation.

Facebook then turns to the so-called "Document Drag-and-Drop Feature," as relayed in the flow chart of FIG. 16A. (Appx1212.) Significantly, Facebook does not cite to *any* discussion in the specification explaining this figure as there is

none.³ Also, Facebook again relies on attorney arguments without the support of any expert testimony. The bottom box in this flow chart states that the “HOST TRANSMITS DATA FILE TO TABLE OF EACH PARTICIPANT.”

(Appx1212.) Interestingly, this refers to transmitting the file to the *table* of a participant and not to the participant. As a file cannot literally be sent to a table, this means that an icon representing the data file is placed on the table. Indeed, FIG. 16B (which Facebook neglects to discuss) begins its flow chart stating that an icon exists on the table: “IF ANY PARTICIPANT ACTIVATES DATA FILE ICON ON TABLE.” (Appx1212.) Similarly, FIG. 16C begins by referring to the icon on the table. (Appx1212.) While FIG.16C then states that the data file is presented to the individual participant, it does not state that this is done by the local computer. Therefore, since the scenario contemplated by FIG. 16C in which the file is presented on only one participant computer is part of the Roseman system, this is also accomplished by the host computer.⁴

C. The Roseman Reference Teaches Away From Local Computers Generating Their Own Images

³ In discussing FIG. 16C, Facebook points to the pseudo-code in the Appendix which is almost word-for-word identical to the flow chart. *Compare* Appx1212, FIG. 16C *and* Appx1225, 14:62-67.

⁴ Facebook also argues, in a footnote, that the host sends changes of a file to a local computer once a meeting is shut down. This, too, is insufficient to show that a local computer creates the images associated with those files, as those file transfers may be performed to ensure record keeping associated with a meeting.

In sum, Facebook has only provided two embodiments where it speculates through attorney argument that a local computer generates a local image. Such conjecture is insufficient where Facebook must show that the Board lacked substantial evidence for its decisions. *Trivascular, Inc. v. Samuels*, 812 F.3d at 1061 (Fed. Cir. 2016). Even if all of these points were true, the Board’s decision could be upheld as the Roseman reference as a whole teaches away from a local computer processing images by, for example, focusing on the host generating images for the participant computers. *Galderma Labs., L.P. v. Tolmar, Inc.*, 737 F.3d 731, 738 (Fed. Cir. 2013) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”).

D. Facebook Waived Any Argument Regarding Generation of Images on Local Computers

Finally, Facebook waived any arguments based on a local computer generating its own local images by failing to address this issue at the PTAB. *In re Baxter Int’l, Inc.*, 678 F.3d 1357, 1362 (Fed. Cir. 2012) (“Absent exceptional circumstances, we generally do not consider arguments that the applicant failed to present to the Board.” (internal citation omitted)). Nowhere in its petition, reply or at oral arguments did Facebook argue that such a scenario exists. As the Board correctly pointed out, Facebook appeared to argue the opposite in its petition: “But

Roseman does not appear to contemplate the scenario in which the second participant computer *internally determines that it cannot present the communication.*” (Appx457 (emphasis in original).)

Accordingly this Court should maintain the Board’s validity findings relating to the ’245 Patent.

VI. THE PATENTABILITY FINDING FOR THE ’657 PATENT SHOULD BE UPHELD

The Board properly upheld the validity of Claims 203, 209, 215 and 221 of the ’657 Patent in light of its claim construction and the alleged prior art. These claims depend from Claims 202, 208, 214 and 220, respectively, and those claims, in turn, all depend on Claim 189.

The relevant portion of Claim 189 reads:

. . .and determining whether the first user identity is individually censored from sending data in the communications, the data presenting at least one of a pointer, video, audio, a graphic, and multimedia by determining whether a respective at least one parameter corresponding to the first user identity has been determined by an other of the user identities;

Claim 202 adds the following representative clause to Claim 189:

wherein the determining whether the first user identity is censored includes determining that the first user identity is censored from the sending of the data presenting the video.

