

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COLLEGE PRODUCTS, INC.,
Petitioner,

v.

INTIRION CORPORATION.,
Patent Owner.

PGR2024-00003 (U.S. Patent No. 11,674,745B2)
PGR2024-00004 (U.S. Patent No. 11,674,746 B2)¹

Before SCOTT A. DANIELS, MATTHEW S. MEYERS, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Motion for Additional Discovery
37 C.F.R. §§ 42.51(b)(2) and 42.224

¹ This Order addresses issues that are the same in both cases. The parties are not authorized to use this style heading for any subsequent papers.

INTRODUCTION

Petitioner requested, via email on May 10, 2024, authorization to file a motion for additional discovery, that is—Petitioner requested authorization under 37 C.F.R. §§ 42.52(a) to serve a subpoena on Northeastern University relating to public accessibility of a prior art reference relied upon in the Petition. **Ex. 3001**. Based on the Board’s May 17, 2024 email authorization, Petitioner filed Petitioner’s Motion Under 37 C.F.R. § 42.52(a) to Apply for Subpoena Under 35 U.S.C. § 24 to Compel Testimony and Production of Documents from Northeastern University. (Paper 17 or “Motion”). Also with our authorization, Patent Owner filed an Opposition to Petitioner’s Motion. (Paper 18 or “Opposition”).

By way of background, Petitioner desires additional discovery and to submit to the Board supplemental information, in the form of testimonial and documentary information, from Northeastern University regarding the public availability of an asserted prior art article entitled, “ISDU: Integrated Smoke detector Unit for Commercial Microwave Ovens,” (Exhibit 1012), referred to as “ISDU.” Northeastern University has informed Petitioner that it requires a subpoena in order to fulfill any requests for additional information with respect to ISDU and its alleged publication on the University’s IRis system. Ex. 1024, 1. In its Motion, Petitioner requests authorization to serve such a subpoena and argues that there is good cause as to why a subpoena of Northeastern University is needed. Paper 17 (citing *Bloomberg, Inc. v. Markets-Alert Pty, Ltd.*, CBM2013-00005, Paper 32 at 5 (PTAB May 29, 2013)).

Petitioner as the moving party has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.51(b)(2), and

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)
PGR2024-00004 (U.S. Patent No. 11,674,746B2)

42.224. We have considered the arguments and evidence in Petitioner’s Motion and Patent Owner’s Opposition. For the reasons discussed below, Petitioner’s Motion is *denied*.

Petitioner’s Motion is a request to try and obtain, and then submit in this proceeding, supplemental information to support the contention that ISDU is prior art to the ’745 and ’746 patents.² Authorization for the Motion was initially requested in a May 10, 2024 email to the Board, exactly one month after our Institution Decision was entered on April 10, 2024. Notably, Patent Owner is *not* in possession of the supplemental information from Northeastern University which it desires to submit. Ex. 3001. Late submission of supplemental information is governed by 37 C.F.R. § 42.123(b), which requires the movant to show why the supplemental information reasonably could not have been submitted earlier and that there is good cause to consider the supplemental information. Under 37 CFR § 42.123(b)

[a] party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

While an interests of justice standard is employed in granting additional discovery in *inter partes* review, as Petitioner argues here, a good cause

² This is contrasted with supplemental evidence, which is offered solely to support admissibility of previously filed evidence. *See* 37 C.F.R. § 42.64(b)(2), *see also HandiQuilter, Inc. v. Bernina Int’l AG*, IPR2013-00364, Paper 30, 2–3 (PTAB Jun. 12, 2014).

