

May 11, 2016

# Post-Grant for Practitioners

## Evidentiary Trends at the PTAB (Part 1)



**Thomas Rozylowicz**  
*Principal*

**Steve Schaefer**  
*Principal*

**David Holt**  
*Associate*

- I. Overview of Webinar Series
- II. Statistics
- III. Evidentiary Objections - Evidence Weight and Admissibility
- IV. Evidence Strategy and PTAB Evidence Procedures
- V. Timing of Evidence Submitted and Limitations for both Petitioners and Patent Owners
- VI. Upcoming Post-Grant Webinar: Evidentiary Trends at the PTAB (Pt. 2) – Bias and Credibility, will be lead by Fish Principal Steve Schaefer on June 8<sup>th</sup>
- VII. Post Grant Resources



# Overview of Webinar Series

- Where? ... see invitation
- How often? ... monthly
- When? ... 2<sup>nd</sup> Wednesday
- Topics? ...
  - Important decisions
  - Developments
  - Practice tips
- Housekeeping
  - CLE
  - Questions
  - Materials
    - <http://fishpostgrant.com/webinars/>

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**Post-Grant  
for Practitioners**

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### Evidentiary Trends at the PTAB

Join Fish attorneys [Thomas Rozylowicz](#), [Stephen Schaefer](#), and [David Holt](#), as they discuss evidentiary trends at the Patent Trial and Appeal Board (PTAB) and provide practical insights for practitioners on how to prepare and submit evidence to support either a petitioner or patent owner position. Topics will include:

- Evidentiary objections - evidence weight and admissibility
- Evidence strategy and PTAB evidence procedures
- Timing of evidence submitted and limitations for both petitioners and patent owners

[Register](#) now for this Post-Grant for Practitioners Webinar.

Wednesday, May 11, 2016  
1:00 PM - 2:00 PM ET  
Via the web

Speakers:

 <p><a href="#">Thomas Rozylowicz</a> <a href="mailto:rozylowicz@fr.com">rozylowicz@fr.com</a> Principal, Washington, DC</p>	 <p><a href="#">Stephen Schaefer</a> <a href="mailto:schaefer@fr.com">schaefer@fr.com</a> Principal, Minneapolis, MN</p>	 <p><a href="#">David Holt</a> <a href="mailto:holt@fr.com">holt@fr.com</a> Associate, Washington, DC</p>
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**REGISTER**

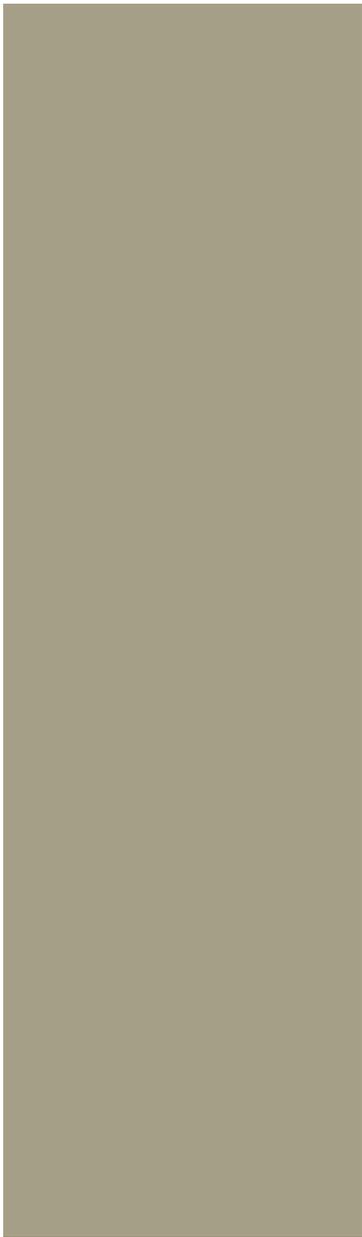
Fish & Richardson will apply for 1.0 hour of general CLE credit in most states. If you would like to receive CLE credit, register with your state bar information.

