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Despite similarities in form, a cross-examination in a Patent Trial and Appeal Board ("PTAB") trial[1] *constitutes trial testimony, which is different from a discovery deposition occurring in civil litigation. While most practitioners would readily recognize this distinction in the abstract, it can be easy to fall back into patterns learned in and applicable to pretrial discovery in civil litigation that may not fit for a PTAB cross-examination. The PTAB regulations describe cross-examination as "routine discovery"*[2] *in the "form of a deposition transcript,"*[3] *but a civil action discovery deposition and a PTAB trial cross-examination deposition differ in their goals, their applicable rules, and their use in the case, all of which should inform how one approaches the cross-examination process.*

One of the classic texts on trial advocacy, THE ART OF CROSS-EXAMINATION,[4] *was published more than a century ago. Through stories and descriptions, that book has taught generations of lawyers its techniques for approaching cross-examination in a live courtroom setting. In this article, drawing its title from that work, we will review some of the regulations, guidelines, and cases from the Board instructing counsel on how to approach and conduct cross-examination in the PTAB trial.*

1. *See* 37 C.F.R. § 42.2 ("*Trial* means a contested case instituted by the Board based upon a petition. A trial begins with a written decision notifying the petitioner and patent owner of the institution of the trial. The term trial specifically includes a derivation proceeding under 35 U.S.C. 135; an inter partes review under Chapter 31 of title 35, United States Code; a post-grant review under Chapter 32 of title 35, United States Code; and a transitional business-method review under section 18 of the Leahy-Smith America Invents Act. Patent interferences are administered under part 41 and not under part 42 of this title, and therefore are not trials.").

2. 37 C.F.R. § 42.51(b)(1)(ii) ("Cross examination of affidavit testimony prepared for the proceeding is authorized within such time period as the Board may set.").

3. 37 C.F.R. § 42.53(a) ("All other testimony, including testimony compelled under 35 U.S.C. 24, must be in the form of a deposition transcript.").

4. FRANCIS L. WELLMAN, THE ART OF CROSS-EXAMINATION WITH CROSS-EXAMINATION OF SOME IMPORTANT WITNESSES IN SOME CELEBRATED CASES (New and Enlarged Ed., 1919).

I. HOW THE DEPOSITION TESTIMONY IS USED

A useful starting point in thinking about a PTAB trial cross-examination deposition and how it differs from a civil action discovery deposition is to consider how each is used in their respective trials.

The trial in a civil action places strict limits on the use of deposition testimony.[5] In a civil action, the primary means of presenting evidence is through the testimony of a witness at trial in open court.[6] Except for the deposition of a party[7] or an unavailable witness,[8] which can be used for any purpose, depositions can be used only for impeachment[9] of testimony given in open court or other uses specifically allowed by the Federal Rules of Evidence.[10] The deposition transcript excerpt may be read into the record or presented by video[11] and, under the rule of completeness,[12] any other parts that, in fairness, should also be considered can be offered at the same time.

In a PTAB trial, all evidence to be considered by the Board including "transcripts of depositions" must be "filed in the form of an exhibit."[13] Objections to admissibility of testimony[14] are made not when the transcript of deposition is filed, but during the deposition itself. Accordingly, the practitioner in a PTAB trial cross-examination deposition should expect the whole transcript of the entire deposition to be filed.

5. FED. R. CIV. P. 32 ("Using Depositions in Court Proceedings.").

6. FED. R. CIV. P. 43(a) ("At trial, the witness's testimony must be taken in open court, unless a federal statute, the Federal Rules of Evidence, these rules, or other rules adopted by the Supreme Court provide otherwise. For good cause in compelling circumstances and with appropriate safeguards, the court may permit testimony in open court by contemporaneous transmission from a different location.").

7. FED. R. CIV. P. 32(a)(3) ("An adverse party may use for any purpose the deposition of a party or anyone who, when deposed, was the party's officer, director, managing agent, or designee under Rule 30(b)(6) or 31(a)(4).").

8. FED. R. CIV. P. 32(a)(4).

9. FED. R. CIV. P. 32(a)(2) ("Any party may use a deposition to contradict or impeach the testimony given by the deponent as a witness, or for any other purpose allowed by the Federal Rules of Evidence.").

10. *Id.*

11. FED. R. CIV. P. 32(c) ("Unless the court orders otherwise, a party must provide a transcript of any deposition testimony the party offers, but may provide the court with the testimony in nontranscript form as well. On any party's request, deposition testimony offered in a jury trial for any purpose other than impeachment must be presented in nontranscript form, if available, unless the court for good cause orders otherwise.").

