

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

C&D ZODIAC, INC.
Petitioner

v.

B/E AEROSPACE, INC.
Patent Owner

Case IPR2014-00727
Patent 8,590,838

PETITIONER'S MOTION TO COMPEL ROUTINE DISCOVERY

Pursuant to the Board’s Order Authorizing Motion for Discovery (Paper No. 33), Petitioner C&D Zodiac, Inc. (“C&D”) moves to compel Patent Owner B/E Aerospace, Inc. (“B/E”) to comply with its obligation under 37 C.F.R. § 42.51(b)(1)(iii) to produce as “routine discovery” information inconsistent with positions taken by B/E in its Response.

The two prior art references at issue in this proceeding – Betts and the Orange Book – describe a coat closet having a recessed forward wall for the McDonnell Douglas DC-10 aircraft. In its Response, B/E maintains that a person of ordinary skill in the art would not have applied the recessed forward wall of the DC-10 coat closet to lavatories or other enclosures. As evidenced by the declaration of Paul Sobotta submitted herewith as Exhibit 1011, B/E’s patentability argument is directly contradicted by an enclosure unit developed in the early 1990s by Flight Structures, Inc. (“FSI”), a company that B/E later acquired. FSI in fact applied the recessed forward wall of the DC-10 coat closet to an entry for a crew rest for KLM Royal Dutch Airlines that is modeled on a lavatory.¹ As evidenced by B/E’s disclosures in other patent applications, B/E was aware of the KLM crew rest when it filed its Response.

In view of this evidence, the Board should compel B/E to produce the

¹ The KLM crew rest is unavailable as prior art here, as it does not qualify as a “prior art consisting of patents or printed publications” under 35 U.S.C. § 311(b).

following documents, which are inconsistent with B/E's positions in its Response:

1. Documents concerning the development of the KLM crew rest that reference (a) the DC-10 coat closet or (b) any other monument with a recessed forward wall.
2. Documents concerning the development of the alleged invention of the '838 Patent or B/E's "Spacewall" lavatory (including any documents of Robert Papke or Don Cook), that reference (a) the KLM crew rest, (b) the DC-10 coat closet, or (c) any other monument with a recessed forward wall.

I. FSI Applied the Forward Wall of the DC-10 Coat Closet Described in Betts and the Orange Book to a Lavatory-Shaped Enclosure

In the early 1990s, KLM awarded FSI, a manufacturer of airline interiors, a contract to develop an overhead crew rest for the Boeing 747 aircraft in its fleet. Ex. 1011, ¶ 7. Paul Sobotta, the Project Engineer assigned to the development of the KLM crew rest, supervised engineers working on the design. *Id.* at ¶ 8. One of those engineers was Robert Papke. *Id.* Mr. Papke was a primary designer on the project and performed much of the engineering design and drafting. *Id.*

The overhead crew rest made use of overhead attic space in the long-haul 747 aircraft to provide crew members a space to rest during long flights. *Id.* at ¶ 9. To provide access to the attic space, FSI designed an entry for the crew rest in front of one of the doors on the right side of the aircraft – a typical location for a

lavatory on a Boeing 747. *Id.* at ¶ 10. The crew rest entry design was based on a lavatory envelope – i.e., the outer walls that enclose a lavatory. *Id.* FSI modified the inside of the lavatory to include stairs to access the overhead space and further provided a lavatory sink (and related plumbing), lighting, mirror, soap dispenser, shaving outlet, and amenity stowage. *Id.* at ¶¶ 10, 16.

During a design review, KLM deemed the initial design unacceptable because the flat forward wall prevented recline for the row of seats immediately forward of the enclosure. *Id.* at ¶ 12. Seat recline was required by the airline, and providing recline would have required either removing seats or compressing seat spacing in the passenger cabin, neither of which was acceptable to KLM. *Id.*

An engineer with KLM provided a solution to the problem. *Id.* at ¶ 13. KLM's fleet included DC-10 aircraft with the coat closets with recessed forward walls that are described in the Betts and Orange Book references. *Id.* KLM suggested that FSI apply the recessed forward wall of the DC-10 coat closets to the crew rest entry in order to permit the seats located immediately in front of the entry to be located further aft while maintaining recline. *Id.* The airline provided FSI with materials detailing the forward wall of the DC-10 coat closet to assist with the redesign. *Id.* at ¶ 14. Mr. Papke redesigned the forward wall of the crew rest to provide a recess in a matter of days. *Id.* at ¶ 15. A rendering of the crew rest is provided as Exhibit 1012.

In August 1998, B/E acquired Flight Structures, Inc. Ex. 1014 (B/E Form 10-Q dated Sept. 24, 1998), at 5. B/E therefore is uniquely in possession of information regarding the development of the KLM crew rest. Mr. Papke remains employed by B/E. Further, at least one of the named inventors, Don Cook, previously was an FSI employee and now is employed by B/E.

II. B/E Was Aware of the FSI-Developed Crew Rest Well Before it Filed Its Patent Owner Response

On March 18, 1999, B/E's patent attorney, James Paul, submitted some limited information regarding the KLM crew rest in an Information Disclosure Statement ("IDS") filed in relation to U.S. Patent No. 6,520,451. Ex. 1015 at 1; Ex. 1016 at 63-91. On December 22, 2014, Mr. Paul again submitted KLM crew rest-related information in another IDS on behalf of B/E, this time in relation to Application No. 14/043,500, which is a continuation of the '838 Patent. Ex. 1017 at 249-54. Mr. Paul also represented B/E during prosecution of the '838 patent. *See* Ex. 1002 at 4.

III. B/E Should Be Required to Produce the Requested Documents as “Routine Discovery” of Information Inconsistent with Arguments Advanced in B/E’s Response

B/E is required to and already should have produced the requested information as “routine discovery” of information inconsistent with positions advanced by B/E in its Response under 37 C.F.R. § 42.51(b)(1)(iii). A theme of B/E’s Response is that a person of ordinary skill in the art would not have applied

the recessed forward wall of the DC-10 coat closet described in Betts and the Orange Book to other enclosures and instead would have provided a flat-walled enclosure. For example, at the outset, B/E asserts that “the conventional approach to efficiently using space in an aircraft avoided expanding lavatories beyond their flat, rectangular confines.” Response at 1. And even more broadly, “Petitioner’s obviousness assertions hang entirely on generalizations about a desire for space efficiency—desires that have purportedly existed for decades and yet never resulted in any product or reference that included all the ‘838 patent’s claim elements.” *Id.* at 3-4. B/E further asserts that “Betts would not have been modified into a lavatory stall unit” and that “those well aware of Betts, and looking to adapt its disclosure to numerous situations needing a lavatory, would have resorted (and in real life did resort) to a conventional, flat-walled lavatory.” *Id.* at 29, 43. B/E made these arguments despite **knowing** – and without disclosing – that FSI in fact applied the prior art recessed wall to a lavatory-shaped enclosure. The Board should compel B/E to provide the requested documents as “routine discovery.”

IV. Conclusion

For the foregoing reasons, C&D requests that the Board compel B/E to provide the requested discovery.

Dated: April 3, 2015

Respectfully submitted,

By: /s/ John C. Alemanni

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **PETITIONER'S
MOTION TO COMPEL ROUTINE DISCOVERY** has been served by email at
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