NYIPLA PTAB Committee

October 6, 2020
4 p.m. E.T.

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AMSTER ROTHSTEIN & EBENSTEIN LLP
Intellectual Property Law

Nineteen Hundred and Twenty-two
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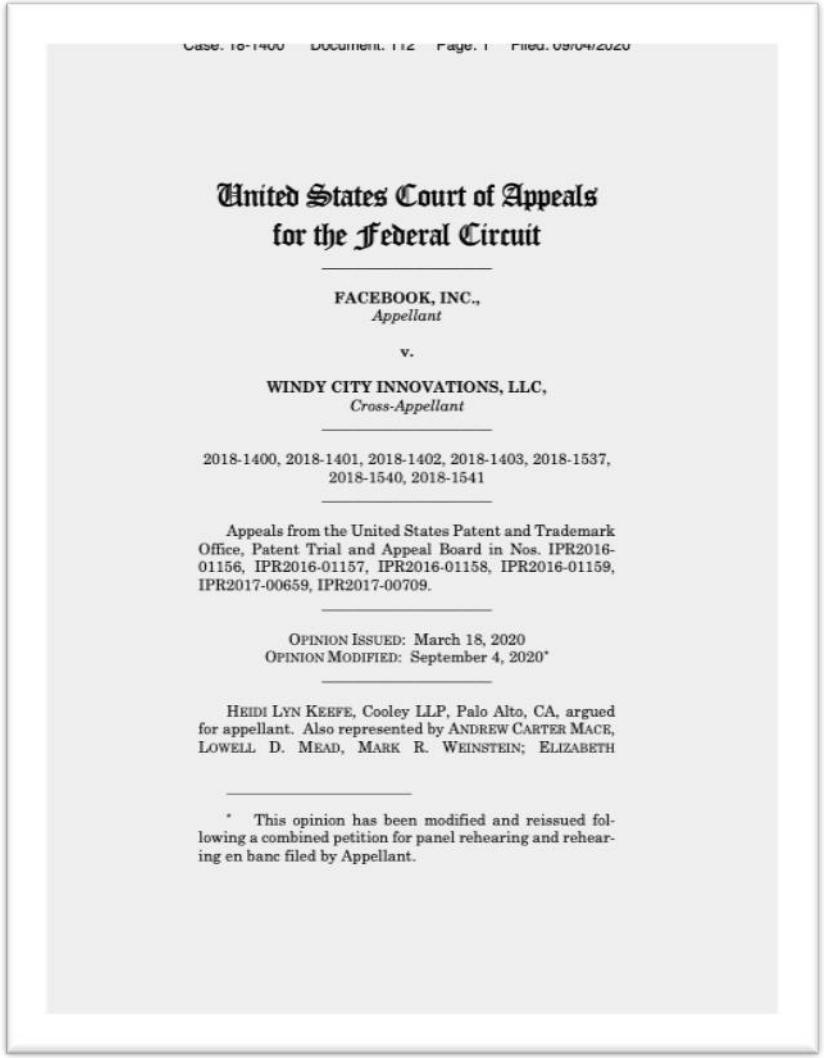
Facebook, Inc. v. Windy City Innovations, LLC, No. 2018-1400 et al., slip op. (Fed. Cir. Sept. 4, 2020) ("Windy City Rehearing Opinion")



Case: 18-1400 Document: 112 Page: 1 Filed: 09/04/2020

United States Court of Appeals
for the Federal Circuit

FACEBOOK, INC.,
Appellant

v.

WINDY CITY INNOVATIONS, LLC,
Cross-Appellant

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

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2016-01156, IPR2016-01157, IPR2016-01158, IPR2016-01159, IPR2017-00659, IPR2017-00709.

OPINION ISSUED: March 18, 2020
OPINION MODIFIED: September 4, 2020*

HEIDI LYN KEEFE, Cooley LLP, Palo Alto, CA, argued for appellant. Also represented by ANDREW CARTER MACE, LOWELL D. MEAD, MARK R. WEINSTEIN; ELIZABETH

