UNITED STATES PATENT AND TRADEMARK OFFICE



Hearsay and Authentication

Presenters: Lead Judge Michael Zecher, Judge Tom Giannetti, Judge Grace Obermann December 6, 2018



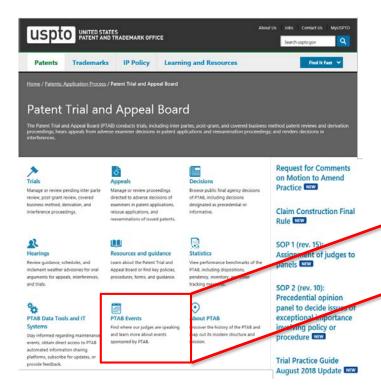
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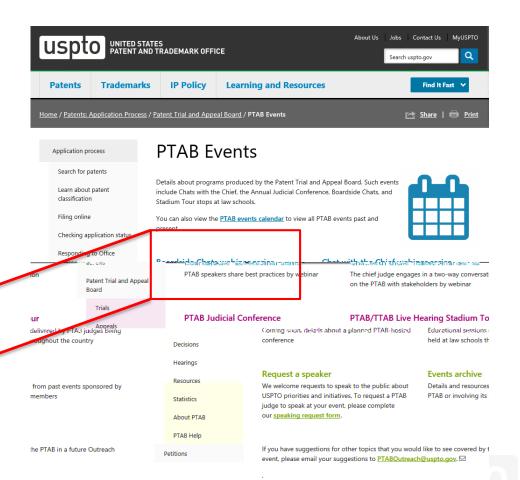
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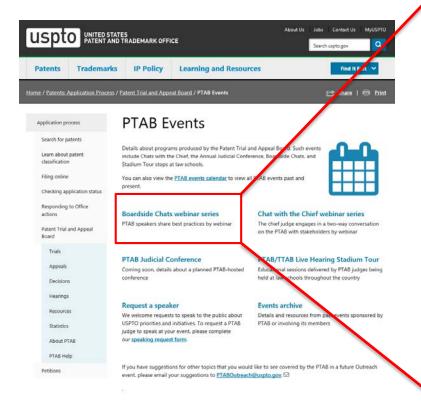


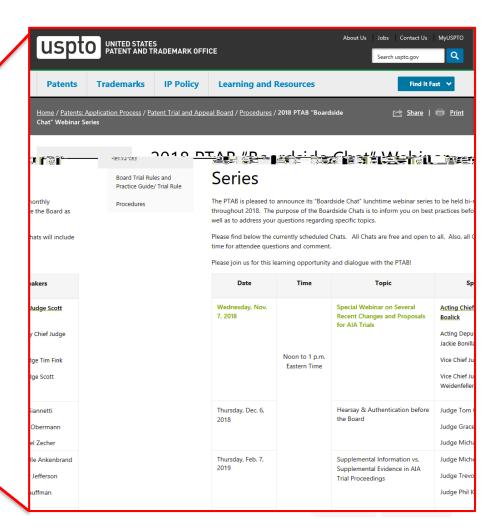
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Discussion Topics

- Authentication Rule
 - Web pages
- Hearsay Rule
 - File Histories
 - Prior Testimony
 - Patents and Publications



Authentication – Rule 901

• (a) *In General*. To satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that **the item is what the proponent claims it is**.



Authentication – Rule 901

- Examples:
 - Testimony of a witness with knowledge
 - Distinctive characteristics or the like
 - Evidence about public records
 - Evidence describing a process or system showing that it produces accurate results



Authentication – Rule 902

- Self-Authentication Examples
 - Domestic public documents (sealed and signed or signed and certified)
 - Certified copies of public records
 - Official publications (issued by a public authority)
 - Newspapers and periodicals



Web Page

- Generally, a party relies on a web page in an AIA Trial proceeding in one of the following two ways:
 - (1) as a prior art reference; or
 - (2) as evidence of the state of the art at or around the time of the claimed invention.



How to Authenticate a Web Page

- Testimony from a person who captured the web page
- Testimony from a computer forensic expert
- Relying on distinct characteristics of the web page
- Demonstrating a clear reliable process for capturing, preserving, and presenting the web page (e.g., Internet Archive)



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Hearsay - Rule 801

"Hearsay" means a statement that:

- (1) the declarant does not make while testifying at the current *trial or hearing*; and
- (2) a party offers in evidence to prove the truth of the matter asserted in the statement.



