

A Different Ball Game: Depositions at the PTAB and District Court

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A Different Ball Game

- This webinar is about the differences between depositions in PTAB and district court cases.
- The focus will be on the strategic and procedural considerations that PTAB depositions present.

Topics We Will Cover

- Deposition Logistics
- Deposition Mechanics
- The Role of PTAB Depositions
- Strategic Considerations



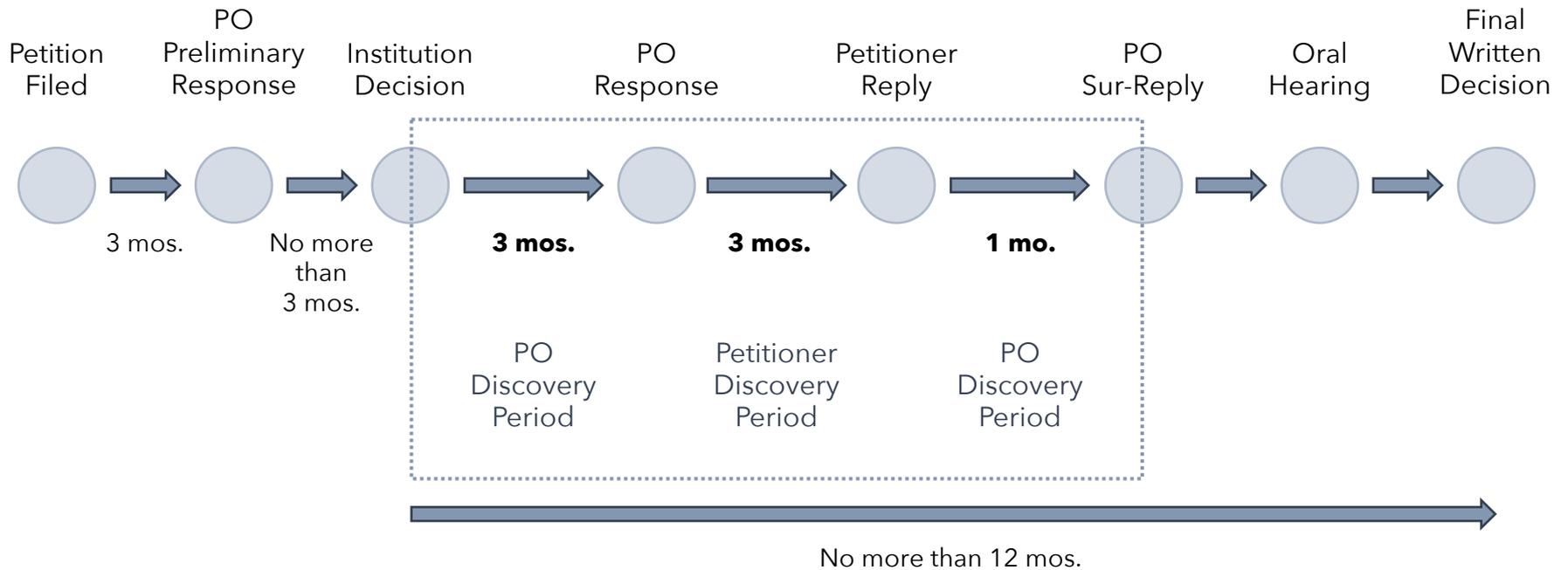
Deposition Logistics

Scheduling the Deposition

- Deposition should be conducted “*more than a week* before the filing date for any paper in which the cross-examination testimony is expected to be used.”
 - 37 C.F.R. § 42.53(d)(2)

- “The party seeking the deposition must file a notice of the deposition *at least ten business days* before a deposition.”
 - 37 C.F.R. § 42.53(d)(4)

IPR Discovery Period



Time Limits

- Unless stipulated by the parties or ordered by the Board, the following time limits apply:
 - 7 hours for cross-examination,
 - 4 hours for redirect examination, and
 - 2 hours for re-cross examination.
- 37 C.F.R. § 42.53(c)(2)

