

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

COSTCO WHOLESALE CORPORATION,  
Petitioner,

v.

ROBERT BOSCH LLC,  
Patent Owner.

---

Case IPR2016-00040  
Patent 7,484,264

---

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

**TABLE OF CONTENTS**

	Page
I. STATEMENT OF PRECISE RELIEF REQUESTED .....	2
II. IDENTIFICATION OF PETITIONER’S OBJECTIONS IN THE RECORD PURSUANT TO 37 C.F.R. § 42.64(C).....	2
III. REASONS FOR RELIEF SOUGHT .....	4
A. The Former Trial Testimony of Wilfried Merkel is Inadmissible Pursuant to Federal Rules of Evidence 801, 802, and 804 .....	4
1. The Former Trial Testimony of Wilfried Merkel Constitutes Inadmissible Hearsay.....	6
2. Patent Owner Cannot Carry Its Burden of Establishing Each Element of the Former Testimony Exception to the Rule Against Hearsay Under Federal Rule of Evidence 804(b)(1).....	7
B. Martin Kashnowski’s Testimony is Inadmissible Pursuant to 37 C.F.R. § 42.65(b) and Constitutes Inadmissible Hearsay Pursuant to Federal Rules of Evidence 801 and 802 .....	12
1. Martin Kashnowski’s Testimony Fails to Set Forth the Requirements for Relying on Technical Tests and Data Which Precludes Patent Owner from Relying on his Testimony .....	12
2. Mr. Kashnowski’s Testimony Constitutes Inadmissible Hearsay.....	14
IV. CONCLUSION.....	15

**TABLE OF AUTHORITIES**

<b><u>Cases</u></b>	<b><u>Page(s)</u></b>
<i>Cordance Corp. v. Amazon.com, Inc.</i> , 639 F. Supp. 2d 406 (D. Del. 2009) .....	10
<i>Holmquist v. Farm Family Cas. Ins. Co.</i> , 800 F. Supp. 2d 305 (D. Me. 2011).....	10
<i>Kirk v. Raymark Indus., Inc.</i> , 61 F.3d 147 (3d Cir. 1995) .....	8, 9
<i>MeadWestVaco Corp. v. Rexam Beauty &amp; Closures, Inc.</i> , 731 F.3d 1258 (Fed. Cir. 2013) .....	11
<i>Ormco Corp. v. Align Tech., Inc.</i> , 463 F.3d 1299 (Fed. Cir. 2006) .....	11
<i>Robert Bosch LLC v. Pylon Manufacturing Corp.</i> , No. 08-542 (D. Del. Apr. 15, 2010).....	3, 4
<i>Transcraft, Inc. v. Galvin, Stalmack, Kirschner &amp; Clark</i> , 39 F.3d 812 (7th Cir. 1994) .....	6
<i>United States v. Kennard</i> , 472 F.3d 851 (11th Cir. 2006) .....	8
<i>United States v. Omar</i> , 104 F.3d 519 (1st Cir. 1997).....	8
<b><u>Statutes and Rules</u></b>	
Federal Rules of Evidence 401, 402, 403 .....	3
Federal Rules of Evidence 602, 603 .....	3
Federal Rule of Evidence 611 .....	10
Federal Rules of Evidence 702, 703 .....	3
Federal Rules of Evidence 801, 802, 803, 804 .....	<i>passim</i>
Federal Rules of Evidence 901, 902 .....	3

IPR2016-00040  
PETITIONER’S MOTION TO EXCLUDE EVIDENCE

Federal Rule of Evidence 1002.....3

**Regulations**

37 C.F.R. § 42.12 .....5

37 C.F.R. § 42.51 .....2, 5

37 C.F.R. § 42.53 .....2

37 C.F.R. § 42.53(a).....5

37 C.F.R. § 42.53(f)(7) .....5

37 C.F.R. § 42.61(a).....5, 14

37 C.F.R. § 42.62 .....4

37 C.F.R. § 42.64(b)(1).....2

37 C.F.R. § 42.64(b)(2).....9

37 C.F.R. § 42.64(c).....4

37 C.F.R. § 42.65 .....3

37 C.F.R. § 42.65(b) .....4, 12, 13, 14

37 C.F.R. § 42.104(b)(5).....5

**Legislative and Administrative Proceedings**

*Palo Alto Networks, Inc. v. Finjan, Inc.*, IPR 2015-01979, Paper  
No. 27 (PTAB Aug. 11, 2016).....9

*Samsung Elecs. Co. v. Unifi Sci. Batteries, LLC*, IPR2013-00236,  
Paper No. 10 (PTAB Sept. 25, 2013) .....13, 14

**Treatises and Periodical Materials**

30 Charles A. Wright & Kenneth W. Graham, Jr.,  
Federal Practice and Procedure § 6325 (1st ed. 1997) .....7

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. 7,484,264 (the “’264 Patent”; Ex. 1001). See Patent Owner Response (the “Response”) (Paper No. 28) at 13–16 (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 16 (citing Ex. 2007 ¶ 6).

Patent Owner relies on this testimony in its attempt to overcome Petitioner’s *prima facie* showing of obviousness of the ’264 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,

---

<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. 31), 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. 30, 32) denied Petitioner the opportunity for cross-examination in accordance with the procedures governing

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.