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# IP Newsflash



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## PATENT TRIAL AND APPEAL BOARD

### Improper Submission of New Evidence Undermines Patent Challenge

In its final written decision, a PTAB panel granted a patent owner's (owner) motion to exclude evidence submitted by a petitioner in support of its unpatentability positions. Under the AIA, "[a] reply may only respond to arguments raised in the corresponding opposition. While replies can help crystalize issues for decision, a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned." In its reply to the owner's response, the petitioner submitted new test results designed to show that the claimed properties are inherently described in prior art compositions. The Board granted the owner's motion to exclude those test results, explaining that "submission...of this 'new' evidence at the reply stage in this *inter partes* review strikes us as prejudicial to [the owner]." In holding that the submitted test results do more than merely address points made in the owner's response, the Board found that the "new evidence sought to be 'excluded' relies on post-petition and post-patent owner response testing using a protocol different from that used for the testing offered with the petition." After determining that this "new" evidence was not properly submitted and would be denied consideration, the Board ruled that the petitioner failed to show by a preponderance of the evidence that the challenged claims are unpatentable.

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*Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00047 (PTAB May 1, 2014) [McKelvey (opinion), Obermann, Bisk, Kamholz, Yang]

### Patent Owner's Defective Motion to Exclude Evidence Denied by PTAB

A PTAB panel has rejected a patent owner's request to exclude evidence submitted by the petitioner in an *inter partes* review proceeding after finding several defects in the motion to exclude. The patent owner sought to exclude testimony from the petitioner's expert that certain prior art disclosed claim elements of the patent under review. In its order, the Board pointed out several defects regarding the patent owner's motion to exclude. According to the Board, a motion to exclude should identify with particularity the evidence to be excluded. Here the patent owner referred to certain paragraphs in the petitioner's expert declaration as exemplary of the objectionable evidence. The Board determined that such an assertion was too vague and that the Board would not engage in guesswork regarding which evidence to exclude. Additionally, the patent owner failed to identify where in the record the petitioner relied on the allegedly objectionable evidence. According to the panel, the Board requires this information to determine the effect of any exclusion on the proponent's case. Furthermore, the Board pointed out that when evidence is challenged as unreliable, the nature of the alleged unreliability must be stated explicitly. Here, the Board could not determine if the unreliability related to the principles and methods employed by the petitioner's expert, or to the application of those principles and methods to the facts of the case. In particular, the patent owner did not explain what principles the petitioner's expert improperly employed in considering the differences between the alleged invention and the prior art. Finally, according to the Board, the patent owner did not come forward with any credible evidence of its own to support its objections. Instead, the patent owner relied on conclusory statements from its own expert. According to the Board, that testimony did not explain why the absence of evidence undermined the reliability of the testimony to a degree requiring exclusion. The Board, therefore, denied the motion to exclude.

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*Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00050 (PTAB May 1, 2014) [McKelvey, Obermann, Bisk, Kamholz (opinion), Yang]

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