

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 IPR2016-00038  
Patent 6,292,974

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

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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 two 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 contention (*see* Pet., Paper 1 at 22-24; Ex. 1008 ¶ 29; Ex. 1012 at 45-46; Reply, Paper 33 at 5-11) 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 Appel, or 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

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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.”). Patent Owner's contrary suggestion is unsupported and erroneous.

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

The cited testimony of Dr. Davis (Ex. 2030 at 131:8-12), when viewed in context (*see id.* at 128:18-131:14), supports Petitioner's contention (*see* Pet., Paper 1 at 10, 18-27; Reply, Paper 33 at 5-11) that combining Prohaska with Appel or Hoyler was a step that 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 use “what's disclosed in Prohaska” and “apply[] it to these beam-style blades of Appel and Hoyler.” Ex. 2030 at 131:2-14. Patent Owner's contrary suggestion is unsupported and erroneous.

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Dated: December 22, 2016

Respectfully Submitted,

/James R. Klaiber/

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 22nd day of December, 2016, the foregoing Petitioner's Response to Patent Owner's Motion for Observation on Cross-Examination of Gregory Davis 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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