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: IPR2019-00314
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 18-29.

I. Background

In this proceeding, Petitioners challenged U.S. Patent No. 7,932,923, relying on *Dimitrova* (Ex. 1006) and *Brill* (Ex. 1004) as prior art for the asserted grounds. In its Preliminary Response, Patent Owner argues that *Dimitrova* and *Brill*[1] are not prior art to the '923 patent. As explained in Petitioners' Reply, both *Dimitrova* and *Brill* have clearly been shown to be prior art printed publications through the evidence submitted with the Petition. This evidence includes, among other things,

[1] 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*.

the regular publication of ACM journal that included *Dimitrova*, the actual dissemination to and cataloging of *Dimitrova* and *Brill* by three libraries, and the declaration of Ms. Emily Florio. Petitioners' Reply, Paper 11 at 5.

Despite the evidence showing that *Dimitrova* and *Brill* 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 *Dimitrova* 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 *Dimitrova* (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 put forth detailed evidence and testimony from someone with direct personal knowledge, such as a librarian from the UCLA library or ***the Library of Congress*** to explain what the stamps mean and to explain the policies for indexing, shelving, or otherwise making public available the reference and its contents to the public." Paper 9 at 28 (emphases added); *see*

also IPR2019-00311, Paper 9 at 22 (alleging the same for MIT). By addressing the Patent Owner's spurious complaints about the prior art status of *Dimitrova*, 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 *Dimitrova*[2] was received, catalogued, and made publicly accessible through the MIT library system prior to October 1999 and (2) testimony and/or documents from the LOC establishing that *Dimitrova* was received, catalogued, and made publicly accessible through the LOC prior to October 1999.

Petitioners made efforts to obtain a declaration from MIT regarding *Dimitrova*. 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

[2] In IPR2019-00311, Petitioners also request a declaration from MIT and the LOC establishing the date *Kellogg* and *Flinchbaugh*, which are relied on in that petition, were 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 *Dimitrova*[3] 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

[3] *Flinchbaugh*, which IPR2019-00311 cites, also has a LOC date stamp.

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