

Additional Discovery Prior To Cross-Examination¹

By Charles L. Gholz²

INTRODUCTION

37 CFR 41.150(c)(2) reads as follows:

When appropriate, a party may obtain production of documents and things during cross examination of an opponent's witness or during testimony authorized under § 41.156.

I have previously criticized the limitation of 37 CFR 41.150(c)(2) to obtaining production of documents and things “during cross examination of an opponent's witness or during testimony authorized under § 41.156.”³ See Gholz, What's the Use of 37 CFR 41.150(c)(2)?, 12

Intellectual Property Today No. 1 at page 14 (2005). That article complains that:

There are at least four problems with 37 CFR 41.150(c)(2). First, what does “[w]hen appropriate” mean? Second, opposing counsel virtually never has the “documents and things” that I want available “during cross examination,” which means that, even if opposing counsel does produce the “documents and things” at some subsequent time, the deposition may have to be re-scheduled in order to ask the witness questions about them—which may require lengthy and expensive travel by one or both of the parties. Third, in the unlikely event that opposing counsel does produce the “documents and things” “during cross examination,” the best of us can't ask good questions about “documents and things” that he or she has just been handed. And, fourth, a fair percentage of the “documents” that you may actually get handed “during cross examination” will be in a language that you can't read—and opposing counsel may blandly assure you that he or she doesn't have a translation of the document into English.⁴

It concludes that, “For all the reasons that led to the adoption of effective discovery mechanisms in our state and Federal courts, the PTO should authorize effective discovery mechanisms in interferences”⁵—including obtaining what the PTO quaintly calls “additional discovery”⁶ prior to cross-examination.

Unfortunately, the PTO has not seen fit to adopt what I called “effective discovery

mechanisms” in this regard--or in many other regards. Accordingly, interferences (and the members of the Board of Patent Appeals and Interferences) have been put to adopting unwieldy work-arounds.

WHAT EIC R. H. SMITH DID IN RIVIER V. COY

In Rivier v. Coy, 12 USPQ2d 1231 (PTO BPAI 1989)(opinion by EIC R. H. Smith, not joined by any other examiner-in-chief), EIC R. H. Smith forthrightly pretty much ignored the language of 37 CFR 1.687(b), which was the predecessor of 37 CFR 41.150(c)(2) and which contained identical language insofar as is relevant here.

Prior to the depositions of Rivier’s witnesses, Coy had moved for production of various documents in Rivier’s possession for use during those depositions. Rivier opposed production on various grounds, including “that the discovery motion is premature because Coy has not yet cross-examined the Rivier rebuttal witnesses and has not requested the documents during cross-examination as set forth in §1.687(b).”⁷ EIC Smith granted Coy’s motion, reasoning as follows:

The undersigned EIC agrees with Coy that additional discovery is appropriate at this time. * * * Rivier’s indication that the appropriate documents will be provided at the cross-examination of the witnesses acknowledged that Coy is entitled to certain additional discovery. However, the undersigned sees no reason to defer the discovery until the time of the cross-examination. * * * [T]o delay the provision of appropriate discovery would ignore the purpose of discovery, i.e., inter alia, to reach the truth as economically and efficiently as possible, and, as noted by Coy, could result in a further delay in the proceeding. Accordingly, the discovery ordered herein is required to be produced for inspection and copying^[8] at least ten days prior to the depositions as requested by Coy.⁹

WHAT JUDGE LEE DID IN GINTER V. BENSON

Regrettably, Judge Lee's opinion in Ginter v. Benson, Interference No. 105,193¹⁰ was not published. However, it also dealt with this issue—and it is citable as non-precedential, but (I hope) highly persuasive authority:

Benson's counsel then raised the matter of document requests which are permitted at the time of cross-examination, e.g., how it is essentially useless because the requested documents will not be at the location of the cross-examination. After a lengthy discussion, particularly addressing counsel for Ginter's concern that the document requests will be overly broad, the APJ ordered as follows:

1. That[,] no later than five days prior to any cross-examination, the party conducting the cross-examination shall specifically identify all documents whose use at the cross-examination can be reasonably expected in a list and forward the list, either by facsimile or e-mail[,] to the opposing counsel as a request for such documents.
2. That[,] unless the opposing counsel objects to production of the requested documents, they be physically placed in the requesting counsel's possession no later than two days [not two business days] prior to the scheduled cross-examination (providing means enabling opposing counsel to have physical possession).
3. That the identification of the documents must be as specific as possible[,] and[,] if a request is written in open-ended form such that it takes [sic; requires?] the recipient of the request to figure out what the specific documents are, that alone is sufficient ground for the recipient party to ignore the request (if that happens, being more specific at the time of cross-examination will not help).
4. That[,] if a dispute arises as to whether the requested documents should be produced, the APJ is available to resolve the dispute by conference call. Counsel for the parties have the APJ's office phone number and cellular phone number.¹¹

COMMENT

This is a recurrent problem. Nothing that I wrote in my 2005 article criticizing 37 CFR 41.150(c)(2) has changed. If amending 37 CFR 41.150(c)(2) is too much trouble, couldn't Their Honors put something in the supposedly forthcoming revision of the Standing Order based on EIC Smith's opinion in Rivier v. Coy and Judge Lee's opinion in Ginter v. Benson?

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³ 37 CFR 41.156 deals with testimony of a witness not under the control of the adverse interferent's real-party-in-interest, which testimony, if not voluntary, must be compelled pursuant to 35 USC 24.

⁴ 12 Intellectual Property Today No. 1 (2005) at page 14.

⁵ 12 Intellectual Property Today No. 1 (2005) at page 15.

⁶ The reason that I use the pejorative term "quaintly" is that what 37 CFR 41.150(b) calls "*Automatic discovery*" is not discovery in any meaningful sense of that word. 37 CFR 41.150(b) only gives you a pre-cross-examination look at what your opponent wants the APJs to see. Real discovery lets you look at what your opponent hopes that the APJs will never see. Real discovery can only be obtained under 37 CFR 41.150(c)(2).

⁷ 12 USPQ2d at 1232.

⁸ I haven't seen an order requiring that documents be produced "for inspection and copying" for years. Rather, parties are now simply required to serve the documents in question on the

opposing counsel.

⁹ 12 USPQ2d at 1232.

¹⁰ My colleagues Michael Casey, Todd Baker, Kurt Berger, and I represented Benson. Linda Thayer, Megan Sugiyama, Jerry Voight, and Ross Franks of Finnegan, Henderson's Palo Alto office represented Ginter.

¹¹ Judge Lee is the only APJ that I have run into who gives counsel his cell phone number and authorizes them to use it to contact him to resolve disputes when he is not in his office. Kudos to him!