

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COLLEGE PRODUCTS, INC.,
Petitioner,

v.

INTIRION CORPORATION,
Patent Owner.

PGR2024-00003
Patent No. 11,674,745

**PETITIONER’S MOTION UNDER 37 C.F.R. § 42.52(a) TO APPLY FOR
SUBPOENA UNDER 35 U.S.C. § 24 TO COMPEL TESTIMONY AND
PRODUCTION OF DOCUMENTS FROM NORTHEASTERN
UNIVERSITY**

EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,674,745
1002	Expert Declaration
1003	Prosecution File History, U.S. Patent No. 11,674,745
1004	Original Intirion Complaint Filed on June 8, 2022.
1005-1007	RESERVED
1008	U.S. Application No. 14/262,290 (“the ’290 Application”), published as U.S. Publication 2014/0251982.
1009	Exemplary embodiment Claim chart 1 sent by Intirion related to U.S. Patent No. 11,274,876
1010	RESERVED
1011	U.S. Application No. 12/317,632 (“the ’632 Application”) published as U.S. Publication U.S. Pub. 2009/0188911 (“Emma”)
1012	“ISDU: Integrated Smoke detector Unit for Commercial Microwave Ovens”, Cory Lloyd <i>et. al</i> , Northeastern University (2007). (“ISDU”)
1013	RESERVED
1014	U.S. Patent No. 4,496,817 to Smith (“Smith”)
1015	U.S. Patent No. 8,446,048 to Butt (“Butt”)
1016	Redline Comparison between 290 and Emma
1017-1019	RESERVED
1020	U.S. Application No. 13/094,747 (“the ’747 Application”) published as U.S. Publication U.S. Pub. 2012/0276763A1 (“Quezada”)
1021	Scheduling Order for <i>Intirion Corporation v. College Products, Inc.</i> , 5:23-cv-04023-KEM, Dkt. 75.

Exhibit No.	Description
1022	Amended Complaint filed by Initiron Corporation, 5:23-cv-04023-KEM, Dkt. 62.
1023	Supplemental Expert Declaration related to the 11,674,745 Petition
1024	Email correspondence between counsel for Petitioner and Northeastern University

Petitioner College Products, Inc. (“Petitioner”) seeks the Board’s authorization to apply for a subpoena to compel the production of documents and related testimony of third party Northeastern University (“Northeastern”). Patent Owner Intirion Corporation (“Intirion”) has indicated it opposes the motion.

I. FACTUAL BACKGROUND

On April 10, 2024, the Board instituted post-grant review of claims 1-28 of U.S. Patent No. 11,674,745 (“the ’745 patent”). *See generally* Paper 10. On April 24, 2024, Patent Owner filed objections challenging whether an article entitled “ISDU: Integrated Smoke detector Unit for Commercial Microwave Ovens” (Exhibit 1012, hereinafter referred to as “ISDU”) qualifies as prior art to the ’745 patent. Paper 12 at 2. Patent Owner objects that “there is not evidence in the record sufficient to demonstrate public availability; no individual with knowledge has submitted evidence showing that ISDU was publicly available.” *Id.*

In response to Patent Owner’s objection, Petitioner timely contacted the Library at Northeastern, the publisher of ISDU. Ms. Sarah Sweeney, the Head of Digital Production Services at Northeastern Library, verified the public availability of ISDU. She indicated that ISDU was publicly available no later than November 2013. Ex. 1024 at 5. Although Ms. Sweeny stated she would be comfortable signing a declaration, the policy of the Office of General Counsel at Northeastern prohibits her from submitting a declaration or documents unless a subpoena has

been served. *Id.* at 1, 3.

Therefore, Petitioner seeks authorization to serve a subpoena to obtain testimony and documents from Northeastern University confirming the public availability of ISDU.

II. GOOD CAUSE EXISTS FOR THE REQUESTED DISCOVERY

In a Post-Grant Review, additional discovery is available “upon a showing of good cause as to why the discovery is needed.” 37 C.F.R. § 42.224(a).

Additional discovery “is limited to evidence directly related to factual assertions advanced by either party in the proceeding.” These requirements are easily satisfied here.

As discussed below, there is good cause as to why a subpoena of Northeastern is needed, according to the five factors set forth in *Bloomberg, Inc. v. Markets-Alert Pty, Ltd.*, CBM2013-00005 (PTAB May 29, 2013) (Paper 32) at 5. The requested discovery is also limited to evidence about the publication date of ISDU, a factual assertion advanced by Petitioner in this proceeding.

