

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

COSTCO WHOLESALE CORPORATION,  
Petitioner,

v.

ROBERT BOSCH LLC,  
Patent Owner.

---

Case IPR2016-00041  
Patent 8,099,823

---

**PETITIONER'S REQUEST FOR REHEARING  
OF THE FINAL WRITTEN DECISION  
AS TO CLAIM 6 OF U.S. PATENT NO. 8,099,823**

**TABLE OF CONTENTS**

	Page
I. STATEMENT OF PRECISE RELIEF REQUESTED .....	1
II. REASONS FOR THE RELIEF REQUESTED .....	1
A. The ’823 Decision Overlooked All of the Evidence That the ’264 Decision Credited in Holding Claim 3 of the ’264 Patent Unpatentable .....	7
B. The ’264 Decision Precludes an Inconsistent Outcome on the Same Issues in This Proceeding .....	13
III. CONCLUSION.....	15

**TABLE OF AUTHORITIES**

<b><u>Cases</u></b>	<b><u>Page(s)</u></b>
<i>B &amp; B Hardware, Inc. v. Hargis Indus., Inc.</i> , 135 S. Ct. 1293 (2015).....	13
<i>Blonder-Tongue Labs., Inc. v. Univ. of Illinois Found.</i> , 402 U.S. 313 (1971).....	15
<i>In re Freeman</i> , 30 F.3d 1459 (Fed. Cir. 1994) .....	13, 14, 15
<i>KSR Int’l Co. v. Teleflex</i> , 550 U.S. 398 (2007).....	7, 9, 10
<i>Mendenhall v. Barber-Greene Co.</i> , 26 F.3d 1573 (Fed. Cir. 1994) .....	13
<i>Ohio Willow Wood Co. v. Alps S., LLC</i> , 735 F.3d 1333 (Fed. Cir. 2013) .....	14
<i>Pharmacia &amp; Upjohn Co. v. Mylan Pharm., Inc.</i> , 170 F.3d 1373 (Fed. Cir. 1999) .....	15
<i>Sakraida v. Ag Pro, Inc.</i> , 425 U.S. 273 (1976).....	7
<i>Soverain Software LLC v. Victoria’s Secret Direct Brand Mgmt., LLC</i> , 778 F.3d 1311 (Fed. Cir. 2015) .....	14
<b><u>Statutes and Rules</u></b>	
37 C.F.R. § 42.2 .....	15
37 C.F.R. § 42.71(d) .....	1, 6, 7
35 U.S.C. § 315(e) .....	15

**TABLE OF AUTHORITIES**

<b><u>Administrative Proceedings</u></b>	<b><u>Page(s)</u></b>
Institution Decision, <i>Costco Wholesale Corp. v. Robert Bosch LLC</i> , IPR2016-00040, Paper No. 16 (PTAB Apr. 25, 2016) .....	2
Trial Hearing Order, <i>Costco Wholesale Corp. v. Robert Bosch LLC</i> , IPR2016-00040, Paper No. 61 (PTAB Dec. 29, 2016) .....	3
Final Written Decision, <i>Costco Wholesale Corp. v. Robert Bosch LLC</i> , IPR2016-00040, Paper No. 67 (PTAB Mar. 30, 2017) .....	<i>passim</i>
<i>Square, Inc. v. Rem Holdings 3, LLC</i> , IPR2014-00312, Paper No. 68 (PTAB Nov. 20, 2015) .....	6
<i>Valeo North America, Inc. v. Magna Elecs., Inc.</i> , IPR2014-00220, Paper No. 61 (PTAB July 14, 2015) .....	6

Pursuant to 37 C.F.R. § 42.71(d), Petitioner respectfully requests Rehearing of the Board's decision that the evidence did not show claim 6 of U.S. Patent No. 8,099,823 (the "'823 Patent"; Ex. 1001) to be unpatentable. *See* Final Written Decision (Paper No. 70) at 36 (the "'823 Decision"). The Board held the *exact opposite* with respect to the *exact same claim limitation* challenged on the *exact same grounds* in a related proceeding involving the parent patent. *See* Final Written Decision, *Costco Wholesale Corp. v. Robert Bosch LLC*, IPR2016-00040, Paper No. 67 (PTAB March 30, 2017) (the "'264 Decision").<sup>1</sup> The '823 Decision overlooked Petitioner's evidence and, in any event, is precluded by the '264 Decision.

## **I. STATEMENT OF PRECISE RELIEF REQUESTED**

Petitioner requests that the Board grant Rehearing of the '823 Decision as to claim 6 and amend its Final Written Decision to hold claim 6 unpatentable for the same reasons articulated in the '264 Decision.

## **II. REASONS FOR THE RELIEF REQUESTED**

The '823 Patent shares a specification with, and claims priority to, U.S. Patent No. 7,484,264 (the "'264 Patent"). The '823 and '264 Patents each disclose and claim the substantially same windshield wiper assembly, comprising three

---

<sup>1</sup> Hereafter, any citation beginning with "'264," *e.g.*, "'264 Petition," including any associated Paper Number, refers to a filing in IPR2016-00040; any citation beginning with "'823" refers to a filing in IPR2016-00041.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.