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IP Newsflash



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PATENT TRIAL AND APPEAL BOARD

Supplemental Information Containing Petitioner's Statements Allowed in IPR

A PTAB panel has granted a patent owner's (owner) motion to submit supplemental information in an *inter partes* review (IPR). A motion to submit supplemental information in an IPR proceeding must show why the information reasonably could not have been obtained earlier and that consideration of the supplemental information would be in the interests of justice. 37 C.F.R. § 42.123(b). Here, the owner sought to submit two supplemental documents — a pair of emails with attachments — that contained statements by the petitioner suggesting that certain scientific testing results were unreliable. In opposing the motion, the petitioner argued that the "documents in question had been produced to [the owner] several months before [the owner] filed its Response, and that [the owner's] failure to submit them with the Response is no more than attorney negligence." The Board ultimately determined that the interests of justice would be served by allowing entry of the supplemental information. In reaching its decision, the Board explained that "[the] documents are Petitioner's own statements and relate directly to an argument Patent Owner has advanced in its Response." In addition, the Board determined that the petitioner would not be prejudiced because the "petitioner will have an opportunity to cross-examine [the owner's] witness about the supplemental documents and may introduce direct testimonial evidence with its Reply that is responsive to the supplemental documents."

Author: [Matthew G. Hartman](#)

Cyanotech Corp. v. Board of Trustees of Univ. of Illinois, IPR2013-00401 (PTAB May 9, 2014) [Kamholz, Snedden (opinion), Braden]

Motion to Exclude Evidence Due to Alleged Unreliability Denied by PTAB

In a final written decision, a PTAB panel has denied a patent owner's motion to exclude the expert testimony of the petitioner's declarant. In its motion, the patent owner argued that the testimony should be excluded as unreliable on two grounds, namely, because the expert failed to review data underlying his opinions, and because he failed to apply the correct legal standard for obviousness. According to the Board, whether a witness' testimony fails to include underlying facts or data on which an opinion is based goes to the weight accorded to the testimony, and not to its admissibility. The Board further determined that the patent owner's arguments concerning the legal standard for obviousness were not persuasive. Specifically, the patent owner argued that the petitioner's expert gave no consideration to the relevant time period when addressing who a person of skill in the art is for obviousness purposes. On this point, the Board concluded that the thoroughness of the petitioner's expert testimony outweighed the concern expressed by the patent owner. The Board, therefore, denied the patent owner's motion to exclude evidence on all grounds.

Author: [Rubén H. Muñoz](#)

Corning Inc. v. DSM IP Assets B.V., IPR2013-00048 (PTAB May 9, 2014) [McKelvey, Obermann, Bisk, Kamholz (opinion), Yang]

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