

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 Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

A. Introduction

Petitioner requested an *inter partes* review of claims 1 and 21 of U.S. Patent No. 8,544,136 (Ex. 1001, “the 136 patent”). Paper 10 (“Petition” or “Pet.”). We denied Petitioner’s Petition and did not institute an *inter partes* review. Paper 22 (“Decision” or “Dec.”). Petitioner filed a Request for Rehearing of our Decision. Paper 23 (“Request” or “Req.”).

B. Applicable Legal Standard

Under 37 C.F.R. § 42.71(c), we review decisions on petitions “for an abuse of discretion.” The burden of showing a decision should be modified lies with the requesting party, who must “specifically identify all matters the party believes the Board misapprehended or overlooked.” *Id.* § 42.71(d).

C. Overview of Our Decision

In our Decision, we determined that a dispositive issue was whether Petitioner had shown in the prior art the claim requirement that “the wiper . . . be on the lower surface of the support element.” Dec. 6. We noted Petitioner asserted that beneath Lumsden’s reinforcing elements was a wiper blade. *Id.* (citing Pet. 23). Notably, the portion of the Petition we cited shows that Petitioner relies solely on Lumsden for showing the claimed support element. *See* Pet. 23. We then noted that “Lumsden does not appear to describe the claimed relationship between the lower surface of the support element and the wiper.” Dec. 7. Specifically, the claim required the wiper to be “on” the lower surface of the support element, which Petitioner asserted was reinforcing elements 8, 10 of Lumsden, but the wiper could not be “on” the reinforcing elements because flanges 24 and 26 were

intervening. *Id.* We noted that Petitioner failed to give a claim construction that would support characterizing “on” in this fashion. *Id.*

We then further noted that Petitioner’s proposed combination was to take the spoiler of Lumsden with the support element of Hoyler. Dec. 7 (citing Pet. 39). However, as we stated above, Petitioner only relied on *Lumsden* to describe the support element, not Hoyler, such that Petitioner’s analysis was inconsistent. *See* Pet. 23. We then noted that further modifications were required of the prior art to meet the particular relationship between the support element and the wiper, and that Petitioner had not set forth a sufficient explanation of this. Dec. 8. Accordingly, the proposed combination was not clear, as the support element limitation was not addressed sufficiently.

D. Petitioner’s Assertions

Petitioner asserts that we “misapprehended Petitioner’s stated grounds of unpatentability.” Req. 5. Petitioner asserts that it “does not rely on *Lumsden* to teach a *support element*.” *Id.*; *id.* at 7–10. Petitioner fails to persuade us we misapprehended its claim chart, however, which only relies on *Lumsden* to teach the support element. Pet. 23; *see also* Req. 8–9 (discussing the claim chart). To the extent Petitioner argues that we could have chosen elements from the asserted prior art in a manner that meets the claims, or that we could have selectively read Petitioner’s Petition in a manner that addresses the claim limitations, we find these arguments unpersuasive. It is not our role to sift through the information provided and determine on our own if there is a reasonable likelihood that the asserted references show unpatentability; it is Petitioner’s role to provide a *specific explanation demonstrating* a reasonable likelihood of such. 37 C.F.R.

§ 42.104(b). In other words, Petitioner must provide in its Petition not only the art, but also the particular rationale and explanation persuasively showing how that art renders the claims unpatentable. Further, even if we were persuaded by similar combinations in other proceedings, those proceedings are not this proceeding and do not relieve Petitioner of its burden to identify the specific challenge. *See id.* §§ 42.104(b), 42.6(a)(3).

Petitioner next asserts that our determination that “Petitioner merely makes an unsupported attorney argument” regarding the proposed modification fails to appreciate fully the declaration of Dr. Davis. Req. 10 (quoting Dec. 8). In particular, Petitioner asserts that the Petition at pages 39 and 44 cite Exhibit 1026, paragraphs 55 and 74. Req. 10. Page 39 contains arguments for why it would have been obvious to combine the Lumsden deflector with the support element of Hoyler. This explanation does not address the specific arrangement required by the claims, however, regarding the claimed “on” relationship between the lower surface of the support element and the wiper. As we explained above, just combining the hollow spoiler with a support element does not necessarily result in the wiper being on the lower surface of the support element (e.g., flanges may intervene). The explanation at page 44 similarly is lacking in specificity, not addressing the particular claimed location of the claws.

Lastly, Petitioner asserts that there are “[i]nstitutional and policy reasons” to grant rehearing, such as avoiding duplicative district court proceedings. Req. 11–12. We are not persuaded here that these reasons outweigh our interest in holding petitioners to the strict standards set forth in 37 C.F.R. § 42.104(b), which facilitates the “just, speedy, and inexpensive” resolution of the proceeding (§ 42.1(b)) by requiring petitioners to bring

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their case-in-chief in the petition and requiring as a component thereof a persuasive and reasoned explanation for how the asserted art renders the claims unpatentable.

E. Order

In view of the foregoing, it is hereby ORDERED that Petitioner's Request for Rehearing of our Decision Denying Inter Partes Review is *denied*.

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