

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

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

SNEDDEN, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion to Compel
37 C.F.R. § 42.52

I. INTRODUCTION

With its Petition, Petitioner submitted an Affidavit of Christopher Butler (Ex. 1012; “Affidavit”), an Office Manager at the Internet Archive, to support its position that Schimrigk 2004 Poster is available as prior art to the ’514 patent, so cross-examination of Mr. Butler is authorized as routine discovery. 37 C.F.R. § 42.51(b)(1)(ii). However, Petitioner represents that Mr. Butler is a third-party and will not make himself available voluntarily for cross-examination. Ex. 2041, 34:15–18.¹ Under such circumstances, when a declarant is unwilling to be voluntarily deposed, 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 . . . must file a motion for authorization. The motion must describe the general relevance of the testimony. . . 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

¹ Ex. 2041, Transcript of teleconference held on April 12, 2019, among respective counsel for Petitioner and Patent Owner, and Judges Snedden and Harlow.

from the Board; otherwise, the compelled evidence would not be admitted in the proceeding.

In this case, we authorized Patent Owner to file a motion under 37 C.F.R. § 42.52(a) to seek authorization to request a subpoena from the requisite federal district court for the cross-examination of Mr. Christopher Butler. Paper 30, 3. On May 16, 2019, Patent Owner filed its Motion to Compel. Paper 33 (“Motion” or “Mot.”). On May 21, 2019, Petitioner filed an Opposition to Patent Owner’s Motion. Paper 36 (“Opp.”).

Upon consideration of the Motion and Opposition, we deny Patent Owner’s Motion.

II. ANALYSIS

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). In our Order authorizing the Motion, we instructed Patent Owner that the “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.” Paper 30, 4 (quoting *Johns Manville Corp. v. Knauf Insulation, Inc.*, Case IPR2015–01453, slip op. at 3 (PTAB Mar. 14, 2016) (Paper 16)). We further noted that

[t]his 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. (quoting *Johns Manville Corp.*, IPR2015–01453, Paper 16, slip op. at 3).

In this case, Patent Owner contends that there is good cause to authorize a subpoena for Mr. Butler’s cross-examination because “the

purported webpage archival addressed in Ex. 1012 occurred in 2004—before Mr. Butler’s employment began in 2009.” Mot. 6. We are not persuaded, however, that compelled testimony related to the start date of Mr. Butler’s employment would yield any additional useful information. That Mr. Butler began employment in 2009 does not seem to be in dispute (*see* Opp. 4), and Patent Owner does not explain how further clarification as to the start date of Mr. Butler’s employment is relevant in this case.

Patent Owner contends that it “believes that Mr. Butler ‘has no knowledge of whether the printouts attached to his affidavit were actually posted at an accessible location on the Internet at the time indicated in the URL assigned to the file’” and that “the Wayback Machine remains “not searchable.”” Mot. 6. We are not persuaded that compelled testimony on either of these points would yield useful information. Other than indicate that the Board has compelled the testimony of Mr. Butler in cases with similar facts, Patent Owner does not explain how further clarification on either of these topics is of particular importance or relevant in this case. Mot. 5–6 (citing *Johns Manville Corp.*, IPR2015-01453, Paper 36). We note that Mr. Butler’s testimony does not aver that he has personal knowledge as to whether the printouts attached to his affidavit were actually posted at an accessible location on the Internet; Mr. Butler’s testimony instead is directed to the general workings of the Internet Archive’s Wayback Machine.

Patent Owner also contends that “the website Mr. Butler seeks to authenticate was purportedly obtained (‘crawled’) by an independent third party (Alexa Crawls), not by Mr. Butler’s employer, the Internet Archive.” Mot. 6 (citing Ex. 2128). As Patent Owner notes, however, “Mr. Butler admits to having no knowledge of the operations of ‘Alexa Internet.’”

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Mot. 7 (citing Ex. 2129, 19:12–16); *see also* Ex. 1012, 1 (Mr. Butler testifying that the Wayback Machine is compiled using such crawlers) (cited at Opp. 5). Accordingly, that the Internet Archive uses Alexa Crawls is not disputed and Patent Owner does not explain how cross-examination testimony on the matter would yield useful information.

In view of the above, we determine that Patent Owner has not met its burden of showing that it should be authorized to compel testimony from Mr. Butler on any issue identified in its Motion. To the extent that Patent Owner’s Motion makes requests outside the scope of our Order authorizing Patent Owner’s motion, such requests are also denied for being outside the scope of our authorization. *See, e.g.*, Mot. 2 (Patent Owner requesting that we order Petitioner to subpoena Mr. Butler for cross-examination).

We note, however, that cross-examination of Mr. Butler is authorized as routine discovery and we will consider the absence of cross-examination of Mr. Butler when determining the weight, if any, to be given to his Affidavit testimony (Ex. 1012). As the proponent of the testimony, if Mr. Butler is not made available for cross-examination, Petitioner “runs the risk that the direct testimony will not be considered.” *Coastal Indus., Inc. v. Shower Enclosures Am., Inc.*, Case IPR2017-00573, slip op. at 4 (PTAB Feb. 20, 2018) (Paper 27) (quoting *Int’l Bus. Machs. Corp. v. Intellectual Ventures II LLC*, Case IPR2015-01322, slip op. at 3 (PTAB Feb. 2, 2016) (Paper 15)). Rather than jointly seeking a motion to compel, however, Petitioner has opted to oppose Patent Owner’s Motion.

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