

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COSTCO WHOLESALE CORPORATION
Petitioner,

v.

ROBERT BOSCH LLC,
Patent Owner.

Case IPR2016-00041
Patent 8,099,823 B2

Before PHILLIP J. KAUFFMAN, WILLIAM V. SAINDON, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

FINAL WRITTEN DECISION

Finding Some Challenged Claims Unpatentable
Granting-In-Part Petitioner's Motion to Exclude Evidence
Denying Petitioner's Motion to Strike
Denying Patent Owner's Motion to Exclude Evidence
35 U.S.C. § 318(a); 37 C.F.R. § 42.73

I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6. We enter this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. We also address herein the parties' Motions to Exclude Evidence.

Petitioner requested an *inter partes* review of claims 1, 6, 9, and 10 of U.S. Patent No. 8,099,823 B2 (Ex. 1001, "the '823 patent"). Paper 9 ("Pet."). Patent Owner filed a Preliminary Response to the Petition. Paper 19 ("Prelim. Resp."). We instituted review on all challenged claims, on four grounds. Paper 20 ("Dec. on Inst."). After our Decision on Institution, Patent Owner filed a Response (Paper 30, "PO Resp."), and Petitioner filed its Reply (Paper 38, "Pet. Reply"). An oral hearing was held January 18, 2017. Paper 68 ("Tr.").

With respect to the grounds asserted in this trial, we have considered the papers submitted by the parties and the evidence cited therein. For the reasons discussed below, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 1, 9, and 10 of the '823 patent are unpatentable. We also determine that Petitioner has not shown, by a preponderance of the evidence, that claim 6 of the '823 patent is unpatentable.

A. Related Matters

The parties represent that the '823 Patent is asserted in *Robert Bosch LLC v. Alberee Products Inc. et al.*, cv-12-574-LPS (D. Del) (consolidated with cv-14-142-LPS). Pet. 1; Paper 5, 1. In addition, Petitioner has filed petitions against several other of Patent Owner's patents: U.S. Patent Nos. 6,973,698 (IPR2016-00034), 6,836,926 (IPR2016-00035), 6,944,905

(IPR2016-00036), 6,292,974 (IPR2016-00038), 7,228,588
(IPR2016-00039), 7,484,264 (IPR2016-00040), and 8,544,136
(IPR2016-00042). Pet. 1; Paper 5, 1.

B. Wiper Blade Background

There are two main types of windshield wiper structures: beam and yoke (or, conventional). The conventional yoke-style structure includes a series of flexible rails that distribute force along the wiper blade. Ex. 1014 ¶ 19. Figure 1 of U.S. Patent 3,418,679 is reproduced below:

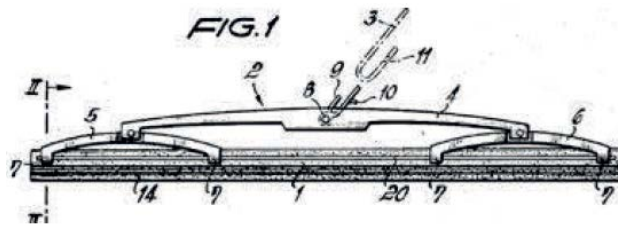


Figure 1 depicts a yoke-style wiper structure, having a large main rail 4 connected to two smaller rails 5, which in turn are connected to the wiper blade.

In contrast to the yoke style wiper is the beam, or flat, style of wiper. This type of wiper uses metal strips adjacent the wiper blade to distribute the load along the length of the wiper blade rather than the yokes. *Id.* ¶ 22.

Figure 1 of the '823 patent is reproduced below:

green. As shown in Figure 2 of the '823 patent, wind deflection strip 42 has two sides (48, 50) that diverge from common point 46, such that, in conjunction with wall 58, wind deflection strip 42 is generally triangular in cross section and has a hollow interior.

D. Challenged Claims

Petitioner challenges claims 1, 6, 9, and 10, of which claim 1 is independent. Claim 1 is reproduced below.

1. A wiper blade (10) for an automobile windshield (14), with an elongated belt-shaped, flexible resilient support element (12) having a longitudinal axis, on a lower belt surface (22) of which that faces the windshield is located an elastic rubber wiper strip (24) sitting against the windshield that extends parallel to the longitudinal axis, and on an upper belt surface (16) of which a wind deflection strip (42 or 112) is located that has an incident surface (54 or 140) facing a main flow direction of a driving wind (arrow 52), said deflection strip extending in the longitudinal direction of the support element, characterized in that the wind deflection strip has two sides (48, 50 or 136, 138) that diverge from a common base point (46 or 134) as seen in a cross section, wherein connected between the two sides of the wind deflection strip there is at least one support means located at a distance from their common base point that stabilizes the sides, and that the incident surface (54 or 140) is located at the exterior of one side (50 or 138), wherein the support element has outer edges, wherein the sides of the wind deflection strip have respective free ends having thereon respective claw-shaped extensions that fittingly grip around the outer edges of the support element at least in sections and engage at least one of the upper belt surface (24) and the lower belt surface (22), so that the wind deflection strip can be snapped onto the outer edges or slid onto the outer edges in a longitudinal direction, wherein the wind deflection strip has a height extending from the base point to ends of the sides farthest from the base point, and wherein a substantial

majority of the height is above the upper belt surface in a direction facing away from the windshield.

E. Prior Art and Asserted Grounds

Trial was instituted to determine the patentability of claims 1, 6, 9, and 10 of the '823 patent in view of the following obviousness grounds:

References	Claim(s) Challenged
Prohaska, ¹ and Appel ² or Hoyler ³	1, 9, and 10
Kotlarski '383 ⁴ or Merkel, ⁵ and Prohaska	1, 9, and 10
Prohaska, Appel or Hoyler, and Kotlarski '090 ⁶ or Mathues ⁷	6
Kotlarski '383 or Merkel, Prohaska, and Kotlarski '090 or Mathues	6

¹ U.K. Patent App. GB 2 106 775 A, published April 20, 1983 (Ex. 1005).

² U.S. Patent No. 3,192,551, issued July 6, 1965 (Ex. 1006).

³ German Patent No. 1,028,896, published June 24, 1954 (Ex. 1007). The English translation begins at page 5.

⁴ PCT WO 99/02383, published January 21, 1999 (Ex. 1003). Petitioner instead cites to Exhibit 1004, U.S. Patent 6,279,191, which issued from the PCT application in Exhibit 1003, because the PCT “does not include reference numbers for line citations, and because it encompasses the same subject matter.” Pet. 20, n.2.

⁵ PCT WO 99/12784, published March 18, 1999 (Ex. 1008). Petitioner instead cites to Exhibit 1009, U.S. Patent 6,295,690, which issued from the PCT application in Exhibit 1009, for the same reasons as explained in *supra* note 4. Pet. 21, n.3.

⁶ PCT WO00/34090, published June 15, 2000 (Ex. 1020). Petitioner instead cites to Exhibit 1021, U.S. Patent 6,295,690, which issued from the PCT application in Exhibit 1020, for the same reasons as explained in *supra* note 4. Pet. 22 (citing *id.* at 5, n.1).