Form of Testimony

- Compelled testimony “must be in the form of a deposition transcript” which “must be filed as an exhibit.”
 - 37 C.F.R. § 42.53(a); 37 C.F.R. § 42.53(f)(7)
- “[1] Parties may agree to video-recorded testimony, [2] but may not submit such testimony without *prior authorization of the Board.*”
 - 37 C.F.R. § 42.53(a)

Form of Testimony (cont'd)

- If parties cannot agree to use video recording, the Board may grant contested requests.
 - *See, e.g., Apple Inc. v. Achates Reference Publ'g, Inc.*, IPR2013-00080, Paper 28 at 6-7 (P.T.A.B. July 2, 2013) (authorizing Patent Owner “to video-record the deposition, as doing so only preserves the opportunity for the Board to review the video if necessary” but noting that “Patent Owner must obtain permission from the Board prior to submitting any portion of the video as an exhibit in these proceedings.”)

Form of Testimony (cont'd)

- The Board has authorized submission of video excerpts of deposition testimony where they “may be helpful in reaching a final determination in [the] proceeding” and where the requesting party argued that they “would be helpful to the panel in assessing [the expert’s] demeanor and his credibility.”
 - *Pacific Market Int’l, LLC v. Ignite USA, LLC*, IPR2014-00561, Paper 27 at 2-3 (P.T.A.B. Feb. 5, 2015)



Deposition Mechanics



Scope of Examination

- “For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.”
 - 37 C.F.R. § 42.53(d)(5)(ii)

Objections

- “Any objection to the content, form, or manner of taking the deposition ... is waived unless made on the record during the deposition and preserved in a timely filed motion to exclude.”
 - 37 C.F.R. § 42.53(f)(8)

Objections (cont'd)

- “unnecessary objections, ‘speaking’ objections, and coaching of witnesses ... are strictly prohibited.”
 - PTAB Consol. Trial Practice Guide, Nov. 2019
- “Objections should be limited to a *single word or term.*”
 - *Id.*
- Counsel may instruct a witness not to answer when necessary to preserve a privilege

- *Id.*

Objections (cont'd)

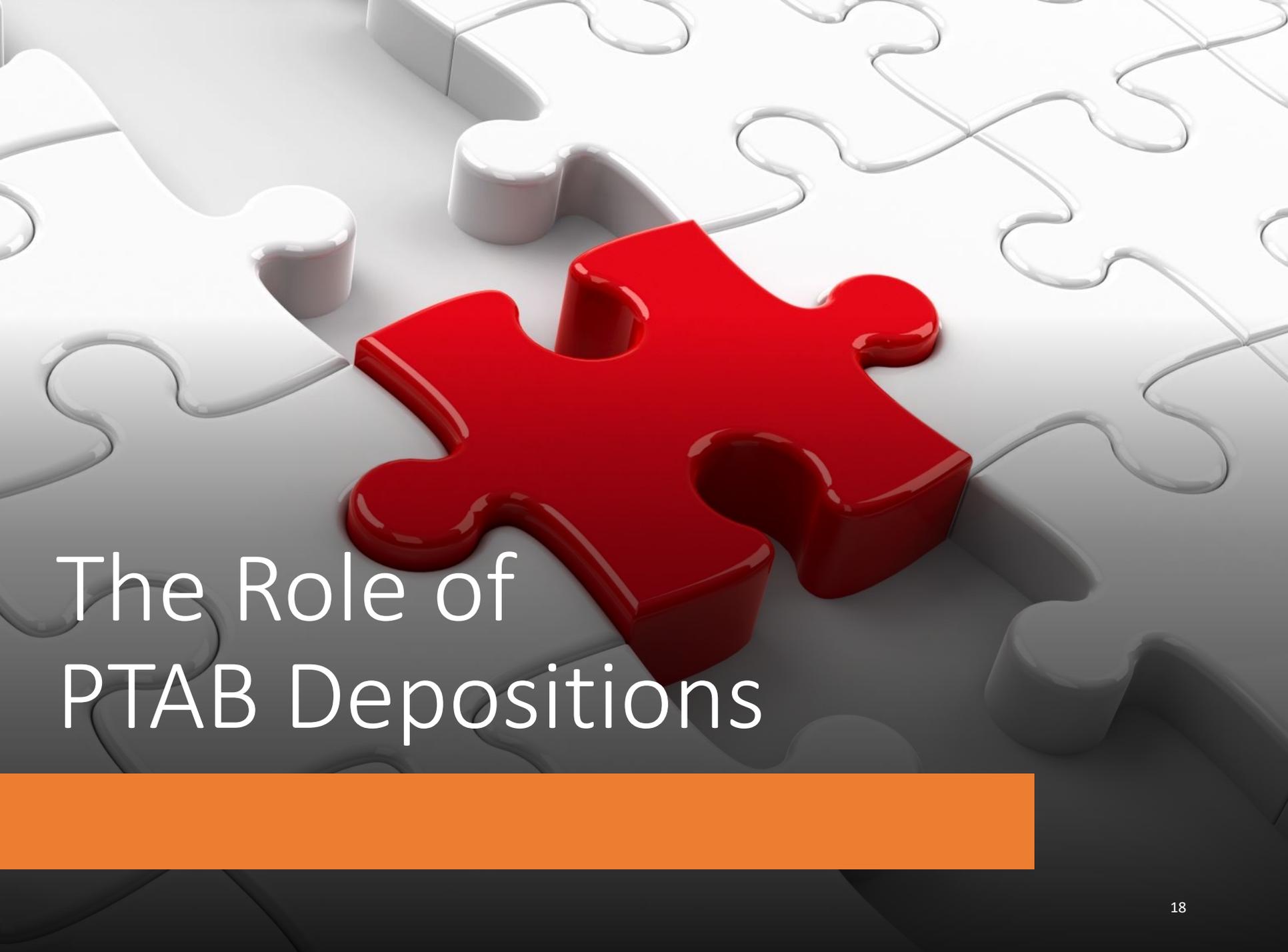
- If there is a dispute during the deposition, telephonic Board intervention is available
 - *E.g.*, a privileged is asserted, or a defending party believes the scope of cross-examination is consistently exceeding the scope of the declaration testimony

