

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ILLUMINA INC.,  
Petitioner,

v.

MOLECULAR LOOP BIOSCIENCES, INC.,  
Patent Owner.

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Case No. IPR2024-00964  
Patent No. 11,041,852

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**PETITIONER'S MOTION FOR AUTHORIZATION TO COMPEL  
TESTIMONY AND/OR DOCUMENTS UNDER 37 C.F.R. § 42.52(a)**

Petitioner moves for an order granting authorization to apply for a subpoena compelling production of documents and testimony from arXiv.org (“arXiv”)<sup>1</sup> to address Patent Owner’s arguments regarding the date of public accessibility of an asserted prior art reference (“*Gloor*”).<sup>2</sup> The Board authorized this motion via email on February 28, 2025. Patent Owner has indicated that it will oppose the motion.

## **I. Background**

Petitioner challenges claims 1-8 of U.S. Patent No. 11,041,852, relying on *Gloor* as prior art. *Gloor* is published on arXiv.org and was publicly accessible as of July 29, 2010. Before submitting the petition, Petitioner’s counsel contacted arXiv to request an affidavit regarding *Gloor*’s date of public availability on arXiv.org. EX1039 at 1, 3, 6. While arXiv confirmed that *Gloor* “was made public on arxiv.org at 8PM Eastern on 7/29/2010,” it declined to provide an affidavit. *Id.* at 5, 8. Petitioner submitted with its petition a declaration from *Gloor*’s author, Dr. Gregory B. Gloor, along with supporting exhibits, to show *Gloor*’s date of public accessibility. EX1002. Dr. Gloor testified that he submitted *Gloor* to arXiv on July

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<sup>1</sup> arXiv is “maintained and operated by Cornell Tech.” EX1045 at 1. Its “[o]perations are maintained by arXiv Leadership Team and arXiv staff at Cornell University.” *Id.*

<sup>2</sup> Gloor et al., Microbiome Profiling by Illumina Sequencing of Combinatorial Sequence-Tagged PCR Products (<https://arxiv.org/abs/1007.5075v1>).

28, 2010, and received an email from arXiv the next day confirming *Gloor*'s public availability as of July 29, 2010. EX1002, ¶¶ 16, 17, Exs. C-F.

Patent Owner nevertheless asserts that Petitioner "fails to show a reasonable likelihood that Gloor (EX1005) was publicly accessible" as of the December 23, 2010, priority date of the challenged patent. Paper 6 at 24. Patent Owner cited a case where the Board accepted an arXiv publication as prior art based on voluntary testimony from a Cornell University Library employee. *Id.* at 27.

The Board preliminarily held Petitioner met its burden. The institution decision states that, "with Dr. Gloor's declaration and the supporting exhibits attached therein," Petitioner met the burden to show "a reasonable likelihood that [Gloor] was publicly accessible" before the priority date of the challenged patent. Paper 7 at 12. The Board, however, "encourage[d] the parties to fully develop the record during trial to facilitate the ultimate resolution of this issue." *Id.* at 13. The Board noted that "testimony from a custodian with any personal knowledge of arXiv.org or its regular practices would have strengthened Petitioner's argument that Gloor is prior art." *Id.* at 12 (internal citation omitted).

After institution, Petitioner again contacted arXiv seeking an affidavit confirming *Gloor*'s public availability as of July 29, 2010. EX1042. Another arXiv employee confirmed public availability as of that date but reiterated that arXiv would not provide an affidavit. EX1043. Petitioner also requested an affidavit from the

same Cornell University Library employee who provided a declaration in the case cited in Patent Owner's Preliminary Response, but he did not reply. EX1044.

Petitioner contacted Patent Owner about seeking leave to apply for a subpoena. During a February 17 meet and confer, Petitioner explained its basis for seeking leave, including that arXiv staff declined to provide an affidavit. In a February 24, 2025 email, Patent Owner stated that it would oppose Petitioner's motion. EX1040 at 1-3. Patent Owner cited a Board decision denying leave to serve a subpoena relating to a reference's public accessibility. *Coll. Prods., Inc. v. Intirion Corp.*, Case PGR2024-00003, Paper 27. Unlike the facts here, the petitioner in that case "appear[ed] to have waited until well after the entry of [the Board's] Institution Decision . . . , before making an inquiry" with the reference's custodian. *Id.* at 7.

