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PTAB Denies Request to Cross-Examine Experts Because Declarations Were Prepared for Other Proceedings and Were Not "Critical" Evidence

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Under 37 C.F.R. § 42.51(b)(1)(ii), "[c]ross examination of affidavit testimony *prepared for the proceeding* is authorized within such time period as the Board may set" (emphasis added). Nestlé argued that, even though the declarations were not prepared for the IPR proceeding, Steuben should produce the witnesses for deposition because the "declarations were recently created, and . . . Patent Owner has not asserted that the Declarants are unavailable," citing *IBG LLC et al. v. Trading Technologies Internationale, Inc.*, CBM2015-00179, Paper 39 (PTAB Apr. 15, 2016). The Board rejected that argument and distinguished the *IBG* case. In *IBG*, the Board ordered the petitioner to produce a witness from a prior litigation because the witness's testimony "was the *sole evidence* that a reference was prior art." Here, Nestlé "d[id] not allege that Patent Owner's evidence rises to such a critical level."

The Board did not reach Nestlé's alternative request to exclude the declarations because Nestlé had not filed a motion to exclude.

Practice Tip: When seeking to cross-examine witnesses based on declarations from prior or parallel proceedings, parties should include in their requests an explanation of why the declaration is "critical" evidence in the IPR. Parties should also consider objecting to the declarations by filing a motion to exclude that includes a reasoned explanation justifying exclusion.

Nestlé Healthcare Nutrition, Inc. v. Steuben Food, Inc., IPR2015-00249, Paper 107 (PTAB Oct. 29, 2018).

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