

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTCO WHOLESALE CORPORATION,
Petitioner,

v.

ROBERT BOSCH LLC,
Patent Owner.

Case IPR2016-00039
Patent 7,228,588

**PETITIONER’S RESPONSE TO PAPER NO. 57 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 47) 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 in this regard amounts to a meritless and wholly unsupported motion for reconsideration. It is, moreover, a gratuitous assertion in this IPR2016-00039 which does not involve Barth.

Skill to Combine. Costco's Petition presented, and this proceeding was instituted on, obviousness grounds that rely on the "substitution of one known element [Prohaska's spoiler] for another [Kotlarski's or Merkel's spoiler] with a predictable result" Decision, Paper 19 at 14, 18-19. Bosch countered that the "conventional thinking at the time was to avoid any additional components on a beam blade" and "beam blades are highly sensitive." Resp., Paper 31 at 3-5, 9; *see id.* at 14. Costco's rebuttal cited admitted prior art in the background of U.S. Patent No. 7,228,588 (the "'588 Patent," Ex. 1001) and the Declaration of David Peck (Ex. 1100 at ¶ 9), which established that (1) spoilers on flat-spring wipers were known before the claimed invention of the '588 Patent and (2) ordinarily-skilled

IPR2016-00039

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persons were skilled enough to account for the additional stiffness of a spoiler structure mounted on a flat-spring wiper support. *See Reply*, Paper 37 at 6 (citing *Resp.* at 3, 9), 16-17 (citing *Resp.* at 12, 14).

Costco's rebuttal properly relies on expert testimony to counter a factual assertion by Patent Owner regarding the supposedly low level of skill in the art at the time the claimed invention was made, especially since the assertion contradicts admitted prior art in the '588 Patent's background and Petitioner could not reasonably have anticipated such an assertion. *See 37 C.F.R. 42.23(b); Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015) (finding reply expert testimony that "confirm[s] the prima facie case" proper); *Volkswagen Grp. of Am, Inc. v. Emerachem Holdgs., LLC*, IPR2014-01555 Paper 36 at 5 (PTAB October 9, 2015) ("[P]etitioner does not have to anticipate all possible arguments . . . [of] patent owner . . .").

Dated: December 23, 2016

Respectfully Submitted,

/James R. Klaiber/

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IPR2016-00039

PETITIONER'S RESPONSE TO PAPER NO. 57 STYLED "PATENT OWNER'S LIST OF IMPROPER REPLY ARGUMENTS, PURSUANT TO THE BOARD'S DECEMBER 12 ORDER"

CERTIFICATE OF SERVICE

I hereby certify that on this 23rd day of December, 2016, the foregoing Petitioner's Response to Paper No. 57 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)
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