

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 LIST OF IMPROPER REPLY ARGUMENTS,
PURSUANT TO THE BOARD'S DECEMBER 12 ORDER**

Patent Owner recognizes the Board’s ruling on arguments concerning the Barth reference, but disagrees, and includes the following paragraph in its submission in an effort to explain why, and to illustrate the kinds of issues that are involved with the arguments listed below. Patent Owner joins with Petitioner in requesting briefing on these issues (*see* Ex. 1108 at 33–36).

In the challenged section of its reply in IPR2016-00038, Petitioner argued that the Barth reference—which was not part of any proposed or instituted ground of unpatentability—taught that wind lift is caused by the rubber wiper strip “common to all wipers” and that Barth’s analysis “applies equally to all wipers . . . regardless of whether they have a flat-spring or conventional-style support structure” (Reply at 5–8). Before the reply was served, Patent Owner had no notice that the Barth reference was alleged to have taught that wind lift is a problem for beam blades. If notice had been given in the petition or in the institution decision, Patent Owner would have contested it in its responsive brief and responsive evidence (for example because Barth teaches only a conventional blade with pressure applied to the wiper strip at four discrete points along the length of the blade, and does not teach that wind lift caused by the wiper strip would be a problem also in beam blades, where the beam applies a nearly uniform pressure along the entire length of the wiper strip, and so the pressure of the wiper

arm, being evenly distributed, would resist wind lift along the entire length of the flexible wiper strip).

Improper Reply Argument 1, found in the Reply at 7:4–7: improper because it presents a new argument that should have part of Petitioner’s *prima facie* case, e.g., because it goes to an artisan’s expectation of success in making the claimed combination. This argument also relies on new evidence, the declaration of David Peck (Ex. 1100 ¶ 9), who was retained in connection with the challenged patents before the Petition was filed, *see* Ex. 2029 at 10:13–12:11.

Improper Reply Argument 2, found in the Reply at 20:10–13: improper because, purportedly responding to evidence of skepticism and unexpected results, it cites Mr. Peck (Ex. 1100 ¶¶ 7–8) to support a new position that it was conventional to add structures to a beam blade. The cited paragraphs are directed to the technical merits and not to skepticism or unexpected results.

DATED: December 16, 2016

Respectfully submitted,

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Certificate of Service

The undersigned hereby certifies that the foregoing PATENT OWNER'S LIST OF IMPROPER REPLY ARGUMENTS, PURSUANT TO THE BOARD'S DECEMBER 12 ORDER was served via electronic mail on December 16, 2016, on the following counsel for Petitioner:

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