

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARIOSIA DIAGNOSTICS.
Petitioner,

v.

ISIS INNOVATION LIMITED
Patent Owner.

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

Before LORA M. GREEN, FRANCISCO C. PRATS, and
JEFFREY B. ROBERTSON, Administrative Patent Judges.

GREEN, *Administrative Patent Judge.*

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

A conference call was held on Monday, August 26, 2013, between Eldora Ellison, representing Patent Owner, Greg Gardella, representing Petitioner, and Judges Green, Robertson, and Prats. A court reporter was present on the call, and a

transcript is to be filed in due course by Patent Owner as an exhibit.¹ Petitioner requested the call to discuss the extraterritorial deposition of one or more witnesses.

I. Extraterritorial Depositions

Petitioner, Ariosa Diagnostics (“Ariosa”), informed the Board that the parties had come to an agreement as to the material aspects of the deposition of Dr. Kazakov and Dr. Mansfield in Mexico City. The Board expressed its concern that the witnesses be properly sworn in before the deposition. Ariosa responded that arrangements had already been made to have the witnesses sworn by the appropriate consular official.

Patent Owner, Isis Innovation Limited (“Isis”), requested additional clarification regarding the taking of a deposition in a foreign language.

First, Isis, citing paper 54 in Interference No. 104,539, requested clarification whether *voir dire* of the interpreter(s) was required, and if not required, could it be done by the parties. The Board noted that while it was not requiring *voir dire* of the interpreter(s), it could be performed by the parties should they have concerns about the interpreter’s qualifications that could not be resolved in advance of the deposition. The Board believes that such *voir dire* should be the exception, not the rule, and directs counsel to cooperate in resolving any such issues before the deposition. The Board will not entertain any objections to the translator’s qualification at the time of the deposition that could have been resolved in advance.

¹ This order summarizes the statements made during the conference call. A more detailed record may be found in the transcript.

In that connection, the Board cautions the parties that very little can be done about the selection and qualifications of the interpreter at the deposition, especially in view of the fact that the location is Mexico City. Therefore, as set forth in Paper 55 of this proceeding, at least five days before the deposition, each party should provide the other party the name, business address, business telephone number, e-mail address, and resume of the first interpreter. It is at that time that a party should express to the other party any concern about the choice of interpreter so that the issue can be resolved in advance of the deposition.

Isis also questioned whether as stated in Guideline 30 of paper 54 in Interference No. 104,539, applied to foreign language depositions in AIA proceedings. Specifically, Guideline 30 states:

At the request of an interpreter, the party and opponent shall provide the interpreter with an opportunity to converse with the witness. Counsel for the party or opponent may inquire on *voir dire* as to any conversation between the witness and the interpreter.

Interference No. 104,539, Paper 54 at 5. The Board stated in response that counsel may inquire of the interpreter as to any such conversation.

Finally, Isis expressed concern as to whether Ariosa could use the same interpreter to prepare the witness for the deposition. Specifically, Isis was concerned about any relationship that might form between the witness and the interpreter. In that same vein, Isis also requested if the same interpreter is used to prepare the witness as is used in the deposition, as to whether they could make inquiries of the interpreter as to that preparation.

The Board has determined that the same interpreter may be used in the deposition and to prepare the witness, as opposing counsel will have a check interpreter, and thus will have the opportunity to raise any issues as to the interpretation of the question or the witness' answer. We do not think it

appropriate that inquiries of the interpreter as to what occurred during the preparation of the witness be allowed, as such inquiries touch on issues of privilege, and perhaps other issues. We do think it is appropriate, however, to permit Isis to inquire only as to the fact of whether the interpreter was involved in preparing the witness.

II. Exhibit 1033

Ariosa moved for authorization to file substitute exhibits pursuant to an Order dated April 19, 2013 (Paper 32), which motion was granted. Paper 46. Ariosa noted during the conference call that Exhibit 1133 had not been originally submitted, but was submitted with the substitute exhibits. According to Ariosa, its exclusion as part of the original exhibits was merely an oversight.

Isis responded that the exclusion of the exhibit was not merely an oversight, as it was only referenced in footnote 30 of the Kazakov Declaration. Isis thus contended that Exhibit 1133 should be treated as the late submission of supplemental information under 37 C.F.R. § 42.123, and thus Ariosa would have to demonstrate why the supplemental information could not have been obtained earlier, and why its consideration would be in the interest of justice.

If Ariosa wishes Exhibit 1133 to be of record, it is authorized to file a motion explaining why its omission as part of the original exhibits was an oversight. The motion must also address, if the Board determines that its omission was not simply an oversight, why the supplemental information could not have been obtained earlier, and why its consideration would be in the interest of justice as required by 37 C.F.R. § 42.123. Any such motion must be filed by Friday, August 30, 2013, and if the motion is received, no opposition is authorized at this

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time. If the motion is not received by that date, Exhibit 1133 will be expunged from the record.

It is:

Ordered that if Ariosa must file any motion to have Exhibit 1133 to be of record in this trial proceeding by **Friday, August 30, 2013**. If the Ariosa files the motion, Isis is **not** authorized to file an opposition at this time. If Ariosa fails to file the motion by that date, Exhibit 1133 will be expunged from the record.

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