If you have questions, please contact Crystal Chisholm at [chishom@fr.com](mailto:chishom@fr.com)

 <p>Never miss an update! Sign up for the eNewsletters of your choice.</p>	 <p>View webinar replays from our Post-Grant for Practitioners series.</p>	 <p>Connect with Fish &amp; Richardson on LinkedIn</p>	 <p>Follow Fish &amp; Richardson on Twitter</p>
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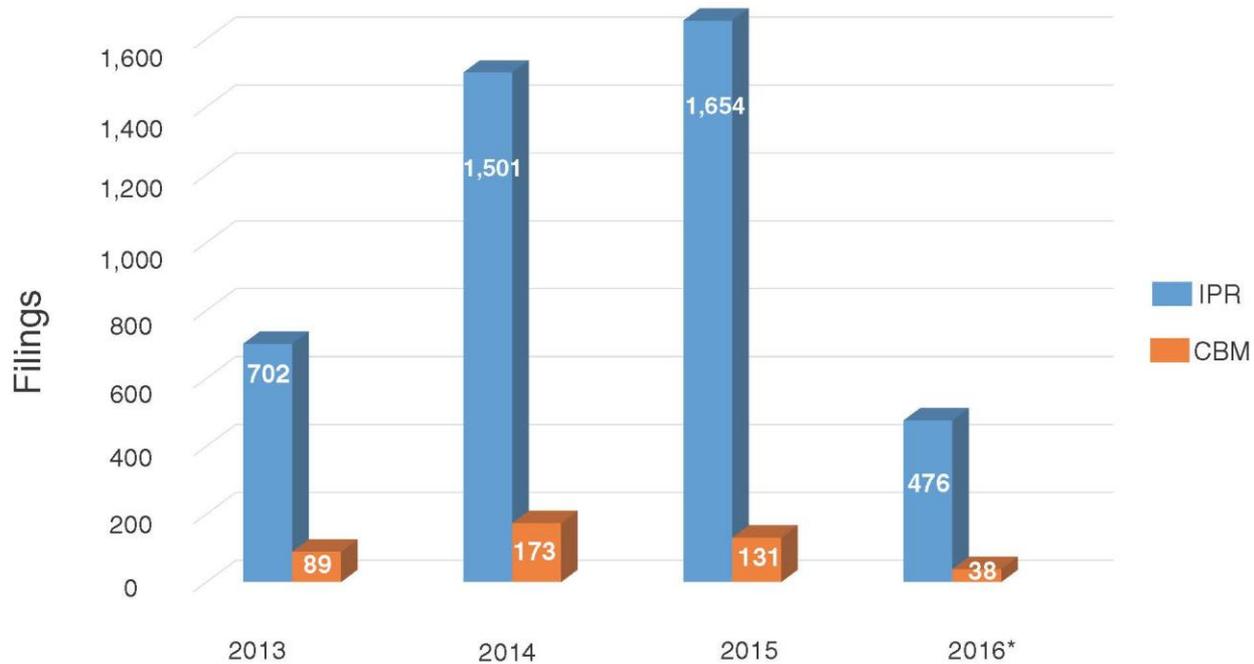


Statistics



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## Trial Filings



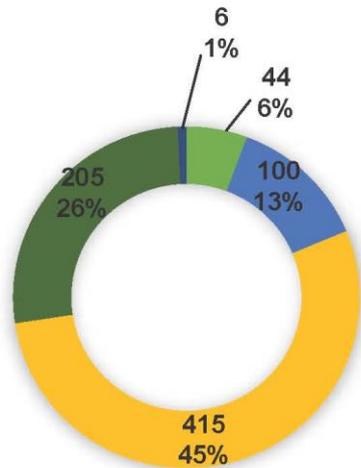
\*2016 numbers are year-to-date. Numbers are through May 4, 2016.

## Trial Status

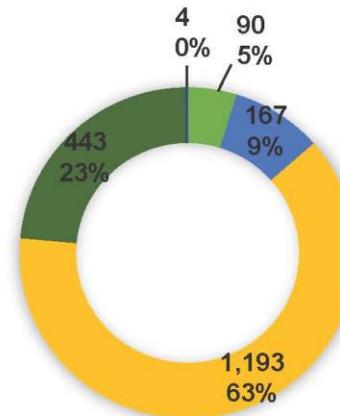


Source: LexMachina PTAB Trial Data, filed between 2013 and May 4, 2016.

**770 Total AIA Petitions in FY 16\***  
(Technology Breakdown)

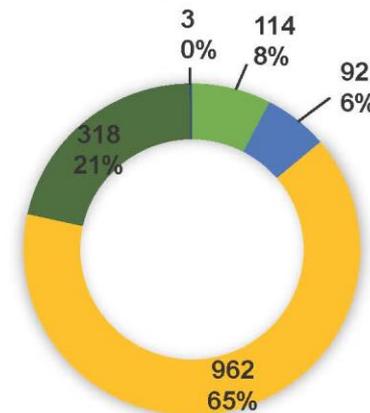


**1897 Total AIA Petitions in FY 15\***  
(Technology Breakdown)



**Narrative:** The pie chart shows the total number of AIA petitions filed in the current fiscal year to date as well as the number and percentage of these petitions broken down by technology.

