THERE ARE LIMITS TO HOW TRICKY ONE'S QUESTIONING CAN BE[1]

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What Happened In Genetech v. Chiron

We all like to ask "tricky" questions. However, Genentech v. Chiron, 75 USPQ2d 1881 (PTOBPAI 2004) (non-precedential) (opinion by APJ Tierney for a panel that also consisted of APJs Lane and Medley), makes it clear that there are limits on how tricky one can get--at least without advance approval from the responsible APJ.

Genentech's outside counsel thought that one of Chiron's expert witnesses was so biased that she would say anything to support Chiron's positions. So, he manufactured what appeared to be an excerpt from a Genentech laboratory notebook, made it a cross-examination exhibit, and asked her questions about it designed to prove her mendacity. After the deposition, Chiron's counsel became suspicious about the authenticity of the exhibit and asked Genentech's outside counsel to produce the entire laboratory notebook from which the excerpt was allegedly taken. Genentech's outside counsel responded evasively. However, Chiron's counsel was eventually able to prove that the exhibit was fabricated. At that point, Chiron's counsel contacted the APJ. During a transcribed conference call, Genentech's outside counsel admitted what he had done but sought to explain it as a "ruse" to demonstrate the witness's bias.

The APJs didn't buy Genentech's outside counsel's explanation. To begin with, they pointed out that there were many other, conventional ways to attempt to demonstrate bias. Interestingly, however, they did not indicate that the use of a fabricated document was per se objectionable--so long as counsel obtained advance authorization from the responsible APJ to engage in the ruse:

> Genentech's creation and use of the non-authentic lab notebook was conducted without the prior consultation and authorization of an Administrative Patent Judge. That Genentech chose to

manufacture "definitive" lab notebook data on a disputed, material question of fact in this interference highlights Genentech's need to provide the Board with notice of its intent to mislead …[Chiron's expert witness] with manufactured documentation.[4]

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Genentech did not provide contemporaneous notification of the creation and use of the manufactured evidence to either the Board or Chiron. There can be no doubt that Genentech's counsel had the right to expose what he believed to be …[Chiron's expert witness] lack of credibility[,] but this right is not unlimited. Genentech must question …[her] credibility by fair and just means, free from falsehood and misrepresentation. Genentech's conduct in creating and using manufactured evidence and its failure to provide contemporaneous, or even prompt, notification of its ruse undermines the fairness of the proceeding and imposed unwarranted burdens upon Chiron. After the ruse was discovered by Chiron, Genentech acknowledged the ruse and argued to the Board and Chiron that its true intent was to demonstrate bias of a witness. Even assuming that this was Genentech's sole intent, based upon the evidence of record, we conclude that Genentech's creation and use of the manufactured GX 2195 evidence was

[4] 75 USPQ2d at 1890.

inappropriate.[5]

Moreover, Genentech's outside counsel engaged in a still more blatant subterfuge. At one point, Chiron's expert witness, who had apparently become suspicious, asked a question concerning the manufactured evidence. Instead of confessing the ruse, Genentech's outside counsel stated, "Oh. Doctor, I assume so but my testimony – my statements are not testimony to you. It is what it is."[6]

Genentech's inside counsel denied all knowledge of what Genentech's outside counsel had done -- and, somewhat surprisingly, Genentech's outside counsel corroborated that assertion.[7] The panel, however, held that "The record can support a finding that… Genentech's in-house personnel had actual knowledge that GX 2195 was not what it purports to be."[8]

The panel "exercise[d]…[its] discretion…[to] allow…[the] interference to continue with the issue of appropriate sanctions being determined at a later date,"[9] and it sent a copy of its opinion to the Office of Enrollment and Discipline[10] -- with at least an implied suggestion that action be taken against both Genentech's outside counsel and its inside counsel:

> Whether or not… [Genentech's outside counsel's] actions and those of Genentech's in-house counsel requires a disciplinary investigation under 37 C.F.R. § 10.131 regarding the alleged

[5] 75 USPQ2d at 1892.

[6] 75 USPQ2d at 1885.

[7] 75 USPQ2d at 1887.

[8] 75 USPQ2d at 1888.

[9] 75 USPQ2d at 1892.

[10] 75 USPQ2d at 1889 n.6.

violations of the Disciplinary Rules is a question for the Office of Enrollment and Discipline ("OED").[11]

Comments

As noted by the panel, there are various methods available to impeach the credibility of a witness, including 1) providing evidence contradicting the witness's testimony; 2) demonstrating prior inconsistent statements of the witness; 3) demonstrating that the witness's capacity to perceive may be impaired; 4) attacking a witness's character for truthfulness; and 5) showing that the witness is biased -- i.e., that the witness has a reason to slant his or her testimony.[12] Nevertheless, Genentech argued that the "misleading exhibit was the only way to expose [the expert's] bias."[13]

We are not persuaded. Moreover, even if this was really the only way in which Genentech could have impeached Chiron's expert witness's credibility, an attorney still must be mindful of the Code of Professional Responsibility -- which, in our case, are codified at 37 CFR Chapter 10. Sometimes there is simply no way to get there from here!

