

**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 Trial and Appeal Board website. The header includes the USPTO logo and navigation links for Patents, Trademarks, IP Policy, and Learning and Resources. The main content area is titled "Patent Trial and Appeal Board" and features several informational cards: Trials, Appeals, Decisions, Hearings, Resources and guidance, Statistics, PTAB Data Tools and IT Systems, and PTAB Events. A red box highlights the "PTAB Events" card, which contains the text: "Find where our judges are speaking and learn more about events sponsored by PTAB."

The screenshot shows the top navigation bar of the USPTO website. It includes the USPTO logo, the text "UNITED STATES PATENT AND TRADEMARK OFFICE", and a search bar with the text "Search uspto.gov". Navigation links for Patents, Trademarks, IP Policy, and Learning and Resources are visible, along with a "Find It Fast" dropdown menu. The breadcrumb trail reads: "Home / Patents: Application Process / Patent Trial and Appeal Board / PTAB Events".

The screenshot shows the sidebar menu for the PTAB Events page. The menu items are: Application process, Search for patents, Learn about patent classification, Filing online, Checking application status, Responding to Office actions, Patent Trial and Appeal Board, Trials, Appeals, Decisions, Hearings, Resources, Statistics, About PTAB, PTAB Help, and Petitions. A red box highlights the "Patent Trial and Appeal Board" item.

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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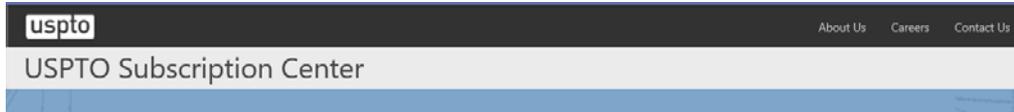
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Next Boardside Chat

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

Thank You

