

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALTERNATIVE LEGAL SOLUTIONS, INC.,
AN OREGON CORPORATION, dba COMPLI, INC.,
Petitioner,

v.

EMPLOYMENT LAW COMPLIANCE, INC.,
Patent Owner.

Case IPR2014-00562
Patent 7,330,817 B1

Before JENNIFER S. BISK, MICHELLE R. OSINSKI, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Motion for Authorization to Compel Testimony
and Production of Documents
37 C.F.R. § 42.52(a)

On December 15, 2014, we authorized Patent Owner, Employment
Law Compliance, Inc., to file a motion for authorization to compel third-
party testimony and production of documents by applying for a subpoena in

federal district court. Paper 16, 4 (“Order”). We also authorized Petitioner, Alternative Legal Solutions, Inc., an Oregon Corporation, d/b/a Compli, to file an opposition to the motion. *Id.* The testimony that Patent Owner seeks to compel relates to whether one of the asserted prior art references in this proceeding qualifies as a “printed publication” under 35 U.S.C. § 102(b). *Id.* at 2–3.

On December 17, 2014, Patent Owner filed a Motion for Authorization to Compel Testimony and Production of Documents. Paper 18 (“Motion”). On December 19, 2014, Petitioner filed an opposition to Patent Owner’s Motion. Paper 19 (“Opp.”). For the reasons set forth below, we deny Patent Owner’s Motion.

DISCUSSION

The applicable rule for compelled testimony and production of documents is 37 C.F.R. § 42.52(a), which provides:

(a) *Authorization required.* A party seeking to compel testimony or production of documents or things must file a motion for authorization. The motion 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 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.”). Because Patent Owner’s request is in the nature of additional discovery, albeit from a third party, our Order instructed Patent Owner to explain in its Motion why the requested discovery is in the interest of justice, in accordance with 35 U.S.C. § 316(a)(5) and 37 C.F.R. § 42.51(b)(2). Order 3–4. We referred the parties to 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) (informative).

1. Testimony and Production of Documents Sought by Patent Owner

In its Motion, Patent Owner indicates that the requested testimony and production of documents involve authentication of *City of Boston* (Ex. 1004),¹ a Massachusetts Institute of Technology (“MIT”) master’s thesis authored by Susan Prytherch. Mot. 1. Patent Owner seeks testimony and production of documents from three individuals—Marilyn McSweeney and Erja Kajosalu, both MIT librarians, and Professor Stuart Madnick, Ms. Prytherch’s thesis supervisor. *Id.* at 1–4. Patent Owner represents that MIT’s General Counsel’s office has indicated that subpoenas are necessary for the requested testimony in an adversarial proceeding. *Id.* at 4.

Ms. McSweeney already has provided a declaration explaining MIT Libraries’ procedures for cataloguing and shelving thesis documents, and providing details regarding when the MIT Libraries received, catalogued,

¹ Susan Ellen Prytherch, *Software Package Evaluation: Application to a Personnel System for the City of Boston* (June 1977) (M.S. Thesis, Massachusetts Institute of Technology).

and shelved the *City of Boston* thesis. *Id.* at 1; Ex. 2029 (“McSweeney Declaration”). Patent Owner asserts that the information in the McSweeney Declaration is “incomplete” and seeks additional details regarding the original card catalog information for the thesis and catalog information as of August 2000, the “critical date” of U.S. Patent No. 7,330,817 B1 (“the ’817 patent”). Mot. 1–2. Patent Owner also seeks details regarding how the physical thesis was shelved and how many times it was accessed. *Id.* at 2. From Ms. Kajosalo, Patent Owner seeks information regarding the search and reporting functionality available in the version of the online library search system prior to the current version. *Id.* at 2. Finally, Patent Owner seeks sworn testimony from Professor Madnick regarding a copy of the *City of Boston* thesis that he retained in his office until 2010, when it was scanned and made available online. *Id.* at 3.

2. *Whether the Requested Discovery is in the Interest of Justice*

In determining whether a request for additional discovery is in the interest of justice, the Board considers several factors. *See Garmin*, slip op. at 6–7. In the instant proceeding, two of those factors are relevant: whether there is more than a mere possibility or mere allegation that something useful to the proceeding will be found, and whether the request is overly burdensome. *Id.*

Regarding the first factor, the party requesting the information “should already be in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered.” *Id.* at 7. In that context, “useful” means “favorable in substantive value to a contention of the party moving for discovery.” *Id.*

Patent Owner has obtained the McSweeney Declaration, which it submits “brings into question the public availability of the [*City of Boston*] thesis at the critical date of the ’817 patent.” Mot. 7. Patent Owner, however, does not indicate specifically what information in the Declaration tends to show that, under the applicable case law, the *City of Boston* thesis was not publicly available at the relevant time. More importantly, in connection with the first *Garmin* factor, Patent Owner does not explain how the Declaration tends to show “beyond speculation” that the additional information Patent Owner seeks from Ms. McSweeney will be useful, i.e., “favorable in substantive value to” Patent Owner, or that the historical information even exists. As for the testimony sought from Ms. Kajosalo and Professor Madnick, Patent Owner does not explain how such testimony, if obtained, would assist Patent Owner in demonstrating that the *City of Boston* thesis was not publicly available under the relevant case law.

We also consider whether Patent Owner’s request is overly burdensome. Patent Owner contends that the discovery requests are narrowly focused and will not be overly burdensome to answer. *Id.* at 8. This factor, however, also takes into account the “financial burden, burden on human resources, and burden on meeting the time schedule of this review.” *Garmin*, slip op. at 14. We particularly are concerned with the impact of Patent Owner’s request on the schedule in this proceeding. Since at least April 2014, when the Petition in this proceeding was filed, Patent Owner has known that the grounds asserted by Petitioner rely in part on *City of Boston*. According to Petitioner, Patent Owner was on notice that Petitioner intended to rely on *City of Boston* even earlier, in February 2014, when Petitioner filed its invalidity contentions in the related district court

proceeding. Opp. 1. Yet Patent Owner did not contact the Board until December 11, 2014, eleven days before the original due date for filing its Patent Owner Response, to request authorization to file the instant Motion. Although our Order modified the due dates for the Patent Owner Response and Petitioner Reply, Order 4, Patent Owner requests an additional extension of time for filing its Patent Owner Response to allow sufficient time to obtain the compelled testimony and production of documents. Mot. 8–9. As Petitioner points out, because Patent Owner delayed in requesting authorization to compel testimony and production of documents, granting such authorization would put the schedule in jeopardy. Opp. 8. Petitioner also notes that if we authorize Patent Owner to subpoena the named individuals at MIT, the need to depose those individuals will impose an additional financial burden on Petitioner. *Id.*

Upon consideration of the *Garmin* factors, we are not persuaded that authorizing Patent Owner to compel testimony and production of documents is in the interest of justice. Therefore, we deny Patent Owner’s Motion for Authorization to Compel Testimony and Productions of Documents.

ORDER

Accordingly, it is:

ORDERED that Patent Owner’s Motion for Authorization to Compel Testimony and Production of Documents is *denied*.

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FOR PETITIONER:

Peter J. Ayers
Brian Mangum
LEE & HAYES, PLLC
13809 Research Blvd., Suite 405
Austin, Texas 78750
peter@leehayes.com
brianm@leehayes.com

FOR PATENT OWNER:

Steven H. Washam
Scott L. Harper
Harper Washam LLP
1700 Pacific Ave, Suite 3600
Dallas, Texas 75201
steven.washam@harperwasham.com
scott.harper@harperwasham.com
patents@harperwasham.com