Supplemental Evidence & Supplemental Information

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Question/Comment Submission

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

PTABBoardsideChat@uspto.gov
Distinguishing supplemental evidence and information

Supplemental evidence
- Offered *solely* to support admissibility of previously filed evidence.

Supplemental information
- Evidence to support an argument on the merits.
- May only be considered if a § 123 motion is both authorized and granted.

Overview

I. Supplemental evidence
II. Supplemental information
III. Combined issues
I. Supplemental evidence
Supplemental evidence overview

Process

• Objection(s)
• Service and filing
• Motion to exclude

37 C.F.R. § 42.64(b)(2)
Supplemental evidence objections

• What is objectionable
• Timing
• Content
Supplemental evidence objection - what

• Supplemental evidence is something offered to support admissibility of previously submitted evidence.

• Deposition evidence - 37 C.F.R. § 42.64(a)
  • Objections to admissibility of deposition evidence are made and cured at the deposition

• Other evidence - 37 C.F.R. § 42.64(b)
  • Objections for other than deposition evidence
Supplemental evidence objection - timing

• Evidence submitted pre-institution.
  • Within 10 business days of institution.

• Evidence submitted post institution.
  • Within 5 business days of service of the evidence.

• 37 C.F.R. § 42.64(b)(1)
Supplemental evidence objection - content

Sufficient particularity

• All objections “must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence.”

37 C.F.R. § 42.64(b)(1)

Grounds

• Federal Rules of Evidence. 37 C.F.R. § 42.62.
• Admissibility. 37 C.F.R. § 42.61.
Supplemental evidence service and filing

• Objections – **filed**, 37 C.F.R. § 42.64(b)(1).

• Supplemental evidence – **served**, 37 C.F.R. § 42.64(b)(2).
Supplemental evidence service and filing

• “Supplemental evidence is not filed at the time of the objection, but simply served, and is filed only in support of an opposition to a motion to exclude. See § 42.64(b)(2).”

Supplemental evidence motion to exclude

• Procedure
• Admissibility only
Supplemental evidence
Motion to exclude - procedure

• A motion to exclude evidence should:

  a) Identify where in the record the objection originally was made;
  b) Identify where in the record the evidence sought to be excluded was relied upon by an opponent;
  c) Address objections to exhibits in numerical order; and
  d) Explain the basis and grounds for each objection.

• Trial Practice Guide Update, 16 (August 2018), https://go.usa.gov/xU7GP;
  37 CFR § 42.64(c)
Supplemental evidence
Motion to exclude - admissibility

• A motion to exclude is not a vehicle for addressing the weight to be given evidence—arguments regarding weight should appear only in the merits documents. Nor should a motion to exclude address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply.

• Trial Practice Guide Update, 16 (August 2018), https://go.usa.gov/xU7GP;
Supplemental evidence
Motion to exclude - admissibility

As explained by the Board, parties may raise issues related to admissibility of evidence (e.g., authenticity or hearsay) in a motion to exclude. See 37 C.F.R. §§ 42.64 and 42.62. In contrast, issues related to credibility and the weight of the evidence should be raised in responses and replies. Further, a motion to exclude may not be used to challenge the sufficiency of the evidence to prove a particular fact, or to present arguments that should have been presented in responses or replies. For instance, arguments related to the issue of whether a U.S. patent or U.S. application publication is prior art under 35 U.S.C. § 102(e) against a substituted claim should be presented in a reply rather than in a motion to exclude.

A party sought to file, prior to institution, a petition from another IPR as supplemental evidence. Permissible?

Not permissible, “supplemental evidence” is a term of art in inter partes review proceedings, governed by 37 C.F.R. § 42.64(b)(2) and “is to be served . . . only in response to an evidentiary objection.” Azure Gaming Macau, Ltd. v. MGT Gaming, Inc., Case IPR2014-01288, slip op. at 3 (PTAB Dec. 4, 2014) (Paper 9).

Also could not be supplemental information prior to institution
II. Supplemental information
Supplemental information overview

• Timing
• Authorizing vs. deciding
• Filing
• Limits
• Admissibility
• Example
Supplemental information - timing

- Not pre-Institution.
- Post institution
  - Up to a month after Institution.
  - More than one month after Institution.

Supplemental information within a month of institution

37 C.F.R. § 42.123(a)

(a) Motion to submit supplemental information.

Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

(1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted.

(2) The supplemental information must be relevant to a claim for which the trial has been instituted.
Supplemental information more than a month from institution

37 C.F.R. § 42.123(b)

Late submission of supplemental information.

A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.
Supplemental information
Responses to comments

• Comment 91: “Since the request must be made within one month of the date the trial is instituted, the patent owner will have sufficient time to address any new information submitted by the petitioner, except in the situation where the party satisfies the requirements of § 42.123(b)”

• Comment 92: “Petitioners are encouraged to set forth their best grounds of unpatentability and supporting evidence in their petitions, lest the petitioner risk a determination by the Board not to institute the review or deny the asserted grounds of unpatentability (§ 42.108(b)).”

Supplemental information
Distinguish authorizing from deciding

• Authorization to file a motion does not necessarily mean the motion will be granted, it is not automatic.

• Possibilities:
  – Denied
    • Deny request to submit motion
    • Authorize submittal of a motion and then deny the motion
  – Granted
    • Authorize submittal of motion and then grant the motion
FURTHER ORDERED that the supplemental information that is the subject of Petitioner’s motion shall be submitted as one or more exhibit(s) with the motion; and

FURTHER ORDERED that the supplemental information exhibit(s) shall not be cited in any papers other than the motion and opposition being authorized by this Order, unless and until the motion is granted or leave to do so is otherwise granted.

Goertek, Inc. v. Knowles Electronics, LLC, Case IPR2013-00614, slip op. at 3 (PTAB Apr. 8, 2014) (Paper 25) (this proceeding terminated without a final written decision)
Supplemental information limits

• May not change the grounds

• May not bolster deficiencies

• Must remain on schedule
Supplemental information limits

- Not information that could have been filed earlier.

- Petitioner’s reply is not a loophole.
  "Oppositions and replies may rely upon appropriate evidence to support the positions asserted. Reply evidence, however, must be responsive and not merely new evidence that could have been presented earlier to support the movant’s motion."

Supplemental information admissibility

We note that our Decision here to grant Petitioner’s Motion to submit the documents (b) – (e) of Exhibit 1010 is not an advisory decision on the admissibility of such evidence.

Supplemental information permitted

Granting PO’s motion to submit a supplemental declaration (123(b)) from its expert that addresses an inconsistency in a prior art reference that PO, and its expert, became aware of only after Petitioner’s Reply.

III. Combined Issues
Distinction

• Supplemental evidence
  – Offered solely to support admissibility previously filed evidence

• Supplemental information
  – Evidence to support an argument on the merits
  – May only be filed if a § 123 motion is both authorized and granted

Combined issues – printed publications

• Petitioner alleges that something either disclosed on a public website or at a conference, or available in a library is prior art.
Question/Comment Submission

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Thank You