

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEBASTO ROOF SYSTEMS, INC.
Petitioner,

v.

UUSI, LLC
Patent Owner.

Case IPR2014-00650
Patent 7,579,802

**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 IPR2014-00417 (“the 417 IPR”). *See* 35 U.S.C. § 315(c); 37 C.F.R. §§ 42.22 and 42.122(b). Both WRSI’s IPR2014-00650 (“the 650 IPR”) and Brose North America, Inc. and Brose Fahrzeugteile GmbH & Co. KG, Hallstadt’s (collectively, “Brose’s”) 417 IPR involve the same patent: US 7,579,802 (“the ’802 patent”). WRSI’s petition in the present 650 IPR involves some overlap in invalidity positions and prior art with Brose’s 417 IPR, which was instituted on August 1, 2014.

Brose’s 417 IPR was instituted against claims 1, 6-9, and 14 on multiple grounds involving Itoh (US 4,870,333), Kinzl (US 4,468,596), or both, including obviousness based on Itoh and Kinzl. *See* IPR2014-00417, Paper 11 at 5, 26. WRSI’s 650 IPR petition asserts obviousness of claims 1, 6-9, and 15-16 based on Itoh and Kinzl. *See* IPR2014-00650, Paper 4 at 10-25. WRSI also asserts obviousness of claim 11 based on Itoh, Kinzl, and Jones (US 4,831,509). *See id.* at 25-27. The remaining grounds in WRSI’s petition involve either Itoh or Kinzl: obviousness of claims 1, 6-9, and 15-16 based on Lamm (DE 4000730A1) and Itoh; obviousness of claim 11 based on Lamm, Itoh and Duhamé (US 5,218,282);

and obviousness of claims 1, 6-9, 11 and 15-16 based on Duhame and Kinzl. *See id.* at 28-60.

WRSI requests that its assertion of obviousness of claims 1 and 6-9 based on Itoh and Kinzl be consolidated with Brose's 417 IPR, which has already been instituted on the same grounds against the same claims. For efficiency, WRSI also requests that (a) obviousness of claims 15-16 based on Itoh and Kinzl and (b) obviousness of claim 11 based on Itoh, Kinzl, and Jones be consolidated with Brose's 417 IPR. *See* 35 U.S.C. § 315(c)-(d); 37 C.F.R. § 42.122. This partial consolidation would permit all claims asserted to be obvious based on combinations involving Itoh and Kinzl as primary references to be addressed in one proceeding.

Although WRSI would not oppose consolidation of the remaining grounds of its 650 IPR petition with Brose's 417 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 417 IPR, and instead address those grounds in WRSI's 650 IPR petition independently.

WRSI has consulted Brose and Patent Owner. Brose has not taken a position on this motion at this time. Patent Owner may oppose some aspects of the proposed partial consolidation.

II. STATEMENT OF MATERIAL FACTS

1. UUSI filed suit against Brose North America alleging infringement of the '802 patent and served the complaint on February 7, 2013. *See* IPR2014-00417, Paper 4 at 1.

2. A little over two months later, UUSI filed suit against WRSI alleging infringement of the '802 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 417 IPR petition. *See* IPR2014-00417, Paper 2.

4. On April 16, 2014, WRSI filed its petition in the present 650 IPR. *See* IPR2014-00650, Paper 2. A chart of the invalidity grounds set forth in WRSI's 650 IPR petition is provided below.

| | Grounds | Claims |
|---|------------------------|-----------------------|
| A | Itoh and Kinzl | 1, 6-9, and 15-16 |
| B | Itoh, Kinzl, and Jones | 11 |
| C | Lamm and Itoh | 1, 6-9, and 15-16 |
| D | Lamm, Itoh, and Duhamé | 11 |
| E | Duhamé and Kinzl | 1, 6-9, 11, and 15-16 |

See id., Paper 4 at 10-60.

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