

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KYOCERA CORPORATION
MOTOROLA MOBILITY LLC
Petitioners

v.

SOFTVIEW LLC
Patent Owner,

Case IPR2013-00007
Case IPR2013-00256
Patent 7,461,353

Before, BRYAN F. MOORE, BRIAN J. McNAMARA and
STACEY G. WHITE, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

ORDER DENYING PATENT OWNER'S REQUESTS TO FILE MOTION TO
STRIKE AND SURREPLY, AUTHORIZING CERTAIN DEPOSITIONS AND
SUPPLEMENTATION OF THE RECORD, AND REQUIRING ADDITIONAL
CLAIM CONSTRUCTION BRIEFING

Conduct of the Proceeding
37C.F.R. § 42.5.

Following a Decision To Institute entered on March 29, 2013, Paper No. 11, IPR2013-00256 was joined with this proceeding. In compliance with a stipulated revised schedule, Softview LLC (Patent Owner) filed a Patent Owner Response on July 19, 2013. Paper No. 25. Kyocera Corporation and Motorola Mobility (Petitioners) filed a Consolidated Reply To Patent Owner's Response (Consolidated Reply) on September 23, 2013. Paper No. 28. On September 30, 2013 Patent Owner filed a Notice of Objections To Evidence. Paper No. 29.

On October 3, 2013, the Board conducted a telephone conference to discuss the following issues: (1) Patent Owner's request for authorization to file a Motion To Strike Petitioners' Consolidated Reply and the corresponding Declaration of Dr. Jack Grimes; (2) Patent Owner's request for authorization to file a surreply to Petitioners' Response to Patent Owner's Response; (3) Patent Owner's request to file supplemental information; and (4) Patent Owner's request to take the depositions of Dr. Jack Grimes and Dr. Richard Lutz, whose Declarations Petitioners filed with their Consolidated Reply to Patent Owner's Response.

Patent Owner's Requests To File Motion To Strike and a Surreply

We deny Patent Owner's requests to file a Motion To Strike Petitioners' Consolidated Reply and to file a surreply. A Motion To Strike or a Patent Owner's surreply is unlikely to provide the Board useful, additional information. Patent Owner's 16 page Notice of Objections To Evidence, Paper No. 29, already extensively addresses Patent Owner's concerns about Petitioners' Consolidated Reply to the Patent Owner Response. Patent Owner contends that the evidence cited in Petitioner's Consolidated Reply raises new claim construction issues that should have been raised in the Petition For *Inter Partes* Review (Petition), raises new and unauthorized challenges to the patentability of the claims, and belatedly

introduces new prior art and new evidence that should have been presented in the Petition. *See*, Patent Owner's Notice of Objections To Evidence, 2-4, 5-8, 9-10.

After due consideration of the Patent Owner Response, the Board will decide whether Petitioner's Consolidated Reply improperly raises new issues or introduces new evidence. Petitioners' Consolidated Reply should be drawn only to issues raised in the Patent Owner Response. 37 C.F.R. § 42.23, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012). The Board will not attempt to sort proper from improper portions of a reply. *Id.* A reply that raises a new issue or introduces new evidence will not be considered and may be returned. *Id.* Thus, a Motion To Strike by the Patent Owner is not necessary.

A surreply by the Patent Owner is also not necessary. The rules do not provide for a surreply should the Board decide that Petitioners' Consolidated Reply does not raise new issues or introduce new evidence. If the Board determines Petitioner's Consolidated Reply is not responsive to the Patent Owner Response and raises new issues or introduces new evidence, the Board will not consider the Consolidated Reply. In that case, there will be no need for a surreply because the Consolidated Reply will not be considered. In either circumstance a surreply to Petitioners' Consolidated Reply is not appropriate.

Patent Owner's Request For Depositions

Patent Owner deposed Petitioner's expert, Dr. Jack Grimes, on June 25, 2013. Petitioner's Consolidated Reply, filed on September 23, 2013, included additional testimonial evidence in the form of the declarations of Dr. Grimes and Dr. Richard Lutz. Petitioner represents that these declarations are in rebuttal to the testimony of Dr. Glenn Reinman filed on July 19, 2013 with the Patent Owner Response. Ex. 2003. During the October 3, 2013 call with the Board, Petitioner

stated it would produce Drs. Grimes and Lutz for deposition. The Board leaves it to the parties to work out the details of the depositions.

Patent Owner's Request To Supplement

For purposes of the Petition, Petitioner stated that it would not be unreasonable for the Board to adopt the constructions proffered by Patent Owner in the pending litigation and the Board adopted those constructions. Decision To Institute, Paper No. 12, pp. 20-22. Patent Owner now requests authorization to submit supplemental information, namely, the district court's claim construction order and related memorandum, as well as the parties' agreed claim constructions. In the teleconference on October 3, 2013, Petitioner stated that it does not object to this submission and asked that the district court's order staying litigation also be included. The Patent Owner had no objection to this addition. Therefore, we grant Patent Owner's request to submit this documentation. We remind the parties that in construing claims in an *inter partes* review, the Board focuses on challenges to patentability and applies the broadest reasonable interpretation to the claims. *See*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012). *See also*, *SAP America v. Versata Development Group, Inc.*, IPR2012-00001, Final Written Decision, Paper No. 70, pp. 7-19. In patent litigation, district courts do not apply the broadest reasonable interpretation standard and the parties may agree to the construction of certain terms for reasons unrelated to the broadest reasonable interpretation. Thus, the district court's claim construction and the parties' agreed constructions may provide the Board useful insight and information, these constructions are not determinative of the broadest reasonable construction for purposes of an *inter partes* review.

New Claim Construction Issue

Based on matters discussed during October 3, 2013 conference call and issues raised in the Patent Owner Response and Petitioners' Consolidated Reply, the Board understands that a new claim construction issue has arisen in this case. Petitioners asserted that Patent Owner's arguments regarding "preserving the original layout, functionality and design" imply a significant departure from the position taken prosecution and thus, the term should be construed as Petitioners argued in their Consolidated Reply. Patent Owner responded that it did not attempt to construe the "preserving" limitation in the Patent Owner Response and that the limitation should be accorded its ordinary meaning.

In order to clarify the parties' positions on this issue, the Board is ordering the parties to submit claim construction briefs of not more than 5 pages by October 18, 2013. 37 CFR § 42.20(d). The Petitioners shall submit a single consolidated brief. The claim construction briefs shall address only how the term "preserving the original layout, functionality and design" should be construed in accordance with the broadest reasonable construction standard applicable to *inter partes* review. The Board will not consider a brief which raises any other issue.

In consideration of the above, it is:

ORDERED that Patent Owner's request to file a Motion To Strike Petitioner's Reply To Patent Owner's Response is DENIED;

FURTHER ORDERED that Patent Owner's request to file a surreply to Petitioners' Consolidated Reply To Patent Owner's Response is DENIED;

FURTHER ORDERED that Patent Owner's request to depose Dr. Jack Grimes and Dr. Richard Lutz is GRANTED;

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