

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

MOTOROLA MOBILITY LLC  
Petitioner,

v.

SOFTVIEW LLC  
Patent Owner

---

Case IPR2013-00256  
Patent 7,461,353

---

Before, SCOTT R. BOALICK, BRYAN F. MOORE and,  
BRIAN J. McNAMARA, *Administrative Patent Judges.*

McNAMARA, *Administrative Patent Judge.*

DECISION ON  
MOTION FOR JOINDER  
*37 C.F.R. § 42.122(b)*

## INTRODUCTION

Motorola Mobility LLC (Motorola) filed the instant petition for *inter partes* review of U.S. Patent 7,461,353 (the '353 Patent) on April 29, 2013 (the Motorola IPR petition). With its petition, Motorola filed a Motion for Joinder with *Kyocera Corporation v. SoftView LLC*, IPR2013-00007, instituted on March 29, 2013 (the Kyocera IPR). In a separate decision, entered today, we grant the Motorola IPR petition, which was limited to the same claims and the same grounds of unpatentability for which the Board instituted the Kyocera IPR. For the reasons that follow, we also grant Petitioner's Motion for Joinder.

## BACKGROUND

On April 23, 2013, at the request of Apple, Inc. (Apple), the Board held a teleconference in the Kyocera IPR concerning the possibility of Apple filing a petition for *inter partes* review and a motion for joinder with the Kyocera IPR. On April 24, 2013, the Board issued an order in the Kyocera IPR authorizing Apple to file a motion for joinder. Paper No. 15, *Kyocera, Inc. v. Softview LLC*, IPR2013-00007. (April 24, 2013 Order). The Board's April 24, 2013 Order identified the following matters to be addressed in a Motion For Joinder: (1) an explanation of the reasons why joinder is appropriate, (2) identification of any new ground of unpatentability raised in the proceeding sought to be joined, (3) how the impact of

the joinder on the schedule and costs of the proceeding would be minimized, and (4) how briefing and/or discovery could be simplified to minimize schedule impact. Although Apple elected not to file, on April 29, 2013, Motorola filed the Motorola IPR Petition and Motion For Joinder.

On May 1, 2013, during a previously scheduled initial telephone conference in the Kyocera IPR, the Board authorized Kyocera and SoftView to file oppositions to Motorola's Motion for Joinder. Both SoftView and Kyocera timely filed oppositions to Motorola's Motion for Joinder.

#### DISCUSSION

The Leahy-Smith America Invents Act (AIA) permits joinder of like review proceedings. Thus, an *inter partes* review (IPR) may be joined with another *inter partes* review. The statutory provision governing joinder of *inter partes* review proceedings is 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.

As the movant, Motorola bears the burden to show that joinder is appropriate. 37 C.F.R. § 42.20(c). In its Motion for Joinder, Motorola addresses

the subjects the Board outlined in its April 24, 2013 Order in IPR 2013-00007.

Motorola represents that its petition asserts the same grounds of unpatentability on which the Board had instituted the Kyocera IPR. Motion for Joinder, pp. 4-5.

Motorola argues that joining the instant proceeding to the Kyocera IPR would enhance efficiency by consolidating issues, avoiding duplicate efforts, and preventing inconsistencies among the pending proceedings, without delaying the schedule of the Kyocera IPR and without prejudicing either Kyocera or SoftView.

Motion for Joinder, pp. 5-8. Motorola also argues that joinder is appropriate because the Motorola *inter partes* reexamination has been stayed and Motorola's participation in the Kyocera IPR would allow Motorola to protect its interests. *Id.* p. 7-8

In exercising its discretion to grant joinder, the Board considers the impact of both substantive issues and procedural matters on the proceedings, as well as other considerations.

## SUBSTANTIVE ISSUES

### 1. Alleged New Grounds of Patentability

SoftView opposes joining the instant proceeding to the Kyocera IPR and argues that the Motorola IPR petition includes new grounds of unpatentability.

SoftView Opp. pp. 5-6. The Board previously determined that the Motorola

petition is limited to asserting the same grounds of unpatentability as those on which the Kyocera IPR was instituted and granted SoftView until June 17, 2013 to exercise its option to file a Patent Owner's Preliminary Response to the Motorola petition. Paper No. 8, *IPR2013-00256*, June 13, 2013 (confirming order in teleconference of May 29, 2013). SoftView did not file a Patent Owner's Preliminary Response. In a separate decision, entered today, we instituted an *inter partes* review in the instant proceeding on the same grounds of unpatentability as those on which the Board instituted the Kyocera IPR. *Id.* Paper No. 9. Substantive issues in the Kyocera IPR would not be unduly complicated by joining the Motorola proceeding because the joinder does not introduce new grounds of unpatentability into the Kyocera IPR.

## 2. Request for Privity Discovery

In its opposition to joining the Motorola IPR proceeding and the Kyocera IPR, SoftView also argues that discovery would be complicated by the need to inquire whether Motorola is acting on behalf of Apple and whether Apple is a "real-party-in interest" or a "privy" of Motorola. SoftView Opp., p. 6-7.<sup>1</sup>

Speculating on the outcome of the Kyocera IPR, SoftView notes that, if joined, the

---

<sup>1</sup> Apple, Inc., which is a defendant in pending patent infringement litigation brought by SoftView, has filed reexaminations 95/000,634 involving the '353 patent and 95/000,635 and 90/009,995 involving related US Patent 7,831,926. On December 21, 2012, the Board stayed these reexaminations while related cases, IPR2013-00004 and IPR2013-00007, are in progress.

# 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.