

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KYOCERA CORPORATION.
Petitioner,
v.

SOFTVIEW LLC
Patent Owner.

KYOCERA'S RESPONSE TO MOTOROLA'S MOTION FOR JOINDER

CASE IPR2013-00007
Patent 7,461,353

I. INTRODUCTION

On April 29, 2013, Motorola Mobility (“Motorola”) filed a petition to institute IPR2013-00256, which concerns the ‘353 Patent, and a petition to institute IPR2013-00257, which concerns the ‘926 Patent. In Paper No. 18, the Board observed that

Motorola Mobility’s petition to institute IPR2013-00256 asserts the same grounds of unpatentability as those on which we instituted inter partes review IPR2013-00007. Motorola Mobility’s petition to institute IPR2013-00257 asserts the same grounds of unpatentability as those on which we instituted inter partes review IPR2013-00004. In view of its assertion of the same grounds of unpatentability, Motorola Mobility has moved for joinder of IPR2013-00256 with IPR2013-00007 and joinder of IPR2013-00257 with IPR2013-00004 (Motions For Joinder). Patent Owner indicated that it desires to oppose Motorola Mobility’s Motions For Joinder.

Paper No. 18 at 4-5. The Board ordered that Kyocera and SoftView have 10 calendar days to submit arguments opposing Motorola’s Motion for Joinder. *Id.* at 5.

Pursuant to the Board’s Order in Paper No. 18, Kyocera raises the following concerns regarding Motorola’s motion. First, if granting Motorola’s motion would

delay the date for a final written decision in this IPR, such delay would severely prejudice Kyocera. Second, granting Motorola's motion may increase Kyocera's expense for litigating this proceeding. Third, granting Motorola's motion, on the terms proposed by Motorola, would deprive Kyocera of control over the contents of the 15 page Reply to SoftView's Opposition. Fourth, granting Motorola's motion, on the terms proposed by Motorola, would diminish the amount of time Kyocera would have to depose SoftView's declarants.

II. ARGUMENT

A. Legal Standard

The Leahy-Smith America Invents Act (AIA) permits joinder of inter partes review proceedings under 35 U.S.C. § 315(c), which reads as follows:

(c) JOINDER.--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.

“The rules are to be construed so as to ensure the just, speedy, and inexpensive resolution of a proceeding” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48758 (Aug. 14, 2012).

In *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109 (PTAB 2013), the Board permitted joinder of a second petition filed by Microsoft. In that proceeding, the patent owner did not oppose the motion for joinder, and in fact, encouraged it. *Id.* at 2. Microsoft filed the second petition “after learning that additional claims were being asserted by Patent owner in concurrent district court litigation.”¹ *Id.* at 3. When it granted Microsoft’s unopposed motion, the PTAB adjusted the schedule. *Id.* at 4. As far as Petitioner is aware, the PTAB has not, as yet, ruled on a motion to join by a third party under the circumstances presented here.

B. Kyocera Would Be Prejudiced If Granting Motorola’s Motion Would Delay This Proceeding

Kyocera filed a motion to stay the *SoftView* patent litigation. *SoftView LLC v. Kyocera Corp.*, 10-389-LPS (consolidated) (D. Del. 2013) (D.I. 940, 941) (Ex. A). In that motion, Kyocera represented to the Court that the PTAB must, by statute, issue a final written decision within one year of institution. (Ex. A at 7, 10, 11, 15). In response, SoftView argued that Kyocera’s representation is “guesswork.” (D. I. 969 at 11) (Ex. B at 15.) Any decision by the PTAB in this IPR that even hints that the deadline for the final written decision might be extended would severely prejudice Kyocera’s motion to stay in the patent infringement litigation.

¹ In the *SoftView* district court litigation, SoftView did not assert additional claims after Kyocera filed its IPR petition.

C. Granting Motorola's Motion May Unduly Increase the Expense to of this Proceeding to Kyocera

Kyocera is concerned that granting Motorola's motion to join this IPR may increase the expense of this proceeding, and may result in significant complications.

1. Briefing May Be More Complicated And More Expensive

Kyocera objects to Motorola's suggestion at page 5 of its motion that "[t]he Board may order Kyocera and Motorola to consolidate their submissions and to conduct joint discovery where appropriate." Under 37 C.F.R. §42.24(c), Kyocera's reply to the SoftView's Opposition is limited to 15 pages. Any order preventing Kyocera from having full use of the 15 pages to which it is entitled under the rules would prejudice Kyocera, because it is unlikely that counsel for Kyocera and Motorola would agree on the contents of the Reply, and in any event, a joint reply will require in all probability multiple exchanges of drafts, which will increase attorneys' fees. Moreover, it would be unjust for Kyocera to lose control of its Reply to SoftView's opposition because a late-comer (who intentionally chose not to file an IPR petition at the statutory one-year deadline) was allowed to join and wrest control of the briefing and discovery away from the petitioner.

2. Granting Motorola's Motion May Increase the Expense of Depositions

Consolidation raises significant issues in discovery. For example, conducting "joint discovery" is not as easy as it sounds. Experience in the

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