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# PTAB HIGHLIGHTS

New developments in post-issuance proceedings

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## PTAB Draws Line on Admissibility of Declaration Evidence in IPR

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September 3, 2014 — In a break from the PTAB’s trend of admitting evidence and allowing objections to admissibility to go to the weight of the evidence, the Board excluded testimonial evidence concerning the contents of documents that were not produced.

[IPR2013-00159 – Zodiac Pool Systems, Inc. v. Aqua Products, Inc. \(Paper 71, August 22, 2014\)](#)

The Patent Owner filed a motion to exclude evidence. Specifically, the Patent Owner moved to exclude several paragraphs of a declaration of one of Petitioner’s employees. In its final written decision finding all challenged claims unpatentable, the Board admitted into evidence most paragraphs of the declaration — explaining that the PTAB is “capable of according the appropriate weigh to testimony.” However, the Board drew the line when it came to a paragraph of the declaration that discussed the contents of documents that were referenced but not produced.

The Patent Owner argued that a particular paragraph of the declaration relied on information that was not produced or was in a foreign language (without English translations), and therefore, should be excluded from evidence as being prejudicial and contrary to Patent Office practices. The paragraph of the declaration referred to an engineering study, three sealed envelopes serving as proof of filing applications with France’s patent office, and nine French patent applications. The Petitioner, however, produced only one of these documents (one of the envelopes) and some supporting documents, which were in French. The Petitioner argued that at least a portion of the disputed paragraph should be admitted into evidence. Specifically, the Petitioner argued for admission of the following, offered for the purpose of disproving Patent Owner’s assertion that Petitioner copied the Patent Owner:

Zodiac had a third party engineering company conduct an engineering study, including a flow analysis on the inverted pump design and engineering drawings. This analysis took place in the spring and summer of 2007.

The Board found this part of the declaration inadmissible, stating that the “sentences relate to the content of cited documents, rather than solely to ‘facts that occurred.’” Accordingly, the Board granted, in part, the Patent Owner’s motion to exclude.

*The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office’s Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer weekly summaries of the board’s significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.*



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