

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

BIOGEN MA INC.,
Patent Owner.

Case IPR2018-01403
Patent No. 8,399,514 B2

Before SHERIDAN K. SNEDDEN, JENNIFER MEYER CHAGNON, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

I. INTRODUCTION

With its Petition, Petitioner submitted an Affidavit of Christopher Butler (“Affidavit”), an Office Manager at the Internet Archives, to support its position that Schimrigk 2004 Poster is available as prior art to the ’514 patent. Ex. 1012 (including Mr. Butler’s Affidavit and Schimrigk 2004 Poster). A conference call in this proceeding was held on April 12, 2019, among respective counsel for Petitioner and Patent Owner, and Judges Snedden and Harlow. A transcript of the conference call is entered as Ex. 2041.

During the call, the parties agreed that the Affidavit is evidence subject to routine discovery. *Id.* at 23:5–21. Cross-examination of the opposing party’s declarants typically is provided for under routine discovery. 37 C.F.R. § 42.51(b)(1)(ii); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012). Counsel for Petitioner, however, indicated that it was his belief that Mr. Butler will not make himself available for deposition voluntarily. Ex. 1041, 30:23–24.

Subsequently, in an email correspondence sent to the Board on May 6, 2019, counsel for Patent Owner requested authorization to file a “motion to compel and/or exclude Mr. Butler’s declaration and cross-examination.”

The relevant portion of the email reads as follows:

Patent Owner Biogen conferred with Petitioner Mylan regarding the Mylan declarant, Mr. Butler, who Mylan is unable to make available for cross-examination. Mylan indicated today that it (1) will not seek a subpoena for Mr. Butler to make him available, (2) will oppose Biogen from seeking to file a motion to compel Mr. Butler’s testimony, (3) will not withdraw the

Butler declaration, and (4) will oppose Biogen filing a motion to exclude the Butler declaration.

Accordingly, Biogen renews its request for authorization to file a motion to compel and/or exclude in regard to Mr. Butler's declaration and cross-examination.

II. DISCUSSION

A. Patent Owner's Request for a Motion to Compel Testimony of Mr. Butler

A party in a contested case may apply to a United States court for a subpoena to compel testimony. 35 U.S.C. § 24. A party seeking a subpoena must first obtain authorization from the Board. 37 C.F.R. § 42.52(a). Upon consideration of the parties' positions, we grant Patent Owner the requested authorization to file a motion for authorization to compel testimony of Mr. Christopher Butler (Office Manager of the non-profit digital Library known as the "Internet Archive"), limited to 7 pages and due within 3 business days of the date of this Order. Petitioner may, if it desires, file an opposition, also limited to 7 pages and due within 3 business days of the date of filing of Patent Owner's motion. If Petitioner chooses not to file an opposition, the panel would appreciate the earliest notification thereof possible.

The parties are reminded that the applicable rule for compelled testimony is 37 C.F.R. § 42.52(a), which provides:

(a) Authorization required. A party seeking to compel testimony or production of documents or things must file a

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motion for authorization. The motion must describe the general relevance of the testimony, document, or thing, and must:

(1) In the case of testimony, identify the witness by name or title

See Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,622 (Aug. 14, 2012):

A party in a contested case may apply for a subpoena to compel testimony in the United States, but only for testimony to be used in the contested case. *See* 35 U.S.C. 24. Section 42.52(a) requires the party seeking a subpoena to first obtain authorization from the Board; otherwise, the compelled evidence would not be admitted in the proceeding.

As the moving party, Patent Owner has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). “[T]he motion must be very specific as to exactly what evidence the parties are seeking, and must show good cause before we will grant such a motion.” *Johns Manville Corp. v. Knauf Insulation, Inc.*, Case IPR2015–01453, slip op. at 3 (PTAB Mar. 14, 2016) (Paper 16).

This is of particular importance because Mr. Butler is an uninterested third-party witness, and a cross examination is a significant inconvenience in time and energy where he has already submitted what appears to be an appropriate attestation to his knowledge and actions with respect to the evidence at issue.

Id. Limitations as to time and scope of the cross-examination weigh in favor of granting the request, whereas the lack of such limitations weigh against it. *Samsung Electronics Co., Ltd. v. Black Hills Media, LLC*, Case IPR2014–00717, slip op. at 5 (PTAB Jan. 22, 2015) (Paper 31) (“[W]e will not permit Mr. Cho’s deposition to turn into a ‘fishing expedition’ on other issues.”).

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B. Patent Owner's Request for Motion to Exclude

Regarding Patent Owner's request for authorization to file a motion to exclude, Patent Owner may file its motion to exclude as is currently authorized under the Scheduling Order for this case. *See* Paper 13 (Due Date 5). To the extent Patent Owner is requesting an additional motion to exclude, that request is denied.

III. ORDER

It is

ORDERED that Patent Owner is authorized to file a Motion to Compel Testimony of Mr. Butler, limited to 7 pages and due within 3 business days of the date of this Order.

FURTHERED ORDERED that Petitioner is authorized to file an Opposition to Patent Owner's Motion, limited to 7 pages and due within 3 business days of the date of filing of Patent Owner's Motion.

FURTHERED ORDERED that any request for a motion to exclude in addition to what is currently authorized under the Scheduling Order (Paper 13) is denied.

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