

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2014-01385
U.S. Patent No. 7,984,081 B1

Before JONI Y. CHANG, JENNIFER S. BISK, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Motion for Authorization to Compel Testimony
37 C.F.R. § 42.52(a)

On May 4, 2014, we authorized Intellectual Ventures I LLC ("Patent Owner") to file a motion for authorization to compel third-party testimony of Mr. Richard Reader, an employee of Oracle Corporation, by applying for a subpoena in a federal district court. Paper 19, 9. We also authorized

International Business Machines Corporation (“Petitioner”) to file an opposition to the motion. *Id.*

On May 18, 2015, Patent Owner filed its Motion for Authorization to Compel Testimony of Richard Reader (Paper 22, “Motion”). On May 19, 2015, Counsel for third party, Oracle Corporation, Ms. Kocialski and Ms. MacGuire, both employees of Oracle Corporation (“Oracle’s Counsel”), contacted the Board requesting a call to discuss concerns regarding the scope of Patent Owner’s request. On May 22, 2015, we had a call with Counsel for the parties and Oracle’s Counsel regarding concerns pertaining to the scope of Patent Owner’s request. During that call, Petitioner indicated that it will not oppose Patent Owner’s request.

1. Background

We instituted the instant trial based, in part, on an asserted ground of unpatentability over Oracle 8i® Application Developer’s Guide — XML, Release 3 (8.1.7) (Sept. 2000) (Exhibit 1008) (“Oracle Developer’s Guide”). Paper 7, 21–22. Subsequently, Patent Owner served Petitioner objections under 37 C.F.R. § 42.64(b)(1), alleging the Oracle Developer’s Guide had not been shown to be a prior art printed publication or authenticated, and it is inadmissible hearsay. Ex. 1016, 7. To respond to Patent Owner’s objections, Petitioner requested, and we authorized, Petitioner, under 35 U.S.C. § 24, to apply for a subpoena to compel discovery from Oracle Corporation limited in scope to the particular document request and deposition request submitted as Exhibit 1015. Paper 15, 9. We additionally permitted Patent Owner to attend the deposition and cross-examine the

witness, but only regarding the subject matter of the direct testimony of the witness. *Id.*

Rather than conducting an oral deposition, Oracle indicated to Petitioner that it preferred to supply a declaration from one of its employees. Petitioner, thereafter, served on Patent Owner supplemental evidence including the Declaration of Mr. Richard Reader, Manufacturing and Distribution Senior Director at Oracle Corporation, and related exhibits containing screenshots of Oracle Corporation's computer system for software and document shipments. Exs. 1038–1040. Petitioner additionally requested filing the Declaration of Mr. Reader as supplemental information. Paper 19, 2. Patent Owner opposed Petitioner's request on the basis that Patent Owner had not had an opportunity to cross-examine Mr. Reader. *Id.* at 4.

On May 4, 2015, we authorized Petitioner's request to file Mr. Reader's Declaration (Ex. 1038) and two-pages of accompanying exhibits (Exs. 1039, 1040) as supplemental information. *Id.* at 8. We also instructed Patent Owner to ascertain whether Oracle Corporation would agree to Patent Owner's cross-examination of Mr. Reader and, if Oracle Corporation did not agree, we authorized Patent Owner to file a motion for authorization to compel Mr. Reader's testimony pursuant to 37 C.R.F. § 42.52(a). *Id.* at 8–9.

On May 18, 2015, Patent Owner filed its request indicating that “Oracle does not agree to make Mr. Reader available for a deposition and that Oracle would require Patent Owner to serve a subpoena for the requested deposition.” Paper 22, 3. For the reasons set forth below, we grant Patent Owner's Motion.

2. *Applicable Law*

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.”).

3. *Patent Owner’s Motion*

With its Motion (Paper 22), Patent Owner submitted Exhibit 2001, which includes Patent Owner’s discovery request. Exhibit 2001 is a single page with one deposition topic. It is entitled “REQUEST FOR DEPOSITION OF RICHARD READER.” Ex. 2001. Patent Owner’s deposition topic is “[t]he subject matter set forth in Mr. Reader’s declaration attached hereto as Exhibit B.” Ex. 2001. Although Patent Owner did not submit “Exhibit B” (*id.*), we evaluate Patent Owner’s request on the basis that Exhibit B will be only the Declaration of Mr. Reader and two pages of

accompanying exhibits, i.e., Exhibits 1038 through 1040, submitted by Petitioner.

The title of Exhibit 2001 indicates that Patent Owner seeks testimony regarding the personal knowledge of Mr. Reader. Patent Owner also indicates it seeks testimony regarding the personal knowledge of Mr. Reader by contending, “Patent Owner cannot meaningfully test . . . by any means other than the cross-examination of Mr. Reader.” Paper 22, 6. As further indication that Patent Owner seeks Mr. Reader’s personal knowledge, Patent Owner contends that even Mr. Reader’s lack of knowledge would be informative. *Id.* at 5.

