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Paper 28
Entered: June 3, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MURRAY & POOLE ENTERPRISES LTD.,
Petitioner,

v.

INSTITUT DE CARDIOLOGIE DE MONTREAL,
Patent Owner.

IPR2023-01064
Patent 11,400,063 B2

Before ULRIKE W. JENKS and SHERIDAN K. SNEDDEN,
Administrative Patent Judges.

JENKS, *Administrative Patent Judge*.

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

On May 30, 2024, a conference call was held in the above-referenced proceedings regarding a dispute between the parties with respect to the deposition of Dr. Bouabdallaoui *or* for Petitioner's request authorization to file a motion for strike. Present on the call were counsel for the parties and Judges Jenks and Snedden.[1] This Order provides a summary of the issues presented and guidance provided.

1. Deposition of Dr. Bouabdallaoui

Discovery is available for the deposition of witnesses submitting affidavits or declarations and for what is otherwise necessary in the interest of justice. 35 U.S.C. § 316(a)(5). Cross–examination of affidavit testimony prepared for the proceeding falls under "routine discovery." 37 C.F.R. § 42.51(b)(1)(ii) ("Cross examination of affidavit testimony prepared for the proceeding is authorized . . . ."). In this case, Patent Owner presented the declaration of Dr. Bouabdallaoui (Ex. 2068) to support its position that the Bouabdallaoui reference (Ex. 1005) is not available as prior art. *See* Paper 21, 14 ("PO Resp."). As Dr. Bouabdallaoui's declaration was prepared for this specific proceeding, it falls under routine discovery, and thus, Petitioner is entitled, as routine discovery, to test Dr. Bouabdallaoui's statements through cross-examination. We note further that, in general, parties are required to make witnesses available for depositions in the United States and the deposition can take up to 7 hours. *See* 37 C.F.R. § 42.53(b)(2), (c).

[1] A court report was present on the conference call as well and the party responsible for the court reporter agreed to file a copy as an exhibit when available.

The parties' disagreement concerns the time allotted for taking Dr. Bouabdallaoui's deposition. Petitioner requests that they be given 5 hours for the deposition, which we note is already two hours less than the 7 hours allotted for the deposition under our rules. Petitioner has also agreed to travel to Montreal, Canada for the deposition to minimize Dr. Bouabdallaoui's time commitment. In addition, Dr. Bouabdallaoui is a native French speaker and requests the use of an interpreter for the deposition.[2] Petitioner contends that the use of an interpreter will naturally slow down the deposition and, therefore, they request to be given 5 hours for the deposition.

Patent Owner opposes and requests that we limit the deposition to 3 hours because Dr. Bouabdallaoui has agreed to 3 hours, is a very busy doctor, and cannot easily spend time away from her duties.

We recognize that that Dr. Bouabdallaoui is an affiant whose testimony was prepared for the proceeding and Petitioner is entitled to take her deposition as part of routine discovery. Accordingly, while this deposition may pose logistical challenges for the parties, we look to the parties to work together to meet those challenges, especially in view of the considerable and reasonable concessions Petitioner has already made in order to conduct Dr. Bouabdallaoui's deposition.

We remind the Patent Owner that, as the proponent of the testimony, if Dr. Bouabdallaoui is not made available for the deposition, Patent Owner

[2] By notifying us that an interpreter will be needed, the requirement of 37 C.F.R § 42.53(e) is met. We direct the parties to the guidelines for foreign language depositions set forth in *Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, Paper 55 (PTAB Aug. 7, 2013).

runs the risk that the direct testimony will not be considered or that the weight given to her declaration will be minimal. We have broad discretion to assign weight to be accorded expert testimony. *Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010). That Dr. Bouabdallaoui's testimony was only of limited scope, or even if outside the merits of this proceeding, does not remove the witnesses from the scope of routine discovery. *TD Ameritrade Holding Corp. et al. v. Trading Techs. Int'l, Inc*., Case CBM2014–00131, slip op. at 2–3 (PTAB Jan. 22, 2015) (Paper 27).

2. Motion to Strike

With regard to motions to strike, the Consolidated Trial Practice Guide[3] provides the option to request authorization to file a motion "[i]f a party believes that a brief filed by the opposing party raises new issues, is accompanied by belatedly presented evidence, or otherwise exceeds the proper scope of reply or sur-reply." Practice Guide 80. Specifically, the Practice Guide addresses the distinct applicability of these two alternatives:

> A motion to strike may be appropriate when a party believes the Board should disregard arguments or late-filed evidence in its entirety, whereas further briefing may be more appropriate when the party wishes to address the proper weight the Board should give to the arguments or evidence. In most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply. As such, striking the entirety

[3] Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) ("Consolidated Trial Practice Guide" or "CPTG"), available at http://www.uspto.gov/sites/default/files/documents/tpgnov.pdf.

> or a portion of a party's brief is an exceptional remedy that the Board expects will be granted rarely.

Id. at 80–81.

First, as discussed above, we advised the parties that the Bouabdallaoui Declaration is testimonial evidence and that we would consider whether Dr. Bouabdallaoui was made available for cross-examination when considering the evidence.

Second, in the absence of appropriate cross-examination, the sur-reply is the appropriate vehicle for Petitioner "to address the proper weight the Board should give to the arguments or evidence." *Id*. at 80. Accordingly, taken together, we see no good cause to grant the rare remedy of striking the evidence and argument related to the Bouabdallaoui Declaration.

Accordingly, it is:

ORDERED that Petitioner's request for authorization to file a motion to strike is *denied.*

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