

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COSTCO WHOLESALE CORPORATION,  
Petitioner,

v.

ROBERT BOSCH LLC,  
Patent Owner.

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CASE NO. IPR2016-00034  
U.S. Patent No. 6,973,698

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**PATENT OWNER'S LIST OF IMPROPER REPLY ARGUMENTS,  
PURSUANT TO THE BOARD'S DECEMBER 12 ORDER**

Patent Owner recognizes the Board’s ruling on arguments concerning the Barth reference, but disagrees, and includes the following paragraph in its submission in an effort to explain why, and to illustrate the kinds of issues that are involved with the arguments listed below. Patent Owner joins with Petitioner in requesting briefing on these issues (*see* Ex. 1108 at 33–36).

In the challenged section of its reply in IPR2016-00038, Petitioner argued that the Barth reference—which was not part of any proposed or instituted ground of unpatentability—taught that wind lift is caused by the rubber wiper strip “common to all wipers” and that Barth’s analysis “applies equally to all wipers . . . regardless of whether they have a flat-spring or conventional-style support structure” (Reply at 5–8). Before the reply was served, Patent Owner had no notice that the Barth reference was alleged to have taught that wind lift is a problem for beam blades. If notice had been given in the petition or in the institution decision, Patent Owner would have contested it in its responsive brief and responsive evidence (for example because Barth teaches only a conventional blade with pressure applied to the wiper strip at four discrete points along the length of the blade, and does not teach that wind lift caused by the wiper strip would be a problem also in beam blades, where the beam applies a nearly uniform pressure along the entire length of the wiper strip, and so the pressure of the wiper

arm, being evenly distributed, would resist wind lift along the entire length of the flexible wiper strip).

Improper Reply Argument 1, found in the Reply at page 20, line 6 (immediately after figures) to page 21, line 3: improper because it presents a new claim construction of “in at least one of said two end sections”—effectively reading it to mean “*at any point* in at least one of said two end sections”—in support of a theory of anticipation not presented in the Petition (which relied on some combination of “the contact Force F ... applied at the center of the wiper blade” and inherent disclosure, *see* pages 45–48).

DATED: December 16, 2016

Respectfully submitted,

Shearman & Sterling LLP

/Patrick R. Colsher/

Patrick R. Colsher (Reg. No. 74,955)

Mark A. Hannemann (*pro hac vice*)

Joseph M. Purcell, Jr. (*pro hac vice*)

599 Lexington Ave

New York, NY 10022

Tel: (212) 848-4000

*Counsel for Patent Owner*

*Robert Bosch LLC*

**Certificate of Service**

The undersigned hereby certifies that the foregoing PATENT OWNER'S LIST OF IMPROPER REPLY ARGUMENTS, PURSUANT TO THE BOARD'S DECEMBER 12 ORDER was served via electronic mail on December 16, 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)  
Stefanie Lopatkin (stefanie.lopatkin@hugheshubbard.com)  
James Dabney (james.dabney@hugheshubbard.com)

/Patrick R. Colsher/  
Patrick R. Colsher  
Reg. No. 74,955  
Shearman & Sterling LLP  
599 Lexington Ave  
New York, NY 10022  
Tel: (212) 848-7708

*Counsel for Patent Owner*  
*Robert Bosch LLC*