UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTCO WHOLESALE CORPORATION,
Petitioner,

v.

ROBERT BOSCH LLC,
Patent Owner.

CASE NO. IPR2016-00039
U.S. Patent No. 7,228,588

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 upon it, may be considered supplemental information, it is 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.

Bosch objects to Ex. 1104 (DE 19736368) and Ex. 1105 (US 6,292,974) under Fed. R. Evid. 104(b), 401, and 802 and 37 C.F.R. §§ 42.23(b) and 42.63(b). Costco relies on Ex. 1104 as additional prior art to support its asserted grounds, beyond the proper scope of a reply and in violation of 37 C.F.R. §§ 42.23(b) and 35 U.S.C. § 312, and without the translation and corresponding affidavit required by 37 C.F.R. §§ 42.63(b). Ex. 1105 is relied on as a U.S. counterpart to, and assumed to be a translation of, Ex. 1104. It is irrelevant (Fed. R. Evid. 401) and hearsay (Fed. R. Evid. 802) insofar as relied upon to establish the English meaning of Ex. 1104, and Ex. 1104 is inadmissible insofar as its relevance depends on the translation (Fed. R. Evid. 104(b)). Just as Exs. 1104 and 1105 are 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 Exs. 1104 and 1105, 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.

Bosch objects to Ex. 1016 (Declaration of Dr. Gregory W. Davis), in particular Exs. F (US 6,944,905) and K (WO00/34090) thereto, under Fed. R. Evid. 401 and 37 C.F.R. §§ 42.6, 42.23(b), and 42.63. Costco submitted Ex. 1016 with its petition, but now improperly relies upon two exhibits to that declaration as prior art to support an entirely new ground and evidence of obviousness—that the invention of the '588 patent was merely "a further iteration in a series of minor improvements," Paper 37 at 10—in violation of 37 C.F.R. § 42.23(b) and 35 U.S.C. § 312. Just as these sub-exhibits to Ex. 1016 are 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). The '905 patent is also irrelevant because it is admitted not to be prior art. These sub-exhibits, insofar as relied upon in support of Costco's positions (as opposed to in support of Dr. Davis's declaration), are also improperly filed under 37 C.F.R. §§ 42.6 and 42.63. To whatever extent these sub-exhibits to Ex. 1016, or the portions of Costco's reply that relies on 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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