Further, the specification’s discussion of censorship is limited to the following portion:

Censorship, which broadly encompasses control of what is said in a group, is also arbitrated by means of the tokens. Censorship can control of access to system 1 by identity of the user, which is associated with the user's tokens. By checking the tokens, a user's access can be controlled per group, as well as in giving group priority, moderation privileges, etc.

Censorship also can use the tokens for real time control of data (ascii, text, video, audio) from and to users, as well as control over multimedia URLs--quantity, type, and subject.

(Appx253, 8:36-44.)

A. The Board Properly Construed Censorship for the Challenged Claims

In its institution decision, the Board provided its preliminary construction of “censor” as “control of what is said in a group.” The Board went on to state that, “in the context of [C]laim 189, ‘the first user identity is individually censored from sending data’ refers to control of data sent by the at least one of the user identities, individually, and is not limited to data suppressed, based on the content of those data or by a moderator.” (Appx5581.) Facebook never disagreed with these constructions, nor did it seek an additional construction of the “censor” term in the context of those claims which derive from Claim 189. (Appx165.)

As the Board explained in its final written decision, the core of Facebook's argument is that “by censoring a user from sending any content, the user effectively is censored from sending individual types of content. . .even if there is no determination specific to the type of content.” (Appx201.) Facebook does not

dispute that its prior art combination fails to disclose a censorship determination based on the type of content. Yet, when the limitation of Claim 202 is added to Claim 189, it is clear that the censorship has been refined to include censorship of video data “determining that the first user identity is censored from the sending of the data presenting the video.” Further, this is consistent with the specification: “[c]ensorship also can use the tokens for real time control of data (ascii, text, video, audio) from and to users, as well as control over multimedia URLs-- quantity, type, and subject.” (Appx256, 8:40-44.)

If, as Facebook contends, the added limitation of Claim 202 simply requires that video be blocked without a determination that the data comprise video, this clause should have been modified as follows:

wherein the determining whether the first user identity is censored includes ~~determining that the first user identity is censored~~ determining the first user identity from the sending of the data presenting the video.

Facebook seeks to rewrite this claim to remove the second “determining” from Claim 202. In effect, it seeks a construction⁵ that would ignore a portion of the claim language – “determining that the first user identity is censored” – without providing any persuasive rationale. “[I]nterpretations that render some portion of the claim language superfluous are disfavored. . . .” *Power Mosfet Techs., L.L.C.*

⁵ Facebook has waived any right to argue for a claim construction for this term as it did not do so at the PTAB. *In re Baxter Int’l, Inc.*, 678 F.3d 1357 at 1362.

v. Siemens AG, 378 F.3d 1396, 1410 (Fed. Cir. 2004); *see also, Merck & Co. v. Teva Pharm. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) (“A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.” (citations omitted)). It is this **determination** that that the user is censored from sending video, rather than the mere result of video being censored, that is captured by this language. Therefore, Facebook’s implicit construction should be rejected.

Finally, Facebook’s reference to Claim 204 is equally unavailing. Claim 204 adds the following limitation to Claim 202: “further including determining whether at least one of the communications is censored based on content.” When read in context of Claim 202, this is properly read as an additional requirement regarding censoring of the content. For example, Claim 202 could capture the case where content containing video is censored, and Claim 204 could capture the case where certain video content is censored, such as video not suited for certain audiences.

The same reasoning as discussed above for the video of Claim 202 applies to the audio of Claim 208, graphic of Claim 214 and multimedia of Claim 220. Therefore, this Court should uphold the validity of Claims 203, 209, 214 and 221 of the ’657 Patent.

VII. THE PATENTABILITY FINDING FOR THE '552 PATENT SHOULD BE UPHELD

Facebook focuses its argument with respect to '552 Patent on the following two limitations of Claim 1: a “controller computer system control[s] real-time communications” by (1) “storing each said user identity and a respective authorization to send multimedia data . . .” and (2) “if permitted by the user identity corresponding to one of the participator computers, allowing the one of the participator computers to send multimedia data to another of the participator computers.” It then argues that these two limitations are present in Roseman (alone or with Rissanen) and, therefore, Claim 1, as well as Claims 4, 6, 7, 9, 18, 50, 54 and 58, should be held invalid. The prior art does not teach these two limitations and therefore this Court should uphold the validity of these claims.

