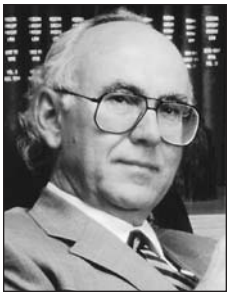
Videotaping Interference Testimony



BY CHARLES L. GHOLZ[1]

INTRODUCTION

In Winner Int'l Royalty Corp. v. Wang, 202 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir. 2000) (opinion by Circuit Judge Michel for a panel that also consisted of Circuit Judges Rader and Gajarsa), a panel of the court erroneously asserted that "in no case is live testimony given before the Board, which would allow the Board to observe demeanor, to hear the witnesses rebut one another's testimony in response to questioning from the parties and the judges, and then to determine credibility."[2] At that time, I pointed out (1) that Winner (which I represented) had not made that argument[3] and (2) that the panel's assertion was "not right"[4] because:

> In the first place, one can submit video depositions, and they are actually more useful than live testimony if one really believes that a judge can tell whether a witness is lying by observing the witness's demeanor, since the judge can stop the video, zoom in on the witness's upper lip (to see if beads of sweat have formed), etc. In the second place, the APJs have taken actual live testimony in a hearing room at the board on at least one occasion—and I think that they will do that more often in the future.[5]

Since then, the APJs on the Trial Section have continued to "take[ ] actual live testimony in a hearing room at the board" from time to time, but it must be conceded that they don't do so very often. On the other hand, while I had videotaped interference testimony[6] from time to time without objection, I now have an opinion (unfortunately, a non-precedential opinion) from APJ Michael Tierney specifically authorizing the videotaping of testimony over my opponent's bitter objection.

APPLIED RESEARCH SYSTEM ARS HOLDING, N.V. V. CELL GENESYS, INC., INT. NO. 105,114

ARS v. CG is a vigorously contested, high stakes interference between two major companies in the biotech industry. However, it does not involve charges of either fraud or derivation—which are the two issues which, in the past, have most frequently led the APJs to take "actual live testimony." Moreover, each side has relied on a plurality of expert witnesses (each one addressing different facets of the issues in dispute), and it was obvious (1) that there would be many days of cross-examination and (2) that APJ Tierney was not going to want to sit through all of that cross-examination. Accordingly, I contacted opposing counsel (Steven B. Kelber) and asked him if he would split the cost of videotaping all of the witnesses (mine as well as his). Somewhat to my surprise, he not only declined to split the cost of videotaping the testimony, he asserted that he would object to my videotaping any of the testimony even if I did it entirely at ARS's expense!

So, we had a conference call with Hizzonor—which turned out to be the longest conference call I've ever had with an APJ. After that conference call, APJ Tierney entered an order which reads in relevant part as follows:

> ARS has requested permission to videotape the parties' depositions. ARS offered to pay for the costs of the videotaping and provide copies of the video at no cost. Cell Genesys objected to ARS videotaping Cell Genesys's witnesses for various reasons including unnecessary expense incurred in responding to ARS's use of hypertext links to the videos.[1]
>
> The USPTO rules governing interferences (37 C.F.R. § 1.601 et seq.) do not specifically provide for the videotaping of depositions. Further, the Board does not at present have a uniform standard for submitting videotaped depositions and/or hypertext linked DVD's of videotaped depositions. Yet, the rules do provide that an Administrative Patent Judge may determine the proper course of conduct for situations that are not specifically provided for by the rules. 37 C.F.R. § 1.610(e).
>
> Similar to the authorization provided by the Rule 30(b)(2) of the Federal Rules of Civil Procedure, the APJ authorized ARS to videotape the depositions as video may demonstrate the demeanor of the witnesses. The APJ is of the opinion that the witnesses' demeanor has the potential to shed light on the witnesses' testimony.
>
> The deposition videotapes and transcripts are to be submitted as exhibits in this interference. At a minimum, all reference to portions of a deposition shall be made to the written transcript by page and line number.
>
> ARS indicated that one of the purposes of videotaping the depositions was to create a hypertext linked demonstrative for the Board. The APJ ruled that a hypertext linked CD or DVD may be submitted to the Board as a demonstrative to aid the Board's review of the official record. Any such hypertext submission shall be filed and served by no later than the conclusion of Time Period 8.
>
> This ruling is not to be considered as setting a Trial Section precedent. For example, while this interference is being conducted via paper submission, the use of hypertext linked videotaped submissions may not be appropriate for interferences conducted via electronic filing due to USPTO constraints in archiving the submissions.
>
> Cell Genesys and ARS may file and serve ***responsive*** comments regarding any hypertext linked demonstratives submitted by their opponent. The time for filing these responsive comments is no later than ten (10) days after the filing date of an opponent's hypertext linked demonstratives. Depending upon the date of submission of the demonstrative, this ten day response period may extend past Time Period 8.