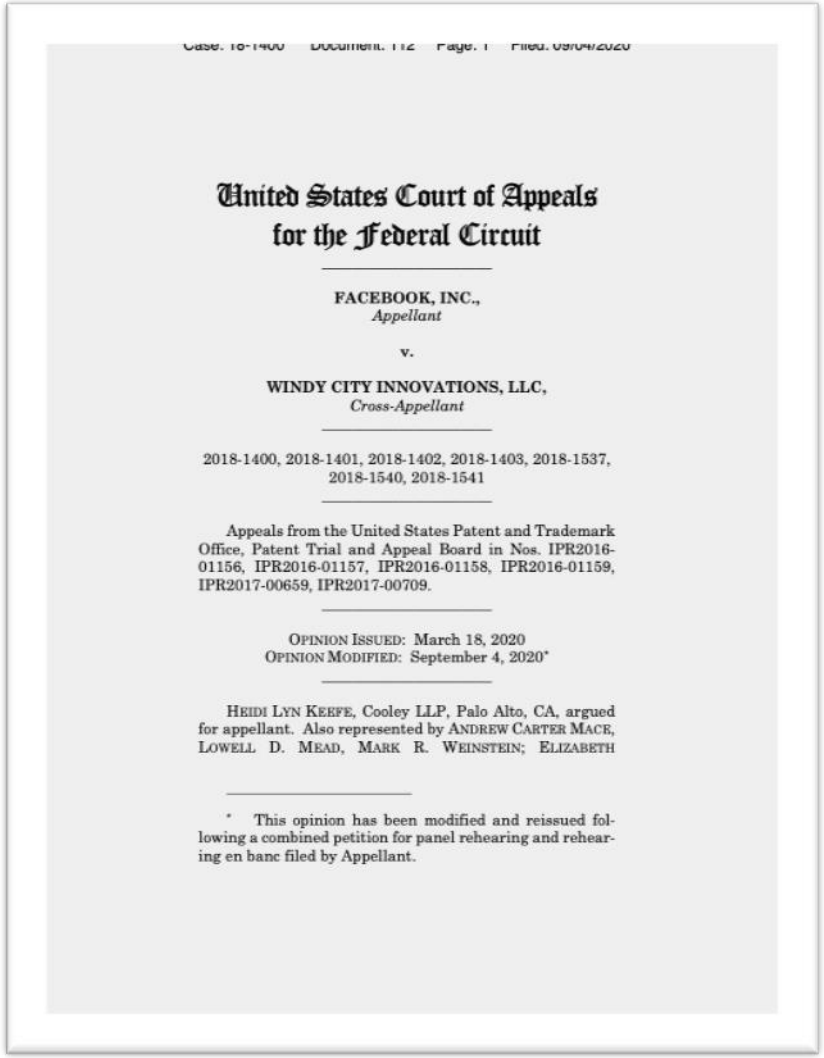
* This opinion has been modified and reissued following a combined petition for panel rehearing and rehearing en banc filed by Appellant.

The New Decision Was Issued To Address *Thryv*

On Friday, September 4, 2020, the Federal Circuit issued its much-anticipated decision in *Facebook, Inc. v. Windy City Innovations, LLC,* No. 2018-1400 et al., slip op. (Fed. Cir. Sept. 4, 2020) ("Windy City Rehearing Opinion").

The panel decision was modified to address the impact of *Thryv, Inc. v. Click to Call Techs., LLP*, 140 S. Ct. 1367 (2020) on the prior panel decision, *Facebook v. Windy City Innovations, LLC*, 953 F.3d 1313 (Fed. Cir. 2020). In addition to revising the original decision, the new panel decision included additional views on the Precedential Opinion Panel ("POP panel") of the Patent Trial and Appeal Board ("PTAB"), and the full court in a separate order denied the pending petition for rehearing en banc.

Facebook, Inc. v. Windy City Innovations, LLC, No. 2018-1400 et al., slip op. (Fed. Cir. Sept. 4, 2020) ("Windy City Rehearing Opinion")



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How The Joinder Issue Arose At The PTAB

The current case comes out of a series of inter partes review ("IPR") petitions that were filed by Facebook against Windy City involving hundreds of claims of multiple patents being asserted in litigation. Because of the peculiar procedural history in those litigations, Facebook filed two rounds of IPRs.

Round 1: Filed the last day possible to file, IPRs were directed to a **subset** of the claims in the patents-in-suit.

Round 2: After Windy City **asserted additional claims**, Facebook filing additional IPRs which Facebook **sought to have "joined" with its prior, previously instituted, IPRs**.

In the proceedings below, the **PTAB allowed Facebook to "join" the new (otherwise time-barred) IPRs with the already-instituted prior IPRs (not time barred), and challenge new claims not in the already-instituted prior IPR proceedings**.

