

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE BOEING COMPANY

Petitioner,

v.

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA

Patent Owner

Case IPR2024-00761

U.S. Patent No. 7,487,684

**PATENT OWNER'S UNOPPOSED MOTION FOR AUTHORIZATION
FOR SUBPOENA UNDER 35 U.S.C. § 24 AND 37 C.F.R. § 42.52**

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TABLE OF EXHIBITS

Exhibit	Description
Exhibit 2002	Proposed Subpoena for Deposition of Ms. LaTonya Morris
Exhibit 2003	November 12, 2024 email from the Board to Counsel for Petitioner and Counsel for Patent Owners

TABLE OF AUTHORITIES

Cases

<i>1964 Ears, LLC. v. Jerry Harvey Audio Holdings, LCC.</i> , IPR2016-00494, Paper 40 (PTAB Jan. 30, 2017)	1, 6
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I. INTRODUCTION

Patent Owners respectfully seek authorization under 35 U.S.C. § 24 and 37 C.F.R. § 42.52 to compel deposition testimony from Petitioner's declarant, Ms. LaTonya Morris, pursuant to the Board's communication dated November 12, 2024. Ex. 2003. Patent Owners are seeking testimony concerning the declaration submitted by Petitioner and authored by Ms. Morris (Ex. 1035) ("Morris Declaration") in support of the Petition for *Inter Partes* Review (Paper No. 1).

Since the Morris' declaration (Ex. 1035) was "specifically prepared for this *inter partes* review, [Patent Owners are] entitled to cross examination discovery under 37 C.F.R. § 41.51(b)(ii)." *1964 Ears, LLC. v. Jerry Harvey Audio Holdings, LCC.*, IPR2016-00494, Paper 40, 4 (PTAB Jan. 30, 2017). Moreover, the requested discovery is in the interests of justice and satisfies the *Garmin* factors. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6-7 (PTAB, Mar. 5, 2013) (precedential). The *Garmin* factors are appropriate for third-party discovery requests. *Alternative Legal Solutions, Inc. v. Employment Law Compliance, Inc.*, IPR2014-00562, Paper 22 at 3 (PTAB, Dec. 23, 2014) (applying *Garmin* factors to request for third party discovery).

II. IDENTIFICATION OF TESTIMONY SOUGHT AND EFFORTS MADE TO OBTAIN IT TO DATE

Pursuant to 35 U.S.C. § 24 and 37 C.F.R. § 42.52(a), Patent Owners request authorization to issue a subpoena for cross-examination testimony from Ms. LaTonya Morris related to the Morris Declaration (Ex. 1035). Specifically, Patent Owners seek four hours of testimony related to the Morris Declaration, including:

- Topic No. 1: Your declaration, dated March 15, 2024, which was presented in United States Patent and Trademark Office Inter Partes Review Proceeding IPR2024-00761 on behalf of The Boeing Company as Boeing Ex. 1035, including all attachments thereto (collectively, “Morris Declaration”).
- Topic No. 2: The past and current policies, procedures, and practices of ProQuest LLC related to collection, organization, publication, and distribution for sale of content, including dissertations and master’s theses.
- Topic No. 3: ProQuest’s collection, organization, publication, and distribution for sale of Dissertation No. 3070468, entitled “Thin -film adhesion measurement by laser –induced stress waves,” by Junlan Wang.
- Topics No. 4: Your employment by ProQuest LLC, including your job description and duties and responsibilities as a Technical Support Team Leader.

- Topic No. 5: All documents and things made in connection with the preparation of the Morris Declaration, including correspondence with counsel for Petitioner, The Boeing Company.
- Topic No. 6: All documents and things made in connection with your preparation for this deposition, including correspondence with counsel for Petitioner, The Boeing Company.

By way of background, in her declaration, Ms. Morris identified herself as a technical Support Team Leader employed by ProQuest, LLC. The Morris Declaration (Ex. 1035) avers that a dissertation by Junlan Wang entitled “Thin-film adhesion measurement by laser-induced stress waves” (“Wang Dissertation”) (Ex. 1005) was available in a ProQuest database for sale as early as March 4, 2003. Petitioner cited the Wang Dissertation (Ex. 1005) in its Petition for *Inter Partes* Review (Paper No. 1) as an alleged prior art reference that rendered U.S. Patent No. 7,487,684 (“the ’684 Patent”) invalid, and Petitioner relied upon the Morris Declaration in support of Petitioner’s assertion that the Wang Dissertation qualifies as prior art. The Board on several instances encouraged Patent Owners to cross-examine Ms. Morris and develop the trial record further. For example, Paper 8 (Institution Decision), at 16 (“Patent Owner is also free to cross-examine Ms. Morris should it choose to do so.”)

