

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE BOEING COMPANY
Petitioner

v.

SEYMOUR LEVINE
Patent Owner

Case No. IPR2015-01341
U.S. Patent No. RE39,618

REPLY IN SUPPORT OF PETITIONER'S MOTION TO EXCLUDE

I. Introduction

PO testified that “[o]n or before May 18, 1996,” he “conceived... of the inventions” of the ‘618 patent. Ex. 2009 ¶ 2. In his Response, PO argued “Mr. Levine testifies here that he conceived of the claimed invention at least as early as May, 1996,” and that “Levine’s testimony is corroborated by” his contemporaneous documents. PO Resp. 14-15. After Boeing sought to exclude Levine’s documents because they are not *independent* evidence of conception, PO made a hasty retreat. PO now argues that “Levine offers no testimony to be corroborated,” and purports to rely exclusively on his documents. *Id.* at 5. Illogically, PO argues that, because he now relies on *less* evidence of conception than before, the corroboration requirement no longer applies.

That is not the law. Independent evidence is *always* required to prove conception. *See, e.g., Procter & Gamble Co. v. Teva Pharm. USA, Inc.*, 566 F.3d 989, 999 (Fed. Cir. 2009) (inventor must provide corroborating evidence “in addition to his own statements and documents”) (citation and internal quotation marks omitted). PO cites *no case* in which an inventor’s own private and uncorroborated documents establish conception.

Corroboration is required “to prevent fraud.” *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1170 (Fed. Cir. 2006). It is a bright-line rule that applies regardless of the credibility of the inventor. *Id.* at 1171-72. If PO’s position were correct,

however, inventors could end-run the rule by simply submitting their own unwitnessed, backdated documents, and declining to testify about what they conceived. The risk of after-the-fact fabrication would be present to the same degree as where the inventor relied on his own uncorroborated testimony.

Not only is this wholly inconsistent with the anti-fraud purpose of the rule, it is in fact impossible for PO to avoid his own testimony. PO is the only witness who can provide testimony purporting to establish the date and origin of the disputed exhibits. Ex. 2009 ¶¶ 2, 4. PO fails to explain why this testimony should be exempt from the rule that “when a party seeks to prove conception via the oral testimony of a putative inventor, the party must proffer evidence corroborating that testimony.” *Chen v. Bouchard*, 347 F.3d 1299, 1309 (Fed. Cir. 2003). The documents themselves cannot be that corroborating evidence. *See Neste Oil Oyj v. Reg Synthetic Fuels, LLC*, IPR2013-00578, Paper 52, 4 (corroboration must be independent, not “circular”).

In sum, PO cannot avoid the corroboration requirement by recanting his conception testimony. PO’s “rule of reason” argument also fails because it goes to the credibility of PO’s *testimony*, not to the corroboration requirement for Exhibits 2002-04. Furthermore, even if the “rule of reason” applied, Levine’s proffered evidence is insufficient. Boeing’s motion should be granted.

II. Argument

A. Physical Exhibits Must Be Independently Corroborated As To Date And Origin

“The principle that corroboration is not required when a party seeks to prove conception through the use of physical exhibits is directed to the technical content of a document, not to the date or origin of the document.” *Microsoft Corp. v. Surfcast, Inc.*, IPR2013-00292, Paper 93, 17. In other words, the patentee need not introduce evidence from an independent witness as to what a document discloses, since the Board can make that determination on its own. However, the date and origin of documents used to establish conception must be independently corroborated precisely to avoid the risk of after-the-fact fabrication. *Id.*

PO argues that *Surfcast* is distinguishable because one of the exhibits at issue in that case, a notebook, was undated. Opp’n. 1, 6. But the Board in *Surfcast* excluded multiple uncorroborated documents, including dated emails. *See Microsoft Corp.*, IPR2013-00292, Paper 93, pp. 16, 52. The Board’s reasoning did not turn on the notebook being undated (a fact that is not recited in the decision), but rather, on its finding that, for multiple exhibits, “the date of the physical exhibits is not corroborated sufficiently...” *Id.* at 17.

Similarly, in *Neste*, the board excluded a dated spreadsheet because it was not independently authenticated. *Neste Oil Oyj*, IPR2013-00578, Paper 52, 3-4.

PO’s attempt to distinguish *Neste* by disavowing his own testimony fails because,

as explained above, his disavowal does not remove the requirement that an inventor cannot rely solely on his “own statements *and documents.*” *Procter & Gamble*, 566 F.3d at 999 (emphasis added).

PO advocates the same incorrect reading of Federal Circuit authority regarding “physical exhibits” that was rejected in *Surfcast*. The Federal Circuit authority supports Boeing’s position, not PO’s, because in *every case* independent corroboration was required. In *Price*, the document at issue was independently authenticated by a corporate secretary. *Price v. Symsek*, 988 F.2d 1187, 1195-96 (Fed. Cir. 1993). The Federal Circuit simply held that the secretary did not need to understand the “content” or “significance” of the drawings in the document in order to provide corroborating evidence. *Id.* In *Mahurkar*, the physical evidence consisted of actual reductions to practice of prototypes of the invention which were, in fact, independently corroborated. *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1578-79 (Fed. Cir. 1996). *Brown* underscored that “the physical evidence in this case may not single-handedly corroborate [the inventor’s] testimony.” *Brown v. Barbacid*, 276 F.3d 1327, 1335 (Fed. Cir. 2002). *Brown rejected* the proffered date for reduction to practice due to insufficient corroboration, but remanded for a determination of whether the applicant could establish conception based on “independent testimony.” *Id.* at 1336-37. These cases confirm that PO cannot establish conception solely through his own unwitnessed documents.

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