

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

PETITIONER'S MOTION TO EXCLUDE

I. Introduction and Legal Standard

Pursuant to 37 C.F.R. §§ 42.62 and 42.64, Petitioner hereby moves to exclude certain evidence propounded by the Patent Owner. Because Petitioner has timely objected to Patent Owner's evidence that does not comport with the Federal Rules of Evidence ("FRE") and/or was untimely produced, the Board should grant this Motion and exclude the evidence identified below from consideration.

II. Exhibits 2002-2004 Should Be Excluded Because They Have Not Been Independently Authenticated

Patent Owner submitted Exhibits 2002-2004 with his Preliminary Response, and argued in his Response that the documents establish a priority date prior to the filing date of the application that led to the '618 patent. Paper 28 at 13-21. Patent Owner described Exhibits 2002-2004 as follows.

Exhibit	Description
2002	Handwritten notes of inventor Seymour Levine
2003	Draft invention disclosures prepared by Seymour Levine, dated October 9, 1996.
2004	Draft invention disclosures prepared by Seymour Levine, dated October 23, 1996.

Paper 7 at v.

Petitioner timely objected to each of these documents based on, *inter alia*, inadequate authentication under FRE 901, which requires that "the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is." Paper 12. Each of Exhibits 2002-2004 fails this requirement because

each lacks the *independent* corroboration that is required to authenticate evidence of prior conception. *See Procter & Gamble Co. v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 999 (Fed. Cir. 2009) (inventor “must provide independent corroborating evidence *in addition to his own statements and documents*”) (emphasis added); *Microsoft Corp. v. Surfcast, Inc.*, IPR2013-00292, Paper 93, 17 (excluding purported evidence of conception lacking independent corroboration); *Neste Oil Oyj v. Reg Synthetic Fuels, LLC*, IPR2013-00578, Paper 52, 4 (same).

Levine submitted a declaration with his Response in which he testifies that Exhibits 2002-2004 are “true and correct copies” of notes and “invention disclosures” that he created at various times in 1996. Ex. 2009 at 1.¹ Mr. Levine’s testimony, however, is insufficient as a matter of law to authenticate his own unwitnessed notes and papers. “It is well established that in order for a

¹ Levine submitted Exhibit 2009 together with his Response on March 28, 2016. That is far more than the 10 days permitted to submit supplemental evidence in response to Petitioner’s evidentiary objections of January 6, 2016. 37 C.F.R. § 42.64(b). The untimeliness of Levine’s purported authentication evidence is a further reason to grant Petitioner’s motion to exclude the documents under FRE 901. *See, e.g., Toshiba Corp. v. Optical Devices, LLC*, IPR2014-01446, Paper 31, at 30-34 (excluding untimely evidence).

contemporaneous document to be accorded any corroborative value[,] the testimony of a witness other than the inventor, who is shown to have understood the recorded information, is generally *necessary to authenticate the document's contents* as well as to explain the witness' relationship to the document in question.” *Horton v. Stevens*, 7 U.S.P.Q.2d 1245, 1988 WL 252359 at *4 (BPAI Mar. 8, 1988) (emphasis added). That is, a patent owner's testimony not only needs to be corroborated with independent evidence, but that evidence, to be admissible, must be authenticated by someone than the inventor. *Neste*, IPR2013-00578, Paper 52, 3 (“While normally, the testimony of [the alleged inventor]—as a witness having personal knowledge of the documents—could be sufficient to ‘support a finding that the item is what the proponent claims is it,’ the context in which these exhibits are offered requires more.... [I]ndependent evidence of authenticity is required” to satisfy FRE 901). Lacking independent evidence of authenticity, Levine's purported conception evidence fails this threshold test for admissibility.

Exhibit 2002: Levine's declaration states that Exhibit 2002 is a copy of his notes from May 1996, but there is no independent evidence to corroborate that the document is what Levine says it is or that it was created on the date claimed by Levine. Levine cannot use this type of “circular” evidence where he seeks to rely on documents to corroborate his testimony, but then turns around and offers only

his testimony “to provide the date or other authentication of that document.”

Neste, IPR2013-00578, Paper 52, 4 (citing *In re NTP, Inc.*, 654 F.3d 1279, 1291 (Fed. Cir. 2011)). Thus, the document must be excluded. *See id.*

Exhibit 2003: Similarly, Levine describes Exhibit 2003 as an “invention disclosure” but he does not claim to have disclosed it to anyone. Ex. 2002, ¶ 4. Instead, Levine asserts that it is a “version” of a different document that he purportedly provided to Mr. Townsley, his lawyer, on a different date. *Id.* Mr. Townsley, for his part, testifies only that he received something “similar in format and content” to Exhibit 2003, thus confirming that he never actually saw Exhibit 2003. *See* Ex. 2010 (Townsley Decl.) ¶ 2. Once again, the only testimony establishing the authenticity of Exhibit 2003 is that of Mr. Levine, and it must be excluded for the same reason as Exhibit 2002.²

² Even if the testimony of Mr. Townsley were sufficient to establish Exhibit 2003 as a *version* of a document created by Mr. Levine, it is plainly inadequate to establish that Mr. Levine created Exhibit 2003 on October 9, 1996. *See Microsoft Corp. v. Surfcast, Inc.*, IPR2013-00292, Paper 93, 17 (“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. The law requires sufficient proof for the date

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