

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 RE39,618

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

WARD, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
and Dismissing Motion for Joinder
35 U.S.C. §§ 315(c), 325(d); 37 C.F.R. §§ 42.122, 42.108

I. INTRODUCTION

A. Background

The Boeing Company (“Petitioner”) filed a Petition seeking to institute an *inter partes* review of claims 4, 5, 8, 9, 10, 14, and 16 (“the challenged claims”) of U.S. Patent No. RE39,618 (Ex. 1001, “the ’618 patent”) pursuant to 35 U.S.C. §§ 311–319. Paper 1 (“Pet.”). Seymour Levine (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). After filing the Petition, Petitioner subsequently filed a Motion for Joinder, requesting joinder with an *inter partes* review trial currently pending before the Board, *The Boeing Company v. Levine*, Case IPR2015-01341. Paper 7 (“Joinder Motion”). Patent Owner filed an Opposition to Petitioner’s Motion for Joinder. Paper 8 (“Joinder Opposition”). We have statutory authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Upon consideration of the Petition, Motion for Joinder, and the specific facts of this case, we exercise our discretion to deny review under 35 U.S.C. § 325(d). Because we determine that the Petition does not warrant institution, we are prohibited from granting, and thus dismiss as moot, the Motion for Joinder under 35 U.S.C. § 315(c).

B. Additional Proceedings

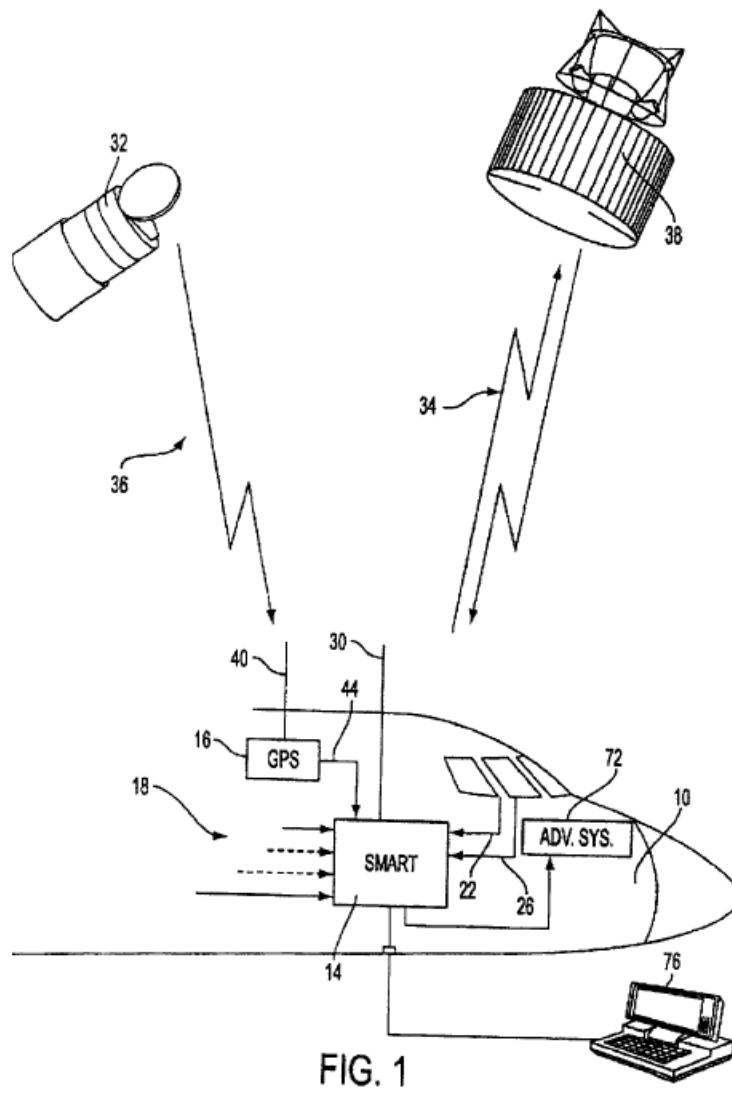
The parties indicated the ’618 patent is the subject of the following district court action: *Levine v. The Boeing Company*, No. 14-cv-1991 (W.D. Wash.). Pet. 1; Paper 5, 1. The ’618 patent is also the subject of an *inter partes* review trial currently pending before the Board, *The Boeing Company*

v. Levine, Case IPR2015-01341 (the “1341 IPR”). In that proceeding, we instituted review of claims 4, 5, 8, 9, 10, 14, and 16 of the ’618 patent, the same claims challenged in this proceeding, on December 21, 2015. 1341 IPR, Paper 10. Trial is currently ongoing in the 1341 IPR, with oral argument scheduled for September 14, 2016. 1341 IPR, Paper 24.