Coaching Witness Prohibited

- During *cross-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 Board order;
 - or (b) suggest to the witness the manner in which any questions should be answered.”
- PTAB Consol. Trial Practice Guide, Nov. 2019

Coaching Witness Prohibited (cont'd)

- “The prohibition of conferring with the witness ends once cross-examination concludes, and, if relevant, begins again when re-cross commences, and continues until re-cross concludes. The prohibition does not exist, however, during the time frame between conclusion of cross-examination and start of re-cross. ... [C]ounsel is ‘permitted to confer with the witness before redirect examination begins.’”
 - *Focal Therapeutics, Inc. v. Senorx, Inc.*, IPR2014-00116, Paper 19 at 2 (P.T.A.B. July 21, 2014) (precedential)

A 3D rendering of a puzzle with one red piece standing out among many white pieces. The red piece is in the center, and the white pieces are arranged around it, some of which are missing, creating a sense of a puzzle being solved or a key piece being highlighted. The lighting is soft, creating shadows and highlights on the pieces.

The Role of PTAB Depositions

Depositions Are Testimony

- Depositions in IPRs are testimony.
- Typically, deposing an opposing party's expert is the only form of discovery a party receives.
- Live testimony is very rare.

Live Testimony

- *K-40 Elecs., LLC v. Escort, Inc.*, IPR2013-00203, Paper 34 (P.T.A.B. May 21, 2014) (precedential) (granting Patent Owner's motion to present live testimony from named inventor)
 - Inventor's declaration testimony was relied upon to antedate the asserted prior art references
 - Factors to be considered for permitting live testimony include: (1) "the importance of the witness's testimony to the case" and (2) whether the witness is a fact witness or an expert

A photograph of a chessboard on a wooden table. The board is partially open, showing the chess pieces. The pieces are arranged in their starting positions. The board is illuminated by a bright light source from the right, creating a strong shadow and highlighting the texture of the wood and the pieces. The text "Strategic Considerations" is overlaid on the left side of the image.

Strategic Considerations

Strategic Considerations

1. Leave Open the Gaps

2. Sound Bites

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