

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

ROBERT BOSCH LLC,

Plaintiff,

v.

ALBEREE PRODUCTS, INC., API KOREA CO.,  
LTD., SAVER AUTOMOTIVE PRODUCTS,  
INC., and COSTCO WHOLESALE  
CORPORATION

Defendants.

Civil Action No. 12-574-LPS  
(CONSOLIDATED)

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COSTCO WHOLESALE CORPORATION,

Counter-Plaintiff,

v.

ROBERT BOSCH LLC and ROBERT BOSCH  
GMBH,

Counter-Defendants.

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**MEMORANDUM OPINION**

March 16, 2016  
Wilmington, Delaware

[Public Version March 28, 2016]

 3/28/16

**STARK, U.S. District Judge:**

On May 4, 2012, plaintiff Robert Bosch LLC (“Bosch LLC” or “Plaintiff”) filed a patent infringement action against defendants API Korea Co., Ltd. (“API”) and Alberee Products, Inc. (“Alberee”) asserting U.S. Patent Nos. 6,523,218 (“the ’218 patent”), 6,530,111 (“the ’111 patent”), 6,553,607 (“the ’607 patent”), 6,611,988 (“the ’988 patent”), 6,675,434 (“the ’434 patent”), 6,836,926 (“the ’926 patent”), 6,944,905 (“the ’905 patent”), 6,973,698 (“the ’698 patent”), 7,228,588 (“the ’588 patent”), 7,293,321 (“the ’321 patent”), 7,523,520 (“the ’520 patent”), and 7,484,264 (“the ’264 patent”). (D.I. 1)<sup>1</sup> On January 18, 2013, Bosch LLC filed an Amended Complaint adding Saver Automotive Products, Inc. (“Saver”) as a defendant. (D.I. 38) On February 5, 2014, Bosch LLC filed an additional patent infringement action against defendants API, Alberee, and Saver, asserting U.S. Patent No. 6,292,974 (“the ’974 patent”). (C.A. No. 14-142-LPS, D.I. 1) On September 10, 2014, the two patent infringement actions were consolidated. (D.I. 67) On October 9, 2014, Bosch LLC filed a Consolidated Amended Complaint against API, Alberee, Saver, and Costco Wholesale Corporation (“Costco”) (collectively, “Defendants”), asserting U.S. Patent Nos. (“the ’823 patent”), 6,668,419 (“the ’419 patent”), 7,941,891 (“the ’891 patent”), and 8,544,136 (“the ’136 patent), as well as all of the previously asserted patents. (D.I. 84) On October 31, 2014, Bosch LLC filed a Second Amended Complaint (“SAC”) asserting U.S. Patent No. 8,272,096 (“the ’096 patent”) as well as all of the previously asserted patents against Defendants. (D.I. 95)

On September 30, 2015, Costco filed a Counterclaim, adding Robert Bosch GmbH

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<sup>1</sup>All D.I. references in this opinion refer to C.A. No. 12-574-LPS unless otherwise specified.

(“Bosch GmbH”) as a counterclaim defendant. (D.I. 244) Bosch GmbH filed a Motion to Dismiss for Lack of Jurisdiction Over the Person on December 4, 2015 (D.I. 263), but withdrew its motion on January 15, 2016 (D.I. 283), and is now a counterclaim defendant ~~and counterclaim plaintiff~~ [revised March 28, 2016] in this case (*see* D.I. 311).

Among the several issues pending before the Court is Costco’s Motion for Summary Judgment as to the Goodyear Hybrid Wiper Product (“Summary Judgment Motion”). (D.I. 158) Bosch LLC and Costco completed briefing on the Summary Judgment Motion on May 29, 2015 (D.I. 159; D.I. 177; D.I. 188), and Defendants API, Alberee, and Saver have joined in Costco’s submissions (D.I. 163; D.I. 179; D.I. 189). The Court heard argument on the Summary Judgment Motion on June 8, 2015. (*See* D.I. 204) (“Tr.”) On June 24, 2015, the Court ordered supplemental briefing (D.I. 201), which the parties completed on July 24, 2015 (D.I. 211; D.I. 212; D.I. 214; D.I. 216; D.I. 229; D.I. 230). The Summary Judgment Motion is directed to multiple issues. This Memorandum Opinion addresses three of them: (1) non-infringement of the ’607 and ’096 patents by the Goodyear Hybrid Product; (2) non-infringement of the ’698 patent by the Goodyear Hybrid Product; and (3) non-infringement of the ’988 patent by the Goodyear Hybrid Product. For the reasons explained below, the Court will grant in part the Summary Judgment Motion with respect to these three issues. The Court will deny without prejudice the remainder of the Summary Judgment Motion in light of the fact that, for the most part, this case will be stayed.

The Court also addresses Bosch LLC’s Motion for Relief from the Court’s December 22, 2015 Order (“Motion for Relief”) (D.I. 284) and how the case will proceed.

## **I. FACTUAL BACKGROUND**

The '607 and '096 patents claim side-lock wiper systems for motor vehicles. (D.I. 161 Exs. 16, 24) The '988 and '698 patents claim wiper blades for motor vehicles. (D.I. 161 Exs. 17, 20) All four of these patents were originally assigned to Bosch GmbH. (D.I. 161 Exs. 16, 17, 20, 24) Bosch GmbH, the parent of Bosch LLC (*see* D.I. 311 at ¶ 4), assigned these four patents to Bosch LLC in 2010 ('607 and '698 patents), 2011 ('988 patent), and 2014 ('096 patent). (D.I. 188 Ex. 2 at BLLC1241453-56, BLLC1241460-65) In doing so, Bosch GmbH retained for itself “a nonexclusive license under the Contract Patents,” including “the right to sublicense the Contract Patents in the framework of manufacturing licenses or patent cross licenses.” (D.I. 216 Ex. A at Ex. 1 at ¶ 5)

Bosch LLC sells in the United States original equipment side-lock wiper systems that practice the '607 and '096 patents, for installation by domestic car manufacturers on vehicles sold in the United States.<sup>2</sup> The Bosch group of companies enters into agreements with domestic car manufacturers. For example, Section 19.01 of the Production Purchasing Global Terms and Conditions, “the global terms-and-conditions agreement applicable to sales by the Bosch group of companies to ██████████ and its affiliates” (D.I. 348 at 1), provides:

The Supplier will grant Licenses on the bases specified below unless an Earlier Agreement (as defined in Section 4.02) states otherwise. A License is a license granted in all cases to the Buyer and its Related Companies on a nonexclusive, worldwide basis, to make, have made, use, have used, sell and import manufactures, compositions, machines and processes covered by the Intellectual Property Rights of the Supplier.

(D.I. 347 Ex. 1 at BGMBH0013576-77)

Bosch GmbH sells outside of the United States original equipment side-lock wiper

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<sup>2</sup>These include the BMW X3, Ford Five Hundred, Ford Freestyle, and Mercury Montego.

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