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The authors ask the PTAB to amend the deposition rules for AIA proceedings to track the deposition rules for interferences.

There's One Way That AIA Proceedings Are Very, Very Different Than the First Phase of Patent Interferences



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Ten years ago the senior author of this article wrote an article about what was then under consideration by Congress and which ultimately became the America Invents Act (AIA) that contained the following

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The views expressed herein are those of the authors and are not necessarily shared by their employer or its clients.

prediction (under the heading, *How Will the PTO Implement the Patent Cancellation Procedure?*):

As far as the PTO is concerned, its decisions have been made. The proposed patent cancellation proceedings, if authorized by Congress, will be "Contested Cases" within the meaning of Subpart D of Part 41, "Practice Before the Board of Patent Appeals and Interferences," of Title 37 of the Code of Federal Regulations. They will be administered by an administrative patent judge ("APJ") pursuant to 37 CFR 41.104. Counsel will be registered patent practitioners unless a non-registered patent practitioner is given leave "to appear as counsel [pro hac vice] in a specific proceeding" pursuant to 37 CFR 41.5(a). The entire procedure will be very, very similar to the procedure that the BPAI has long followed during the preliminary motions phase of interferences. [Id. at page 7; footnote omitted.]

Well, Congress didn't call the AIA proceedings "cancellation proceedings." Instead it created four different types of proceedings, called inter partes review (35 U.S.C. § 311 et seq.), post-grant review (35 U.S.C. § 321 et seq.), covered business method (Section 18 of the America Invents Act) and derivation proceedings (35 U.S.C. § 135), respectively. Moreover, the PTO decided not to treat them as "Contested Cases" under Part 41 of Title 37, but instead to generate "umbrella rules" under Subpart A, Part 42 of Title 37 governing trial practice and procedure and separate procedures for each of the four new AIA proceedings under Subparts B-E, Part 42 of Title 37. However, when all was said and done, the last sentence of that prediction remained very, very accurate.

With one exception. That exception is that the newly named Patent Trial and Appeal Board replaced what has become known to the interference bar as the "McKelvey Deposition Rules" (published as an appendix to the board's Standing Order entitled "Cross Examina-

tion Guidelines”) with “Testimony Guidelines” (published in the Office’s Patent Trial Practice Guide, Federal Register, Vol. 77, No. 157).

In another article published 10 years ago, the senior author of this article wrote the following concerning the McKelvey Deposition Rules:

The . . . [Standing Order’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.

The Testimony Guidelines are similar to the McKelvey Deposition Rules in most respects, but differ from the McKelvey Deposition Rules in one significant manner. The McKelvey Deposition Rules specify that “Counsel must not make objections to statements that even remotely suggest an answer to a witness,” and provided examples of comments which would be viewed as suggesting an answer to a witness:

- (a) Objection, vague.
- (b) Objection to the *form* of the question.
- (c) Take your time in answering the question.
- (d) Look at the document before you answer.
- (e) Counsel, do you want to show the witness the document?

In contrast to the McKelvey Deposition Rules, the AIA Testimony Guidelines explicitly allow “objection, form.”

Is the Absence of the McKelvey Deposition Rule Prohibiting Objections to Form in the AIA Proceedings a Good Thing?

Some members of the interference bar were initially hostile to the McKelvey Deposition Rules—notably including the very senior member of the interference bar whose conduct was publicly excoriated in *California Institute of Technology v. Enzo Life Sciences*, Interference No. 105,496, paper 117 (non-precedential) (opinion by APJ Torczon). However, we think it fair to say that, in time, most of us came to understand and appreciate them. In particular, we appreciated the prohibition against objecting to the form of a question.

The problem with objections to the form of a question is that nobody knows what that really means. Consequently, it can be given whatever meaning the lawyer asking the questions and the witness being asked the questions have agreed upon in advance. In particular, objections to “form” can be effectively used to prompt a witness to ask for a new question or to think long and hard before answering, thereby destroying the rhythm that the questioner has painstakingly developed. More objectionably, it can be used to mean “This is one of the questions that we anticipated and discussed at length in advance. Be careful to respond using precisely the language that I told you to use!”

Use of an objection as to form to convey such signals to a witness is particularly bothersome when used during cross-examination of an expert witness. Who’s in a better position to discern an ambiguous question related to the witness’s expertise, the lawyer asking the questions or the expert witness being asked the questions?

Moreover, speaking now only for ourselves, practice in AIA proceedings in the absence of the McKelvey Deposition Rules’ ban on objections as to form has given us an intense retrospective appreciation of that ban. The influx of patent post-grant practitioners who, while being members of the patent bar, have learned their deposition skills in jurisdictions (of which there are many) having nothing like the McKelvey Deposition Rules has, in our opinion, led to exactly the kind of evils against which Hizzoner inveighed: coaching objections and lengthy, confusing colloquies between counsel on the record, making the records very difficult to follow.

Recommendation

Medtronic Inc. v. Troy R. Norred, M.D., IPR2014-00110 (P.T.A.B. Oct. 8, 2014) (Paper 23), available at <http://src.bna.com/IOh> (non-precedential) (opinion by APJ Weatherly for a panel that also consisted of APJs Snedden and Grossman), sought to curb some of the practices that concern us. However, as should be obvious by this point, our recommendation is that Their Honors revise the Testimony Guidelines to promulgate either the McKelvey Deposition Rules as the senior APJ promulgated them (particularly including a ban on objections as to form) or a revised version thereof taking into account their own experiences with those rules.