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)

PGR2024-00004 (U.S. Patent No. 11,674,746B2)

standard is applied in post-grant review and covered business method patent review. 37 C.F.R. §§ 42.51(b)(2)(i) and 42.224. On balance, the interests of justice standard is a slightly higher standard than the good cause standard, to reflect that the scope of issues which could be raised by a petitioner in an *inter partes* review is limited to grounds based on patents or printed publications. *Id.*

DISCUSSION

Petitioner relies on ISDU as a secondary reference in Grounds 1, and either of Grounds 5 or 6, as well as either Grounds 7 or 8.³ ISDU is an undergraduate research paper with a cover page having a date of April 17, 2007. Ex. 1012, 2. The entirety of Petitioner’s explanation in the Petition regarding the asserted public accessibility of ISDU is reproduced below.

ISDU: Integrated Smoke detector Unit for Commercial Microwave Ovens, Cory Lloyd et. al, Northeastern University (“ISDU”) published on April 17, 2007, on “IRis”. Ex. 1012. IRis was a “digital archive,” indexed on Google and readily accessible worldwide, that allowed Northeastern University researchers, starting in 2006, to publish their work to “promote and preserve their intellectual output” and was a precursor to Northeastern University’s more current Digital Repository Service. Ex. 1002 ¶¶[96-98]. Per IRis’s publishing practices, ISDU was published and publicly available in Northeastern University’s digital archive in 2007. *Id.* ISDU is prior art pursuant to at least 35 U.S.C. §102(a)(1).

Pet. 20. In summary, the Petition makes three assertions with respect to ISDU relative to public accessibility. First, the Petition states that ISDU was

³ For example, Petitioner’s explanation of Grounds 5 and 6 assert that “[c]laims 12, 14, 19, 23, and 26 are obvious under 35 U.S.C. §103 in view of Emma combined with either ISDU or Smith, and further combined with the knowledge of a POSITA.” Pet. 12.

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)

PGR2024-00004 (U.S. Patent No. 11,674,746B2)

“published on April 17, 2007, on ‘IRis,’” citing the paper itself, Exhibit 1012. *Id.* Second, the Petition then describes IRis as “a ‘digital archive,’ indexed on Google and readily accessible worldwide . . . starting in 2006,” citing to testimony by Petitioner’s declarant, Dr. Mark Horenstein, Exhibit 1002 ¶¶ 96–98. *Id.* Third, relying on Dr. Horenstein’s testimony, the Petition concludes that “[p]er IRis’s publishing practices, ISDU was published and publicly available in Northeastern University’s digital archive in 2007.” *Id.* (citing Ex. 1002 ¶ 98).

In its Patent Owner Preliminary Response Patent Owner challenged Petitioner’s sufficiency of evidence as to the public availability of ISDU arguing, *inter alia*, that

Petitioner does not rely on anyone with first-hand knowledge of ISDU’s public accessibility. Nor does Petitioner rely on evidence of actual pre-critical date access of the ISDU reference. Petitioner does not even rely on evidence of those with first-hand knowledge of the system on which ISDU was allegedly published (“IRis”).

Prelim. Resp. 7.

We instituted based on an analysis of Petitioner’s Grounds 3 and 4 which do not include ISDU as a prior art reference. Inst. Dec. 12–40. The question of whether or not ISDU has been shown to be prior art is part of the current trial and need not be decided here. However, for the reasons that follow, we deny Petitioner’s Motion because Petitioner has not shown sufficiently why the additional discovery and subpoena it seeks in this proceeding could not have been requested earlier and that there is good cause to consider this information. 37 CFR § 42.123(b).

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)

PGR2024-00004 (U.S. Patent No. 11,674,746B2)

Whether Petitioner has shown why the supplemental information reasonably could not have been obtained earlier

