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Paper 85
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UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,394 MPT
Technology Center 1600

PAOLO **PEVARELLO**, MARIO VARASI,
PATRICIA SALVATI and CLAES POST,

Patent 6,306,903,
Junior Party,

v.

NANCY C. **LAN**, YAN WANG,
and SUI XIONG CAI,

Application 10/429,764,
Senior Party.

Before: FLEMING, *Chief Administrative Patent Judge*, McKELVEY, *Senior Administrative Patent Judge*, and SCHAFER, HANLON, LANE and TIERNEY, *Administrative Patent Judges*.

McKELVEY, *Senior Administrative Patent Judge*.

MEMORANDUM OPINION and ORDER

The interference is before an expanded panel for consideration of a portion of LAN MOTION 1 TO EXCLUDE EVIDENCE (Paper 67). The portion of the MOTION before us involves objections to the admissibility of evidence based on alleged violations of the Cross Examination Guidelines.

Objections based on other grounds are before the motions panel (Judges Hanlon, Lane and Tierney).

Lan suggests that "the Patent Bar needs clarification as to whether *** [certain action] falls inside or outside *** the Guidelines." Lan Motion 1, page 10. We agree and take this opportunity to address practice under the Guidelines. We also address issues associated with testimony related to how direct testimony affidavits are created and signed.

A. Historical perspective

1. Rules

Patent interferences have been part of patent practice since the 1800's. For a long time, direct testimony was by deposition. See, e.g., 37 CFR § 1.272(a) (1984); Rivise & Caesar, Interference Law and Practice, Vol. 3, § 408 (1947) (Patent Office rules provide that the testimony of witnesses in this country may be taken by deposition); Rivise, Interference Practice, § 128 (1932) (testimony is taken in the form of deposition). Cross examination occurred at the deposition. Affidavit testimony could be used only by agreement of the parties. 37 CFR § 1.272(c) (1984).

In 1984, the rules were amended to permit the party presenting testimony to elect to present direct testimony by deposition or affidavit. 37 CFR § 1.672(b) (1985). If direct testimony was presented in affidavit form, cross examination was authorized. *Id.*

In 1995, the rules were again amended and for the first time required that direct testimony be presented by affidavit. 37 CFR § 1.672(a). The only exception was testimony which is compelled by subpoena under 35 U.S.C. § 24. Cross-examination of testimony presented in affidavit form was authorized. 37 CFR § 1.672(d) (1995).

The practice adopted in 1995 was recodified in 2004 as 37 CFR § 41.157(a) (2005). *See* 69 Fed. Reg. 49960, 50017 (Aug. 12, 2004).

2. Experience with presentation of direct testimony

Experience with affidavit testimony has convinced us that it is the most efficient way to have direct testimony presented to the Board. It is true that occasionally "live" testimony occurs in special circumstances when requested by the Board. However, from a practical point of view testimony is generally presented via affidavits and deposition transcripts, *i.e.*, on "paper."

When a motion is filed, the moving party must serve all of its evidence in support of the motion. The evidence may include one or more affidavits. Before the opponent determines whether cross examination would be appropriate, the opponent has before it all of the moving party's evidence. An opponent has complete "discovery" of the case-in-chief of the moving party, a luxury an opponent ordinarily would not enjoy in a trial in a court. Additionally, the opponent chooses the order in which witnesses are cross examined. 37 CFR § 41.157(c)(2) (2006). Since the opponent has the entire case-in-chief on any given motion before cross examination begins, numerous objections have been avoided compared to when testimony was presented in piece-meal deposition fashion. One example of an objection rarely raised is relevancy based on a "lack of foundation" *e.g.*, when a first witness is testifying about a test run by a second witness who has not yet testified.[1]

[1] Fed. R. Evid. 104(b).

Pre-1998 experience with deposition transcripts involving both direct testimony or cross examination showed that often considerable discussion about the objection took place. The objections and discussion made it very difficult to consider a deposition transcript on its merits. Often by the time one sifted through the objections and associated discussion one lost track of what question was asked. Additionally, there is little doubt from our point of view that through the objection and subsequent discussion process, "witness coaching" was alive and well in pre-1998 interferences.

