

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COSTCO WHOLESALE CORP.,  
Petitioner,

v.

ROBERT BOSCH LLC,  
Patent Owner.

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IPR2016-00035  
Patent 6,836,926 B1

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Before PHILLIP J. KAUFFMAN, WILLIAM V. SAINDON, and  
BARRY L. GROSSMAN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION  
Denying Request for Rehearing  
*37 C.F.R. § 42.71*

## I. INTRODUCTION

Costco Wholesale Corporation (“Petitioner”) timely filed a Request for Rehearing (Paper 17, (“Req. Reh’g.”)) requesting rehearing of our decision (Paper 16 (“Decision” or “DI”)) denying institution of an *inter partes review* of claims 1–3 in U.S. Patent No. 6,836,926 B1 (Ex. 1001, “the ’926 patent”).

Petitioner raises two issues on which Petitioner asserts the Board abused its discretion. One concerns the claim limitation in independent claim 1 of a support element having “a substantially rectangular cross sectional profile,” with “a substantially constant width” and “a substantially constant thickness.” The other issue concerns the claim limitation in claim 3, dependent on claim 1, of a support element “comprised of at least two individual bars” and wherein the widths of the individual bars add up to a total width.

For the reasons stated below, we deny Petitioner’s Request.

## II. ANALYSIS

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

The burdens and requirements of a request for rehearing are stated in 37 C.F.R. § 42.71(d):

(d) Rehearing. . . . The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

A. SUPPORT ELEMENT HAVING A  
SUBSTANTIALLY RECTANGULAR CROSS SECTIONAL PROFILE

Petitioner asserts an abuse of discretion in the determination that “Petitioner did not present an adequate rationale for applying the stiffness teachings of Swanepoel ’650 and Swanepoel ’564 to prior art windshield wiper supports having a *substantially constant* width and thickness,” as disclosed in Palu. Req. Reh’g. 4 (citing Decision at 23-25). It is Petitioner’s position that the Decision “overlooked Petitioner’s discussion of U.S. Patent 3,881,214 to Palu (Ex. 1011) on pages 40 and 48 of the Petition.”<sup>1</sup> *Id.* Petitioner points to the disclosure in Palu, but does not cite where in its Petition it provided an evidence-based *rationale*, in accordance with controlling law and precedent, that it would have been obvious to a person of ordinary skill to combine Palu’s disclosure with the other cited references.

Our Decision to Institute discussed Petitioner’s assertion that claim 1 would have been obvious based on Swanepoel ’650 (Ex. 1006), in view of

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<sup>1</sup> The discussion of Palu on page 48 of the Petition (in the context of Petitioner’s Ground 2) is a verbatim repetition of the discussion of Palu on page 40 of the Petition (in the context of Petitioner’s Ground 1). The Decision Denying Institution, and this Decision denying Petitioner’s request for rehearing, refer to the discussion on page 40 of the Petition.

Appel (Ex. 1008), Swanepoel '564 (Ex. 1005), DE '939 (Exs. 1009, 1010), Palu (Ex. 1011), Arman (Ex. 1012), or Hoyler (Exs. 1013, 1014). DI 13-25.

In the Petition, Petitioner argued:

The parameterization method taught in Swanepoel '650 *could be applied* to support elements of constant width and thickness, which are constants as a function of coordinate. Moreover, support elements of substantially constant width and thickness are also taught by the *secondary references*, Appel, DE '939, Palu, Arman, and Hoyler, each of which teaches that the support element may be of substantially constant width and thickness *over at least a portion* of its length.

Pet. 40 (emphases added, citations omitted).

Independent claim 1, however, is not limited to a substantially constant width and thickness “over at least a portion of its length,” as Petitioner characterized the prior art. Claim 1 recites that the support element has a substantially rectangular cross sectional profile, with a substantially constant width *and* a substantially constant thickness.

Petitioner singled out Palu from the list of secondary references to assert:

Palu (Ex. 1011) teaches: “At the same time, since the cross section of said supporting structure is substantially constant, the ends of the supporting structure can withstand very well the forces which tend to flect them laterally.” Ex. 1011, 4:52-55. “Thus, the windshield wiper blade” of Palu “presents . . . the advantage of withstanding considerably higher lateral loads, since its supporting structure 1 has a substantially constant cross section.”

*Id.* (quoting Ex. 1011, 4:52-55.) Petitioner’s characterization of Palu refers to a substantially constant cross section. It does not also assert, however, a

substantially constant width *and* a substantially constant thickness, as recited in claim 1.

Notwithstanding this distinction between the argued disclosure in Palu and the claimed elements and limitations, the Decision did not overlook Petitioner’s discussion of Palu on pages 40 and 48 of the Petition. In discussing the scope and content of the prior art, we discussed collectively what Petitioner referred to as the “secondary references.”

Petitioner asserts “support elements of substantially constant width and thickness are also taught by the secondary references, Appel, DE ’939, *Palu*, Arman, and Hoyler, each of which teaches that the support element may be of substantially constant width and thickness *over at least a portion of its length.*”

DI 17 (quoting Pet. 40) (emphases added). Thus, we did not overlook Petitioner’s reliance on Palu. Nor did we misapprehend Palu’s disclosure.

#### 1. RATIONALE

Our Decision was based on the determination that, notwithstanding the disclosure in Palu and the other references, Petitioner did not provide “a rationale based on persuasive evidence or argument for why a person of ordinary skill would have chosen certain features from the cited references, omitted other features, and combined the selected features to yield the invention in the challenged claims.” DI 25 (citing *ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312, 1327–1328 (Fed. Cir. 2012)). Petitioner does not take issue with the determination that there was not a persuasive rationale for the proposed combination of references. Petitioner merely asserts we overlooked or misapprehended the disclosure of Palu. Req. Reh’g. 4 (“The Board appears to have overlooked Petitioner’s

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