

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 OPPOSITION TO PATENT OWNER'S MOTION  
FILED PURSUANT TO PAPER NO. 67**

**TABLE OF AUTHORITIES**

<b><u>Cases</u></b>	<b><u>Page(s)</u></b>
<i>Aqua Marine Supply v. AIM Machining, Inc.</i> , 247 F.3d 1216 (Fed. Cir. 2001) .....	6
<i>Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.</i> , 324 U.S. 806 (1945).....	9
<i>In re Robert Bosch LLC</i> , No. 17-2239 (Fed. Cir. Sept. 18, 2017) .....	1, 6, 7
<i>Robert Bosch LLC v. Pylon Mfg. Corp.</i> , No. 08-542-SLR (D. Del. Apr. 23, 2010), <i>vacated per stipulation</i> , No. 08-542-SLR (D. Del. October 31, 2013). .....	9
<i>U.S. Bancorp Mortgage Co. v. Bonner Mall Partnership</i> , 513 U.S. 18 (1994).....	5, 6, 8
 <b><u>Statutes and Rules</u></b>	
35 U.S.C. § 141(c) .....	3
35 U.S.C. § 143 .....	6
35 U.S.C. § 317(a) .....	4, 5, 8
35 U.S.C. § 318(b) .....	2, 8
35 U.S.C. § 319 .....	3
35 U.S.C. § 327(a) .....	4
37 C.F.R. § 42.5(a).....	7
37 C.F.R. § 42.74 .....	3

**TABLE OF AUTHORITIES**

<b><u>Administrative Decisions</u></b>	<b><u>Page(s)</u></b>
<i>Costco Wholesale Corp. v. Robert Bosch LLC</i> , IPR2016-00040, Paper No. 67 (PTAB Mar. 30, 2017).....	1
<i>Salesforce.com v. VirtualAgility, Inc.</i> , CBM2013-00024, Paper No. 52 (PTAB Nov. 24, 2014).....	4

On April 25, 2016, on Petition of Costco Wholesale Corporation (“Costco” or “Petitioner”), the Board instituted *inter partes* review of claims 1, 6, 9, and 10 of U.S. Patent No. 8,099,823 (the “823 Patent”; Ex. 1001). See Paper No. 20. On April 12, 2017, the Board issued a Final Written Decision holding claims 1, 9, and 10 to be unpatentable, but finding that Petitioner did not show claim 6 to be unpatentable. Paper No. 70 at 36. On May 12, 2017, Petitioner requested rehearing of the Board’s decision as to claim 6 because the Board had 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 Paper No. 71; see also Final Written Decision, *Costco Wholesale Corp. v. Robert Bosch LLC*, IPR2016-00040, Paper No. 67 (PTAB Mar. 30, 2017).

Patent Owner subsequently filed appeals from this Board’s Final Written Decisions entered in all six parallel *inter partes* review proceedings, including this proceeding. The appeal from IPR2016-00034 (Appeal No. 2017-2239) is currently active and pending before the Federal Circuit, with opening briefs due October 6, 2017<sup>1</sup>; the appeals from IPR2016-00036, IPR2016-00038, IPR2016-00039,

---

<sup>1</sup> Patent Owner has moved to stay this appeal or alternatively to extend the deadline for opening briefs. Motion of Appellant to Stay Appeal, *In re Robert Bosch LLC*, No. 17-2239 (Fed. Cir. Sept. 13, 2017), Dkt. 22.

IPR2016-00041

PETITIONER'S OPPOSITION TO MOTION FILED PURSUANT TO PAPER NO. 67

IPR2016-00040 have been consolidated into Appeal No. 2017-2122 and are stayed pending the Board's decision on Petitioner's Request for Rehearing in this proceeding; and all that remains to be done in order to terminate the instant proceeding, IPR2016-00041, is for the Board to render a decision on Petitioner's Request for Rehearing. *See* Paper No. 73.

Notwithstanding that Patent Owner has taken an appeal (or sought to take an appeal, *see* Paper No. 73) from these proceedings, Patent Owner now moves to vacate the Final Written Decision in this proceeding based on what it calls "Costco's abandonment of the contest." Paper No. 75 at 1.<sup>2</sup> But circumventing the appellate process is not the appropriate mechanism for avoiding this Board's reasoned judgments.<sup>3</sup>

---

<sup>2</sup> Patent Owner incongruously uses the word "terminate" to characterize two other forms of relief in the alternative: (i) non-issuance of "any certificate cancelling claims is issued pursuant to 35 U.S.C. § 318(b)" and (ii) entry of "adverse judgment against Costco." Paper No. 75 at 1–2.

<sup>3</sup> Although the Board specifically denied authorization for similar motions in the parallel proceedings (*see* Paper No. 74), Patent Owner has indicated that it will file such motions if the Board later grants authorization to do so. Paper No. 75 at 1 n.1. The Board recognized that it may perform only "purely ministerial functions"

# 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.