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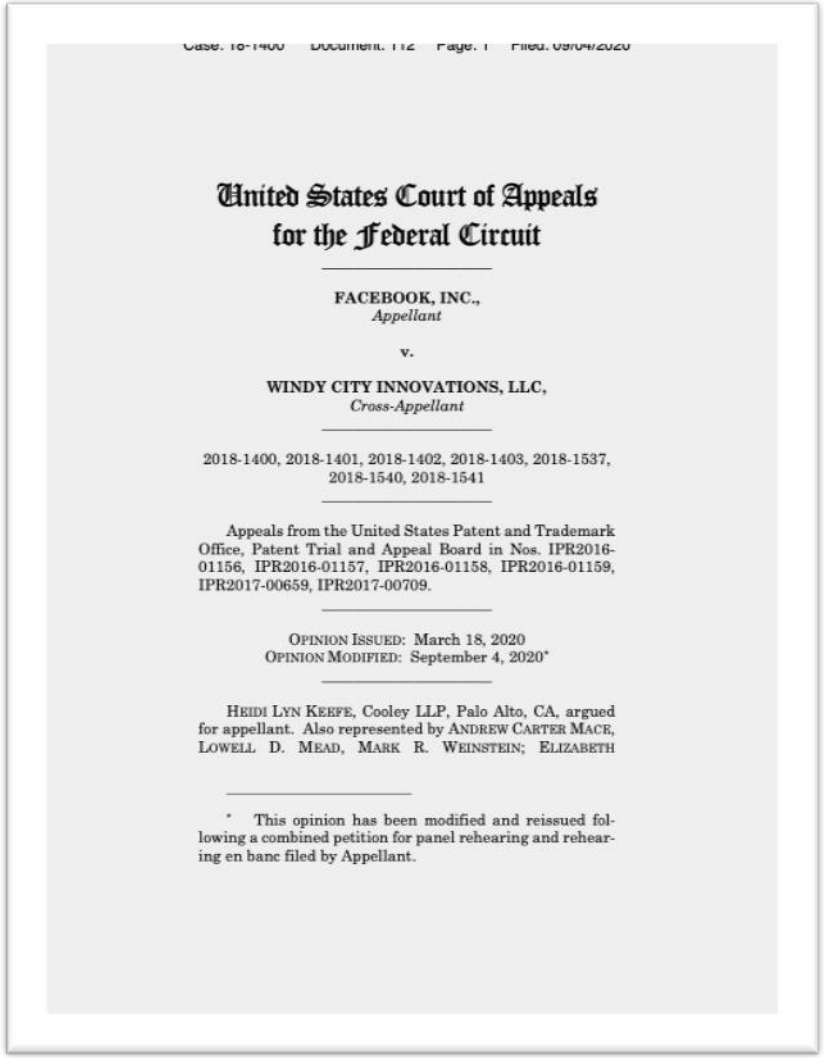

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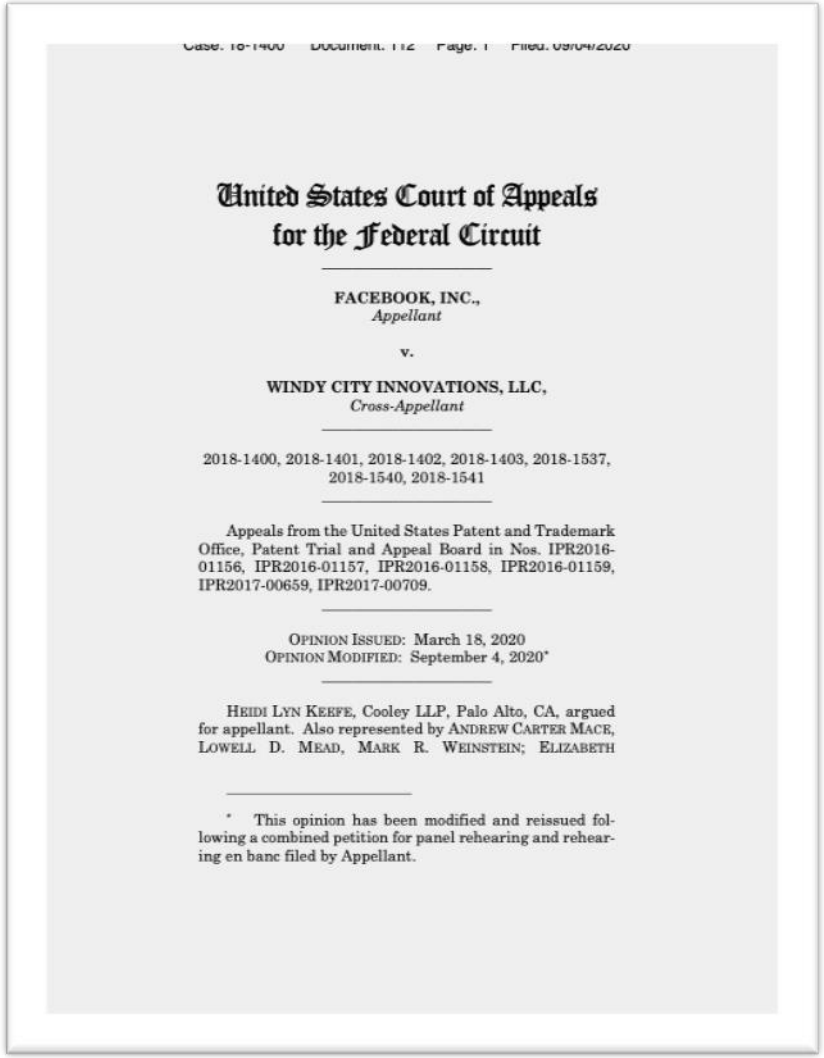
The Resolution on the Joinder and Time-Bar Issues

In the Windy City Rehearing Opinion, the Court (per Chief Judge Prost) held:

- "[T]he Board erred in its joinder decision in allowing Facebook to join itself to a proceeding in which it was already a party" (i.e., **there is no such thing as "self-joinder" under the AIA**). Windy City Rehearing Opinion, slip op. at 3.
- The Board "also erred in allowing Facebook to add new claims to the IPRs through that joinder" (i.e., **joinder under 315(c) is only of "parties" not "proceedings"**). Id.
- Under *Thryv*, the Federal Circuit **lacked authority to review whether the PTAB could institute the otherwise time-barred**, later-filed proceeding, and **remanded to the Board "to consider whether the termination of those proceedings finally resolve them."** Id.