Hearsay - Rule 801

"Statement" means a person's **oral assertion**, **written assertion**, or **nonverbal conduct**, if the person intended it as an assertion.



Trial or Hearing - 37 C.F.R § 42.62(c)

"Unless otherwise clear from context, the following terms of the Federal Rules of Evidence shall be construed as indicated: . . .

Hearing means, as defined in Federal Rule of Evidence 804(a)(5)["Criteria for being Unavailable"], the time for taking testimony.

. . .

Trial or hearing in Federal Rule of Evidence 807 ["Residual Exception"] means the time for taking testimony."

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Rationale for Excluding Hearsay

- No oath
- No personal presence at trial
- No cross-examination

McCormick on Evidence § 245 (2nd Ed. 1972)



Hearsay Exceptions

- Rule 803
 - Regardless of whether declarant is available as a witness
 - Examples: business records, state of mind, prior inconsistent statement of witness
- Rule 804
 - Declarant unavailable

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File Histories

- Office Actions
 - Public Records Exception (Rule 803(8))
 - 37 C.F.R. § 42.61(b) certification not necessary
- Responses
 - Opposing Party Statement (Rule 801(d)(1))
- Declarations
 - Opposing Party Statement
- Other



Admissions of Opposing Party

- Not hearsay under the Federal Rules
- Fed. R. Evid. 801(d)(2) exclusions include a statement:
 - made by a party
 - one which party manifested adoption or belief in truth
 - made by a person authorized by the party

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Depositions and Transcripts

(1) Routine discovery. Except as the Board may otherwise order:

. . .

(ii) Cross examination of affidavit testimony **prepared for the proceeding** is authorized within such time period as the Board may set.

37 C.F.R. § 42.51(b)(1)(ii)(as amended)

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Depositions and Transcripts

- Not hearsay when prepared for this trial.
- Hearsay when prepared for another proceeding.
 - Some Exceptions: not for truth, admission of an opponent, prior testimony (where witness is "unavailable"), prior inconsistent statement of a witness subject to cross-examination



Exceptions - Rule 804(b)(1)

- (1) Former Testimony. Testimony that:
- (A) was given as a witness at a trial, hearing, or lawful deposition, whether given during the current proceeding or a different one; and
- **(B)** is now offered against a party who had or, in a civil case, whose predecessor in interest had an **opportunity and similar motive** to develop it by direct, cross-, or redirect examination.

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Former Testimony – Rule 804(b)

Rule 804 (b) The Exceptions. The following are not excluded by the rule against hearsay if the declarant is unavailable as a witness:



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Rule 804(a) - Unavailability

- (1) privilege applies
- (2) refuses to testify despite court order
- (3) doesn't remember
- (4) death/infirmity/illness



Rule 804(a) - Unavailability

- (5) is absent from the [time for taking testimony] and the statement's proponent has not been able, by process or other reasonable means, to procure:
 - (A) **the declarant's attendance**, in the case of a hearsay exception under Rule 804(b)(1) [former testimony]. . .



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Prior Art Printed Publications

- A specification or drawing of a U.S. Patent
 Application or Patent is admissible as evidence only
 to prove what the specification or drawing describes.
- If there is data in the specification or a drawing upon which a party intends to rely to prove the truth of the data, an affidavit by an individual having firsthand knowledge of how the data was generated must be filed.

37 C.F.R. § 42.61(c)



Rule 807 – Residual Exception

- (a) *In General*. Under the following circumstances, a hearsay statement is not excluded by the rule against hearsay **even if the statement is not specifically covered** by a hearsay exception in Rule 803 or 804:
 - (1) the statement has **equivalent circumstantial guarantees** of trustworthiness;
 - (2) it is offered as evidence of a material fact;
 - (3) it is **more probative** on the point for which it is offered **than any other evidence** that the proponent can obtain through reasonable efforts; **and**
 - (4) admitting it will best serve the purposes of these rules and the **interests** of justice.