Although Petitioner believes the record evidence establishes *Gloor's* July 29, 2010, date of public accessibility under the preponderance standard, in view of Patent Owner's arguments, Petitioner now seeks leave to apply for a subpoena compelling testimony and documents from arXiv about *Gloor's* public availability and arXiv's regular practices of making references publicly available. Such evidence aligns with the Board's comments in the institution decision and will directly address Patent Owner's argument about *Gloor's* prior-art status. *See* Paper 6 at 27. The subpoena would narrow the issues for final determination and allow the Board and parties to focus on the substantive merits of the petition and instituted grounds.

## **II. Identification of Testimony/Documents Sought**

Pursuant to 37 C.F.R. § 42.52(a), Petitioners request authorization to issue a subpoena for (1) documents from arXiv sufficient to show when *Gloor* was made publicly available on arXiv.org; and (2) testimony from arXiv staff, *e.g.*, the program director or others with personal knowledge, about *Gloor*'s date of publication on arXiv.org, including arXiv's policies and standard business procedures for receiving and publishing manuscripts. The proposed requests are detailed in Exhibit A.

## **III. The Requested Discovery Is in the Interest of Justice**

Additional discovery in an IPR is limited to what is "necessary in the interest of justice." 35 U.S.C. § 316(a)(5). The Board considers five factors in determining whether discovery serves the interests of justice. *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, Paper 26 at 6-7 (P.T.A.B. Mar. 5, 2013). Here, all five *Garmin* factors favor Petitioner's proposed discovery.

### **1. There is more than a possibility and a mere allegation that useful information will be discovered (*Garmin* Factor 1)**

Petitioner's proposed discovery will provide evidence to rebut Patent Owner's challenge to *Gloor*'s prior-art status, addressing Patent Owner's argument that "Petitioner provides no testimony from any Cornell employee or any other custodian with any personal knowledge of arXiv.org or its regular practices." Paper 6 at 27.

As the publisher and custodian of *Gloor*, arXiv is expected to have information regarding *Gloor*'s date of public accessibility. As Patent Owner

acknowledged, arXiv personnel are “responsible for arXiv.org and knowledgeable regarding its practices.” *Id.* In fact, arXiv’s staff ***already confirmed*** that *Gloor* “was made public on arxiv.org at 8PM Eastern on 7/29/2010.” EX1039 at 5. arXiv also previously provided information about public accessibility of manuscripts published on arXiv.org in another proceeding and should be able to do so again here. EX1041.

The Board has repeatedly granted requests from petitioners for leave to subpoena custodians of prior-art references for information regarding the prior-art status of those references. *See, e.g., Canon Inc. v. Avigilon Fortress Corp.*, Case IPR2019-00311, Paper 24 (P.T.A.B. Sept. 6, 2019); *Apple Inc. v. Qualcomm Inc.*, Case IPR2018-01283, Paper 14 (P.T.A.B. Apr. 30, 2019); *Kaz USA, Inc. v. Exergen Corp.*, Case IPR2016-01437, Paper 21 (P.T.A.B. May 31, 2017).

**2. The proposed discovery does not seek legal positions or the underlying basis for a legal position (*Garmin* Factor 2)**

The subpoena is limited to facts surrounding *Gloor*’s public accessibility and does not request any information about Patent Owner’s litigation positions.

**3. The proposed discovery is not available through other means (*Garmin* Factor 3).**

While the petition provided evidence—including a declaration from *Gloor*’s author— showing public accessibility as of July 29, 2010, the most direct way to address Patent Owner’s challenge to public accessibility is through discovery from arXiv. As the publisher and custodian of *Gloor*, arXiv is in a unique position to

corroborate *Gloor*'s public accessibility. Petitioner is unaware of any other means for obtaining this discovery, nor has Patent Owner suggested any alternative source.

