

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**THE BOEING COMPANY,**

Petitioner

v.

**SEYMOUR LEVINE,**

Patent Owner

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Case No. **IPR2015-01341**

Patent No. RE39,618

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**PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL  
INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a)**

**I. STATEMENT OF PRECISE RELIEF REQUESTED**

In accordance with the Board's Order dated January 20, 2016 (Paper 20), The Boeing Company ("Petitioner" or "Boeing") respectfully moves to submit the supplemental declaration of Dr. Albert Helfrick (tentatively Exhibit 1042), and the Exhibits A-C to his declaration, as supplemental information pursuant to 37 C.F.R. § 42.123(a).

Boeing respectfully submits that including the supplemental Helfrick declaration in this proceeding is the most practical way to address this material. Boeing filed a second petition (IPR2016-0023) regarding this patent before Boeing's one-year cutoff, and included a Helfrick declaration identical to the one in the present petition except for a few paragraphs of expanded testimony and related exhibits. Boeing wanted to ensure a full record was presented in a timely manner, and did so before the statutory deadline. When this proceeding was instituted, Boeing moved to include the limited additional material as supplemental information, and if allowed, will withdraw its second petition. In the alternative, Boeing has moved to join the two IPRs into a single proceeding with one record.

The supplemental information meets all legal requirements for such material, and should be allowed because its inclusion in this proceeding is not prejudicial to the patent owner, who has had it for months, and is the most efficient and practical way to proceed regarding the '618 patent. First, the declaration and its exhibits are relevant: they further support Boeing's showing

that the transmitters in prior art ACARS systems would have been understood by a skilled artisan to be “portable” or “positionable.” The Board already found sufficient evidence of this in Boeing’s petition and Dr. Helfrick’s declaration in support thereof (Exhibit 1002) when the Board instituted trial here. The supplemental information merely corroborates the current record.

Second, including the information here is consistent with Board precedent, most notably *Pacific Market International v. Ignite USA, LLC*, IPR2014-00561, Paper 23, at 3 (PTAB Dec. 2, 2014). As in that proceeding, the supplemental information here does not alter the scope of the instituted grounds. It relates to the same limitation, claims, and patent in issue, and corroborates the same prior art reference combined in the same way currently at issue. And like *Pacific Market*, the supplemental information here is limited in comparison to the record already at issue, and was provided to the patent owner before he commenced discovery. Accordingly, Petitioner respectfully requests that the information be allowed in this proceeding and that this motion be granted.

## **II. STATEMENT OF REASONS FOR RELIEF REQUESTED**

### **A. LEGAL STANDARD**

A party may submit supplemental information under 37 C.F.R. § 42.123(a) if a request is made within a month of institution for relevant information. While meeting these criteria “does not, itself, guarantee” that the motion will be granted, the Board recognizes that “supplemental information

may prove beneficial to the Board in reaching a decision with respect to the trial.” See *Pacific Market International v. Ignite USA, LLC*, IPR2014-00561, Paper 23 (PTAB Dec. 2, 2014) at 3. Thus, the Board has granted a motion to submit supplemental information where, as here, limited expert testimony was provided to further support a ground of unpatentability on which review had been instituted. See *id.*

## **B. ARGUMENT**

### **1. Boeing’s Motion Is Timely And The Supplemental Information Is Relevant**

As the Board has already found, Petitioner’s request for authorization was made within one month of the date of institution and is timely. Paper 20 at 2. In addition, the supplemental information is relevant to a claim for which the trial has been instituted as required by 37 C.F.R. § 42.123(a)(2).

For a number of prior art references in this case, including the Ward reference, Boeing contends that the “transmitter portable” (claim 4) or “transmitter positionable” (claim 14) limitation is disclosed by an ACARS system. As the Board noted in its decision to institute review, “Ward discloses that the data link to the ground systems is an ACARS system, a system that includes a transmitter.” Paper 10 at 15. The Board further found that Dr. Helfrick’s testimony supported the “portability” or “positionability” of the transmitter:

Petitioner offers Dr. Helfrick’s statement that ARINC 624-1 discloses a standards-compliant ACARS system, including a VHF transceiver and an HF transceiver. Pet. 33 (citing Ex. 1002 ¶ 25). We are not

persuaded, on this record, that such disclosures of discrete transmitters do not indicate that they were capable of changing location.

*Id.* at 15–16. The Supplemental Helfrick Declaration submitted herewith evidences the correctness of the Board’s conclusion by noting the connectability and removability of different types of ACARS transmitters, including VHF transceivers and HF transceivers. Thus, the supplemental information is relevant to claims for which the trial has been instituted.

## **2. The Board Should Grant Boeing’s Motion**

As explained above, the supplemental material relates to relevant testimony already in the record, *i.e.*, that prior art transmitters could change location. Further, it is limited compared to the record evidence. The Helfrick declaration (Exhibit 1002) contains 107 paragraphs of testimony over 48 pages, while the Supplemental Helfrick Declaration is 7 paragraphs over 4 pages.

The Board has granted requests for supplemental information under similar circumstances. *See, e.g., Pacific Market International*, IPR2014-00561, Paper 23. The supplemental information that petitioner sought to enter in *Pacific Market* was additional expert testimony regarding reasons to combine particular prior art references that formed the underlying basis for instituting trial. *Id.* at 3–4. The Board found that the supplemental testimony “does not operate to change any grounds of unpatentability that were authorized in this proceeding, nor does it change the type of evidence initially presented in the Petition to support the grounds of unpatentability.” *Id.* at 4. Rather, the supplemental testimony was simply “additional evidence” which according to

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