Facebook, Inc. v. Windy City Innovations, LLC, No. 2018-1400 et al., slip op. (Fed. Cir. Sept. 4, 2020) ("Windy City Rehearing Opinion")



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Additional Views -- on Reviewability after *Cuozzo*, *SAS* and *Thryv*

- The scope of what is not appealable under 35 U.S.C. § 314(d) -- Significantly, in view of *Cuozzo*, *SAS* and *Thryv*, the Windy City Rehearing Opinion found joinder determinations, which can **only be made after an institution determination, were subject to appellate review, and such review was not precluded under § 314(d).**

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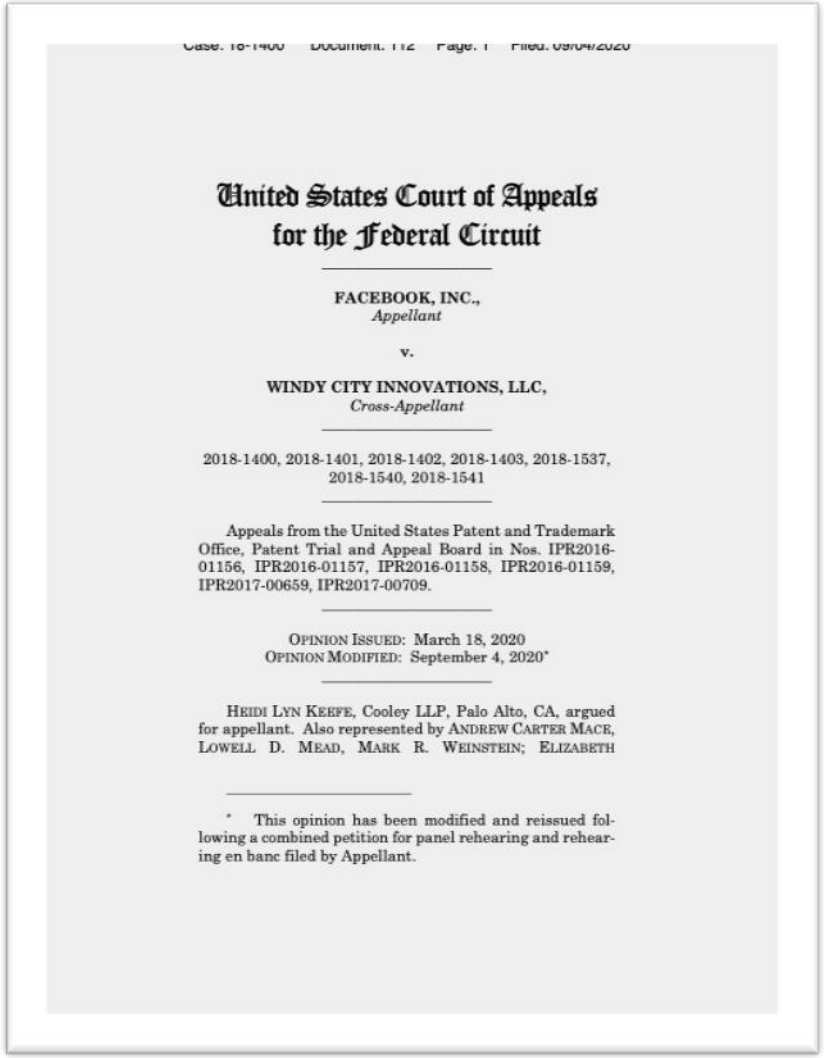

