

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEBASTO ROOF SYSTEMS, INC.
Petitioner,

v.

UUSI, LLC
Patent Owner.

Case IPR2014-00648
Patent 8,217,612

**PETITIONER'S MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)**

Attorney Docket: 130163.231151

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I. INTRODUCTION AND STATEMENT OF REQUESTED RELIEF

Petitioner Webasto Roof Systems, Inc. (“WRSI”) hereby requests joinder in *Brose North America, Inc. and Brose Fahrzeugteile GmbH & Co. Kg, Hallstadt v. UUSI, LLC*, Case IPR2014-00416 (“the 416 IPR”). *See* 35 U.S.C. § 315(c); 37 C.F.R. §§ 42.22 and 42.122(b). Both WRSI’s IPR2014-00648 (“the 648 IPR”) and Brose North America, Inc. and Brose Fahrzeugteile GmbH & Co. KG, Hallstadt’s (collectively, “Brose’s”) 416 IPR involve the same patent: US 8,217,612 (“the ’612 patent”). WRSI’s petition in the present 648 IPR involves some overlap in invalidity positions and prior art with Brose’s 416 IPR, which was instituted on August 1, 2014.

Brose’s 416 IPR was instituted against claims 1, 2, and 5-8 on multiple grounds involving Itoh (US 4,870,333), Kinzl (US 4,468,596), or both, including obviousness based on Itoh and Kinzl. *See* IPR2014-00416, Paper 12 at 6, 25-26. WRSI’s 648 IPR petition similarly asserts obviousness of claims 1, 2, and 5-8 based on Itoh and Kinzl. *See* IPR2014-00648, Paper 4 at 16-31. The remaining grounds in WRSI’s petition either do not involve Itoh or Kinzl or involve them in combination with other primary references: anticipation of claims 6-8 based on Bernard (GB 2026723); obviousness of claims 1, 2, and 5-8 based on Lamm (DE 4000730A1), Itoh and Bernard; and obviousness of claims 1, 2, and 5-8 based on Duhamé (US 5,218,282) and Kinzl. *See id.* at 8-16, 31-60.

WRSI requests that its assertion of obviousness of claims 1, 2, and 5-8 based on Itoh and Kinzl be consolidated with Brose's 416 IPR, which has already been instituted on the same grounds against the same claims. *See* 35 U.S.C. § 315(c)-(d); 37 C.F.R. § 42.122. This consolidation would permit the obviousness grounds based on Itoh and Kinzl to be addressed in one proceeding.

Although WRSI would not oppose consolidation of the remaining grounds of its 648 IPR petition with Brose's 416 IPR, WRSI believes that this would not provide as much efficiency because the other grounds involve additional primary references. WRSI is also concerned that full consolidation would result in an excessively large proceeding and lead to scheduling difficulties. WRSI therefore respectfully proposes that the Patent Trial and Appeal Board ("Board") find that it would not be reasonable to permit those other grounds to be raised in Brose's 416 IPR, and instead address those grounds in WRSI's 648 IPR petition independently.

WRSI has consulted Brose and Patent Owner. Brose and Patent Owner may take a position after reviewing the motion.

II. STATEMENT OF MATERIAL FACTS

1. UUSI filed suit against Brose North America alleging infringement of the '612 patent and served the complaint on February 7, 2013. *See* IPR2014-00416, Paper 4 at 1.

2. A little over two months later, UUSI filed suit against WRSI alleging infringement of the '612 patent and served the complaint on April 16, 2013. *See UUSI, LLC v. Webasto Roof Sys., Inc.*, No. 2:13-cv-11704 (E.D. Mich.).
3. On February 7, 2014, Brose filed its original 416 IPR petition. *See* IPR2014-00416, Paper 1.
4. On April 16, 2014, WRSI filed its petition in the present 648 IPR. *See* IPR2014-00648, Paper 2. A chart of the invalidity grounds set forth in WRSI's 648 IPR petition is provided below.

	Grounds	Claims
A	Bernard (anticipation)	6-8
B	Itoh and Kinzl	1, 2, 5-8
C	Lamm, Itoh, and Bernard	1, 2, 5-8
D	Duhamel and Kinzl	1, 2, 5-8

See id., Paper 4 at 8-60.

5. On July 24, 2014, Patent Owner filed its preliminary response to WRSI's 648 IPR petition. *See id.*, Paper 9.
6. On August 1, 2014, the Board instituted Brose's 416 IPR. A chart of the grounds instituted by the Board is provided below.

	Grounds	Claims
A	Itoh (anticipation)	1, 2, and 6-8
B	Itoh (obviousness)	1, 2, and 5-8
C	Itoh and Kinzl	1, 2, and 5-8

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