3. Establishment of the guidelines

Some time after creation of the Trial Section in 1989, an opinion came to our attention which had been authored by the late U.S. District Judge Robert S. Gawthrop, III of the U.S. District Court for the Eastern District of Pennsylvania. *Hall v. Clifton Precision, a Division of Litton Systems, Inc.*, 150 F.R.D. 525 (E.D. Pa. 1993). In his opinion, Judge Gawthrop summarizes difficulties with deposition practice. As a result, an order was entered in *Hall* setting out guidelines governing future depositions. 150 F.R.D. at 531-532.

Despite differences in practice before the Board in interference cases and practice under the Federal Rules of Civil Procedure, Judge Gawthrop's deposition experience in large measure mirror ours. Rather than reinvent a set of guidelines, the Trial Section adopted seven guidelines relying heavily on those adopted by Judge Gawthrop, taking into account of course differences in practice between interferences and civil actions. Our guidelines are essentially those which appear in *Hall*. We recommend that the practicing bar read Judge Gawthrop's opinion because the deposition philosophy expressed in his opinion was adopted by the Trial Section—now

the Trial Procedures Section of the Trial Division. Many questions which the bar may have are answered in Judge Gawthrop's opinion. Fundamentally, however, it should be remembered that a deposition is an opportunity for an opposing counsel to have a conversation with the witness: "A deposition is meant to be a question-and-answer conversation between the deposing lawyer and the witness. There is no proper need for the witness's own lawyer to act as an intermediary, interpreting questions, deciding which questions the witness should answer and helping the witness to formulate answers." 150 F.R.D. at 528, col. 1.

B. Application of the Guidelines to the facts of this case

A review of the transcripts of the cross examination depositions of Dr. Stephen G. Waxman (Ex 1026 and Ex 1027) and Dr. Sergio Mantegani (Ex 1077) reveals at least the following.

(1) Stipulation with respect to objections

Counsel stipulated that "failure to state the basis for *** [an] objection does not constitute a waiver of that objection ***." Ex 1026:4:16-18. *See also* Ex 1027, page 4:2-5.

The stipulation is contrary to Guideline [3]. Any objection to the admissibility of evidence during cross examination must be stated concisely and in a non-argumentative and non-suggestive manner and *must include the legal basis for the objection.*

A first reason for a requirement for a legal basis for an objection is to permit the deposing lawyer to ask additional questions or rephrase a question to overcome the objection. A second reason is to make it efficient for the Board to consider and resolve any objection which is renewed in a motion to

exclude filed pursuant to 37 CFR § 41.155(c) (2006). If no legal basis is given at the time a "blanket" objection is made, then the objecting lawyer may be able to prevail on a motion to exclude if there is any reason to exclude. An ability to present multiple grounds for a blanket objection in a motion to exclude burdens both the opponent and the Board and is inconsistent with a just, speedy and inexpensive resolution of the interference. 37 CFR § 41.1(b) (2006).

It may be that counsel in this case felt that the stipulation was necessary to avoid even an appearance of witness coaching. However, Guideline [3] expressly requires that a legal basis be stated. Any legal basis for an objection must be based on the rules governing admissibility of evidence for contested patent cases, including the Federal Rules of Evidence. 37 CFR §§ 41.151-41.153 (2006).

Examples of suitable objections with a legal basis include:

> Objection, hearsay.[2]
>
> Objection, document not authenticated.[3]
>
> Objection, leading.[4]
>
> Objection, beyond the scope of the direct testimony.[5]

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[2] Fed. R. Evid. 802.

[3] Fed. R. Evid. 901.

[4] Fed. R. Evid. 611(c). Leading questions ordinarily are permitted on cross examination. Leading questions ordinarily are not permitted on re-direct. Since direct testimony is presented by affidavit, issues concerning leading questions on direct do not arise in interference cases.

[5] Fed. R. Evid. 611(b). Counsel for Lan properly followed the Guidelines on re-direct during the deposition of Pevarello's witness Dr. Sergio Mantegani: "Objection. It's beyond the scope of cross examination." Ex 1077, page 72:10-11.

Following the objection, there is no need for an explanation by the questioning lawyer as to why an objection lacks merit. What is important is that the questioning lawyer be made aware why an objection has been made. The time and place to explain why an objection lacks merits is in an opposition to a motion to exclude. 37 CFR § 41.155(c) (2006) (motion to exclude); 37 CFR § 41.122(a) (2006) (opposition to motions). Obviously, if a motion to exclude is never filed a discussion becomes unnecessary.

