



## Cross-Examination Is Not Authorized as Routine Discovery Where the Relied-Upon Testimony Is from an Underlying Litigation

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The PTAB confirmed that a petitioner is entitled to routine cross-examination discovery based on declarations specifically prepared for an *inter partes* review proceeding. *See* 37 C.F.R. § 41.51(b)(1)(ii) (2015) (authorizing routine discovery for the “[c]ross examination of affidavit testimony prepared for this proceeding”). Accordingly, and with no objection from the patent owner, Exhibits 2037 and 2038 were stricken and expunged from the proceeding. The PTAB, however, denied the petitioner’s request to strike Exhibits 1004 and 2028 because those declarations had been prepared for the parallel district court litigation many months before a petition had been filed. The Board reasoned that a declaration prepared for a different proceeding is not transformed into routine discovery simply because it is incorporated by reference. The Board further noted that it would consider the fact that the inventor was not cross-examined when weighing the evidentiary value of those two exhibits.

### Categories

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Inter Partes Review

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