Even before filing its Petition on October 9, 2023, the very nature of ISDU being an “undergraduate capstone project” should have provided some level of apprehension that there would be a challenge and questions, both by the Board and Patent Owner, as to publication and public availability of ISDU. ISDU includes simply a date on its cover page of April 17, 2007. Ex. 1012, 2. On the cover page there is no description or additional information provided with this date apart from the title of the research paper and a list of the authors and their academic advisor. *Id.* Apart from its conclusory citation to ISDU itself and the uncorroborated speculative testimony of Dr. Horenstein, Petitioner has not provided persuasive evidence that April 17, 2007 is ISDU’s publication date on IRis. It is well settled that a date on a document or paper is, alone, generally not sufficient to show public accessibility. *See Carella v. Starlight Archery*, 804 F.2d 135, 139 (Fed. Cir. 1986) (The Court determining that the date on an advertising mailer was insufficient to show “receipt of the mailer by any of the addressees.”); see also *Apple Inc. v. DSS Tech. Management, Inc.*, IPR2015-00373, Paper 8 at 10–11 (PTAB June 25, 2015) (denying institution where “[t]hat stamped date, however, would appear to be a hearsay statement to the extent that it would be offered for its truth”). Based on the April 17, 2007 date being untethered to any meaningful information or evidence regarding this date, the challenge to ISDU’s public accessibility was reasonably foreseeable at the time of filing the Petition.

Moreover, Patent Owner expressly raised and argued, at length, the issue of public accessibility of ISDU in its Patent Owner Preliminary

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)

PGR2024-00004 (U.S. Patent No. 11,674,746 B2)

Response filed January 17, 2024. Prelim. Resp. 6–14. If there was any question as to the foreseeability of public accessibility regarding ISDU, it was at that point a full-throated defense raised by Patent Owner in its Preliminary Response. *See id.* at 13 (Patent Owner arguing that “Petitioner’s purported evidence should be rejected because it amounts to little more than a bare allegation that ISDU was published on April 17, 2007.”). Yet, Petitioner did not address, or seek to address, in any manner Patent Owner’s arguments with respect to ISDU’s public accessibility in its subsequent Reply to Patent Owner’s Preliminary Response filed March 8, 2024. *See generally*, Reply to Prelim. Resp. 1–3.

In fact, Patent Owner appears to have waited until well after the entry of our Institution Decision April 10, 2024, before making an inquiry with Northeastern University as to information relating to ISDU and the IRis system.⁴ In an April 30, 2024 email, Petitioner’s counsel inquired with a Northeastern University employee as to “when [ISDU] was first published and when it was available in the IRis system.” Ex. 1024, 7.⁵ Patent Owner eventually learned on May 7, 2024 that Northeastern University would

⁴ Petitioner casts its inquiry as “timely” following Patent Owner’s Objections to Petitioner’s Exhibit List and Expert Reports. Mot. 1. We disagree. Petitioner was at least on notice of Patent Owner’s challenge to ISDU’s alleged public accessibility date as least at the time of filing of the Patent Owner Preliminary Response, if not earlier.

⁵ On May 24, 2024, more than one month after entry of our Institution Decision, without authorization by the Board or a motion to submit supplemental information as required under 37 C.R.F. § 42.123(b), Petitioner entered, as Exhibit 1024, the April 30, 2024 email between Petitioner’s counsel and Sarah Sweeney, an employee of Northeastern University. Ex. 1024.

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)

PGR2024-00004 (U.S. Patent No. 11,674,746B2)

require a subpoena before the University would designate an appropriate Keeper of Records to sign a declaration. *Id.* at 1. On May 10, 2024, Patent Owner requested by email that the Board provide authorization to file the instant Motion, and authorization was granted May 17, 2024. Exs. 3002, 3003.

Regardless of when authorization was requested for the instant Motion, the submission of any information or evidence relating to public accessibility would inevitably occur more than one month after our Institution Decision. *See* 37 CFR § 42.123(b). Petitioner should have been aware of this issue as early as the filing date of the Petition in October 2023, and was expressly on notice as to the public accessibility issue by January 17, 2024. Petitioner's Motion does not satisfactorily explain why it waited until this late in the proceeding to begin an attempt to obtain relevant information pertaining to the public accessibility of ISDU. Petitioner argues that its Motion is timely, explaining that

Petitioner first contacted Northeastern on April 30, 2024, within three weeks of the institution decision, and almost three months before Patent Owner's response to the petition is due. *See* Ex. 1024 at 7; Paper 11 at 11. Given Northeastern's policy of preventing testimony and documents from being produced absent a subpoena, Petitioner would not have been able to procure testimony and documents much sooner, if at all, than now.