**1489 Total AIA Petitions in FY 14\***  
(Technology Breakdown)



- Electrical/Computer - TCs 2100, 2400, 2600, 2800
- Mechanical/Business Method - TCs 3600, 3700
- Chemical - TC 1700
- Bio/Pharma - TC 1600
- Design - TC 2900

\*Data current as of 3/31/2016

Source: USPTO Patent Trial and Appeal Board Statistics, 3/31/2016



Evidentiary Objections -  
Evidence Weight and  
Admissibility

- Overview of Timing
- Pillars of PTAB Evidentiary Consideration
- Absolute Exclusion
- Evidence Greatly Diminished
- Evidence Entered
- Takeaways



# Overview of Timing

# Overview of Timing

- Burden on Petitioner to establish prima facie case
  - Petitioner must introduce all substantive positions here; no new arguments allowed later
- Optional Preliminary Patent Owner's Response may be filed 3 months after awarding a filing date
- Due Date 1 - Patent Owner's Response (POR)
  - ~3 months after Institution Decision
- Due Date 2 - Petitioner's Reply
  - ~3 months after POR
- Due Date 4
  - Observations
  - Motions to Exclude
  - ~45 days after Due Date 2
- Due Date 5
  - Opposition to Motion to Exclude
  - Response to Observations
  - ~7 days after Due Date 4
- Due Date 6
  - Reply to Opposition to Motion to Exclude
  - ~7 days later



# Pillars of PTAB Evidentiary Considerations

# Overview – Pillars of PTAB Evidentiary Considerations

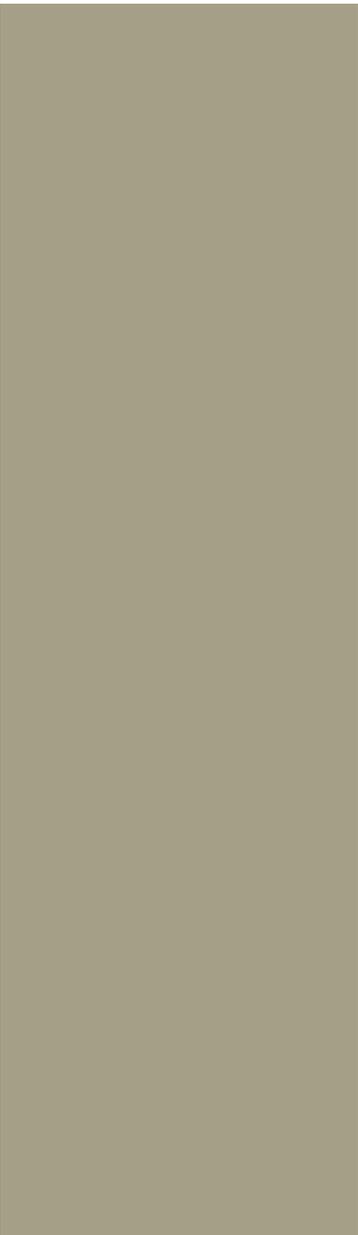
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- Consistent with the Federal Rules of Evidence (FRE), there is a presumption that evidence will be entered unless there is a reason why it should be excluded
- Petitioner may not raise new arguments or fix prior defects
- Evidence appearing in affidavit must actually be relied upon
- Uncorroborated testimony is entitled to little or no weight
- No evidence can be relied upon unless the other side had the opportunity to examine and rebut that evidence

# Practical application of these principles

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- Consider these principles with the impact of a limited schedule
  - Evidentiary matters are decided in Final Written Decision with decision on merits
- Expert affidavit needs to be well-integrated document
  - Well integrated with Petition
  - Well integrated with corroborating evidence
- Multiple bases for a position should exist
  - Avoid single points of failures
- Many evidentiary objections are made with goal of diminishing impact rather than realistic opportunity to actually exclude evidence in question