Patent Owner additionally indicates it is willing to be bound by the same deposition topic submitted by Petitioner, i.e., “[t]he date of first public availability of [the Oracle Developer’s Guide].” Ex. 1015. In particular, Patent Owner asserts that “cross-examination of Mr. Reader would lead to further testimony *relevant to whether Exhibit 1008 is a prior art printed publication.*” Paper 22, 4 (emphasis added).

Patent Owner further indicates it will adhere to time constraints and manner of conducting the deposition that we previously suggested. Paper 19, 6. Patent Owner specifically states it “is also willing to conduct the deposition by telephone and to limit the length of cross-examination to one hour.” Paper 22, 7.

4. Concerns Raised by Oracle’s Counsel

During the call on May 22, 2015, Oracle’s Counsel expressed concern that Patent Owner’s request is not tailored sufficiently narrowly. Oracle’s Counsel specifically noted a concern with the following statement in Patent

Owner's Motion, "there can be no reasonable doubt that Mr. Reader possesses additional knowledge—not stated in his declaration—relevant to whether Exhibit 1008 was sufficiently accessible to the relevant public to qualify as a prior art printed publication." Paper 22, 4. Oracle's Counsel expressed an additional concern that the subpoena would be burdensome on Oracle Corporation, for example, by requiring preparation of Mr. Reader for his deposition.

We inquired as to whether Oracle Corporation would like to file an Opposition to Patent Owner's request, as part of this proceeding. Oracle's Counsel responded that at this time they are uncertain if they would like to file such an Opposition. Oracle's Counsel indicated that providing written answers to written questions presented by Patent Owner would be less burdensome. Oracle's Counsel suggested that a narrower topic also would be less burdensome, but did not provide specificity as to a particular topic that would not be opposed by Oracle Corporation.

5. Analysis

As discussed above, Patent Owner's request arises out of series of requests pertaining to Patent Owner's objections regarding the date of first public availability of the Oracle Developer's Guide. We already permitted Patent Owner to attend any potential deposition conducted by Petitioner and cross-examine the Oracle witness regarding the subject matter of the direct testimony of the witness. Paper 15, 9. We, therefore, turn to the concerns raised by Oracle's Counsel.

Regarding Oracle's Counsel's concern that the topic is not tailored sufficiently narrowly, Patent Owner requests a one hour cross-examination

of Mr. Reader regarding his personal knowledge of “[t]he subject matter set forth in Mr. Reader’s declaration.” Ex. 2001. In his Declaration, Mr. Reader states, “I have personal knowledge of the following facts and could competently testify as to each statement if called as a witness at a deposition, hearing or trial.” Ex. 1038 ¶ 1. Patent Owner also is willing to conduct the deposition by telephone (Paper 22, 7) and indicates it is willing to be bound (Paper 22, 4) by the same deposition topic submitted by Petitioner, i.e., “[t]he date of first public availability of [the Oracle Developer’s Guide].” Ex. 1015. We note that Oracle Corporation was able to provide the Declaration of Mr. Reader regarding this same topic.

We turn to the specific statement in Patent Owner’s Motion noted by Oracle’s Counsel i.e., “there can be no reasonable doubt that Mr. Reader possesses additional knowledge—not stated in his declaration—relevant to whether Exhibit 1008 was sufficiently accessible to the relevant public to qualify as a prior art printed publication” (Paper 22, 4). Patent Owner provides an example “Mr. Reader likely can testify . . . whether the website from which the document allegedly could be ordered [was] sufficiently accessible to the relevant public.” *Id.* 4–5. Without more clarification, we cannot determine whether Mr. Reader “likely” can testify as Patent Owner suggests or whether Mr. Reader possesses additional knowledge, not stated in his Declaration. Mr. Reader states in his Declaration, “Note that the status ‘ONLINE’ indicates that the documentation . . . was instead made available online on an Oracle website.” Ex. 1038 ¶ 7. One possibility is that Mr. Reader’s personal knowledge is limited to this statement in his Declaration.

Additionally, on this record, we do not make any determination regarding the merit of Patent Owner's contentions regarding what testimony Mr. Reader might provide and what any lack of personal knowledge might indicate. Paper 22, 4–5. At this stage in the proceeding, we do not have a transcript with actual questions and answers. Furthermore, without more specificity from Oracle's Counsel regarding its concerns and without having an Opposition filed by Oracle Corporation, we cannot make further determinations regarding objections that Oracle Corporation might have. We, however, note that after Oracle Corporation is served any subpoena resulting from this order, Oracle Corporation may take advantage of its rights in the United States District Court related to that subpoena.

