

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 IPR2016-00036  
Patent 6,944,905

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**PETITIONER'S RESPONSE TO PATENT OWNER'S  
MOTION FOR OBSERVATION ON  
CROSS-EXAMINATION OF GREGORY DAVIS**

Pursuant to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012), and the Board's Scheduling Order (Paper 17), Costco Wholesale Corp. ("Petitioner") submits its Response to Patent Owner's Motion for Observation On Cross-Examination of Gregory Davis (Paper 51). Patent Owner presented five observations on the November 30, 2016 deposition testimony of Dr. Davis (Ex. 2030). Although Petitioner responds to each of Patent Owner's observations, Petitioner respectfully requests that the Board decline to consider Patent Owner's Observations because they are excessively argumentative in violation of the Office Patent Trial Practice Guide.

### **RESPONSE TO OBSERVATION NO. 1**

The cited testimony of Dr. Davis (Ex. 2030 at 120:9-13), when viewed in context (*see id.* at 87:11-89:18, 116:20-127:9), supports Petitioner's contentions (*see* Pet., Paper 1 at 21-23, 26-27; Ex. 1007 ¶ 27; Ex. 1008 at 45-46; Reply, Paper 34 at 5-8) that wind lift was a problem known to affect both conventional and flat-spring wipers, and that a person of ordinary skill in the art would have been able to select the stiffness and bending properties of the components of Prohaska and Hoyler in combining the teachings of those references to solve the well-known wind lift problem. *See* Ex. 2030 at 118:16-21 ("Q: The question is, does Prohaska teach a person of ordinary skill in the art how to calculate the relative stiffness and

bending properties of different spoilers and springs? A: Well, one of ordinary skill in the art would already know how to do that.”).

### **RESPONSE TO OBSERVATION NO. 2**

The cited testimony of Dr. Davis (Ex. 2030 at 131:8-12), when viewed in context (*see id.* at 129:18-131:14), supports Petitioner's contention (*see* Pet., Paper 1 at 34-37; Reply, Paper 34 at 5-8, 13-14) that combining Prohaska and Hoyler would have required no more than ordinary skill in the art. In particular, Dr. Davis expressly explained that a person of ordinary skill would have been able to perform the calculations and make material selections needed to take “what's disclosed in Prohaska” and “apply[] it to these beam-style blades of . . . Hoyler.” Ex. 2030 at 131:12-14. Patent Owner's contrary suggestion is unsupported and erroneous.

### **RESPONSE TO OBSERVATION NO. 3**

The cited testimony of Dr. Davis (Ex. 2030 at 97:18-22), when viewed in context (*see id.* at 97:5-98:16, 102:13-106:21, 112:12-115:7), supports Petitioner's contentions (*see* Reply, Paper 34 at 13) that DE 19736368 to Merkel (“Merkel”; Exs. 1011, 1012<sup>1</sup>) does not describe any “sensitivity” of flat-spring wipers, and selecting the materials and stiffnesses of flat-spring wiper components required no

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<sup>1</sup> U.S. Patent No. 6,292,974 (Ex. 1012) is the U.S. counterpart to DE 19736368 (Ex. 1011).

more than ordinary skill in the art. Patent Owner's contrary suggestion is unsupported and erroneous.

#### **RESPONSE TO OBSERVATION NO. 4**

The cited testimony of Dr. Davis (Ex. 2030 at 98:17-22, 102:3-11), when viewed in context (*see id.* at 98:17-100:21), supports Petitioner's contention (*see* Reply, Paper 34 at 13-14) that Merkel does not teach that flat-spring wipers are affected by "small changes" in their structure. As described above (*see supra* Resp. to Observation 3), Dr. Davis explained that the "design considerations" (i.e., the stiffness and material properties) of the components of flat-spring wipers are common to flat-spring and conventional wipers. Ex. 2030 at 98:17-100:21.

#### **RESPONSE TO OBSERVATION NO. 5**

The cited testimony of Dr. Davis (Ex. 2030 at 107:15-108:8, 109:19-23), when viewed in context (*see* Ex. 2030 at 106:23-113:18), supports Petitioner's contention (*see* Reply, Paper 34 at 13-14) that the '905 patent does not teach that flat-spring wipers are affected by "small changes" to their structure. As described above (*see supra* Resps. to Observations 3, 4), there is no such teaching in Merkel. Furthermore, Dr. Davis explained that designing the stiffness of the components of flat-spring wipers is a "design consideration" and requires no more than ordinary skill in the art. Ex. 2030 at 106:23-108:8; *see also id.* at 105:4-106:21.

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PETITIONER'S RESPONSE TO PATENT OWNER'S  
MOTION FOR OBSERVATION ON CROSS-EXAMINATION OF GREGORY DAVIS

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Respectfully Submitted,

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