

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

CANON INC., CANON U.S.A., INC., and  
AXIS COMMUNICATIONS AB,  
Petitioners,

v.

AVIGILON FORTRESS CORPORATION,  
Patent Owner.

---

CASE: IPR2019-00311  
U.S. Patent No. 7,932,923

---

**PETITIONERS' MOTION FOR AUTHORIZATION TO COMPEL  
TESTIMONY AND/OR DOCUMENTS**

---

Pursuant to the Board’s August 14, 2019 Order (Paper 17) granting authorization to file this motion, and pursuant to 37 C.F.R. §§ 42.52(a), Petitioners move for an order granting authorization to subpoena the M.I.T. Libraries (“MIT”) and the Library of Congress (“LOC”) to compel testimony and/or the production of documents. Petitioners are seeking to subpoena these libraries to address Patent Owner’s challenge to the public accessibility of the asserted references. *See, e.g.*, Patent Owner’s Preliminary Response, Paper 9 at 19-29.

## **I. Background**

In this proceeding, Petitioners challenged U.S. Patent No. 7,932,923, relying on *Kellogg* (Ex. 1003) and *Brill* (Ex. 1004) as prior art for the asserted grounds, and *Flinchbaugh* (Exhibit J to the Florio Declaration (Ex. 1007)) as further evidence to show the public accessibility of *Kellogg*. In its Preliminary Response, Patent Owner argues that *Kellogg* and *Brill*<sup>1</sup> are not prior art to the ’923 patent. As explained in Petitioners’ Reply, both *Kellogg* and *Brill* have clearly been shown to

---

<sup>1</sup> Because the library of the University of Virginia (“UVA”) has agreed to voluntarily provide a declaration regarding its cataloguing records for *Brill*, Petitioners are not presently seeking authorization to compel UVA or other libraries with information regarding the public accessibility of *Brill*.

be prior art printed publications through the evidence submitted with the Petition. This evidence includes, among other things, indicia on the face of *Kellogg* (date stamp), cataloging of *Kellogg* at MIT, citation of *Kellogg* in another reference, *Flinchbaugh*, actual dissemination to and cataloging of *Brill* by three libraries, and the declaration of Ms. Emily Florio. Petitioners' Reply, Paper 11 at 5.

Despite the evidence showing that *Kellogg* and *Brill* (as well as *Flinchbaugh*) are prior art publications, Patent Owner continues to challenge the public accessibility of the references. Patent Owner's Sur-reply, Paper 12 at 1-5. Patent Owner does so without presenting any evidence suggesting that either reference was not publicly accessible or a prior art publication.

Although the evidence submitted with the Petition demonstrates the public accessibility and prior art status of *Kellogg* and *Brill*, and such evidence was deemed sufficient by the Board for institution purposes (Paper 13), Petitioners seek authorization to subpoena MIT and the LOC to obtain testimony and/or the production of documents to further demonstrate the public accessibility of *Kellogg* (the additional evidence for *Brill* being collected without the need for a subpoena). Such evidence will directly address Patent Owner's argument that "Petitioners were required, at a minimum, to *gather detailed evidence and testimony* from someone with direct personal knowledge, such as an *MIT librarian*." Paper 9 at 22 (emphases added); *see also* IPR2019-00314, Paper 9 at 28 (alleging the same

for the Library of Congress). By addressing the Patent Owner's spurious complaints about the prior art status of *Kellogg*, these subpoenas will reduce the issues for final determination and allow the Board and the parties to focus on the substantive merits of the Petition and instituted grounds.

## II. Identification of Testimony/Documents Sought and Efforts To-Date

Pursuant to 37 C.F.R. § 42.52(a), Petitioners request authorization to issue a subpoena for (1) testimony and/or documents from MIT establishing that *Kellogg* and *Flinchbaugh* were received, cataloged, and made publicly accessible through the MIT library system prior to October 1999, and (2) testimony and/or documents from the LOC establishing that *Flinchbaugh*<sup>2</sup> was received, cataloged, and made publicly accessible through the LOC prior to October 1999.

Petitioners made efforts to obtain a declaration from MIT regarding *Kellogg* and *Flinchbaugh*. Specifically, Petitioners asked MIT to provide a declaration voluntarily. MIT responded during a phone call that MIT's policy was to only provide a declaration in response to a subpoena. Petitioners understand this to be

---

<sup>2</sup> In IPR2019-00314, Petitioners also request a declaration from MIT and the LOC establishing the date *Dimitrova*, an asserted reference in that proceeding, was publicly available.

consistent with MIT's policy regarding declarations and it has prompted requests and subpoena authorizations from the Board in the past. *See, e.g.*, IPR2016-01437 Paper 15 at 2; IPR2014-00562, Paper 22 at 3.

Petitioners also communicated with the LOC to obtain a declaration voluntarily regarding the date stamped copy of *Flinchbaugh*<sup>3</sup> obtained from the LOC. The LOC has not indicated that it is willing to provide a declaration voluntarily. Further, Petitioners are unaware of any such declarations that have been voluntarily provided from the LOC for submission in an IPR proceeding.

### **III. The Requested Discovery is in the Interest of Justice**

Discovery in an *inter partes* review proceeding is limited to routine discovery and additional discovery that is necessary “in the interest of justice.” *See* 35 U.S.C. § 316(a)(5); *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, Paper 26 at 6-7 (P.T.A.B. Mar. 5, 2013) (precedential). The Board considers the following factors in determining whether additional discovery serves the interests of justice: (1) whether there is more than a possibility and a mere allegation that useful information will be discovered; (2) whether the proposed discovery seeks legal positions or the under lying basis for legal

---

<sup>3</sup> *Dimitrova*, which IPR2019-00314 relies on, also has a LOC date stamp.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.