

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 29

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

VICTOR BRONSHTEIN,

Junior Party,
(Patent 5,766,520),

v.

BRUCE ROSER and ENDA MARTIN GRIBBON,

Senior Party
(Application 08/923,783).

Patent Interference 104,727 (McK)

ORDER AUTHORIZING CROSS-EXAMINATION IN ENGLAND

A. Introduction

Following a conference call on 12 October 2001, Roser has filed an unopposed miscellaneous motion (Paper 27) seeking leave to take cross-examination of Professor Geoffrey Lee in London, England. Prof. Lee's testimony is relied upon by Roser, inter alia, in connection with Roser's opposition to be filed with respect to Bronshtein preliminary motion for judgment alleging no interference-in-fact (Paper 22).

B. Applicable regulations

The rules give the board discretion to authorize cross-examination testimony to be taken in a foreign country. 37 CFR § 1.672(i). Subsection (i) of Rule 672 reads as follows:

(i) In an unusual circumstance and upon a showing that testimony cannot be taken in accordance with the provisions of this subpart, an administrative patent judge upon motion (§ 1.635) may authorize testimony to be taken in another manner.

The rules also proscribe the conditions which must be satisfied to avoid testimony taken in a foreign country from being given little, if any, weight. 37 CFR § 1.671(j).

Subsection (j) of Rule 671 reads as follows (emphasis added) :

(j) The weight to be given deposition testimony taken in a foreign country will be determined in view of all the circumstances, including the laws of the foreign country governing the testimony. Little, if any, weight may be given to deposition testimony taken in a foreign country unless the party taking the testimony proves by clear and convincing evidence, as a matter of fact, that knowingly giving false testimony in that country in connection with an interference proceeding in the United States Patent and Trademark Office is punishable under the laws of that country and that the punishment in that country for such false testimony is comparable to or greater than the punishment for perjury committed in the United States. The *** Board, in determining foreign law, may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence.

C. Discussion

A decision as to whether to allow cross-examination to proceed in a foreign country is made on a case-by-case basis. The general rule is that all cross-examination take place within the United States. 37 CFR § 1.671(d). However, as noted above, the board may exercise its discretion to permit cross-examination to take place outside the United States. The following paragraphs provide a discussion as to why discretion in this case is being exercised to permit Prof. Lee to be cross-examined in London, England, on 26 October 2001.

1.

Counsel for Roser represents that there exists at this time an "uncertain political situation" (Paper 28, page 2). While there is no evidence in the record to support of counsel's representation, official notice (37 CFR § 1.671(b) and Fed. R. Evid. 201) is taken of the fact that at this time individuals have become concerned about air travel within the United States since (1) the terrorist attacks on the World Trade Center in New York City and the Pentagon in Arlington, Virginia on 11 September 2001 and (2) the recent commencement of military-type action in Afghanistan.

2.

Prof. Lee is believed to be a subject of Great Britain and a resident of Germany. Hence, this is not a case where the witness is a citizen of the United States residing abroad.

3.

During the conference call, counsel for Roser represented that Prof. Lee's family did not want him to travel to the United States via airplane. In this respect, it will be noted that Roser had retained Prof. Lee and submitted his affidavit prior to 11 September 2001. Hence, this is not a case where a party has knowingly retained an expert-type witness knowing that the witness might not want to travel to the United States.

4.

Counsel for Bronshtein indicated during the conference call that there was no objection on the part of Bronshtein or counsel for Bronshtein to have counsel travel to London, England, for a cross-examination deposition of Prof. Lee. Hence, this is not a case where an opponent objects to travel to a foreign country to effect cross-examination.

5.

Counsel for Roser represented, and counsel for Bronshtein agreed, that Roser would pay the excess cost (i.e., air travel and per diem) for two of Bronshtein's counsel to travel to London, England. Hence, this is not a case where an opponent will have to pay expenses to travel to a foreign country.

6.

Counsel for Roser understood that as a condition precedent to any deposition testimony being given any weight that Roser (not Bronshtein) would have to comply with the requirements of 37 CFR § 1.671(j). Ordinarily, the board would require a party

to make out its case under Rule 1.671(j) **prior** to authorizing any cross-examination deposition in a foreign country. In this case, however, the board is reasonably certain that the law, jurisprudence and nature of judicial proceedings of England (much of which has been adopted in the United States) and the United States, that the proof required by Rule 671(j) are highly likely to be similar. Accordingly, Roser reasonably could be expected to be able to successfully present the needed proof shortly after Prof. Lee's deposition is concluded. It bears noting at this point that in this particular interference, Bronshtein's preliminary motion alleging no interference-in-fact is being handled on an expedited basis. The needed proof required by Rule 671(j) may be any appropriate proof. As discussed during the conference call, the proof may be in the form of an affidavit of a person knowledgeable with the laws of England. Any affidavit should include copies of any Statutes of England, applicable English court rules, and any precedent of English courts upon which the affidavit relies; in other words, an affidavit based solely on an opinion of an attorney is not likely to be accorded much weight. Cf. § 42 of the STANDING ORDER (Paper 2). To the extent Roser may elect to rely on an affidavit, it should be prepared, filed and served on Bronshtein in such a manner that Bronshtein would have, if it chose, an opportunity to cross-examine any affiant at the same time cross-examination of Prof. Lee is to take place.

7. The parties agreed to conduct cross-examination in England on 26 October 2001 at a time when I can participate via telephone and thereby hear testimony. Roser is responsible for having a speaker phone at the location of the deposition and for placing a telephone call to the board at the time the deposition begins. On 26 October 2001, I will be in the office no later than 6:30 a.m. and would suggest that any cross-examination deposition begin after 7:00 a.m. (Eastern Time in the U.S.). Prior to leaving for England, Bronshtein shall file under seal and ex parte a copy of any document it may use to cross-examine Prof. Lee so that I can have a copy of any document handed to Prof. Lee. Counsel should advise the board of the time when cross-examination is to begin. A copy of any document may be made available given to counsel for Roser and Prof. Lee during cross-examination.

8.

Roser must file a copy of Prof. Lee's affidavit (and any exhibits relied upon therein) prior to leaving for England so that it will be available at the board during cross-examination.

Order

Upon consideration of Roser Unopposed Miscellaneous Motion for permit cross-examination of Prof. Lee to take place in London, England, on 26 October 2001, and for the reasons given, it is

ORDERED that the motion is granted subject to the conditions set out herein.

Fred E. McKelvey
Senior Administrative Patent Judge

15 October 2001
Arlington, VA

cc (via fax):

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