

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 B2

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

SAINDON, *Administrative Patent Judge*.

DECISION ON REHEARING

Denying Petitioner's Request for Rehearing in IPR2016-00041
37 C.F.R. § 42.71(d)

I. BACKGROUND

Petitioner filed a request for rehearing (Paper 71, “Req. Reh’g” or “Request”) in IPR2016-00041 of our Final Written Decision (Paper 70, “the ’823 Final Dec.”) in which we determined that claims 1, 9, and 10 of U.S. Patent No. 8,099,823 (Ex. 1001, “the ’823 patent”) were unpatentable but that claim 6 of the ’823 patent was not unpatentable. In its Request, Petitioner asserts that claim 6 of the ’823 patent is similar in scope to claim 3 of U.S. Patent No. 7,484,264 (Ex. 1011, “the ’264 patent”), which we determined was unpatentable in our Final Written Decision in IPR2016-00040 (IPR2016-00040, Paper 67, “the ’264 Final Dec.”). Req. Reh’g 1. Petitioner asserts that our conclusions with respect to claim 6 of the ’823 patent and claim 3 of the ’264 patent are “irreconcilable” because those claims involve “the same prior art; the same expert testimony; [and] the same arguments.” *Id.* at 5.

II. LEGAL STANDARD

The Rule governing requests for rehearing provides that “[t]he burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). Further, “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

III. ANALYSIS

We have reviewed Petitioner’s arguments and our Final Written Decisions with respect to the ’264 patent and the ’823 patent, and we agree

that the results are mutually exclusive. In order to consider whether our decisions in IPR2016-00041 and IPR2016-00040 are irreconcilable, we must, of course, consider both decisions. For the reasons expressed below, we are persuaded that our analysis of the evidence was correct in the '823 Final Decision.¹

Claim 6 of the '823 patent and claim 3 of the '264 patent both require the wind deflection strip (i.e., spoiler) of a windshield wiper to be “designed as a binary component”² that has claw-shaped extensions (for holding onto the beam of the wiper) “made of a harder material” than the upper portion (which deflects wind). *See, e.g.*, '823 Final Dec., 4 (reproducing Figure 2 of the '823 patent with added green coloring to denote the spoiler, and with item 56 indicating a claw-shaped extension and item 46 indicating the base point of the upper portion). As we explained in the '823 Final Decision, and which is not disputed in the Request, we considered a “binary component” “to be a structure wherein the portions having different hardness values are not separable.” '823 Final Dec. 22.

All of the grounds asserted against claim 6 of the '823 patent and claim 3 of the '264 patent effectively rely on Prohaska (Ex. 1005) to teach a spoiler having claw-shaped extensions. *See* '823 Final Dec. 16–17; '264 Final Dec. 15–16. The proposed modification to address the “binary component” limitation is to modify Prohaska’s spoiler in view of Kotlarski '090 (Ex. 1021) or Mathues (Ex. 1019). *See* '823 Final Dec. 14–15; '264

¹ IPR2016-00040 is presently on appeal to the Court of Appeals for the Federal Circuit.

² Claim 6 of the '823 patent depends from claim 5; our quotes here are limitations present in claim 6 by virtue of dependence from claim 5.

Final Dec. 33; *see also* IPR2016-00040, Paper 1, 3 (identifying Mathues or Kotlarski '090 for claim 3 of the '264 patent). Kotlarski '090 describes the spoiler and the spoiler retaining components as separate structures made of separate materials. '823 Final Dec. 14–15. Mathues describes a binary component, that component made of a retaining portion and a wiper blade. *Id.* at 15. Petitioner's Request does not allege a misapprehension with respect to those facts.

In the '823 Final Decision with respect to Kotlarski '090, we determined that Petitioner failed to provide “an explanation for why it would have been obvious to combine the two separate components in Kotlarski '090 into a single component.” '823 Final Dec. 22. In its Request, Petitioner asserts that we overlooked the explanation by its expert that “[e]ach part of the ‘binary component’ performs the same function in the same way as the distinct components of Kotlarski '090.” Req. Reh'g 10 (citing Ex. 1014 ¶ 74). But pointing out that Kotlarski '090 and claim 6 of the '823 patent both have a spoiler for displacing air and claws for retention fails to account for the fact that they are configured to do so in different ways. Claim 6 requires a binary component having portions with different hardness values, where the wind deflection portion and the claws are integrated into a single piece (*see, e.g.*, Ex. 1001, Figs. 1, 2 (depicting the claw as the lower portion of the spoiler, uniform along the length of the wiper)), whereas Kotlarski '090 has separate retaining clips, longitudinally spaced apart in intervals, that have a similar profile as the wind deflection portion (*see, e.g.*, Ex. 1021, Figs. 5–15 (depicting various embodiments of spoiler/clip combos, with blowouts showing just the separate clips)). This is not a simple matter of making two things one; somehow fusing the clips and

wind deflection portion together of Kotlarski '090 would not meet the requirement of claim 6 where the claw area is harder than the wind deflection portion, because the clips in Kotlarski '090 are hard from claw to tip (i.e., through the wind deflection portion). *See, e.g.*, Ex. 1021, Figs. 5, 6 (depicting the clip and a cross-section of the clip as made of a uniform material). We emphasize that Kotlarski '090's clips are separate components from the spoiler, are of uniform hardness (all plastic), and are not harder at the claws. Petitioner's expert's testimony that the wind deflection portion and the claws perform the same function in the same way is an oversimplification and does not address this significant distinction.

Further, Petitioner has not directed us to, nor do we see, any direct application of the teachings of Kotlarski '090 for modifying the Prohaska spoiler to have harder claws. The Prohaska spoiler is similar to the spoiler in the '823 patent, in that the claws are on the spoiler. Kotlarski '090 is different—it teaches separate clips. It does not teach making the claws of a spoiler harder. To apply the teachings of Kotlarski '090 to Prohaska's spoiler in one of the articulated grounds would not satisfy the claims; it would require a further modification than what is shown in Kotlarski '090 or explained in the Petition in order for the claw portion to be harder than the wind deflection portion. Petitioner argues that Prohaska already teaches a “binary component,” Req. Reh'g 10–12, but this argument is untenable in view of our understanding of the term. *See* '823 Final Dec. 22 (explaining that the claim requires a binary component to be made of a *single structure* having different hardness values). Reviewing the Request, we are not persuaded we misapprehended or overlooked Petitioner's arguments or evidence regarding the ground asserted against claim 6 of the '823 patent

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