C. The ’618 Patent

The ’618 patent is titled “Remote, Aircraft, Global, Paperless Maintenance System” and generally relates to a system that monitors performance parameters and aircraft operational parameters, and broadcasts this information along with aircraft identification, audio, video, global positioning and altitude data, to a worldwide two-way RF network. Ex. 1001, Abstract. The ’618 patent discloses that the information is monitored and recorded at a remote, centralized location and analysis of this information allows identification of problems and generation of advisories. *Id.*

Figure 1 of the ’618 patent, reproduced below, illustrates an embodiment of the system described:



As shown above in Figure 1, the '618 patent discloses an aircraft 10 with Sensor Multiplexer Receiver & Transmitter ("SMART") 14, which can receive aircraft performance and control data 18, acoustic data 22, video data 26, and information from GPS receiver system 16. *Id.* at 4:57–65. SMART 14 periodically samples the sensor signals 18, 22, 26, 44 and adds to each signal a sensor identification label, an aircraft identification label, and a configuration label. *Id.* at 5:1–5. Aircraft 10 equipped with SMART 14 transmits the sensor data over a UHF radio to communication satellite 38, which relays the data to Central Ground Based Processing Station

(“CGBS”) 42. *Id.* at 5:21–28. CGBS 42 includes processing station 62 for data analysis and problem simulation and advisory module 70 for generating aircraft advisories. *Id.* at 5:49–53.

D. Illustrative Claims

Claims 4 and 8 are illustrative of the claimed subject matter and are reproduced below.

4. An aircraft maintenance system for use on an aircraft having a flight data recorder, the maintenance system comprising:

a transmitter portable to be placed on an aircraft, said transmitter configured for transmission of digital aircraft performance data across a communication network while said aircraft is in flight; and

a central station connected to said communication network configured to receive and analyze said digital aircraft performance data to generate maintenance advice for said aircraft while said aircraft is in flight,

wherein said digital aircraft performance data includes an identifier unique to a particular aircraft and a configuration label, and at least a portion of said digital aircraft performance data comprises data directed to the flight data recorder.

8. The aircraft maintenance system of claim 4 wherein said digital aircraft performance data includes aircraft position data directed to said flight data recorder.

E. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of the challenged claims of the '618 patent based on the following grounds, the same grounds as raised in the 1341 IPR:

Claims	References	Basis
4, 5, 14, and 16	Ward ¹ in view of ARINC 624-1 ²	§ 103
8, 9, and 10	Ward in view of ARINC 624-1 in further view of Monroe ³	§ 103
4, 5, 14, and 16	Dyson ⁴ in view of Chetail	§ 103
8, 9, and 10	Dyson in view of Chetail ⁵ in further view of Monroe	§ 103
4, 5, 14, and 16	Dowling ⁶ in view of ARINC 624-1	§ 103
8, 9, and 10	Dowling in view of ARINC 624-1 in further view of Monroe	§ 103
8, 9, and 10	Ward in view of ARINC 624-1, ARINC 702-6, ⁷ and FAA, Increased FDR Parameters ⁸	§ 103
8, 9, and 10	Ward in view of ARINC 624-1, FAA, Increased FDR Parameters and Farmakis ⁹	§ 103

¹ M J Ward, “Power Plant Health Monitoring – The Human Factor,” February 1992 (Ex. 1015) (“Ward”).

² “Design Guidance for Onboard Maintenance System,” ARINC Report 624-1, August 1993 (Ex. 1014) (“ARINC 624-1”).

³ US Patent No. 5,798,458, filed October 28, 1996 (Ex. 1017) (“Monroe”).

⁴ R.J.E. Dyson, “Commercial Engine Monitoring Status at GE Aircraft Engines,” October 1988 (Ex. 1019) (“Dyson”).

⁵ P. Chetail, “LE CFM 56-5 SUR A320 A Air France,” October 1988 (Ex. 1018) (“Chetail”).

⁶ Drew Dowling and Richard A. Lancaster, “Remote Maintenance Monitoring Using a Digital Link,” December 1984 (Ex. 1013) (“Dowling”).

⁷ “Flight Management Computer System,” ARINC Characteristic 702-6, June 10, 1994 (Ex. 1016) (“ARINC 702-6”).

⁸ “Increased Flight Data Recorder Parameters,” Federal Register 13,862–13,864, March 14, 1995 (Ex. 1011) (“FAA, Increased FDR Parameters”).

⁹ US Patent No. 5,714,948, filed April 16, 1996 (Ex. 1021) (“Farmakis”).

