

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. IPR2016-00036  
U.S. Patent No. 6,944,905

---

**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, and evidence newly cited therein, as follows:

Bosch objects to Ex. 1100 (Declaration of David Peck) under Fed. R. Evid. 401 and 701–02 and 37 C.F.R. § 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. 1102 (Second Declaration of Dr. Gregory W. Davis) under Fed. R. Evid. 401 and 37 C.F.R. § 42.23(b). Paragraphs 8–20 of Ex. 1102 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 the assertion that the spoiler of Prohaska was applicable to the different wiper blade of Hoyler. Costco should

have submitted any evidence in support of this position with its petition. Bosch further objects to paragraphs 8, 10–13, and 17–18 of Ex. 1102 as improperly relying upon prior art not part of the grounds instituted by the Board. Just as the aforementioned 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 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. 1011 (DE 19736368) and Ex. 1012 (US 6,292,974), insofar as newly relied upon by Costco, under Fed. R. Evid. 104(b), 401, and 802 and 37 C.F.R. §§ 42.23(b) and 42.63(b). Costco originally filed Exs. 1011 and 1012 with its petition, but relied on them only to explain the ’905 patent, its prosecution history, and the alleged state of the art. It was not part of the grounds alleged in the petition or instituted by the Board. Ex. 1012 was submitted as a U.S. counterpart to, and assumed to be a translation of, Ex. 1011. It is irrelevant (Fed. R. Evid. 401) and hearsay (Fed. R. Evid. 802) insofar as relied upon to establish the English meaning of Ex. 1011, and Ex. 1011 is inadmissible insofar as its relevance depends on the translation (Fed. R. Evid. 104(b)). In its reply, Costco

has improperly relied upon Ex. 1011 as prior art to support its asserted grounds, in violation of 37 C.F.R. §§ 42.23(b) and 35 U.S.C. § 312, and has done so without the translation and corresponding affidavit required by 37 C.F.R. §§ 42.63(b). Just as Exs. 1011 and 1012 are 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 Exs. 1011 and 1012, or the portions of Costco's reply that rely upon them, may be considered supplemental information, they are untimely and improperly submitted under 37 C.F.R. § 42.123, for example, because they expands the scope of the grounds upon which *inter partes* review was instituted.

Bosch objects to Ex. 1016 (US 3,418,679) and its equivalent Ex. 2009, insofar as newly relied upon by Costco, under 37 C.F.R. § 42.23(b). Costco submitted Ex. 1016 with its petition but did not cite it for any purpose. In its reply, Costco has improperly relied upon Ex. 1016/2009 as prior art to support its asserted grounds, in violation of 37 C.F.R. §§ 42.23(b) and 35 U.S.C. § 312. To whatever extent Exs. 1016 and 2009, or the portions of Costco's reply that rely upon them, may be considered supplemental information, they are untimely and improperly submitted under 37 C.F.R. § 42.123, for example because they expand the scope of the grounds upon which *inter partes* review was instituted.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.