

# Seyfarth PTAB Blog



## A legal look at Patent Trial and Appeal Board decisions and trends

### Filing vs. Serving - The PTAB Splits Another Hair

By Patrick T. Muffo

The admissibility of evidence is an important consideration for many PTAB proceedings. The procedures for objecting to and admitting evidence can be nuanced and, as often is the case with the PTAB, the devil is in the details. Panels are also quick to point out that non-precedential decisions from other panels have no binding effect such that different panels may operate under slightly different procedural rules. One panel clarified the process for handling evidentiary objections to shed some light on the correct manner of curing objections or challenging the admissibility of evidence.

The case of *Taiwan Semiconductor Manufacturing Company, Ltd. v. Godo Kaisha IP Bridge 1*, Case IPR2016-01249 and IPR2016-01264 (January 20, 2017 Order) clarified the process for objecting to evidence and the manner of curing such objections. Taiwan Semiconductor objected to evidence filed by Godo Kaisha, and Godo Kaisha filed supplemental evidence in an attempt to cure the objection. Taiwan Semiconductor then objected to the **filing** of the supplemental evidence, arguing it should have instead been **served** under 37 C.F.R. § 42.64(b)(1) and (2):

(1) Objection. Any objection to evidence submitted during a preliminary proceeding must be **filed** within ten business days of the institution of the trial. Once a trial has been instituted, any objection must be **filed** within five business days of service of evidence to which the objection is directed...

(2) Supplemental evidence. The party relying on evidence to which an objection is timely served may respond to the objection by **serving** supplemental evidence within ten business days of service of the objection.

The PTAB agreed with Taiwan Semiconductor, first contrasting the terminology from 37 C.F.R. § 42.64(b)(1) and (2) (emphasized above) and expunging the filed evidence from the record. The PTAB explained the reasoning for such a bright line rule as follows:

The rule does not require (or authorize) the filing of supplemental evidence at the time it must be served. This is so because it is contemplated that, in some instances, supplemental evidence will cure objections to the satisfaction of the objecting party. In those instances, the supplemental evidence never becomes relevant to any issue that must be decided by the panel.

The Board did leave open the possibility of such evidence being filed in the hypothetical situation where the parties disagree about whether the supplemental evidence cured the objection, and the objecting party files a motion to exclude:

In other instances, supplemental evidence served on an objecting party may not cure the objections to the satisfaction of the objecting party, and the objecting party may thereafter file a motion to exclude. If the evidence-proffering party opposes the motion to exclude, it may file supplemental evidence (assuming it had been previously timely served) to support the arguments for admissibility it makes in its opposition brief.

## Takeaway:

This Order clarifies the process as follows: (1) serving party files evidence; (2) opposing party objects; (3) serving party can cure objection by serving, not filing, additional evidence;

(4) opposing party may then maintain their objection and file a motion to exclude; and (5) serving party may then file evidence in response to motion to exclude.

[Patrick T. Muffo](#) is an author of the Seyfarth PTAB Blog and Partner in the firm's Chicago office. For more information, please contact a member of the Patent Practice Group, your Seyfarth Shaw LLP attorney, or Patrick Muffo at [pmuffo@seyfarth.com](mailto:pmuffo@seyfarth.com).

[www.seyfarth.com](http://www.seyfarth.com)



Attorney Advertising. This PTAB blog post is a periodical publication of Seyfarth Shaw LLP and should not be construed as legal advice or a legal opinion on any specific facts or circumstances. The contents are intended for general information purposes only, and you are urged to consult a lawyer concerning your own situation and any specific legal questions you may have. Any tax information or written tax advice contained herein (including any attachments) is not intended to be and cannot be used by any taxpayer for the purpose of avoiding tax penalties that may be imposed on the taxpayer. (The foregoing legend has been affixed pursuant to U.S. Treasury Regulations governing tax practice.)

---

Seyfarth Shaw LLP PTAB Blog | February 14, 2017

©2017 Seyfarth Shaw LLP. All rights reserved. "Seyfarth Shaw" refers to Seyfarth Shaw LLP (an Illinois limited liability partnership). Prior results do not guarantee a similar outcome.