A. The Prior Art Does Not Disclose Separately Storing a User Identity and a Respective Authorization as Required by the Claims

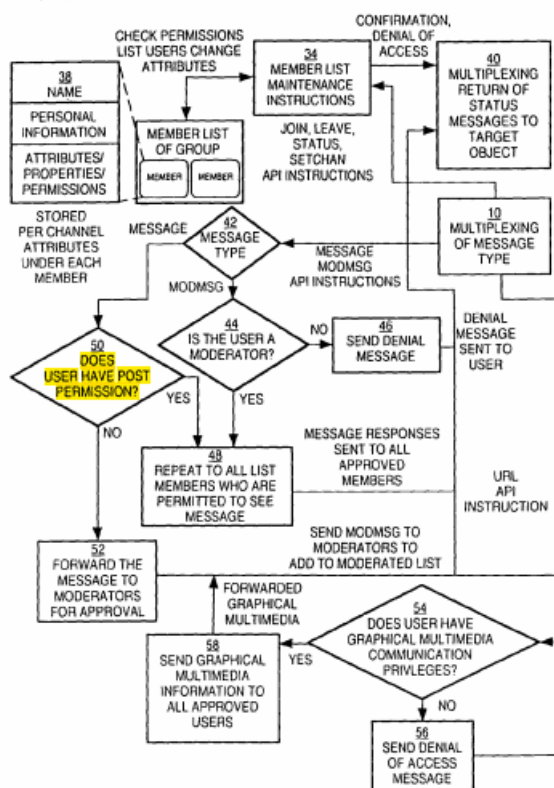
The first limitation requires storage of “each said user identity” along with a “respective authorization to send multimedia data.” However, the antecedent basis for “each said user identity” appears earlier in these claims as an “*authenticated* user identity.” Accordingly, an authenticated user identity needs its own authorization to send multimedia data. However, in the prior art, the only “authenticated user identity” is an individual who has been granted access to a conference room. By arguing that, “if a user is permitted to send multimedia data

simply by virtue of being authorized to join a group or conference, the claim limitations are satisfied,” Facebook implicitly concedes that there is no separate storage of an authorization to send multimedia data as required by the first claim element. Regardless of the specific construction of “authorization,” the claim requires storing authorization per user identity. Therefore, Facebook’s attempt to overlook this claim limitation should be rejected.

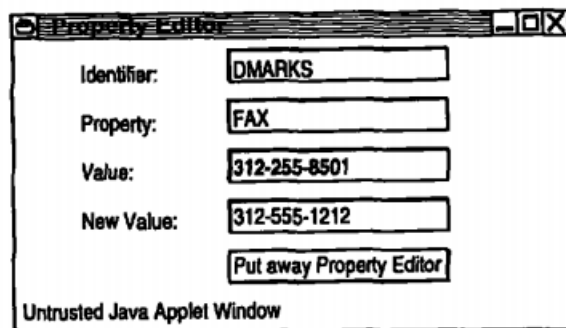
B. The Prior Art Does Not Disclose Checking Permission Prior to Sending Multimedia Data

The second claim limitation requires a check that the user identity is allowed to send the multimedia data: “if permitted. . .” Such a check is explicitly disclosed in the specification and in Fig. 3: “the logic flows to Block 50, which tests whether a user has post permission. If the user has post permission, the logic flows to Block 48. . .” (Appx252, 6:32-35.)

FIG. 3



In spite of this, Facebook does not point to any disclosure in the prior art where such a check occurs. At best, the Roseman system discloses a “preauthorization” scheme where all invitees are permitted to send multimedia data. Moreover, the prior art does not disclose where this authorization may be altered during the lifecycle of the system. Therefore, it is an *unalterable* preauthorization which would *never* require a check. In contrast, the patents contemplate changing permissions: “FIG. 27 is an illustration of a proprietary editor, suitable for a dialog to change tokens, on a screen of the present invention.” (Appx250, 3:52-53.)

