

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 IPR2015-01341  
Patent RE39,618

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Before MICHAEL W. KIM, TRENTON A. WARD, and  
DANIEL N. FISHMAN, *Administrative Patent Judges*.

WARD, *Administrative Patent Judge*.

ORDER

Petitioner's Motion to Submit Supplemental Information  
*37 C.F.R. § 42.123(a)*

## I. INTRODUCTION

We authorized the Boeing Company (“Petitioner”) to file a motion to submit supplemental information and Seymour Levine (“Patent Owner”) to file an opposition thereto. Paper 20, 2. Petitioner moves to submit supplemental information under 37 C.F.R. § 42.123(a). Paper 21 (“Mot.”). Patent Owner opposes. Paper 23 (“Opp.”). The supplemental information consists of Supplemental Declaration of Dr. Albert Helfrick (“Supplemental Helfrick Declaration”) and associated Exhibits A–C collectively filed as Exhibit 1042. Upon consideration of the documents and the parties’ arguments, and for the reasons stated below, Petitioner’s motion is granted.

## II. DISCUSSION

Pursuant to 37 C.F.R. § 42.123, a petitioner, upon meeting certain requirements, may request authorization to file a motion to submit supplemental information in connection with a petition. In that respect, 37 C.F.R. § 42.123 states, in part, the following:

§ 42.123 Filing of supplemental information.

(a) Motion to submit supplemental information. Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

(1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date for which the trial has been instituted.

(2) The supplemental information must be relevant to a claim for which the trial has been instituted.

As to the first requirement, we note that Petitioner’s request for authorization was made within one month of the institution of trial. *See* Paper 20, 2. With respect to the second requirement, Petitioner argues that

the supplemental information relates to the recitation in independent claim 4 of a “transmitter portable” and the recitation in independent claim 14 of a “transmitter positionable.” Mot. 3. Specifically, Petitioner argues that the supplemental information addresses the connectability and removability of certain transmitters disclosed in the prior art references relied upon in the Petition. Mot. 4. Additionally, Petitioner states that the Supplemental Helfrick Declaration provides a “modest amount of expert testimony that confirms the *prima facie* obviousness of the claims.” Mot. 5.

Patent Owner counters that the motion to submit the Supplemental Helfrick Declaration should be denied because it changes the evidence originally relied upon by Petitioner. Opp. 3. More particularly, Patent Owner argues that the Supplemental Helfrick Declaration provides evidence, for the first time, regarding the “portable/positionable” requirement of the claimed transmitter. Opp. 3.

Although a party may meet the requirements laid out in 37 C.F.R. § 42.123 so as to obtain authorization to file a motion to submit supplemental information, that does not, itself, guarantee that the motion will be granted. Indeed, the provision for submitting supplemental information is not intended to offer a petitioner a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a preliminary response. To that end, a petitioner should not expect § 42.123 to present a “wait-and-see” opportunity to supplement a petition after initial comments or arguments have been laid out by a patent owner.

The requirements of 37 C.F.R. § 42.123, however, do clearly contemplate scenarios in which, after institution of trial in an *inter partes* review, supplemental information may prove beneficial to the Board in

reaching a decision with respect to the trial. In promulgating the rule, the Board was cognizant of concerns that may arise due to a belated request to submit supplemental information in establishing an “interests-of-justice” standard in such a circumstance; however, there is no such standard for requests that are presented within one month of the date trial being instituted. *See* 37 C.F.R. § 42.123; *see also* 77 Fed. Reg. 48,707, Comment 91 (Aug. 14, 2012).

We determine that the supplemental information proposed by Petitioner is limited in scope, as directed exclusively to the issue of the “portability” or “positionability” of the transmitter in the challenged claims. *See* Ex. 1042. Furthermore, the Supplemental Helfrick Declaration is limited to 4 pages providing only 7 paragraphs of testimony from Dr. Helfrick, in comparison to the original 48 page, 107 paragraph, Helfrick Declaration submitted with the Petition. *See id.* Additionally, we are not persuaded by Patent Owner’s argument that the Supplemental Helfrick Declaration changes the evidence originally relied upon. The additional testimony from Dr. Helfrick, and related exhibits, do not alter the ground as proposed in the Petition but merely provide supplemental information seeking to support the ground as proposed. *Compare* Pet. 33; Ex. 1042. As Petitioner argues, the supplemental information is additional evidence provided to support Petitioner’s proposed *prima facie* case of obviousness set forth in the Petition. Mot. 4–5.

Petitioner also suggests that it is more appropriate to bring this supplemental information forward at this stage in the proceeding, rather than in connection with Petitioner’s Reply to Patent Owner’s Response, so that Patent Owner has the opportunity to cross-examine the expert. Mot. 5. We

agree that the inclusion of the evidence at this stage in the proceeding will provide Patent Owner with a greater opportunity to respond to the supplemental information and will further the Board's mandate to "secure the just, speedy, and inexpensive resolution" of the proceeding. 37 C.F.R. § 42.1(b).

Accordingly, in view of the circumstances of this proceeding, we grant Petitioner's motion to submit the Supplemental Declaration of Dr. Albert Helfrick and associated Exhibits A–C (Ex. 1042). Furthermore, as Patent Owner has already filed its Patent Owner Response in this proceeding, we authorize Patent Owner to file a Supplemental Patent Owner Response to address issues raised by the Supplemental Declaration of Dr. Albert Helfrick and associated Exhibits A–C (Ex. 1042). Should Patent Owner choose to file a Supplemental Patent Owner Response, it must not exceed five pages and must be filed on or before April 29, 2016.

### III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's motion for leave to file a Supplemental Declaration of Dr. Albert Helfrick and associated Exhibits A–C (Ex. 1042) is granted;

FURTHER ORDERED that Exhibit 1042 be, and hereby is, entered into the record; and

FURTHER ORDERED that, if Patent Owner so chooses, Patent Owner may file, on or before April 29, 2016, a Supplemental Patent Owner Response of up to five pages to address only issues raised by the

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