**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | | |
|---|---|---|
| In re: Gary B. Rohrabaugh and Scott A. Sherman | ) | **Examiner:** Unassigned |
| **Patent No.:** 7,461,353 | ) | **Group Art Unit:** Unassigned |
| **Issued:** December 2, 2008 | ) | Monday, April 29, 2013 |
| **For:** Scalable Display of Internet Content on Mobile Devices | ) | |

**MOTION FOR JOINDER**
**UNDER 37 C.F.R. §§ 42.22 AND 42.122(b)**

Motorola Mobility LLC ("Petitioner" or "Motorola Mobility") submits concurrently herewith a Petition for *Inter Partes* Review of U.S. Patent No. 7,461,353 ("Petition"). Petitioner respectfully requests that its Petition be granted and that the proceedings be joined pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) with the pending *inter partes* review proceedings concerning the same patent in *Kyocera Corporation v. SoftView LLC*, Case IPR2013-00007 ("Kyocera IPR"). Petitioner submits that joinder is appropriate because it will promote efficient resolution of the issues without affecting scheduling for the pending proceeding and will not prejudice the parties to the Kyocera IPR. Absent joinder, Petitioner may be prejudiced because its interests will not be adequately represented in the pending *inter partes* review proceedings.

Petitioner's motion for joinder and accompanying Petition are timely under 37 C.F.R. §§ 42.22 and 42.122(b), as they are submitted within one month of March 29, 2013, the date that the Kyocera IPR was instituted.[1]

## I. Background and Related Proceedings

SoftView LLC is the owner of U.S. Patent No. 7,461,353 (the "'353 Patent") and related U.S. Patent No. 7,831,926 (the "'926 Patent"). In 2010, SoftView sued Apple, Inc. and AT&T Mobility for infringement of the '353 Patent and the '926 Patent (the "Patents-in-Suit"). *SoftView LLC v. Apple Inc. et al.*, Case No. 10-389-LPS (D. Del.) (the "Underlying Litigation"). On September 30, 2011, SoftView filed an amended complaint alleging for the first time that Petitioner and 16 new defendants infringed the '353 and '926 Patents. *Id*. (D.I. 108-3). The cases against all of the defendants are consolidated for pre-trial purposes, and discovery is ongoing.

In addition to the Underlying Litigation, the '353 Patent is the subject of three pending reexamination proceedings including: (i) *Inter Partes* Reexamination

[1] On April 26, 2013, counsel for Petitioner confirmed with Judge Joni Chang of the Patent Trial and Appeal Board that § 42.122(b) provides for filing motions for joinder and that prior authorization for filing a motion for joinder with a petition is not required under the Board's rules. The Board further provided express authorization for Motorola's Motion for Joinder on April 29, 2013. Judge Chang expressed that the Board would welcome the opportunity to discuss Petitioner's joinder motion with Petitioner and the parties to the Kyocera IPR. Petitioner has reached out to the Board to schedule a conference and anticipates that a conference will occur soon.

No. 95/000,634; (ii) *Ex Parte* Reexamination No. 90/009,994; and (iii) *Inter Partes* Reexamination No. 95/002,132. Petitioner filed the request for *Inter Partes* Reexamination No. 95/002,132; Apple, Inc. requested the other two pending reexaminations.

Kyocera Corporation filed its petition for *inter partes* review of the '353 Patent on October 2, 2012. On December 21, 2012, the Patent Trial and Appeal Board ("Board") stayed the three pending reexamination proceedings, including the reexamination filed by Petitioner, in view of Kyocera's IPR petition. *Kyocera Corporation v. SoftView LLC*, Case IPR2013-00007, Paper No. 9 (Order to Stay the Concurrent Reexaminations). The Board noted that all of the claims challenged by Kyocera would be reexamined in the pending reexaminations and that the grounds of challenge in the Kyocera IPR are based on prior art references on which many of the rejections in the pending reexaminations are also based. *Id*. The Board determined that there was good cause to stay the pending reexamination proceedings to avoid duplicating efforts and potential inconsistencies among the proceedings. *Id*.

The Board granted the Kyocera IPR on March 29, 2013. Soon thereafter, Kyocera filed a motion to stay the Underlying Litigation pending the outcome of the Kyocera IPR. *SoftView LLC v. Apple Inc. et al.*, Case 10-389-LPS (D. Del.) (D.I. 940). That motion is pending.

Petitioner understands that the parties to the Kyocera IPR have stipulated to postpone the first deadline – the due date for SoftView's response to Kyocera's petition and any motion to amend the patent – to June 28, 2013. Oral argument is set for January 7, 2014.

## II. Joinder will not impact the Board's ability to complete the review within the one-year period

Joinder in this case will not impact the Board's ability to complete its review in a timely manner. 35 U.S.C. § 316(a)(11) and associated rule 37 C.F.R. § 42.100(c) provide that *inter partes* review proceedings should be completed and the Board's final decision issued within one year of institution of the review. The same provisions provide the Board with flexibility to extend the one-year period by up to six months for good cause, or in the case of joinder. *Id*. (§ 316(a)(11)). In this case, joinder should not affect the Board's ability to issue its final determination within one year because Petitioner does not raise any issues that are not already before the Board.

The Petition for *Inter Partes* Review of the '353 Patent submitted by Petitioner is based on the same grounds and same combinations of prior art that were submitted by Kyocera Corporation and granted by the Board in the Kyocera IPR, for which joinder is requested. The first deadline in the Kyocera IPR is the due date for SoftView's response to Kyocera's petition (37 C.F.R. § 42.120) and any motion to amend the patent (37 C.F.R. § 42.121). Petitioner understands that

SoftView and Kyocera have stipulated to postpone this deadline to June 28, 2013 – two months from the date of this motion. Should the Board determine to grant Petitioner's request for joinder, SoftView will have ample time to complete its submissions by its deadline. Because Petitioner's *inter partes* review petition does not raise any new issues, SoftView's response would not require any analysis beyond what SoftView is already required to undertake to respond to Kyocera's petition.

Motorola respectfully suggests that further briefing and discovery may be simplified, further to minimize any impact to the schedule or the volume of materials to be submitted to the Board. Given that Kyocera and Motorola will be addressing the same prior art and the same bases for rejection of the claims at issue, the Board may order Kyocera and Motorola to consolidate their submissions and to conduct joint discovery where appropriate. Conducting the proceedings in this manner should avoid further complication or delay.

## III. Joinder would enhance efficiency by consolidating issues, avoiding duplicate efforts, and preventing inconsistencies among the pending proceedings

The validity of the '353 patent is squarely at issue in, as described above, (a) the District Court litigation, (b) three pending reexaminations (presently stayed in light of the Kyocera IPR), and (c) the Kyocera IPR. In deciding to stay the reexamination requested by Petitioner and the two reexaminations requested by

DOCKET ALARM

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

**LAW FIRMS**
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

**FINANCIAL INSTITUTIONS**
Litigation and bankruptcy checks for companies and debtors.

**E-DISCOVERY AND LEGAL VENDORS**
Sync your system to PACER to automate legal marketing.