

UNITED STATES
PATENT AND TRADEMARK OFFICE



Common Evidence Issues

Presenters:

Judge Sally Medley

Judge Joni Chang

Judge Josiah Cocks

Overview

I. Basics

II. Common Problems

I. Basics

- A. Admissibility
- B. Federal Rules of Evidence
- C. Format

I. Basics - A. Admissibility

- Evidence is: affidavits, transcripts of depositions, and documents
- Evidence must be filed as an exhibit
- Evidence must be taken, sought, and filed in accordance with Part 42 to be admissible
- Additional Requirements for the Petition

37 CFR §§ 42.61, 42.63

I. Basics - B. Federal Rules of Evidence

The Federal Rules of Evidence (FRE) apply

Exceptions:

- As otherwise provided in Part 42
- Portions that apply to criminal proceedings, juries, and other matters not relevant to proceedings under Part 42

37 CFR § 42.62

I. Basics - B. FRE Terminology

FRE Term	Part 42 Term
Judicial Notice	Official Notice
Hearing - As used in FRE804(a)(5)	time for taking testimony
Trial	time for taking testimony

37 CFR § 42.62; *see also* 37 CFR §§ 42.51-42.65

I. Basics – C. Formatting

- Translations
- Numbering
 - Exhibits
 - Pages
- Incorporation by Reference
- Filed with the first document in which it is cited

37 CFR §§ 42.6, 42.63

I. Common Problems

- A. Objections
- B. Supplemental Evidence/ Supplemental Information Distinction
- C. Scope of Reply
- D. Admissibility vs Sufficiency
- E. Expert Testimony

I. Common Problems – Objections

- Depositions
- Other Evidence
 - Timing
 - Content

37 CFR § 42.64

I. Common Problems – Supplemental Evidence/Information

Supplemental Evidence –
evidence **served** by the opposing party to
attempt to demonstrate the admissibility
of other evidence. Rule 64(b)(2).

I. Common Problems – Supplemental Evidence/Information

Supplemental Information

- Evidence submitted by motion post institution
- Is evidence on the merits

37 CFR § 42.123

I. Common Problems – Scope of Reply

“A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, or patent owner response.”

37 CFR § 42.23

I. Common Problems – Admissibility vs Sufficiency

Admissibility of Evidence may be challenged by submitting arguments in a motion to exclude evidence (e.g., authenticity or inadmissible hearsay).

Sufficiency of Evidence to prove a particular fact (e.g., credibility or the weight of the evidence) may be challenged by submitting arguments in a patent owner response or reply.

I. Common Problems – Expert Testimony

- Underlying Data
- Excluding

37 CFR §§ 42.64-65

Questions?

Thank You

