

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JOHNS MANVILLE CORPORATION and JOHNS MANVILLE, INC.,
Petitioner,

v.

KNAUF INSULATION, INC. and KNAUF INSULATION SPRL,
Patent Owner.

Case IPR2015-01453
Patent D631,670 S

Before SCOTT A. DANIELS, KRISTINA M. KALAN, and
JAMES A. WORTH, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

Petitioner requested, by an email dated March 3, 2016, a conference with the Board on two matters: (1) Petitioner and Patent Owner requested authorization under 37 C.F.R. § 42.52(a) to submit a joint motion to compel testimony, and, in particular, to seek a subpoena from the requisite federal district court for the cross examination of a third-party witness, Mr.

Christopher Butler¹, Office Manager of the non-profit digital Library known as the “Internet Archive”; and (2) Patent Owner’s request to modify the current trial schedule to coordinate this proceeding with IPR2016-00130, a second IPR filed by Petitioner concerning the same design patent claim in the ’670 patent. *See Ex. 3001.* We conducted a telephone conference with the parties’ respective counsel on March 9, 2016.²

During the telephone conference, Patent Owner explained that they expect to challenge the authenticity of certain exhibits Petitioner obtained via the Wayback Machine, a web page archiving service operated by the Internet Archive. Petitioner explained that the authenticity of the exhibits is supported by an affidavit from Mr. Butler, who avers that:

[a]ttached hereto as Exhibit A are true and accurate copies of printouts of the Internet Archive’s records of the PDF files for the URLs and the dates specified in the coversheet of each printout.

¹ In the March 3, 2016, email to the Board, Petitioner made the following representation:

On January 26, 2016, Patent Owners served objections challenging the authenticity of certain Exhibits obtained from the nonprofit digital library Internet Archive, best-known for its web archive “The Wayback Machine.” In response to such objections, Petitioners secured and timely served supplemental evidence pursuant to 37 C.F.R. § 42.64 in the form of the attached affidavit from Christopher Butler of the Internet Archive confirming the source and authenticity of the challenged Exhibits. Mr. Butler’s testimony largely mirrors the Internet Archive’s standard affidavit (see <https://archive.org/legal/affidavit.php>).

² For completeness of the record we enter the March 3, 2016, email into the record as Exhibit 3001, and Mr. Butler’s affidavit as Exhibit 3002.

Ex. 3002, ¶ 6. Patent Owner desires to depose Mr. Butler over his affidavit, alleging that certain statements in the affidavit raise concerns relative to the design patent claim at issue in this proceeding. Petitioner asserts that cross-examination of Mr. Butler over this standard affidavit that has been provided in numerous other IPR proceedings is unnecessary, but does not oppose authorization of the motion.

Although we authorize the parties to submit a joint motion requesting authorization from the Board to seek a subpoena, we point out that the motion must be very specific as to exactly what evidence the parties are seeking, and must show good cause before we will grant such a motion. This is of particular importance because Mr. Butler is an uninterested third-party witness, and a cross examination is a significant inconvenience in time and energy where he has already submitted what appears to be an appropriate attestation to his knowledge and actions with respect to the evidence at issue. Moreover, neither party has asserted that Mr. Butler will be testifying as an expert as to the ultimate substantive issues of anticipation or obviousness in this proceeding.

During the conference Patent Owner's counsel explained that they desired to cross examine Mr. Butler regarding statements in the affidavit pertaining to technical criteria relating to the Internet Archive's "crawlers," and questioned how HTML files, image files and other linked files such as .pdf files, and respective capture dates were discerned by the crawlers.

We point out that there are two aspects of evidence in our proceedings that parties should bear in mind as they consider filing their joint motion, admissibility and weight. The Trial Practice Guide explains that:

A motion to exclude must explain why the evidence is not admissible (e.g., relevance or hearsay) *but may not be used to*

challenge the sufficiency of the evidence to prove a particular fact.

Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48767 (col. 3) (Aug. 14, 2012) (italics added). Patent Owner appears at this point to desire to challenge the admissibility of certain evidence authenticated by Mr. Butler's affidavit by, eventually, filing a motion to exclude Petitioner's exhibits. The reasons stated, however, as to why cross examination of Mr. Butler is necessary, appear to be based on Patent Owner's and Petitioner's respective counsels' concerns with respect to weight of the evidence, i.e. facts relating to whether a linked image or other linked documents allegedly in the evidence was archived on a particular date. A motion to exclude is not a vehicle for addressing the sufficiency or weight to be given evidence. In this regard, a joint motion should clearly explain what aspects of admissibility are expected to be challenged, what specific evidence with respect to admissibility Patent Owner is seeking from Mr. Butler, and why the affidavit itself is not sufficient. The motion should also explain in detail what the specific scope of the cross examination questions will be and how much time the cross examination is expected to take.

As noted above, Mr. Butler is not an expert in this proceeding, and although he may have expertise and knowledge relating to the Wayback Machine, we will not lightly grant a motion for a subpoena for cross-examination of a third party with respect to admissibility where counsel simply concedes that they do not understand how the Wayback Machine works. Therefore, the joint motion should provide a clear explanation as to why Mr. Butler's testimony, as compared to some other expert witness testimony, is necessary. A patent owner should consider, thoughtfully, whether it wants to take on the burden of establishing inadmissibility as

opposed to arguing in an opposition that petitioner has failed to sustain its burden to prove its substantive merits case.

Turning to the issue of scheduling, Patent Owner requests that we order a change in Due Date 1 so that they have time to consider any institution decision that may occur in a second case, IPR 2016–00130, which concerns the same '670 patent. Petitioner opposes this request, asserting that this would provide Patent Owner with almost five months to prepare their opposition and leave Petitioner with less than two months to file a reply thereto.

It is premature to alter the schedule in the present IPR with an aim toward potential synchronization before any decision whether to institute trial is entered in IPR2016-00130. We do not see the need, at this time, to modify the proposed scheduling order. The parties are free to stipulate to changes in due dates 1–6, but we will not step in and modify the schedule at this time. If trial is instituted in IPR2016-00130, we may revisit the possibility of allowing the cases to be consolidated, if it can be shown that such consolidation is promoting the Board's goal of securing the “just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b).

Nothing in this Order should be construed to indicate whether trial shall be instituted in IPR2016-00130.

Accordingly, it is

ORDERED that Petitioner and Patent Owner's request to file a Joint Motion for Authorization to Seek a Subpeona under 37 C.F.R. § 42.52(a) is *granted*;

FURTHER ORDERED that Petitioner's request to revise the Scheduling Order in this proceeding is *denied*;

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