Who You Gonna Call? The Board!

By H. Wayne Porter

February 23, 2015 — The PTAB issued an order providing guidance for responding to potential witness coaching during a deposition recess.

Cases IPR2014-00411 and IPR2014-00434 – FLIR Systems, Inc. v. Leak Surveys, Inc.

In an *inter partes review* (IPR), a party normally submits direct testimonial evidence in the form of a declaration or affidavit. The opposing party is then permitted to cross-examine the declarant in a deposition. The PTAB takes a dim view of attempts to coach a witness. As set forth in Appendix D to the Office Patent Trial Practice Guide,[i] "unnecessary objections, 'speaking' objections, and coaching of witnesses in proceedings before the Board are strictly prohibited." The guide further includes the following:

> 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 Board order; or (b) suggest to the witness the manner in which any questions should be answered.[ii]

In a February 10, 2015, order entered in a pair of IPRs, the PTAB addressed an asserted instance of witness coaching. In those IPRs, the authenticity of two prior art references is at issue. The petitioner submitted a declaration by a witness to support the authenticity of those references,

and the witness was then deposed. During cross-examination, there was "unexpected testimony." At the conclusion of cross-examination, a recess was taken, and counsel for the petitioner held an off-the-record discussion with the witness. On redirect, and according to the opposing party, the patent owner, the witness made an attempt to overcome and possibly explain away the unexpected testimony. When the patent owner's counsel sought further testimony regarding the nature of conversations during the recess, the petitioner's counsel asserted privilege and would not permit the witness to answer.[iii]

This deposition became the subject of two conference calls with the Board. In the first call, the patent owner raised the issue of possible witness coaching and suggested that sanctions were appropriate. In the second call, the petitioner sought leave to file "supplemental information" in the form of a further declaration by the witness in question.

The PTAB indicated that the patent owner could file a motion to exclude the deposition testimony and, if that motion failed, argue the weight that should be given that testimony. The PTAB declined to allow a motion for sanctions and found that the patent owner could obtain complete relief, if it is successful, in excluding the references or convincing the PTAB that no weight should be given. The PTAB also declined to allow the petitioner's request for leave to file a motion to rely on supplemental information.

The Order acknowledged the problems associated with off-the-record discussions between counsel for a party and a witness testifying for that party. If there are recess conversations, a party risks the PTAB excluding or giving no weight to testimony of a coached witness. The Order then offered the following guidance and caution:

> If a recess is requested and a party believes a recess is not appropriate, a conference call may be placed to the Board for a determination of whether a recess should occur and, if a recess is authorized, the conditions under which the recess is to occur.
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> In our view, any possibility of developing further information or evidence relating to what occurred during Petitioner's off-the-record recess conference with the deponent was waived when the Patent Owner did not seek the assistance of the Board when Petitioner declined to permit its witness to answer Patent Owner's questions during the deposition.

Curiously, the transcript of the deposition in question suggests that the patent owner attempted to call the PTAB during the deposition.[iv] It is not clear from the transcript why the call was not successful. In any event, the take-away from the Order is clear. If a lawyer believes that opposing counsel is coaching a witness, get the PTAB on the phone during the deposition.

The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office's Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer weekly summaries of the board's significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.

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[i] 77 Fed. Reg. 48756, 48772 (Aug. 14, 2012).

[ii] *Id*.

[iii] Although the PTAB Order states that "[a]ttempts to obtain further testimony by Petitioner on the nature of any conversations taking place during the recess were not allowed by Patent Owner, principally on privilege grounds," this appears to be a typographic error of reversing the roles of the parties. The deposition transcript indicates that the counsel for the patent owner inquired about the nature of the recess conversation, and that counsel for the petitioner asserted privilege. See Exhibit 2044 to IPR2014-00411, at pages 74-75.

[iv] *Id*. at page 76.