Mot. 5. This explanation as to when Petitioner's counsel began their inquiry does not explain why efforts to obtain additional information from Northeastern University could not have been undertaken months earlier given the foreseeable nature of this issue.

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)

PGR2024-00004 (U.S. Patent No. 11,674,746 B2)

The statutory provisions for *inter partes* reviews, post-grant reviews, and covered-business method patent reviews caution against overly broad discovery⁶ and provide the same considerations, including efficient administration of the Office and the ability of the Office to complete the proceeding timely.⁷ Moreover, as stated in the legislative history, “[g]iven the time deadlines imposed on these proceedings, it is anticipated that, regardless of the standards imposed in [35 U.S.C. §§ 316 and 326], PTO will be conservative in its grants of discovery.” 154 Cong. Rec. S9988-89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl). On this record, it was reasonably foreseeable, and indeed expressly stated, that Patent Owner would challenge the public accessibility date of ISDU. Because Petitioner waited, at a minimum, over three months following the Patent Owner Preliminary Response before attempting to obtain additional information regarding the public accessibility of ISDU, Petitioner’s Motion is denied.

Good Cause

According to Petitioner, the “*Garmin*” factors, as evaluated under the good cause standard discussed in *Bloomberg, Inc. v. Markets-Alert Pty, Ltd.*, CBM2013-00005 (PTAB May 29, 2013) (Paper 32) at 5, show good cause

⁶ See 35 U.S.C. 316(a)(6) and 326(a)(6) (“The Director shall prescribe regulations. . . (6) prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass *or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding.*”) (Emphasis added).

⁷ See 35 U.S.C. §§ 316(b) and 326(b) (“In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.”) (Emphasis added).

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)
PGR2024-00004 (U.S. Patent No. 11,674,746B2)

as to why a subpoena of Northeastern University is needed. Mot. 2–5. We disagree for at least the following reason.

Bloomberg explains that under the first *Garmin* Factor “[t]he mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to establish a good cause showing.”

Bloomberg, Inc. v. Markets-Alert Pty, Ltd., CBM2013-00005 (PTAB May 29, 2013) (Paper 32) at 5. Petitioner argues that

Ms. Sweeney indicated that Northeastern possesses documents confirming that ISDU was publicly available no later than November 2013. Ex. 1024 at 5. She has provided information indicating the public availability of ISDU via IRis, a database that Northeastern maintained, by that date.

Mot. 2. However, even if we consider this supplemental information, entered by Petitioner without authorization or motion, as Ex. 1024, Ms. Sweeney provides conflicting and ambiguous information with respect to the publication date of ISDU.

For example, Petitioner and Dr. Horenstein assert that April 17, 2007 was the publication date of ISDU on IRis. Pet. 20; Ex. 1002 ¶¶ 96–98. In her April 30 email, Ms. Sweeney contradicts this, explaining that library staff did not enter the paper into IRis until 2009, stating that “I can tell you that the paper was not available in IRis before December 2009.” Ex. 1024, 5. Further, Ms. Sweeney stated that “I have no documentation that would indicate whether or not the file was public (and therefore indexed by Google and other major search engines) or private during the time it was in IRis.” *Id.* Ms. Sweeney did describe that data showed 24 downloads of ISDU in a month, and may indicate “the file was public in IRis by December 2013.”

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)

PGR2024-00004 (U.S. Patent No. 11,674,746B2)

Miss Sweeney did not, however, confirm whether or not these were public downloads.

