

Title: Request For Clarification Whether to File Objections to Evidence When Objections Are Served

By Rick Neifeld, Neifeld IP Law, PC¹

This article contains a copy of an email I sent to the PTAB on 11/5/2014 requesting clarification on the PTAB's interpretation of its rule on objections to evidence, 37 CFR 42.64.

Date: 11/5/2014

To: PTAB at Trials@USPTO.GOV

I. INTRODUCTION

I administer the <https://groups.yahoo.com/neo/groups/PatentInterPartes/info> group dedicated to dissemination of information related to PTAB practice. I note that the PTAB has provided *conflicting* guidance whether to file objection to evidence concurrent with service of the objections. I wish you to provide clarification in writing on this issue. Some PTAB decisions indicate that filing of objections to evidence concurrent with their service is improper. Yet the PTAB has informally advised practitioners to file objections to evidence concurrent with their service, and some PTAB decisions indicate filing of objections to evidence concurrent with their service is not improper.

Counsels and parties ask me whether to file objections when they serve the objections. I would like to be in a position to give them an answer they can rely upon. The lack of clarity on this issue is not consistent with the policy of just, speedy, and inexpensive resolution of proceedings specified in 42.1(b). You need to provide clarification to the public and to provide a uniform policy that all PTAB personnel will follow on this issue.

II. DETAILS

42.7 is titled "§ 42.7 Management of the record." 42.7(a) states "(a) The Board may expunge any paper directed to a proceeding or filed while an application or patent is under the jurisdiction of the Board that is not authorized under this part or in a Board order or that is filed contrary to a Board order. "

42.64 is titled "Objection; motion to exclude; motion in limine."

42.64(b) states "(b) *Other evidence*. For evidence other than deposition evidence: (1) *Objection*. Any objection to evidence submitted during a preliminary proceeding must be served within ten business days of the institution of the trial. Once a trial has been instituted, any objection must be served within five business days of service of evidence to which the objection is directed. The objection must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence."

42.64(c) states "(c) *Motion to exclude*. A motion to exclude evidence must be filed to preserve any objection. The motion must identify the objections in the record in order and must explain the objections. The motion may be filed without prior authorization from the Board."

42.64(b) requires service of objections to evidence, but excludes authorization to file such objections. *Inclusio unius est exclusio alterius*. 42.64(c) requires the objections be "in the record" to support a motion to exclude. The conventional interpretation of these facially contradictory requirements in 42.64(b) and (c) is that, if a motion to exclude is filed, when the motion is filed the objections must be made exhibits and served and filed in support the motion, but not before.

In some cases, you have exercised your authority to expunge objections filed concurrent with their service. See Mitsubishi Plastics, Inc. v. Celgard, LLC, IPR2014-00524, paper 17 (PTAB 10/215/2014) (Order by APJ Crumbley, for a panel consisting of APJs Prats, Praiss, and Crumbley):

The Board's Rules do not require, nor have we authorized, the parties to file objections to evidence with the Board. See *SIPNet EU SRO v. Straight Path IP Group, Inc.*, Case No. 2013-00246, slip op. 3 (PTAB Dec. 12, 2013) (Paper 28). Such objections, and any supplemental evidence served in response, are only to be filed with the Board in the event they later become the basis of a Motion to Exclude Evidence. See *Sealed Air Corp. v. Pregis Innovative Packaging, Inc.*, Case IPR2013-00554, slip op. 2-3 (PTAB Apr. 1, 2014) (Paper 18). *** ORDERED that Paper 16 shall be expunged from the record of this proceeding.

In this Order, the decision emphasized the word "service" appearing in 42.64(b), to support the conclusion that 42.64(b) did not authorize filing of exhibits.

In other cases, you have not exercised this authority while noting the existence of objections filed apparently concurrent with their service. For example, in American Honda Motor Co., Inc. v. American Vehicular Sciences LLC, IPR2014-00633, paper 15 (PTAB 11/3/2014) (Order by APJ Parvis, for APJs Parvis and Anderson), the panel discussed filed objections in consideration of some issue, without recognizing that the filing of the discussed objections was not authorized.

III. CONCLUSION

Consistent with 42.1(b) and your obligations to the public, the PTAB should specify to the public whether or not to file objections to evidence when the objections are served on opposing parties. I intend to post your response to the <https://groups.yahoo.com/neo/groups/PatentInterPartes/info> group.

Please advise.

Truly, Rick Neifeld, Ph.D., Patent Attorney

1. I can be reached via telephone at 1-703-415-0012, or via the firm's web site at: <http://www.neifeld.com/cv.html#neifeld>.