

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 ORAL ARGUMENT
PURSUANT TO 37 C.F.R. § 42.70**

IPR2016-00041

PETITIONER'S REQUEST FOR ORAL ARGUMENT

Pursuant to 37 C.F.R. § 42.70(a) and the Board's Scheduling Order (Paper No. 21), Costco Wholesale Corporation ("Petitioner") hereby submits its Request for Oral Argument. The Board has already scheduled oral argument for January 18, 2017. Scheduling Order (Paper No. 21) at 7. The Board also scheduled a hearing on the same date in the related IPR2016-00039 proceeding, which involves U.S. Patent No. 7,228,588 (the "'588 Patent"), and the related IPR2016-00040 proceeding, which involves U.S. Patent No. 7,484,264 (the "'264 Patent"). The '264 Patent is a division of the same application that resulted in the '588 Patent, and U.S. Patent No. 8,099,823 (the "'823 Patent"), at issue in this proceeding, is a division of the same application that resulted in the '264 Patent. The '823 Patent, the '588 Patent, and the '264 Patent are directed to similar subject matter and thus, the trials will involve overlapping issues and arguments. Accordingly, Petitioner respectfully requests that the Board consolidate oral argument for IPR2016-00041, IPR2016-00039, and IPR2016-00040.

Petitioner believes that one hour of argument time, including any time reserved for rebuttal argument, will be sufficient to cover the issues related to these three proceedings. Petitioner also requests permission to use audio-visual equipment to display possible demonstrative exhibits.

Pursuant to 37 C.F.R. § 42.70(a), Petitioner specifies the following issues to be argued:

1. The grounds on which the instant *inter partes* review proceeding was instituted, namely the unpatentability of claims 1, 9, and 10 over Prohaska, and Appel or Hoyler; the unpatentability of claims 1, 9, and 10 over Kotlarski '383 or Merkel, and Prohaska; the unpatentability of claim 6 over Prohaska, Appel or Hoyler, and Kotlarski '090 or Mathues; and, the unpatentability of claim 6 over Kotlarski '383 or Merkel, Prohaska, and Kotlarski '090 or Mathues. This may include, for example, the level of ordinary skill in the art of the '823 Patent.
2. Any issues specified by Patent Owner in a Request for Oral Argument;
3. Any issues identified by either party in connection with Patent Owner's list of allegedly improper reply arguments and Petitioner's response;
4. Any issues specified in any motions to exclude, motions to strike, or motions for observation on cross-examination filed by the parties; and
5. Any issues that the Board deems necessary for issuing a final written decision or that are otherwise raised by the Board.

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Dated: December 13, 2016

Respectfully Submitted,

/Stefanie M. Lopatkin/
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CERTIFICATE OF SERVICE

I hereby certify that on this 13th day of December, 2016, the foregoing Petitioner's Request for Oral Argument Pursuant to 37 C.F.R. § 42.70 was served in its entirety by email on the attorneys of record for Patent Owner:

- Patrick R. Colsher (patrick.colsher@shearman.com)
- Mark Hannemann (mark.hannemann@shearman.com)
- Joseph Purcell (joseph.purcell@shearman.com)

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