FIG. 27

Therefore, the prior art fails to teach the second limitation.

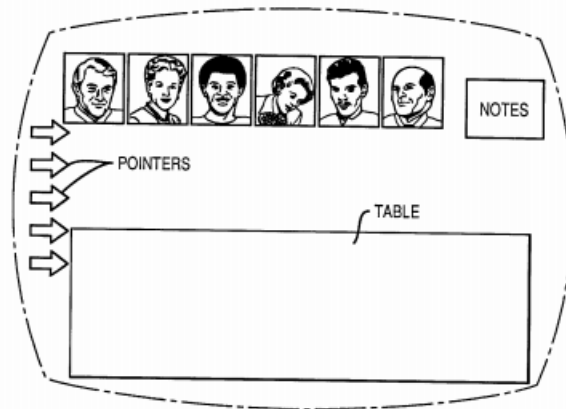
C. The Spectators of Roseman Do Not Disclose Either of the Two Required Claim Limitations

Facebook's argument with respect to "Spectators," disclosed in Roseman, should be dismissed for several reasons. First, Facebook fails to point to *any* prior argument in the record that accounts for the "Spectators" and neglects to articulate a reason why it has not waived the issue as presented. Hence, this Court should not consider the "Spectators" on procedural reasons. *In re Baxter Int'l, Inc.*, 678 F.3d 1357 at 1362 (Fed. Cir. 2012).

On the merits, the Spectators of Roseman do not teach the two required claim limitations. First, there is no teaching in Roseman of storing an identity and authorization with respect to the Spectators. For example, there is no indication in Roseman that each (or any) Spectator corresponds to a unique user identity. Roseman merely states that for certain conferences any person can enter and observe. (Appx1222, 7:21-24.) Therefore, Roseman does not disclose an

embodiment where there is a record of which individuals entered the room as Spectators. In contrast, Roseman affirmatively discloses recording the invitees that have entered as their pictures are displayed. (Appx1223, 9:35-38.)

FIG. 9



By failing to record which users enter as Spectators, Roseman does not disclose any storage of these user identities and does not teach the first claim element.

The Roseman reference also does not disclose an (1) authorization corresponding to a user identity or (2) a check of permission with respect to these Spectators, as would be required by the first and second claim limitations, respectively. As these Spectators do not have permission to send any data, there is no need to record an authorization or a check of permission. (Appx1222, 7:21-24.) For example, the Spectator feature could be implemented through a different graphical user interface than a typical Invitee. Once a Spectator has entered a conference room, he may be provided with GUI that lacks an area to enter potential

messages. The possibility of performing a check on a potential message does not even exist. Therefore, Roseman does not teach these limitations.

Accordingly, this Court should uphold the validity of the Claims of the '552 Patent.

VIII. THE BOARD IMPROPERLY COMBINED THE ROSEMAN AND RISSANEN REFERENCES

In all four of its challenged petitions, Facebook cited an obviousness combination that included the Roseman and Rissanen references. In the -1157, -1158 and -1159 final decisions, the Board found that this was a permissible combination. (Appx71; Appx127; Appx186.) As a result, the Board found Claims 1-9, 12, 15-28, 31, and 34-37 of the '356 Patent, Claims 2, 3, 5, 7, 10-17, 59, and 64 of the '552 Patent, and Claims 189, 334, 342, 348, 465, 477, 482, 487, 492, 580, 584, and 592 of '657 Patent not patentable. (Appx94; Appx154; Appx211.) However, the underlying evidence and Facebook's expert inability to explain how such a system would be built necessitate a different finding.

In support of its obviousness combination, Facebook relied on a declaration of Dr. Tal Lavian. Dr. Lavian claimed that as far as back as April 1996, his own background exceeded that of a person of ordinary skill in the art. (Appx1960, 161:14-17.) He declared that

[i]t would have been obvious to a person of ordinary skill in the art to combine Roseman with Rissanen, with no change in their respective functions, predictably resulting in the virtual conference system of

Roseman in which the conference room “keys” are stored in a database which serves as a repository of keys for other programs to access. A skilled artisan would have understood that the user identity and password information in Rissanen is analogous to the “keys” in Roseman, and would have been motivated to make this combination.

