

Depositions At PTAB Vs. District Court: What To Know

By **Matthew Bultman**

Law360 (April 18, 2018, 6:28 PM EDT) -- Deposing an opponent's expert witness can be an important part of America Invents Act reviews, but there are significant differences between depositions at the Patent Trial and Appeal Board and district court that can trip up the unsuspecting attorney.

Often involving close factual and technical issues, inter partes reviews and other AIA reviews at the PTAB can sometimes turn into a battle of the experts, whose testimony almost always goes to the heart of the case.

But the PTAB almost never allows live testimony at hearings, which means depositions are often the only chance for litigants to ask questions of the other side's expert. Adding to the importance of depositions is the limited scope of discovery in AIA reviews, PTAB practitioners said.

"As far as discovery goes, often times you will have one deposition and that's the end of it," Jason Stach of Finnegan Henderson Farabow Garrett & Dunner LLP said.

While taking depositions in district court may be familiar for many, deposing a witness at the PTAB is different in some key respects. Scott Kamholz of Covington & Burling LLP, a former PTAB judge, said the purpose and execution between the two are quite distinct.

"About the only thing in common between the two is the court reporter," he said. "Lawyers cannot come into a PTAB deposition expecting it to be like a district court deposition."

More Focus, Less Fishing

In district court, the goal of the deposition is often to learn as much as possible from the other side's expert witness and find out what that person is going to say later to a judge or jury. Attorneys will also try to nail the expert down on specific positions ahead of trial.

PTAB depositions are much more focused.

Under board rules, the scope of the deposition is limited to what the witness said in his or her declaration. One reason for that is the board doesn't want litigants to use depositions as a chance to fish for information on issues in parallel district court cases, such as infringement.

Rather than use the deposition as a chance to explore or test theories, ask lines of questions that are carefully planned ahead of time, designed to guide them into admissions. Use the expert witness' declaration as a road map, analyzing it for issues worth digging into.

"We're not here to learn from the expert," Kamholz said. "We are here to pull soundbites from the expert, we're here to pull admissions. And that's all."

Glenn Forbis of Harness Dickey & Pierce PLC said the deposition is akin to cross-examination during a district court trial.

"You have to think about it as if it were live testimony, as opposed to a more free-flow discovery, broad-reaching fishing expedition in civil cases," he said.

The challenge is that there is no warmup to figure out what questions to ask, practitioners said, as this is the first time in the room with the expert. But the transcript of what is said will be put in front of the PTAB judges who are deciding the case.

"It's very much doing the tightrope walk without a net," Kamholz said. "You don't get a dry run. You go from their paper statement to the deposition testimony, and that's it."

Holes in the Declaration? Leave Them Open

When analyzing the expert's declaration, it may be that some weak points are discovered. Maybe the other side didn't meet their burden to show the witness actually is an expert in the field, or the expert didn't fully explain aspects of a prior art reference.

In district court, where the witness is going to have a chance to potentially clean up those deficiencies later down the road, that is probably something worth probing. But at the PTAB, litigants may be better off leaving it alone.

"More so than in district court deposition, I think at the PTAB for depositions you want to be more surgical and strategic and may want to consider not addressing a declarant's weak points," Rich Coller of Sterne Kessler Goldstein & Fox PLLC said.

Again, this is in all likelihood the last time an expert will provide testimony in the case.

By asking them about a weakness in their declaration, it opens the door for the expert to elaborate on their opinion and backfill it with information. But if it is not asked about, the hole may remain and can be pointed out later to the board.

"What's important is not to ask the broad questions that allow that witness to elaborate, support or enhance their existing opinions," Forbis said.

Stach said he has seen instances where one side avoided the deposition altogether, something that is virtually unheard of in district court litigation or at the U.S. International Trade Commission.

One example he and others highlighted were gaps related to the expert's qualifications. If one side feels, based on the papers submitted to the board, that the other side hasn't shown the witness is an expert, they might argue to the PTAB that person's opinion is entitled to little or no weight.

“But if you get to the deposition and start asking questions and they tell you about all of this [relevant] experience they have that’s not in the papers submitted in the IPR ... you’ve just given the other side a gift and allowed them to supplement the record,” Stach said.

On the other side, attorneys defending the expert witness may want to consider taking advantage of redirect at the deposition. Something that may often go unused or is given short shrift in district court cases, redirect can provide one last chance to tidy things up.

“At the PTAB, I think it behooves practitioners to consider if they need to do a more lengthy, detailed redirect because, again, it’s going to be the last time to clean up the record,” Collier said.

Objections, Phone Calls, Coaching

Along with the strategic considerations, lawyers said there are also several procedural differences in depositions at the PTAB.

One area is objecting to questions posed by the other side. While there are exceptions, generally there can be more leeway in district court for a broader scope of objections as compared with the PTAB, which tends to frown upon long-winded objections that help to coach the witness.

At the same time, the PTAB requires objections be made during the deposition or litigants lose that opportunity. Forbis said it’s a narrow line to walk.

“The best rule of thumb is: First of all, do not lose the opportunity to make an objection because you’ll waive it,” he said. “Second, when you make your objection, say ‘objection’ and whatever the one-word reason is. ‘Objection relevance. Objection foundation.’”

The PTAB also avails its judges to make on-the-spot rulings over the phone when there are disputes during depositions. This is somewhat different from federal courts or the ITC, where it can be difficult to call a judge and get a resolution.

There is also the question of what attorneys can, or cannot, discuss with witnesses during breaks in the deposition. Some district courts will not let counsel defending the witness discuss the substance of the testimony. Others have fewer restrictions.

“The PTAB has come down squarely by rule on the side of no witness coaching or guidance during breaks,” Collier said.

--Editing by Philip Shea and Aaron Pelc.