12. FED. R. CIV. P. 32(a)(6) ("If a party offers in evidence only part of a deposition, an adverse party may require the offeror to introduce other parts that in fairness should be considered with the part introduced, and any party may itself introduce any other parts.").

13. 37 C.F.R. § 42.63(a) ("Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.").

14. Objections to transcript exhibits are discussed below.

II. WHOM MAY A PARTY DEPOSE

In a civil action, a party may depose any person without leave of court.[15] A party must appear upon notice[16] and a subpoena can compel the attendance[17] of witnesses. PTAB trial practice is more limited. Uncompelled direct testimony is submitted as an affidavit[18] (or declaration[19]), and cross-examination of such testimony is allowed as "routine discovery."[20]

In one unusual example, in *Donghee America*,[21] the Board allowed a petitioner to file a sur-reply under the then-applicable trial practice guide[22] to replace a motion for observations, but indicated that the sur-reply "shall not be accompanied by any new evidence."[23] The petitioner took that to mean that it need not produce for cross-examination a witness who provided a new declaration filed with the petitioner's reply.[24] The Board explained that this was in error, that all testimony is subject to cross-examination,[25] and that the petitioner would have to make its declarant available for deposition or risk having that declaration discounted.[26]

The routine discovery cross-examination deposition is available for any declarant, not just those on substantive issues. In *Unified Patents*,[27] for example, the petitioner had submitted an exhibit styled "Petitioner's Voluntary Interrogatory Responses" concerning the identity of the real party-in-interest but which included a declaration under 28 U.S.C. § 1746[28] Despite its format, the Board deemed the exhibit to be an "affidavit within the meaning of 37 C.F.R. § 42.51(b)(1)(ii)" subjecting the declarant to cross-

15. FED. R. CIV. P. 30(a)(1) ("A party may, by oral questions, depose any person, including a party, without leave of court except as provided in Rule 30(a)(2).").

16. FED. R. CIV. P. 30(d)(1)(A)(i) (providing that the court may impose sanctions if "a party or a party's officer, director, or managing agent—or a person designated under Rule 30(b)(6) or 31(a)(4)—fails, after being served with proper notice, to appear for that person's deposition.").

17. FED. R. CIV. P. 30(a)(1) ("The deponent's attendance may be compelled by subpoena under Rule 45.").

18. 37 C.F.R. § 42.53(a) ("Uncompelled direct testimony must be submitted in the form of an affidavit.").

19. 37 C.F.R. § 42.2 ("*Affidavit* means affidavit or declaration under § 1.68 of this chapter. A transcript of an ex parte deposition or a declaration under 28 U.S.C. 1746 may be used as an affidavit."); 37 C.F.R. § 1.68 ("Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration.").

20. 37 C.F.R. 42.51(b)(1)(ii) ("Cross examination of affidavit testimony prepared for the proceeding is authorized within such time period as the Board may set.").

21. Order at 2, Donghee Am., Inc. v. Plastic Omnium Advanced Innovation & Rsch., No. IPR2017-01633, 2018 WL 4182265, at *1 (P.T.A.B. Aug. 29, 2018), Paper 27.

22. OFFICE PATENT TRIAL PRACTICE GUIDE. 83 Fed. Reg. 39,989 (Aug. 13, 2018).

23. Order at 2, *Donghee Am.*, 2018 WL 4182265, *1.

24. *Id.* at 3.

25. 37 C.F.R. § 42.51(b)(1)(ii).

26. *Id*.

27. Order at 2, Unified Patents, Inc. v. Digital Stream IP, LLC, No. IPR2016-01749, 2017 WL 2590158, at *1 (P.T.A.B. June 14, 2017), Paper No. 13.

28. *See supra* note 19; Pursuant to § 1746, an unsworn declaration under penalty of may be used whenever a matter is required or permitted to be supported by testimony or an affidavit.

examination.[29] The Board allowed the petitioner to withdraw the exhibit.[30] In another example, the Board in *Tianjin Shuangrong* concluded that a "Certification of Translation affidavit" was testimony subjecting the affiant to a cross-examination.[31]

In *Securus,*[32] the petitioner had submitted declarations from its counsel in opposition to a motion to terminate. The Board held this would subject counsel to a cross-examination deposition as routine discovery.[33] Because the petitioner refused to allow its counsel to testify, the Board expunged those declarations and refused to consider any arguments based on them.[34]