⁷ U.S. Patent No. 3,121,133, issued February 11, 1964 (Ex. 1019).

Petitioner also relies on the declaration of Gregory W. Davis, Ph.D. (Ex. 1014).

II. MOTIONS

A. Patent Owner's Motion to Exclude

Patent Owner moves to exclude the testimony of David Peck in Exhibit 1100, offered by Petitioner as evidence of the features of a rival windshield wiper blade. Paper 53. Petitioner offers in opposition (Paper 59), to which Patent Owner offers its reply (Paper 65). The Motion to Exclude and associated papers have no meaningful distinction from the Motion to Exclude in IPR2016-00038, and consequently Patent Owner's Motion to Exclude portions of Mr. Peck's Declaration (Ex. 1100) is *denied*.

B. Petitioner's Motion to Exclude and Motion to Strike

Petitioner moves to exclude the testimony of Wilfried Merkel offered by Patent Owner in Exhibit 2005 as evidence for consideration in our objective indicia of non-obviousness analysis. Paper 54, 4–11. Petitioner also moves to exclude the testimony of Martin Kashnowski, offered by Patent Owner in Exhibit 2007 for similar reasons. *Id.* at 12–15. Patent Owner offers its opposition (Paper 62), to which Petitioner offers its reply (Paper 66).

With respect to the testimony of Mr. Merkel, our analysis in IPR2016-00039 is applicable here. For the reasons giving in that proceeding, Petitioner has demonstrated that Mr. Merkel's testimony from the Pylon litigation is inadmissible hearsay, and with respect to this evidence, Petitioner's Motion is *granted*.

With respect to the testimony of Mr. Kashnowski, our analysis in IPR2016-00038 is applicable here. For the reasons given in that proceeding, Petitioner has not demonstrated effectively that the testimony at issue is inadmissible hearsay, and with respect to this evidence, the Motion to Exclude is *denied*.

Petitioner moves to strike the testimony of Mr. Merkel in Exhibit 2005. Paper 37. Patent Owner filed an opposition. Paper 40. Petitioner's Motion to Strike and associated papers do not differ from the Motion to Strike in IPR2016-00038 in any meaningful way. We adopt that analysis here, and accordingly, that Motion is *denied*.

C. Motion for Observations

Patent Owner submits a Motion for Observation regarding the testimony of David Peck. Paper 55. Petitioner offers a response. Paper 61. We have reviewed these papers and the statements made therein.

III. PATENTABILITY ANALYSIS

A. Claim Construction

We interpret the claims of an unexpired patent using the broadest reasonable interpretation in light of the specification of the patent. 37 C.F.R. § 42.100(b).

In our Decision on Institution, the only claim construction issue we discussed was Patent Owner's argument that Petitioner failed to meet the requirement of 37 C.F.R. § 42.104(b)(3) to construe means-plus-function claims. Dec. on Inst. 7–11. However, the construction of that term was not at issue in our Decision to Institute. Neither party raises a claim construction issue in its subsequent briefs, nor do we discern a term that

requires construction for rendering our Decision. Therefore, we do not construe any terms.

B. Overview of the Prior Art and Level of Ordinary Skill

We first present the parties' positions regarding the level of ordinary skill in the art. Then, we briefly discuss each of the prior art references cited in Petitioner's grounds.

The challenged claims are generally directed to a beam-style wiper blade having a hollow spoiler attached thereto. To address the challenged claims, Petitioner sets forth three main grounds, those primarily relying on Prohaska, Kotlarski '383, or Merkel. In the Prohaska-led grounds, Petitioner cites to Prohaska for the teachings directed to the hollow spoiler and Appel, or alternatively Hoyler, for the teachings directed to the fact the spoiler is on a beam-style wiper. In the Kotlarski '383-led grounds, Petitioner cites to Kotlarski '383 for the beam-style wiper blade having a spoiler, and to Prohaska for the limitation directed to the spoiler being hollow. The Merkel-led ground is similar to the Kotlarski '383-led ground, and cites to Merkel for the beam-style wiper blade having a spoiler and to Prohaska for the spoiler being hollow. All of these grounds then propose adding Kotlarski '090 or Mathues, which discuss certain portions of the spoiler having different hardness values, to address dependent claim 6.

1. The Level of Ordinary Skill in the Art

Petitioner proposes that “[a] person of ordinary skill in the art would have the education and experience in mechanical engineering to have knowledge of the information deployed in [the prior art used in its grounds].” Pet. 26. Petitioner adds, “the level of skill in the art also

included the ability to make predictable use of the materials and components described above according to their established functions.” *Id.* Patent Owner proposes that a person of ordinary skill in the art “would have had either an undergraduate degree in mechanical engineering or a similar discipline, or several years of experience in the field of wiper blade manufacture and design.” PO Resp. 1. Patent Owner then argues that Petitioner’s proposed level of skill confuses the “content of the prior art” *Graham* factor with the “level of skill in the art” *Graham* factor.⁸ PO Resp. 2.

Patent Owner’s proposed level of skill would include anyone with an undergraduate degree in mechanical engineering or similar discipline, regardless of whether they had any actual knowledge or experience in the present field of endeavor, i.e. windshield wiper blades. *See id.* at 1 (proposing “mechanical engineering . . . or . . . experience in the field”). Patent Owner’s proposed level would include virtually anyone with a mechanical engineering degree. We cannot accept Patent Owner’s proposed level of skill because it reads out at least “in the art” in “a person of ordinary skill in the art.” Instead, we adopt Petitioner’s proposed level of skill. *See also Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“the prior art itself reflects an appropriate level [of skill]”).

⁸ The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) (cited with approval in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007)).

2. Prohaska

Prohaska is directed to an automobile windshield wiper blade. Ex. 1005, 1:5–7. Prohaska describes the known problem of an air stream striking the wiper blade, which diminishes the contact pressure of the wiper, causing lifting and deterioration of the wiper blade, especially at high vehicle speeds. *Id.* at 1:8–16. Prohaska explains that spoilers are known, but prior spoilers were attached to the yoke or were unduly complicated and unattractive. *Id.* at 1:25–29. Prohaska proposes a spoiler formed on, or attached to, a flexible strip, which in turn is attached to a wiper blade. *Id.* at 1:48–52, 68–77. Prohaska explains that its spoiler makes it “easily possible to retrofit a wiper blade.” *Id.* at 1:68–69. One embodiment is shown in Figure 3, reproduced below with added coloring:

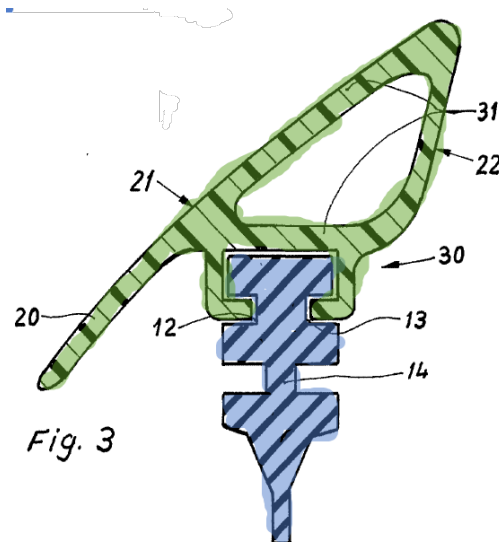


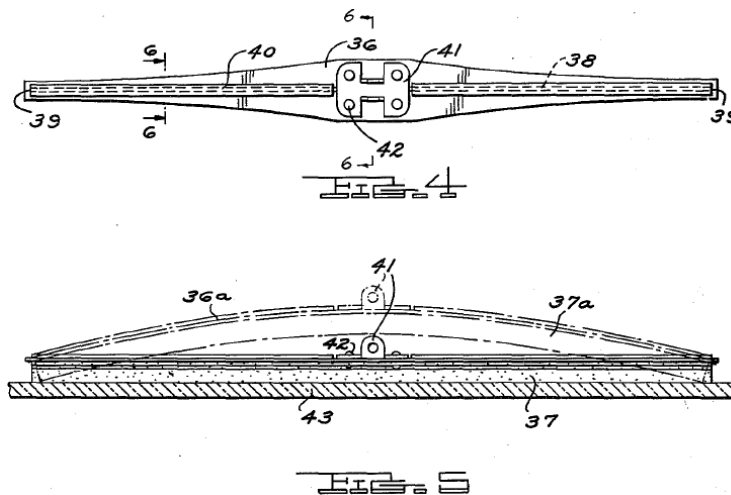
Figure 3 of Prohaska depicts spoiler 20 (in green) integral with flexible strip 30 (also green) and attached to wiper 10 (in blue). *Id.* at 2:71–75.

Petitioner cites to Prohaska for its teachings of a hollow spoiler attached to a windshield wiper. *See, e.g.,* Pet. 43. Prohaska does not teach a

spring support element (i.e., the metal bar that makes the wiper a beam-style wiper); Petitioner relies on Appel or Hoyler to teach this aspect of the claims. *Id.*

3. Appel / Hoyler

Appel and Hoyler are used by Petitioner in the Prohaska-led ground to demonstrate that beam-style wiper blades were known in the art. Appel discloses a wiper having a spring element as a backbone to distribute the wiper load evenly. Ex. 1006, 1:23–28. Figures 3 and 4 of Appel are reproduced below.



Figures 4 and 5 of Appel are top and side views, respectively, of a beam-style windshield wiper blade.

Hoyler discloses a wiper having a wiper bar formed of elastic metal strips bent according to the curvature of the windshield. Ex. 1007, 6⁹ (left column). Figure 1 of Hoyler is reproduced below:

⁹ Citations to Exhibit 1007 are to the page numbers stamped in the lower right hand corner.

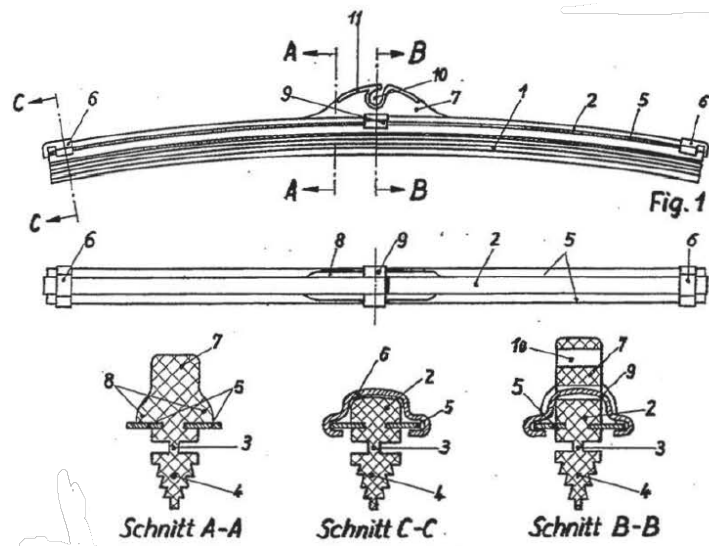


Figure 1 of Hoyler depicts side, top, and cross-section views of a beam-style wiper blade.

Hoyler also describes the importance of having light-weight wipers. Specifically, Hoyler states that the “weight of the moving parts can be largely reduced thereby so that the stress upon the drive elements is low,” and that “low weight also meets the demand for increasing wiper speeds.” Ex. 1007, 5 (right column).

4. Kotlarski '383 / Merkel

Kotlarski '383 and Merkel both describe beam-style wiper blades having spoilers. Figure 2 of Kotlarski '383 and Figure 3 of Merkel are reproduced below:

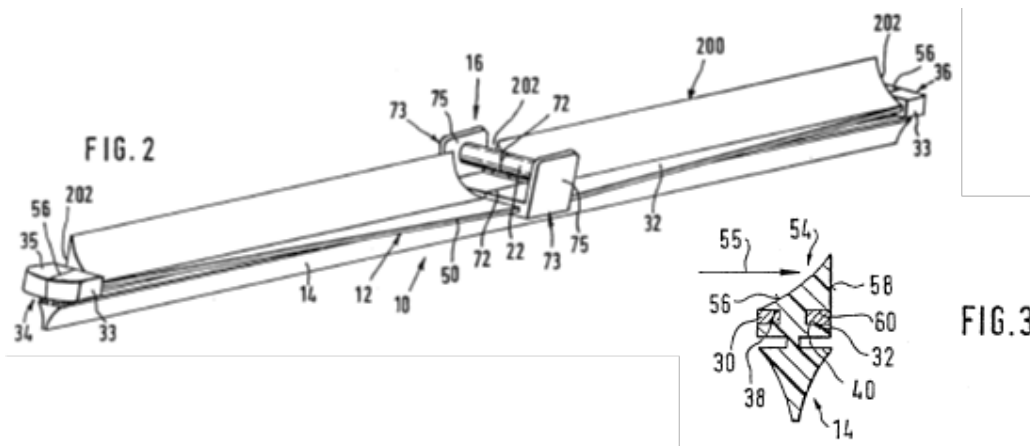
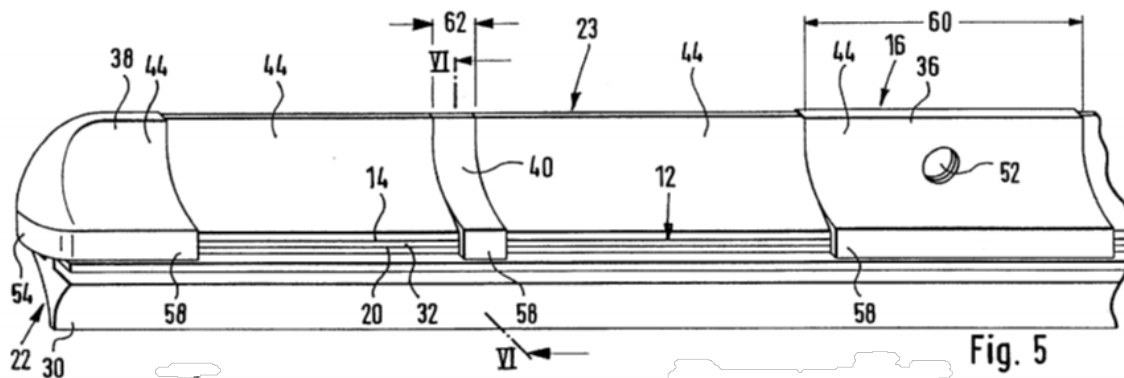


Figure 2 of Kotlarski '383 is an isometric view of a beam-style wiper blade having spoiler 200 and end caps 35. Figure 3 of Merkel is a cross-section view of a similar style wiper.

