

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.

*Appeals from the United States Patent and Trademark Office, Patent Trial and
Appeal Board, in Case Nos. IPR2016-01156, IPR2016-01157, IPR2016-01158,
IPR2016-01159*

BRIEF FOR APPELLANT PURSUANT TO AUGUST 12, 2019 ORDER

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CERTIFICATE OF INTEREST

Counsel for Appellant Facebook, Inc. certifies the following:

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

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:
The party named in the caption, Facebook, Inc., is the real party in interest.

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: **There are no such corporations or companies.**

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:

Cooley LLP: Andrew C. Mace

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:

***Windy City Innovations, LLC v. Facebook, Inc.*, Case No. 4:16-cv-01730-YGR (N.D. Cal.), in which the Court on September 24, 2019 granted summary judgment of invalidity under § 101 as to the asserted claims of U.S. Patent No. 8,458,245 and directed the parties to submit a proposed form of judgment within five business days (Dkt. No. 215).**

***Windy City Innovations, LLC v. Facebook, Inc.*, Case Nos. 2018-1543, 2018-1544, 2018-1545 (Fed. Cir.), in which the patent owner Windy City appealed from IPR proceeding nos. IPR2016-01067, IPR2016-01141 and IPR2016-01155. The appeal was dismissed on May 14, 2018.**

Dated: October 1, 2019

By: /s/ Heidi L. Keefe
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TABLE OF AUTHORITIES

CASES

<i>Proppant Express Investments, LLC v. Oren Technologies, LLC</i> , No. IPR2018-00914, Paper 38 (P.T.A.B. Mar. 13, 2019)	1, 2
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Facebook, Inc. (“Facebook”) respectfully submits this brief pursuant to the Court’s order of August 12, 2019, inviting the parties to submit their views on what, if any, deference should be afforded to decisions of a Patent Trial and Appeal Board Precedential Opinion Panel (“POP”), and specifically to the POP opinion in *Proppant Express Investments, LLC v. Oren Technologies, LLC*, No. IPR2018-00914, Paper 38 (P.T.A.B. Mar. 13, 2019) (“*Proppant*”).

Facebook believes the Amicus Curiae Brief of the United States addressed the deference issues and does not have anything to add to that discussion. Beyond the abstract questions of constitutional authority and statutory interpretation, *Proppant*’s interpretation of the IPR joinder rules promotes substantial justice and efficiency in concrete, real-world situations—including the situation that arose in the case at bar. *Proppant* discusses the circumstances under which same-party joinder and/or issue joinder may be appropriate. For example, same-party joinder may be warranted in view of “actions taken by a patent owner in a co-pending litigation—such as the late addition of newly asserted claims” after expiration of the one-year statutory period for filing an IPR petition. *Proppant*, at 19.

That was precisely the situation in the present case. The plaintiff-patentee asserted four patents containing 830 claims. As the one-year deadline for IPR approached, the plaintiff refused to disclose which particular claims were allegedly infringed. The defendant (Facebook) did everything it could reasonably do in the

district court to obtain an identification of asserted claims in advance of the one-year deadline. Under the circumstances, permitting same-party joinder to IPR proceedings after the original one-year deadline, consistent with *Proppant's* interpretation of the applicable rules, was critically important to enable fair and efficient usage of the IPR procedure without burdening the parties and PTAB with a massively wasteful set of petitions challenging all 830 claims. Indeed, at the time that Facebook was faced with this factual scenario, Windy City did not dispute, and therefore waived, that this was an appropriate use of the same-party joinder procedure. (Reply Br. at 24-26.)

In an ideal world, these types of circumstances justifying same-party joinder after the one-year period would rarely, if ever, arise because district courts would actively foster the identification and narrowing of asserted claim selections well in advance of the one-year deadline. Such timely identification and narrowing of asserted claims enables the A.I.A.'s post-grant review procedures to achieve their statutory purpose as cost-effective alternatives to district court litigation. It also promotes the "just, speedy, and inexpensive determination of every action and proceeding." Fed. R. Civ. P. 1. The Court's opinion in this case would do well to discuss district court claim-selection procedures as implicated by *Proppant* in a way that encourages district courts to pursue these worthy objectives.

Dated: October 1, 2019

COOLEY LLP

By: /s/ Heidi L. Keefe

Heidi L. Keefe

Counsel for Appellant
FACEBOOK, INC.

CERTIFICATE OF SERVICE

I hereby certify that on October 1, 2019, I caused a copy of the foregoing Appellant's Opening Brief to be served on Appellee's counsel via electronic mail at the following addresses:

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CERTIFICATE OF COMPLIANCE

This brief complies with the page limitation of the Court's August 12, 2019, Order. Exclusive of the exempted portions of the brief, the brief contains 2 pages.

This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). The brief has been prepared in proportionally spaced typeface using Microsoft Word in 14 point Times New Roman font.

Dated: October 1, 2019

By: /s/ Heidi L. Keefe

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