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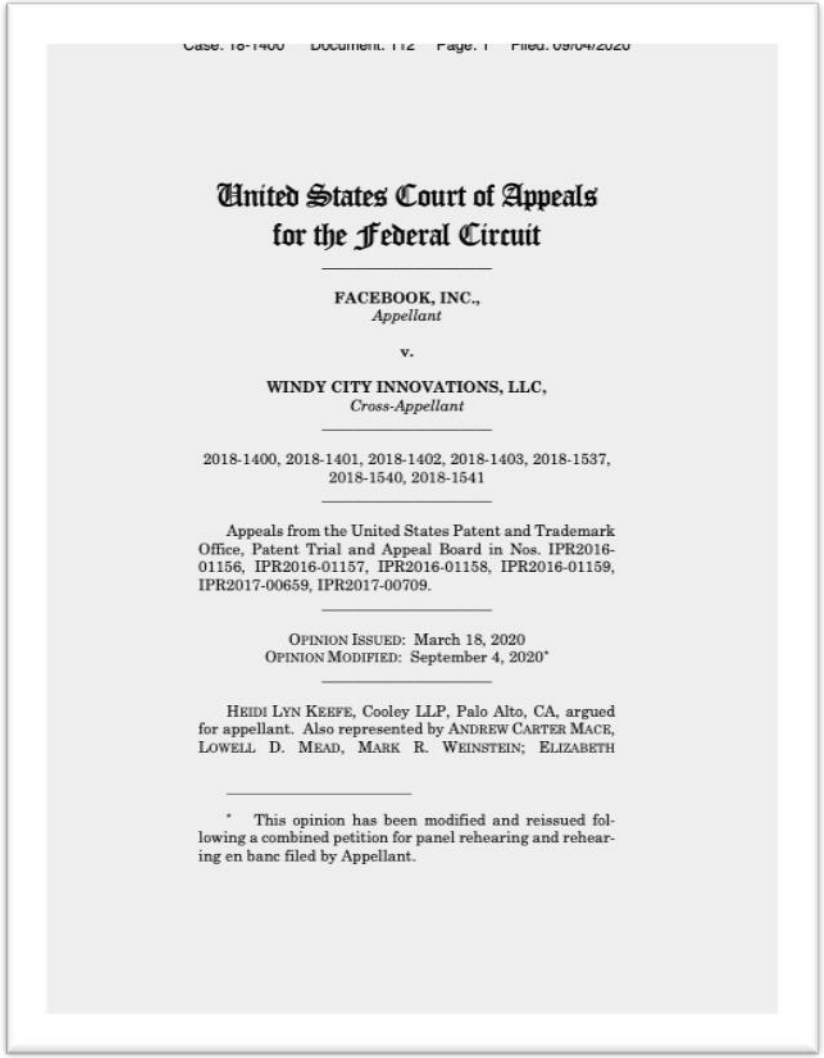
Additional Views -- on Joinder of "Parties" v. "Proceedings"

- The difference between "**joinder**" of **parties** under § 315(c) and **consolidation of proceedings** under § 315(d) -- The Windy City Rehearing Opinion recognized that joinder under § 315(c) is **only of new party** to a proceeding (and not an existing party) and does **not include joinder of new claims**. Rather, issues of **joinder of proceedings** are addressed under § 315(d).

Facebook, Inc. v. Windy City Innovations, LLC, No. 2018-1400 et al., slip op. (Fed. Cir. Sept. 4, 2020) ("Windy City Rehearing Opinion")



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Additional Views -- POP Opinions

- Windy City Rehearing Opinion also addressed the deference, or lack of deference, the Federal Circuit will apply to the PTO's interpretation either through **regulation** or **POP panel proceedings** to the Patent Act, and § 314(c) in particular. Significantly, the Windy City Rehearing Opinion rejected as wrong, and due no deference, as such, the POP panel in *Proppant Express Investments, LLC v. Oren Techs., LLC,* No. IPR2018-00914, Paper 38 (P.T.A.B. Mar. 13, 2019) (resolving prior conflicting panel decisions and authorizing same party joinder).
- In a separate "**additional views**" authored by all three Judges of the panel, the panel makes clear its view that **the POP panel procedure is, itself, a violation of the Administrative Procedures Act and without statutory authority.**

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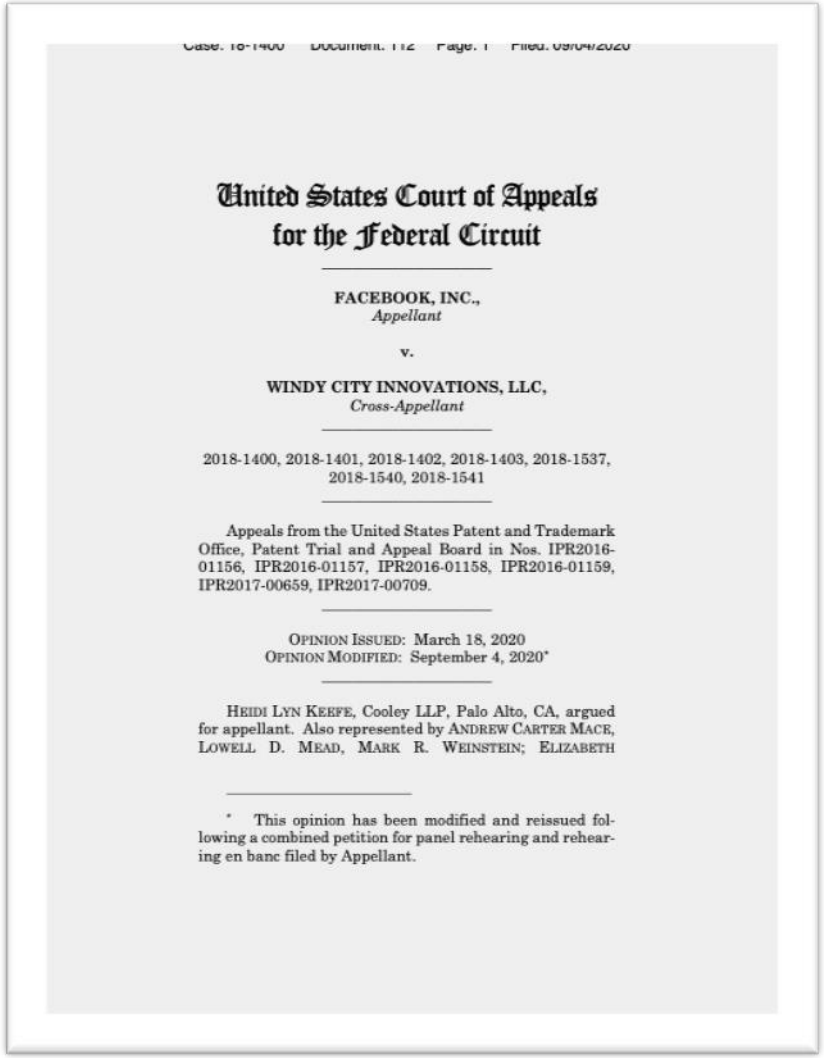