Patent Owners are entitled to cross-examination of Ms. Morris under 37 C.F.R. § 42.51(b)(1)(ii) with respect to statements made regarding the public availability of the Wang Dissertation through the ProQuest database. Patent Owners have been seeking a deposition date since October 7, 2024. Ex. 2003, at 3.

On November 8, 2024, Petitioner notified Patent Owner for the first time that Petitioner was refusing to make Ms. Morris voluntarily available for a deposition. However, Petitioner at that same time confirmed that it does not oppose Patent Owner's request to subpoena Ms. Morris. *See Id.*.

On November 8, 2024, Patent Owner requested authorization from the Board to formally move to compel the testimony of Ms. Morris pursuant to 37 C.F.R. § 42.52(a). *Id.* Later that same day, Petitioner wrote to the Board and Patent Owner informing that it had been working with Ms. Morris' employer, ProQuest, to make her available for a deposition. *Id.*, at 2. Petitioner stated that third party ProQuest had recently said it does not object to Ms. Morris testifying, but would require a subpoena to make its employee available.¹ ***Id.* Petitioner stated that ProQuest had said it may request accommodations for the convenience of the witness, such as a remote deposition, but will not otherwise contest the subpoena. Likewise, Petitioner stated that it also does not object to the subpoena. *Id.***

¹ Ms. Morris is represented by in-house counsel for ProQuest.

On November 12, 2024, the Board responded to the communications of November 8, 2024 from Patent Owner and Petitioner, permitting Patent Owner to file a motion for authorization to apply for a subpoena under 35 U.S.C. § 24, and ordered Patent Owner to confer with Petitioner and counsel for Ms. Morris “regarding the parameters of the deposition and any accommodations desired by the witness.” Ex. 2003, at 1.

Counsel for Patent Owner, counsel for Petitioner, and counsel for Ms. Morris conferred via email and telephone during the week of November 11, 2024. The positions of counsel and agreements reached are as follows:

Counsel for Ms. Morris requested to accept service of the subpoena on Ms. Morris’ behalf, and provided the address of the ProQuest office out of which Ms. Morris works for service of the subpoena. Counsel for Ms. Morris also provided dates in December 2024 during which Ms. Morris would be unavailable.

The parties agreed on a deposition to be conducted remotely via Zoom between the present date and mid-December 2024. Counsel for Patent Owner has requested four hours for its questioning of Ms. Morris during the deposition.

III. PATENT OWNERS ARE ENTITLED TO CROSS EXAMINE MS. MORRIS

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*, IPR2012-00001, Paper 26 at 6-7 .

Cross-examination of the opposing party's declarants is typically provided under routine discovery. 37 C.F.R. § 42.51(b)(1)(ii).

The Morris Declaration, dated March 15, 2024 was prepared for the Petition filed April 1, 2024. *See* Paper 1, at 13 (relying on the Morris Declaration to establish that the Wang Declaration was prior art). Accordingly, if the Morris Declaration is to remain in this proceeding, Patent Owner is entitled to cross examine Ms. Morris on her declaration. *1964 Ears*, IPR2016-00494, Paper 40, 4 (“We find that because Exhibits 2037 and 2038 are declarations specifically prepared for this *inter partes* review, Petitioner is entitled to routine cross examination discovery under 37 C.F.R. § 41.51(b)(ii). We, therefore, conclude that because Petitioner has been deprived that routine discovery, the appropriate remedy is to strike and expunge Exhibits 2037 and 2038 from the record.”).

Additionally, Ms. Morris states in her declaration that she is “competent to testify” (Ex. 1035, 4), and the Board has already acknowledged that “Patent Owner is also free to cross-examine Ms. Morris should it choose to do so.” Paper 8, 16.

IV. THE REQUESTED DISCOVERY THROUGH SUBPOENA IS IN THE INTERESTS OF JUSTICE

Even if Patent Owner is not entitled to cross examine Ms. Morris as a matter of right under 37 C.F.R. § 41.51(b)(1)(ii), this discovery is necessary “in the interests of justice.” *Garmin*, IPR2012-00001, Paper 26 at 6-7 .

If a declarant is unwilling to appear voluntarily, a party in a contested case before the Patent and Trademark Office may apply to a United States District Court for a subpoena to compel testimony. 35 U.S.C. § 24. A party seeking a subpoena to compel testimony must first obtain authorization from the Board. 37 C.F.R. § 42.52(a).

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 positions; (3) whether the requested information is available through other means; (4) whether the instructions associated with the discovery are easily understandable; and (5) whether the discovery is overly burdensome to answer. *Garmin*, IPR2012-00001, Paper 26 at 6-7 (collectively "the Garmin Factors"). Because all the *Garmin* factors favor the proposed discovery in this case, the Board should grant the requested discovery.

