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PATENTS

Not Your Normal Depo: Depositions in Patent Office Litigation



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Depositions are an important tool in contested proceedings before the Patent Trial and Appeal Board. But depositions in *inter partes* reviews and other contested proceedings differ in significant ways from traditional district court depositions. Understanding the idiosyncrasies of depositions in contested proceedings at the PTAB is imperative to maximizing their utility. This article provides four keys for effective and efficient depositions in this unique forum.

No. 1 – Know the Rules. It goes without saying that any practitioner taking or defending a deposition in an IPR or other PTAB contested proceeding should be intimately familiar with the rules. This is particularly important for practitioners who practice primarily before

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the district courts and who may only be admitted *pro hac vice* to practice before the PTAB.

Procedural Rules: Many of the applicable rules for depositions in PTAB contested proceedings can be found at 37 C.F.R. § § 42.51-53. The PTAB's Trial Practice Guide (77 Fed. Reg. 48756-48773) is also a must-read, and provides a succinct overview of deposition practice in these contested proceedings. Important procedural rules include:

- **Notice:** The party seeking to take the deposition must file a notice of the deposition at least ten days in advance of the deposition (37 C.F.R. § 42.53(d)(4));

- **Time limits:** Although parties may stipulate to time limits, the rules provide for a default of seven hours for cross-examination, four hours for re-direct examination, and two hours for re-cross examination (37 C.F.R. § 42.53(c)(2)); and

- **Evidence:** The admissibility of evidence is governed by the Federal Rules of Evidence, with limited modifications (37 C.F.R. § 42.62(a)-(c)).

Objections

Parties defending or taking a deposition should also understand the rules governing objections. Any objection must be made promptly on the record during the deposition, or it is waived. (37 C.F.R. § 42.53(f)(8).) Importantly, "speaking objections" and coaching the witness are strictly prohibited. (77 Fed. Reg. 48772.) Rather, objections should be limited to a single word, for example: "Objection, form" or "Objection, relevance." Notably, however, counsel may instruct a witness not to answer a question if necessary to preserve a privilege. (77 Fed. Reg. 48772.)

If there is a dispute, for example, a privileged is asserted or a defending party believes the scope of cross-examination is consistently exceeding the scope of the declaration testimony, the parties may call the PTAB to resolve the dispute.

Prohibition on Conferring with the Witness

An important distinction from some district court jurisdictions is the prohibition on conferring with a witness being deposed in a PTAB contested proceeding regarding the substance of their testimony given or ex-

pected to be given. (77 Fed. Reg. 48772.) So, unlike some district court jurisdictions that may allow conferring with a witness—usually during a pre-scheduled break, but not between questions—a practitioner at the PTAB may not discuss a witness’s testimony with them during a scheduled break, such as during lunch. Likewise, a practitioner may not coach a witness during a break. Therefore, the party taking the deposition may want to inquire about discussions between practitioners and the witness that occurred during a break, particularly if they think the opposing party may not be familiar with this rule.

Notably, the PTAB’s Trial Practice Guide indicates that the rule applies only during cross-examination. (77 Fed. Reg. 48772 (“Once the *cross-examination of a witness has commenced, and until cross-examination of the witness has concluded*, counsel offering the witness on direct examination shall not: (a) Consult or confer with the witness regarding the substance of the witness’ testimony already given, or anticipated to be given, except for the purpose of conferring on whether to assert a privilege against testifying or on how to comply with a PTAB order; or (b) suggest to the witness the manner in which any questions should be answered.” (emphasis added)).)

At least one PTAB panel agreed that the Trial Practice Guide is unambiguous on this point. (IPR2013-00290, Paper 21, p. 3) According to that panel, the “term ‘cross-examination’ in Guideline 6 refers to actual cross-examination of the witness. Thus, the restrictions identified in the Guideline do not apply during the period of time after cross-examination concludes and prior to commencement of any recross-examination.” Therefore, it may be useful to take the opportunity to discuss with the witness points that will be addressed during re-direct.

However, while it appears that nothing prevents a practitioner from conferring with the witness prior to re-direct examination, proceed with caution. Another panel suggested that it may not be permissible to coach a witness between cross-examination and re-direct, but that any such objection is waived if not raised. (IPR2014-00411, Paper 45, pp. 5, 7-8.)

No. 2 – Not a Fishing Expedition. The goal of a deposition in district court litigation is often to gather as much information as possible from the witness, typically a technical expert. That information may be used later, possibly to impeach the witness while cross-examining them during their direct oral testimony at trial. It may also be used to uncover additional avenues for discovery, which is relatively liberal in the district courts.

But in PTAB contested proceedings such as IPRs, witnesses are rarely permitted to offer live testimony to the PTAB to supplement their written declaration. Also, discovery before the PTAB is extremely limited. Rather, a PTAB contested proceeding deposition amounts to the only opportunity for cross-examination of the witness’s

direct testimony, provided earlier in the form of a written declaration.

And importantly, by rule, the scope of this cross-examination is limited to the content of the direct testimony offered in the witness’s declaration. (37 C.F.R. § 42.53(a).) If the party taking the deposition exceeds this scope, the defending party may, and should, object. One important purpose for this limited scope is to prevent depositions in PTAB contested proceedings from being misused to gain additional information for a pending district court litigation.

No. 3 – You Only Have One Shot, So Use it Wisely. In district court litigation, a deposition witness will likely also take the stand if the case proceeds to trial. In contrast, a witness in a PTAB contested proceeding will almost certainly *not* testify at the oral hearing. Both sides should therefore use the deposition wisely.

For a practitioner taking a deposition, this means having a plan and strategically covering important portions of the witness’s declaration. But it also means considering whether *not* to explore certain topics. For example, it may be beneficial to avoid asking the witness questions about weaknesses in their declaration. This can prevent the witness from supplementing a weak point during the deposition. And because the scope of the re-direct examination is limited only to the scope of the cross-examination, the opposing party will not have the opportunity to rehabilitate the witness on that potentially weak point.

On the other hand, the party defending the witness must use their re-direct examination effectively. Since the witness is unlikely to testify at the oral hearing, the deposition transcript is usually the last opportunity to supplement the record with the witness’s testimony or rehabilitate a witness whose credibility has been attacked. Any ambiguities in the witness’s testimony should also be clarified during re-direct examination.

No. 4 – Keep the Future in Mind. Though it is unlikely that the witness will testify at the oral hearing, a party can effectively place the witness in front of the PTAB by using a well-placed excerpt from the deposition transcript in a demonstrative. This may take the form, for example, of a presentation slide displayed to the PTAB. This can be a powerful tool, particularly if the witness’s testimony in the deposition provided a potent sound bite.

For this reason, it is important to elicit clear testimony from the witness. And it is equally important to reference the quote containing the desired sound bite in a substantive pleading prior to oral hearing, as PTAB panels strictly applying the rules may otherwise bar it from appearing in an oral hearing demonstrative.

Because IPRs and other contested proceedings before the PTAB sometimes become a battle of the experts, having a persuasive or damaging quote from a witness for the panel to view might just tip the case in your favor.