Trials@uspto.gov
571-272-7822

Paper 35
Entered: December 6 , 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

IPA TECHNOLGIES, INC.,
Patent Owner.

IPR2019-00730
IPR2019-00731
Patent 7,069,560 B1[1]

Before KEN B. BARRETT, TREVOR M. JEFFERSON, and BART A. GERSTENBLITH, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding, Compelling Testimony and Production
37 C.F.R. §§ 42.5, 42.52

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[1] This Order applies to both listed cases. The parties may not use this style heading unless authorized.

Patent Owner filed an authorized "Motion Under 37 C.F.R. § 42.52(a) to Apply for Subpoena Under 35 U.S.C. § 24 to Compel Testimony from Adam J. Cheyer and David L. Martin" on November 20, 2019, in IPR2019-00730 and IPR2019-00731. Paper 27 ("Mot.").[2] In both cases, Patent Owner seeks authorization to file a subpoena to compel testimony from the named-inventors of U.S. Patent 7,069,560 B1 ("the '560 patent"), Messrs. Martin and Cheyer, to rebut Petitioner's arguments concerning whether Exhibit 1011[3] qualifies as prior art to the '560 patent. Mot. 2. Patent Owner's motion addresses the factors set forth for such discovery in *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013). *Id.* at 3–5.

Petitioner filed an "Opposition to Patent Owner's Motion to Apply for Subpoena to Compel Testimony" (Paper 30, "Opp."), and Patent Owner filed a "Reply in Support of its Motion Under 37 C.F.R. § 42.52(a) to Apply for Subpoena to Compel Testimony from Adam J. Cheyer and David L. Martin" (Paper 33, "Reply").

Patent Owner's motion sets forth the efforts to obtain testimony in the form of declarations from Messrs. Cheyer and Martin related to Petitioner's contentions regarding Exhibit 1011. Mot. 1–2. Following unsuccessful

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[2] For clarity and expediency, references to paper or exhibit numbers apply to IPR2019-00730, unless indicated otherwise. Identical papers were filed in IPR2019-00731. *See* Papers 28, 31, and 34 (IPR2019-00731).

[3] David L. Martin, Adam J. Cheyer, Douglas B. Moran, *Building Distributed Software Systems with the Open Agent Architecture*, PROCEEDINGS OF THE THIRD INTERNATIONAL CONFERENCE ON THE PRACTICAL APPLICATION OF INTELLIGENT AGENTS AND MULTI-AGENT TECHNOLOGY 355 (1998) (Ex. 1011, "Martin").

attempts to obtain voluntary declarations from Messrs. Cheyer and Martin, Patent Owner now seeks a subpoena to compel the testimony. *Id.* (citing Ex. 2008 ¶¶ 4–20; Ex. 2009 ¶¶ 6–10). Petitioner argues that Patent Owner's motion is belated and acknowledges that changes to the schedules may be required to accommodate the testimony sought due to Patent Owner's alledged lack of diligence. Opp. 2–3; *see* Mot. 3 n.1 (Patent Owner acknowledging that schedule changes may be needed).

A party moving for a subpoena "must show that such additional discovery is in the interests of justice." 37 C.F.R. § 42.51(b)(2). The Board has identified factors important in determining whether an additional discovery request meets the standard of being "in the interest of justice." *Garmin International, Inc.*, IPR2012-00001, slip op. at 6–7. Having reviewed Patent Owner's request and arguments, we find that the *Garmin* factors weigh in favor of allowing the discovery. Mot. 3–5.

Petitioner's arguments regarding Patent Owner's belated timing and lack of diligence to obtain the testimony sought from Messrs. Cheyer and Martin (Opp. 3–5) do not negate the *Garmin* factors regarding the information sought and whether it is in the interest of justice. In addition, Petitioner's arguments that the testimony Patent Owner seeks would not be useful or that delays in the schedule would be overly burdensome to Petitioner are not persuasive.

Here, we agree with Patent Owner that the testimony sought is more than mere allegation that useful information will be discovered and is not available through other means. Mot. 3–4. Although the schedules in IPR2019-00730 and IPR2019-00731 and their related cases may be

impacted, these speculative changes are not sufficient to rebut the interest of justice regarding the information Patent Owner seeks at this time. We encourage the parties to meet and confer to address any scheduling issues this discovery presents. Upon reviewing Patent Owner's motion and Petitioner's opposition, we agree with Patent Owner that the *Garmin* factors favor allowing Patent Owner to pursue the discovery sought.

It is

ORDERED that Patent Owner's Motion Under 37 C.F.R. § 42.52(a) to Apply for Subpoena Under 35 U.S.C. § 24 to Compel Production of Testimony from Adam J. Cheyer and David L. Martin is *granted*; and

FURTHER ORDERED that Patent Owner is authorized under 35 U.S.C. § 24 to apply for a subpoena from the Clerk of the United States court for the district where testimony of Adam J. Cheyer and David L. Martin is to be taken.

IPR2019-00730
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PETITIONER:

Naveen Modi
naveenmodi@paulhastings.com

Joseph Palys
josephpalys@paulhastings.com

Daniel Zeilberger
danielzeilberger@paulhastings.com

Arvind Jairam
arvindjairam@paulhastings.com

PATENT OWNER:

Steven Hartsell
shartsell@skiermontderby.com

Alexander Gasser
agasser@skiermontderby.com

Sarah Spires
sspires@skiermontderby.com