



Inventor Declaration Excluded by PTAB Because Examination in Foreign Proceeding No Substitute for Cross-Examination by IPR Counsel

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The petitioner challenged two patents related to streaming media content. The patents each name Jin Young Lee and Truong Cong Thang as the sole inventors. After the PTAB instituted review on both patents, the patent owner filed motions to amend. In opposition, the petitioner asserted a new prior art reference under Pre-AIA § 102(a). The asserted reference named six authors, two of whom were Mr. Lee and Mr. Thang.

In reply, the patent owner submitted a declaration of Mr. Lee, which supported the argument that the asserted reference was “authored by the same inventive entity” as the challenged patents and thus was not prior art under § 102(a). The patent owner was unable to produce Mr. Lee for cross-examination in the IPR, however. Apparently, Mr. Lee “understood that . . . he would be questioned about [his declaration only] during his upcoming examination in Korea” as part of the parallel district court proceedings—an examination in which only a Korean judge and the petitioner’s separate Korean counsel could ask questions. In place of producing Mr. Lee for cross-examination in the IPR, the patent owner offered to allow the petitioner to submit transcripts from the Korean examination. The petitioner rejected the offer and moved to exclude Mr. Lee’s declaration.

In its motions to exclude, the petitioner argued that failing to make Mr. Lee available for cross-examination violated the PTAB’s discovery rules, that Mr. Lee’s declaration was inadmissible hearsay, and that submitting a transcript of the Korean examination—in place of cross-examination by its IPR counsel—would prejudice the petitioner. In response, the patent owner argued that the Korean examination qualified as a “cross-examination” in the IPR

proceedings and, alternatively, that a hearsay exception applied under FRE 804(b)(1) because the petitioner's Korean counsel had "an opportunity and similar motive to develop" Mr. Lee's declaration testimony in Korea.

The PTAB agreed with the petitioner and excluded Mr. Lee's declaration. As the PTAB explained, "the rules governing routine discovery" allow the PTAB "to consider Mr. Lee's testimony in his Declaration" **only if** the patent owner "make[s] Mr. Lee available for cross-examination by Petitioner"—which it failed to do. See 37 C.F.R. §§ 42.51–42.53. The Korean examination did not satisfy the PTAB's rules because depositions "outside the United States may only be taken upon agreement of the parties or as the Board specifically directs"—neither of which occurred. *Id.* § 42.53(b)(3). The patent owner also failed to "initiate a conference with the Board at least five business days before" the examination, as required for depositions involving an interpreter. *Id.* § 42.53(e). Finally, the Board explained that Mr. Lee's "understanding" that he would only be examined in Korea was not "an extraordinary circumstance" that could justify his unavailability.

The PTAB also excluded Mr. Lee's declaration as inadmissible hearsay under FRE 801 and 802 because it included out-of-court statements offered for their truth. An exception under FRE 804(b)(1) did not apply because the petitioner did not have "an opportunity . . . to develop" Mr. Lee's testimony by cross-examination. The PTAB rejected the patent owner's argument that the Korean examination was an "opportunity" for cross-examination because the petitioner's IPR counsel could not participate in the examination. Additionally, no evidence showed that the examination followed the procedures for foreign-language depositions set forth in *Ariosa Diagnostics v. ISIS Innovation Ltd.*, IPR2012-00022, Paper 55 (PTAB Aug. 7, 2013) (informative).

Finally, the PTAB explained that excluding the declaration was an appropriate remedy because allowing it to remain in the record would prejudice the petitioner. Namely, "[t]he admissibility [of] the Lee Declaration [wa]s no tangential matter—it [went] to the heart of whether [a key reference] constitute[d] prior art." Indeed, it was "the only (remaining) piece of evidence in the record that addresse[d] the inventive entity" of the reference. Thus, denying the motion to exclude would have "significantly impact[ed] Petitioner's ability to address a dispositive issue."

Practice Tip: Practitioners should proceed with caution when relying on declarants in PTAB proceedings, particularly when the declarants reside in foreign countries. Practitioners should

ensure that their declarants are willing and able to sit for a deposition in the IPR proceedings—even if they have been or will be deposed on related subject matter in related proceedings. Moreover, for depositions in foreign countries, practitioners should ensure that they confer with opposing counsel, or get authorization from the PTAB, in a timely manner pursuant to 37 C.F.R. § 42.53(b)(3). Finally, for foreign-language depositions, practitioners must be sure to follow the rules and guidelines set forth in 37 C.F.R. § 42.53(e) and *Ariosa Diagnostics*.

Vudu, Inc. v. IdeaHub, Inc., IPR2020-01688, Paper 47, IPR2020-01689, Paper 48 (PTAB Mar. 16, 2022).

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