

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., MEDTRONIC VASCULAR, INC., AND
MEDTRONIC COREVALVE, LLC,
Petitioner,

v.

TROY R. NORRED, M.D.,
Patent Owner.

Case IPR21014-00110 and
IPR2014-00111¹
Patent 6,482,228 B1

Before SHERIDAN K. SNEDDEN, BARRY L. GROSSMAN, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

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

A conference call was conducted on October 7, 2014, during which counsel for Petitioner, Mr. Barufka, and counsel for Patent Owner, Mr. Marcus, appeared before Administrative Patent Judges Weatherly, Grossman, and Snedden. Petitioner initiated the call to obtain guidance

¹ We use this caption in this paper to indicate that this Order is to be entered in both trials. Nevertheless, the parties are not authorized to use this caption.

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regarding the form in which Patent Owner's counsel was interposing objections to questions that were occurring during a deposition of an expert witness who appeared on behalf of Patent Owner. More specifically, Petitioner contended that Patent Owner's objections were improper "speaking objections" as that term is used in the Office Patent Trial Practice Guide. The Office Patent Trial Practice Guide sets forth the standards by which the propriety of objections to questions during depositions are measured as follows:

Consistent with the policy expressed in Rule 1 of the Federal Rules of Civil Procedure, and corresponding § 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.

* * *

3. 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.

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Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,772 (Aug. 14, 2012).

The court reporter at the deposition read back a portion of the transcript reflecting one example of Patent Owner's objections to a question posed by Petitioner. Petitioner represented that the exemplary objection was representative of a number of objections interposed by Patent Owner and asked for an order preventing further interference with the deposition. The exemplary objection began, "Objection, misleading . . ." and then went on to explain at some length that the question was misleading because it asked for a conclusion from the witness based on only a portion of a patent that Patent Owner contends was "taken out of context."

We agree with Petitioner that the exemplary objection was improper under the guidelines set forth in the Practice Guide. We instructed Patent Owner's counsel that the exemplary objection and those like them were improper and ordered Patent Owner's counsel to cease such objections in the future. We also instructed Patent Owner's counsel on the proper form of objections to questions during deposition proceedings before the Board. We cautioned Patent Owner's counsel that further violations of the standards set forth in the Practice Guide may warrant sanctions including, but not limited to, exclusion of the primary declaration testimony from the witness being deposed.

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ORDER

For the reasons given, it is:

ORDERED that Patent Owner's counsel stop interposing objections that include argument or suggest answers to the witness according to the standards set forth in the Practice Guide as referenced above.

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