UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTCO WHOLESALE CORPORATION,

Petitioner,

v.

ROBERT BOSCH LLC,

Patent Owner.

CASE NO. IPR2016-00042

U.S. Patent No. 8,544,136

PATENT OWNER'S UPDATED MANDATORY NOTICES

**PURSUANT TO 37 C.F.R. § 42.8** 

### Updated Mandatory Notices Pursuant to 37 C.F.R. § 42.8

Patent Owner Robert Bosch LLC hereby files these Updated Mandatory Notices, pursuant to 37 C.F.R. § 42.8, with updated contact information for Practitioner Enrique W. Iturralde, whom Patent Owner previously moved to appoint as lead counsel.

### I. REAL PARTY-IN-INTEREST

Patent Owner identifies the real party-in-interest as Robert Bosch LLC. Robert Bosch North America Corp. and Robert Bosch GmbH are parent companies of Robert Bosch LLC.

#### **II. RELATED MATTERS**

The following judicial matter, in which U.S. Patent No. 8,544,136 is at issue, may affect or be affected by a decision in this proceeding: Robert Bosch LLC v. Alberee Products Inc. et al., Civil Action No. 12-574-LPS, currently pending in the United States District Court for the District of Delaware (consolidated with Civil Action No. 14-142-LPS (D. Del.)) ("Bosch-Alberee lawsuit").

Patent Owner notes that Petitioner has filed petitions for *inter partes* review of the following additional patents that Patent Owner owns and has asserted against Petitioner in the pending Bosch-Alberee lawsuit: U.S. Patent Nos. 6,973,698 (IPR2016-00034), 6,836,926 (IPR2016-00035), 6,944,905 (IPR2016CASE NO. IPR2016-00042 U.S. Patent No. 8,544,136 00036), 6,292,974 (IPR2016-00038), 7,228,588 (IPR2016-00039), 7,484,264 (IPR2016-00040), and 8,099,823 (IPR2016-00041).

## III. LEAD AND BACK-UP COUNSEL

Patent Owner identifies Practitioner Enrique W. Iturralde as its lead counsel.

Mr. Iturralde's contact information is:

Enrique W. Iturralde, USPTO Reg. No. 72,883 SHEARMAN & STERLING LLP 599 Lexington Ave New York, NY 10022 Tel: (212) 848-7707 Fax: (646) 848-7707 enrique.iturralde@shearman.com

On January 4, 2016, the Board granted Patent Owner's motion for pro hac

vice admission of Mark A. Hannemann and authorized Mr. Hannemann to appear

in this proceeding. Patent owner designates Mr. Hannemann as back-up counsel.

Mr. Hannemann's contact information is:

Mark A. Hannemann mark.hannemann@shearman.com Shearman & Sterling LLP 599 Lexington Avenue New York, NY 10022-6069 Tel.: (212) 848-4000 Fax: (646) 848-7696

# **IV. SERVICE INFORMATION**

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Patent Owner identifies the following service information.

## CASE NO. IPR2016-00042 U.S. Patent No. 8,544,136 Postal & Hand-Delivery Address, Phone & Facsimile Numbers:

Enrique W. Iturralde enrique.iturralde@shearman.com SHEARMAN & STERLING LLP 599 Lexington Ave New York, NY 10022 Tel: (212) 848-7707 Fax: (646) 848-7707

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Patent Owner consents to service by electronic mail.

Electronic Mail Addresses:

enrique.iturralde@shearman.com mark.hannemann@shearman.com

DATED: January 20, 2016

DOCKE.

Respectfully submitted,

Shearman & Sterling LLP

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Agent for Patent Owner Robert Bosch LLC

# **Certificate of Service**

The undersigned hereby certifies that the foregoing PATENT OWNER'S

UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8 was

served via electronic mail on January 20, 2016, on the following counsel for

Petitioner:

Richard M. Koehl (richard.koehl@hugheshubbard.com) James R. Klaiber (james.klaiber@hugheshubbard.com) David E. Lansky (david.lansky@ hugheshubbard.com)

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