Unlike the petitioner in *College Products*, who submitted no declaration from any fact witness with the petition and waited until well after the institution decision before making any inquiry about the discovery, Petitioner here diligently attempted to obtain voluntary discovery from arXiv both before filing its petition and after institution. Before filing its petition, Petitioner's counsel emailed arXiv requesting an affidavit regarding *Gloor*'s date of public accessibility. EX1039 at 1, 3, 6. While arXiv's program director confirmed *Gloor*'s public availability as of July 29, 2010, she declined to provide an affidavit. *Id.* at 5, 8. Post-institution, even without evidentiary objections, Petitioner again sought an affidavit from both arXiv and the Cornell University Library staff who previously submitted a declaration regarding public accessibility of a manuscript on arXiv.org. EX1042; EX1044. arXiv's Head of Content & User Support again confirmed the July 29, 2010 date of *Gloor*'s public accessibility but declined to provide an affidavit. EX1043 (confirming that *Gloor* "was posted on 30 July 2010 shortly after midnight UTC (8PM ET)").

**4. The instructions of the discovery are easily understandable, and the discovery is not overly burdensome (*Garmin* Factors 4 and 5)**

As shown in Exhibit A, the instructions for the requested discovery are clear and concise. The proposed discovery is narrowly tailored to specifically address

*Gloor*'s date of public accessibility and Patent Owner's objections. The requests are limited to information about a single manuscript and arXiv's regular publication practices. The requests impose no excessive financial or other burden on arXiv. As Patent Owner acknowledged, arXiv provided similar information about the public accessibility of manuscripts published on arXiv.org in a prior proceeding and should be able to do so here without undue burden. Paper 6 at 27; EX1041. Discovery requests with similar scope were proposed and granted in previous proceedings. *See, e.g., Canon*, Case IPR2019-00311, Paper 18; *Apple*, Case IPR2018-01283, Paper 11.

The limited scope of the subpoena does not present a burden in meeting the timeline for the IPR. Nor does the narrow issue of *Gloor*'s date of public accessibility impact Patent Owner's ability to address the substance set forth in the petition. Further, Patent Owner will have the opportunity to address any additional evidence in its sur-reply and motion to exclude evidence, with deadlines still months away.

#### **IV. Conclusion**

For the foregoing reasons, Petitioner respectfully requests that the Board grant its motion for authorization.

Respectfully submitted,

Dated: March 7, 2025

By: /William B. Raich/  
William B. Raich, Reg. No. 54,386  
Lead Counsel for Petitioner

# **EXHIBIT A**

### **DOCUMENT REQUEST NO. 1:**

Documents sufficient to show when the manuscript entitled “Microbiome profiling by Illumina sequencing of combinatorial sequence-tagged PCR products” (<https://arxiv.org/abs/1007.5075v1>) was made available to the public by arXiv.org.

Responsive documents may include, for example:

- Documents and metadata reflecting the date the above-mentioned manuscript was first published and/or made accessible to the public;
- Documents reflecting arXiv.org’s policies and procedures effective as of 2010 for publishing and/or making papers accessible to the public;
- Logs from arXiv.org’s servers that show when the above-mentioned manuscript was uploaded; and
- Emails, internal memos, or other communications related to the publication of the above-mentioned manuscript.

### **DEPOSITION TOPIC NO. 1:**

The date of publication of the manuscript entitled “Microbiome profiling by Illumina sequencing of combinatorial sequence-tagged PCR products” (<https://arxiv.org/abs/1007.5075v1>) by arXiv.org, including descriptions of arXiv.org’s policies and standard business procedures for receiving and publishing manuscripts, and the meaning of the documents and information produced in response to Document Request No. 1.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing  
**PETITIONER'S MOTION FOR AUTHORIZATION TO COMPEL  
TESTIMONY AND/OR DOCUMENTS UNDER 37 C.F.R. § 42.52(a)** was  
served on March 7, 2025, via e-mail directed to counsel of record for the Patent  
Owner at the following:

Brian D. Matty  
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Patent Owner has consented to electronic service.

Dated: March 7, 2025

By: /William Esper/  
William Esper  
Legal Assistant and PTAB Coordinator  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP