

Filed on behalf of Seymour Levine

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE BOEING COMPANY
Petitioner,

v.

SEYMOUR LEVINE
Patent Owner

Case IPR2016-00023

Patent RE039,618

**PATENT OWNER PRELIMINARY RESPONSE TO PETITION
PURSUANT TO 37 C.F.R. § 42.107**

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. THE BOARD SHOULD DENY THIS PETITION UNDER § 325(d)	2
A. Boeing’s Second Petition Presents the Same Art and the Same Argument as Its Original Petition	2
B. Boeing’s Second Petition Should be Denied for the Same Reason Its Proposed Motion for Supplemental Information Should be Denied	6
III. CONCLUSION.....	10

TABLE OF AUTHORITIES

	<u>Page</u>
<u>Cases</u>	
<i>Butamax Advanced Biofuels LLC v. Gevo, Inc</i> Case IPR2013-00581 (PTAB Oct 14, 2014) (Paper 8)	2, 4, 5, 8
<i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd</i> Case IPR2013-00324 (PTAB Nov. 21, 2013) (Paper 19)	2, 8
<i>Maxlinear, Inc. v. Cresta Technology Corp</i> Case IPR2015-00591 (PTAB June 15, 2015) (Paper 9).....	8
<i>Mitsubishi Plastics, Inc., v. Celgard, LLC</i> Case IPR2014-00524 (PTAB Nov. 28, 2014) (Paper 30)	6
<i>Rackspace US, Inc. v. PersonalWeb Technologies, LLC</i> Case IPR2014-00057 (PTAB Apr. 30, 2014) (Paper 16).....	7
<i>Unilever, Inc. v. Procter & Gamble Co</i> Case IPR2014-00506 (PTAB July 7, 2014) (Paper 17).....	5
<i>Vitaulic Co. v. The Viking Corp</i> Case IPR2015-00423 (PTAB Aug 4, 2015) (Paper 16)	7
<i>ZTE Corp. v. ContentGuard Holdings, Inc</i> Case IPR2013-00454 (PTAB Sept. 25, 2013) (Paper 12)	4, 9
<i>ZTE Corp. v. ContentGuard Holdings, Inc</i> Case IPR2013-00139 (PTAB Jul 30, 2013) (Paper 27).....	6

Statutes

35 U.S.C. § 314(a)	8
35 U.S.C. § 325(d)	passim
37 C.F.R. § 42.1(b)	9
37 C.F.R. § 42.108(b)	8

Patent Owner Seymour Levine (“Levine”) hereby submits this preliminary response to the Petition filed by Petitioner The Boeing Company (“Boeing”), which was accorded a filing date of October 7, 2015 (Paper 5), seeking *inter partes* review of claims 4, 5, 8, 9, 10, 14 and 16 of U.S. Reissued Patent No. RE39,618 (“the ’618 patent”).

I. INTRODUCTION

By its own admission, this petition “is identical to the petition in pending IPR2015-01341, except” that Boeing has supplemented its expert’s declaration specifically “to address purported deficiencies raised in the PO Preliminary Response in IPR2015-01341.” Pet. at 1.

On December 21, 2015, the Board instituted review on all challenged claims in IPR2015-01341 (the “’1341 case”), IPR2015-01341, Paper 10, rendering this petition completely redundant. For the reasons discussed below, the Board should exercise its discretion under 35 U.S.C. § 325(d) and deny this petition.

The Patent Owner does not repeat here its arguments on the merits as those have already been considered by the Board in the ’1341 case. Patent Owner, nevertheless, expressly reserves its right to address this IPR on the merits should it be instituted in any respect.

II. THE BOARD SHOULD DENY THIS PETITION UNDER § 325(d)

The Director, and, by extension, the Board, has broad discretion to deny a petition for *inter partes* review that raises substantially the same prior art or arguments previously presented to the Office:

In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

35 U.S.C. § 325(d).

A. Boeing's Second Petition Presents the Same Art and the Same Argument as Its Original Petition

The Board has invoked this authority numerous times to deny petitions that merely recycle previously presented prior art references and couple them with modified arguments that attempt to address the failings of the petitioner's first effort. It has done so both when its prior decision denied review and, as here, where the prior decision instituted review. *See, for example, Butamax Advanced Biofuels LLC v. Gevo, Inc.*, Case IPR2013-00581, slip op. at 9-10, (PTAB Oct 14, 2014) (Paper 8) (denying review under § 325(d) where petition sought to add evidence to correct mistake in prior petition where review had been instituted against the same claim); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, Case IPR2013-00324, slip op. at 6-7 (PTAB Nov. 21, 2013) (Paper 19)

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.