Trials@uspto.gov
571.272.7822

Paper No. 24
Filed: September 6, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

AVIGILON FORTRESS CORPORATION,
Patent Owner.

Case IPR2019-00311
Case IPR2019-00314[1]
Patent 7,923,923 B2 & C1

Before GEORGIANNA W. BRADEN, KIMBERLY McGRAW, and JESSICA C. KAISER, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

ORDER

Granting Motions to Compel Testimony and/or Documents
37 C.F.R. § 42.52

[1] This Order applies to both listed cases. The parties may not use this style heading unless authorized.

I. INTRODUCTION

Canon Inc., Canon U.S.A., Inc., and Axis Communications AB ("Petitioner") filed a motion in IPR2019-00311 and in IPR2019-00134 seeking authorization to compel testimony and/or documents pursuant to 37 C.F.R. § 42.52(a). Paper 18[2], "Mot." In both cases, Petitioner seeks authorization to file a subpoena to compel production of documents and testimony from:

(1) the Massachusetts Institute of Technology Libraries ("MIT") relating to certain references (i.e., Kellogg[3], Dimitrova[4], and Flinchbaugh[5]) sufficient to establish that Kellogg and Flinchbaugh were received and made available to the public by the MIT Libraries before October 1999 (Mot. 1, Ex. A), and

(2) the Library of Congress sufficient to show Dimitrova and Flinchbaugh were received and made available to the public by the Library of Congress before October 1999 (Mot. 1, Ex. B).

Petitioner states it is seeking to subpoena these libraries under 37 C.F.R. § 42.52(a) to address Patent Owner's arguments that testimony from a librarian with personal knowledge is required to establish the public

---

[2] Similar papers and exhibits having the same numbering were filed in each proceeding. For clarity and expediency, references to paper or exhibit numbers apply to both IPR2019-00311 and IPR2019-00314, unless indicated otherwise.

[3] Kellogg is a reference asserted to be prior art to the challenged claims in IPR2019-00311.

[4] Dimitrova is a reference asserted to be prior art to the challenged claims in IPR2019-00314.

[5] Flinchbaugh is a reference asserted to show the public accessibility of Kellogg because it "would have led interested parties to finding" Kellogg. *See* IPR2019-0311, Paper 11, 5.

accessibility of the references. *See* Mot. 2. Patent Owner opposes. Paper 21, "Opp. to Mot."

For the reasons stated below we grant-in-part and deny-in-part Petitioner's motions.

II. ANALYSIS

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion under 37 C.F.R. § 42.52(a) seeking to compel testimony or production of documents or things must describe the general relevance of the testimony, document, or thing, and must:

> (1) In the case of testimony, identify the witness by name or title; and
>
> (2) In the case of a document or thing, the general nature of the document or thing.

See also 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 from the Board; otherwise, the compelled evidence would not be admitted in the proceeding.").

We have reviewed Petitioner's motions, including the attached exhibits and determine Petitioner has sufficiently identified the witnesses by title and described the general relevance of the requested discovery as required by § 42.52(a). We are not persuaded by Patent Owner's argument

that Petitioner failed to identify the witnesses by name or title as required by § 42.52(a)(1). Petitioner's motions explain that for each identified library (i.e., the MIT library and the Library of Congress) a *librarian* can provide the requested testimony. *See e.g.*, IPR2019-00311, Mot. 2 (stating the requested discovery is to address Patent Owner's argument that Petitioner must provide "detailed evidence and testimony from someone with direct personal knowledge, such as *an MIT librarian*") (emphasis modified); IPR2019-00318, Mot. 2 (stating the requested discovery will address Patent Owner's argument that Petitioner must "at a minimum, to put forth detailed evidence and testimony from someone with direct personal knowledge, such as *a librarian from . . . 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") (emphasis modified). Thus, Petitioner's motions have sufficiently identified the witness as required by § 42.52(a)(1).

Because Petitioner's requests are in the nature of additional discovery, albeit from a third party, our Order also instructed Petitioner to explain in its motions why the requested discovery is in the interest of justice by addressing the factors set forth in *Garmin International, Inc. v. Cuozzo Speed Technologies, LLC*, IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential). *See* Paper 17, 8.

Petitioner asserts all five *Garmin* factors weigh in favor of discovery. Patent Owner argues four of these factors weigh against discovery. We address each factor in turn.

Factor 1: More than a Possibility or Mere Allegation that Something Useful to the Proceeding Will be Found

Regarding the first *Garmin* factor, we agree with Petitioner that evidence showing Kellogg and Flinchbaugh were publicly accessible before October 1999 is useful in the IPR2019-00311 proceeding because any such evidence is relevant to determining whether Kellogg qualifies as prior art to the challenged claims. *See* IPR2019-00311, Mot. 5. We also agree that evidence showing Dimitrova was publicly accessible before October 1999 is useful in the IPR2019-00314 proceeding because any such evidence is relevant to determining whether Dimitrova qualifies as prior art to the challenged claims. *See* IPR2019-00314, Mot. 5.

Patent Owner argues Petitioner's discovery requests are not "useful" because Petitioner seeks information about the public accessibility of Kellogg and Dimitrova *before October 1999* yet only argued in its petitions that the Kellogg was publicly accessible in *September 1993* (IPR2019-00311, Opp. to Mot. 3–5) and that Dimitrova was published *October 1995* (IPR2019-00314, Opp. to Mot. 3–5). We disagree with Patent Owner. Petitioner has asserted that both Kellogg and Dimitrova are prior art under pre-AIA 35 U.S.C. § 102(b) and, as such, the relevant date for demonstrating the prior art status of Kellogg and Dimitrova is October 24, 1999.[6]

We are persuaded Petitioner has sufficiently shown there is more than a mere possibility or allegation that MIT can provide testimony or documents tending to show the prior art status of Kellogg and Dimitrova.

[6] U.S. Patent No. 7,932,923 B2 ("the '923 patent") claims priority to an application filed October 24, 2000; therefore, a reference published prior to October 24, 1999 would qualify as prior art to the '923 patent under pre-AIA § 102(b).

DOCKET ALARM

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.