(Appx11391140.)

Under direct questioning, he stated that the Roseman reference discloses that a specific key may be associated with multiple rooms. (Appx1925, 18:11-17.) He admitted that “a level three key can be associated with more than one individual.” (Appx1926-27, 25:24-26:2.) He also conceded that a key can work for a specific room, but only during specific times. (Appx1930, 40:23-41:1). Therefore, unlike Rissanen’s password database which provides or denies access to the system, simply looking up a key in a database would not be sufficient to authenticate a user possessing a key in the Roseman system. Given that the two systems are in fact not analogous, Dr. Lavian’s testimony contradicts Facebook’s proffered motivation: “[a]lthough Rissanen also describes using spoken voice passwords, this Petition cites it for its more pedestrian teachings relating to database storage of passwords of any form.” (Appx2130.)

Remarkably, the expert then admitted that the prior art disclosure was insufficient to determine how one would implement the logic necessary to authenticate a key in the Roseman system:

Q: If you were writing a piece of software that -- that had to -- that had to process a key in the system, would one of

the pieces of information that you may want include the type of key, such as level one, level two, or level three key?

A: I'm not sure I can answer about this type of question without a clear definition and clear design document, clear architectural, clear spec. Off the top of my head, you can -- you can write on a piece of paper anything, but you have to have a spec.

Q: You don't consider the -- the specification of the '636 patent sufficient for your purposes?

A: No, the specification is the specification of the patent. This is not architectural document for software.

(Appx1927, 28:5-24 (objections omitted)). Ultimately, he agreed that the logic would likely include 1) the identity of the key; 2) the identity of the meeting room; and 3) the identity of the person seeking access to the meeting room. (Appx1928, 30:2-31:8.)

In contrast, Windy City's expert opined that it "would take substantial creativity to modify Risanen [sic] extensively in order to perform the functions taught by Roseman." (Appx1883, ¶43.) He added that:

I find the fact that Petitioner's expert could not explain how Roseman's keys would be stored in an actual system and how a determination of the logic could be made without referring to the user's identity provides strong additional evidence that a database merely storing the key and invitation level would not be sufficient to determine whether a person would be given access and therefore a person of ordinary skill in the art would not be motivated to combine any teaching from Rissanen with the Roseman system.

(Appx1885, ¶47.)

Since Facebook's expert only provided conclusory testimony about what a person of ordinary skill in the art could do, but failed to explain *how* the combined Roseman and Rissanen system would be implemented, there is no adequate factual basis to support the combination proffered by Windy City. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”); *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983) (“What matters in the § 103 nonobviousness determination is whether a person of ordinary skill in the art, having all of the teachings of the references before him, is able to produce the structure defined by the claim.”); *InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1351 (Fed. Cir. 2014) (overturning a jury's verdict of invalidity when underlying expert testimony was insufficient under the substantial evidence standard because, *inter alia*, it provided conclusory opinions about what a person of ordinary skill in the art could have done without addressing whether one would have been motivated to do so.); *Duke Univ. v. BioMarin Pharm. Inc.*, 685 F. App'x 967, 978 (Fed. Cir. 2017) (overturning obviousness finding from the PTAB where the underlying expert

testimony “falls short” of what is required because it only addressed what a person of ordinary skill could do in certain circumstances.)

Apart from the expert’s unsupported conclusions about what a person of ordinary skill could have implemented, the sum total of the Board’s reasoning is that

[g]iven that Roseman describes using keys to access conference rooms that have persistence, we agree with Petitioner that a database, described in Rissanen as storing similar information for a similar purpose, would be a straightforward and predictable choice for storing Roseman’s keys.