Absolute Exclusion

# Absolute Exclusion (Part 1)

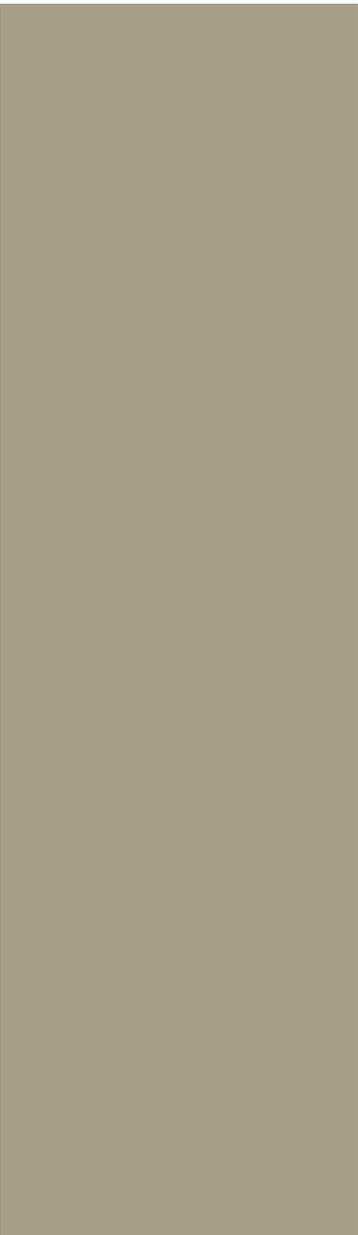
- Must rely upon the exhibit in written record or non-excluded part of declaration
  - **Example Cases**
    - IPR2015-00108 (non-opposed motion re Petitioner's exhibit)
    - IPR2015-00017 (non-opposed motion re Petitioner's exhibit)
    - IPR2014-00679 (opposed motion re Patent Owner's exhibit)
- Must submit evidence in the earliest practicable filing
  - **Example Cases**
    - IPR2014-01506: Patent Owner submitted "summary" evidence in a sur-reply. Board excluded as late and admittedly cumulative. Other evidence excluded because no translation filed (PO argued it was relied upon for its existence not its content so no translation needed, but Board said it couldn't even rely upon it for that without ability to review content)
    - IPR2014-01445: Authentication evidence submitted with Petitioner Reply (which was outside of ten-business days from PO's original evidentiary objection) was excluded as untimely. Petitioner argued it was evidence responsive to an argument made in the PO Response, but Board said that doesn't mean it wasn't untimely. Petitioner ideally should have put it in the Petition, but at the latest should have sought to serve and file it within ten business days of objection from PO.

# Absolute Exclusion (Part 2)

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- Cannot Introduce New Theories or Non-Responsive Arguments in Replies
  - **Example Case**
    - IPR2014-01557: Excluded portions of reply. Need to ensure that evidence in reply is (1) responsive to PO arguments from response and (2) supportive of original theory of how prior art applies to the claims, not a new theory.
- Know the Federal Rules of Evidence (Hearsay, Relevance, Leading Qs)
  - **Example Cases**
    - IPR2014-01188: Hearsay evidence (article with quoted statements from petitioner's employee) was excluded under FRE.
    - IPR2014-01146: Board excluded leading questions on redirect under FRE 611.
    - IPR2014-01164: Petitioner couldn't persuasively explain how previous expert statements support asserted combination of references, because it didn't appear to pertain to those two references.
    - CBM2013-00038: Limits on scope of lay witness testimony. Declarant was not being offered as an expert, so a portion of testimony was excluded because PO couldn't prove statements were within personal knowledge of declarant.

- Know the Federal Rules of Evidence: Authentication
  - **Example Cases**
    - IPR2014-01348: Interesting case with a dissent. Primary references (IEEE papers) are excluded as unauthenticated. Two members granted because Petitioner made no effort to submit authenticating evidence either after the objection or in the opposition to Motion to Exclude (MTE). Dissenter felt the PO was using MTE as end-run around arguing sufficiency of “publication” in its case-in-chief. Lesson seems to be that you should always take every objection seriously and submit necessary evidence as early as possible.
    - IPR2014-00148: Product spec sheet excluded because not enough information given (e.g., source information and/or decs from people with knowledge) even where screenshot was submitted showing "created" and "modified" dates for the PDF. Board said the provenance of these screenshots were not properly explained with declaration support
    - IPR2013-00578: Fascinating case with relatively long list of exclusions
      - Authenticating evidence needs to be from an unbiased third party. In this case the, inventors declaration authenticating a lab notebook that was used to support date of invention was not sufficient due to potential bias of inventor.
      - Photos of library catalogs showing dates of a prior art paper are hearsay. Presumably, Petitioner would need to get a declaration from someone willing to testify to the procedure behind the business record



