

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTCO WHOLESALE CORP.,
Petitioner,

v.

ROBERT BOSCH LLC,
Patent Owner.

Case IPR2016-00040
Patent 7,484,264 B2

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

KAUFFMAN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION

35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. OVERVIEW

Costco Wholesale Corp. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1, 2, and 3 of U.S. Patent No. 7,484,264 B2 (Ex. 1001, “the ’264 patent”). Pet. 1. Robert Bosch LLC (“Patent Owner”) filed a Preliminary Response (Paper 15, “Prelim. Resp.”) to the Petition. We instituted *inter partes* review of claims 1, 2, and 3.

We discuss preliminary matters, such as motions, in Section II below.

We held an oral hearing on January 18, 2017. *See* Paper 65 (“Tr.”); *see also* Ex. 1206 (Petitioner’s transcript errata).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the claims on which we instituted trial.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 2, and 3 the ’264 patent are unpatentable.

B. RELATED PROCEEDINGS

The parties indicate that the ’264 patent is at issue in: *Robert Bosch LLC v. Alberee Products Inc. et al.*, No. 12-574-LPS (consolidated with No. 14-142-LPS) (D. Del.) (“the related litigation”). Pet. 1; Paper 4, 1.

IPR2016-00040
Patent 7,484,264 B2

The parties are currently involved in the following *inter partes* proceedings (“these proceedings”):

Case #	U.S. Patent #	Abbreviation
IPR2016-00034	6,973,698	“the ’698 patent”
IPR2016-00036	6,944,905	“the ’905 patent”
IPR2016-00038	6,292,974	“the ’974 patent”
IPR2016-00039	7,228,588	“the ’588 patent”
IPR2016-00040 ¹	7,484,264	“the ’264 patent”
IPR2016-00041	8,099,823	“the ’823 patent”

Two of the patents at issue in these proceedings, the ’905 patent and the ’974 patent, were at issue in prior litigation between Patent Owner and Pylon Manufacturing Corporation. Paper 36, 2. *Robert Bosch LLC v. Pylon Manufacturing Corporation* (D. Del., Case No. 08-542 (SLR)) (“the Pylon litigation”). See Paper 33, 1.

In these proceedings, sometimes a party submitted an identical paper or exhibit in all of the proceedings even though that paper or exhibit may not be applicable, or applies in a different manner, to a particular proceeding. At other times, we are able to apply the analysis of one proceeding to another.

¹ The ’264 patent is a division of the application that became the ’588 patent (IPR2016-00039). Ex. 1001, [62]. The remaining patents are not related.

C. EVIDENCE AND ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner asserts that the challenged claims are unpatentable under the following grounds:

Claims Challenged	§	References(s)
1, 2	103(a)	Prohaska ² and Kotlarski '383 ³
1, 2	103(a)	Prohaska and Merkel ⁴
3	103(a)	Prohaska, Kotlarski '383, and Kotlarski '090 ⁵
3	103(a)	Prohaska, Merkel, and Kotlarski '090
3	103(a)	Prohaska, Kotlarski '383, and Mathues ⁶
3	103(a)	Prohaska, Merkel, and Mathues

In the Patentability section below, we address these grounds in three groupings:

1. *Prohaska and either Kotlarski '383 or Merkel*
2. *Prohaska, either Kotlarski '383 or Merkel, and Kotlarski '090*
3. *Prohaska, either Kotlarski '383 or Merkel, and Mathues*

² U.K. Patent Application No. GB 2 106 775 A, published Apr. 20, 1983 (Ex. 1003).

³ PCT WO 99/02382, published Jan. 21, 1999 (Ex. 1006). The certified English translation begins at page 27.

⁴ PCT WO 99/12784, published March 18, 1999 (Ex. 1016). The certified English translation begins at page 20. We reference the U.S. counterpart filed as Ex. 1017 (U.S. Pat. No. 6,295,690 B1). References to “Merkel,” mean the prior art, while references to “Mr. Merkel” pertain to that person.

⁵ PCT WO 00/34090, published June 15, 2000 (Ex. 1008). We reference the U.S. counterpart (Pat. No. 6,523,218 (Ex. 1009)). *See* Pet. 5, n. 1.

⁶ U.S. Patent No. 3,121,133, issued Feb. 11, 1964 (Ex. 1013).

II. PRELIMINARY MATTERS

A. PETITIONER'S MOTION TO STRIKE AND MOTION TO EXCLUDE

1. *Motion to Strike*

Petitioner's Motion to Strike and associated papers⁷ do not differ from the Motion to Strike in IPR2016-00038 in any meaningful way. We adopt that analysis here, and accordingly, that Motion is *denied*.

2. *Motion to Exclude*

Petitioner's Motion to Exclude and associated papers⁸ do not differ from the Motion to Exclude in IPR2016-00039 in any meaningful way. We adopt that analysis here, and accordingly, that Motion is *granted-in-part* and *denied-in-part* as outlined below.

a) *Mr. Merkel's former testimony*

Just as in IPR2016-00039, the patent at issue in the proceeding at hand was not at issue in the Pylon litigation. Consequently, for the reasons given in IPR2016-00039, Petitioner has demonstrated that Mr. Merkel's testimony from the Pylon litigation is inadmissible hearsay, and with respect to this evidence, Petitioner's Motion is *granted*.

b) *Mr. Kashnowski's testimony*

Our analysis in IPR2016-00038 is applicable here. Consequently, Petitioner has not demonstrated effectively that the testimony at issue is

⁷ See Paper 31 (authorizing the Motion), Paper 33 (Petitioner's Motion), Paper 36 (Patent Owner's opposition).

⁸ See Paper 29 (Petitioner's Objections); Paper 50 (Petitioner's Motion); Paper 58 (Patent Owner's Opposition); Paper 63 (Petitioner's Reply to Patent Owner's Opposition).

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