(Appx71.) However, this reasoning is flawed for the same reasons as set forth above with regard to Facebook’s expert. It does not address the difficulty of combining a database of Rissanen to authenticate the users of Roseman. Instead, by focusing on the similarity of using a database with persistence to address access to a conference room with persistence the Board, has defined the problem to be solved in a manner that presumes the solution. *See Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1377 (Fed. Cir. 2012) (“This statement of the problem represents a form of prohibited reliance on hindsight. The district court has used the invention to define the problem that the invention solves. Often the inventive contribution lies in defining the problem in a new revelatory way. In other words, when someone is presented with the identical problem and told to make the patented invention, it often becomes virtually certain that the artisan will succeed in making

the invention.”) Hence, the Board’s reasoning is based on an improper hindsight relating to the persistence of the conference room and cannot be applied to the combination of Roseman and Rissanen.

Accordingly, this Court should find that the Roseman and Rissanen references should not have been combined, and that the Board’s unpatentability findings as to Claims 1–9, 12, 15–28, 31, and 34–37 of the ’356 Patent, Claims 2, 3, 5, 7, 10–17, 59, and 64 of the ’552 Patent, Claims 189, 334, 342, 348, 465, 477, 482, 487, 492, 580, 584, and Claim 592 of ’657 Patent should be reversed.

IX. THE BOARD EXCEEDED ITS AUTHORITY WHEN IT IMPROPERLY JOINED FACEBOOK’S “SAME-PARTY” PETITIONS

The Board exceeded its statutory authority, abused its discretion, and has routinely done so, by erroneously concluding that 35 U.S.C. § 315(c) allows for same-petitioner joinder, *i.e.*, the joining of a new petition filed after the one-year bar date to the petitioner’s own already-instituted IPR. Windy City seeks a reversal as to two joinder decisions: (1) Facebook’s IPR2017-00709 with its own IPR2017-01156; and (2) Facebook’s IPR2017-00659 with its own IPR2017-01159. (Appx8172 and Appx7399, respectively.) Reversing these joinders would correct an abuse of discretion based on the application of incorrect law, resolve a split among Board panels and the Director of the United States Patent and Trademark

Office, and cease the routine practice of using § 315(c) to allow a time-barred petitioner to add new claims and new issues to its own instituted IPR.

Section 315(c) does not authorize joinder of the same petitioner to its own instituted IPR under any reasonable interpretation, much less for the purpose of adding new claims to the already-instituted IPR. The statute states:

If the Director institutes an inter partes review, the Director, in his or her discretion, *may join as a party to that inter partes review any person* who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(c) (emphasis added). The text of the statute is unambiguous with respect to at least three relevant points. The statute makes clear what gets joined: any *person*. The statute makes clear how the person is joined: *as a party*. The statute makes clear to what the party joins: *the instituted review*.

Here, the two joinder decisions by the Board represent a clear abuse of discretion applying incorrect law for at least two fundamental reasons. First, Section 315(c) does not authorize a petitioner that is already *a party* to an instituted IPR to join that IPR. Second, Section 315(c) does not authorize the addition of new claims and new issues to the *instituted review*.

A. 35 U.S.C. § 315(c) Does Not Authorize Same-Petitioner Joinder

Section 315(c) of Title 35 does not authorize a petitioner that is already a party to an instituted IPR to join that same IPR. Because Facebook was a

petitioner in an already-instituted IPR, it was already participating *as a party* to the case and could not be joined *as a party to that instituted review*. If Congress intended to allow same-petitioner joinder without restriction, Congress would have omitted from Section 315(c) the restriction “*as a party to that instituted review*” or it would have expressly created an avenue to amend the authorized case which the Board acknowledged was Facebook’s ultimate objective in seeking joinder of a second set of different claims. (Appx768.) Disturbing the silence of Congress, where silence would otherwise act as a prohibition, is a clear and unmistakable abuse of discretion. The Board’s “power is no greater than that delegated to it by Congress.” *Lyng v. Payne*, 476 U.S. 926, 937 (1986). As a “creature of statute,” the Board’s authority “must be grounded in an express grant from Congress.” *Killip v. Office of Pers. Mgmt.*, 991 F.2d 1564, 1569 (Fed. Cir. 1993).

