UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE BOEING COMPANY,

Petitioner

v.

SEYMOUR LEVINE,

Patent Owner

Case No. **IPR2016-00023**
Patent No. RE39,618

PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)

TABLE OF CONTENTS

Page

I. STATEMENT OF THE PRECISE RELIEF REQUESTED 1
II. STATEMENT OF MATERIAL FACTS 2
III. STATEMENT OF REASONS FOR RELIEF REQUESTED 5
A. Institution And Joinder Are Appropriate If Supplemental Information Is Disallowed 7
1. Boeing's Request Is Timely 9
2. Joinder Would Be Efficient In This Case 9
B. No New Grounds of Unpatentability Are Asserted In the Petition 11
C. Joinder Will Have No Impact, Or Minimal Impact If Any, On the Trial Schedule and Costs for the Existing Review 11
D. Procedures to Simplify Briefing and Discovery 12
IV. CONCLUSION 12

TABLE OF AUTHORITIES

Page(s)

CASES

Dell Inc. v. Network-1 Security Solutions, Inc.,
IPR2013-00385 (PTAB July 29, 2013) 6

Kyocera Corp. v. Softview LLC,
IPR2013-0004 (PTAB April 24, 2013) 7

Zhongshan Broad Ocean Motor Co., Ltd., Broad Ocean Motor LLC, and Broad Ocean Technologies, LLC v. Nidec Motor Corporation, IPR2015-00762 (PTAB October 5, 2015) 5

STATUTES

35 U.S.C. § 103 ..... 2, 3

35 U.S.C. § 315(c) 1, 5, 7

REGULATIONS

37 C.F.R. § 42.1(b) 8, 9

37 C.F.R. § 42.122(b) 1, 6, 9

37 C.F.R. § 42.123(a) 7

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

The Boeing Company ("Petitioner" or "Boeing") respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the Petition for *Inter Partes* Review of U.S. Patent No. RE39,618 filed in the above-captioned proceeding, IPR2016-00023 ("second petition"), with pending *inter partes* review Case No. IPR2015-01341 ("first petition"), which was instituted on December 21, 2015. *See The Boeing Company v. Seymour Levine*, Case No. IPR2015-01341, Paper 10.

The second petition is substantively identical to the first petition with the exception of five additional paragraphs in the expert declaration and exhibits referenced therein (as well as further evidence that a certain reference is a printed publication). Boeing filed the second petition before any decision by the Board on the first petition, out of an abundance of caution to provide a more robust record regarding the "portable/positionable" limitation. In instituting the first petition, the Board found that Boeing's evidence for that limitation was sufficient. But the more robust record is available and appropriate, and the Patent Owner has indicated that he will continue to press during these proceedings that the record be limited to less than the full record Boeing has created in a timely way for this patent and the claims and grounds at issue. Boeing thus asks the Board to resolve the dispute over the record in one of two alternative ways: the Board should grant the second petition and join it to the first petition only as alternative relief to a motion to add the above-referenced expert declaration and exhibits as supplemental information. The Board has

authorized Boeing to make the latter motion, which will be filed within six days. If Boeing's motion to file the additional material as supplemental information is granted, Boeing will withdraw this motion for joinder, and will withdraw the second petition as well.

If Boeing is not permitted to file the additional material as supplemental information in the first petition, Boeing submits that institution of the second petition and joinder will promote the just, speedy, and inexpensive resolution of the validity of the '618 Patent. The second petition was timely filed within the one-year statutory period from the service of Levine's lawsuit, involves the same patent as the first, challenges the same claims, and involves the same prior art grounds on which review was instituted in the first petition Furthermore, review was only recently instituted in the first petition and no post-institution discovery has taken place, and as such there will be little or no impact on the trial schedule for the existing review.

II. STATEMENT OF MATERIAL FACTS

A. Patent Owner Seymour Levine served Boeing with a complaint asserting infringement of the '618 Patent on September 3, 2014. Levine voluntarily dismissed the action without prejudice. *See Levine v. The Boeing Company*, No. 14-cv-6859 (C.D. Cal.).

B. Levine sued Boeing in October 2014 in the Northern District of Illinois. The complaint, which asserted infringement of the '618 Patent, was served on Boeing on October 8, 2014. That case was transferred to the Western

DOCKET ALARM

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.