

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

K-40 ELECTRONICS, LLC
Petitioner

v.

ESCORT, INC.
Patent Owner

Case IPR2013-00203
Patent 7,999,721

Before GLENN J. PERRY, THOMAS L. GIANNETTI, and
TRENTON A. WARD, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

ORDER
Request for Live Testimony
37 C.F.R. § 42.70

Patent Owner, Escort, Inc., has moved to present live testimony from its named inventor, Steven K. “Steve” Orr, at the final oral argument in this case on June 17, 2014. Paper 28 (“Motion”). Petitioner, K-40 Electronics, LLC, opposes. Paper 29 (“Opposition”).¹

The Board *grants* the motions, subject to the restrictions set forth below.

DISCUSSION

The Board does not envision that live testimony will be necessary at many oral arguments. *See* Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). However, under very limited circumstances, cross-examination of witnesses may be ordered to take place in the presence of an administrative patent judge. *Id.* at 48762. For example, the Board may occasionally require live testimony where the Board considers the demeanor of a witness critical to assessing credibility. *Id.*

The Board has determined that this case presents such circumstances. In addition to being named as sole inventor on the patent in this proceeding and a related proceeding involving the same parties and technology, i.e., IPR2013-00240, Mr. Orr is Petitioner’s principal fact witness. Through his declaration testimony in both cases, Patent Owner attempts to antedate the only two references (Hoffberg and Fleming III) relied on by Petitioner in its challenge to patentability. Mr. Orr’s testimony is, therefore, key, and may well be case-dispositive. Further, in that connection, declarations by Mr. Orr were presented to overcome the same

¹ We do not accept Petitioner’s characterization of this motion as seeking “additional discovery” subject to the *Garmin* interests-of-justice factors. Opposition 2.

references in other USPTO proceedings. There is, therefore, good cause to grant the motion.

We have considered Petitioner's arguments in opposition and find them unavailing. For instance, Petitioner contends that granting the motion will establish a "de facto" rule permitting live testimony in all antedating disputes. We disagree. Opposition 1. The Board envisions that live testimony will be necessary only in limited circumstances and intends to approach requests for live testimony on a case-by-case basis.

Factors to be considered may include the importance of the witness's testimony to the case, i.e., whether it may be case-dispositive. Here, the outcome of this proceeding may well turn on Mr. Orr's testimony. Another factor favoring live testimony is that Mr. Orr is a fact witness. In contrast, the credibility of experts often turns less on demeanor and more on the plausibility of their theories. *See Andreu v. Sec'y of HHS*, 569 F.3d 1367, 1379 (Fed. Cir. 2009) ("A trial court makes a credibility determination in order to assess the candor of a fact witness, not to evaluate whether an expert witness' medical theory is supported by the weight of epidemiological evidence."). In short, the Board sees no possibility that a "per se" rule will result from granting the motion, or that as a result, granting requests for live testimony will become the norm rather than the exception.

Neither are we persuaded that granting the motion gives Patent Owner a chance to "rewrite" testimony that Petitioner characterizes as an "unfavorable record." Opposition 3, 5. The Board has determined that only cross-examination and redirect will be permitted, thus limiting the scope of examination. No changes will be possible to Mr. Orr's direct testimony, for that is fixed by his previously submitted declaration. And should Petitioner suspect that Mr. Orr is changing his testimony, he may be impeached with his prior testimony.

Finally, we have noted Petitioner's contention that Mr. Orr's credibility is not case-dispositive because his testimony is uncorroborated. Opposition 4-5. Patent Owner, obviously, disputes this. PO Resp., Paper 12, 35. Petitioner in effect asks us to decide this issue now, in its favor. Presumably, this will be covered in Mr. Orr's cross-examination and in oral argument. We prefer to address the issue after hearing his live testimony and argument from the parties.

ORDER

In view of the foregoing, it is, therefore,

ORDERED that Patent Owner's motion to present live testimony of Steve Orr at the final hearing on June 17, 2014, is granted;

FURTHER ORDERED that such testimony will be limited to up to 30 minutes of cross-examination by Petitioner's counsel, followed by up to 30 minutes of redirect by Patent Owner's counsel;

FURTHER ORDERED that the scope of Mr. Orr's cross-examination will strictly be limited to his declaration testimony in this proceeding and the scope of his redirect examination will strictly be limited to the scope of cross-examination;

FURTHER ORDERED that the hearing on June 17, 2014, will begin with the presentation of live testimony from Mr. Orr followed by the oral argument.

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Patent 7,999,721

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