



PTAB Designates as Precedential 2014 Decision Governing Communications with Counsel During Deposition

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On July 10, 2019, the Patent Trial and Appeal Board designated as precedential *Focal Therapeutics, Inc. v. Senorx, Inc.*, IPR2014-00116, Paper 19 (PTAB, July 21, 2014), which concerned the rules governing depositions in the context of an *inter partes* review proceeding. In *Focal*, the Board addressed whether counsel may confer with a deponent after cross-examination concludes but before redirect begins. The Board's Testimony Guidelines prohibit conferring with the witness only "[o]nce cross examination of a witness has commenced, and until cross-examination of the witness has concluded." *Office Patent Trial Practice Guide*, Appendix D, 77 Fed. Reg. 48772-48773 (Aug. 14, 2012).

The Board's decision to permit counsel and witness to confer during deposition diverges from the practice in many federal courts.

Specifically, under Rule 30(c) of the Federal Rules of Civil Procedure, "examination and cross-examination of a deponent [should] proceed as they would at trial under the Federal Rules of Evidence." Courts have interpreted Rule 30(c) to prohibit counsel from conferring with the witness after deposition begins. See *Hall v. Clifton Precision*, 150 F.R.D. 525, 528 (E.D. Pa. 1993) ("During a civil trial, a witness and his or her lawyer are not permitted to confer at their pleasure during the witness's testimony. Once a witness has been prepared and has taken the stand, that witness is on his or her own. The same is true at a deposition."); see also *Chassen v. Fidelity Nat. Title Ins. Co.*, No. 09-291 (ES), 2010 WL 5865977 (D.N.J. July 21, 2010) (noting that "*Hall* is not universally followed in all jurisdictions," but agreeing with *Hall* and prohibiting counsel from conferring with witnesses "except for the purpose of deciding whether to assert a privilege").

Focal also provides an additional data point demonstrating the Board's interest in designating as precedential older decisions that clarify procedural and evidentiary issues often confronted by practitioners in *inter partes* review proceedings. See, e.g., *K-40 Elecs., LLC v. Escort, Inc.*, IPR2013-00203, Paper 34 (PTAB May 21, 2014) (designated: Mar. 18, 2019) (granting motion to present live testimony to enable assessment of credibility); *DePuy Synthes Prods., Inc. v. Medidea, L.L.C.*, IPR2018-00315, Paper 29 (PTAB Jan. 23, 2019) (designated: Mar. 18, 2019) (denying request for live testimony

as impermissible new evidence where would-be witness never provided declaration evidence).

With precedential decisions like *Focal*, we gain greater insight into the evolving and idiosyncratic nature of PTAB practice and AIA proceedings. For additional information regarding AIA procedures, including IPRs, PGRs, and CBMs, and *ex parte* reexamination procedures please contact Clinton H. Brannon or Janet M. Smith.

Related People

- Clinton H. "Clint" Brannon – 703.760.5226 – cbrannon@williamsmullen.com
- Janet M. Smith – 804.420.6212 – jmsmith@williamsmullen.com

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