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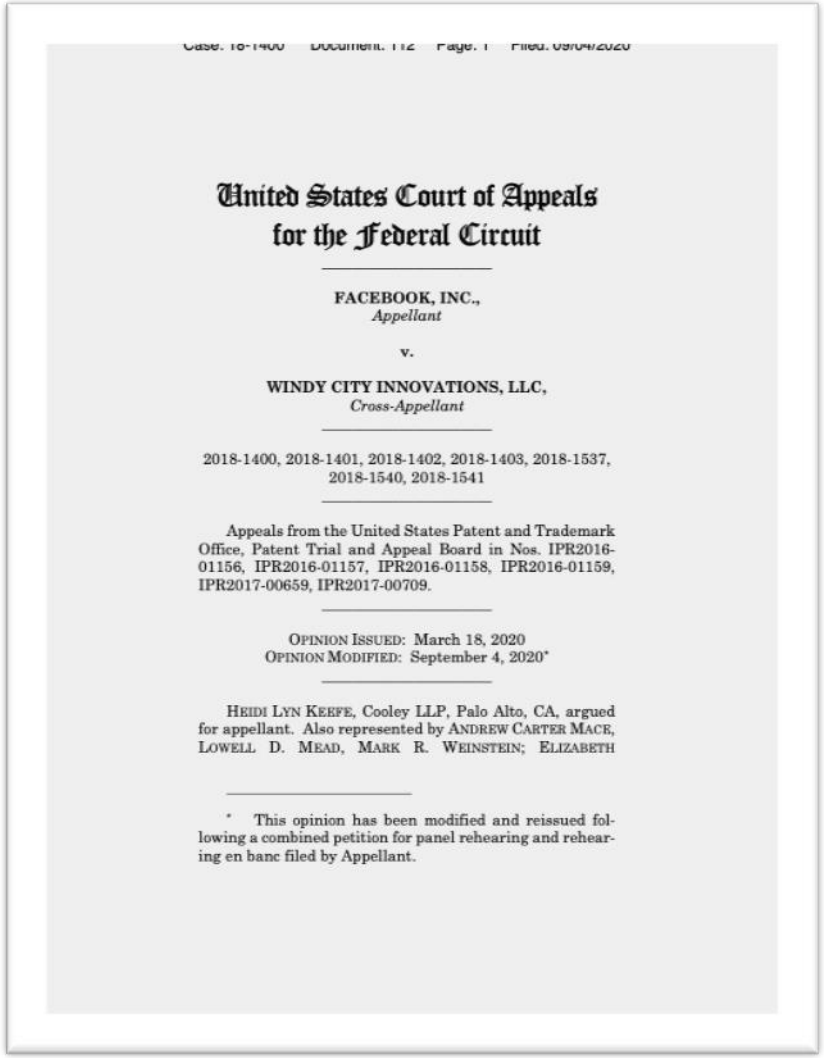
Additional Views -- Obviousness

The Windy City Rehearing Opinion also provided some insight on obviousness determinations at the PTAB:

- The Board correctly rejected an obviousness challenge where the Petitioner failed to explain "why a skilled artisan would have incorporated" the feature into the prior art.
- The Board correctly rejected an argument where the party "cites no evidence supporting this position".
- The Board correctly rejected an argument "which is based on attorney argument rather than evidence"; and

Facebook, Inc. v. Windy City Innovations, LLC, No. 2018-1400 et al., slip op. (Fed. Cir. Sept. 4, 2020) ("Windy City Rehearing Opinion")



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United States Court of Appeals
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2018-1400, 2018-1401, 2018-1402, 2018-1403, 2018-1537, 2018-1540, 2018-1541