On this very issue, the Board itself remains split and in discord with the Director. In both of the joinder decisions at issue, a majority of the panel, consisting of Administrative Patent Judges J. John Lee and David C. McKone, wrote separately and expressed their “concerns regarding an important issue.” IPR2017-00709, Paper 11 (Appx8173.) (also filed in IPR2016-01156 as Paper 34 at 12 (Appx775.)) The judges stated that “§ 315(c), when properly interpreted, does not authorize same-party joinder because a party cannot be joined to a proceeding ‘as a party’ if it already is a party to that proceeding.” (Appx776); *see*

also IPR2017-00659, Paper 11 at 17 (Appx7401.) Yet, recognizing that the Director “has taken the position before [this Court] that such same-party joinder is permitted by § 315(c)” in *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, No. 2016-2321 (Fed. Cir. filed Jan. 12, 2017), the Board concurred with the grant of joinder notwithstanding their express “disagreement” with the Director’s interpretation of § 315(c). (Appx7401.)

Highlighting this disagreement, the majority identified a clear split in PTAB cases deciding the issue of same-petitioner joinder. Denying joinder and holding that “35 U.S.C. § 315(c) provides for the joinder of parties only, not issues, and does not contemplate joinder by someone who is already a party,” the Board in *SkyHawke* explained that the statute was clear in excluding “the joining of a petition or new patentability challenges,” and “the joining of a new issue (as opposed to a person).” *SkyHawke Technologies, LLC v. L&H Concepts, LLC*, Case IPR2014-01485, Paper 13 at 3–4 (P.T.A.B., Mar. 20, 2015).

On the other side of the split, the argument in favor of same-petitioner joinder is largely enabled by the use of expanded rehearing panels. In *Target*, a three-judge panel initially denied joinder, finding that § 315(c) authorized only the joining of a petitioner (not an issue or petition) as a party to an instituted IPR, and that *Target* could not be joined because it was already a party to the instituted proceeding. *Target Corp. v. Destination Maternity, Corp.*, Case IPR2014–00508,

Paper 18 at 3 (P.T.A.B., Sept. 25, 2014). After a rehearing request, an expanded rehearing panel reversed the denial of joinder. *Id.*, Paper 28. The expanded rehearing panel reasoned primarily that “the statute does not exclude a person who is already a petitioner in an instituted review proceeding that is the subject of the joinder analysis.” *Id.*, Paper 28 at 7. But, in deciding to extend joinder to an already-included petitioner under this flawed reasoning, the Board “transgress[ed] the limits of judicial power by an attempt to supply, by construction, this supposed omission of the legislature.” *Evans v. Jordan*, 13 U.S. 199, 203 (1815).

To the extent that this Court finds that Section 315(c) contains any ambiguity regarding this issue, the Board and this Court have acknowledged that the legislative history does not support same-petitioner joinder. *SkyHawke Technologies, LLC v. L&H Concepts, LLC*, Case IPR2014-01485, Paper 13 at 4 (P.T.A.B., Mar. 20, 2015); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1020 (Fed. Cir. 2017). Indeed, the Final Committee Report expressly states that under Section 315(c) “[t]he Director may allow other petitioners to join an inter partes or post-grant review.” H.R. REP. NO. 112-98, pt. 1, at 76 (2011) (emphasis added). While legislative history does not add to the statute, neither should the Director’s unreasonable interpretation.

B. 35 U.S.C. § 315(c) Does Not Authorize Joinder of New Claims or New Issues

Section 315(c) also does not authorize the Board's routine practice of adding new claims and new issues which are not present in that instituted review. But this is exactly the type of unauthorized joinder that the Board granted.

As noted above, Section 315(c) provides only for the joinder of *any person. . . as a party to that instituted review*, not for the joinder of new claims or new issues. The clear and unambiguous text of the statute, *i.e.*, the use of both a person and a party, excludes the joinder of issues or claims. Nevertheless, Facebook's motion for joinder with respect to its IPR2017-00709 requested "joinder only as to claims 19 and 22–25 of the '245 Patent, with instituted proceeding IPR2016-01156." (Appx8105.) In return, the Board's decision granted the motion while admitting that "the Motion here seeks to join challenges to different claims than in the [Instituted] IPR." (Appx768.) Similarly, Facebook's motion for joinder with respect to its IPR2017-00659 requested "joinder only as to claims 203, 209, 215, 221, 477, 482, 487, and 492 ('the Petition Claims') of the '657 Patent, with instituted proceeding IPR2016-01159." (Appx7333.) Again, the Board's decision granted the motion, while conceding the "new challenge of claims 203, 209, 215, 221, 477, 482, 487, and 492" (Appx5789.)