We are not persuaded by Petitioner’s arguments, as they are highly speculative and do not provide sufficient factual reason to demonstrate that something “useful” will be uncovered. As Patent Owner points out, Ms. Sweeney admits to “lack personal knowledge—with relevant facts being before her time—and to having ‘no documentation’” for ISDU and any asserted publication date. While we can speculate that Ms. Sweeney might provide certain information as to this issue, the explanations in this email lack the sufficient threshold showing, beyond speculation, that something useful regarding public availability of ISDU will be uncovered. For instance, Petitioner argues that Ms. Sweeney “has provided information indicating the public availability of ISDU via IRis, a database that Northeastern maintained, by” November 2013. Mot. 2. She has not. In fact, Ms. Sweeney is only speculating that the data showing 24 downloads in a month were public downloads. *See* Ex. 1024, 5 (Ms. Sweeney stating that “[t]here would be no reason for library staff to download the ISDU paper 24 times in a month, as indicated in the email, so I feel pretty confident saying that the file was public in IRis by December 2013.”).

Considering the other *Garmin* factors, Petitioner has failed to provide the Board with specific additional discovery requests so that we can evaluate whether or not they seek the underlying basis for litigation positions, are easily understandable, and not overly burdensome to answer. Mot. 2–4. Petitioner stated only that it would request “1) testimony attesting to the information Ms. Sweeney already provided; and 2) the documents that support the conclusion that ISDU was publicly available no later than

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)
PGR2024-00004 (U.S. Patent No. 11,674,746B2)

November 2013.” To the extent these are the actual testimony and document requests that Petitioner would articulate in its discovery request, they are overly broad, uninformative, vague, and ambiguous. To the extent they are general summary of the questions, this is insufficient for the Board to evaluate in any meaningful way the efficiency and burden that would be placed on the University. And as Patent Owner has pointed out, Petitioner has failed to explain why it could not have obtained information about ISDU’s publication date from other sources and “did not contact ISDU’s authors, Bepress, or anyone else,” regarding the public accessibility of ISDU.

For the foregoing reasons, Petitioner’s Motion for additional discovery and a subpoena is *denied*.

Bloomberg points out, Markets-Alert is seeking prior art and information that are irrelevant to the instituted grounds of unpatentability. (Opp. 3.) While those prior art and information sought by Markets-Alert were considered by Bloomberg, they are not relied upon to support the asserted grounds of unpatentability.

Hughes notes that it has already submitted substantial evidence that Divsalar is available as a publication reference. Mot. 6 (citing Ex. 1011; Ex. 1064; Ex. 1006 p.4). According to Hughes, both potential witnesses list

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)

PGR2024-00004 (U.S. Patent No. 11,674,746 B2)

Divsalar among their publications on their respective public biographies.

Hughes argues that these facts demonstrate likely possession of information by the potential witnesses showing that Divsalar is a publication reference prior to the '781 patent. Mot. 6. Hughes argues that it has no other way than this discovery to learn what evidence is known or in the possession of these authors regarding publication of Divsalar. Even if we accept that as true, Hughes did not choose to rely on these witnesses in the first instance. These witnesses are not the only way to establish Divsalar as a publication. In fact, Hughes chose another way. It chose to make its case for publication and prove a publication date by submitting the declaration of Dr. Horenstein, its declarant in this case, who's testimony regarding ISDU's public accessibility date is based on a review of Robin Fradenburgh, a librarian at the University of Texas

Considering Petitioner's first assertion, Petitioner has provided no persuasive evidence in the Petition that ISDU was, in fact, "published on April 17, 2007, on 'IRis.'" Pet. 20. It is just as likely, if not more so, that this date is simply the date the undergraduate authors submitted their paper to their academic advisor. *See Apple Inc. v. DSS Tech. Management, Inc.*, IPR2015-00373, Paper No. 8 at 10-11 (PTAB June 25, 2015) (denying institution where "[t]hat stamped date, however, would appear to be a hearsay statement to the extent that it would be offered for its truth").