Missing from these references are the limitations in the challenged claims requiring the spoiler to be hollow, which Petitioner asserts is found in Prohaska. Pet. 44.

5. Kotlarski '090 / Mathues

Petitioner cites to Kotlarski '090 and Mathues to teach that certain components of the retaining mechanism of the wiper are harder than other components, relevant for dependent claim 6. See, *e.g.*, Pet. 51, 53. Figure 5 of Kotlarski '090 is reproduced below.



Kotlarski '090 describes a beam-style wiper blade having a spoiler 23 that is retained via claws 58 of retainers that grasp rails 32 (i.e., the beams). Ex. 1021, Fig. 5. The retainers are made of plastic. *Id.* at 5:45–46.

Mathues discloses a wiper blade having a retention portion of the blade harder than the wiper. Ex. 1019, Fig. 1 (showing profile of wiper), Fig. 3 (showing hardness values at various portions of the wiper). Figure 3 is reproduced below.

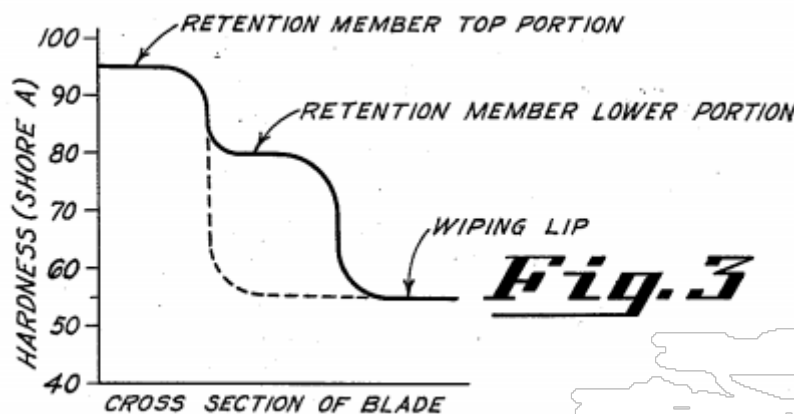


Figure 3 of Mathues depicts the relationship between the location on the cross-section of the wiper blade and its corresponding hardness value. Mathues teaches that heavily contoured windshields benefit from harder material in the retention portion of the wiper. *Id.* at 2:70–3:1.

C. Analysis of the Teachings of the Cited References

The disputes between the parties does not revolve around whether the prior art discloses each element of claims 1, 9, and 10. For completeness of our analysis, we address briefly these aspects of Petitioner's ground. Claim 1 requires a belt-shaped flexible resilient support element (beam), an elastic rubber wiper strip (wiper), and a wind deflection strip (spoiler). Claim 1 specifies that the spoiler has two sides that diverge from a common base

point, which in turn are connected by a support means; effectively requiring the spoiler to be a hollow triangle-like shape. *See* Ex. 1001, Fig. 3. In addition, the claim requires the spoiler has claw-shaped extensions to provide for attachment to the beam. Claim 9 specifies that the spoiler extends along at least half of the length of the wiper blade, and claim 10 specifies that the claw-shaped extensions engage both the upper and lower surfaces of the beam.

For the Prohaska-led ground, Petitioner directs us to spoiler 20 of Prohaska, which as shown in Figure 3 reproduced above, has two sides that diverge from a common base point, which are then connected by a wall. Pet. 27–28; Ex. 1005, Fig. 3. Further, Petitioner points out that the spoiler is connected to a wiper blade via claw-shaped extensions, also as shown in Figure 3. Pet. 29–30. Petitioner points to the beam-style wipers of Appel and Hoyler for the flexible resilient support element in claim 1. *Id.* at 27, 31 (citing Ex. 1006, Fig. 1; Ex. 1007, Fig. 1). Petitioner also points out that Prohaska’s spoiler is coextensive with its wiper (Pet. 54), and that the claw-shaped extensions of Prohaska grip both an upper and lower surface of the flexible strip (*id.* at 57). We find no reasonable dispute on this record as to these disclosures, and adopt Petitioner’s findings (i.e., claim chart and associated discussion) as our own.

For the Kotlarsky ’383-led ground, Petitioner directs us to the elongated, spring-elastic support element 12 for the beam, rubber-elastic wiper strip 14 for the wiper, and wind deflector strip 200 for the spoiler. Pet. 34–35 (citing, e.g., Ex. 1003, Fig. 1). Petitioner directs us to Prohaska for the particular configuration of the spoiler, e.g., the divergent legs, length, and claw-shaped extensions. *Id.* at 35–37. We find no reasonable dispute on

this record as to these disclosures, and adopt Petitioner's findings as our own.

For the Merkel-led ground, Petitioner directs us to the elastic spring-elastic support 12 for the beam, rubber-elastic wiper strip 14 for the wiper, and wind deflection strip 54 for the spoiler. Pet. 37–39 (citing, e.g., Ex. 1009, Fig. 1). Petitioner directs us to Prohaska for the particular configuration of the spoiler, e.g., the divergent legs, length, and claw-shaped extensions. *Id.* at 38–41. We find no reasonable dispute on this record as to these disclosures, and adopt Petitioner's findings as our own.

Claims 6 depends indirectly from claim 1, and requires the spoiler to be a “binary component,” wherein the claw-shaped extensions are made of a harder material than the remainder of the spoiler, and wherein the transition in hardness occurs near the wall (i.e., the support means). For all of the grounds, Petitioner points to either Kotlarski '090 or Mathues. Pet. 48–50. As described above, Kotlarski '090 describes a retainer having claws 58, and Mathues describes a wiper with varying hardness at the retention portion, versus the blade. Patent Owner argues that Kotlarski '090 does not teach a binary component because the retention portion is a separate element. PO Resp. 11. Patent Owner appears to concede that Mathues describes a binary component, but argues that Mathues does not disclose a spoiler. *Id.* at 11–12. Petitioner's ground, however, does not look to Kotlarski '090 by itself to teach the limitations of claims 6, but rather the combination of Prohaska and Kotlarski '090. Pet. 51–52. Similarly, Petitioner does not rely on Mathues to describe the spoiler, but rather that binary components were known, and that it would be obvious to apply the teachings of Mathues to the spoiler of Prohaska. *Id.* at 53. Thus, the dispute here is not over what

the prior art references teach, but rather whether Petitioner has explained why it would have been obvious to arrive at the claimed invention. We address issues of rationale in the next section. Accordingly, we adopt Petitioner’s findings as to the teachings of Kotlarski ’090 and Mathues as our own.

