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Facebook, USPTO Tell Fed. Circ. Thryv Bars Joinder Appeals

By **Tiffany Hu**

Law360 (June 11, 2020, 6:12 PM EDT) -- Facebook and the U.S. Patent and Trademark Office have told the Federal Circuit a decision that the social media company improperly joined itself in a patent challenge cannot stand because of a recent U.S. Supreme Court ruling prohibiting time-bar appeals in Patent Trial and Appeal Board cases.

Facebook argued in a brief filed Wednesday that **the high court's Thryv ruling** in April "confirms" that the appeals court has no authority to block patent challengers from joining themselves as a party to existing inter partes reviews that would otherwise be time barred.

The Supreme Court held in **Thryv** that the PTAB's time-bar decisions cannot be appealed, and Facebook said the decision enforces the notion that appeals based on "institution-related issues" — rather than the merits of a validity decision — go against Congress' purpose in creating the inter partes review process.

Facebook has **petitioned the full appeals court** to revisit the panel's March decision, which tossed PTAB rulings in which the appellate panel found the PTAB had impermissibly allowed Facebook to join itself as a party to existing IPRs challenging Windy City Innovations LLC network communication patents.

"Windy City's request for review of the board's joinder determination conflicts with Thryv's analysis of the statutory purpose and design," Facebook wrote. "Procedural objections that Facebook was not entitled to be an IPR petitioner, that it was not permitted to raise these particular claims, or that its follow-on petitions were untimely focus only on the institution decision and have nothing to do with the board's resolution of the merits of patentability."

The USPTO's brief argues the Federal Circuit could not review the PTAB's joinder decision because it was "integral to, indeed a condition on, institution," citing Thryv. If a party requested to join as a party to a review within a year of an accompanying petition, then the PTAB's authority to institute the review would be separate from its joinder authority, the agency said.

"But if joinder is sought after the time limit ... has run, as is typically the case, and is the case here, the IPR petition is entirely dependent on the fate of the joinder motion," it wrote. As such, "Thryv makes clear that [the statute] bars judicial review of the joinder decision in this case."

The briefs come after the Federal Circuit in late April instructed the involved parties and the USPTO to file additional briefing on the Thryv ruling's implications for the present case, court documents show.

The panel **had found** that if the board had not improperly let Facebook join itself on multiple petitions, many parts of the reviews would have been time-barred under the America Invents Act, which bans "same-party joinder, and does not authorize the joinder of new issues."

Not only was joinder impermissibly allowed in the Facebook case, the panel said the PTAB's Precedential Opinion Panel wrongly held in its **first-ever decision** in an unrelated case in March 2019 that parties can join their own petition and use joinder to add issues.

Windy City also filed a brief Wednesday on Thryv's impact, telling the Federal Circuit the high court's ruling did not bar its appeal over the PTAB's joinder decision. The statutory requirements and processes for institution and joinder were not "closely tied," it argued.

"Windy City did not challenge a conclusion by the board that the requirements of initiating review ... were satisfied," it wrote. "Instead, Windy City argued that the board exceeded its authority ... by permitting Facebook to add time-barred issues to its already-instituted IPRs, which led to a final written decision on more claims than what was authorized in the properly-instituted petitions."

Counsel for the parties and a representative for the U.S. Department of Justice did not immediately respond to requests for comment Thursday.

The patents-in-suit are U.S. Patent Nos. 8,458,245; 8,694,657; 8,473,552 and 8,407,356.

Facebook is represented by Heidi L. Keefe, Mark R. Weinstein, Lowell D. Mead, Elizabeth B. Prelogar, Phillip E. Morton and Andrew C. Mace of Cooley LLP.

Windy City is represented by Vincent J. Rubino III, Alfred R. Fabricant, Peter Lambrianakos and Enrique W. Iturralde of Brown Rudnick LLP.

The USPTO is represented in-house by Thomas W. Krause, Farheena Y. Rasheed, Joseph Matal and Molly R. Silfen and Joseph H. Hunt, Scott R. McIntosh, Jeffrey E. Sandberg and Joshua M. Koppel of the DOJ's Civil Division.

The case is Facebook Inc. v. Windy City Innovations LLC, case number 18-1400, in the U.S. Court of Appeals for the Federal Circuit.

--Additional reporting by Ryan Davis and Britain Eakin. Editing by Marygrace Murphy.

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