Where a single witness submits declarations in more than one PTAB proceeding, in the absence of an order consolidating the matters and limiting discovery, the witness would generally be subject to a cross-examination deposition in each proceeding.[35] The Board explained in *Samsung* that the separate proceedings were not consolidated, but instead that their scheduling orders were merely coordinated.[36]

On the other hand, the language of the regulation[37] provides for routine discovery only for affidavit testimony "prepared for the [PTAB] proceeding,"[38] which may not include all declarations filed in the proceeding. In *Medtronic*, the Board concluded that a declaration was prepared for a related district court civil action instead of the PTAB trial, and therefore did not subject the declarant to a cross-examination deposition.[39]

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29. *Id.*

30. *Id.* Patent Owner then sought to challenge the identification of the real party in interest, but in the absence of contrary evidence the Board held the statement in the Mandatory Disclosures to be sufficient. Final Written Decision, Unified Patents, Inc. v. Digital Stream IP, LLC, No. IPR2016-01749, 2018 WL 1230580, at *3 (P.T.A.B. June 14, 2017), Paper No. 13 (""In view of the foregoing, we find that the circumstances here do not raise sufficient doubt about whether Petitioner has satisfied its obligation to name all real parties-in-interest.").

31. Order at 3, Tianjin Shuangrong Paper Prod. Co., Ltd. v. Kiss Nail Prod., Inc., No. IPR2016-00371, 2016 WL 8969946, at *1 (P.T.A.B. Aug. 9, 2016), Paper No. 19 ("We agree with Patent Owner that Mr. Wang is an affiant whose testimony was prepared for the proceeding and Patent Owner is entitled to take his deposition as part of routine discovery.").

32. Order at 2, Securus Techs., Inc. v. Glob. Tel*link Corp., No. CBM2017-00034, 2017 WL 4742203, at *1 (P.T.A.B. Oct. 18, 2017), Paper No. 18.

33. *Id.* ("We agree with Patent Owner that such depositions would fall under routine discovery, and further we find that the scope of such cross examination is normally limited to the breadth of the testimony, in this case declarations, unless broadened through request of the panel.").

34. *Id.* at 3, 2017 WL 4742203, *1 ("In view of Petitioner's continued refusal to make Mr. Bragalone and Mr. Olejko available for deposition concerning their declaration testimony, we will expunge those declarations and not consider any arguments relying on those declarations.").

35. Order at 2, Samsung Elecs. Co., Ltd. v. Nucurrent, Inc., No. IPR2019-00860, 2020 WL 3965912, at *1 (P.T.A.B. July 13, 2020), Paper No. 27. ("Cross examination is ordinarily allowed in each separate proceeding as a matter of routine discovery.").

36. *Id.* at 8, 2020 WL 3965912, *2.

37. 37 C.F.R. § 42.51(b)(1)(ii) ("Cross examination of affidavit testimony **prepared for the proceeding** is authorized within such time period as the Board may set.") (emphasis added).

38. *Id*.

39. Order at 4–5, Medtronic, Inc. v. Teleflex Innovations S.à.r.l., No. IPR2020-00126, 2020 WL 7233354, at *2 (P.T.A.B. Dec. 8, 2020), Paper No. 77 ("In this case, the parties agree that the Ms. Welch's declaration is the same declaration that was prepared for and filed in the related district court litigation rather than the specific proceedings before the Board. Mot. 1; Opp. 2. Consequently, the testimony of

Of course, a party can move for the Board to order other depositions as additional discovery[40] and attendance can be compelled by subpoena[41] at such depositions. For example, the Board may allow such discovery where a technician has performed tests or prepared reports on which a testifying expert relied in their testimony.[42] But there is no assurance of getting such testimony because the Board will sometimes allow the requests for such depositions[43] but obtaining such a deposition is not guaranteed.[44]

As noted above in *Securus*,[45] where a party refuses to produce a witness for cross-examination the Board may strike the declaration and disregard the testimony (or the Board may simply give the declaration no weight) or impose other sanctions.[46] "The Board may impose an appropriate sanction — including the reasonable expenses and attorneys' fees incurred by any

Ms. Welch was prepared for another proceeding and her cross-examination in this proceeding is not "routine discovery.").

40. 37 C.F.R. § 42.51(b)(2).

41. 35 U.S.C. § 24.