D. Analysis of the Rationales

1. Prohaska-led Ground

Petitioner’s proposed combination is to combine the spoiler of Prohaska with the beam-style wiper of Appel or Hoyler. Pet. 41–44. Based on the disclosures of the prior art brought to our attention by Petitioner, we find that a person of ordinary skill in the art would have known that liftoff tendency was a problem with windshield wipers. See Pet. 42 (“spoilers maintain wiper blade contact pressure at high speeds”) (citing Ex. 1005, 1:8–19; Ex. 1009, 1:55–56; Ex. 1014 ¶ 25). Similarly, we find that spoilers were a known solution to that problem, both for conventional and beam-style wipers. See *id.* (“spoilers were a solution to liftoff tendency”); Ex. 1005, 1:8–21 (“The practice shows that spoilers closely arranged to the windscreen are most effective against the attacking air stream.”); Ex. 1009, 1:53–57 (“[t]o suppress the aforementioned tendencies of the wiper blade to lift off from the window, the accessories trade offers so-called spoilers”), 2:15–31 (describing a spoiler on a beam-style wiper); Ex. 1003, 2–3 (describing a “wind deflection strip” as advantageous when driving at high speeds); Ex. 1021, 1:25–29 (providing for a beam-style wiper with a “spoiler, if the tendencies of the wiper blade to lift away from the window at relatively high travel speeds are to be averted”); see also Ex. 1014, 1:33–54 (a 1965 patent

describing “well known . . . aerodynamic principles” regarding airflow as applied to windshield wipers). With this level of knowledge, we find that Petitioner has provided rational underpinnings that provide a factual basis for its assertion that adding the spoiler of Prohaska to the beam-style wiper of Appel or Hoyler would “yield[] predicatable results,” and be “nothing more than a simple arrangement of old elements, each performing the same function it had been known to perform.” Pet. 43–44 (citing *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007)).

Patent Owner’s arguments that “conventional thinking” with respect to beam-style blades would be to “avoid any additional components” is unpersuasive, as the prior art shows that a person of ordinary skill in the art had contemplated adding spoilers to beam-style wipers, e.g., such as shown in Merkel, Kotlarski ’383, and Kotlarski ’090. PO Resp. 4–5. Patent Owner next argues that Prohaska discourages the use of a hollow spoiler. *Id.* at 7–10. The problem with this argument is that Prohaska affirmatively describes a hollow spoiler. We acknowledge that Prohaska cautions that a hollow spoiler, “possibly migh[t] be disadvantageous.” Ex. 1005, 3:2–6. Prohaska indicates that the possible disadvantage stems from the pressure exerted by the airstream, which Prohaska proposes can be eliminated by a “close fit of the parts,” i.e., by filling the void in the hollow of the spoiler. *See id.* at 3:7–21. First, to the extent Patent Owner is arguing that Prohaska teaches away, we find that Prohaska does not affirmatively teach away from a hollow spoiler; indeed it provides an embodiment specifically directed to a hollow spoiler. In addition, just because a patent teaches that a particular course of action has certain disadvantages does not preclude a person of ordinary skill in the art considering that course of action for what it teaches. *See DePuy*

Spine, Inc. v. Medtronic Sofamor Danek, Inc., 567 F.3d 1314, 1327 (Fed. Cir. 2009) (“A reference does not teach away [...] if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed.”); *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“[w]here the prior art contains ‘apparently conflicting’ teachings . . . each reference must be considered ‘for its power to suggest solutions to an artisan of ordinary skill . . . consider[ing] the degree to which one reference might accurately discredit another.’”) (citing *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991)).

The only evidence Patent Owner offers in support of its argument is the testimony of Dr. Dubowsky. PO Resp. 8 (citing Ex. 2003 ¶¶ 66, 73, and 83). Dr. Dubowsky states that a person of ordinary skill in the art would have understood Prohaska’s hollow spoiler would cause vibrations and premature failure. Ex. 2003 ¶ 66. We do not credit his testimony because his experience provides little insight into the knowledge of a person of ordinary skill in the art, because he provides no supporting evidence, and because he provides no technical explanation in support of his statement. 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”); Ex. 2003 ¶¶ 5–13 (professional experience not including automotive or wiper technology; sole experience with wipers is as expert for Patent Owner). Instead, we credit the testimony of Dr. Davis, who has significant automotive engineering experience and specific experience with the design of a wiper blade system, and who testifies that a person of ordinary skill in the art would consider the hollow feature of Prohaska’s

spoiler is a trade-off between weight and flexibility. Ex. 2002, 113:15–115:14 (“it’s kind of one of the design trade-offs that you [i.e., a person of ordinary skill in the art] would be making”) (cited in PO Resp. 8–9); Ex. 1014 ¶¶ 6–8 (describing prior work experiences), 59–60 (describing the structural integrity of a hollow spoiler). Petitioner also offers evidence that we find establishes that a person of ordinary skill in the art is concerned about the weight of a given wiper, and has a reason to make wipers lighter. Pet. 19 (citing Ex. 1007, 5), 46 (citing Ex. 1014 ¶ 56); Ex. 1007, 5 (“The weight of the moving parts can be largely produced thereby so that the stress upon the drive elements is low.” “The low weight also meets the demand for increasing wiper speeds.”); Ex. 1014 ¶ 56 (Dr. Davis testifying that Hoyler shows an awareness in the art regarding weight). Given that a person of ordinary skill in the art is concerned with the weight of a wiper, we find reason for him or her to consider using an existing hollow spoiler design such as shown in Prohaska. Ex. 1014 ¶¶ 54–55 (Dr. Davis testifying that weight reduction, and the solution to provide a hollow structure, are “perennial goals” in the automobile industry).

Reviewing the arguments and evidence before us, we find that a person of ordinary skill in the art knew how to place a spoiler on a beam-style windshield wiper to avoid wind lift, and was motivated to seek light-weight components. Accordingly, with respect to the challenged claims, we find reason to make the spoiler of a beam-style windshield wiper, such as found in Appel or Hoyler, to be hollow, as shown in Prohaska.

With respect to claim 6, in contrast, we do not find Petitioner to have set forth a reason to combine the references supported by rational underpinnings. As Patent Owner points out, Kotlarski ’090 describes the

spoiler and a separate retainer. PO Resp. 11. Without disagreeing with Petitioner’s assertion that these materials have different hardness values, the claim requires a “binary component” which we understand to be a structure wherein the portions having different hardness values are not separable. *See also* PO Resp. 11, (arguing that “[the prior art] does not disclose any individual element made of ‘a binary component’ material with two different hardnesses.”) (emphasis in original). For example, claim 6 describes that there is a “transition” from one hardness value to the other, implying in context that there is no separation. Further, the ’823 patent describes the “binary wind deflection strip” is manufactured using a “complex extrusion process.” Ex. 1001, 5:48–51. This again implies that there is no separation between the portions with different hardness values. Accordingly, missing from Petitioner’s analysis is an explanation for why it would have been obvious to combine the two separate components in Kotlarski ’090 into a single component.