II. ANALYSIS

Our statutory authority to institute *inter partes* review derives from 35 U.S.C. § 314(a), which provides that a review may not “be instituted unless the Director¹⁰ determines that the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” As we have recognized, “Congress did not mandate that an *inter partes* review must be instituted under certain conditions. Rather, by stating that the Director—and by extension, the Board—*may not* institute review *unless* certain conditions are met, Congress made institution discretionary.” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, Case IPR2013-00324, slip op. at 4 (PTAB Nov. 21, 2013) (Paper 19). In determining whether to institute an *inter partes* review, the Board may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b); *see* 35 U.S.C. § 314(a).

Our discretion is further guided by 35 U.S.C. § 325(d), which states, in relevant part, that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31,¹¹ 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.”

¹⁰ “The Board institutes the trial on behalf of the Director.” 37 C.F.R. § 42.4(a).

¹¹ Chapter 31 of the Patent Act covers *inter partes* review proceedings. Thus, although § 325(d) appears in Chapter 32, which is directed to post-grant reviews, it is applicable to *inter partes* reviews.

The Board, acting on behalf of the Director, also has broad discretion whether to join a party to an *inter partes* review under 35 U.S.C. § 315(c):

JOINDER.—If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

Thus, joinder in an *inter partes* review may be warranted in certain circumstances, but is not required in any. *See Sony Corp. v. Network-1 Sec. Solutions, Inc.*, Case IPR2013-00386, slip. op. at 3 (PTAB July 29, 2013) (Paper 16) (“[t]he Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations”). The statute does, however, set forth at least one circumstance in which we do *not* have the discretion to join a party: if the Board determines that the second petition does not warrant institution. 35 U.S.C. § 315(c) (“the Director . . . may join as a party . . . any person who properly files a petition . . . that the Director . . . determines warrants the institution of an *inter partes* review under section 314”).

With these statutory provisions in mind, we turn to the question of whether, in our discretion, the Petition in this case warrants *inter partes* review. Petitioner states in the Joinder Motion that its “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).” Joinder Motion. 1. Furthermore, Petitioner explains that it is separately seeking leave in the first case, the 1341 IPR, to add the only new material contained in this second petition, namely the limited additional testimony and related exhibits from its declarant, Dr. Albert Helfrick, as supplemental information in the first petition pursuant to 37 C.F.R. § 42.123(a). *Id.* at 7. Should Petitioner’s motion to submit supplemental information in the 1341 IPR be denied, Petitioner alternatively “seeks institution of the second petition and joinder to the instituted IPR2015-01341.” *Id.* In other words, we understand that Petitioner filed this second petition “in an abundance of caution,” in the event that we deny its Motion to Submit Supplemental Information in the 1341 IPR. *See* 1341 IPR, Paper 21.

Concurrent with the entry of this Decision, the Board has issued an Order granting Petitioner’s Motion to Submit Supplemental Information in the 1341 IPR. *See* 1341 IPR, Paper 30. The Order granting Petitioner’s Motion to Submit Supplemental Information in the 1341 IPR authorizes the entry of the Supplemental Declaration of Dr. Albert Helfrick and associated Exhibits A–C. *See id.* (authorizing the entry of 1341 IPR, Ex. 1042). In view of the Board’s entry of the supplemental information in related 1341 IPR, we determine that this second petition is rendered moot because, as stated by Petitioner, “[t]he second petition is substantively identical to the first petition with the exception of five additional paragraphs in the expert declaration and exhibits referenced therein.” Joinder Motion 1.

Because the Petition presents substantially the same prior art, and substantially the same arguments, as the Petition in the 1341 IPR, we

exercise our discretion to deny institution of review under 35 U.S.C. § 325(d).

III. SUMMARY

For the foregoing reasons, we determine that the Petition presents substantially the same art and arguments as the Petition in the 1341 IPR, and, taking into account the grant of the motion to submit supplemental information in the 1341 IPR, we exercise our discretion to deny institution of review under 35 U.S.C. § 325(d). Consequently, we are prohibited from granting, and thus dismiss as moot, Petitioner's Motion for Joinder with the 1341 IPR.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied* as to all challenged claims of the '618 patent; and

FURTHER ORDERED that the Motion for Joinder with *The Boeing Company v. Levine*, Case IPR2015-01341 is *dismissed*.

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PETITIONER:

Ryan McBrayer
Chun Ng
PERKINS COIE LLP
rmcbrayer@perkinscoie.com
cng@perkinscoie.com

PATENT OWNER:

Bruce R. Zisser
Amardeep (Amar) L. Thakur
QUINN EMANUEL URQUHART & SULLIVAN, LLP
brucezisser@quinnemanuel.com
amarthakur@quinnemanuel.com