(2) Blanket objections

During the depositions, "blanket" objections stating no basis for the objection were made to questions by the questioning lawyer. Motions to exclude based on blanket objections will not be considered because blanket objections during a deposition fail to comply with Guideline [3].

Examples of blanket objections include the following.

1.

[By counsel for Lan]: Other than your declaration that's been submitted in this interference as Exhibit 2003, can you recall every testifying about sodium channel blockers in written testimony.

[By counsel for Pevarello]: Objection. Ex 1026, page 14:24 through page 15:2.

2.

[By counsel for Lan]: Are there any other documents that you recall thinking about in connection with this interference?

[By counsel for Pevarello]: Objection. Ex 1026, page 21:14-17.

3.

[By counsel for Lan]: Can you think of any other specific documents?

[By counsel for Pevarello]: Objection.

[Witness]: None that come to mind. Ex 1026, page 23:4-8.

4.

[By counsel for Lan]: Well you said well what I would do is X. And I'm wondering if there are other ways that what you would do?

[By counsel for Pevarello]: Objection.

[Witness]: Sure. Ex 1026, page 52:22 through page 53:2.

5.

[By counsel for Pevarello on redirect]: Yes, in addition to the information presented in the LAN applications, what further information would you need in order to be able to say that a person skilled in the art would believe that the component would be likely to be useful as a local anesthetic?

[By counsel for Lan]: Objection. Ex 1027, page 29:16-22.

6.

[By counsel for Lan]: Did you arrive at the Maastricht conference on Sunday?

[By counsel for Pevarello]: Objection. Ex 1077, page 49:15-17.

(3) Improper objections and discussion

During the course of the depositions, improper objections and associated discussion occurred.

Examples include the following.

1.

[By counsel for Lan]: I'm simply trying to learn what your understanding of a patent interference is?

[Witness]: I'm not trying to be vague.

[By counsel for Pevarello]: Objection. Was there a question there? Ex 1026, page 25:14-18.

It is up to the witness, not opposing counsel to ask for a clarification. See Guideline [1]. The record in this case shows that a witness is capable of asking for clarification: "Excuse me. Could you rephrase your question?" Ex 1077, page 112:22-23.

2.

[By counsel for Lan]: Did you ever correspond with Newron's attorneys via e-mail?

[Witness]: No.

[By counsel for Lan]: Via fax?

[Witness]: No.

[By counsel for Pevarello]: When you are asking Newron's attorneys, I'm not sure if—I'm not sure it's clear exactly what you're talking about. Ex 1026, page 44:23 through page 45:5.

Counsel for Pevarello may have been confused about a question which was asked. But, it is not up to counsel for Pevarello to note any confusion. It is up to the witness to indicate that the witness is confused. *See* Guideline [1]. As hard as it may be for defending counsel to believe it, sometimes when counsel is confused the witness is not. Reproduced in footnote 1 of the Guidelines is an observation by Judge Gawthrop:

> I also note that a favorite objection or interjection of lawyers is, "I don't understand the question, therefore the witness doesn't understand the question." This is not a proper objection. If the witness needs clarification, the witness may ask the deposing lawyer for clarification. A lawyer's purported lack of understanding is not a proper reason to interrupt a deposition. In addition, lawyers are not permitted to state on the record their interpretations of questions, since those interpretations are irrelevant and often suggestive of a particularly desired answer.

150 F.R.D. at 530 n.10. There can be no objection under the contested cases rules or the Federal Rules of Evidence that a question is ambiguous, not clear or vague. Furthermore, by clarifying what is perceived as a vague question, the defending lawyer may help the questioning lawyer make out a case for the questioning lawyer's client! Often the less said the better. If a vague question is asked, any answer may be entitled to little, or no, weight if at the end of the day the question cannot be understood by the trier of fact.

3.

[By counsel for Lan]: I'm trying to understand what you mean when you say the general concept of developing a new sodium channel blocker that would be useful for the treatment of pain.

[By counsel for Pevarello]: Objection.

[By counsel for Lan]: That wasn't the question.

[By counsel for Pevarello]: That was my objection. Ex 1026, page 51:14-21.

It is hard to imagine why the objection was made.

4.

