FOLEY

FOLEY & LARDNER LLP

Vice Chief APJ Scott R. Boalick
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
Via Electronic Mail to: TrialsRFC2014@uspto.gov

October 16, 2014

Re: Comments on "Request for Comments on Trial Proceedings Under the American Invents Act Before the Patent Trial and Appeal Board," Federal Register Vol. 79, No. 124, June 27, 2014.

Dear Vice Chief Boalick:

The undersigned attorneys of Foley & Lardner LLP's post-grant trials practice group appreciate the opportunity to provide comments in response to the captioned Federal Register notice.

The undersigned represent both patent owners and petitioners in AIA trials, and do not intend to take any position that would favor one side over the other. Rather, these comments are intended to be neutral as to patent owners and petitioners, and to improve the overall functioning of AIA trials. These comments reflect the views of the undersigned individuals and are not necessarily the views of the firm or its clients.

Our comments are directed to the following questions.

17. General—What other changes can and should be made in AIA trials?

a. Rehearing requests involving an intra-Board conflict

Proposal: If a rehearing request contains a certification, similar to counsel's statement in a petition for rehearing *en banc* under Federal Circuit Rule 35(b), that the panel decision is contrary to a prior Board or court decision on a particular issue, then the rehearing request shall be decided by an expanded panel, including at least one Lead Judge, and shall be reviewed de novo as to that issue. In the absence of such a certification, the rehearing request shall be handled under existing Board practice.

Explanation: The Board's current rehearing practice, which has the original panel review its own decision for an "abuse of discretion," means that conflicting panel decisions on issues such as statutory interpretation or rules of practice will not be resolved on rehearing, absent a mechanism to request an expanded panel to review the decision for correctness. In such cases, the movant should be required to file a statement, similar to that in a petition for rehearing en banc under Federal Circuit Rule 35(b)(2), which specifically identifies the conflicting Board or court decision.

b. Amendment to Rule 42.52(d)(2)

Proposal: Amend Rule 42.52(d)(2) as follows: Cross-examination should ordinarily take place after any supplemental evidence relating to the direct testimony has been [[filed]] served and more than a week before the filing date for any paper in which the cross-examination testimony is expected to be used.

Explanation: This change is necessary because supplemental evidence is "served" under § 42.64(b)(2) and is not "filed" until after a motion to exclude has been filed (Due Date 4), which occurs well after most depositions have taken place.

c. Amendment to Rule 42.53(d)(4)

Proposal: Amend Rule 42.53(d)(4) as follows: The party seeking the deposition must file a notice of the deposition before the later of: (A) ~~at least~~ ten business days before ~~a~~ the deposition, or (B) two business days after the parties have agreed on the time and place of the deposition.

Explanation: In practice, parties typically agree on the time and place of the deposition, as required by Rule 42.53(d)(1); however, such agreement often does not happen more than 10 business days before the deposition. While parties routinely agree to waive the requirements of Rule 42.53(d)(4), a party could attempt to use this rule to prevent a deposition from occurring. Resolving such a dispute would not be an efficient or worthwhile use of the Board's time. In practice, the 10-day period does not facilitate the scheduling of depositions, and likely only leads to unnecessary disputes that the Board must resolve.

d. Clarification of Rule 42.64(a)

The undersigned respectfully request that the Board clarify under what circumstances counsel may pose a "beyond the scope" objection during a deposition and to what extent, if any, the deponent may avoid answering the question. The reason for this request is that, in practice, "beyond the scope" objections often appear to trigger a response from the deponent that the issue has not been considered and that the deponent cannot answer the question without further consideration. Such occurrences inhibit the ability of the party seeking cross examination to explore alternate theories or other avenues by which a deponent's direct testimony might be questioned or tested, which is a key tenet of cross examination. In addition, "beyond the scope" objections are rarely, if ever, raised in a subsequent motion to exclude.

e. Clarification of Rule 42.53(g)

The undersigned respectfully request guidance from the Board regarding Rule 42.53(g) as to which party should bear the cost of providing a court reporter when a deposition is sought in order to cross examine a witness who has previously submitted direct testimony via an affidavit.

f. Amendment to Rule 42.63(d)(2)(i)

Proposal: Amend Rule 42.63(d)(2)(i) as follows: Each page must be uniquely numbered in sequence if page or column/line numbering is not already present and clearly discernible on every page of the original document.

Explanation: The purpose of this proposed amendment is to prevent confusing markings on a document submitted as evidence. Most documents submitted as exhibits already contain clear page or column/line numbering, and the practice of adding additional page numbering to such documents (e.g., starting with "0001") adds a second set of numbering that rarely provides additional clarity. Instead, in practice, a second set of page numbers often leads to confusion as to which set of page numbers is being referred to, especially, for example, when a witness is being questioned about a given document during a deposition. It would be more efficient and would promote clarity in the record to only require that page numbers be added to documents that do not already contain clearly discernible page or column/line numbering.

g. Amendment to Testimony Guideline *#6*

Proposal: Amend *Testimony Guideline* #6 as follows: Once the cross-examination of a witness has commenced, and until ~~cross-examination~~ the deposition 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.

Explanation: Some Board panels have interpreted the foregoing Testimony Guideline to permit a party to confer with its witness during the period between cross-examination and re-direct (and, indeed, during every break during re-direct). This interpretation encourages re-direct in every deposition and effectively permits a party to rehearse its questions-and-answers on re-direct with it expert, which frustrates rather than promotes the goal of securing just, speedy, and inexpensive trials.

The undersigned sincerely thank the USPTO for considering these comments and would welcome any further dialogue or opportunity to support the USPTO in improving the overall functioning of the AIA trials.

Sincerely,

George E. Quillin

Andrew S. Baluch

Michael R. Houston