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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

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

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I. INTRODUCTION

Petitioner Webasto Roof Systems, Inc. (“Webasto”) seeks to join Ground A of its IPR2014-00650 (“Webasto IPR”), which alleges that Claims 1, 6-9, and 15-16 of U.S. Patent No. 7,579,802 (“the ’802 patent”) are obvious over Itoh and Kinzl, with Ground 5 of IPR2014-00417 filed by Brose et al. (“Brose IPR”), which alleges that the Claims 1, 6-9, and 14 are obvious over Itoh, Kinzl, and ordinary skill in the art. Webasto IPR, Paper 11 at 2. In addition to requesting joinder of different Claims 15 and 16, Webasto also requests adding Ground B of its IPR, which alleges that Claim 11 is obvious over Itoh, Kinzl, and Jones, as a different ground including different prior art to the Brose IPR. *Id.*

Patent Owner UUSI, LLC (“UUSI”) will agree to Webasto’s proposed joinder in part 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 ’802 patent in addition to Brose IPR2014-00416 and Webasto IPR2014-00648, if instituted, for U.S. Patent No. 8,217,612 (“the ’612 patent”).

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

UUSI opposes adding Webasto's Ground B to the Brose IPR because this ground involves a totally different claim, Claim 11, and a different prior art reference, Jones, that are not asserted in the Brose IPR. UUSI, however, will agree to joinder of Webasto's Ground A with Brose's Ground 5 if the Board orders the following procedural conditions:

(1) Both petitioners must speak with a "single voice" for Claims 1 and 6-9 of Brose's Ground 5 and Webasto's Ground A 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 for Claims 1 and 6-9 of this proposed Ground A.

(2) Webasto's expert's Declaration must be stricken and ignored with regard to Claims 1 and 6-9 of Webasto's Ground A 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 (such as when it additionally combines the Jones reference for Claim 11) then such testimony cannot be used in support of Claims 1 and 6-9 of Brose's Ground 5 or Webasto's Ground A.

(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 Claims 1 and 6-9 of Brose's Ground 5 and Webasto's Ground A. This causes these proposed grounds to be identical and not alternate in nature.

(4) The proposed claim constructions asserted by Webasto regarding Claims 1 and 6-9 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 the partial joinder of Webasto's Ground A with Brose's Ground 5. If the preceding conditions are not ordered then UUSI opposes the joinder in its entirety for the following reasons since UUSI will be disadvantageously harmed.

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

1. WEBASTO'S GROUND A AND BROSE'S GROUND 5 ARE NOT "THE SAME"

Citing IPR2013-00629 ("Smith IPR"), Webasto contends that its and Brose's invalidation positions for Claims 1 and 6-9, which are common in these grounds, are "the same" and therefore these grounds should be joined. Webasto IPR, Paper 11 at 7. 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

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