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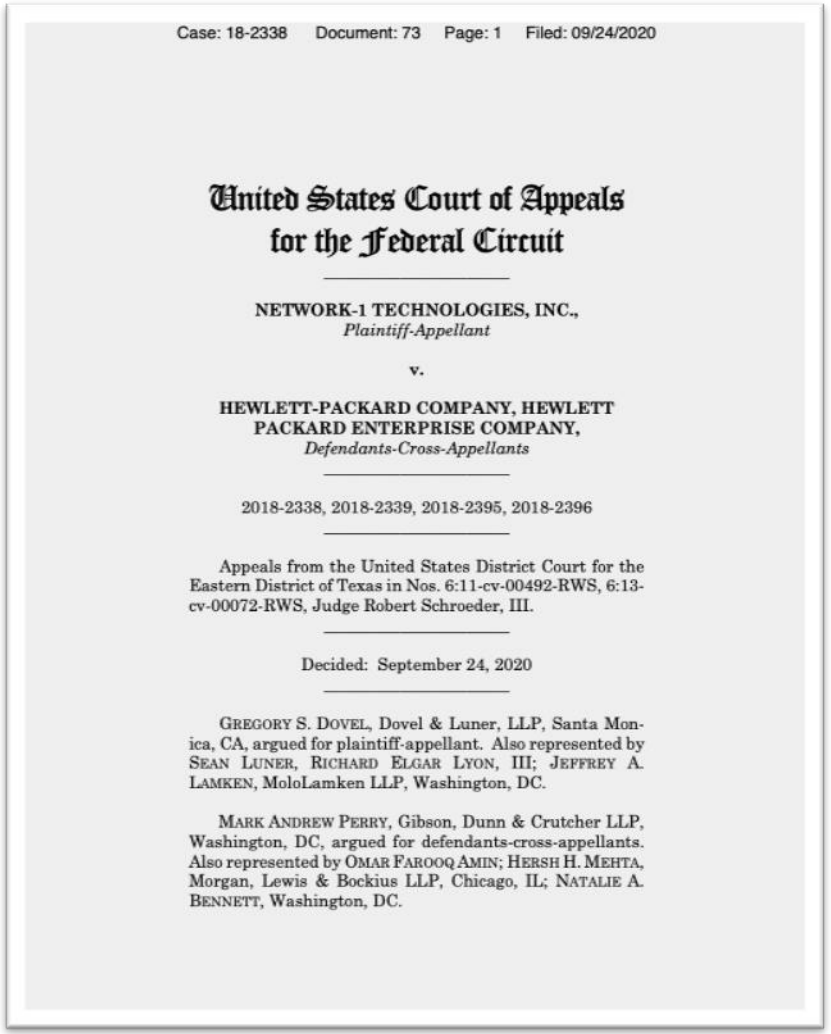
Additional Views -- Obviousness (cont'd)

- An obviousness argument that is based on an argument that it "would be a straightforward and predictable choice" was appropriate even if the combination would not be bodily incorporated into the prior art: "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference." Windy City Rehearing Opinion, slip op. at 34 (quoting *Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016) (quoting *In re Keller*, 642 F.2d 413, 425 (C.C.P.A. 1981))).

Network-1 Technologies, Inc. v. Hewlett Packard Company, Slip Op. (Fed. Cir. Dec. 24, 2020)



Case: 18-2338 Document: 73 Page: 1 Filed: 09/24/2020

United States Court of Appeals for the Federal Circuit

NETWORK-1 TECHNOLOGIES, INC.,
Plaintiff-Appellant

v.

HEWLETT-PACKARD COMPANY, HEWLETT PACKARD ENTERPRISE COMPANY,
Defendants-Cross-Appellants

2018-2338, 2018-2339, 2018-2395, 2018-2396

Appeals from the United States District Court for the Eastern District of Texas in Nos. 6:11-cv-00492-RWS, 6:13-cv-00072-RWS, Judge Robert Schroeder, III.

Decided: September 24, 2020

GREGORY S. DOVEL, Dovel & Luner, LLP, Santa Monica, CA, argued for plaintiff-appellant. Also represented by SEAN LUNER, RICHARD ELGAR LYON, III; JEFFREY A. LAMKEN, MoloLamken LLP, Washington, DC.