With respect to Mathues, Patent Owner does not contest that the wiper is a binary material, but rather argues that it is not a spoiler. PO Resp. 11–12. Petitioner points out that it never alleged that Mathues taught a spoiler that was made from binary material. Pet. Reply 15. Petitioner also points out that the examiner in the original prosecution made a similar combination using this teaching of Mathues that was not contested. *Id.* at 16 (citing Pet. 9–10, in turn citing Ex. 1012, 108¹⁰). Although Mathues teaches that the *wiper portion* should be softer than the retention portion, and is not clear to

¹⁰ Petitioner actually cites to pages 71 to 72, but that citation is clearly erroneous.

us, nor does Petitioner explain, how this is applicable to *spoilers*. For example, a reason to have softer material in the wiper portion is so that it is more flexible while in contact with the windshield. There is no evidence before us that states why it would be beneficial to the upper portion of the spoiler to be more flexible, and Petitioner has given us no other reason to make it more flexible. Thus, while binary components were known in the windshield wiper art, we have an insufficiently persuasive explanation for why a person of ordinary skill in the art would have considered such a component with respect to the spoiler. We find that Petitioner has not provided a reason supported by rational underpinnings with respect to the Prohaska-led ground for why it would have been obvious to include a binary component as recited in dependent claim 6.

2. *Kotlarski '383-led Ground*

Petitioner's proposed combination is to modify the spoiler of the beam-style wiper blade in Kotlarski '383 to be hollow as shown in Prohaska. Pet. 44–48. Petitioner asserts that “substituting a hollow spoiler for a solid one predictively yields a lighter-weight wiper blade, as would have been readily apparent to a person of ordinary skill.” *Id.* at 45. Petitioner adds that the claims “solely combine old elements according to their established functions.” *Id.* at 48.

As we found above, the testimony of Dr. Davis, supported by the teachings of Hoyler, shows that a person of ordinary skill in the art had a reason to make a windshield wiper lighter. Ex. 1014 ¶¶ 54–56; Ex. 1007, 5 (“The weight of the moving parts can be largely produced thereby so that the stress upon the drive elements is low.” “The low weight also meets the

demand for increasing wiper speeds.”). We also found that it was known in the art to provide hollow windshield wipers, as shown in Prohaska. We also credit the testimony of Dr. Davis that making things hollow makes them lighter. Ex. 1014 ¶¶ 54–55.

Patent Owner’s arguments regarding the Kotlarski ’383/Prohaska combination are largely unpersuasive for the reasons discussed above. Patent Owner’s argument that a person of ordinary skill in the art would not have a reason to modify the “complete beam blade solution” of Kotlarski ’383, if taken to its logical conclusion, effectively precludes virtually any modification to a prior art reference. PO Resp. 6. Contrary to Patent Owner’s assertions, Petitioner does articulate a reason to make the existing spoiler in Kotlarski ’383 hollow—to make it lighter, which we know from Hoyler was recognized as providing less stress on the drive elements. We find that Petitioner has provided a reason supported by rational underpinnings to modify the spoiler of Kotlarski ’383 to be hollow. Petitioner’s ground with respect to claim 6, however, is deficient for the reasons expressed above with respect to the Prohaska-led ground.

3. Merkel-led Ground

Petitioner’s proposed combination is to modify the spoiler of the beam-style wiper blade and Merkel to be hollow as shown in Prohaska. Pet. 44–48. The relevant disclosure in Merkel is substantially similar to that of Kotlarski ’383, and Patent Owner’s arguments against are the same as those against Kotlarski ’383. See PO Resp. 6–12. Thus, for the reasons expressed above with respect to the Kotlarski ’383-led ground, we find that Petitioner has provided a reason supported by rational underpinnings to modify the

spoiler of Merkel to be hollow as required by the challenged claims, but has not provided a reason supported by rational underpinnings to modify it to be a binary component as required by claim 6.

E. Analysis of the Objective Evidence of Non-Obviousness

Evidence of secondary considerations “may often establish that an invention appearing to have been obvious in light of the prior art was not.” *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1378 (Fed. Cir. 2012). Patent Owner offers evidence it asserts shows objective evidence of non-obviousness (PO Resp. 12–20), in the form of commercial success (*id.* at 15, 18), praise and awards (*id.* at 15, 18), copying/knockoff products (*id.* at 18–19), licensing (*id.* at 19–20), and long-felt need and failure of others (*id.* at 14, 17–18). Patent Owner also directs us to its arguments and evidence in support of a nexus between the claims and the objective evidence. *Id.* at 15–16. Petitioner provides its arguments in rebuttal. Pet. Reply 18–23. We have reviewed the arguments and evidence cited in these papers.

1. Nexus

Paramount in any consideration of objective evidence is the nexus analysis—it serves to provide a link between the merits of the invention and the evidence provided, such as to allow us to distinguish when the objective evidence speaks to the invention, rather something else. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011) (“For objective evidence of secondary considerations to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the claimed invention.”) (citations omitted). For example, we must not attribute to the non-obviousness of an invention commercial success or praise derived

simply from business acumen, clever marketing, or the mere use of features already within the public domain. *See, e.g., Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315-16 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); *Solder Removal Co. v. United States Int'l Trade Comm'n.*, 582 F.2d 628, 637 (CCPA 1978) (“[c]ommercial success due only to superior business acumen, or effective advertising, is of no relevance”); *Schwinn Bicycle Co. v. Goodyear Tire & Rubber Co.*, 444 F.2d 295, 300, (9th Cir. 1970) (sponsorship by market leader “may be largely responsible for the success of the design”). The burden of showing that there is a nexus lies with the Patent Owner. *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994). Further, we acknowledge that “there is a presumption of nexus for objective considerations when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘is the invention disclosed and claimed in the patent.’” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329 (Fed. Cir. 2016) (quoting *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997)).

Patent Owner fails to explain in any sufficient amount of detail whether the asserted objective evidence is tied to the claims. Patent Owner alleges its commercial Aerotwin and Icon blades “practice the challenged claims.” PO Resp. 15. Patent Owner then cites to dozens of pages of exhibits, without explanation, that have no clear connection to the challenged patent’s claims.

Exhibit 2014 is Patent Owner’s response to interrogatories in the underlying district court litigation. It lists the Aerotwin wiper as practicing

the '823 patent (along with 15 other patents), and one version of the Icon wiper as practicing the '823 patent (along with 16 other patents) and containing a marking listing the '823 patent. This evidence is merely an allegation that “[Patent Owner’s] beam-type wiper blades have practiced and currently practice at least one claim of the following asserted patents [listed in the table].” Ex. 2014, 3. There are at least 15 other patents listed for each of these products, with no explanation for which features are covered by the '823 patent. The exhibit does not discuss any of the '823 patent’s claims, does not provide any analysis, and is not credible evidence of nexus.