42. Order at 2, 3M Company v. Westech Aerosol Corporation, No. IPR2018-00576, 2019 WL 496244, at *1 (P.T.A.B. Feb. 8, 2019), Paper No. 23 ("Mr. Banbury conducted experiments described in Exhibit 2039 titled 'Official Test Report,' which is relied upon by Patent Owner and Patent Owner's expert, Dr. Robert A. Wanat. Dr. Fisher is a signatory to Exhibit 2039 as the 'certifying manager.' Patent Owner objects as Messrs. Banbury and Fisher are not affiants and therefore not subject to routine discovery. Upon consideration of the parties' arguments, we authorized Petitioner to file a motion to conduct additional discovery.").

43. Order at 2, Amneal Pharms. LLC v. Almirall, LLC, No. IPR2019-00207, 2019 WL 5099752, at *1 (P.T.A.B. Oct. 11, 2019), Paper No.24 ("Petitioners are granted authorization to file a motion, not exceeding ten (10) pages, on or before October 18, 2019, requesting additional discovery relating to the cross-examination of Kevin S. Warner, Ph.D. and to the production of a deposition transcript of Kevin S. Warner, Ph.D. from district court litigation Almirall LLC v. Taro Pharmaceutical Industries Ltd., No. 1-17-cv-00663 (D. Del)."); Order at 3, Intel Corp. v. Tela Innovations, Inc., No. IPR2019-01228, 2020 WL 4390673, at *1 (P.T.A.B. July 30, 2020), Paper No. 48 ("Based on the arguments presented, we grant Patent Owner's request for authorization to file a motion to compel what Patent Owner characterizes as routine discovery, namely, the deposition of Dr. Christopher Auth under 37 C.F.R § 42.52, and the complete testimony of Dr. Daniel Foty.").

44. Order at 4, Lenovo Holding Co., Inc. v. Dodots Licensing Sols. LLC, No. IPR2019-01278, 2020 WL 5221762, at *2 (P.T.A.B. Sept. 1, 2020), Paper No.22 ("However, as Petitioner's technical expert is not a reply witness and no good cause has been adduced for allowing the requested deposition, we decline Patent Owner's request for leave to cross-examine Petitioner's technical expert in these proceedings.").

45. Tianjin Shuangrong, *supra* note 32, at 1.

46. Final Written Decision at 12-13, Triple Plus Ltd. v. Mordechai Ben Old, No. PGR2018-00038, 2019 WL 3856984, at *5 (P.T.A.B. Aug. 16, 2019), Paper No. 15 ("Accordingly, in light of Patent Owner's failure to participate in the proceeding by appearing for a deposition by Petitioner or otherwise, we agree that the appropriate remedy is to exclude Patent Owner's declaration, submitted as its Preliminary Response (Paper 7). Thus, to the extent we would have considered Patent Owner's declaration at this post-institution stage of the proceeding, we decline to do so."); Finale Written Decision at 22, Stride Rite Children's Grp., LLC v. Shoes by Firebug LLC, No. IPR2017-01809, 2019 WL 236242, at *10 (P.T.A.B. Jan. 16, 2019), Paper 64 ("Although Patent Owner offered to make Mr. Barcroft available for written questions, we are not persuaded that Mr. Barcroft's concerns about future career opportunities justify depriving Petitioner of the opportunity to cross-examine Mr. Barcroft in person. Accordingly, Petitioner's Motion to Strike the Barcroft Declaration is granted. Mr. Barcroft's declaration testimony is stricken from the record, and we shall accord no weight to the statements and arguments made by Patent Owner in reliance upon Mr. Barcroft's testimony.").

party — on a person who impedes, delays, or frustrates the fair examination of the witness."[47]

III. CONDUCT, SEQUENCE, AND TIMING OF CROSS-EXAMINATION DEPOSITIONS

A cross-examination deposition in a PTAB trial is different from a deposition in a civil action with regard to rules about sequence and timing. Absent a stipulation or court order, in a civil action depositions can be taken at any time after the Rule 26(f)[48] conference,[49] "methods of discovery may be used in any sequence," and "discovery by one party does not require any other party to delay its discovery."[50] Many districts have local rules about when and whether counsel can confer with a witness during discovery deposition, but practice varies between districts. In discovery depositions in district couirt "examination and cross-examination proceed as they would at trial" except for the rules about rulings on evidence and excluding witnesses.[51] Absent stipulation or order, "a deposition [in a civil action] is limited to 1 day of 7 hours."[52]

In a PTAB trial, concerning timing, a cross-examination deposition should occur after any supplemental evidence has been served and more than a week before any response in which the deposition is expected to be used.[53] A party asking to cross-examine more than one witness can specify the order of their respective examinations.[54] Like a deposition in civil litigation, examination in a PTAB trial proceeds as it would "in a trial under the Federal Rules of Evidence, except that Rule 103 (Rulings on Evidence) does not apply":[55] Unless otherwise stipulated or ordered, a cross-examination

47. PATENT TRIAL AND APPEAL BOARD, CONSOLIDATED TRIAL PRACTICE GUIDE at 92 (Nov. 2019) https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf [hereinafter Consolidated Guide], https://perma.cc/F7D2-57BK.

