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Counsel are Permitted to Confer with Witness Before Redirect: Focal Therapeutics, Inc. v. Senorx, Inc., IPR2014-00116, Paper 19 (PTAB July 21, 2014) (precedential)

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On July 10, 2019, the PTAB's Precedential Opinion Panel designated *Focal Therapeutics, Inc. v. Senorx, Inc.*, IPR2014-00116, Paper 19 (PTAB July 21, 2014), as precedential. By way of background, during PTAB proceedings, direct testimony is typically provided by way of declarations. The other party may then obtain cross-examination testimony of the declarant witness by way of a deposition. Once initial cross-examination has completed, redirect of the witness is permitted, followed by optional re-cross, which is limited to the scope of testimony on redirect.

In *Focal Therapeutics*, Patent Owner sought clarification concerning Appendix D of the PTAB's Trial Practice Guide, which indicates, in relevant part:

> 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.

Specifically, Patent Owner requested clarification as to whether cross-examination of a witness "has concluded" at the end of the initial cross-examination, or whether it concludes at the end of the deposition itself, as is commonly the case in depositions related to district court litigation. In response, the Board indicated that cross-examination is considered concluded after the initial cross-examination has been completed, i.e., before redirect. The Board went on to state that "counsel is 'permitted to confer with the witness before redirect examination begins.'" (quoting *Google Inc. and Apple Inc. v. Jongerius Panoramic tech.*, LLC, IPR2013-00191, Paper 48, 3 (PTAB, Feb. 6, 2014)).

The decision may come as a surprise to many, especially those familiar with district court deposition procedure. It also re-emphasizes the importance of retaining counsel for patent challenges before the PTAB who are highly experienced with the nuances of PTAB practice.