

Filed on behalf of UUSI, LLC
By: Monte L. Falcoff (mlfalcoff@hdp.com)
Hemant M. Keskar (hkeskar@hdp.com)
HARNES, DICKEY & PIERCE, P.L.C.
5445 Corporate Drive, Ste. 200
Troy, MI 48098
Telephone: (248) 641-1600
Facsimile: (248) 641-0270

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

PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION FOR
JOINDER

I.	INTRODUCTION.....	3
II.	JOINDER ACCEPTABLE IF CERTAIN CONDITIONS ARE IMPOSED TO REDUCE HARM.....	4
III.	REASONS FOR DENYING JOINDER ABSENT UUSI'S PROPOSED CONDITIONS	5
	1. WEBASTO'S GROUND B AND BROSE'S GROUND 3 ARE NOT "THE SAME"	5
	2. MODIFYING BROSE'S SCHEDULE WILL NOT REDUCE HARM TO UUSI	6
	3. WEBASTO'S DELAY TACTICS SHOULD NOT BE REWARDED	7
	4. DENYING JOINDER WILL NOT HARM WEBASTO....	8
	5. UUSI RECOMMENDS SETTING A COMMON DATE FOR ORAL ARGUMENTS.....	8
IV.	CONCLUSION	9

I. INTRODUCTION

Petitioner Webasto Roof Systems, Inc. (“Webasto”) seeks to join Ground B of its IPR2014-00648 (“Webasto IPR”), which alleges that Claims 1, 2, and 5-8 of U.S. Patent No. 8,217,612 (“the ‘612 patent”) are obvious over Itoh and Kinzl, with Ground 3 of IPR2014-00416 filed by Brose et al. (“Brose IPR”), which alleges that Claims 1, 2, and 5-8 are obvious over Itoh, Kinzl, and ordinary skill in the art. Webasto IPR, Paper 11 at 2.

Patent Owner UUSI, LLC (“UUSI”) will agree to Webasto’s proposed joinder if the Patent Trial and Appeal Board (“Board”) orders UUSI’s proposed conditions as set forth below, which will create efficiencies with minimal harm to all parties and the Board. If the Board does not order UUSI’s conditions then UUSI opposes joinder since, without these conditions, joinder will not reduce the burden on the Board and UUSI, and will harm UUSI. If the Board does not order UUSI’s conditions then, in lieu of joinder, UUSI requests the Board to set a common date for oral arguments for the Brose IPR and, if instituted, the Webasto IPR for the ‘612 patent in addition to Brose IPR2014-00417 and Webasto IPR2014-00650, if instituted, for U.S. Patent No. 7,579,802 (“the ‘802 patent”).

II. JOINDER ACCEPTABLE IF CERTAIN CONDITIONS ARE IMPOSED TO REDUCE HARM

UUSI finds that efficiencies will occur with minimal harm to all parties and the Board if the Board orders the following procedural conditions:

(1) Both petitioners must speak with a “single voice” for Brose’s Ground 3 and Webasto’s Ground B throughout all of the IPR proceedings including depositions, reply briefs, and the oral arguments. In other words, Brose will take the lead, and Webasto cannot file any supplemental briefs, ask deposition questions, or the like on this proposed Ground B.

(2) Webasto’s expert’s Declaration must be stricken and ignored with regard to Webasto’s Ground B and the facts and conclusions regarding the combination of the Itoh and Kinzl references discussed therein. Furthermore, if Webasto’s expert testifies during his deposition on the combination of the Itoh and Kinzl references then such testimony cannot be used in support of Brose’s Ground 3 or Webasto’s Ground B.

(3) No evidence of ordinary skill in the art or the like presented in or attached to the IPR Petition or expert’s Declaration solely filed by Webasto can be used in support of Brose’s Ground 3 and Webasto’s Ground B. Thus, this causes these proposed grounds to be identical and not alternate in nature.

(4) The proposed claim constructions asserted by Webasto regarding Claims 1, 2, and 5-8 be ignored such that only the Brose ones shall be proffered on behalf of both Petitioners (without UUSI admitting to the correctness or incorrectness of either of these claim constructions at this time).

If the Board orders the preceding conditions then UUSI agrees to joinder for the '612 patent. If the preceding conditions are not ordered then UUSI opposes the joinder for the following reasons since UUSI will be disadvantageously harmed.

III. REASONS FOR DENYING JOINDER ABSENT UUSI'S PROPOSED CONDITIONS

1. WEBASTO'S GROUND B AND BROSE'S GROUND 3 ARE NOT "THE SAME"

Citing IPR2013-00629 ("Smith IPR"), Webasto contends that these grounds are "the same" and therefore should be joined. Webasto IPR, Paper 11 at 6.

Webasto's contention, however, is meritless because the facts of the Smith IPR are inapposite, and the grounds Webasto seeks to join are not "the same." Specifically, Webasto's reliance on the Smith IPR is misplaced because all parties in the Smith IPR including the Patent Owner jointly moved to join a later-filed IPR with the earlier-filed Smith IPR since the grounds sought to be joined in the two IPRs were identical. Further, all parties agreed to a single deposition of Patent Owner's expert, agreed to maintain the schedule of the earlier-filed Smith IPR, and agreed to terminate the later-filed IPR. Smith IPR, Paper 18 at 2-5.

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.