

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTCO WHOLESALE CORPORATION,
Petitioner,

v.

ROBERT BOSCH LLC,
Patent Owner.

Case IPR2016-00039
Patent 7,228,588

DECLARATION OF JAMES W. DABNEY

Costco Exhibit 1023 p 1

I, James W. Dabney, declare as follows:

1. I am a partner and co-chair of the Intellectual Property group at the law firm of Hughes Hubbard & Reed LLP, located at One Battery Park Plaza, New York, NY 10004.

2. I make this declaration in support of Petitioner TC Heartland LLC's Motion for my admission *pro hac vice*.

3. I am a member in good standing of the bar of the State of New York and the State of New Jersey. I am also duly admitted and authorized to practice law before the Supreme Court of the United States, the Courts of Appeals for the Second, Third, Fourth, Fifth, Sixth, Seventh, Eighth, Ninth, Tenth, Eleventh and Federal Circuits, and various federal district courts throughout the country.

4. I have been practicing law and litigating cases for 36 years. During most of this time, my practice has included patent infringement matters. I have been lead counsel in several patent infringement trials and appeals. I am an Adjunct Professor of Law at Cornell Law School, where I teach patent law.

5. Since 2014, I have been lead trial counsel for Petitioner in *Robert Bosch LLC v. Alberee Products, Inc., et al.*, No. 12-574-LPS (D. Del.) (the "Delaware Action"), which involves the same subject matter at issue in this proceeding. U.S. Patent No. 7,228,588, the patent at issue in this IPR proceeding, is also at issue in the pending Delaware Action. I have spent a substantial amount time be-

coming familiar with this patent and the patents in related IPR proceedings, including learning the underlying windshield wiper blade technology and pertinent prior art. As a result, I have become very familiar with the subject matter at issue in this proceeding.

6. I have never been suspended or disbarred from practice before any court or administrative body.

7. I have never had a court or administrative body deny my application for admission to practice.

8. No sanctions or contempt citations have ever been imposed against me by any court or administrative body.

9. I am submitting herewith applications to be admitted *pro hac vice* in five co-pending related *inter partes* review proceedings, Cases IPR2016-00034, IPR2016-00036, IPR2016-00038, IPR2016-00040, and IPR2016-00041. In the past three (3) years I have been admitted *pro hac vice* in three other matters pending before the United States Patent and Trademark Office, Cases IPR2015-01128, IPR2015-01129, and IPR2015-01131.

10. I have read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Part 42 of 37 C.F.R.

11. I agree to be subject to the United States Patent and Trademark Rules

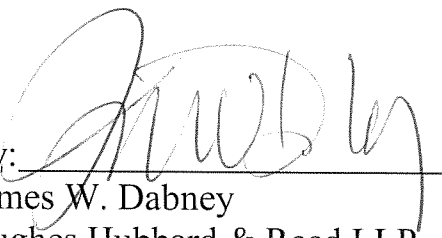
IPR2016-00039

DECLARATION OF JAMES W. DABNEY

of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on: July 1, 2016

By: 
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Costco Exhibit 1023, p. 4