

UNITED STATES PATENT AND TRADEMARK OFFICE

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COSTCO WHOLESALE CORP.,  
Petitioner,

v.

ROBERT BOSCH LLC,  
Patent Owner.

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Cases<sup>1</sup>

IPR2016-00034 (Patent 6,973,698 B1)  
IPR2016-00036 (Patent 6,944,905 B2)  
IPR2016-00038 (Patent 6,292,974 B1)  
IPR2016-00039 (Patent 7,228,588 B2)  
IPR2016-00040 (Patent 7,484,264 B2)  
IPR2016-00041 (Patent 8,099,823 B2)

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

KAUFFMAN, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
37 C.F.R. § 42.5

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<sup>1</sup> This order addresses issues that are the same for each case. The parties are not authorized to use this heading style.

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At Patent Owner's request, the Board held a conference call with the parties. Patent Owner provided a court reporter and will file a copy of the transcript in each case.

Patent Owner provided the status of the corresponding Federal Circuit appeal for each of our proceedings: the appeal of IPR2016-00034 is proceeding; the appeal of IPR2016-00041 has been dismissed due to the request for rehearing pending before the Board (*see* IPR2016-00041, Paper 73); and appeal of the remaining cases is stayed pending outcome of our rehearing decision in IPR2016-00041 (*id.*).

Patent Owner requests authorization to file a motion in each case, in view of a written settlement agreement between the parties, seeking to vacate each Final Written Decision or, in the alternative, to otherwise prevent the Office from issuing a certificate pursuant to 35 U.S.C. § 318(b) in each case. Petitioner opposes, contending that such action is not appropriate because the proceedings have been terminated.

In IPR2016-00041, we authorize Patent Owner to file a motion addressing whether the Board may either vacate a Final Written Decision, or otherwise not issue a § 318(b) certificate upon reaching Final Written Decision, based upon settlement between the parties when that settlement is made after entry of the Final Written Decision but before either (1) time for appeal has expired or (2) appeal has terminated. In particular, the Motion should address whether Patent Owner's requests are permissible under 35 U.S.C. §§ 317(a), 318(b), or any other statute or Rule applicable in these

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circumstances. The Motion should cite to any supporting authority. The Motion may address whether permitting such settlement serves the public interest, and argue any other policy considerations.

As to IPR2016-00034, IPR2016-00036, and IPR2016-00038–40, we note that “the subject matter of the appeal is transferred” to the Federal Circuit upon the filing of a notice of appeal. *In re Allen*, 115 F.2d 936, 941 (CCPA 1940). Under *Allen*, the USPTO may perform only “purely ministerial function[s]” once such a notice of appeal is filed. *In re Grier*, 342 F.2d 120, 123 (CCPA 1965). We deny Patent Owner’s request to file a motion at this time in these cases.<sup>2</sup> Notwithstanding, the motion in IPR2016-00041 may also address whether permitting settlement and vacating the Final Written Decision when appeal is pending at the Federal Circuit would be a ministerial act by the Board. *See generally Mitsubishi Cable Industries, Ltd v. Goto Denshi Co.*, Case No. IPR2015-01108 (PTAB May 5, 2017) (Paper 28).

It is ORDERED that Patent Owner may file a motion in IPR2016-00041, as outlined above, not to exceed fifteen pages, no later than five business days from entry of this order;

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<sup>2</sup> Further, because of the differences in stances between the cases, slightly different briefs would need to be filed in these cases. For the sake of efficiency, we decide to hold briefing on this question in the ’00041 case, to have all issues raised addressed in one brief.

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FURTHER ORDERED that Petitioner may file an opposition in IPR2016-00041, not to exceed fifteen pages, no later than five business days from service of Patent Owner's Motion;

FURTHER ORDERED we *deny* Patent Owner's request to file a motion in IPR2016-00034, IPR2016-00036, IPR2016-00038, IPR2016-00039, and IPR2016-00040.

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