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 IPR2016-00041
Patent 8,099,823

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**PETITIONER'S MOTION TO STRIKE HEARSAY
TESTIMONY OF WILFRIED MERKEL [EXHIBIT 2005]**

<u>**TABLE OF AUTHORITIES**</u>

TABLE OF AUTHORITIES
Cont'd

Costco Wholesale Corporation ("Petitioner") submits this Motion to Strike the hearsay testimony of Wilfried Merkel (Exhibit 2005, 210–264), submitted by Robert Bosch LLC ("Patent Owner") in connection with IPR2016-00034, IPR2016-00036, IPR2016-00038, IPR2016-00039, IPR2016-00040, and IPR2016-00041 (the "IPRs") pursuant to 37 C.F.R. §§ 42.51-53 (governing routine discovery), and 37 C.F.R. § 42.12. In each of the IPRs, Patent Owner submitted approximately 54 pages of a 2010 district court trial transcript, *Robert Bosch LLC v. Pylon Manufacturing Corp.*, No. 08-542 (D. Del. Apr. 15, 2010), in which Mr. Merkel testified on behalf of Patent Owner. *See* Ex. 2005, 210–64. Each of Patent Owner's Responses in the IPRs cites Mr. Merkel's prior testimony as purportedly supporting assertions of non-obviousness in the IPRs, including as to patents that were not even at issue in the 2010 trial. *See* IPR2016-00034, Paper No. 26, at 22, 24, 27; IPR2016-00036, Paper No. 28, at 17, 19, 22; IPR2016-00038, Paper No. 28, at 9, 11, 14; IPR2016-00039, Paper No. 31, at 12–14, 17; IPR2016-00040, Paper No. 28, at 13, 15–16, 18; IPR2016-00041, Paper No. 32, at 14, 15–16, 19.

On July 29, 2016, Petitioner objected to Mr. Merkel's testimony on multiple grounds. *See* Petitioner's Objections to Evidence (Paper No. 33), 3. On August 12, 2016, in response to Petitioner's objections, Patent Owner served a Declaration of Wilfried Merkel, in which Mr. Merkel asserted that "for reasons of cardiac health" he would not "voluntarily give a deposition in this case." Ex. 1106 (Klaiber Decl.),

pp. 6–8 (Tab A). After Petitioner inquired further, Patent Owner informed Petitioner that they contacted Mr. Merkel, but would not be producing him New York, instead proposing that Mr. Merkel answer written questions. Ex. 1106, p. 12 (Tab C). Petitioner declined because "it is important to cross-examine this particular witness in person to properly discuss the many exhibits and technical issues that are involved in" these six cases and because it is entitled to do so. *Square, Inc. v. REM Holdings 3, LLC*, IPR2014-00312, Paper No. 37, at 2–3 (PTAB December 9, 2014). Patent Owner rejected Petitioner's suggestion to voluntarily withdraw Mr. Merkel's testimony from consideration. Ex. 1106, p. 31 (Tab E).

On September 22, 2016, Petitioner sought relief from the Board and requested either that the Board order Patent Owner to make Mr. Merkel available for cross examination in the United States or authorize Petitioner to file a motion to strike. Ex. 1106, p. 33–34 (Tab F). On September 27, 2016, the Board held a teleconference call to discuss Petitioner's request. During that call, counsel for Patent Owner represented that before Patent Owner supplemented its evidence with a declaration from Mr. Merkel, it had not contacted Mr. Merkel in years.[1] Subsequently, the Board authorized Petitioner to file a motion to strike Exhibit 2005, containing hearsay testimony of Mr. Merkel, from the record (Paper No. 35).

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[1] Ex. 1106 ¶ 3.

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