48. FED. R. CIV. P. 26(f).

49. FED. R. CIV. P. 26(d)(1).

50. FED. R. CIV. P. 26(d)(3).

51. FED. R. CIV. P. 30(c)(1).

52. FED. R. CIV. P. 30(d)(1).

53. *See* 37 C.F.R. § 42.53(d)(2) ("Cross-examination should ordinarily take place after any supplemental evidence relating to the direct testimony has been filed and more than a week before the filing date for any paper in which the cross-examination testimony is expected to be used."). The word "filed" appears to be in error. Supplemental evidence is only served, not filed, within ten days of and in response to the evidentiary objection, 37 C.F.R. § 42.64(b)(2), and is not filed except in response to a motion to exclude filed later in the case. 53.Order at 7, Toyota Motor Cop. Corp. v. Blitzsafe Texas, No. IPR2016-00418, 2016 WL 8969954, at *3 (P.T.A.B. Aug. 2, 2016), Paper No. 16 ("In particular, supplemental evidence is evidence served in response to an evidentiary objection and filed in response to a Motion to Exclude under 37 C.F.R. § 42.64(b)(1), (2), and is offered solely to support admissibility of the originally filed evidence and to defeat a Motion to Exclude that evidence, and not to support any argument on the merits (i.e., regarding the patentability or unpatentability of a claim).").

54. 37 C.F.R. § 42.53(d)(2).

55. CONSOLIDATED GUIDE, *supra* note 47, at 127-28 ("The examination and cross-examination of a witness proceed as they would in a trial under the Federal Rules of Evidence, except that Rule 103 (Rulings on Evidence) does not apply. After putting the witness under oath or affirmation, the officer

deposition allows seven (7) hours for cross, four (4) hours for redirect, and one (1) hour for re-cross.[56] A party can request to expand or limit the amount of time, but absent a compelling reason to do so the Board does not usually intervene, relying instead on counsel to resolve the matter.[57]

Similar to the practice under many district court local rules, the Board has also indicated that counsel should not request a break to confer with a witness while a question is pending except to discuss issues of privilege, and should not consult or confer with a witness about the substance of the witness's testimony:

6. 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.

7. An attorney for a witness shall not initiate a private conference with the witness or call for a break in the proceedings while a question is pending, except for the purpose of determining whether a privilege should be asserted.[58]

However, counsel is permitted to confer with the witness between cross-examination and re-direct.[59] The Board has explained:

"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,

must record the testimony by audio, audiovisual, or stenographic means. Testimony must be recorded by the officer personally, or by a person acting in the presence and under direction of the officer.").

56. 37 C.F.R. § 42.53(c)(2); CONSOLIDATED GUIDE, *supra* note 47, at 129 ("Unless otherwise agreed by the parties or ordered by the Board, the testimony is limited in duration to the times set forth in 37 C.F.R. § 42.53(c). The Board may allow additional time if needed to examine the witness fairly or if the witness, another person, or any other circumstance impedes or delays the examination.").

57. *See* Order at 2, Netflix, Inc. v. Divx, LLC, No. IPR2020-00558, 2021 WL 1158199, at *1 (P.T.A.B. Mar. 26, 2021), Paper No. 34 ("In particular, the panel does not find that Petitioner established a sufficient basis to require modification of the time constraints set forth in § 42.53(c)(2). The panel leaves to the parties to jointly select a date for the deposition, with the understanding that it should be limited to the declaration testimony (Ex. 1031).").

58. CONSOLIDATED GUIDE, *supra* note 47, at 129.

59. Order at 3, Google, Inc. v. Jongerius Panoramic Techs., LLC, No. IPR2013-00191 (P.T.A.B. Feb. 6, 2014), Paper No. 48 ("[C]ounsel was permitted to confer with the witness before redirect examination begins.").

during the time frame between conclusion of cross-examination and start of re-cross.[60]

The Board also provides for counsel to call the Board to request assistance if needed during a deposition:

At any time during the testimony, the witness or a party may move to terminate or limit the testimony on the ground that it is being conducted in bad faith or in a manner that unreasonably annoys, embarrasses, or oppresses the witness or party. The witness or party must promptly initiate a conference call with the Board to discuss the proposed motion. 37 C.F.R. § 42.20(b). If the objecting witness or party so demands, the testimony must be suspended for the time necessary to obtain a ruling from the Board, except as the Board may otherwise order.[61]

The Board has also noted when counsel did not avail themselves of this option and sought to raise the issue later, and declined that counsel's requested relief.[62]

IV. SCOPE OF EXAMINATION

Cross-examination depositions in a PTAB trial also differ from discovery depositions in a civil action in the permissible scope of the examination. The scope of discovery in civil litigation encompasses any non-privileged material relevant to claims or defenses and proportionate to the needs of the case[63] and is generally not limited by prior testimony or disclosures.

In a PTAB trial, in contrast, the scope of a cross-examination deposition is limited to the scope and content of the direct testimony.[64] Upon timely objection and a successful motion to exclude, the Board can exclude testimony outside the proper scope,[65] but an instruction not to answer on that

60. Order at 3, Focal Therapeutics, Inc. v. SenoRx, Inc., No. IPR2014-00116, 2014 WL 12892710, at *1 (P.T.A.B. July 21, 2014), Paper No. 19 (designated prceedential).

61. CONSOLIDATED GUIDE, *supra* note 47, at 130.

62. Beckman Coulter, Inc. v. Sysmex Corp., No. IPR2020-01503, 2022 WL 557727, at *15 (P.T.A.B. Feb. 18, 2022) ("Despite Patent Owner's concerns regarding the propriety of Petitioner's counsel's objections, Patent Owner did not avail itself of this option during Mr. Roche's deposition.").

63. FED. R. CIV. P. 26(b)(1) ("Unless otherwise limited by court order, the scope of discovery is as follows: Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit. Information within this scope of discovery need not be admissible in evidence to be discoverable.").

64. 37 C.F.R. § 42.53(d)(5)(ii) ("For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.").

65. Final Written Decision at 158, Eli Lily & Co. v. Teva Pharms. Int'l Gmbh, No. IPR2018-01710, 2020 WL 1540364, at *67 (P.T.A.B. Mar. 31, 2020), Paper No. 69, ("Upon review of the Ferrari Declaration, Exhibit 2268, we agree that questions on cyclic AMP were beyond the scope of the Ferrari Declaration. Accordingly, we grant this aspect of the motion.").

basis is improper.[66] The questioner is also permitted to explore the underlying basis of any opinions expressed as being fairly within the scope of direct.[67]

V. EXHIBITS

The handling of exhibits also differs between a civil action discovery deposition and a PTAB cross-examination deposition. In a civil action, depositions and the exhibits to testimony are not filed[68] until they are used at trial, and objections to admissibility are made and ruled on at that time.[69] In a PTAB trial cross-examination, objections to "deposition evidence" must be made during the deposition.[70] It is not entirely clear whether exhibits used during a deposition are "deposition evidence," or whether they can be objected to as "other evidence" when filed as exhibits in support of a paper.[71] The safer course of action is to object early and often, stating any objections relating to, e.g., foundation, authentication, hearsay, etc. on the record during the deposition and renewing those objections if and when the exhibit is filed. For depositions before a sur-reply on new direct testimony submitted with a replyu, an objection to the use of new exhibits (other than testimony itself) in a sur-reply can be made if and when the exhibit is filed,[72] but could also be made during the deposition.

66. Order at 2, Corning Inc. v. DSM IP Assets B.V., No. IPR2013-00043, 2013 WL 11254595, at *1 (P.T.A.B. July 8, 2013), Paper No. 31 ("DSM objected to Corning's instruction to the witness not to answer several questions that Corning felt were outside the scope of the expert's deposition and thus not relevant to the proceedings. We agree with DSM that Corning's instructions to the witness were improper.").

67. Order at 5, Mylan Pharms. Inc. v. Qualicaps Co., Ltd., No. IPR2017-00203, 2017 WL 3668922, at *2 (P.T.A.B. Aug. 23, 2017), Paper No. 35 ("Petitioner is entitled to cross-examine Mr. Tanjoh with regard to the experiments, data, and statements in Mr. Tanjoh's Declaration, particularly regarding the criticality of the boundaries for combined methoxyl group and hydroxypropoxyl group content. Mot. 4.").

68. FED. R. CIV. P. 5(d)(1)(A) ("But disclosures under Rule 26(a)(1) or (2) and the following discovery requests and responses must not be filed until they are used in the proceeding or the court orders filing: depositions, interrogatories, requests for documents or tangible things or to permit entry onto land, and requests for admission.").

