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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Cases: IPR2016-00034, IPR2016-00036,
IPR2016-00038, IPR2016-00039,
IPR2016-00040, IPR2016-00041d

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COSTCO WHOLESALE CORPORATION,
Petitioner,
VS.
ROBERT BOSCH LLC,
Patent Owner.
-----X

TELEPHONIC HEARING

December 9, 2016

11:00 a.m.

BEFORE:

JUDGE WILLIAM SAINDON
JUDGE BARRY GROSSMAN
JUDGE PHIL KAUFFMAN

Reported by:

AYLETTE GONZALEZ, RPR, CLR, CCR

JOB NO. 116818

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1 PROCEEDINGS

2 JUDGE SAINDON: This conference
3 call is at the request of Patent
4 Owner. We received an e-mail and they
5 have requested a Motion to Strike or
6 some other relief regarding
7 Petitioners reply. So what we
8 instructed the parties to do was
9 essentially to provide or for Patent
10 Owner to provide a list of examples
11 for us to go through today to decide
12 whether or not we need further
13 briefing on this issue.

14 Before we get into the particular
15 items that were provided, I just
16 wanted to do a quick background on our
17 view of what's proper in a reply and
18 what we're looking for and to try to
19 hope that the arguments that we see
20 can be a little more useful to us.

21 So we see this issue come up a lot
22 especially recently given the federal
23 circuit cases regarding new arguments
24 in the reply. What we're looking for
25 is -- it's often the case that in a

1 PROCEEDINGS

2 Patent Owner response will have an
3 argument and then in the reply,
4 Petitioner responds to that and they
5 introduce new evidence to respond to
6 that and in our view, that is within
7 the rules, that's what the reply is
8 for, even if that is something that
9 could theoretically have been raised
10 in the petition.

11 The issue for us is whether the
12 response is a change in the theory of
13 unpatentability and so that's really
14 what we're looking for here, not
15 really is it something that could have
16 been raised in the petition but is a
17 change, because it's obviously
18 something not in the petition, it's in
19 the reply.

20 So to the extent we can focus less
21 on that this is new and more on this
22 either -- I mean it does happen that
23 something in the reply is not
24 responsive to something in the Patent
25 Owner response, that is rare though.

1 PROCEEDINGS

2 So if that's true the issue, then
3 let's talk about it, but if it's
4 really that the issue is that this is
5 a new thrust of theory for
6 unpatentability, then let's focus on
7 that issue and just go right to it,
8 because that's the one we're really
9 interested in and if that's the case,
10 then what we're looking for is either
11 to disregard that argument, that new
12 argument or that new factor, whatever
13 it may be or to have Patent Owner have
14 the opportunity to respond to it in
15 some fashion. And so again, those are
16 the two avenues that we're looking at
17 here, if we find ourselves with
18 something new.

19 So again, with the arguments that
20 we're going to discuss today, I'd just
21 like that to be in the back of the
22 mind of the parties because that's
23 what we're looking for.

24 So with that, Patent Owner, I see
25 the first item on your list, if you

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