

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

**PATENT OWNER'S OBJECTIONS TO PETITIONER'S REPLY
EVIDENCE**

Patent Owner Robert Bosch LLC (“Bosch”) objects to the evidence submitted by Petitioner Costco Wholesale Corp. (“Costco”) on October 24, 2016, with its reply brief as follows:

Bosch objects to Ex. 1100 (Declaration of David Peck) under Fed. R. Evid. 401 and 701–02 and 42.23(b). Paragraphs 5–26 of Ex. 1100 constitute unqualified expert testimony (Fed. R. Evid. 702) because Costco has not established Mr. Peck as an expert to opine on the thinking of a person of ordinary skill in the art at the time of the invention, or the applicability of any secondary considerations, and constitute improper lay opinion testimony (Fed. R. Evid. 701) because the opinions offered by Mr. Peck are based on “scientific, technical, or other specialized knowledge within the scope of Rule 702.” Costco further has failed to provide the requisite disclosures required by Fed. R. Civ. P. 26(a)(2)(B). Paragraphs 5–13, 14, 17, and 21–26 of Ex. 1100 constitute material outside the proper scope of a reply (37 C.F.R. § 42.23(b)) because they do not respond to arguments in Bosch’s patent owner response and because they add to or modify the grounds and evidence of alleged unpatentability asserted in Costco’s petition and instituted by the Board and present evidence that should have been presented with Costco’s petition (35 U.S.C. § 312), for example, by asserting additional prior art, evidence, and reasons that someone would have been motivated to modify or combine elements of the

prior art. This evidence should have been presented in Costco's petition. Because these paragraphs fall outside the scope of a proper reply, and further because they are presented from the perspective of a single artisan rather than a person of ordinary skill in the art, they are irrelevant (Fed. R. Evid. 401). To whatever extent Ex. 1100, or the portions of Costco's reply that rely on it, may be considered supplemental information, it is untimely and improperly submitted under 37 C.F.R. § 42.123, for example, because it expands the scope of the grounds upon which *inter partes* review was instituted.

Bosch objects to Ex. 1103 (Second Declaration of Dr. Gregory W. Davis) under Fed. R. Evid. 401 and 42.23(b). Paragraphs 8–27 of Ex. 1103 constitute material outside the proper scope of a reply (37 C.F.R. § 42.23(b)) because they do not respond to arguments in Bosch's patent owner response and because they add to or modify the grounds and evidence of alleged unpatentability asserted in Costco's petition and instituted by the Board and present evidence that should have been presented with Costco's petition (35 U.S.C. § 312), for example, by asserting how a person of ordinary skill in the art would understand the prior art relied upon by Costco in its petition and by asserting additional prior art, evidence, and reasons that someone would have been motivated to modify or combine elements of the prior art. Costco's petition relied upon (i) the incorporation by reference of Appel '551 into Appel '770, (ii) the combination of Arai and Appel '770, and

(iii) Swanepoel's alleged teaching of the elements of the challenged claims.

Costco should have submitted any evidence in support of these positions with its petition. Just as these paragraphs fall outside the scope of a proper reply and add to the issues that should have been presented in the petition, they are irrelevant to the issues properly part of this proceeding (Fed. R. Evid. 401). To whatever extent Ex. 1103, or the portions of Costco's reply that rely upon it, may be considered supplemental information, it is untimely and improperly submitted under 37 C.F.R. § 42.123, for example because it expands the scope of the grounds upon which *inter partes* review was instituted.

DATED: October 31, 2016

Respectfully submitted,

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Certificate of Service

The undersigned hereby certifies that the foregoing PATENT OWNER'S
OBJECTIONS TO PETITIONER'S REPLY EVIDENCE was served via
electronic mail on October 31, 2016, on the following counsel for Petitioner:

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