

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

**PETITIONER'S REQUEST FOR REHEARING OF
DECISION DENYING INSTITUTION OF *INTER PARTES* REVIEW OF
U.S. PATENT NO. 8,544,136**

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Costco Wholesale Corporation (“Petitioner”) respectfully requests rehearing of the Board’s decision dated April 25, 2016 (Paper No. 22; the “Decision”), which denied institution of *Inter Partes* Review of claims 1 and 21 of U.S. Patent No. 8,544,136 (the “’136 Patent”; Exhibit 1001).

STATEMENT OF RELIEF SOUGHT

Petitioner requests that the Board institute *Inter Partes* review of claims 1 and 21 of the ’136 Patent and consolidate this case for trial with IPR2016-00039, IPR2016-00040, and IPR2016-00041 (the “Related Cases”).

REASONS FOR THE RELIEF REQUESTED

This case involves a patent that is a direct descendant of the patents involved in the Related Cases. The challenged claims here are very similar to the claims at issue in the Related Cases. The prior art combinations asserted here are very similar to the prior art combinations at issue in the Related Cases. The Scheduling Orders issued in the Related Cases refer to this IPR2016-00042 as if the three cases (and two other similar cases) were going to be instituted together. And the interests of justice clearly support having this Board, rather than a lay jury in parallel litigation, decide the questions of patentability raised here, especially in view of the close parallel between this case and the Related Cases.

In IPR2016-00039, the Board instituted *Inter Partes* Review with respect to six grounds of unpatentability, including claim 1 of U.S. Patent No. 7,228,588 (the

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“’588 Patent”; Exhibit 1009 at 1-9) as unpatentable under 35 U.S.C. § 103(a) (2006) over Merkel (Exhibit 1007) and Prohaska (Exhibit 1003). Claim 1 of the ’588 Patent recites a wiper assembly comprising a flat spring support element and a hollow wind deflection strip, as do the challenged claims here.

In IPR2016-00040, the Board instituted *Inter Partes* Review with respect to six grounds of unpatentability, including claim 1 of U.S. Patent No. 7,484,264 (the “’264 Patent”; Exhibit 1010 at 1-8) as unpatentable under 35 U.S.C. § 103(a) (2006) over Merkel (Exhibit 1007) and Prohaska (Exhibit 1003). Claim 1 of the ’264 Patent recites a wiper assembly comprising a flat spring support element and a hollow wind deflection strip, as do the challenged claims here.

In IPR2016-00041, the Board instituted *Inter Partes* Review with respect to four grounds of unpatentability, including claim 1 of U.S. Patent No. 8,099,823 (the “’823 Patent”; Exhibit 1011 at 1-8) as unpatentable under 35 U.S.C. § 103(a) (2006) over Merkel (Exhibit 1007) and Prohaska (Exhibit 1003). Claim 1 of the ’823 Patent recites a wiper assembly comprising a flat spring support element and a hollow wind deflection strip, as do the challenged claims here.

The petitions in IPR2016-00039, IPR2016-0040, and IPR2016-0041 are each supported by the same Declarations of Dr. Eric H. Maslen (“Maslen Decl.”; Exhibit 1016), and Dr. Gregory W. Davis (“Davis Decl.”; Exhibit 1026) as is the Petition here.

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