Exhibit 2015 is a claim chart mapping claims of patents other than the '823 patent to the Aerotwin wiper; Exhibit 2016 is similar but directed to the Icon wiper. As Petitioner points out, Patent Owner submits the same evidence for six related patents without distinction. Pet. Reply 18–19. Thus, although Patent Owner may have detailed analysis in these exhibits for other patents, it omits any analysis on the '823 patent. Although other patents have similar features to the '823 patent, Patent Owner does not make any effort to direct us to where these wipers disclose each element in the recited claims. As evidenced by the art before us (and that 15+ patents are listed per wiper), we find that wiper blades are highly similar to each other by their nature, such that patentability is found in small distinctions. Thus, Patent Owner’s omission of a map means that we cannot presume a nexus between the challenged claims of the '823 patent and the Aerotwin or Icon wipers based on these exhibits.

Patent Owner cites to the testimony of Mr. Kashnowski, who simply refers to the Aerotwin and Icon blades, but provides no nexus analysis between those blades in the challenged claims. Ex. 2007 ¶ 6.

Patent Owner then cites to transcripts from a trial not involving Petitioner. PO Resp. 16. Exhibit 2006 involves testimony of Dr. Dubowski with respect to the claims of another patent and does not get into the features in any detail. Exhibit 2005 involves the testimony of Mr. Kashnowski. He states that the Aerotwin and Icon blades had a spoiler. Ex. 2005, 234:25–235:4, 249:25–250:5. He also testifies as to other various features, but as a layperson his testimony was objected to and is of dubious value. *Id.* at 252:17–254:21. Exhibit 2005 also involves the testimony of Mr. Merkel, who states that a hollow spoiler is used in the Icon wiper. *Id.* at 353:22–354:1, 359:12–360:4. Mr. Merkel’s testimony, directed to the “hollow” Icon wiper, appears to have some bearing on the claimed wiper, which has divergent legs and a connecting means between them, and which could be described as “hollow,” but we cannot presume that Mr. Merkel means the particular claimed feature in the ’823 patent because it was not at issue when he testified (which is why we excluded this testimony), and moreover Patent Owner makes no effort to convince us otherwise. *WBIP*, 829 F.3d at 1331 (“Questions of nexus are highly fact-dependent ‘It is within the province of the fact-finder to resolve these factual disputes regarding whether a nexus exists between commercial success of the product and its patented features, and to determine the probative value of evidence of secondary considerations.’” (citing *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1574 (Fed. Cir. 1996))).

In conclusion, Patent Owner has not mapped the claims of the ’823 patent onto any of its products, or otherwise explained how its products embody the claimed invention. Patent Owner offers maps for other patents having similar features, but does not point out the combination of features

unique to this patent. Patent Owner has over 15 patents covering each commercial product—the fact Patent Owner believes that it takes that many patents to cover a rather simple product not having many parts indicates that the nuances and distinctions between those patents is meaningful, and we will not presume to stand in Patent Owner’s shoes to make an analysis on this highly fact-specific issue. Accordingly, we do not find a nexus.

Notwithstanding, we review the objective evidence for sake of completeness, and to the extent it clearly bears on an isolated claim feature. *See Ashland Oil, Inc. v. Delta Resins & Refractories*, 776 F.2d 281, 306 (Fed. Cir. 1985) (holding that the weight attributed to the secondary evidence is proportional to its nexus to the merits of the invention, implying that a weak nexus requires some discount factor to the evidence, but a strong nexus does not).

2. *The Objective Evidence*

a. *Commercial Success*

One of the key tenets of commercial success case law is that the commercial success must come from the merits of the invention and not from external factors, or features already known in the art. *Cable Elec. Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1027 (Fed. Cir. 1985); *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006) (finding unconvincing secondary evidence directed to unclaimed features or to features known in the prior art); *see also J.T. Eaton & Co., Inc. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997) (“[T]he asserted commercial success of the product must be due to the merits of the claimed invention beyond what was readily available in the prior art.”); *Richdel, Inc.*

v. Sunspool Corp., 714 F.2d 1573, 1580 (Fed. Cir. 1983) (holding claims obvious despite purported showing of commercial success when patentee failed to show that “such commercial success as its marketed system enjoyed was due to anything disclosed in the patent in suit which was not readily available in the prior art”). We must be careful when discounting evidence tending to show that commercial success was due to features “known in the prior art” because virtually every device is a combination of known features. “[P]roof of nexus is not limited to only when objective evidence is tied to the supposedly ‘new’ feature(s).” *WBIP*, 829 F.3d at 1330. We must consider “the claimed combination as a whole that serves as a nexus for the objective evidence.” *Id.*

Patent Owner offers some sales figures that allegedly show commercial success. PO Resp. 18. Patent Owner merely lists sales figures for three different years and touts this as “significant.” *Id.* (citing Ex. 2007 ¶ 8). It is not clear to us where these sales figures come from; Patent Owner offers no discussion of their origin. Mr. Kashownski, a former “Director of Product Management for Wiping Systems” of Patent Owner, recites these numbers without providing supporting documentation. Ex. 2007 ¶¶ 1, 8; 37 C.F.R. § 42.65(a). Taking them at face value, these raw sales figures are of little use. Many non-innovative products are bought and sold. It is not our view that “commercial success” boils down to mere commercialization; attendant in the word “success” is some degree of popularity relative to another. Patent Owner alleges the sales numbers are “significant” but provides no explanation or evidence in support, and Mr. Kashnowski’s verbatim testimony likewise is not supported by evidence. 37 C.F.R. § 42.65(a). Notwithstanding the lack of nexus, this characterization is not

credible evidence of commercial success, and the numbers by themselves are also not credible evidence of commercial success.

Patent Owner also alleges that there was commercial success because demand for the Icon blade “was considerably high, even though it was more expensive” and because “customers expressed a great deal of excitement for the Icon blade.” PO Resp. 15 (citing Ex. 2007 ¶ 5; Ex. 2005, 270:14–271:3). Again, Patent Owner offers no credible evidence to support these assertions. In his declaration, Mr. Kashnowski merely repeats Patent Owner’s attorney arguments without further evidence or explanation, and is not credible evidence of this assertion. 37 C.F.R. § 42.65(a). In his testimony, Mr. Kashnowski attributes the success of the invention to “beam blades with spoilers and end caps,” something found in Merkel, Kotlarski ’83, or Kotlarski ’090. Ex. 2005, 270:14–271:3. Thus, to the extent there was commercial success on this basis, it is due to features wholly within the prior art and not something having to do with the invention claimed in the ’823 patent.

b. Industry Praise

Evidence that a person of ordinary skill in the art recognized the inventiveness of the product can be evidence of non-obviousness. *Vulcan Eng’g Co. v. Fata Aluminium, Inc.*, 278 F.3d 1366, 1373 (Fed. Cir. 2002) (“Appreciation by contemporaries skilled in the field of the invention is a useful indicator of whether the invention would have been obvious to such persons at the time it was made.”); *Institut Pasteur & Universite Pierre Et Marie Curie v. Focarino*, 738 F.3d 1337, 1347 (Fed. Cir. 2013) (“[I]ndustry praise . . . provides probative and cogent evidence that one of ordinary skill in the art would not have reasonably expected [the claimed invention].”).

