

would ordinarily have easier access to such materials than the requester and would be in a better position to ensure that the requested material is the material cited. It would also eliminate many routine discovery requests and disputes. The requirement would not be a requirement for a party to create materials or to provide materials not cited. See *Scott v. Gbur*, 62 USPQ2d 1959 (BPAI 2002) (nonprecedential). Any request under proposed § 41.150(b) should come early in the proceeding to ensure that the requesting party will have timely access to such materials. Proposed § 41.150(c) would restate existing practice under Rule 687 regarding additional testimony.

Proposed § 41.151 would continue the practice under Rule 671(i) of making failure to comply with the rules a basis for challenging admissibility.

Proposed § 41.152 would continue the current practice of using the Federal Rules of Evidence in contested cases. Experience since this practice was implemented in 1984 has shown it to be beneficial without being unduly restrictive for either the parties or the Board. Moreover, the Federal Rules of Evidence embrace a well-developed body of case law and are familiar to the courts charged with reviewing Board decisions in contested cases. Minor changes to the rule have been made to conform the rule with amendments to the Federal Rules of Evidence since 1984.

No special provisions for electronic records are proposed beyond the provisions already in the Federal Rules of Evidence. See Fed. R. Evid. 1001(3). While electronic records appear to be of special concern because they often may be easily altered, the requirements already present in the Federal Rules of Evidence adequately addressed this concern. The Board's limited experience with electronic records in interferences has not suggested any unique admissibility problems requiring special provisions. Electronic records have been admissible in interferences on the same basis as other records.

Proposed § 41.153 would restate the practice under Rule 671(d) of admitting Office records that are available to all parties without certification. Cf. 28 U.S.C. 1744, which provides for the admissibility of certified Office records. Note that under proposed § 41.154(a), each Office record cited as evidence would have to be submitted as an exhibit, following the practice of Standing Order ¶ 14.5. In the case of application files and similar files, only the specific record cited should be submitted as an exhibit. Submitting the entire file when only discrete portions

are cited would create a record-management problem for the Board and confusion about what the fact-finders must consider in reaching a decision. The Board might expunge such filings *sua sponte*.

Proposed § 41.154(a) would restate Rule 671(a), which sets the form of evidence, and would codify the existing practice that all evidence must be submitted as an exhibit. Proposed § 41.154(b) would restate Rule 647 regarding translation of foreign language evidence. Proposed § 41.154(c) would set forth additional formal requirements for exhibits consistent with current practice under Standing Order ¶ 14.8.1. An exhibit list would be required under proposed § 41.154(d), following the current practice under Standing Order ¶ 14.8.5.

Proposed § 41.155 would set forth rules for objecting to evidence and responding to objections. The current practice is to provide a time for filing motions to exclude. Under proposed § 41.155(b)(1), the default time for serving an objection to evidence other than testimony would be five business days. Since evidence would have to be served by EXPRESS MAIL® or comparably fast means, see proposed § 41.106(e)(3), five business days would ordinarily be adequate time to object.

Proposed § 41.155(b)(2) would permit a party that submitted evidence ten business days after service of the objection to cure any defect in the evidence. (Standing Order ¶ 14.2 provides two weeks.) The Board would not ordinarily address an objection unless the objecting party filed a motion to exclude under § 41.155(c) because the objection either might have been cured or might prove unimportant in light of subsequent developments. Proposed § 41.155(d) would provide for a motion in limine for a ruling on admissibility, following the practice of Standing Order ¶ 13.10.3.2.

Under 35 U.S.C. 23, the Director may establish rules for affidavit and deposition testimony. Under 35 U.S.C. 24[1], a party in a contested case may apply for a subpoena to compel testimony in the United States, but only for testimony to be used in the contested case. Proposed § 41.156(a) would require the party seeking a subpoena to first obtain authorization from the Board; otherwise the compelled evidence would not be used in the contested case. Proposed § 41.156(b) would impose additional requirements on a party seeking testimony or production outside the United States because the use of foreign testimony generally increases the cost and complexity of the proceeding for both

the parties and the Board. The Board would give weight to foreign deposition testimony to the extent warranted in view of all the circumstances, including the laws of the foreign country governing the testimony. Little, if any, weight might be given to deposition testimony taken in a foreign country unless the party taking the testimony proved, as a matter of fact, that knowingly giving false testimony in that country in connection with a Board proceeding is punishable under the laws of that country and that the punishment in that country for such false testimony is comparable to or greater than the punishment for perjury committed in the United States. Proposed § 41.156(c) would advise that the Board may rely on official notice and hearsay to determine the scope and effect of foreign law.

Proposed § 41.157 would restate existing practice regarding the taking of testimony. The time period for cross-examination set in proposed § 41.157(c)(2) would follow the current practice under Standing Order ¶ 14.3 and would set a norm for the conference held under proposed § 41.157(c)(1). A party seeking to push the deposition outside this period would have to be prepared to show good cause. Proposed § 41.157(c)(3) would clarify the practice of providing documents in advance by limiting the practice to direct testimony. Since direct testimony is generally in the form of a declaration, the circumstance in which proposed § 41.157(c)(3) would apply should rarely occur apart from compelled testimony.

Proposed § 41.157(d) would codify the existing requirement for a conference before a deposition with an interpreter. Board experience suggests that the complexity of foreign language depositions can be so great that in many cases the resulting testimony is not very useful to the fact-finder. To avoid a waste of resources in the production of an unhelpful record, the Board must approve of the deposition format in advance and may require that the testimony occur before the Board. Occasionally other testimony that particularly touches on the credibility of the witness, such as testimony about best mode, derivation, or inequitable conduct, will also be required to be taken before the Board so the Board may directly observe the demeanor of the witness.

Proposed § 41.157(e) would depart from the current rules in adopting "officer", the term used in 35 U.S.C. 23, to refer to the person qualified to administer testimony.

The certification of proposed § 41.157(e)(6)(vi) would substantially adopt the standard of Rule 674 for