

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 MOTION FOR OBSERVATION ON CROSS-
EXAMINATION OF GREGORY DAVIS**

Pursuant to the Scheduling Order (Paper 17) and the Office Patent Trial Practice Guide, Patent Owner Robert Bosch LLC (“Bosch”) moves the Board to observe the following passages in the cross-examination of Gregory Davis. Petitioner Costco Wholesale Corp. (“Costco”) submitted a declaration by Dr. Davis (Ex. 1102) with its Reply, and Bosch cross-examined Dr. Davis on November 30, 2016. The complete transcript of the cross-examination is submitted herewith as Exhibit 2030.

1. In Exhibit 2030, at page 120, lines 9–13, Dr. Davis testified that Prohaska’s spoiler designs were for conventional blades, but “that’s why I was looking at the idea of the combination of Prohaska with, like, Appel or Hoyler.” This testimony is relevant to Costco’s position, argued at pages 5–8 of its Reply, that it would have been obvious to apply conventional-blade spoilers to beam blades. It is relevant because, consistent with Bosch’s arguments in its Response, it shows that Dr. Davis (and, by extension, Costco) is using the ’905 patent as a roadmap to construct a hindsight-driven obviousness argument.

2. In Exhibit 2030, on page 131, lines 8–12, Dr. Davis testified, “Whether or not they would literally try to take the spoiler as is from Prohaska and combine it with Appel or Hoyler, I don’t think that’s the point. It’s the idea of what’s disclosed in Prohaska in applying it to these beam-style blades of Appel and

Hoyler.” This testimony is relevant to Costco’s position, argued at pages 5–8 of its Reply, that it would have been obvious to apply conventional-blade spoilers to beam blades. It is relevant because Dr. Davis implicitly acknowledges that changes would be required to adapt Prohaska’s spoiler to Hoyler’s beam blade, but does not account for what those changes might be or how they might have been implemented.

3. In Exhibit 2030, on page 97, lines 18–22, Dr. Davis, in response to a question about the teachings of Merkel (’974 patent, Ex. 1012, at 2:30–35), testified, “So if we were to make another element that was sizeable in cross-section that is stiffer than the support element, that then could impair the design. We would have to redesign the system.” This is relevant to Costco’s argument, in its Reply at pages 12–13 (citing Merkel, among others), that beam blades were not thought to be sensitive to small changes in structure, as Bosch argued in its Response.

4. In Exhibit 2030, on page 98, lines 17–22, Dr. Davis testified that the same passage in Merkel referred to in Observation 3 is referring specifically to beam blades (in particular, a “support element” which is a beam-blade component). This is relevant to the same argument as Observation 3. It is relevant because it confirms Merkel’s teaching, consistent with Bosch’s position in its Response, that beam blades *in particular* are affected by small changes to their structure. *See also*

Ex. 2030 at 102:3–11 (clarifying that the “support element” described by Merkel is specifically one which is “able to function in the absence of the claw and [yoke] system of a traditional wiper blade.”)

5. In Exhibit 2030, on page 107, line 15 to page 108, line 8, Dr. Davis testified that the '905 patent itself (at 1:49–52) contains “precisely” the same teaching as Merkel referred to in Observation 3. This is relevant to Costco’s argument on page 13 of its Reply that the '905 patent does not contain support for Bosch’s position that beam blades are sensitive to small changes in their structure. It is relevant because this passage does in fact support Bosch’s position by acknowledging that spoilers like those in Merkel can affect the rigidity and behavior of a beam blade. *See also* Ex. 2030 at 109:19–23 (acknowledging that this passage in the '905 patent is referring to Merkel’s beam blade).

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Respectfully submitted,

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Certificate of Service

The undersigned hereby certifies that the foregoing PATENT OWNER'S MOTION FOR OBSERVATION ON CROSS-EXAMINATION OF GREGORY DAVIS was served via electronic mail on December 13, 2016, on the following counsel for Petitioner:

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