

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTCO WHOLESALE CORPORATION,
Petitioner,

v.

ROBERT BOSCH LLC,
Patent Owner.

Case IPR2016-00038
Patent 6,292,974

**PETITIONER’S RESPONSE TO PAPER NO. 55 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 43) 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 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, and this proceeding was instituted on, obviousness grounds that rely on the "predictable use of . . . Prohaska's spoiler . . . to counter liftoff tendency[]." Order at 4; *see* Pet., Paper 1 at 23-24. Bosch countered that liftoff tendency purportedly was unknown in flat-spring wipers. *See* Resp., Paper 28 at 5-6 (citing Pet., Paper 1 at 22-23). Costco's rebuttal cited Barth (Exs. 1007, 2009), to explain that liftoff tendency is common to conventional and flat-spring wipers. *See* Reply, Paper 33 at 3, 5-8 (citing Resp., Paper 28 at 3-5). The Board rightly held that Costco's argument is neither new nor based on new evidence, does not "introduc[e] a new motivation to combine," and is proper rebuttal argument. Order at 5-6; *see* 37 C.F.R. 42.23(b); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077-82 (Fed. Cir. 2015); Pet., Paper 1 at ii; Ex. 1008 at ¶ 29; Ex. 1012

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at 45-46.

U.S. Patent No. 3,317,945 ("Ludwig"). In its response to the Petition, Patent Owner asserted that "the conventional thinking at the time of the '974 patent was to avoid adding any additional components on a beam blade, keeping the profile of the wiper blade very *low*, and thus making the beam perform the best." Resp., Paper 28 at 5. Costco's rebuttal cited the '974 Patent's prosecution history (Ex. 1002) and Ludwig (Ex. 1009), which showed that Patent Owner's response argument was unsupported and wrong. *See* Reply, Paper 33 at 3, 9-10 (citing Resp., Paper 28 at 7); Pet., Paper 1 at 6-9 (explaining Ludwig's role during prosecution). Accordingly, Costco's argument presents no new evidence and is proper. *See* 37 C.F.R. § 42.23(b); *Belden*, 805 F.3d at 1077-82.

Dated: December 23, 2016

Respectfully Submitted,

/James R. Klaiber/

James R. Klaiber

Registration No. 41,902

Hughes Hubbard & Reed LLP

One Battery Park Plaza

New York, New York 10004

James.klaiber@hugheshubbard.com

(212) 837-6125

Attorney for Petitioner Costco Wholesale Corp.

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CERTIFICATE OF SERVICE

I hereby certify that on this 23rd day of December, 2016, the foregoing Petitioner's Response to Paper 55 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)
- Mark Hannemann (mark.hannemann@shearman.com)
- Joseph Purcell (joseph.purcell@shearman.com)

/James R. Klaiber/
James R. Klaiber
Registration No. 41,902