[By counsel for Lan]: So is it fair to say that there are multiple ways of developing a new sodium channel blocker that would be useful for treatment of pain?

[By counsel for Pevarello]: Objection

[Witness]: It's fair and unfair. And by that what I mean is there are multiple ways, but some of them are not feasible in our society.

[By counsel for Lan]: Can I ask you what the basis of your objection is?

[By counsel for Pevarello]: Yeah, I think it's ambiguous when you're talking about developing new sodium channel and also linking that with the issue of usefulness. It's not clear whether you're talking just developing the chemical as opposed to determining its usefulness. I think it's ambiguous as to exactly what you are asking when you are saying developing it that would be useful. Ex 1026, page 53:18 through page 54:10.

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[By counsel for Lan]: Did you consider any other dates in formulating the opinions that are set forth in your declaration?

[By counsel for Pevarello]: Objection.

[By counsel for Lan]: Mr. Baker, may I ask you why you're objecting.

[By counsel for Pevarello]: Yeah, when you said did you consider any other dates, it wasn't clear whether you meant other than 1998 or other than the two dates referred to in paragraph 22 that you've been asking him about. The paragraph talks both about '97 and '98. It was ambiguous when

you said other dates, what you meant by other. Other than what? Ex 1026, page 71:15 through page 72:8.

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[By counsel for Lan]: The question was: In your opinion, does a person skilled in the art, as you've used that phrase in paragraph 43 of your declaration, differ from a person of ordinary skill in the art?

[By counsel for Pevarello]: Objection.

[By counsel for Lan]: May I ask the basis for your objection?

[By counsel for Pevarello]: Yeah. When you're asking about a person of ordinary skill in the art, it's not clear whether you are talking about in general or as he's used that second phrase somewhere else in some other paragraph in the declaration. Ex 1026, page 90:22 through page 91:8.

Here we have three examples of a first error compounded by a second error re-compounded by a third error. *First*, there should not have been a blanket objection; rather a legal basis must accompany an objection. *Second*, consistent with the stipulation (as discussed earlier, the stipulation itself is yet another error) counsel for Lan should not have asked counsel for Pevarello the basis for the objection. *Third*, as pointed out earlier, what is ambiguous to counsel for Pevarello is irrelevant—the witness must state that the witness is confused. All the discussion by counsel for Pevarello as to why the questions are supposedly ambiguous was unnecessary and contrary to the Guidelines.

5.

[By counsel for Lan]: Would you like to clarify this point in your declaration by modifying --.

[Witness]: Well I mean another way of saying it and perhaps a clearer way of saying it is an expert in this field would have required evidence and—so if that's clearly, certainly that's—that's what I mean.

[By counsel for Lan]: Is it clearer to you? It's your declaration. I --.

[By counsel for Pevarello]: I –

[By counsel for Lan]: Please don't coach the witness. Please --.

[By counsel for Pevarello]: You are trying to encourage the witness to change his declaration.

[By counsel for Lan]: I'm asking the witness if he would like to change his declaration.

[By counsel for Pevarello]: He doesn't need to change his declaration just to suit you. If he feels he needs to, he can do that.

[By counsel for Lan]: I'm asking him if he feels he needs to.

[By counsel for Pevarello]: Then ask him. Ex 1026, page 74:9 through 75:4.

In this instance, counsel for Lan is attempting to determine if there is something in the declaration of the witness which the witness would like to change or clarify. However, at the point where counsel for Pevarello says "I –", counsel for Pevarello is "side tracking" the deposition, and probably coaching the witness.

The response by counsel for Pevarello that you're trying to get the witness to change his direct testimony is out of order. *First*, there is nothing wrong on cross examination to inquire into whether a witness would like to reconsider and possibly change or otherwise clarify direct testimony. It happens all the time. A witness with an open mind is often willing to change or clarify direct testimony. If a witness be so advised, change or

clarification is to be encouraged. *Second*, the remark by counsel for Pevarello that the witness does not have to change his declaration "just to suit you" is not appropriate. Apart from being a violation of the Guidelines, it crossed the line of the decorum rule. 37 CFR § 41.1(c) (2006). The contest is *Pevarello v. Lan*, not *Counsel for Pevarello v. Counsel for Lan*. The whole discussion was a side show apart from the main event—the main and possibly the only event being an opportunity for counsel for Lan to have a discussion with the witness.

