

Post-Grant for Practitioners

Depositions in Post-Grant Proceedings

Dorothy Whelan
*Principal, Post-Grant
Practice Co-Chair*
Twin Cities



Steve Schaefer
Principal
Twin Cities



Agenda

#FishWebinar
@FishPostGrant

- I. Overview of Webinar Series
- II. Statistics
- III. Depositions in Post-Grant Proceedings:
 - A. PTO Testimony Process in General
 - B. Rules of the Game
 - C. Practice Pointers

#FishWebinar
@FishPostGrant

Overview of Webinar Series

FISH.

- Where? ... see invitation
- How often? ... monthly
- When? ... 2nd Wednesday
- Topics? ...
 - Important decisions
 - Developments
 - Practice tips
- Housekeeping
 - CLE
 - Questions
 - Materials
 - <http://fishpostgrant.com/webinars/>



FISH.
FISH & RICHARDSON

**Post-Grant
for Practitioners**

Fishpostgrant.com Bios Alerts Webinars Case Studies App

Depositions in Post-Grant Proceedings

Some call depositions in Patent Office proceedings the ultimate challenge in trial advocacy skill, the blind cross-examination. That is because in many cases there is not a prior fact-finding deposition to hone the questioning to only those questions for which the answer is known and helpful to the case. Indeed, the deposition in a Patent Office proceeding is NOT a fact-finding deposition. It is THE trial cross-examination testimony ... your one and only shot.

Join [Steve Schaefer](#) as he addresses the governing rules for depositions in Patent Office proceedings and takes a closer look at preparation and strategy considerations, from the perspective of both taking depositions and defending them.

[Register](#) now for this Post-Grant for Practitioners webinar.

Wednesday, June 10, 2015
1:00 PM - 2:00 PM ET
Via the web

Speaker:



[Steve Schaefer](#)
schaefer@fr.com
Principal
Twin Cities

REGISTER

#FishWebinar
@FishPostGrant

Statistics

FISH.

Statistics

- **IPR's Filed?**

- **3008** filed through June 4, 2015
- **145** filed in May 2015

- **CBM's Filed?**

- **354** filed through June 4, 2015
- **26** filed in May 2015

- **FWD's on the Merits Issued So Far**

- IPR: **377** through June 4, 2015
- CBM: **50** through June 4 2015

PTO Testimony Process in General

Testimony Process in General

Witness Testimony in PTO Litigation

- Direct testimony:
 - Uncompelled direct testimony (typical situation) – only by affidavit or declaration, to support petition, motion, opposition, reply. 37 CFR §§ 42.53(a), 42.53(b).
 - Compelled direct testimony (rare) – by deposition. 37 CFR §§ 42.53(c)(1), 42.53(d)(3), 42.53(d)(5)(i); *see also* 35 USC § 24 (PTO subpoena rule).
- Cross-examination:
 - By deposition. 37 CFR § 42.53(a).

Testimony Process in General

Witness Testimony in PTO Litigation (continued)

- Re-direct:
 - By deposition. 37 CFR § 42.53(c).
 - Witness proponent may consult with attorney before taking redirect. See *Focal Therapeutics v. Senorex* (IPR2014-00116).
 - Consulting with attorney before redirect may negatively impact witness credibility, assuming that is brought out on the record.
- Re-cross:
 - By deposition. 37 CFR § 42.53(c).

Testimony Process in General

PTO Deposition is not a “Discovery” Deposition

- PTO deposition IS trial testimony, not fact-finding to prepare for witness testimony at trial.
 - It is trial evidence upon which the Board may rely.
 - Subject to evidentiary objections.
- Compare a litigation deposition where it is expected that the witness will testify at trial:
 - Some will become trial testimony; many will not (the witness is strongly expected to be at trial).
 - Deposition conducted under FRCP 26 and 30, broad scope.
 - Use at trial limited. FRE 804 (hearsay exceptions) – e.g., unavailable witness [FRE 804(b)(1)] or statements against interest [FRE 804(b)(3)].

Testimony Process in General

PTO cross exam often is a “blind” cross-exam

- No right to discovery to prepare for cross-examination in PTO proceedings.
 - No PTO analog to FRCP 26 and 30.
 - PTO discovery limited. 37 CFR §§ 42.51, 42.52.
- Rare in Federal District Court patent litigation to conduct cross-examination of an important witness, without having first done a deposition of the witness to reign in what witness can say at trial without being impeached.
- Blind cross exams happen all the time in other types of litigation.

