

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTCO WHOLESALE CORPORATION
Petitioner,

v.

ROBERT BOSCH LLC,
Patent Owner.

Case IPR2016-00042
Patent 8,544,136

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

SAINDON, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner requests an *inter partes* review of claims 1 and 21 of U.S. Patent No. 8,544,136 (Ex. 1001, “the 136 patent”). Paper 10 (“Pet.”). Patent Owner filed a Preliminary Response to the Petition. Paper 21 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition and Patent Owner’s Preliminary Response, we do not institute an *inter partes* review of the ’136 patent.

A. Related Matters

The parties represent that the ’136 patent is asserted in *Robert Bosch LLC v. Albersee Products Inc. et al.*, cv-12-574-LPS (D. Del) (consolidated with cv-14-142-LPS). Pet. 1; Paper 5, 1. In addition, Petitioner has filed petitions against several other of Patent Owner’s patents related to windshield wiper technology: U.S. Patent Nos. 6,973,698 (IPR2016-00034), 6,836,926 (IPR2016-00035), 6,944,905 (IPR2016-00036), 6,292,974 (IPR2016-00038), 7,228,588 (IPR2016-00039), 7,484,264 (IPR2016-00040), and 8,099,823 (IPR2016-00041). Pet. 1; Paper 5, 1.

B. The ’136 Patent

The ’136 patent is directed to an automobile windshield wiper blade. Ex. 1001, Abstract. The wiper is made of three main components: elastic rubber wiper strip 24, resilient support element 12, and wind deflection strip

42. *Id.* These three components are illustrated in Figure 2 of the '136 patent, reproduced below with added coloration.

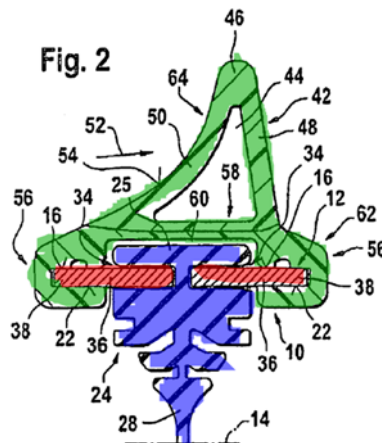


Figure 2 of the '136 patent depicts a cross-sectional view of a windshield wiper blade embodiment, with elastic rubber wiper strip 24 highlighted in blue, resilient support element 12 in red, and wind deflection strip 42 in green. As shown in Figure 2 of the '136 patent, wind deflection strip 42 has two sides (48, 50) that diverge from common point 46, such that, in conjunction with wall 58, wind deflection strip 42 is generally triangular in cross section and has a hollow interior.

C. Challenged Claims

Petitioner challenges claims 1 and 21, both of which are independent. Claims 1 and 21 are similar in scope and the differences between them do not affect the outcome in this Decision. Claim 1 is reproduced below for reference.

1. A wiper blade (10) for an automobile windshield (14), with an elongated belt-shaped, flexible resilient support element (12) having a longitudinal axis, on a lower belt surface (22) of which that faces the windshield is located an elastic rubber wiper strip (24) sitting against the windshield that extends parallel to the longitudinal axis, and on an upper belt

surface (16) of which a wind deflection strip (42 or 112) is located that has an incident surface (54 or 140) facing a main flow direction of a driving wind (arrow 52), said deflection strip extending in the longitudinal direction of the support element, characterized in that the wind deflection strip has two sides (48, 50 or 136, 138) that diverge from a common base point (46 or 134) as seen in a cross section, and that the incident surface (54 or 140) is located at the exterior of one side (50 or 138), wherein the support element has outer edges, wherein the sides of the wind deflection strip have respective free ends having thereon respective claw-shaped extensions that fittingly grip around the outer edges of the support element at least in sections and engage at least one of the upper belt surface (24) and the lower belt surface (22), so that the wind deflection strip can be snapped onto the outer edges or slid onto the outer edges in a longitudinal direction, wherein the wind deflection strip has a height extending from the base point to ends of the sides farthest from the base point, wherein a substantial majority of the height is above the upper belt surface in a direction facing away from the windshield, and characterized in that the wind deflection strip is designed as a binary component whose longitudinal area provided with the claw-shaped extensions is made of a harder material than a longitudinal area lying closer to the base point.

D. Prior Art and Asserted Grounds

Petitioner asserts that claims 1 and 21 of the '136 patent are unpatentable on the following grounds:

Reference(s)	Basis	Claim(s) Challenged
Hoyler, ¹ Lumsden, ² and Kotlarski '090 ³ or Mathues ⁴	§ 103	1
Merkel, ⁵ Lumsden, and Kotlarski '090 or Mathues	§ 103	1
Kotlarski '383, ⁶ Lumsden, and Kotlarski '090 or Mathues	§ 103	1
Hoyler and Lumsden	§ 103	21
Merkel and Lumsden	§ 103	21
Kotlarski '383 and Lumsden	§ 103	21

Petitioner also relies on the declaration of Gregory W. Davis, Ph.D. (Ex. 1026).

¹ German Patent No. 1,028,896, published April 24, 1958 (Ex. 1006). The English translation begins at page 5.

² U.K. Patent App. GB 2 346 318 A, published August 9, 2000 (Ex. 1025).

³ PCT WO00/34090, published June 15, 2000 (Ex. 1018). Petitioner instead cites to Exhibit 1020, U.S. Patent 6,523,218, which issued from the PCT application in Exhibit 1018, because the PCT “does not include reference numbers for line citations, and because it encompasses the same subject matter.” Pet. 17, n.5. (Ex. 1018).

⁴ U.S. Patent No. 3,121,133, issued February 11, 1964 (Ex. 1017).

⁵ PCT WO 99/12784, published March 18, 1999 (Ex. 1007). Petitioner instead cites to Exhibit 1022, U.S. Patent 6,295,690, which issued from the PCT application in Exhibit 1022, for the same reasons as explained in *supra* note 3. Pet. 15, n.4.

⁶ PCT WO 99/02383, published January 21, 1999 (Ex. 1004). Petitioner instead cites to Exhibit 1021, U.S. Patent 6,279,191, which issued from the PCT application in Exhibit 1004, for the same reasons as explained in *supra* note 3. Pet. 14, n.3.

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