

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Hearsay and Authentication

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

UNITED STATES
PATENT AND TRADEMARK OFFICE



Question/Comment Submission

To send in questions or comments during the webinar, please email:

PTABBoardsideChat@uspto.gov

Slides

The screenshot shows the USPTO Patent and Trademark Office website. The main navigation bar includes 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. The breadcrumb trail reads 'Home / Patents: Application Process / Patent Trial and Appeal Board'. The main heading is 'Patent Trial and Appeal Board'. Below this, there is a brief description of the PTAB's role. A sidebar on the left contains several menu items: 'Trials', 'Appeals', 'Decisions', 'Hearings', 'Resources and guidance', 'Statistics', 'PTAB Data Tools and IT Systems', and 'PTAB Events'. The 'PTAB Events' item is highlighted with a red box. The main content area lists several recent news items, including 'Request for Comments on Motion to Amend Practice', 'Claim Construction Final Rule', 'SOP 1 (rev. 15): Assignment of judges to panels', 'SOP 2 (rev. 10): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure', and 'Trial Practice Guide August 2018 Update'.

This screenshot shows the top portion of the USPTO website. The header features the 'uspto' logo and the text 'UNITED STATES PATENT AND TRADEMARK OFFICE'. On the right, there are links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO', along with a search bar containing 'Search uspto.gov'. Below the header is a navigation bar with tabs for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', and a 'Find It Fast' dropdown menu. The breadcrumb trail at the bottom of this section reads 'Home / Patents: Application Process / Patent Trial and Appeal Board / PTAB Events'.

This screenshot shows the 'PTAB Events' page. The main heading is 'PTAB Events'. Below the heading, there is a brief description of the programs produced by the PTAB, including Chats with the Chief, the Annual Judicial Conference, Boardside Chats, and Stadium Tour stops at law schools. A calendar icon is visible on the right. The page is divided into several sections: 'Application process' (with sub-sections like 'Search for patents', 'Learn about patent classification', etc.), 'PTAB speakers share best practices by webinar', 'PTAB Judicial Conference', 'PTAB/TTAB Live Hearing Stadium To', 'Request a speaker', and 'Events archive'. A red box highlights the 'PTAB speakers share best practices by webinar' section. The text in this section reads: 'PTAB speakers share best practices by webinar. The chief judge engages in a two-way conversation on the PTAB with stakeholders by webinar.' Other sections include 'PTAB Judicial Conference' (describing a planned PTAB-hosted conference) and 'Request a speaker' (welcoming requests to speak at public events).

Slides

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Home / Patents: Application Process / Patent Trial and Appeal Board / PTAB Events

Application process

- Search for patents
- Learn about patent classification
- Filing online
- Checking application status
- Responding to Office actions
- Patent Trial and Appeal Board
- Trials
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PTAB Events

Details about programs produced by the Patent Trial and Appeal Board. Such events include Chats with the Chief, the Annual Judicial Conference, Boardside Chats, and Stadium Tour stops at law schools.

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Home / Patents: Application Process / Patent Trial and Appeal Board / Procedures / 2018 PTAB "Boardside Chat" Webinar Series

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Please find below the currently scheduled Chats. All Chats are free and open to all. Also, all Chats will include time for attendee questions and comment.

Please join us for this learning opportunity and dialogue with the PTAB!

Date	Time	Topic	Speakers
Wednesday, Nov. 7, 2018	Noon to 1 p.m. Eastern Time	Special Webinar on Several Recent Changes and Proposals for AIA Trials	Acting Chief Judge Boalick Acting Deputy Chief Judge Jackie Bonilla Vice Chief Judge Tim Fink Vice Chief Judge Scott Weidenfeller
Thursday, Dec. 6, 2018		Hearsay & Authentication before the Board	Judge Thomas Obermann Judge Michael Zecher
Thursday, Feb. 7, 2019		Supplemental Information vs. Supplemental Evidence in AIA Trial Proceedings	Judge Michelle Ankenbrand Judge Jeffrey Huffman

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.”

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

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)

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.

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**:

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 first-hand 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**.

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.

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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Patent Trial and Appeal Board

The Patent Trial and Appeal Board (PTAB) conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings; hears appeals from adverse examiner decisions in patent applications and reexamination proceedings; and renders decisions in interferences.

- Trials**
Manage or review pending inter parte review, post-grant review, covered business method, derivation, and interference proceedings.
- Appeals**
Manage or review proceedings directed to adverse decisions of examiners in patent applications, reissue applications, and reexaminations of issued patents.
- Decisions**
Browse public final agency decisions of PTAB, including decisions designated as precedential or informative.
- Resources and guidance**
Learn about the Patent Trial and Appeal Board or find key policies, procedures, forms, and guidance.
- Statistics**
View performance benchmarks of the PTAB, including disposition, pendency, inventory, and other tracking statistics.
- PTAB Events**
Find where our judges are speaking and learn more about events sponsored by PTAB.
- About PTAB**
Discover the history of the PTAB and tap out its modern structure and mission.

Request for Comments on Motion to Amend Practice NEW

Claim Construction Final Rule NEW

SOP 1 (rev. 15): Assignment of judges to panels NEW

SOP 2 (rev. 10): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure NEW

Trial Practice Guide August 2018 Update NEW

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Stay informed regarding maintenance events, obtain direct access to PTAB automated information sharing platforms, subscribe for updates, or provide feedback.

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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

