



Unavailability of Witness for Cross-Examination Dooms Reliance on Affidavit Testimony in PTAB Proceeding

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The petitioner challenged several patents, all related to methods and devices used to open and remove tissue from a patient's eye. In support of its petitions, the petitioner submitted a 1984 article that discusses a surgical method for opening or tearing the trabecular meshwork of an eye.

After the PTAB instituted review, the patent owner submitted a sworn affidavit from the named author of the 1984 article to clarify what the article was meant to report. However, upon the petitioner's request to cross-examine the witness, the patent owner was unable to produce him. The witness—an 85-year-old, retired Spanish citizen residing in Spain—was unwilling to travel to the United States for a deposition because of health concerns and the COVID-19 pandemic. The PTAB instructed the parties to further cooperate and depose the witness in Spain, but the witness eventually stated he did not wish to be involved in the dispute beyond his previous affidavit.

The petitioner then moved to strike the affidavit, arguing that its inability to cross-examine the witness would cause extreme prejudice, as the affidavit attempted to contradict and rewrite portions of the 1984 article. In response, the patent owner argued that the affidavit is not dispositive to the issues in dispute, and therefore something less than a live deposition would be a suitable alternative for the petitioner. The patent owner further advocated that, rather than strike the evidence, the PTAB should simply accord the appropriate weight to the affidavit in light of having no cross-examination.

The PTAB ultimately agreed with the petitioner, determining that it would be improper to consider the affidavit without the patent owner making the witness available for cross-examination. The PTAB explained that routine discovery requires that parties make their witnesses available for cross-examination if they want to proffer testimony by affidavit. See 37 C.F.R. §§ 42.51–42.53. The PTAB’s Consolidated Trial Practice Guide further clarifies that “[d]iscovery is a tool to develop a fair record and to aid [the PTAB] in assessing the credibility of a witness,” and therefore a party seeking to present testimony by affidavit must make the witness available for cross-examination. Because allowing the affidavit to remain in evidence without cross-examination would not provide a fair record and would prevent the PTAB from assessing the witness’s credibility, the PTAB granted the petitioner’s motion to strike the affidavit from each of the proceedings.

Practice Tip: To introduce and rely on sworn affidavits as evidence in an *inter partes* review proceeding, parties should be prepared to make those witnesses available for cross-examination. Failure to do so may have profound consequences on the merits of the proceeding, such as the PTAB striking evidence from the record and according no weight to briefing that relies on such evidence. While extenuating circumstances may elicit some flexibility from the PTAB, it does not relieve a party of its duty to produce a witness for cross-examination.

New World Medical, Inc. v. Microsurgical Tech., Inc., IPR2020-01573, Paper 49 (PTAB Nov. 5, 2021).

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