

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTCO WHOLESALE CORPORATION,
Petitioner,

v.

ROBERT BOSCH LLC,
Patent Owner.

CASE NO. IPR2016-00039
U.S. Patent No. 7,228,588

**PATENT OWNER'S MOTION FOR ADMISSION
PRO HAC VICE OF MARK A. HANNEMANN**

Pursuant to 37 C.F.R. § 42.10(c), Patent Owner Robert Bosch LLC respectfully requests that the Board admit Mark A. Hannemann *pro hac vice* as back-up counsel in this proceeding.

I. Statement of Facts Showing There is Good Cause for the Board to Admit Counsel *Pro Hac Vice*

“The Board may recognize counsel *pro hac vice* in a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose.” 37 C.F.R. § 42.10(c). “[W]here lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon a showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” *Id.* The facts here establish good cause for the Board to admit Mark Hannemann *pro hac vice* during this proceeding, so that he may participate in, *inter alia*, oral hearings, depositions, and conferences with the Board.

1. Lead counsel, Eric Schreiber, is a registered practitioner.
2. As set forth in the accompanying Declaration of Mark A. Hannemann in Support of Patent Owner’s Motion for Admission *Pro Hac Vice* (“Hannemann Decl.”), Mr. Hannemann is admitted to practice law in the State of New York, the U.S. Courts of Appeals for the Federal Circuit and the Second Circuit, and the U.S.

District Courts for the Eastern District of New York, the Southern District of New York, and the Eastern District of Michigan. Hannemann Decl., ¶ 3.

3. Mr. Hannemann is an experienced litigating attorney. More specifically, he has 20 years of litigation experience with a focus on patent infringement proceedings. Hannemann Decl., ¶ 4. Mr. Hannemann has been a first-chair litigator in several patent infringement trials. Hannemann Decl., ¶ 4.

4. Mr. Hannemann also has an established familiarity with the subject matter at issue in this proceeding. Since 2007, he has been lead counsel for Patent Owner in numerous patent infringement cases in federal courts and before the U.S. International Trade Commission involving the same subject matter at issue in this proceeding, Patent Owner's beam windshield wiper blade technology. Hannemann Decl., ¶ 5. In each of those cases, Patent Owner has asserted patents directed to beam wiper blade technology. Hannemann Decl., ¶ 5. U.S. Patent No. 7,228,588, the patent at issue in this IPR proceeding, was at issue in several of these prior cases. Hannemann Decl., ¶ 5.

5. Mr. Hannemann is lead counsel for Patent Owner in a patent infringement case currently pending against Petitioner in the United States District Court for the District of Delaware, *Robert Bosch LLC v. Alberee Products Inc. et al.*, Civil Action No. 12-574-LPS (consolidated with Civil Action No. 14-142-LPS (D. Del.)). Hannemann Decl., ¶ 6. U.S. Patent No. 7,228,588, the patent at issue

in this IPR proceeding, is also at issue in the pending Delaware action. Hannemann Decl., ¶ 6.

6. Mr. Hannemann attests to each of the *pro hac vice* declaration requirements listed in the Board's Order in Case No. IPR2013-00639 (Paper 7). See Hannemann Decl., ¶¶ 3-12.

7. Mr. Hannemann has 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. Hannemann Decl., ¶ 10.

8. Mr. Hannemann agrees to be subject to the USPTO Rules 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) and to be subject to the USPTO Rules of Professional Conduct as set forth in Changes to Representation of Others Before the United States Patent and Trademark Office; Final Rule, 78 Fed. Reg. 20180 (Apr. 3, 2013) (effective May 3, 2013). Hannemann Decl., ¶ 12.

II. Conclusion

The requirements for admission *pro hac vice* being hereby established, Patent Owner respectfully requests that the Board admit Mark Hannemann *pro hac vice* as back-up counsel in this proceeding.

CASE NO. IPR2016-00039

U.S. Patent No. 7,228,588

Respectfully submitted,

Dated: November 2, 2015

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