

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. IPR2016-00041
U.S. Patent No. 8,099,823

**PATENT OWNER'S MOTION FOR OBSERVATION ON CROSS-
EXAMINATION OF DAVID PECK**

Pursuant to the Scheduling Order (Paper 21) and the Office Patent Trial Practice Guide, Patent Owner Robert Bosch LLC (“Bosch”) moves the Board to observe the following passages in the cross-examination of David Peck. Petitioner Costco Wholesale Corp. (“Costco”) submitted a declaration by Mr. Peck (Ex. 1100) with its Reply, and Bosch cross-examined Mr. Peck on December 2, 2016. The complete transcript of the cross-examination is submitted herewith as Exhibit 2029. Also submitted herewith is an article written by Mr. Peck, Exhibit 2028, which was introduced and served upon Costco at the deposition.

1. In Exhibit 2029, on page 50, line 24 to page 52, line 12, Mr. Peck testified that Ford purchased a variant of the Innovision product for one year but found it didn’t work well, and no other OEMs purchased Innovision. This is relevant to Costco’s arguments on page 21 of its Reply. It is relevant because it rebuts any assertion that Trico’s product (lacking a spoiler or end caps) was commercially successful, and highlights the relative success of Bosch’s own beam-blade products (including a spoiler and end caps).

2. In Exhibit 2029, on page 53, line 24 to page 54, line 25, Mr. Peck testified that there were no concerns regarding wind-lift in the Trico Innovision product. He testified that it did not have a spoiler, because it did not need one; the blade would not lift below 110 miles per hour. This testimony is relevant to Bosch’s position, expressed in its Response at page 6, that a person of ordinary

skill in the art would not have had reason to modify Kotlarski or Merkel. It is relevant because it shows that Trico either did not recognize the wind-lift problem or determined that its blade was good enough not to modify it.

3. In Exhibit 2029, on page 65, lines 14 to 21, Mr. Peck testified that a spoiler was never added to the Trico Innovision product because Trico did not want to buy additional gluing equipment. This testimony is relevant to Bosch's position, argued in its Response at 3–6, that it would not have been obvious to combine the conventional-blade spoiler of Prohaska with the beam blade of Kotlarski or Merkel. It is relevant because it demonstrates artisans' assumption that a spoiler would need to be glued to a beam blade.

4. In Exhibit 2029, on page 82, lines 3 to 8, Mr. Peck testified that the Variflex software was only designed to account for a spoiler glued to the blade. This testimony is relevant to Bosch's position, argued in its Response at 3–6, that it would not have been obvious to combine the conventional-blade spoiler of Prohaska with the beam blade of Kotlarski or Merkel. It is relevant because it shows that the proprietary Variflex software to which Mr. Peck refers could not be used to design a functional beam blade with a spoiler (because it “couldn't accommodate the wind lift characteristics” and “did not have in there the low temperature effects when rubber becomes very hard”), and could not be used to

model a coupler or spoiler that was attached in some other way, not glued to the beam.

5. In Exhibit 2029, on page 70, lines 18–23, Mr. Peck testified that he had not performed the spoiler-design process described in paragraph 8 of his declaration on a beam blade before 2002.¹ This is relevant to Costco’s reliance on that paragraph in its Reply at page 20 to attempt rebuttal of Bosch’s secondary considerations evidence. It is relevant because it is Bosch’s position, expressed in its Response at pages 3–6 and 13–16, that teachings regarding conventional blades (including with respect to spoilers) were not believed to be applicable to beam blades at the time of the invention, and Mr. Peck has no basis for saying otherwise.²

6. In Exhibit 2029, on page 72, line 19 to page 74, line 4, Mr. Peck testified that he had not performed the procedure described in paragraph 9 of his declaration on a beam blade until approximately 2003. This is relevant to Costco’s reliance on that paragraph in its Reply at page 7 to attempt rebuttal of Bosch’s

¹ According to his declaration, 2002 is the last year that he was directly involved in beam-blade design. Ex. 1100 at ¶ 16.

² Notably, while paragraphs 7 and 9 of Mr. Peck’s declaration (Ex. 1100) refer specifically to beam blades, paragraph 8 does not explicitly do so. Thus, paragraph 8 is not false in this regard, but in context it is misleading.

secondary considerations evidence. It is relevant because Bosch’s position, expressed in its Response at 3–6 and 13–16, is that teachings regarding conventional blades (including with respect to spoilers) were not believed to be applicable to beam blades at the time of the invention, and Mr. Peck has no basis for saying otherwise.

7. In Exhibit 2029, on page 70, line 25 to page 71, line 6, Mr. Peck testified that a spoiler designed for a conventional (“whiffletree”³) blade would be rigid, whereas a spoiler designed for a beam blade would be flexible. This testimony is relevant to Costco’s position, argued in its Reply at pages 5–9, that it would have been obvious to use a conventional-blade spoiler with a beam blade. It is relevant because it demonstrates that, consistent with Bosch’s position that conventional blades and beam blades are fundamentally different (Response at 3–5), the considerations for designing a spoiler for a beam blade would have been fundamentally different from those for a conventional blade.

8. In Exhibit 2029, on page 97, line 23 to page 98, line 19, Mr. Peck testified that “[h]igher profile would make wind noise more of an issue for sure.” This is relevant to Bosch’s arguments at pages 4–5 and 16 of its Response. It is relevant because it supports Bosch’s position that artisans would not have thought

³ Mr. Peck used the term “whiffletree” to refer to a conventional blade. *See, e.g.*, Ex. 2029 at 16:8–9, 36:16–18, 38:11–14, 41:20–21.

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