The fact that IRis as "a 'digital archive,' indexed on Google and readily accessible worldwide . . . starting in 2006," as Petitioner asserts, also

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)

PGR2024-00004 (U.S. Patent No. 11,674,746B2)

provides no objective evidence that ISDU was published or publicly accessible on April 17, 2007 or on any date for that matter. Pet. 20.

Petitioner relies on the testimony of Dr. Horenstein who states that “ISDU indicates its date of publication as April 17, 2007 and indicates on its face that it was published on “IRis.” Ex. 1002 ¶ 96. Just like Petitioner’s conclusory assertion that ISDU was “published” on April, 17, 2007, Dr. Horenstein’s testimony does not explain *how* or *why* the date on the face page of the paper indicates publication or public accessibility. Moreover, Dr. Horenstein’s reliance on “the IRis Brochure” may indicate that IRis is a “digital archive” and includes an “open-access journal” that can found in a Google search, but this still does not provide any persuasive evidence as to when ISDU would have been published or publicly accessible. *See id.* (Dr. Horenstein testifying that “[t]he IRis Brochure indicates that in February of 2010, the IRis database was accessed from a number of different countries noting that “64% of IRis visits came via Google.”). Petitioner has not explained that Dr. Horenstein has any first hand knowledge pertaining to IRis or how and when ISDU would have been publicly available on IRis.

Finally, again relying on Dr. Horenstein’s testimony, the Petition concludes that “[p]er IRis’s publishing practices, ISDU was published and publicly available in Northeastern University’s digital archive in 2007.” *Id.* (citing Ex. 1002 ¶ 98). Yet Dr. Horenstein has no first person knowledge of the IRis system or when ISDU was actually publicly available. The tie between the IRis brochure and alleged publication date of ISDU is tenuous at best. Moreover, as we have learned from Petitioner’s subsequent filing of supplemental information, Dr. Horenstein’s and Petitioner’s conclusion is contradicted by an email from Sarah Sweeney, a Northeastern University

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)
PGR2024-00004 (U.S. Patent No. 11,674,746B2)

employee who explained in an email to counsel that “I can tell you that the paper was not available in IRis before December 2009.” Ex. 1024, 5.

Overall, from the dearth of information and evidence in the Petition regarding the alleged April 17, 2007 ISDU publication date, it should have been readily apparent, and foreseeable, that the public accessibility of ISDU would be challenged.

MOTION

In its Motion, Petitioner argues there is good cause for a subpoena to gather further evidence as to the publication and public accessibility of ISDU. Mot. 2–5. However, Petitioner has presented no arguments or explanation as to why evidence of public accessibility could not have obtained, or at the very least requested, information from Northeastern University regarding IRis and ISDU before filing its Petition.

Petitioner has failed to explain why such information as to ISDUs publication and public accessibility could not have been obtained earlier. In addition, given the nature of ISDU and the IRis system itself, it was entirely foreseeable, and would have been a relatively simple matter to contact the authors, academic advisor, or Northeastern University to obtain such information prior to filing the Petition on October 9, 2024.

Moreover, good cause does not exist, now, for a subpoena simply because Petitioner waited until challenged to begin to provide evidence of ISDUs public accessibility. Indeed, the fact that new information shows that ISDU may have been publicly available by November 2013 does not tend to show publication six years earlier on April 1, 2007 as alleged by Petitioner and Dr. Horenstein.

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)
PGR2024-00004 (U.S. Patent No. 11,674,746B2)

PGR2024-00003 (U.S. Patent No. 11,674,745 B2)
PGR2024-00004 (U.S. Patent No. 11,674,746B2)

For PETITIONER:

Domingo Llagostera
Domingo.llagostera@blankrome.com

Russell Wong
Russell.wong@blankrome.com

Megan Wood
Megan.wood@blankrome.com

Alexander Perry
aperry@blankrome.com

FOR PATENT OWNER:

R. Scott Johnson
rsjohnson@fredlaw.com

Thomas Patton
tpatton@fredlaw.com