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Patent Trial and Appeal Board
Informative
Standard Operating Procedure 2
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Paper 55
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARIOSA DIAGNOSTICS.
Petitioner,

v.

ISIS INNOVATION LIMITED
Patent Owner.

Case IPR2012-00022 (MPT)
Patent 6,258,540

Before MICHAEL P. TIERNEY, LORA M. GREEN, and JEFFREY B. ROBERTSON, Administrative Patent Judges.

GREEN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

The initial conference call was held on Tuesday, August 1, 2013, between Eldora Ellison, representing Patent Owner, Greg Gardella, representing Petitioner, and Judges Tierney and Green. Petitioner requested the call to discuss the deposition of Professor Kazakov

I. Prof. Kazakov's availability

Petitioner, Ariosa Diagnostics ("Ariosa") informed the Board that there may be a need for alternative accommodations to conduct the deposition of Prof. Kazakov. According to Ariosa, the deposition of Prof. Kazakov is currently scheduled for the middle of August, but it is unclear if he will obtain a visa in time. Ariosa proposed an alternate plan, whereby the deposition would be taken later in August or early September, in a jurisdiction other than the United States that does not require a visa.

The Board pointed to rule 37 C.F.R. § 42.53(b)(3), which states that "[u]ncompelled deposition testimony outside the United States may only be taken upon agreement of the parties or as the Board specifically directs." The parties agreed that they would discuss the alternate plans suggested by Ariosa, and stated they hope to come to an agreement for taking the deposition in a location outside of the United States, if so needed.

II. Guidelines for a foreign language deposition

The parties also requested guidance as to taking a deposition in a foreign language as required by 37 C.F.R. § 42.53(e) ("If an interpreter is to be used during the deposition, the party calling the witness must initiate a conference with the Board at least five days before the deposition"). In particular, Isis requested clarification as to whether the guidelines set forth by the Board in Interference No. 104,539, Paper 54, would also apply to AIA proceedings.

Rule 42.53 governs the taking of testimony, including cross-examination testimony. In addition to adhering to the requirements of that rule, the following guidelines are to be used when conducting a deposition in a foreign language. In

the guidelines below, "party" refers to the party proffering the witness, and "opponent" refers to the party cross-examining the witness.

1. The party proffering the witness is responsible for providing a "first interpreter" who can interpret using a consecutive mode of interpretation.
2. At least five (5) business days before the cross-examination deposition, the party shall provide to the opponent the name, business address, business telephone number, e-mail address, and resume of the first interpreter.
3. The opponent may engage the services at the counsel table of a "second interpreter."
4. At least five (5) business days before the cross-examination deposition, the opponent shall provide to the party the name, business address, business telephone number, e-mail address, and resume of the second interpreter.
5. The consecutive mode of interpretation shall be used.
6. If the second interpreter has a disagreement with the first interpreter regarding the interpretation of the question and/or the answer, the second interpreter should inform counsel by note. If counsel desires to raise the disagreement on the record, the second interpreter, using the consecutive mode, will be allowed to interpret the question for the witness, as well as the witness' answer to the second interpreter's interpretation of the question.
7. If there is a disagreement as to interpretation, and the first and second interpreter cannot work out a mutually agreeable interpretation, an objection should be made on the record, and the first and second interpreter should specify on the record what they believe to be the correct interpretation.
8. In such an event, the Board will determine which interpretation, if any, is to be accorded more weight.

9. Collateral attacks with respect to the qualifications of any interpreter, or the manner in which any question or answer was interpreted, shall not be allowed after the conclusion of the deposition.
10. Copies of any documents which an interpreter will be required to "sight translate" at the deposition shall be provided to the interpreter no later than three days before the deposition is to take place. Failure to timely provide the documents may result in their exclusion from evidence. Unless agreed to by both parties, the interpreter shall not reveal to opposing counsel the nature of any document so provided.
11. If, at any time during the deposition, the interpreter is unable to interpret or translate a word, expression, or special term, the interpreter shall, on the record, advise the parties of the issue.
12. An individual may not serve simultaneously as both an attorney for a party and as an interpreter.

The Board acknowledges that, beyond Rule 42.53 and the above guidelines, the parties are in the best position to determine the procedure by which the deposition is to be conducted. If there are additional situations that the parties foresee may occur during the deposition, such as requiring additional time to cross-examine the witness because of the need for an interpreter, and the need for the interpreter to take breaks during the proceeding, the parties should agree to how those situations should be handled before the deposition. If problems arise and the parties cannot come to an agreement, the parties should contact the Board for additional guidance.

It is:

Ordered that the above guidelines shall cover the taking of a deposition in a foreign language in this proceeding;

Further ordered that the conference call held on August 1, 2013, and this order meet the requirement of 37 C.F.R. § 42.53(e); thus there is no need for an additional conference call unless the parties need further clarification or guidance from the Board.

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