

Play Nice in the Deposition Sandbox

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Medtronic, Inc. v. Norred

In two separate orders on the conduct of the proceeding, the U.S. Patent and Trademark Office Patent Trial and Appeal Board (PTAB or Board) came down on the parties for their inability to amicably resolve disputes that arose during witness depositions without intervention by the PTAB. *Medtronic, Inc. v. Norred*, Case Nos. IPR2014-00110 and IPR2014-00111, Paper 23 (PTAB, Oct. 8, 2014) (Weatherly, APJ); Case Nos. IPR2014-00110 and IPR2014-00111, Paper 24 (PTAB, Oct. 9, 2014) (Grossman, APJ).

The patent at issue relates generally to an aortic heart valve that can be placed inside a patient without the need for open-heart surgery. The petitioner filed two petitions for inter partes review (IPR) of the patent, asserting that several of the patented claims were invalid as anticipated and/or obvious.

During witness depositions, two separate disputes broke out between the parties. The first dispute centered around the scope of the patent owner's questions during re-direct examination of the named inventor witness. In the petitioner's cross-examination of the witness, counsel questioned the witness about two specific exhibits. During re-direct examination, counsel for the patent owner asked questions about two additional exhibits. The petitioner objected that the re-direct exhibits were beyond the scope of the cross-examination testimony, and initiated a conference call with administrative patent judges (APJs) to obtain guidance on the matter.

The APJs noted that all of the exhibits at issue were part of one or both of the IPR petitions. Specifically, "[t]he fact that a document is an exhibit and thus is proffered as evidence, does not establish that the document is admissible or establish its probative value. It does establish, however, that the document is relevant for inquiry during deposition." The APJs further noted that the exhibits at issue, like the exhibits from cross-examination, were hand-drawn sketches created by the inventor and related to the development of the patent at issue. Therefore, the APJs ordered that the patent owner could obtain re-direct deposition testimony from the additional exhibits.

In the second dispute, the petitioner again initiated a conference call with the APJs, seeking guidance regarding the form in which the patent owner's counsel could object to deposition questions of an expert witness. The petitioner asserted that opposing counsel was utilizing improper "speaking objections." By way of example, the petitioner noted one specific objection that "began, 'Objection,

misleading . . .’ and then went on to explain at some length that the question was misleading because it asked for a conclusion from the witness based on only a portion of a patent that Patent Owner contends was ‘taken out of context.’”

The APJs agreed with the petitioner, and found that the patent owner’s objections were improper under the guidelines set forth in the Office Patent Trial Practice Guide. Counsel for the patent owner was ordered to cease such improper objections immediately and was cautioned that further such violations might result in sanctions.

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