69. FED. R. EVID. 103.

70. 37 C.F.R. § 42.64(a) ("An objection to the admissibility of deposition evidence must be made during the deposition. Evidence to cure the objection must be provided during the deposition, unless the parties to the deposition stipulate otherwise on the deposition record.").

71. *Cf.* 37 C.F.R. § 42.64(a) *with* 37 C.F.R. § 42.64(b).

72. Final Written Decision at 34-35, Netflix, Inc. v. Divx, LLC, No. IPR2020-00558, 2021 WL 3729361, at *13 (P.T.A.B. Aug. 23, 2021), Paper 50 ("In light of the procedures set forth above and the facts presented here, it would not make sense to require Petitioner to raise an objection under Rule 42.23(b) during Dr. McDaniel's second deposition. Specifically, this portion of Rule 42.23(b) specifies what evidence may and may not accompany a Sur-reply. Dr. McDaniel's second deposition was held on April 5, 2021 (Ex. 2026, 1), and Patent Owner filed Exhibit 2025 with its Sur-reply on April 21, 2021. To find as Patent Owner requests, Petitioner would be required to object to Patent Owner filing the exhibit before Patent Owner actually filed the exhibit. That would not make sense. Accordingly, we determine that Petitioner was not required to object to Patent Owner's filing before Patent Owner filed. Thus, the objection was not waived.").

VI. OBJECTIONS

PTAB cross-examination depositions also differ from civil action discovery depositions in the need to make objections to questions. In a civil action discovery deposition, objections to form are waived if not made during the deposition,[73] but other objections to competence, relevance, materiality, or questions of admissibility including hearsay are not waived and are instead made in connection with use at trial, such as in preparing the pretrial order.[74] In contrast, in PTAB cross-examination depositions, objections are **not** preserved, and must be made on the record during the deposition. [75]

The testimonial guidelines from the Board specifically prohibit coaching the witness with speaking objections.[76] Those guidelines also reiterate that an objection should not prevent the witness from answering — the examination should proceed, with testimony taken pursuant to the objections, [77] and that objections must be succinct and specific, limited to a single word or phrase. [78] The Board prohibits instructions not to answer except to preserve privilege[79] and may order the deposition be resumed.[80]

73. FED. R. CIV. P. 32(d)(3)(B) (providing objections are waived when not made during the deposition if "it relates to the manner of taking the deposition, the form of a question or answer, the oath or affirmation, a party's conduct, or other matters that might have been corrected at that time.").

74. *See* FED. R. CIV. P. 32(d)(3)(A).

75. *See* 37 C.F.R. § 42.53(f)(8) ("Any objection to the content, form, or manner of taking the deposition, including the qualifications of the officer, is waived unless made on the record during the deposition and preserved in a timely filed motion to exclude.").

76. CONSOLIDATED GUIDE, *supra* note 47, at 127 ("Consistent with the policy expressed in Rule 1 of the Federal Rules of Civil Procedure, and corresponding 37 C.F.R. § 42.1(b), unnecessary objections, 'speaking' objections, and coaching of witnesses in proceedings before the Board are strictly prohibited. Cross-examination testimony should be a question and answer conversation between the examining lawyer and the witness. The defending lawyer must not act as an intermediary, interpreting questions, deciding which questions the witness should answer, and helping the witness formulate answers while testifying.").

77. *Id.* at 128 ("An objection at the time of the examination—whether to evidence, to a party's conduct, to the officer's qualifications, to the manner of taking the testimony, or any aspect of the testimony—must be noted on the record, but the examination still proceeds; testimony is taken subject to any such objection.").

78. *Id.* ("An objection must be stated concisely in a non-argumentative and non-suggestive manner. Counsel must not make objections or statements that suggest an answer to a witness. Objections should be limited to a single word or term. Examples of objections that would be properly stated are: 'Objection, form'; 'Objection, hearsay'; 'Objection, relevance'; and 'Objection, foundation.' Examples of objections that would not be proper are: 'Objection, I don't understand the question'; 'Objection, vague'; 'Objection, take your time answering the question'; and 'Objection, look at the document before you answer.' An objecting party must give a clear and concise explanation of an objection if requested by the party taking the testimony or the objection is waived.").

79. *Id.* at 129. ("Counsel may instruct a witness not to answer only when necessary to preserve a privilege, to enforce a limitation ordered by the Board, or to present a motion to terminate or limit the testimony.").

