

Rolling Dice on Foreign Depositions in IPR Proceedings



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In litigation, it is not uncommon for depositions to be taken outside the U.S., particularly when a given witness resides outside the U.S. and cannot or does not wish to travel to the U.S. In **IPR** proceedings, however, a foreign-based witness's testimony may be discarded if the witness won't come to the U.S. for a deposition.

Regarding depositions following the submission of declaration testimony, Rule 42.53(b)(2) provides that deposition testimony may be taken at any reasonable time and location within the United States. However, the next subsection provides that

Uncompelled deposition testimony outside the United States may only be taken upon agreement of the parties or as the Board specifically directs.

Rule 42.53(b)(3). Thus, where the taking party refuses to agree to take a deposition outside the U.S., an order from the Board must be sought. However, prior decisions from the Board of Patent Appeals and Interferences ("BPAI") suggests that the Board is reluctant to authorize foreign depositions.

For example, in [Quadrant Drug Delivery Ltd. v Nektar Therapeutics, 76 U.S.P.Q.2d 1518, *6 \(B.P.A.I. 2005\)](#) (Doc. No. 64), the Board noted how rarely it has granted permission to conduct a deposition outside the U.S. The Board's decision listed a number of reasons disfavoring foreign depositions, such as the difficulty of

consulting the Board due to the time difference should such a need arise. While a foreign deposition was ultimately authorized in *Quadrant*, the deciding factor was likely the development of an intervening medical problem with the expert that hindered his ability to travel to the U.S.

As noted in *Quadrant*, “[w]hen a testimony proponent has failed to take reasonably prudent precautions in securing witness availability for cross examination, the Board will be more concerned about prejudice to the opponent and to the Board than to the proponent.” *Id.* at *5. Even where good cause exists for a foreign deposition, the proponent of the witness must further consider whether the proposed location of the deposition is likely to provide sufficient safeguards for the reliable taking of sworn testimony, and must be prepared to reimburse the opposing party for reasonable costs in excess of a deposition in the U.S. See *id.* at *3-4 (finding the United Kingdom to provide adequate safeguards for reliable cross examination testimony, and noting that the proponent would cover the opponent’s excess travel costs).

In view of *Quadrant*, it is recommended practice to secure a foreign-based witness’ agreement to travel to the U.S. for a deposition before relying on that witness’ declaration testimony in an IPR. It may even be desirable to include such a statement in the signed declaration itself. If an intervening event later prevents the witness from traveling to the U.S., the Board may accommodate such a change in circumstance, especially where counsel initially believed in good faith that deposition in the U.S. would be possible. In that case, however, counsel must ensure that the foreign location is suitable for the taking of reliable testimony, and should be prepared to pay excess costs.

Lastly, where the foreign deposition requires the use of a translator (or even if the deposition is in the U.S. for that matter), readers are directed to Rule 42.53(e) and the Board’s guidance provided in [Ariosa Diagnostics v. Isis Innovation Ltd., IPR2012-00022, Paper No. 55](#), regarding the use of translators in depositions.

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