

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTCO WHOLESALE CORP.,
Petitioner,

v.

ROBERT BOSCH LLC,
Patent Owner.

Cases

IPR2016-00034 (Patent 6,973,698 B1)
IPR2016-00036 (Patent 6,944,905 B2)
IPR2016-00038 (Patent 6,292,974 B1)
IPR2016-00039 (Patent 7,228,588 B2)
IPR2016-00040 (Patent 7,484,264 B2)
IPR2016-00041 (Patent 8,099,823 B2)

Before PHILLIP J. KAUFFMAN, WILLIAM V. SAINDON,
and BARRY L. GROSSMAN, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

ORDER

Authorizing Patent Owner to File a List of Reply
Arguments It Considers Improper

Authorizing Petitioner to File a Response

37 C.F.R. §§ 42.5

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Patent Owner requested a conference call to discuss what it believed were improper arguments and evidence in Petitioner's Reply. Patent Owner was asked to provide Petitioner and the panel a list of several items it believed were representative. A conference call was then held on December 9, 2016. A court reporter provided by Petitioner transcribed the conference. Petitioner will file and serve a copy of the transcript. We will first discuss a procedure for Patent Owner to bring to our attention those arguments it considers new, with an opportunity for Petitioner to respond. We will then discuss a particular argument Patent Owner alleges was new that was addressed during the conference call.

Opportunity to Identify Allegedly New Arguments

During the call, we asked Patent Owner if an opportunity to provide a list of citations to portions of the Reply, along with a brief explanation, would address its concern that the Reply raises new issues. Patent Owner represented that it would. Petitioner objected, and asked instead for full briefing on the issue. Patent Owner indicated that it did not wish to pursue further briefing, in the interests of costs and finality of briefing.

We have considered the positions of the parties and determine that the following procedure serves the just, speedy, and inexpensive resolution of this proceeding. First, Patent Owner may file, in each above-identified proceeding, a numbered list of citations, with brief explanations (akin to a motion for observation), to those passages in the reply briefs it believes

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contain improper arguments.¹ Patent Owner's lists will be filed as papers and will be called "Patent Owner's List of Improper Reply Arguments." Then, Petitioner may respond to each item and cite to where the argument in the Reply is supported by the theory of unpatentability expressed in the Petition and/or is in response to an argument raised by Patent Owner in its Response, with brief explanations (again, akin to a motion for observation). In the event our Final Written Decision does not rely on a passage included in Patent Owner's list, then we will make no comment as to whether that passage is proper. In the event that our Final Written Decision relies on a passage included in Patent Owner's list, we will set forth our analysis why that passage does not contain an improper argument.

Alleged New Argument Discussed During Conference Call

During the call, we discussed Patent Owner's leading example of where it believed Petitioner had included improper material in its Reply. We

¹ For purposes of this paper, an improper argument is an argument made by Petitioner in its Reply where (1) it is beyond the scope of a reply under 37 C.F.R. § 42.23(b) or (2), if we were to rely on it to find Patent Owner's claims unpatentable, Patent Owner would not have had sufficient notice and opportunity to respond (*see, e.g., Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015) (applying a similar standard in *inter partes* review as in prosecution: "this court has determined whether the Board relied on a 'new ground of rejection' by asking 'whether applicants have had fair opportunity to react to the thrust of the rejection.'")). Because arguments are supported by evidence, and evidence not argued is not considered, we purposely leave out a separate class of "improper evidence."

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provide a decision here for the benefit of the parties, to provide guidance as to what we consider to be a proper reply argument.

With respect to the Reply in IPR2016-00038 (Paper 33), Patent Owner alleged that page 5, line 13 through page 8, line 13 introduced Barth as prior art, and alleged a new motivation to combine.

By way of background, in our Decision on Institution in IPR2016-00038 (Paper 16) we understood Petitioner's instituted ground to rely on a combination of the wipers of Appel and Prohaska (*see* Paper 16, 10–12), or Hoyler and Prohaska (*see id.*, 16–17). We understood the combination in each would be to take the spoiler of Prohaska and combine it with to the wiper of Appel or Hoyler. *Id.* at 11, 17. We understood Petitioner's rationale to be that the combination is the predictable use of prior art elements (e.g., adding Prohaska's spoiler) according to its established function (e.g., to counter liftoff tendency). *Id.* at 11–12, 17.

In its Response, Patent Owner argues that “wind liftoff . . . was generally recognized as a problem in *conventional* blades, [but] it was not a recognized problem in *beam* blades.” Paper 28, 5; *see also id.* at 5–6 (entire argument). The relevance of this argument is that Appel and Hoyler teach beam blades, whereas Prohaska teaches a conventional blade. *Id.* at 7.

Petitioner then replies that it is the triangular wiper strip itself that causes the lift problem, not whether it is a beam or conventional blade. Paper 28, 5–8. As evidence, Petitioner cites Barth and argues that it shows that:

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Contrary to Bosch’s arguments (Response, 3–5), because wind lift is caused by a wiper strip’s inverted-triangle profile—a profile common to *all* wipers¹—a person of ordinary skill in the art would have understood that conventional and flat-spring wipers are subject to wind lift in fundamentally the same way.

Paper 33, 8.

Reviewing the briefing, and having heard the arguments of both parties on this matter during the conference call, we determine that Petitioner’s Reply here is not improper. Patent Owner argues that the problem its patent solved was not recognized with respect to a certain class of wiper blades. Petitioner offers evidence that tends to show that the problem stems from the shape of the wiper strip itself, not the class of wiper blade. Both parties have had the opportunity to offer arguments and evidence on this issue, and we see no compelling reason to strike or disregard this portion of Petitioner’s Reply or the evidence cited therein.

Patent Owner also argues that the portion of Petitioner’s Reply at page 5 also introduces a new motivation to combine. Reviewing the record before us, and having heard the arguments of both parties during the conference call, we disagree. As we explained above, we understood Petitioner’s rationale to be that the combination is the predictable use of prior art elements according to their established function to counter liftoff tendency. Thus, Petitioner’s statement in its Reply that, “[t]hus, a person of ordinary skill in the art seeking to solve the well-known problem of wind lift would have turned to the well-known solution to that problem, ie. adding a conventionally shaped spoiler to a pre-existing wiper,” is simply restating its

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