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 MOTION TO EXCLUDE EVIDENCE PURSUANT TO 37 C.F.R. § 42.64(c)

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I. PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner Robert Bosch LLC ("Patent Owner") respectfully requests that the Board exclude Paragraphs 7, 9–11, 15, 18, 19, 21, and 23–26 of the declaration of Mr. David Peck (Ex. 1100) offered by Petitioner. Patent Owner timely objected to this evidence on October 31, 2016. *See* Paper 40. Petitioner did serve any supplemental evidence or otherwise respond to the objection.

It is unclear whether Petitioner intends to offer Mr. Peck's testimony as a fact or an expert witness. While Petitioner did not establish Mr. Peck as qualified to opine as an expert on the subjects on which he offered his opinions, Petitioner did retain Mr. Peck in February 2015 (prior to filing this IPR) and did pay Mr. Peck for his testimony in connection with this proceeding. Ex. 2029 at 7:11–20; 10:13–12:11.

II. MR. PECK IS NOT QUALIFIED TO GIVE TECHNICAL EXPERT OPINIONS REGARDING THE THINKING OF A PERSON OF ORDINARY SKILL IN THE ART AT THE TIME OF THE INVENTION

Rule 702 allows opinion testimony from an expert witness only if the witness is qualified "by knowledge, skill, experience, training, or education" on the subject to which the witness is testifying, and then only if four criteria are met: "(a) the expert's scientific, technical, or other specialized knowledge will help the trier

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of fact to understand the evidence or to determine a fact in issue; (b) the testimony is based on sufficient facts or data; (c) the testimony is the product of reliable principles and methods; and (d) the expert has reliably applied the principles and methods to the facts of the case." *See* Fed. R. Evid. 702. Conversely, a lay witness may not offer opinion testimony unless it is "(a) rationally based on the witness's perception; (b) helpful to clearly understanding the witness's testimony or to determining a fact in issue; and (c) not based on scientific, technical, or other specialized knowledge within the scope of Rule 702." Fed. R. Evid. 701.

The questions presented in this proceeding concern the understanding of a hypothetical person of skill in the pertinent art at the time the invention was made (no later than April 26, 2001, the foreign application priority date of the '588 patent). *See, e.g.*, *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 405 (2007); *see also* 35 U.S.C. § 103(a). However, nowhere in his declaration or deposition testimony did Mr. Peck express any understanding of who a person of ordinary skill is in the context of this patent, nor any understanding that the opinions stated in his declaration are directed to what such a person would have known and understood.

Mr. Peck's expertise was gained in the course of his employment by Trico, a previously accused infringer that is now one of Patent Owner's licensees. *See* Ex. 1100 at ¶ 3; Ex. 2029 at 102:18–103:15; *see also Robert Bosch LLC v. Trico Prods. Corp.*, Case No. 12 CV 437 (N.D. Ill.), D.I. 209, Stipulation of Dismissal

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and Order (Aug. 6, 2014). However, he did not begin his employment at Trico until the spring of 1997, and Petitioner has made no showing that he has ever been a wiper-blade designer—certainly not during the time period between his joining Trico and the time of the invention, such that he could have gained expertise sufficient to opine as to the state of mind of a person of ordinary skill of the art in the wiper-design field as of the time of the invention. Ex. 1100 at ¶ 3; Ex. 2029 at 20:12–32:24. His experience is in the field of manufacturing machinery, including the design of the "production equipment" that was used to manufacture what ultimately became the Trico "Innovision" beam-style wiper blade. Ex. 2029 at, *e.g.*, 34:25–37:17; *see also* 20:12–32:24.

Regardless of whether he has any design experience at all, Mr. Peck had little to no experience in designing beam-style wiper blades at the time of the invention in April 2001. *Id.* In particular, he had no experience designing beam-style wiper blades with spoilers at the time of the invention—Trico (the company for which he worked and the sole source of his purported experience) did not start designing beam blades with spoilers until 2003, well after the invention of the '588 patent and the publication of its PCT counterpart. *Id.* at, *e.g.*, 69:16–70:15 ("When we went to beam blades, once we got it commercialized, so that puts it in the 2003 beginning, then we started focusing on adding air foils into the VariFlex type

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program.");[1] *see also* 73:16–74:4 (discussing beam blades, "[t]hat would mean it started about 2003-ish, where we would start trying to develop the air foil and how you integrate it into a flexible structure.").

Accordingly, Paragraphs 7, 9–11, 18, 19, 21, and 23–26 should be excluded under Rule 702.

To the extent that Mr. Peck is offering his lay opinion, these paragraphs should be excluded under Rule 701 because Mr. Peck's lay opinion is not rationally based on Mr. Peck's perception, and because it is based on scientific, technical, or other specialized knowledge within the scope of Rule 702 instead; and as irrelevant under Rule 401 because his purported experience stems from the wrong time period.

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[1] VariFlex is a "proprietary" software program created by a third party that was not "commercially available at any time," (Ex. 2029 at 74:17–24; *see also* Ex. 1100 at ¶ 10 ("a custom computer program created by Adrian Swanepoel….."))—one that Mr. Peck never personally used, (Ex. 2029 at 44:11–45:6).

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