6.

[By counsel for Lan]: I would like to make sure that something on the transcript appears correctly. Earlier I had asked you do you mean an expert. And the transcript reads: You need to be an expert to do it right. Is that what you said?

[Witness]: If it says it on the transcript, then I said it.

[By counsel for Lan]: Is that your testimony?

[By counsel for Pevarello]: Well let me clarify when he said that, he was posing as a hypothetical. I think it should have a question mark at the end of that statement.

[Witness]: I don't --.

[By counsel for Pevarello]: Rather than a hypothetical. Rhetorical. I suppose it's a rhetorical question he was asking himself in answering your question. Ex 1026, page 77:19 through 78:10.

When a defending lawyer attempts to clarify what the witness said, the defending lawyer has determined that the Board's Guidelines do not apply. The lawyer takes over control of the case from the Board. However,

it is the Board which controls proceedings before it—not the parties or their lawyers. We cannot efficiently administer a case management process whereby our rules and established procedures, such as the Guidelines, are jettisoned to serve some interest of a lawyer. Fortunately, Dr. Waxman—an independent expert hired by Pevarello—deserves considerable credit for his ability to have stayed above the fray instigated by counsel for Pevarello.

7.

[By counsel for Lan]: Earlier when I asked you what you meant by viable therapeutic window, you stated in part, so you want the window to be such that there's room for little bit of variation or error without getting you patients in trouble.

[Witness]: Certainly as you move toward the clinical world, you need to do that. Now …

[By counsel for Pevarello]: I'm going to object because there's no question pending. Ex 1026, page 117:16-25.

The objection is highly inappropriate. "I'm going to object because there's no question pending" translated into plain English means "Do not say anything more." If ever there was an example of improper coaching, this is it. There was a question pending and apparently the witness was not done answering the question when counsel, in effect, told the witness to "Shut up!" It is perfectly appropriate *prior to* a deposition to prepare a witness and to remind the witness "Answer just the question which is asked and do not volunteer." Once the deposition starts, the defending lawyer can no longer "prepare" the witness for the deposition. After the "derailment" when

testimony resumed, it seems as though the witness again was able to stay above the fray.

8.

[By counsel for Lan]: Is it your understanding the PDR [Physician's Desk Reference] includes relevant warnings, hazards, contraindications, side effects and precautions for prescription drugs?

[By counsel for Pevarello]: Objection.

[Witness]: That is my understanding.

[By counsel for Lan]: What is the basis for the objection? Did I misread something?

[By counsel for Pevarello]: No. It's a question of whether the PDR is complete including all information about the items you mentioned or are you asking whether it's supposed to –

[By counsel for Lan]: I didn't say "all." I said includes relevant warning, hazards.

[By counsel for Pevarello]: I think you said "any relevant warnings, hazards," et cetera.

[By counsel for Lan]: Transcript says, I believe, "it's supposed to include that information."

[By counsel for Pevarello]: Because it wasn't clear, that was the basis of my objection. Ex 1027, page 14:21 through page 15:19.

The exchange is precisely the kind of exchange which the Guidelines seek to keep out of deposition transcripts. The objection by counsel for Pevarello based on alleged vagueness was not proper. After the witness answered the question asked by counsel for Lan, the "What is the basis for

the objection" was unnecessary. After that, the "Because it wasn't clear" was also unnecessary. A deposition is not a legal argument by counsel; it is a question and answer session between the lawyer and the witness.

Apart from Guideline violations by both counsel, we question why an objection was needed. The question seems perfectly clear to us. We take official notice that the PDR is a well-known reference book and we cannot imagine that Dr. Waxman would not have known about the PDR. Dr. Waxman's statement that "That's my understanding" confirms his knowledge consistent with what we would have expected.

9.

[By counsel for Lan]: Is it your testimony that that book was on the table when you walked in this morning?

[By counsel for Pevarello]: Objection. I think that misstates the witness's testimony. Ex 1077, page 96:2-5.

A similar objection was made at Ex 1077, page 124:18-23.

It is up to the witness to inform questioning counsel that the witness's testimony has been mischaracterized or misstated. The proper procedure would have been for counsel for Pevarello to clear up the "misstatement" on redirect.

10.

[By counsel for Lan]: You told me this morning that you gave it to her, right?

