UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.

Petitioner

v.

BIOGEN MA INC.

Patent Owner

Case No. IPR2018-01403
U.S. Patent No. 8,399,514

MYLAN'S OPPOSITION TO BIOGEN'S MOTION TO COMPEL

In its Order authorizing Biogen MA Inc.'s ("Biogen's") motion, the Board instructed that "[t]he motion must describe the general relevance of the testimony" sought and "must be very specific as to exactly what evidence [Biogen is] seeking." Paper 30, 4 (citations omitted). Biogen's motion neither identifies what evidence Biogen seeks, nor explains the relevance of any such testimony. Instead, Biogen's motion—and the unspecified cross-examination testimony it seeks—appears to be a generalized attempt to attack clear statements in the Butler declaration, which mirror declaration statements the Board has previously accepted in other IPRs. Biogen has failed to meet its burden.

Biogen also spends four of its seven pages arguing that Mylan Pharmaceuticals Inc. ("Mylan") should seek Mr. Butler's testimony. But the Board did not authorize Biogen to file a motion to compel *Mylan* to do anything (including making Mr. Butler available for deposition). Biogen was authorized only to file a motion seeking a third-party subpoena of Mr. Butler. *See* Paper 30, 3–4. Therefore, pages 1–4 of Biogen's motion, which do not apply the relevant standard to compel third-party cross-examination testimony, should be disregarded.

I. BACKGROUND

Biogen's motion relates to a single exhibit—Exhibit 1012, the Schimrigk 2004 poster by a company acquired by Biogen[1]—which also includes an affidavit from Internet Archives Office Manager Christopher Butler. Ex. 1012. The Butler affidavit explains how the Wayback Machine operates. Ex. 1012, 1. Similar affidavits from Mr. Butler have been accepted by the PTAB to establish the public availability of archived webpages, without Mr. Butler's deposition having been taken. *See, e.g., Samsung Elecs. Co. v. Rosetta-Wireless Corp.*, IPR2016-00622, Paper 48, 64, 66–67 (P.T.A.B. Aug. 21, 2017); *Intel Corp. v. Alacritech, Inc.*, IPR2017-01392, Paper 81, 12–14 (P.T.A.B. Nov. 26, 2018); *Fisher & Paykel Healthcare Ltd. v. Resmed Ltd.*, IPR2017-00062, 2018 WL 1605264, at *1 n.3 & n.6 (P.T.A.B. Mar. 29, 2018). Mr. Butler is a third-party and will not make himself available voluntarily for cross-examination. Ex. 2041, 34:15–18.

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1 The Schimrigk 2004 poster is a poster presentation published on behalf of Fumapharm AG. In 2006, Biogen acquired Fumapharm. Ex. 1058. To the extent Biogen intends to argue that the Schimrigk 2004 poster is not prior art, Biogen should already have in its possession all necessary information related to the publication of the poster, including historical details of the Fumapharm website that published the poster.

II. ARGUMENT

Biogen's motion fails to meet the standard to compel Mr. Butler's deposition testimony. Biogen nowhere explains the general relevance of the testimony it seeks—indeed, it does not even identify specific evidence it seeks to elicit from a cross-examination of Mr. Butler as instructed by the Board. Paper 33, 5–7.[2]

A. Biogen does not describe the general relevance of any sought cross-examination testimony, specifically point to the evidence Biogen seeks, or show good cause for cross-examination testimony.

Despite the Board's directive, Biogen fails to "describe the general relevance of the testimony" it seeks, nor is it "very specific as to exactly what evidence [Biogen is] seeking." Paper 30, 4 (citation omitted). To succeed in its motion, Biogen needed to make both showings, in addition to demonstrating good cause for Mr. Butler's deposition.

If a third-party declarant is not willing to be voluntarily deposed, the applicable rule is 37 C.F.R. § 42.52(a). Paper 30, 3–4; *Coastal Indus., Inc. v. Shower Enclosures Am., Inc.*, IPR2017-00573, 2018 WL 1005356, at *1 (P.T.A.B. Feb. 20, 2018) (citing 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.

[2] Biogen has already embarked on a similar fishing expedition during its deposition of Jennifer Rock. *See* Ex. 1059.

Reg. 48,612, 48,622 (Aug. 14, 2012)). Under 37 C.F.R. § 42.52(a), "[a] party seeking to compel testimony . . . must describe the general relevance of the testimony." Paper 30, 3–4. Biogen was also required to specify "exactly what evidence [Biogen is] seeking, and must show good cause." *Id*. at 4 (quoting *Johns Manville Corp. v. Knauf Insulation, Inc*., IPR2015-01453, Paper 16, 3 (P.T.A.B. Mar. 14, 2016)).

Biogen made no such showing. Instead, Biogen selected examples of testimony Mr. Butler has given in another proceeding to speculate that similar facts may be present here.[3] Paper 33, 5–6. But such speculation does not meet the good cause standard to compel cross-examination testimony of Mr. Butler.

Even if the Board accepts Biogen's speculation as postulated "admissions" it may be able to elicit from Mr. Butler in this case, Biogen has not shown good cause to take Mr. Butler's deposition—Mr. Butler did not make any statements in his affidavit that contradicted any of these purported "admissions." For example, Mr. Butler never asserted that he began working for the Internet Archive before 2009.

[3] To the extent Biogen simply seeks to have Mr. Butler restate what he has already testified to in *Johns Manville*, that deposition is publicly available. *Johns Manville*, IPR2015-01453, Ex. 2016. No further deposition is required, particularly for an uninterested third party like Mr. Butler.

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