Hearsay and Authentication

Presenters: Lead Judge Michael Zecher, Judge Tom Giannetti, Judge Grace Obermann
December 6, 2018
Question/Comment Submission

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

PTABBoardsideChat@uspto.gov
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.

You can also view the PTAB events calendar to view all PTAB events past and present.

Boardside Chats webinar series

PTAB speakers share best practices by webinar

Chat with the Chief webinar series

The chief judge engages in a two-way conversation on the PTAB with stakeholders by webinar

PTAB/TTAB Live Hearing Stadium Tour

Educational sessions delivered by PTAB judge being held at law schools throughout the country

Request a speaker

We welcome requests to speak to the public about USPTO priorities and initiatives. To request a PTAB Judge to speak at your event, please complete our speaking request form.

If you have suggestions for other topics that you would like to see covered by the PTAB in a future Outreach event, please email your suggestions to PTABOutreach@uspto.gov.
2018 PTAB “Boardside Chat” Webinar Series

The PTAB is pleased to announce its “Boardside Chat” lunchtime webinar series to be held bi-monthly throughout 2018. The purpose of the Boardside Chats is to inform you on best practices before the Board as well as to address your questions regarding specific topics.

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.

<table>
<thead>
<tr>
<th>Date</th>
<th>Time</th>
<th>Topic</th>
<th>Speakers</th>
</tr>
</thead>
<tbody>
<tr>
<td>Wednesday, Nov. 7, 2018</td>
<td>Noon to 1 p.m. Eastern Time</td>
<td>Special Webinar on Several Recent Changes and Proposals for AIA Trials</td>
<td>Acting Chief Judge Scott Bozdik, Acting Deputy Chief Judge Jackie Bonilla, Vice Chief Judge Tim Finn, Vice Chief Judge Scott Weidenfeller</td>
</tr>
<tr>
<td>Thursday, Dec. 6, 2018</td>
<td></td>
<td>Hearsay &amp; Authentication before the Board</td>
<td>Judge Tom Gannatti, Judge Grace Gernandt, Judge Michael Zecher</td>
</tr>
<tr>
<td>Thursday, Feb. 7, 2019</td>
<td></td>
<td>Supplemental Information vs. Supplemental Evidence in AIA Trial Proceedings</td>
<td>Judge Michelle Ankenbrand, Judge Trevor Jefferson, Judge Phil Kauffman</td>
</tr>
</tbody>
</table>
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
• 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)
Questions?
Question/Comment Submission

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

PTABBoardsideChat@uspto.gov
"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.
“Statement” means a person’s oral assertion, written assertion, or nonverbal conduct, if the person intended it as an assertion.
“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
Questions?
Question/Comment Submission

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

PTABBoardsideChat@uspto.gov
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:

\[
\ldots
\]

(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/infirmitiy/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]. . .
Questions?
Question/Comment Submission

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

PTABBoardsideChat@uspto.gov
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)
(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) \textit{Notice}. The statement is admissible only if, before the [time for taking testimony], the proponent gives an adverse party \textit{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)
Question/Comment Submission

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

PTABBBoardsideChat@uspto.gov
Questions?
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.

You can also view the PTAB events calendar to view all PTAB events past and present.

Boardside Chats webinar series

PTAB speakers share best practices by webinar.

Chat with the Chief webinar series

The Chief Judge engages in a two-way conversation on the PTAB with stakeholders by webinar.

PTAB/TTAB Live Hearing Stadium Tour

Educational sessions delivered by PTAB judges being held at law schools throughout the country.

Request a speaker

We welcome requests to speak to the public about USPTO priorities and initiatives. To request a PTAB Judge to speak at your event, please complete our speaking request form.

If you have suggestions for other topics that you would like to see covered by the PTAB in a future Outreach event, please email your suggestions to PTABOutreach@uspto.gov.
2018 PTAB “Boardside Chat” Webinar Series

The PTAB is pleased to announce its “Boardside Chat” lunchtime webinar series to be held bi-monthly throughout 2018. The purpose of the Boardside Chats is to inform you on best practices before the Board as well as to address your questions regarding specific topics.

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.

<table>
<thead>
<tr>
<th>Date</th>
<th>Time</th>
<th>Topic</th>
<th>Speakers</th>
</tr>
</thead>
</table>
| 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 Scott Boaltick
| Thursday, Dec. 6, 2018 | Noon to 1 p.m. Eastern Time | Hearsey & Authentication before the Board | Judge Tom Giansanti
| Thursday, Feb. 7, 2019 | Noon to 1 p.m. Eastern Time | Supplemental Information vs. Supplemental Evidence in AIA Trial Proceedings | Judge Michelle Akimenbrand
Subscription Center

https://public.govdelivery.com/accounts/USPTO/subscriber/new

Sign up to receive the latest news and updates from the USPTO conveniently via e-mail
Next Boardside Chat

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