[By counsel for Pevarello]: Objection. Ex 1077, page 104:10-12.

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[By counsel of Lan]: You don't remember that. And just so I understand, you don't remember that, but you remember specific questions asked at a poster presentation ten years ago; is that correct?

[By counsel for Pevarello]: Objection. Ex 1077, page 105:17-22.

Given the surrounding context (not reproduced in this opinion) in which these "Objections" were made one reasonably could determine that witness coaching took place.

(4) Objections to the form of the question

In the second deposition of Dr. Stephen Waxman, counsel "stipulated that all objections are reserved until the time of trial, except those objections as are directed to the form of the question." Ex 1027, page 4:2-5.

We have already addressed the need for a reason to be stated when an objection is made during a deposition. There are two other concerns we have concerning the stipulation quoted above.

First, "until the time of trial" makes no sense in the context of an interference. Cross-examination during a deposition is the "trial" in an interference. After the deposition, there is no subsequent trial where a witness is further cross examined "live" as might occur in a Federal court. An objection is either made during the deposition or it is waived—period.

Second, in patent interference practice before the Board, there is no such thing as an objection to the form of the question. We recognize from our law school days and from reading transcripts of depositions and trials in cases before Federal and State courts that objections to the "form of the question" may be made in at least some of those courts. However, whatever the practice in Federal and State courts, there is no objection under our rules

or the Federal Rules of Evidence based on the "form of the question." An objection to the form of the question should not be made in patent interference cases.

(5) Re-occurring objections and disagreements during depositions

Judge Gawthrope notes in *Hall*:

> They [, i.e., counsel,] should comport themselves accordingly; should they be tempted to stray, they should remember that this judge is but a phone call away.

150 F.R.D. at 531, col. 1.

The administrative patent judge assigned to manage an interference also is "but a phone call away."

When redirect and recross of Dr. Sergio Mantegani took place, a dispute arose as to whether a certain line of testimony was beyond the scope of both direct and cross examination. Many objections based on questions being leading were also made. Ex 1077, page 68:22 (starting at 13:11 hours) through page 92:16 (ending at 13:45 hours). The situation is a classic example of when a deposition should be suspended and a phone call placed to the judge. Guideline [2]; STANDING ORDER, ¶ 10.5 (Jan. 3, 2006). Any phone conversation involving counsel and the judge can be made of record during the deposition since a court reporter is available.

C. Cross examination concerning preparation of direct testimony

At the beginning of cross examination of Dr. Stephen Waxman and Dr. Sergio Mantegani, attempts were made by counsel for Lan to inquire into the "details" of how the Waxman and Mantegani direct declaration testimony came into existence.

(1) Waxman declaration

What follows are paraphrases of questions asked of Dr. Waxman.

Who wrote the Waxman declaration? Ex 1026, page 38:10.

Approximately how many versions of the declaration were reviewed? Ex 1026, page 38:18.

Did you suggest changes to the declaration as submitted to you? Ex 1026, page 38:20-21.

Did the attorney suggest changes? Ex 1026, page 38:23-24.

Do you have any drafts of your declaration? Ex 1026, page 39:1-2.

Do you recall specific changes made to your declaration? Ex 1026, page 39:21-22.

Do you recall changes suggested by the attorney? Ex 1026, page 41:6-7.

Can you give me an example of what you say is the attorney's phraseology? Ex 1026, page 42:15-16 and page 43:9-10.

Were there any topics which the attorneys suggested be included in your declaration? Ex 1026, page 44:12-13.

How many meetings did you have with the attorneys? Ex 1026, page 44:15-22.

Did you correspond with the attorneys? Ex 1026, page 45:8.

Did you have telephone discussions with the attorney about drafts of your declaration? Ex 1026, page 47:12-18.

Did you ever e-mail the attorneys? Ex 1026, page 48:6.

(2) Mantegani declaration

What follows are paraphrases of questions asked of Dr. Mantegani.

Who wrote your declaration? Ex 1077, page 35:8.

Did you have a discussion with your attorney before a draft of the declaration was prepared? Ex 1007, page 35:10-11.

Did you make any changes to any language of any draft declaration? Ex 1077, page 36:15-16.

How was the declaration sent to you? Ex 1077, page 41:25 through page 42:2.

(3) Discussion

The questions set out above generally are a waste of time, both for the witness and the Board.