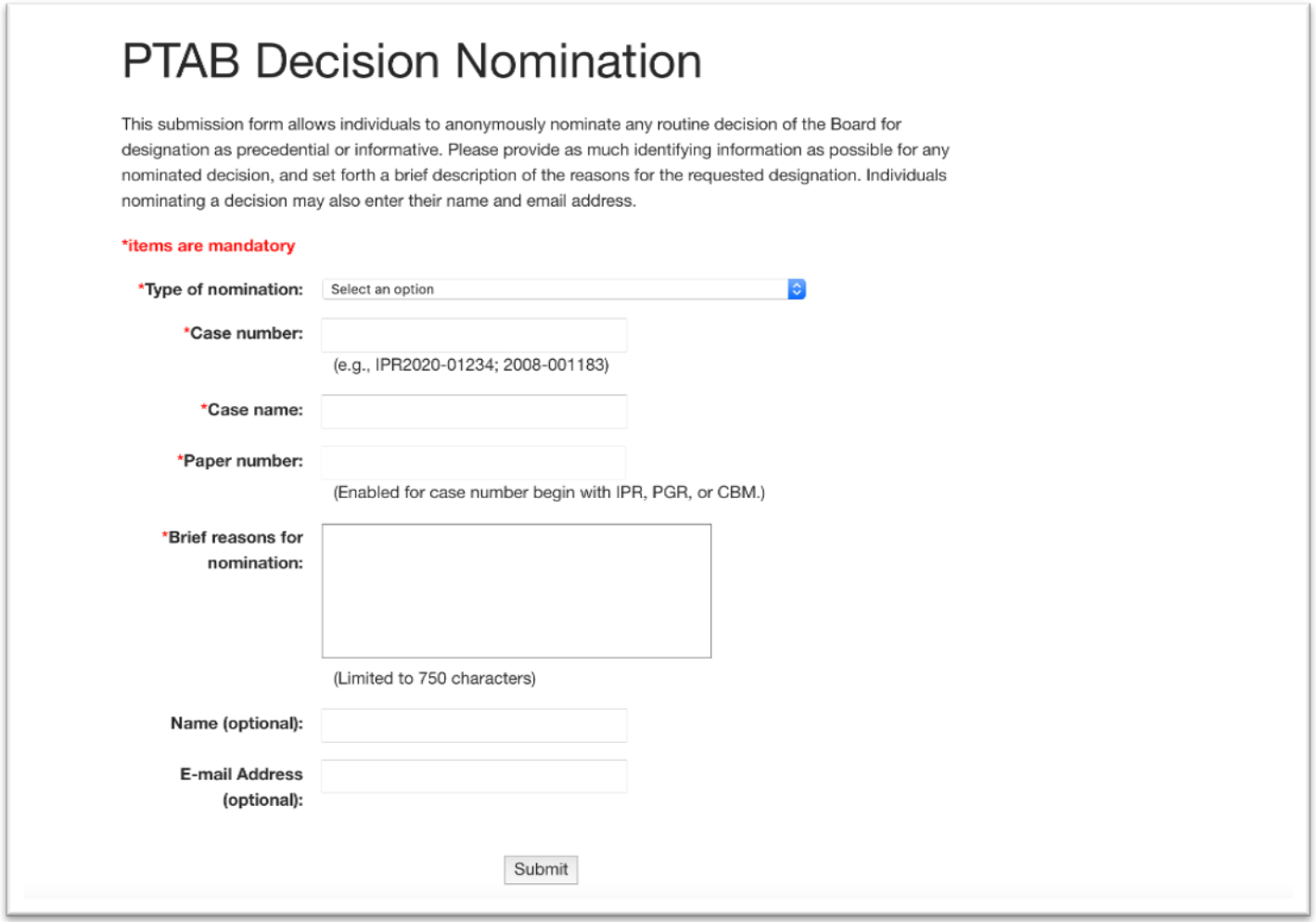
MARK ANDREW PERRY, Gibson, Dunn & Crutcher LLP, Washington, DC, argued for defendants-cross-appellants. Also represented by OMAR FAROOQ AMIN; HERSH H. MEHTA, Morgan, Lewis & Bockius LLP, Chicago, IL; NATALIE A. BENNETT, Washington, DC.

Facebook v. Windy City Applied – *Network-1 Techs., Inc. v. Hewlett-Packard Co.*

Panel reversed estoppel decision, where Hewlett Packard's efforts to join claims in prior filed petition were barred under its new decision in Windy City Rehearing Opinion:

- "According to the AIA, under 35 U.S.C. § 315(c), HP was permitted to join the Avaya IPR "as a party" even though HP was time- barred under § 315(b) from bringing its own petition. But, as we held in *Facebook, Inc. v. Windy City Innovations, LLC*, the joinder provision does not permit a joining party to bring into the proceeding new grounds that were not al- ready instituted. *Facebook, Inc. v. Windy City Innovations, LLC*, __ F.3d __, No. 18-1400, 2020 WL 5267975, at *9–10 (Fed. Cir. Sept. 24, 2020). Rather, it may only join the already-instituted proceeding as a party. *Id.*"
- "Thus, according to the statute, a party is only estopped from challenging claims in the final written decision based on grounds that it "raised or reasonably could have raised" during the IPR. Because a joining party cannot bring with it grounds other than those already instituted, that party is not statutorily estopped from raising other invalidity grounds. "

Nominate A PTAB Decision To Be Precedential



PTAB Decision Nomination

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Charles R. Macedo, Esq.
Partner and Co-Chair
cmacedo@arelaw.com
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