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Rule 807 – Residual Exception

(b) *Notice.* The statement is admissible only if, before the [time for taking testimony], the proponent gives an adverse party **reasonable notice** of the intent to offer the statement and its particulars, including the declarant's name and address, so that the party has a fair opportunity to meet it.



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Resources

- McCormick on Evidence Title 10 (2d Ed. 1972)
- Weinstein's Federal Evidence
- Wigmore on Evidence Chapter VII (3d Ed. 1940)



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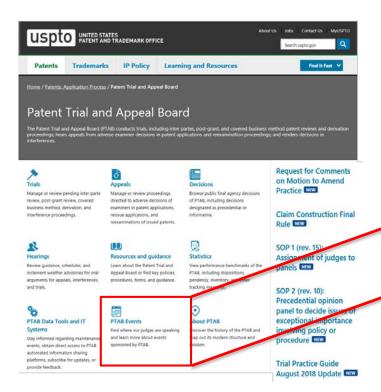
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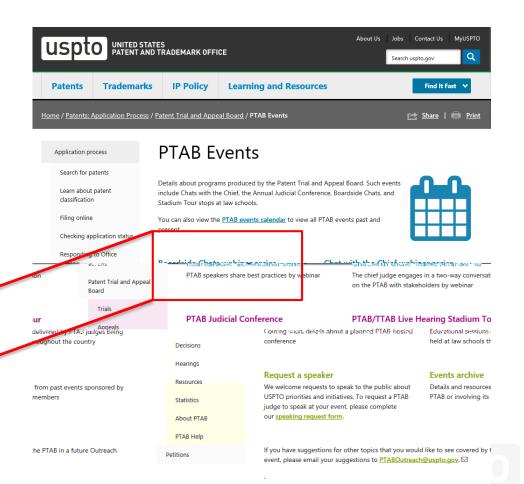


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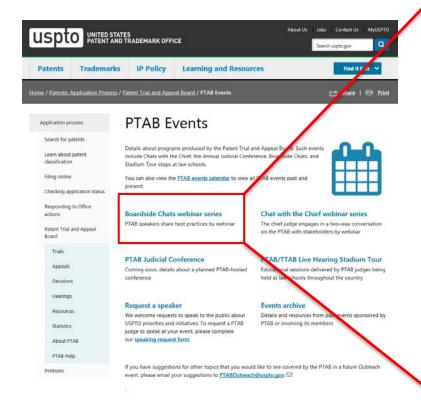


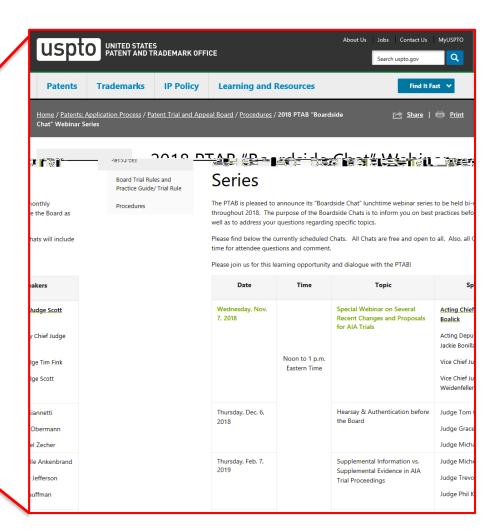
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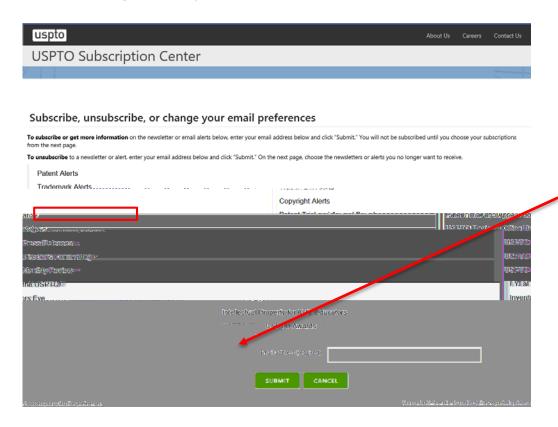
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Next Boardside Chat

- Tuesday, January 15, 2019
- Noon to 1 pm ET
- Reasons to Combine
- Presenters:
 - –Judge Rom Delmendo
 - -Judge Jack Jeffery



Thank You



