

Patent Trial and Appeal Board (PTAB) Grants in Part Request for Rehearing of its Decision on Live Testimony from Inventor

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Matter: K-40 Electronics, LLC v. Escort, Inc., IPR2013-00203

The **PTAB** on May 30 granted in part petitioner K-40's request for rehearing on the issue of live testimony from Mr. Orr, the named inventor on the patent at issue. The Board had previously granted patent owner Escort's motion requesting live testimony from the inventor at oral argument.

In its initial decision on Escort's motion for live testimony, the Board explained that such testimony would only be permitted in limited circumstances. The Board observed that Mr. Orr would be testifying as a fact witness, not an expert, and that his testimony on the issue of whether his invention antedated the asserted prior art would likely be dispositive. The Board emphasized the importance, under these circumstances, of its ability to assess the demeanor of the witness. The Board initially ordered that Mr. Orr's previously-submitted declaration would serve as his direct examination, and that petitioner K-40 would be permitted 30 minutes of cross-examination, followed by 30 minutes of re-direct from Escort.

In its request for rehearing under 37 CFR 42.71(d), K-40 argued that the Board had overlooked the existence of 7 hours of video recorded deposition testimony from Mr. Orr, which K-40 asserted would sufficiently permit the Board to assess Mr. Orr's demeanor. K-40 also asserted that it had no further questions for Mr. Orr. Finally, K-40 explained that it was unsure whether the Board was ordering it to conduct cross-examination at oral argument.

In its decision on K-40's request for rehearing, the Board denied that it had overlooked the availability of video of Mr. Orr's deposition, citing previous acknowledgement of the video in prior conferences. As for K-40's assertion that it had no further questions, the Board noted that this assertion had not been made in prior briefing. However, the Board adjusted the prescribed procedure to begin with direct examination from Escort, to which K-40 was permitted to respond in cross-examination if it so chose. If K-40 elected not to conduct live cross-examination, it would be permitted to submit portions of the video record of the deposition. Finally, the Board's order provided that re-direct by Escort may be permitted at the Board's discretion.

K-40's representation that it had no further questions for Mr. Orr on cross-examination may have been a strategic maneuver intended to forestall live re-direct from Escort, mooted the necessity for

live testimony. If so, the strategy appears to have backfired, as the Board adjusted the prescribed procedure to open with live direct examination by Escort. Moreover, Escort may also be allowed to conduct re-direct examination if the Board permits it.

The Board's initial decision provides guidance on when the Board is likely to permit live testimony at oral argument, i.e., when the testimony of a fact witness may be dispositive, and the Board will benefit from the opportunity to observe the witness's demeanor during examination. The Board's decision on the motion for rehearing serves as a point of caution, demonstrating that a party should take into account that the Board may respond to its arguments by modifying an existing order in a manner not foreseen—or preferred—by the movant.

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