Evidence Greatly Diminished

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# Evidence Greatly Diminished

- Testimony given little weight when expert affidavit is unclear. See e.g., IPR2014-00869.
  - How references are being combined,
  - Uncorroborated with objective facts, and
  - Mimics language and positions of Petition in verbatim manner.
- Testimony that does not provide the underlying facts is entitled to little or no weight. See e.g., IPR2015-01269.
  - Considering whether testing methodology is disclosed.
  - Imperative in chemical or materials science cases.
- Evidence given little weight where PTAB focused on what was said in petition vs. what was actually disclosed in the underlying references themselves. See e.g., IPR2013-00048.
- Evidence given little weight where party does not rely upon cited evidence, and/or party fails to rely upon methodology disclosed. See e.g., IPR2013-00049.
- Testimony given little weight where test methodology was not disclosed. See e.g., IPR2015-01867.
- Testimony given little or no weight where supporting evidence re motivation to combine is very thin. See e.g., IPR2014-01476.



Evidence Entered



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- Proper manner to address corroborating testimony is with rebuttal evidence. *See, e.g.*, IPR2013-00214.
- Just because PTAB reached a contrary conclusion does not mean that evidence was not considered or given little or no weight. *See, e.g.*, IPR2013-00028.
- If the PTAB does not rely upon evidence to reach its decision, objection will often be considered moot and evidence will not be excluded. *See, e.g.*, IPR2015-00014.
- New evidence is allowed in a Reply, as long as its responsive to opposing party's arguments and does not change original theory. *See, e.g.*, IPR2015-00014.
- Whether a reference is publically available publication is issue for case-in-chief, not for motion to exclude. *See, e.g.*, IPR2014-01445.



# Takeaways



# Takeaways

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- Submit early and under the rules, and there's a good chance your evidence will be kept on the record
  - Know the objections most often raised, and consider supplementing evidence to avoid the objection in the first place (e.g., authenticating evidence)
- PTAB usually exercises discretion to assign appropriate weight and does not exclude.
  - Beyond exclusion, if you want evidence given weight, you need to establish sufficient evidentiary foundations for factual assertions that are key to case.
- Do not be cavalier in dismissing evidentiary objections
  - POs should always argue sufficiency of proof re public availability and publication in PO response, not just motion to exclude. Board is sensitive to where things are argued.
  - Take advantage of opportunity to provide supplemental evidence.



# Post-Grant for Practitioners Webinar Series

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## Mark your Calendar!

Wednesday, June 8

### **Post-Grant Webinar**

Topic: Evidentiary Trends at the PTAB (Pt. 2) – Bias and Credibility

Part 2 of this series will take a deep dive into witness credibility and bias, and how the PTAB has treated those issues. Additional topics will explore considerations in view of the fact that witness testimony in nearly all cases is evaluated by the PTAB on the papers, as opposed to seeing live witness testimony.

Fish Principal Steve Schaefer will lead the June 8<sup>th</sup> presentation.

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# Post-Grant Resources

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- In Fish & Richardson’s initial 7-part webinar series titled “Challenging Patent Validity in the USPTO,” we explored details regarding several of the post grant tools, with 3 sessions dedicated to Inter Partes Review (IPR), and a final session walking through several hypotheticals, to help listeners understand how these apply to common situations.
- Audio and slides for these webinars are posted online at:  
<http://fishpostgrant.com/webinars/>
- If you listen to these webinars, you will be well positioned to engage in a conversation over whether and when to use those tools and how to defend against them.

- Fish web sites:
  - Post-Grant for Practitioners: <http://fishpostgrant.com/webinars/>
  - General: <http://fishpostgrant.com/>
  - IPR: <http://fishpostgrant.com/inter-partes-review/>
  - PGR: <http://fishpostgrant.com/post-grant-review/>
  - Rules governing post-grant: <http://fishpostgrant.com/>
  - Post-Grant App: <http://fishpostgrant.com/app/>
- USPTO sites:
  - AIA Main: [http://www.uspto.gov/aia\\_implementation/index.jsp](http://www.uspto.gov/aia_implementation/index.jsp)
  - Inter Partes: [http://www.uspto.gov/aia\\_implementation/bpai.jsp](http://www.uspto.gov/aia_implementation/bpai.jsp)

# Thank You!

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