Rules of the Game

Rules of the Game

Uncompelled Witness Testimony

- Direct testimony by affidavit or declaration - Most typically subject matter expert witnesses, but also fact witnesses to support your case (e.g., proving a reference is a prior art publication, witnesses to provide testimony on secondary indicia related to obviousness issue). See 37 CFR § 42.53(a).
 - Analogous to International Trade Commission procedure.
- Deposition starts with cross-examination, and may proceed to redirect and re-cross if the questioning attorneys desire to do so. See 37 CFR § 42.53(c)(2).

Rules of the Game

Compelled Witness Testimony

- Only uncompelled direct testimony is required to be in the form of an affidavit or declaration. 37 CFR § 42.53(a).
- Compelled testimony is rare:
 - Requires motion to Board for authorization. 37 CFR § 42.52(a); *see also* Trial Practice Guide, ¶ F.3.
 - Motion to include description of the general relevance of the testimony. 37 CFR § 42.52(a).
 - Although § 42.52(a) governing compelled testimony does not set forth the type of “interests of justice” standard that is applicable to additional discovery motions (37 CFR § 42.51(b)(2)(i)), you will likely need to explain to the Board the need for the compelled testimony under the additional discovery standards.
- PTO has subpoena power for contested cases. 35 USC § 24 (but 35 USC § 24 out of date in view of amendment to FRCP 45).

Rules of the Game

Scope of Deposition Testimony

- Direct Deposition Testimony (e.g., Compelled)
 - Notice for deposition limits scope of testimony. 37 CFR § 42.53(d)(5)(i).
 - Notice must list all exhibits to be used in the deposition, as well as provide a general description of the scope and nature of the testimony to be elicited. 37 CFR § 42.53(d)(5)(i).
- Cross-Examination Testimony:
 - Limited by scope of direct. 37 CFR § 42.53(d)(5)(ii); FRE 611(b).
 - Also matters affecting credibility of the witness. See FRE 611(b).
 - If larger scope of questioning of the other side's witness is desired, you may theoretically seek Board approval in advance under 37 CFR § 42.53(d)(5), but don't get your hopes up.
- Redirect and Re-Cross: Limited by scope of cross and redirect.

Rules of the Game

Attorney Conduct and Objections

- Testimony Guidelines in Trial Practice Guide, Appendix D.
- Objections:
 - Strictly prohibited: Unnecessary objections, “speaking” objections, and coaching of witnesses. TPG, App. D, Introduction.
 - Concise: “Objection, form”; “Objection, hearsay”; etc. *Id.*, ¶ 3.
 - Improper: “Objection, vague.” *Id.*, ¶ 3.
 - Objections must be made during deposition to preserve motion to exclude, and evidence to cure the objection must also be provided at the deposition unless the parties stipulate otherwise. 37 CFR § 42.64(a).

Rules of the Game

Attorney Conduct and Objections (continued)

- Instructions not to answer: Only to preserve a privilege, enforce Board-ordered limitation, or present a motion to terminate or limit testimony. TPG, App. D, ¶ 4.
- Deposition notice filed to inform Board about timing of deposition, so a Board member is available if needed (but likely not on weekends or evenings). See 37 CFR § 42.53(d)(4).
- Sanctions may be imposed by Board. TPG, App. D, ¶ 8.

Rules of the Game

Deposition Logistics

- When – During testimony period set by Board. 37 CFR § 42.53(b)(1).
 - After deadline to serve supplemental evidence under 37 CFR § 42.64(b)(2) in response to evidentiary objection. 37 CFR § 42.53(b)(2) & (d)(2).
 - More than 1 week before filing date for paper, *id.*, but make sure you've given the Court reporter enough time to prepare the transcript.
 - Coordinate in advance for witnesses who are hard to schedule.
- Notice – File 10 business days prior. 37 CFR § 42.53(d)(4).

Rules of the Game

Deposition Logistics (continued)

- Location – By agreement or Board intervention if parties cannot agree (which I've never had happen), 37 CFR § 42.53(d)(1); typically done at a location convenient for the witness.
- Time limits – Using entire allotted time untypical:
 - 7 hours for cross, 4 hours for redirect, and 2 hours for re-cross.
 - Additional time (theoretically) if testimony relates to multiple post grant matters.