[1]To help control costs, rather than videotape the depositions the APJ

offered to have the depositions conducted at the Board. The parties declined this offer.

Subsequently, Mr. Kelber and I agreed to split the cost of the videotapes, and the videotaping of the depositions has proceeded without acrimony.

HYPERTEXT LINKED DEMONSTRATIVES FOR THE BOARD

I don't believe that I told APJ Tierney that I planned to submit "a hypertext linked demonstrative for the Board." What I actually plan to do is to submit hypertext linked copies of my motions, oppositions, replies, and rejoinders.[7] According to section 12 of the Trial Section's 1 May 2003 version of its Standing Order, interferents "are authorized to file copies of documents in electronic form" because "Often documents in electronic form (1) are more easily searched and (2) can minimize the chance that an argument or evidence will be overlooked by an administrative patent judge or other board personnel." What I have done in the past is to submit electronic copies of my motions, oppositions, replies, and rejoinders with hypertext links (1) to copies of the opinions cited in those papers and (2) to copies of the portions of the transcripts referred to in those papers. What I intend to do in this case is that plus hypertext links to the portions of the videotapes of the trial testimony referred to in those papers.

I cannot, of course, be certain that the APJs on the panel that decides the preliminary motions will actually employ the hypertext links to look at the witnesses—any more than I can be certain that an Article III trial judge will read all the opinions cited in my briefs or stay awake during the testimony of my witnesses.[8] However, I hope and believe (1) that they will do so and (2) that, whether or not they actually do so, there will be a legal presumption that they do so. Either way, the submission of the hypertext links to the videotaped testimony should increase the deference that Article III judges give the decisions of the Article I APJs in subsequent review whether under 35 USC 141 or 35 USC 146—and reduce the frequency of slighting comments such as the one made by the Federal Circuit in Winner Int'l Royalty Corp. v. Wang. IPT

ENDNOTES

1. Copyright 2004 by Charles L. Gholz; Oblon, Spivak, McClelland, Maier & Neustadt, P.C.; Alexandria, Virginia. Partner in and head of the interference section of Oblon, Spivak, McClelland, Maier & Neustadt, P.C. My direct dial telephone number is (703) 412-6485, and my E-mail address is cgholz@oblon.com.
2. 202 F.3d at 1347, 53 USPQ2d at 1585.
3. Gholz, A Critique of Recent Opinions in Patent Interferences, 83 JPTOS 161 (2001) at 201 n.139.
4. Op. cit. at 201.
5. Id.; footnotes omitted.
6. I know that many people refer to the trial testimony in interferences as "depositions" because the trial testimony in interferences is usually conducted in much the same fashion as depositions in infringement litigation. However, what happens in interferences is the trial testimony; it is not preparation for a subsequent trial. Accordingly, I think that it promotes clarity of thinking to refer to it as trial testimony and not as depositions.
7. The Trial Section's Standing Order does not use the word "rejoinder." However, it authorizes the filing of comments on the depositions of the witnesses offered in support of the replies, and I call those comments rejoinders.
8. Twice I have had bench trials before Article III judges who slept through most of the testimony. Those trials stand out in my memory!