

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**

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

Patent Owner Robert Bosch LLC hereby files these Mandatory Notices, pursuant to 37 C.F.R. § 42.8, with updated law firm affiliation and contact information for Mark A. Hannemann, whom Patent Owner previously moved to admit *pro hac vice* as back-up 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

(IPR2016-00036), 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 Eric Schreiber as its lead counsel:

Eric T. Schreiber, USPTO Reg. No. 58,771
eschreiber@kenyon.com
KENYON & KENYON LLP
One Broadway
New York, NY 10004-1007
Tel.: (212) 425-7200
Fax: (212) 425-5288

On November 2, 2015, Patent Owner filed a motion for *pro hac vice* admission of Mark A. Hannemann. Patent Owner designates Mr. Hannemann as back-up counsel subject to the Board granting Patent Owner's motion and authorizing Mr. Hannemann to appear in this proceeding.

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

Patent Owner identifies the following service information.

Postal & Hand-Delivery Address, Phone & Facsimile Numbers:

Eric T. Schreiber
eschreiber@kenyon.com
KENYON & KENYON LLP
One Broadway
New York, NY 10004-1007
Tel.: (212) 425-7200
Fax: (212) 425-5288

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

Patent Owner consents to service by electronic mail.

Electronic Mail Addresses:

eschreiber@kenyon.com
mark.hannemann@shearman.com

DATED: November 30, 2015

Respectfully submitted,

KENYON & KENYON LLP

/Eric T. Schreiber/
Eric T. Schreiber
Reg. No. 58,771
KENYON & KENYON LLP
One Broadway
New York, NY 10004-1007
Tel: (212) 425-7200

Counsel 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 November 30, 2015, 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)

/Eric T. Schreiber/
Eric T. Schreiber
Reg. No. 58,771
KENYON & KENYON LLP
One Broadway
New York, NY 10004-1007
Tel: (212) 425-7200

Counsel for Patent Owner
Robert Bosch LLC