

**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:

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Slides

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- Learn about patent classification
- Filing online
- Checking application status
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PTAB Events

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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.”

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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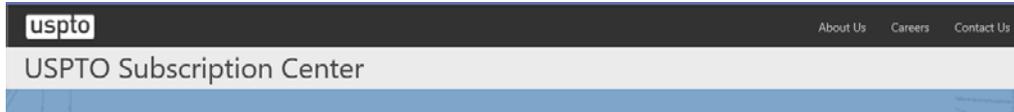
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Next Boardside Chat

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

Thank You