37 CFR 10.85, entitled "Representing a client within the bounds of the law," provides that:

a practitioner shall not:

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(4) Knowingly use perjured testimony or false evidence.

(5) Knowingly make a false statement of law or fact.

[11] 75 USPQ2d at 1889 n. 6.

[12] 75 USPQ2d at 1889.

[13] 75 USPQ2d at 1890; emphasis supplied.

(6) Participate in the creation or preservation of evidence when the practitioner knows or it is obvious that the evidence is false.

Rule 3.3 of the Model Rules of Professional Conduct is similar and governs the lawyer's ethical duties when he makes representations of fact or law to a tribunal. Rule 3.3(a) provides in pertinent part that:

A lawyer shall not knowingly:

(1) make a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the lawyer;

. . . .

(3) offer evidence that the lawyer knows to be false.

Courts have found that Model Rule 3.3(a) (and state disciplinary rules which are similar) apply to attempts by attorneys to engage in a "ruse" with unsuspecting witnesses.

For instance, in Cincinnati Bar Assn. v. Statzer, 800 N.E.2d 1117 (Ohio St.3d 2003), the lawyer taking a deposition waved around "suggestively" labeled tapes implying that the tapes contained conversations between the deponent and the lawyer. The tapes were, in fact, blank and were used by the attorney to suggest that she had recorded conversations with the witness that could impeach the witness's credibility and cause embarrassment. The attorney also intermittently cautioned the witness to answer truthfully or risk perjuring herself.

The attorney in Statzer argued that "wide latitude was imperative during that proceeding to draw honest testimony from a theretofore untrustworthy witness and that use of the audio cassette tapes was merely a tactic to achieve this legitimate end."[14] The court recognized that the pursuit of information cannot be overly restrictive if it is to remain effective, but it drew the line

[14] 800 N.E.2d at 1122.

at "an attorney['s] engag[ing] in [a] subterfuge that intimidates a witness."[15] The court found that this "bluff" was deceptive and a violation of the applicable ethical rule. The lawyer was suspended for six months, although the suspension was stayed.

Engaging in subterfuge with a fact witness is one thing, but shouldn't experts in high-stakes patent litigation be prepared to handle some "tricky" questioning? Presumably the attorney questioning an expert should be given wider latitude to pursue information than an attorney questioning a fact witness, as the chances of "intimidating" an expert witness are much less.

The panel in Genentech indicated that Genentech's counsel should have sought permission to engage in his "ruse" prior to the deposition. Other tribunals, primarily in criminal cases, have similarly suggested that obtaining advance approval from the court prior to engaging in a ruse is necessary in order to avoid findings of ethical misconduct. For instance, lawyers have sought to conduct their own in-court lineup by having someone who is not their client sit at counsel table and pretend to be the accused. Some courts have held lawyers in contempt for that tactic without first getting the court's permission. See, e.g. People v. Simac, 641 N.E.2d 416 (Ill.2d 1994) (convicting defense counsel of contempt for substituting a similar-looking individual for defendant at counsel's table without notifying the court and noting that it would not violate any principles of professional responsibility if it required the defense counsel to notify the court before substituting an individual for defendant at counsel's table), and see also United States v. Thoreen, 653 F.2d 1332, 1342 n.7 (9th Cir. 1981) (suggesting that counsel could first seek the court's permission to have more than one person seated at counsel table without

[15] Id.

identifying which one is the witness, or have no one seated at counsel's table except counsel, or have an in-court line-up).

Of course, in criminal cases, the judge presumably would not alert the jury to the ruse. In the civil context, however, and more particularly in a deposition, obtaining advance authorization from the responsible APJ to employ an unusually tricky "ruse" will require that opposing counsel be in on the conference call. So, what should you do if you don't trust opposing counsel not to alert the target witness to the impending ruse?

One colleague suggested that a solution to this problem would be to ask the witness to leave the room and then disclose on the record what one was about to do. At that point, opposing counsel could (and probably would) insist on a conference call with the APJ, but he or she would not be able to talk privately to the witness before the ruse was employed, assuming the APJ agreed to allow the ruse to proceed.

Conclusion

As we said at the outset, we all like to ask "tricky" questions. However, there is a limit -- for the good of the system and the preservation of our licenses to practice law!