

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NAVICO, INC.,
Petitioner

v.

GARMIN SWITZERLAND GMBH,
Patent Owner

Case IPR: 2017-02051
U.S. Patent No. 7,268,703

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION FOR JOINDER**

In its Motion for Joinder, Petitioner represents that it will accept an “understudy” role with respect to pending IPR2017-00946. (Paper 3 at 3, 6-8) (Petitioner in IPR2017-00946 is FLIR Systems, Inc. and FLIR Maritime US, Inc., collectively “FLIR”). Petitioner identifies several exemplary events or actions for which it will serve as an understudy, such as being bound by any agreement between Patent Owner and FLIR concerning discovery and/or depositions. *See id.* at 6-7, *citing* IPR2014-00550, Paper 38 at 5 (Apr. 10, 2015). The list of events/actions identified by Petitioner does not necessarily represent a comprehensive list of events/actions adopted by the Board as part of an “understudy” role. As such, Patent Owner opposes Petitioner's Motion for Joinder, *but only to the extent* that Petitioner attempts any equivocation in serving as a silent understudy.

In particular, Patent Owner does not oppose Petitioner's Motion for Joinder to the extent that Patent Owner agrees, *subject to FLIR remaining a participating party to IPR2017-00946*, to the following:

(1) Petitioner will not file any papers or exhibits in any joined proceeding, except *pro hac vice* motions and administrative filings (*see* IPR2016-01393, Paper 9 at 2-3 (Nov. 21, 2016));

(2) Petitioner may attend but will not otherwise participate in any deposition in any joined proceeding (*see* IPR2015-01881, Paper 11 at 5, Bullet Point 3 (Jan. 19, 2016));

(3) Petitioner may attend but will not otherwise participate in any oral hearing or conference call with the Board in any joined proceeding;

(4) Petitioner will be copied on correspondence between Patent Owner and FLIR, but neither Patent Owner nor FLIR will be required to obtain Petitioner's consent or opposition to any request by Patent Owner or FLIR in any joined proceeding (e.g., Patent Owner will not be required to confer with FLIR for a requested motion or action in the IPR);

(5) Petitioner will comply with the role otherwise set forth by Petitioner in its Motion for Joinder, Paper 3 at 6-7; and

(6) Petitioner will not otherwise "actively participate" in the joined proceeding and will assume a "passive role" (*see* IPR2017-01636, Paper 10 at 12 (Oct. 3, 2017); IPR017-0012, Paper 27 at 2 (Jun. 1, 2017)).

In sum, to the extent that Petitioner's understudy role is as a silent understudy with no active participation in any joined proceeding (to the extent that FLIR remains an active, participating party in the joined proceeding), and further to the extent that such silent understudy role includes complying with the above limitations on Petitioner's participation in the joined proceeding, Patent Owner does not oppose the Motion for Joinder. Should Petitioner refuse to comply with the above limitations on its role in any joined proceeding, Patent Owner opposes the Motion for Joinder, as Petitioner's involvement would introduce additional argument, briefing, and/or discovery. *See* IPR2015-00268,

Paper 17 at 6 (Apr. 10, 2015) (noting petitioner's assurance that its understudy role would not introduce additional arguments, briefing, or discovery).

Respectfully submitted,

/Jennifer C. Bailey/

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ATTORNEYS FOR PATENT OWNER

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that a true copy of the PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO AMEND was served via Electronic Mail this 9th day of October 2017, in their entireties on the following lead and back-up counsel for Petitioner, Navico, Inc.:

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