

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA INC.,
Petitioner,

v.

MOLECULAR LOOP BIOSCIENCES, INC.,
Patent Owner.

IPR2024-00964 (Patent 11,041,852 B2)
IPR2024-00965 (Patent 11,768,200 B2)¹

Before ERICA A. FRANKLIN and ZHENYU YANG,
Administrative Patent Judges.

YANG, *Administrative Patent Judge.*

ORDER
Denying Petitioner's Motion for
Authorization to Compel Testimony and/or Documents
37 C.F.R. § 42.52

¹ This Order addresses issues that are the same in each of the above identified proceedings. We issue one Order to be entered in each proceeding. The parties are not authorized to use this style caption unless later permitted.

With our authorization (Ex. 3001), Petitioner filed a Motion for Authorization to Compel Testimony and/or Documents. Paper 12² (“Mot.”). Specifically, in the Motion,

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.

Id. at 4. Patent Owner filed an Opposition to the Motion. Paper 15 (“Opp.”). For the following reasons, we deny Petitioner’s Motion.

I. BACKGROUND

In the Petition, Petitioner asserted Gloor,³ among others, as prior art to challenge the claims of the patents-at-issue. Paper 1 (“Pet.”), 23. Relying on the Declaration of Dr. Gloor, the first named author, and exhibits attached therein, Petitioner argued that Gloor was published on July 29, 2010, and thus, “is prior art under at least pre-AIA 35 U.S.C. §102(a).”⁴ *Id.* at 12 (citing Ex. 1002).

In its Preliminary Response, Patent Owner contended that the exhibits Dr. Gloor relied on in support of his declaration “at best indicate[] his article was *submitted*, but do[] not show if and when it was actually *published*, much less published in July 2010.” Paper 6 (“Prelim. Resp.”), 26.

² For expediency, we cite to papers in IPR2024-00964. Similar papers and exhibits were filed in IPR2024-00965.

³ G.B. Gloor, et al., *Microbiome profiling by Illumina sequencing of combinatorial sequence-tagged PCR products*, Cornell University Library, arXiv:1007.5075v1 (2010) (Ex. 1005, “Gloor”).

⁴ Petitioner uses December 23, 2010, the earliest possible priority date, as the priority date of the challenged claims. *See* Pet. 1.

In our Decision to Institute, we discussed Dr. Gloor’s declaration and its supporting exhibits, specifically Exhibits E, F, and H. Paper 7 (“DI”), 11. We noted that Exhibit E, which Dr. Gloor testified is an email he received from arXiv.org, “shows that the Gloor reference was assigned an arXiv identifier as of July 29, 2010” and “provides a hyperlink to the abstract and states that the abstract would appear in that day’s mailing.” *Id.* (citing Ex. 1002, Exhibit E). Exhibit F, purportedly an email from arXiv Technical Support, “states that the submission with the same hyperlink ‘would have been announced on Thursday, July 29, 2010.’” *Id.* (citing Ex. 1002, Exhibit F). Dr. Gloor also cited Exhibit H, a poster he allegedly presented at a conference held between August 31 and September 2, 2010. Ex. 1002 ¶ 18. We noted that “the References section” of Exhibit H provides a complete citation to the Gloor reference. DI 11 (citing Ex. 1002, Exhibit H).

In view of Dr. Gloor’s declaration and the exhibits attached therein, we found that for purposes of institution, Petitioner met its burden to show that Gloor qualifies as prior art by “a reasonable likelihood” standard. *Id.* at 12 (citing *Hulu, LLC, v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29, 13 (PTAB Dec. 20, 2019) (precedential)). We reminded the parties that “[t]o prevail in this *inter partes* review, Petitioner must meet the preponderance of the evidence standard” and “encourage[d] the parties to fully develop the record during trial to facilitate the ultimate resolution of this issue.” *Id.* at 12–13.

Petitioner explains that, before even filing the Petition, it sought, albeit unsuccessfully, an affidavit from arXiv staff regarding Gloor’s publication date. Mot. 1 (citing Ex. 1039). After institution, Petitioner again sought such an affidavit. *Id.* at 2 (citing Ex. 1042). According to Petitioner,

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another arXiv employee confirmed Gloor’s public availability as of July 29, 2010 “but reiterated that arXiv would not provide an affidavit.” *Id.* (citing Ex. 1043).

Petitioner “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.” *Id.* at 3.

II. ANALYSIS

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Petitioner must show that granting its request, which is in the nature of additional discovery, is in the interests of justice. 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2)(i). We consider several factors in determining whether discovery serves the interests of justice, including (1) there is more than a possibility and a mere allegation that useful information will be discovered; (2) the proposed discovery does not seek the other party’s legal positions or the underlying basis for a legal position; (3) the proposed discovery is not available through other means; (4) the instructions of the discovery are easily understandable; and (5) the discovery is not overly burdensome. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (P.T.A.B. Mar. 5, 2013) (precedential).

Petitioner argues that its requested discovery is in the interest of justice. Mot. 4–7. Patent Owner disagrees. Opp. 5–7. We focus our analysis on whether the proposed discovery is available through other means.

According to Petitioner, “[a]s 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

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has Patent Owner suggested any alternative source.” Mot. 5–6. Although we agree with Petitioner that “the most direct way to address Patent Owner’s challenge to public accessibility is through discovery from arXiv” (*id.* at 5), we are not persuaded that compelling testimony, as Petitioner seeks, is the only way to establish the public accessibility of Gloor.

Petitioner cites our Decision to Institute, where we stated 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 2 (quoting DI 12). This statement, however, directly addressed Patent Owner’s argument in the Preliminary Response. DI 12 (citing Prelim. Resp. 27). It is not meant to prescribe testimony from a custodian as the sole means to show Gloor qualifies as prior art. Indeed, in the same paragraph of the Decision to Institute, we also set “testimony regarding the internet archive service known as the Wayback Machine (<https://web.archive.org/>)” as an example in determining public accessibility. *Id.* (citing *Murray & Poole Enters. LTD v. Institut De Cardiologie De Montreal*, IPR2023-01064, Paper 49 (PTAB Jan. 14, 2025)).

Moreover, Patent Owner contends that Petitioner has the ability to generate the requested information without need of additional discovery.

Opp. 6 (citing *Garmin*, Paper 26 at 6). According to Patent Owner,

Petitioner alleges that Gloor became publicly available in an email announcement sent by arXiv to its subscribers in July 2010 but fails to explain why it could not submit that email. For author Dr. Gloor—who testified that he “became a registered member of arXiv.org at least as of July 28, 2010” and that he “believe[s] arXiv.org sent email alerts to subscribers on July 29, 2010”—Petitioner does not explain why he did not provide the email sent to subscribers, despite submitting other emails he received from arXiv around the alleged publication

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date. EX1002, ¶¶ 12, 17. And Petitioner never requested that email from arXiv, which allegedly sent it, nor did Petitioner address whether it contacted any of the six other authors on Gloor.

Id. at 6–7.

We agree with Patent Owner that the alleged email arXiv.org sent to subscribers on July 29, 2010, announcing the publication of Gloor would constitute competent evidence to show Gloor’s public accessibility as of that date. Petitioner has not produced this email. Nor has Petitioner shown that it requested this email, either from arXiv.org or any of the authors of Gloor.

III. CONCLUSION

Because the requested information may be available through other means, we find additional discovery is not in the interest of justice.

IV. ORDER

For the foregoing reasons, it is:

ORDERED that Petitioner’s Motion for Authorization to Compel Testimony and/or Documents is denied.

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