

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTCO WHOLESALE CORPORATION,
Petitioner,

v.

ROBERT BOSCH LLC,
Patent Owner.

Case IPR2016-00036
Patent 6,944,905

**PETITIONER’S RESPONSE TO PAPER NO. 56 STYLED
“PATENT OWNER’S LIST OF IMPROPER REPLY ARGUMENTS,
PURSUANT TO THE BOARD’S DECEMBER 12 ORDER”**

U.S. Patent No. 3,428,679 ("Barth"). Patent Owner asserts that the Board purportedly erred in its Order issued December 12, 2016 ("Order," Paper 44) holding that Petitioner was entitled to rely on Barth to rebut Patent Owner's factual assertion that, prior to August 21, 1997, persons having ordinary skill in the wiper art prior purportedly did not understand the causes of wiper "wind lift" and purportedly harbored an erroneous and false belief that flat spring wipers were not subject to "wind lift." Patent Owner's assertion of "improper reply argument" as to this point amounts to a meritless and unsupported motion for reconsideration.

The Petition presented evidence that "liftoff tendency" at high speeds was a known problem potentially affecting windshield wipers prior to the claimed invention date. Pet., Paper 1 at 27 (quoting U.S. Patent No. 6,292,974 to Merkel ("Merkel," Exs. 1011, 1012). Bosch countered that liftoff tendency was purportedly unknown in flat-spring wipers. *See Resp.*, Paper 28 at 10-11. Costco's rebuttal cited Barth (Exs. 1016, 2009), to explain that liftoff tendency is common to conventional and flat-spring wipers. *See Reply*, Paper 34 at 6 (citing *Resp.*, Paper 28 at 8-10). Costco's argument is neither new nor based on new evidence, does not introduce a new motivation to combine, and is proper rebuttal argument. *See Order* at 5-6; *see also* 37 C.F.R. 42.23(b); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077-82 (Fed. Cir. 2015) (finding new reply expert testimony proper);

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Pet., Paper 1 at 20-21, 35-37; Ex. 1007 at ¶ 27; Ex. 1008 at 45-46.

Reason to Combine. In its response to the Petition, Patent Owner asserted that "conventional wisdom taught to avoid adding anything that would alter a beam blade's highly sensitive profile because even a slight [*sic*, change] would have a negative impact on blade performance." Resp., Paper 28 at 11. Costco's rebuttal cited Merkel (Ex. 1012) as evidence that Patent Owner's "conventional wisdom" assertion was unsupported and wrong. *See* Reply, Paper 34 at 7 (citing Resp., Paper 28 at 11). Costco's reply argument is neither new nor based on new evidence (*see* Pet., Paper 1 at 4, 26-27, 35-37; Ex. 1007 at ¶ 28), does not introduce a new motivation to combine, and is proper rebuttal argument. *See Belden*, 805 F.3d at 1077-82; 37 § C.F.R. 42.23(b); Order at 3, n.1.

Dated: December 23, 2016

Respectfully Submitted,

/James R. Klaiber/

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CERTIFICATE OF SERVICE

I hereby certify that on this 23rd day of December, 2016, the foregoing Petitioner's Response to Petitioner's Response to Paper No. 56 Styled "Patent Owner's List of Improper Reply Arguments, Pursuant to the Board's December 12 Order" was served in its entirety by email on the attorneys of record for Patent Owner:

- Patrick R. Colsher (patrick.colsher@shearman.com)
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