As with the unauthorized practice of same-petitioner joinder, the joining of new claims and new issues has split the Board. In *Niddec*, the majority of the initial

panel denied joinder on the basis that “only a person who is not already a party to an instituted inter partes review can be joined to the proceeding,” to which the sole dissenting judge responded, “that § 315(c) encompasses both party joinder and issue joinder, and, as such, permits joinder of issues, including new grounds of unpatentability, presented in the petition that accompanies the request for joinder.” *Zhongshan Broad Ocean Motor Co., Ltd. v. Nidec Motor Corp.*, Case IPR2015-00762, Paper 12 at 12–13 and 16 (P.T.A.B., July 20, 2015). An expanded rehearing panel reversed the denial of joinder and repeated verbatim the conclusion of statutory interpretation without explanation. *Zhongshan Broad Ocean Motor Co., Ltd. v. Nidec Motor Corp.*, Case IPR2015-00762, Paper 16 at 5 (P.T.A.B., October 5, 2015).

On appeal, this Court declined to address the unauthorized joinder as described above, instead resolving the case on obviousness grounds. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1016 (Fed. Cir. 2017). Consistent with the trend at the Board of writing separately against joinder practice, Judge Dyk, joined by Judge Wallach, wrote “to express [their] concerns as to the United States Patents and Trademark Office’s [] position on joinder and expanded panels since those issues are likely to recur.” *Nidec Motor Corp.*, 868 F.3d at 1019 (concurring). Judges Dyk and Wallach explained that Section 315(c) does not authorize, nor was it likely intended to allow, a time-

barred petitioner to add new issues “to an otherwise timely proceeding, whether the petitioner seeking to add issues is the same party that brought the timely proceeding, as in this case, or the petitioner is a new party.” *Id.* at 1020.

Windy City previously sought relief for this issue from this Court in the form of a writ of mandamus. *In Re: Windy City Innovations, LLC*, Case 18-102, No. 2 (Fed. Cir. 2017). While this Court declined to issue that extraordinary form of relief, it stated “it is clear that Windy City will have an opportunity in the relatively near future to address its concerns through a response or cross-appeal [to Facebook’s appeal].” *In Re: Windy City Innovations, LLC*, Case 18-102, No. 19 at *3 (Fed. Cir. 2018). Notably, the Board found Claims 477, 482, 487, and 492 of the ’657 Patent unpatentable in its final written decision in IPR2016-01159 even though these claims were not in the original petition. (Appx158.) Additionally, while the Board found Claims 203, 209, 215, 221 of the ’657 Patent and Claims 19 and 22–25 of the ’245 all patentable in its final written decision, Facebook has challenged those decisions in this appeal. (Appx34.)

Accordingly, this Court should withdraw the joinder decisions the Board issued with respect to (1) Facebook’s IPR2017-00709 with its own IPR2017-01156 and (2) Facebook’s IPR2017-00659 with its own IPR2017-01159.

X. CONCLUSION

For all of the foregoing reasons, Windy City respectfully requests that the Court uphold the Board's final written decisions confirming the validity of all the Claims of the '245, '657, and '552 Patents.

Dated: August 31, 2018

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on August 31, 2018, I caused a copy of the foregoing Cross-Appellant's Response Brief to be served on Appellant's counsel via electronic mail at the following addresses:

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CERTIFICATE OF COMPLIANCE

I certify that this Brief complies with the type-volume limitation of Fed. R. App. P. 27(d)(2)(A). This Brief contains 8,981 words, excluding the parts of the Brief exempted by Fed. R. App. 27(d) and Fed. Cir. R. 27(d). This Brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. 32(a)(6). This Brief has been prepared in a proportionally spaced typeface using Microsoft Word 2010 in 14 point Times New Roman font.

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