A. Factor 1: Petitioner’s Current Evidence Tends to Show, Beyond Mere Allegations, that Northeastern Has Information that ISDU was Publicly Available No Later Than November 2013.

As detailed in Exhibit 1024, Ms. Sweeney indicated that Northeastern possesses documents confirming that ISDU was publicly available no later than November 2013. Ex. 1024 at 5. She has provided information indicating the

public availability of ISDU via IRis, a database that Northeastern maintained, by that date. *Id.*

Thus, Petitioner has sufficient current evidence that a subpoena would yield information corroborating Petitioner's contention that ISDU was publicly available and qualifies as prior art.

B. Factor 2: Petitioner Does Not Seek Litigation Positions or Underlying Bases

The subpoena is limited to information about facts surrounding the publication of ISDU by Northeastern. It does not call for any information about Patent Owner's litigation positions or underlying bases for them.

C. Factor 3: Petitioner Is Unlikely to Obtain the Sought-After Evidence Absent Discovery from Northeastern

Petitioner attempted to obtain a declaration and supporting documents from Ms. Sweeney without formal discovery. *See generally* Ex. 1024. But the policy of the Office of General Counsel at Northeastern prohibits employees from submitting a declaration or documents unless a subpoena has been served. *Id.* at 1. Thus, Petitioner is unlikely to be able to procure the requested discovery without a subpoena.

D. Factor 4: The Instructions Are Easily Understandable

Petitioner's discovery request is limited and straight forward and would not request substantial or superfluous definitions or instructions. Petitioner would

simply request: 1) testimony attesting to the information Ms. Sweeney already provided; and 2) the documents that support the conclusion that ISDU was publicly available no later than November 2013.

E. Factor 5: The Discovery Request Is Not Overly Burdensome to Answer

Ms. Sweeney has already provided information and collected documentation indicating that ISDU was publicly available. Ex. 1024 at 5. She has also already indicated her willingness to submit a declaration attesting to this information. *Id.* at 3. Thus, a subpoena targeted at obtaining testimony and supporting documents from the appropriate Northeastern representative would not be overly burdensome, financially, timewise, or otherwise, on Northeastern to answer.

The limited scope of the subpoena also does not present a burden for meeting the deadline for deciding this Post Grant Review. The narrow issue of the public availability of ISDU also does not impact Patent Owner's ability to address the substantive positions set forth in the Petition. Notably, there is ample time before Patent Owner's July 16, 2024 deadline to file the Patent Owner Response for information to be gained in response to the subpoena and considered by the parties.

* * *

Petitioner therefore submits that each of the five *Bloomberg* factors weighs

in favor of additional discovery. Thus, good cause exists for authorizing Petitioner's subpoena of Northeastern about the publication date of ISDU.

III. PETITIONER'S REQUEST IS TIMELY

To the extent Patent Owner insists that Petitioner was not diligent in its efforts to obtain a subpoena, that simply is not true. The earliest the issue of ISDU's status as prior art was ripe was April 10, 2024, the date the Board instituted this proceeding. *See generally* Paper 10. Prior to that date, it is unlikely the Board would have granted a motion for subpoena. Petitioner first contacted Northeastern on April 30, 2024, within three weeks of the institution decision, and almost three months before Patent Owner's response to the petition is due. *See* Ex. 1024 at 7; Paper 11 at 11. Given Northeastern's policy of preventing testimony and documents from being produced absent a subpoena, Petitioner would not have been able to procure testimony and documents much sooner, if at all, than now. Further, Petitioner raised this issue with the Board by the deadline set forth in the Scheduling Order to contact the Board about proposed motions that have not been authorized by that Order.

IV. CONCLUSION

Based on the foregoing, good cause exists for granting Petitioner permission to apply for issuance of a subpoena to Northeastern pursuant to 35 U.S.C. § 24.

Dated: May 24, 2024

Respectfully submitted,

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/Domingo M. LLagostera/

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Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **PETITIONER’S MOTION UNDER 37 C.F.R. § 42.52(a) TO APPLY FOR SUBPOENA UNDER 35 U.S.C. § 24 TO COMPEL TESTIMONY AND PRODUCTION OF DOCUMENTS FROM NORTHEASTERN UNIVERSITY** was served on counsel of record on May 24, 2024, by electronic mail at the following address, , as authorized in Patent Owner’s Mandatory Notices, as authorized in Patent Owner’s Mandatory Notices:

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