

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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WEBASTO ROOF SYSTEMS, INC.  
Petitioner,

v.

UUSI, LLC  
Patent Owner.

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Case IPR2014-00648  
Patent 8,217,612

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

Attorney Docket: 130163.231151

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## I. SUMMARY OF THE REPLY

Petitioner WRSI filed its motion for joinder to explain the relationship between WRSI's 648 IPR and Brose's 416 IPR, and to propose a potential efficient way to proceed. Brose has stated that it does not oppose the partial consolidation WRSI has requested. *See* IPR2014-00416, Ex. 1031 at 13 ("So we are open to whatever the board wants to do with respect to the '612 patent."). Patent Owner opposes joinder unless the Board orders WRSI to comply with Patent Owner's proposed conditions. *See* IPR2014-00648, Paper 12 at 3-5. The Board stated that it is cognizant of the parties' issues and would not take an action that would put parties in "untenable positions." *See* IPR2014-00416, Ex. 1031 at 17.

WRSI would be placed in an untenable position if grounds in WRSI's 648 IPR petition were denied merely because Brose's 416 IPR petition already has been instituted. In particular, WRSI would be placed in an untenable position as to its obviousness challenge based on Itoh and Kinzl if this ground were not instituted, given that the Board has already decided that this ground should be instituted against the same claims. *See* IPR2014-00416, Paper 12 at 22-23, 25. If institution were not granted on the same ground in WRSI's 846 IPR petition, then Brose could settle its 416 IPR and WRSI would be foreclosed from maintaining this ground to invalidate the '612 patent.

WRSI's proposed partial consolidation would avoid placing WRSI in this untenable position. Denial of any joinder would also avoid placing WRSI in this untenable position, although it would require the parties and the Board to expend more resources. WRSI therefore proposed partial consolidation in the interest of efficiency.

## **II. RESPONSE TO PATENT OWNER'S PROPOSED CONDITIONS**

Patent Owner has not specifically denied the Statement of Material Facts on which WRSI's request for partial joinder is founded, and therefore those facts should be considered admitted. *See* 37 C.F.R. § 42.23(a). Patent Owner, however, opposes joinder unless the Board orders the conditions set forth in its opposition. Patent Owner identifies no precedent for its proposed conditions.

Consistent with the Board's prior decisions on joinder, WRSI stated it in its initial brief that it would withdraw the portions of the declaration of its expert that relate to the grounds already addressed by Brose's expert, would agree that Brose would take the lead with respect to the consolidated grounds (as long as Brose has not settled), and only requested to file a separate paper of up to 5 pages to express any separate views. *See* IPR2014-00648, Paper 11 at 9-10. WRSI respectfully submits that these conditions are sufficient to proceed efficiently, and Patent Owner's proposed conditions go too far.

Patent Owner's proposed fourth condition, that WRSI's proposed claim constructions "be ignored," is particularly problematic. IPR2014-00648, Paper 12 at 5. WRSI's 648 IPR petition sets forth other grounds of invalidity besides the obviousness grounds based on Itoh and Kinzl of Brose's 416 IPR, and WRSI's claim construction positions remain relevant to those other grounds. WRSI should be permitted to advocate claim construction positions in the 648 IPR to the extent those claim construction positions are implicated by other grounds of invalidity that may be at issue in that proceeding.

Patent Owner's first condition seeks to deny WRSI the ability to submit even a short 5-page separate paper to express any separate views. WRSI respectfully submits that permitting WRSI to submit a short separate paper is an equitable solution in the circumstances here. This is not a case where WRSI has filed a motion for joinder after the statutory deadline, as is often the case, and would have no right to pursue an IPR absent joinder. Indeed, WRSI anticipates little benefit from joinder because WRSI hopes to proceed separately on other grounds in the 648 IPR. WRSI proposed partial joinder because WRSI believes this would be more efficient, particularly for the Board. WRSI would be happy to proceed separately with a full ability to advocate for its positions, which Patent Owner professes to prefer to potentially receiving an additional 5-page brief.

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