Guidelines? What Guidelines?[1]

By Charles L. Gholz[2]

Introduction

There is an appendix to the Standing Order entitled "Cross Examination Guidelines." Pilgrim, be not misled. These are not "guidelines.' These are rules! SAPJ McKelvey's recent precedential opinion for an expanded panel comprised of the SAPJ, CAPJ Fleming, and APJs Schafer, Hanlon, Lane, and Tierney in Pevarello v. Lan, Int. No. 105,394, make that thunderingly clear.

What Pevarello v. Lan Says

The opinion starts with a "Historical perspective" which ends with the following absolutely accurate paragraph:

> Pre-1998 experience with depositions transcripts involving both direct testimony or [sic; and] cross-examination showed that often considerable discussion about the objection took place. The objections and discussions made it very difficult to consider a deposition transcript on its merits. Often by the time one sifted through the objections and associated discussions one lost track of what question was asked. Additionally, there is little doubt from our point of view that through the objection and subsequent discussion process, "witness

[2] Partner in and head of the Interference Section of Oblon, Spivak, McClelland, Maier & Neustadt. My direct dial telephone number is 703/412-6485, and my email address is CGHOLZ@OBLON.COM.

coaching" was alive and well in pre-1998 interferences.[3]

The opinion then proceeds to criticize counsel for both parties for their failure to follow the "guidelines":

> It may be that counsel in this case felt that the stipulation was necessary to avoid even an appearance of witness coaching. However, Guidelines [3] expressly requires that a legal basis be stated. Any legal basis for an objection must be based on the rules governing admissibility of evidence for contested patent cases, including the Federal Rules of Evidence. 37 CFR §§ 41.151-41.153 (2006).[4]
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> During the depositions, "blanket" objections stating no basis for the objections were made to questions by the questioning lawyer. Motions to exclude based on blanket objections will not be considered because blanket objections during a deposition fail to comply with Guideline [3].[5]
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> During the course of the depositions, improper objections and associated discussions occurred.[6]
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> There can be no objection under the contested cases rules of the Federal Rule of Evidence that a question is ambiguous, not clear or vague.[7]
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> Here we have three examples of a first error

[3] SO at 4.

[4] SO at 6; emphasis added.

[5] SO at 7.

[6] SO at 8.

[7] SO at 10.

compounded by a second error re-compounded by a third error. *First*, there should not have been a blanket objection; rather a legal basis must accompany an objection. *Second*, consistent with the stipulation (as discussed earlier, the stipulation itself is yet another error)[,] counsel for Lan should not have asked counsel for Pevarello the basis for the objection. *Third*, as pointed out earlier, what is ambiguous to counsel for Pevarello is irrelevant--the witness must state that the witness is confused. All the discussion by counsel for Pevarello as to why the question are supposedly ambiguous was unnecessary and contrary to the Guidelines.[8]

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[T]he remarks by counsel for Pevarello that the witness does not have to change his declaration "just to suit you" is not appropriate. Apart from being a violation of the Guidelines, it crossed the line of the decorum rule. 37 CFR § 41.1(c) (2006). The contest is *Pevarello v. Lan,* not *Counsel for Pevarello v. Counsel for Lan*. The whole discussion was a side show apart from the main event--the main and possibly the only event being an opportunity for counsel for Lan to have a discussion with the witness.[9]

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When a defending lawyer attempts to clarify what the witness said, the defending lawyer has determined that the Board's Guidelines do not apply. The lawyer takes over control of the cases from the Board. However, it is the Board which controls proceeding before it--not the parties or their lawyers. We cannot efficiently administer a case management process whereby our rules and established procedures, such as the Guidelines, are jettisoned to serve some interest of a lawyer.[10]

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The objection is highly inappropriate. "I'm going to

[8] SO at 12.

[9] SO at 14.

[10] SO at 14-15.

> object because there's no question pending" translated into plain English means "Do not say anything more." If ever there was an example of an improper coaching, this is it. There was a question pending and apparently the witness was not done answering the question when counsel, in effect, told the witness to "Shut up!" It is perfectly appropriate *prior to* a deposition to prepare a witness and to remind the witness "Answer just the question which is asked and do not volunteer." Once the deposition starts, the defending lawyer can no longer "prepare" the witness for the deposition.[11]
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> Apart from Guideline violations by both counsel, we question why an objection was needed. The question seems perfectly clear to us.[12]

Comments

The SO's "guidelines" are highly idiosyncratic. Lawyers accustomed to practicing in other venues sometimes find them burdensome--or just plain silly. However, they are what they are--and what they are is not "guidelines" but rules. We who practice before the board must obey--or risk public flagellation.[13]

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[11] SO at 15.

[12] SO at 17; emphasis added.

[13] I have suggested elsewhere that there may be a way around the guidelines for counsel who find them unduly onerous. See Gholz, How Should We Deal With § 16.3 of the Trial Section's Standing Order?, 11 Intellectual Property Today No. 9 at page 8 (2004). So far I have not been chastised for employing that technique, and I am not aware that anyone else has been either. However, as a matter of prudence, I am employing that technique less and less these days.