For example, evidence that shows the product was “warmly received in the [relevant] industry” may indicate non-obviousness. *Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 1380 (Fed. Cir. 2000); *WBIP*, 829 F.3d at 1344 (“Industry participants, especially competitors, are not likely to praise an obvious advance over the known art.”).

Patent Owner’s allegations of praise are from customers, not persons of ordinary skill in the art. PO Resp. 15 (“customers expressed a great deal of excitement for the Icon blade”). Even if customer praise were a consideration, Patent Owner offers no evidence having a nexus to the claimed invention, and the alleged praise is not supported by evidence. 37 C.F.R. § 42.65(a).

Patent Owner also asserts that the Icon wiper was given an award from Frost & Sullivan an automotive research organization, but does not provide a copy or other description of the award. PO Resp. 18 (citing Ex. 2007 ¶ 8). There is no discussion of what the award was for, or how it relates to the ’823 patent. This is similarly the case with the Pace and Automechanika awards. *See id.* at 14–15.

c. Copying

For copying to be effective in showing non-obviousness, there must be more than simply a competing version of the product. *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004) (“Not every competing product that arguably falls within the scope of a patent is evidence of copying. Otherwise every infringement suit would automatically confirm the nonobviousness of the patent.”). Evidence of copying can be particularly persuasive when a competitor had tried and failed to introduce a competing product until the patented product became

available. *Vandenberg v. Dairy Equipment Co., a Div. of DEC Int’l, Inc.*, 740 F.2d 1560, 1567 (Fed. Cir. 1984). Copying, however, “is only equivocal evidence of non-obviousness in the absence of more compelling objective indicia.” *Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 1380 (Fed. Cir. 2000). One reason why is that other competitors might not view the product as something protectable by patent, e.g., it being a straightforward design or simply containing known features. *See Cable Elec. Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1028 (Fed. Cir. 1985).

Patent Owner alleges that it created a new “market category” with its Aerotwin blade, and that others sold “knockoff” products.” PO Resp. 18–19. However, commensurate with our nexus analysis above, Patent Owner does not tie these allegations to the claims. The market already included beam blades with spoilers. Merely offering competing products or alleging infringement are not signs of non-obviousness, for the reasons expressed by our reviewing court in cases such as *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010). The secondary consideration of copying is very specific—“evidence of efforts to replicate a specific product.” *Id.* This specifically is not *evidence of efforts to provide a competing product* or *evidence of a product having the same features*, or we would be reading out the crux of the basis for the court’s reasoning in *Wyers*, that “[n]ot every competing product that arguably falls within the scope of a patent is evidence of copying.” *Id.*

d. Licensing

Licenses may indicate non-obviousness. *In re Sernaker*, 702 F.2d 989, 996 (Fed. Cir. 1983) (“Despite the fact that a patent has not yet issued, appellant has been able to license his invention.”). Patent Owner alleges that

competitors are “largely respectful” of its “beam-blade patent rights,” and that they have licensed and paid royalties. PO Resp. 19–20. But Patent Owner’s allegations here are for other patents, and Patent Owner makes no effort to tie these allegations to the ’823 patent.

e. Long-Felt Need

Long-felt need can be shown by evidence that indicates that the prior art had a recognized need for a solution to the problem and that others had tried and failed to find a solution to that problem. *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1325 (Fed. Cir. 1999); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540 (Fed. Cir. 1983). Notably, the case law characterizes the need in terms of a long-felt but *unresolved* need. *Al-Site*, 174 F.3d at 1325 (discussing “long felt but unresolved needs”). Accordingly, Patent Owner must show that the need was both known and not resolved.

Patent Owner alleges that a “Trico Innovision wiper” failed in the marketplace. PO Resp. 17–18. But Patent Owner acknowledges that this wiper did not have similar features such as a spoiler. *Id.* Further, the prior art already included wipers with spoilers (e.g., Merkel), such that a need for spoilers on beam blades (had there been any) was resolved.

f. Synthesis of the Objective Evidence

Patent Owner has not mapped the ’823 patent to the alleged commercial embodiments, and has not shown nexus. Patent Owner points to alleged praise, copying, licensing, and long-felt need for other patents but has not shown how this relates to the ’823 patent. Patent Owner provides naked, unsubstantiated sales figures, but these are given no context to determine whether it relates to the ’823 patent nor to determine whether

there is truly any success. At best, the objective evidence suggests that Patent Owner has sold beam-style wiper blades of some kind that have similar features to prior art designs (e.g., Merkel, Kotlarski '090, Kotlarski '383).

3. Conclusion for Obviousness Grounds

The evidence before us shows that beam-style wiper blades having a spoiler were known, and that hollow spoilers were known for conventional wiper blades. There was a reason to make existing spoilers hollow—to reduce the weight of the blade. The objective evidence does not speak to this particular combination, and offers little-to-no probative value of non-obviousness. Weighing the evidence before us, we determine that it would have been obvious to a person of ordinary skill in the art to modify a spoiler in a beam-style blade to be hollow, for the purpose of reducing weight. Similarly, we determine that it would have been obvious to a person of ordinary skill in the art to modify a beam-style blade to have a hollow spoiler, for the purpose of overcoming lift-off.

With respect to claim 6, Petitioner has not established a reason with rational underpinnings for modifying the spoiler in the above combinations to use a binary material. The evidence shows a way to attach the spoiler without a binary material (Kotlarski '090) and shows a binary material for a wiper blade, but in a different context (Mathues). Petitioner has not shown the reason for having a binary material on a wiper blade applies to a spoiler, which is functionally different from a wiper blade, and thus the reason for Mathues to use a binary material does not clearly apply to a spoiler (and Petitioner has not explained otherwise).

In view of the above, we determine that Petitioner has shown, by a preponderance of the evidence, that the subject matter of claims 1, 9, and 10 would have been obvious to a person of ordinary skill in the art. We determine that Petitioner has not shown, by a preponderance of the evidence, that the subject matter of claim 6 would have been obvious to a person of ordinary skill in the art.

IV. ORDER

In view of the foregoing, it is hereby:

ORDERED that claims 1, 9, and 10 of the '823 patent have been shown by a preponderance of the evidence to be unpatentable;

FURTHER ORDERED that claim 6 of the '823 patent has not been shown by a preponderance of the evidence to be unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Exclude is *denied*;

FURTHER ORDERED that Petitioner's Motion to Strike is *denied*;

FURTHER ORDERED that Petitioner's Motion to Exclude is *granted-in-part*; and

FURTHER ORDERED that this is a Final Written Decision under 35 U.S.C. § 318(a), and that parties to the proceeding seeking judicial review of the decision under 35 U.S.C. § 319 must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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Patent 8,099,823 B2

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