Rules of the Game

Deposition Logistics (Continued)

- Non-US resident witnesses:
 - Deposition “within the United States” except as Board otherwise orders. 37 CFR § 42.53(b)(2).
 - Board has permitted depositions outside the United States by video from the US, when parties agree on procedures.
- Live testimony before the Board:
 - Rare, but may be ordered where Board “considers the demeanor of a witness critical to assessing credibility.” Trial Practice Guide, ¶ F.5.
 - Examples: Cases where derivation is an issue; where misconduct is alleged to have occurred during the proceedings; where testimony is given through an interpreter. *Id.*
 - Permitted inventor “swear-behind” testimony when Petitioner attacked the inventor’s credibility, in *K-40 Electronics LLC v. Escort Inc.*, IPR2013-00203.
 - Denied Petitioner request to present live expert testimony because credibility more tied to scientific reliability than witness demeanor, in *Edmund Optics, Inc. v. Semrock, Inc.*, IPR2014-00599.

Rules of the Game

Deposition Logistics (Continued)

- Expense allocation – Confusing rules, but use common sense:
 - Costs of testimony, including making witness available, borne by “proponent of direct testimony” (offering party). 37 CFR § 42.53(g). Typically includes the hourly rate of the witness and travel costs to get the witness to the deposition. See *also* Trial Practice Guide, ¶ F.1(b).
 - Transcript of testimony must be arranged for and filed by “proponent of testimony” (taking party). 37 CFR § 42.53(f)(7). Typically the taking party pays for the Court reporter, the deposition facility if needed, and the transcript.
- Filing transcript as exhibit with the Board:
 - Filed when corresponding paper filed (opposition, reply, observations).
 - Taking party must file transcript as an exhibit. 37 CFR § 42.53(f)(7).
 - Entire transcript, not snippets, and including redirect.
 - Including all exhibits used in the deposition, including the redirect exhibits.

Practice Pointers and Strategy Considerations

Practice Pointers and Strategy Considerations

Preparation, Preparation, Preparation

- First Commandment of Cross-Exam: **Thou Shalt Prepare.**
 - Timothy A. Pratt, “The Ten Commandments of Cross-Examination.”
- Questioner must intimately know case.
 - Especially important in uncharted territory of the blind cross.
- Practice Pointer for Cross-Examiner: Draft the responsive Paper before the cross-examination.
- Re-Direct Preparation:
 - Fresh eyes to identify likely areas of cross-examination.
 - Prepare re-direct outline, including possible exhibits.
 - Understand limits of “back-filling” gaps in case.

Practice Pointers and Strategy Considerations

Know When To Stop, and When Not to Cross

- Understand what improves your case.
- Downsides of taking the deposition or continuing questioning has its downsides: Letting the other side “back-fill” gaps in its case.
- Practice Pointer: Prepare short list of goals for deposition that improve your case.

#FishWebinar
@FishPostGrant

Post-Grant Resources

FISH.

- F&R web sites:
 - Post-Grant for Practitioners: <http://fishpostgrant.com/webinars/>
 - General: <http://fishpostgrant.com/>
 - IPR: <http://fishpostgrant.com/inter-partes-review/>
 - PGR: <http://fishpostgrant.com/post-grant-review/>
 - Rules governing post-grant: <http://fishpostgrant.com/>
 - Post-Grant App: <http://fishpostgrant.com/app/>
- USPTO sites:
 - AIA Main: http://www.uspto.gov/aia_implementation/index.jsp
 - Inter Partes: http://www.uspto.gov/aia_implementation/bpai.jsp

Thank You!

#FishWebinar
@FishPostGrant

Dorothy Whelan
*Principal, Post-Grant
Practice Co-Chair*
whelan@fr.com
612-337-2509

Steve Schaefer
Principal
schaefer@fr.com
612-337-2508

Please send your NY CLE forms or questions about the webinar to Emma Brown at
ebrown@fr.com

A replay of the webinar will be available for viewing at <http://fishpostgrant.com/webinars/>

© Copyright 2015 Fish & Richardson P.C. These materials may be considered advertising for legal services under the laws and rules of professional conduct of the jurisdictions in which we practice. The material contained in this presentation has been gathered by the lawyers at Fish & Richardson P.C. for informational purposes only, is not intended to be legal advice and does not establish an attorney-client relationship. Legal advice of any nature should be sought from legal counsel. Unsolicited e-mails and information sent to Fish & Richardson P.C. will not be considered confidential and do not create an attorney-client relationship with Fish & Richardson P.C. or any of our attorneys. Furthermore, these communications and materials may be disclosed to others and may not receive a response. If you are not already a client of Fish & Richardson P.C., do not include any confidential information in this message. For more information about Fish & Richardson P.C. and our practices, please visit www.fr.com.