

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COALITION FOR AFFORDABLE DRUGS II LLC,
Petitioner,

v.

NPS PHARMACEUTICALS, INC.,
Patent Owner.

Cases IPR2015-00990 and IPR2015-01093
(Patent 7,056,886 B2)¹

Before JACQUELINE WRIGHT BONILLA and SHERIDAN K. SNEDDEN,
Administrative Patent Judges.

SNEDDEN, *Administrative Patent Judge.*

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

¹ This order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are authorized to use this style heading when filing a single paper in each proceeding, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

In an email correspondence sent to the Board on December 9, 2015, counsel for Patent Owner requested a conference call seeking guidance regarding the Board's Testimony Guidelines in relation to a deposition dispute. The relevant portion of the email reads as follows:

These IPRs concern the same patent but different groups of claims. However, all challenged claims are related.

Petitioner presented two declarations of the same expert which are similar in content in the parallel IPRs. Patent Owner noticed cross-examination of the expert in each IPR. Because of the extensively overlapping subject matter of the declarations, Patent Owner suggested one deposition for 10 hours instead of 2 depositions of 7 hours each. In the alternative, Patent Owner would like to be able to rely upon both cross examinations in both IPRs where relevant.

Either of these procedures would eliminate asking the same questions twice, once in the first deposition and again in the second. It would also eliminate the possibility for the witness to be coached by counsel on the questions that would need to be re-asked the second day of the depositions. It would also eliminate the need for the Board to study two cross examinations of the same witness on common subject matter on the same patent and to review possibly conflicting testimony from different days from the same witness. Dividing the cross-examinations into two separate, duplicative sessions defeats the purpose of cross-examination.

A telephone conference was held among respective counsel for the parties and Judges Snedden and Bonilla on December 9, 2015. During the teleconference, Patent Owner noted that the two present cases involve the same patent, same witness, and, as a result, involve a significant overlap in subject matter. Patent Owner expressed concerned that, under these circumstances, having two separate depositions of the same witness in

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IPR2015-00990 and IPR2015-01093 creates an opportunity for inappropriate discussions to occur during the time between depositions. Patent Owner thus requested one deposition for 10 hours instead of two depositions of 7 hours each. In the alternative, Patent Owner requested allowance to rely upon either transcript of the deposition in either case.

Petitioner requested that the depositions for IPR2015-00990 and IPR2015-01093 be treated separately in the two cases. Petitioner noted that the cases involved different claims of the subject patent and have not been consolidated.

During the teleconference, we provided the parties with verbal guidance indicating that, in the absence of an agreement to the contrary, our default rules apply. For the convenience of the parties, additional guidance regarding the taking of testimony is provided below.

37 C.F.R. § 42.53(c)(1) governs the duration of testimony, which provides as follows:

Unless stipulated by the parties or ordered by the Board, direct examination, cross-examination, and redirect examination for compelled deposition testimony shall be subject to the following time limits: Seven hours for direct examination, four hours for cross-examination, and two hours for redirect examination.

Furthermore, 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 the absence of any agreement between the parties, depositions for a same witness in IPR2015-00990 and IPR2015-01093 shall occur separately and each for the time allotted in § 42.53(c)(1). The parties, however, may rely upon either deposition transcript in either case.

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 The prohibition of conferring with the witness ends once cross-examination concludes in each case. The prohibition does not exist during the time frame between the end of the cross-examination in the first case and the beginning of cross-examination in the second case.

In consideration of the foregoing, it is hereby

ORDERED that, in the absence of any agreement between the parties, 37 C.F.R. § 42.53 governs the taking of testimony and the depositions for IPR2015-00990 and IPR2015-01093 shall occur separately; and

FURTHER ORDERED that the parties may rely upon a transcript of a deposition taken in IPR2015-00990 or IPR2015-01093 in either case.

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