80. Order at 7, Microsoft Corp. v. Directstream LLC, No. IPR2018-01594, 2019 WL 6999870, at *3 (P.T.A.B. Nov. 13, 2019), Paper No. 48 ("For the foregoing reasons, we order Patent Owner to produce Mr. Huppenthal for additional cross-examination. Petitioner does not specify in the Motion how much deposition time is requested. However, in view of Petitioner's identification in the Motion of instances of instructions not to answer, we determine one hour of deposition time is sufficient.").

VII. CONCLUSION

Having reviewed some of the regulations, guidelines, and cases concerning cross-examination depositions, let us conclude with a few practical suggestions. A principle goal of a discovery deposition in litigation is to avoid later surprises with trial testimony and elicit testimony that can be used for impeachment if the story changes later. In general, that is not a goal for a cross-examinatoin deposition in a PTAB trial, because this proceeding is the trial testimony itself, not merely a preview. The goal here is not to explore potential testimony, but instead only to elicit important admissions. This can also be a goal in discovery deposition, but it is more often reserved for cross-examinatoin at trial to limit the witness's opportunity to recover or explain away the admission before it goes into evidence. The practitioner should treat the questions not like a discovery deposition, but like cross-examination at trial live and in open court.

Establish and maintain control. The Board's guidelines say that examination is a "conversation,"[81] but it should be a one-sided conversation with you in control. Focus only on the specific points you want to cite in your next paper.

Always ask leading questions. Maintain tight control of the transcript. Don't invite the witness to elaborate or fill in gaps with an open-ended response.

Ask tight questions limited to one or two facts. Don't give the witness room to disagree on unimportant details. Focus on just those facts that help with your case and hurt your opponent's case

Try to frame questions that can be answered "yes" or "no." This is another aspect of maintaining control and discouraging the witness from elaborating. If possible, it is best if the answer could be answered "yes" or "no" and neither answer is good for the witness.

Ask only questions to which you know the answer. You do not want to be surprised by an answer or have the witness introduce something omitted in direct testimony that is helpful to the opponent's case. Ideally, you should know the answer, and have documentary evidence that would force the witness to agree or impeach the witness's credibility.

Do not rehash the direct except to set up impeachment. The direct testimony is the other side's case. There should be no need to use time repeating it, such as by going over an expert's background. If you want to ask about some gap in the background or deficiency in the expert's qualifications to diminish the weight afforded that expert's testimony or to support of a motion to exclude,[82] you do not generally need to have him

81. CONSOLIDATED GUIDE, *supra* note 47, at 127 ("Cross-examination testimony should be a question and answer conversation between the examining lawyer and the witness.").

82. The Board in principal applies FED. R. EVID. 702 concerning expert qualification (*see generally* CONSOLIDATED GUIDE, *supra* note 47, at 34-36; Kumho Tire Co. v. Carmichael, 526 U.S. 137 (1999);

repeat the parts you are not challenging. One exception is for impeachment—here, you may want to direct the witness to the specific part of his direct testimony and have him recommit to that before completing the impeachment.

Do not try to elicit the witness's full story to limit later testimony. This technique is specifically for a discovery deposition and is of little if any use in cross-examination. In discovery, you may want to confirm what the witness does not know or the limits of their recollection or analysis, so that you can use that for impeachment if they try to go beyond those limits in testimony at trial. Here, however, the witness has already provided their direct testimony. You don't need to limit it. In some situations, the witness may have an opportunity to provide a second declaration with rebuttal testimony later, but even there carefully consider whether it is even possible to set up an impeachment that will be effective and persuasive to the Board by asking questions beforehand about that testimony that has not happened yet.

* * *

The art of cross-examination is a performance meant to persuade. In a PTAB trial, that performance will be reduced to a written transcript. Decide what you need that transcript to say when you file it with the Board, and then carefully frame your questions to elicit only that information. The extra time spent in preparation will produce a far better work product to use in support of the next paper your file.

Daubert v. Merrell Dow Pharmaceuticals, 509 U.S. 579 (1993)), but in practice the Board usually declines to exclude such testimony and treats suich challenges as going to the weight, not the admissibility, of the evidence. *See, e.g.*, Ty Inc. v. Softbelly's, Inc., IPR2020-00689, Paper 43 at 45-46 (PTAB Sept. 10, 2021); MindGeek, s.a.r.l. v. Skky Inc., IPR2014-01236, Paper 45 at 23 (PTAB January 29, 2016); AVX Corp. v. Greatbatch, Ltd., IPR2014-00697, Paper 57 at 25-26 (PTAB October 21, 2015).