

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOCAL THERAPEUTICS, INC.,
Petitioner,

v.

SENORX, INC.,
Patent Owner.

Case IPR2014-00116
Patent 8,288,745 B2

Before LORA M. GREEN, FRANCISCO C. PRATS, and
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

In an e-mail correspondence sent to the Board on July 17, 2014 (attached), Counsel for Patent Owner requested a conference call seeking guidance regarding the Board's Testimony Guidelines in relation to a deposition dispute. The Testimony Guidelines are set forth in Appendix D of the Office Patent Trial Practice Guide. *See* 77 Fed. Reg. 48756, 48772-48773 (Aug. 14, 2012). In relevant part, the Testimony Guidelines provides:

Once the cross-examination of a witness has commenced, and until cross-examination of the witness has concluded, counsel offering the witness on direct examination shall not: (a) consult or confer with the witness regarding the substance of the witness' testimony already given, or anticipated to be given, except for the purpose of conferring on whether to assert a privilege against testifying or on how to comply with a Board order; or (b) suggest to the witness the manner in which any questions should be answered.

Id. at 48772 (emphasis added).

Counsel for Patent Owner seeks clarification as to when cross-examination of a witness "has concluded." *Id.* As stated in the e-mail, during a deposition of Petitioner's expert conducted on July 14, 2014, after Patent Owner's counsel concluded cross-examination, and before redirect questioning began, "Petitioner's counsel initiated a private conference with his witness to discuss his redirect testimony." *See* attached e-mail. Counsel for Patent Owner now asks: "Does the above guideline apply only to the initial cross-examination of the witness, or apply to the entire deposition, which can of course include redirect as well as subsequent re-cross of the witness." *Id.*

As noted above, the Testimony Guidelines state that "[o]nce the *cross-examination* of a witness has commenced, and until *cross-examination* of the witness has concluded," counsel may not, for example, "suggest to the

witness the manner in which any questions should be answered.” *Id.* at 48772 (emphasis added). “Cross-examination” here refers to either cross-examination or re-cross, but does not refer to the entire time frame between when cross-examination commences, and until re-cross examination concludes. The prohibition of conferring with the witness ends once cross-examination concludes, and, if relevant, begins again when re-cross commences, and continues until re-cross concludes. The prohibition does not exist, however, during the time frame between conclusion of cross-examination and start of re-cross. As noted by our colleagues in *Google Inc. and Apple Inc. v. Jongerius Panoramic Tech., LLC*, IPR2013-00191, Paper 48, 3 (PTAB, Feb. 6, 2014), counsel is “permitted to confer with the witness before redirect examination begins.”

In this particular instance, we address a deposition that already took place. We note that parties may confer before a deposition occurs, and agree among themselves regarding such matters. For example, the parties may agree in advance of a deposition that counsel may not confer with a witness until after the deposition is over, i.e., after re-cross, if any occurs.

In consideration of the foregoing, it is hereby

ORDERED that Counsel for Patent Owner’s request for a conference call is *denied* as moot.

Case IPR2014-00116
Patent 8,288,745 B2

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Cc: ARNOLD TURK; Kreeger, Matthew I. (MKreeger@mofo.com); Chivvis, Matthew Alan (MChivvis@mofo.com)
Subject: IPR2014-00116; Request For Conference Call

Counsel for Patent Owner requests a conference call in IPR2014-00116 to request clarification of the Testimony Guidelines. The Testimony Guidelines state in pertinent part:

Once the cross-examination of a witness has commenced, and until cross-examination of the witness has concluded, counsel offering the witness on direct examination shall not: (a) Consult or confer with the witness regarding the substance of the witness' testimony already given, or anticipated to be given, except for the purpose of conferring on whether to assert a privilege against testifying or on how to comply with a Board order; or (b) suggest to the witness the manner in which any questions should be answered.

Counsel for Patent Owner requests clarification as to when cross-examination of the witness has concluded.

At the deposition of Petitioner's expert conducted on Monday July 14, 2014, after Patent Owners counsel's cross examination questioning, before redirect questioning was to commence, over Patent Owners counsel's objection, Petitioner's counsel initiated a private conference with his witness to discuss his redirect testimony. Does the above guideline apply only to the initial cross-examination of the witness, or apply to the entire deposition, which can of course include redirect as well as subsequent re-cross of the witness.

Counsel for Patent Owner is available for a conference call on July 24 or 25, in the morning or afternoon. Counsel for Petitioner has indicated that they are available for a conference call July 24 or 25 in the afternoon California time.

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