BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,

Petitioners,

v.

BIOGEN MA INC.,

Patent Owner.

Case IPR2019-01403

Patent 8,399,514

Biogen's Motion to Compel

Contents

Mylan obtained the direct testimony of Mr. Christopher Butler ("Butler Declaration," Ex. 1012, p. 1), prepared specifically for and submitted by Mylan in this proceeding, by paying fees to the Internet Archive. As recognized by the Board and conceded by Mylan, the Butler Declaration is subject to routine discovery (Order at 2), which entails the self-executing requirement for Mylan to provide Mr. Butler for cross-examination. 37 CFR § 42.51(b)(1); *BlackBerry Corp. v. Wi-Lan USA Inc.*, IPR2013-00126, Paper 15 at 2 (PTAB Aug. 19, 2013) (noting that "routine discovery under 37 C.F.R. § 42.51(b)(1) is self-executing and self-enforcing"). This required cross-examination is central to "our system of jurisprudence to test the credibility and reliability of proferred [sic] testimony," *Borror v. Herz*, 666 F.2d 569, 573 (C.C.P.A. 1981) (in the interference context).

This motion stems from Mylan's failure to provide Mr. Butler for cross-examination, as required, and its efforts to hinder this routine discovery. Mylan, apparently, did not secure Mr. Butler's agreement to appear for cross-examination when it paid the Internet Archive fees to obtain his direct testimony. And Mylan has further indicated that it (1) refuses to seek a subpoena for Mr. Butler to make him available, (2) opposes Biogen seeking to compel Mr. Butler's testimony, (3) will not withdraw the Butler declaration, and (4) opposes Biogen filing a motion to exclude the Butler declaration. Order at 2; Ex. 2126.

Rather than allow Mylan to flout its obligations under the Board's rules to

Biogen's prejudice, Mylan should be ordered to subpoena, or otherwise secure, Mr. Butler for cross-examination.

In the alternative, Biogen is willing to file for a subpoena of Mr. Butler for cross-examination on the Butler Declaration with the Board's authorization, even though it is not Biogen's burden to do so. *Int'l. Bus. Machs. Co. v Intellectual Ventures II, LLC.*, IPR2015-01323, Paper 15 at 3 (PTAB Feb. 2, 2015). In order to limit the burden on Mr. Butler, Biogen agrees to reduce the time for cross-examination to one hour.

I. Mylan Must Secure Cross-Examination of Its Declarant, Mr. Butler

Mylan failed to produce Mr. Butler for cross-examination after using the Butler Declaration offensively in this proceeding. Order at 2; Ex. 1041, 30:23-24. Mr. Butler's organization, the Internet Archive, is not, however a disinterested third party for which any exception to cross-examination is warranted. *Cf. Toshiba Corp. v. Optical Devices, LLC,* IPR2014-01445, Paper 14 (PTAB May 8, 2015) (denying cross-examination of a third party who had not prepared a declaration submitted in the proceeding). Although not disclosed in the Butler Declaration or Mylan's Petition, declarations from the Internet Archive are a fee-based, revenue generating service. Ex. 2127; Ex. 2129, 15:10-17.

Notwithstanding its routine discovery obligations, Mylan affirmatively seeks to prevent and impede cross-examination of Mr. Butler, indicating that it (1) will

not seek a subpoena for Mr. Butler to make him available, (2) will oppose Biogen's 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. Order at 2; Ex. 2126. Mylan's efforts to simultaneously rely on Mr. Butler's testimony while seeking to prevent his cross-examination contravene the core basis of adversarial proceedings as well as the controlling rules and regulations. *See Borror*, 666 F.2d at 573.

The PTAB rules, in particular, provide for routine cross-examination of declarants. 37 CFR § 42.51(b)(1). This is consistent with the statutory requirement that "[t]he Director shall prescribe regulations… setting forth standards and procedures for discovery of relevant evidence, including… the deposition of witnesses submitting affidavits or declarations." 35 U.S.C. § 316. It is likewise consistent with the Administrative Procedure Act, which provides that "[a] party is entitled… to conduct such cross-examination as may be required for a full and true disclosure of the facts." 5 U.S.C. § 556(d); *Dell Inc. v. Acceleron, LLC,* 818 F.3d 1293, 1301 (Fed. Cir. 2016) (applying 5 U.S.C. § 556(d) to IPRs). Further implementing these requirements, the Trial Practice Guide advises that a "party presenting a witness's testimony by affidavit ***should arrange*** to make the witness available for cross-examination." 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012) (emphasis added). Notably, it is clear that "[t]his applies to witnesses employed by

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