Because we cannot access fully Oracle Corporation's concerns, we note that we are providing Patent Owner with the *opportunity* to apply for a subpoena from the Clerk of the United States District Court for the district where the testimony of Oracle Corporation is to be taken, as limited herein. Patent Owner contends “declaration testimony is normally subject to cross-examination as part of routine discovery.” Paper 22 (citing 37 C.F.R. § 42.51(b)(1)(ii)). However, Mr. Reader has not been established as Petitioner's declarant as Mr. Reader is an employee of third party, Oracle Corporation, and has not been shown to have received compensation from Petitioner. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012). Although the circumstances in the instant case differ from those involving routine discovery, allowing Patent Owner the opportunity to apply for a subpoena so as to cross-examine Mr. Reader is

consistent with providing for the cross-examination of “the other sides declarants.” *Id.*

We note that Patent Owner indicated it is unwilling at this time to submit written questions or provide further guidance regarding questions it plans to ask during Mr. Reader’s deposition. We, however, continue to encourage Patent Owner to cooperate with Oracle Corporation and Mr. Reader. For example, Patent Owner can provide additional specificity of its proposed deposition topic in advance of the actual deposition, as requested by Oracle Corporation. In addition to easing the burden on Oracle Corporation and Mr. Reader, additional specificity by Patent Owner may make the transcript more meaningful.

6. Conclusion

For the foregoing reasons, we determine that Patent Owner has satisfied its burden and is authorized under 35 U.S.C. § 24 to apply for a subpoena from the Clerk of the United States District Court for the district where the testimony of Oracle Corporation is to be taken. The scope of the subpoena shall be limited to the deposition topic in Exhibit 2001, i.e., “[t]he subject matter set forth in Mr. Reader’s declaration attached hereto as Exhibit B.” Ex. 2001. We further note that our authorization is on the basis that the deposition topic of Exhibit 2001 is a sub-set of and limited to Petitioner’s topic, as specified in Exhibit 1015 i.e., “[t]he date of first public availability of [the Oracle Developer’s Guide].” Ex. 1015. We further note that “Exhibit B” referenced in Exhibit 2001 may be only Petitioner’s Exhibits 1038 through 1040. Additionally, the deposition is of the personal knowledge of Mr. Reader.

Each of counsel for Petitioner and counsel for Oracle Corporation is permitted to attend and each is allowed to conduct redirect examination. The cross-examination, redirect examination, and re-cross examination shall be subject to the following time limits: One hour for cross-examination by Patent Owner, 15 minutes for redirect examination by Petitioner, 30 minutes for redirect examination by Oracle Corporation, and, for re-cross examination by Patent Owner, the shorter of 30 minutes or the combined time taken by Petitioner and Oracle Corporation for redirect examination. We further require that the deposition be conducted telephonically, unless Oracle Corporation prefers an in-person deposition, and that Patent Owner provide us with notice of the date and time of the deposition, at least two business days prior to the deposition.

We note that our decision is that Patent Owner is authorized to apply for a subpoena under 35 U.S.C. 24 and to use the testimony in the present case. We, however, note that the authorization is on the basis that the additional discovery that Patent Owner seeks will be completed no later than August 1, 2015. We encourage the parties to cooperate with Oracle Corporation in this regard. If Patent Owner has difficulty meeting the August 1, 2015 date, Patent Owner should notify us if it wishes to seek an extension.

ORDER

For the reasons given, it is

ORDERED that Patent Owner is authorized under 35 U.S.C. § 24 to apply for a subpoena from the Clerk of the United States District Court for the district where the testimony of Oracle Corporation is to be taken;

FURTHER ORDERED that the scope of the subpoena shall be limited to the deposition topic submitted in this proceeding as Exhibit 2001, which is understood to be a sub-set of and limited by Petitioner's deposition topic specified in Exhibit 1015;

FURTHER ORDERED that counsel for Petitioner and counsel for Oracle Corporation are permitted to attend the deposition and conduct redirect examination of the witness, but only regarding the subject matter of the cross-examination testimony of the witness;

FURTHER ORDERED that the cross-examination, redirect examination, and re-cross examination shall be subject to the following time limits: One hour for cross-examination by Patent Owner, 15 minutes for redirect examination by Petitioner, 30 minutes for redirect examination by Oracle Corporation, and, for re-cross examination by Patent Owner, the shorter of 30 minutes or the combined time taken by Petitioner and Oracle Corporation for redirect examination;

FURTHER ORDERED that re-cross examination by Patent Owner, if any, be limited to the subject matter of the redirect examination of the witness conducted by Petitioner or Oracle Corporation; and

FURTHER ORDERED that the deposition of Mr. Reader should be conducted telephonically, unless Oracle Corporation prefers an in-person deposition, and the additional discovery must be completed by August 1, 2015, unless Patent Owner obtains an extension from us.

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