

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 NO. IPR2016-00038  
U.S. Patent No. 6,292,974

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**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. 1101 (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. 1101 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 or Appel.

Costco should have submitted any evidence in support of this position with its petition. Bosch further objects to paragraphs 8–12 and 17 of Ex. 1101 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 upon 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. 1009 (US 3,317,945), insofar as newly relied upon by Costco, under Fed. R. Evid. 401 and 37 C.F.R. § 42.23(b). Costco originally filed Ex. 1009 with its petition, but relied on it only to explain the ’974 patent’s prosecution history. It was not part of the grounds alleged in the petition or instituted by the Board. In its reply, Costco has improperly relied upon Ex. 1009 as prior art to support its asserted grounds, in violation of 37 C.F.R. §§ 42.23(b) and 35 U.S.C. § 312. Just as Ex. 1009 is outside the scope of a proper reply and adds to the issues that should have been presented in the petition, it is irrelevant to the issues properly part of this proceeding (Fed. R. Evid. 401). To whatever extent Ex. 1009, or the portions of Costco’s reply that rely upon 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. 1007 (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. 1007 with its petition but did not cite it for any purpose. In its reply, Costco has improperly relied upon Ex. 1007/2009 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. 1007 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.

DATED: October 31, 2016

Respectfully submitted,

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