First, it does not matter how a declaration for direct testimony is prepared, who suggested what, what changes were made, how drafts and the final declaration were transmitted to a witness for signature, etc. If a witness signed a declaration, a good starting point is to presume that the witness agrees with the content of the declaration apart from who wrote it and how many changes were made or why they were made. We can advise the bar that (1) we assume that ordinarily an attorney prepares at least the first draft of a declaration after discussion with the witness, (2) the witness is probably paid for time involved in testifying, either because the witness is an outside expert or is employed by the real party in interest, (3) drafts, possibly numerous drafts, are created and revised through discussions between the witness and the attorneys and (4) ultimately a draft is agreed to which is signed. We have no problem whatsoever with the process.

Second, a tension exists between (1) an inquiry into details of how a direct testimony declaration came to be prepared, on the one hand, and (2) both the attorney work product doctrine and attorney-client privilege, on the other hand. An attorney needs to be able to freely talk with a client

witness or a non-client witness to formulate a litigation strategy (or even to see if there is a case to present). After-the-fact cross examination inquiries into declaration preparation tend to chill an inquiry an attorney might initially make into what the facts are and who should testify concerning particular facts.

Third, what matters is what is said on the merits, *e.g.*, (1) identification of credentials, (2) explanation of an invention, (3) explanation of prior art, (4) explanation why an invention would not be expected to "work," (5) an underlying basis for opinions stated by experts and (6) events related to conception, diligence and actual reduction to practice. Cross examination to inquire into whether the witness has a basis for facts asserted and opinions stated in a declaration is fair game. Indeed, inquiry into facts and opinions should be the focus of cross examination. Obviously there will be cases where qualification of a witness and possible witness bias may need to be addressed and inquiry into these subjects is also fair game for cross examination. Cross examination which "sticks" to the relevant technical facts will shorten cross examination time and will probably be more effective in helping a party establish its position on a particular point.

We acknowledge that a majority of the Federal courts have apparently determined that under the Fed. R. Civ. P. 26(a)(2) documents and information disclosed to an expert in connection with the expert's testimony are discoverable by the opposing party. *See, e.g., In re Pioneer Hi-Bred Int'l, Inc.*, 238 F.3d 1370, 1375, 57 USPQ2d 1658, 1661 (Fed. Cir. 2001). An August 2006 report of the American Bar Association points out why an amendment to Rule 26(a)(2) to limit discovery would be in the public interest. See "Report" available at:

http:www.abanet.org/litigation/standards

then search for 120a.report. The Fed. R. Civ. P. do not apply in interference cases before our Board. Among reasons given in the Report for an amendment to limit discovery of expert communications with counsel are (1) counsel should be free to explore different theories and options in preparing a case, (2) an expert should be able to arrive at a carefully considered opinion by testing different hypotheses, permutations and calculations, (3) there is no evidence, empirical or otherwise which shows that discovery of work product information improves the quality of justice and (4) disclosure imposes unnecessary costs on the litigation process and advantages the well-heeled litigant who can afford two experts. All of these reasons are consistent with a limitation in patent interference cases for not permitting inquiry into how a direct testimony declaration was prepared and with the underlying philosophy governing contested cases. 37 CFR § 41.1(b) (2006).

In the future, absent a compelling reason, we counsel against any attempt to inquire on cross-examination into how direct testimony declarations came to be prepared.

D. Order

Upon consideration of the record as set out above, and for the reasons given, it is

ORDERED that the interference is remanded to the panel for such action as it deems appropriate.

/ss/ Michael R. Fleming	)	
MICHAEL R. FLEMING	)	
Chief Administrative Patent Judge	)	
	)	
/ss/ Fred E. McKelvey	)	
FRED E. McKELVEY	)	
Senior Administrative Patent Judge	)	
	)	
/ss/ Richard E. Schafer	)	
RICHARD E. SCHAFER	)	
Administrative Patent Judge	)	
	)	BOARD OF
/ss/ Adriene Lepiane Hanlon	)	PATENT
ADREIEN LEPIANE HANLON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
/ss/ Sally Gardner Lane	)	
SALLY GARDNER LANE	)	
Administrative Patent Judge	)	
	)	
/ss/ Michael P. Tierney	)	
MICHAEL P. TIERNEY	)	
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