

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 IPR2016-00039  
Patent 7,228,588

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**PETITIONER'S MOTION TO EXCLUDE EVIDENCE  
PURSUANT TO 37 C.F.R. § 42.64**

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Costco Wholesale Corporation (“Petitioner”) submits this Motion to Exclude (i) the former trial testimony of Wilfried Merkel (Ex. 2005 at 338–92<sup>1</sup>), and (ii) portions of the Declaration of Martin Kashnowski (Ex. 2007) that relate to noise testing. These exhibits were submitted by Robert Bosch LLC (“Patent Owner”) in support of its Response to the Petition for *inter partes* review of U.S. Patent No. 7,228,588 (the “’588 Patent”; Ex. 1001). *See* Patent Owner Response (the “Response”) (Paper No. 31) at 12–14 (citing Ex. 2005 at 337:10–23, 346:16–348:2, 353:22–354:1, 359:12–360:4, 388:23–391:8); *id.* at 14–15 (citing Ex. 2007 ¶ 6).

Patent Owner relies on this testimony in its attempt to overcome Petitioner’s *prima facie* showing of obviousness of the ’588 Patent, but these exhibits cannot form the basis of Patent Owner’s assertions because they are inadmissible. The direct testimony of Wilfried Merkel (Ex. 2005 at 338–92) cannot be considered by the Board because Mr. Merkel was never produced for deposition.<sup>2</sup> His testimony,

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<sup>1</sup> These page citations reflect the actual page numbers of the transcript and correspond to pages 210–64 of Patent Owner’s exhibit stamp.

<sup>2</sup> Pursuant to an Order of this Board (Paper No. 34), Petitioner previously moved to strike Mr. Merkel’s testimony because his failure to appear for deposition in response to Petitioner’s Notice of Deposition (Paper Nos. 33, 35) denied Petitioner

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