

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDTRONIC, INC. and MEDTRONIC VASCULAR, INC.,  
Petitioner,

v.

ENDOTACH, LLC,  
Patent Owner.

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Case IPR2014-00100  
Patent 5,593,417

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Before JACQUELINE WRIGHT BONILLA and  
MICHAEL J. FITZPATRICK, *Administrative Patent Judges.*

FITZPATRICK, *Administrative Patent Judge.*

ORDER  
Taking Testimony  
*37 C.F.R. 42.53*

A conference call was held August 27, 2014, among Judges Fitzpatrick and Bonilla and counsel for the parties.

The call was requested by the Patent Owner to discuss Petitioner's cross-examination of Patent Owner's witness, James Silver, Ph.D. Patent Owner's request for the call was precipitated by a Supplemental Notice of Deposition of Dr. Silver, in which Petitioner informed Patent Owner that its cross-examination of the witness "may rely on," among other things, a declaration by Dr. Silver filed in district court and three U.S. patents. Paper 31.<sup>1</sup>

Patent Owner objected to any questioning of Dr. Silver regarding such documents because they are not cited or discussed in his declaration filed in this proceeding ("IPR Declaration," Ex. 2002). Patent Owner contended that such questioning *necessarily* would be outside the scope of Dr. Silver's direct testimony set forth in his IPR Declaration. *See* 37 C.F.R. § 42.53(d)(5)(ii) ("For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.").

We disagree with Patent Owner's contention. As Petitioner pointed out, the language of the applicable rule limits cross-examination to the scope of the direct testimony and not to the documents cited or discussed therein. *See* 37 C.F.R. § 42.53(d)(5)(ii). We contemplate multiple scenarios in which other documents may be used for cross-examining a witness, while staying within the scope of his or her direct testimony. The fact that a

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<sup>1</sup> During the call, Judge Fitzpatrick erroneously stated that notices of deposition are to be served, but not filed. In fact, the parties correctly filed their notices of deposition. 37 C.F.R. § 42.53(d)(4) ("The party seeking the deposition must file a notice of the deposition at least ten business days before a deposition.").

Case IPR2014-00453  
Patent 8,623,077

document is not cited or discussed in a declaration is not dispositive for purposes of enforcing § 42.53(d)(5)(ii).

Accordingly, it is

ORDERED that Patent Owner's objection is overruled without prejudice; Patent Owner is not precluded from making scope-based objections to actual questions posed during the cross-examination of Dr. Silver; and

FURTHER ORDERED that counsel for the parties shall attempt to resolve among themselves any differences that may arise during Dr. Silver's deposition, including, for example, regarding any scope-based objections, prior to involving the Board.

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