Authorizing Patent Owner to apply for a subpoena is consistent with the mandate that the Board “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). Authorizing the subpoena provides Patent Owner with the opportunity to cross-examine the declarant it has requested and also obviates the need for any additional motion practice regarding the ability of Petitioner to continue relying on the declaration in this proceeding.

V. DISCOVERY IS APPROPRIATE

Each of the *Garmin* factors favors granting the request to apply for a subpoena.

A. There is More Than a Possibility and a Mere Allegation that Useful Information Will Be Discovered (Factor 1)

The Morris Declaration (Ex. 1035) brings into question the public availability of the Wang Dissertation as of the critical date of the '684 Patent, which is a central question that will impact the resolution of the issues raised in the IPR2024-00761. Accordingly, Patent Owner is “in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered.” *Garmin*, IPR2012-00001, Paper 26 at 7.

The testimony that Patent Owner seeks will directly address the public accessibility arguments made by Petitioner by shedding light on the date the Wang Dissertation was obtained by ProQuest and made publicly accessible. This information is useful because it directly responds to Petitioner’s argument that

ProQuest obtained and made the Wang Dissertation publicly accessible as of March 4, 2003, which is exactly one year and one day before the priority date of the '684 Patent qualifying it as a prior art under Section 102(b) as opposed to other sections.

The subpoena is likely to result in the discovery of evidence on this subject. For example, Ms. Morris has stated in her declaration that she is “familiar with ProQuest's sales and publication practices with respect to the publication of dissertations and master’s theses as well as the related Abstract Database.” Ex. 1035, at ¶2.

B. Patent Owners Do Not Seek Petitioner’s Litigation Positions (Factor 2)

Patent Owners are not seeking the Petitioner’s litigation positions. Nor will any litigation position be revealed because the deposition seeks to take the testimony of a third-party witness regarding the publication date of an alleged prior art reference.

The proposed subpoena seeks information regarding Ms. Morris’ familiarity with ProQuest’s policies and practices regarding obtaining, date-stamping, and making publicly-available the reference materials in its holdings, with specific focus on how the Wang Dissertation was treated by ProQuest as a reference material in its holdings.

C. Patent Owner Cannot Generate Equivalent Information (Factor 3)

The deposition testimony Patent Owner seeks relates to the alleged date of publication of an alleged prior art reference, which was the subject of the Morris Declaration (Ex. 1035) offered by the proposed deponent. This testimony can only be obtained from the proposed deponent. Patent Owner cannot independently generate or obtain this information. Ms. Morris' counsel has indicated that it will only permit Ms. Morris to testify on her declaration in response to a subpoena.

D. Patent Owners' Request Has Easily Understandable Instructions (Factor 4)

Patent Owner only requests the very focused testimony of the proposed deponent, on the subject of her declaration, which in turn is directed to the publication date of alleged prior art reference, the Wang Dissertation.

Exhibit 2002 to this motion includes Patent Owner's proposed subpoena requests and topics for Ms. Morris. As evidenced by these requests and topics, the subjects of the requested testimony are easy to understand and not overly burdensome.

E. Compliance with Patent Owners' Request Is Not Overly Burdensome (Factor 5)

The deposition testimony sought is narrowly focused and will not be overly burdensome to provide because it is centered around the scope and content of the Morris Declaration and her knowledge of the associated policies and procedures of ProQuest.

F. Additional Factors Favor Patent Owners' Request

Finally, Patent Owner has acted with diligence and has not caused any unnecessary delay in seeking the requested deposition testimony. Patent Owner sought the requested testimony promptly from Petitioner, who offered the Morris Declaration in support of its Petition for *Inter Partes* Review. *See* Ex. 2003, at 3. When Petitioner's counsel indicated that it did not represent Ms. Morris, Patent Owner promptly sought the testimony from Ms. Morris' counsel. Patent Owner's prompt requests for the testimony, including its current motion for authorization to seek a subpoena for such testimony, will not put the schedule for this proceeding in jeopardy if granted.

VI. CONCLUSION

Patent Owners respectfully request the Board to grant its motion for authorization to apply for a subpoena to compel deposition testimony from Ms. LaTonya Morris. Neither Petitioner nor counsel for Ms. Morris opposes this request.

Respectfully submitted,

/Raja N. Saliba/

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the attached Patent Owner's Motion For Authorization To Apply For A Subpoena Under 35 U.S.C. § 24 and 37 C.F.R. § 42.52 is being served by electronic mail on the following counsel of record:

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