

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 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 640 IPR and Brose's 417 IPR, and to propose a potential efficient way to proceed. Brose has stated it opposes addition of claims 11, 15, and 16 to its 417 IPR, but has not voiced opposition to consolidation as to the same claims at issue in the 417 IPR (claims 1 and 6-9). *See* IPR2014-00417, Ex. 1043 at 14-15. Patent Owner also opposes joinder as to claims 11, 15, and 16, and opposes joinder as to claims 1 and 6-9 unless the Board orders WRSI to comply with Patent Owner's proposed conditions. *See* IPR2014-00650, Paper 12 at 4, 15. 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* IPR2014-00417, Ex. 1043 at 17.

WRSI would be placed in an untenable position if grounds in WRSI's 650 IPR petition were denied merely because Brose's 417 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 against claims 1 and 6-9, given that the Board has already decided that this ground should be instituted against the same claims. *See* IPR2014-00417, Paper 11 at 26. If institution were not granted on the same ground in WRSI's 648 IPR petition, then Brose could settle its 417 IPR and WRSI would be foreclosed from maintaining this ground to invalidate the '802 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.

WRSI appreciates the Board's sensitivity to the private parties' interests, and WRSI similarly has no desire to disadvantage Brose. WRSI has no objection to proceeding against claim 11 based on Itoh, Kinzl, and Jones and against claims 15 and 16 based on Itoh and Kinzl separately in the 650 IPR (assuming institution on these grounds) to avoid Brose's concern about potential estoppel if these claims were consolidated into Brose's 417 IPR.

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 7 pages to express any separate views and claims not addressed by Brose. *See* IPR2014-00650, Paper 11 at 11-13. 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. IPR2014-00650, Paper 12 at 5. WRSI's 6450 IPR petition sets forth other grounds of invalidity besides the obviousness grounds based on Itoh and Kinzl of Brose's 417 IPR, and WRSI's claim construction positions remain relevant to those other grounds. WRSI should be permitted to advocate claim construction positions in the 650 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 7-page separate paper to express any separate views and any claims that Brose has not addressed in its 417 IPR.¹ 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

¹ If none of claims 11, 15, or 16 are consolidated with the 417 IPR, then WRSI would request to submit no more than a 5-page separate paper.

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