UNITED STATES
PATENT AND TRADEMARK OFFICE

Patent Trial and Appeal Board Boardside Chat:

Use of Expert Witness Testimony

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UNITED STATES
PATENT AND TRADEMARK OFFICE
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Question/comment submission

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Agenda

- Expert's role in proceedings before the Board
- Discussion of hypothetical situations & practical problems
- Panel Q&A

Expert’s role in proceedings before PTAB

Federal Rule of Evidence 702

A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if:

- **(a)** the expert's scientific, technical, or other specialized knowledge will *help the trier of fact* to understand the evidence or to determine a fact in issue;
- **(b)** the testimony is *based on sufficient facts* or data;
- **(c)** the testimony is the *product of reliable principles* and methods; and
- **(d)** the expert has *reliably applied the principles and methods* to the facts of the case.

Basic principles

- Expert Declaration is a form of *direct* testimony/evidence; substitutes for taking direct witness testimony at trial
- Opinions supported by underlying facts and data
- Testimony on U.S. Patent Law not admissible
- Subject to *cross-examination*
- Depositions of experts are *NOT discovery depositions*

Some relevant rules for IPRs

- 37 C.F.R. § 42.53(a) – Taking testimony, e.g., uncompelled direct by affidavit
- 37 C.F.R. § 42.62 – FRE generally apply, e.g., FRE 702 (expert qualifications), 703 (bases of opinion), FRE Article 8 rules re hearsay
- 37 C.F.R. § 42.63 – Forms of evidence, e.g., affidavit, deposition transcript

Some relevant rules for IPRs (cont.)

- 37 C.F.R. § 42.64 – Objections, Motions to Exclude
- 37 C.F.R. § 42.65 – Expert testimony; tests and data, e.g., facts, data supporting opinion; testimony on patent law not admissible
- 37 C.F.R. § 42.105(a)(5) – Content of Petition
- 37 C.F.R. § 42.107 – Preliminary Response

More relevant resources

- Consolidated Office Trial Practice Guide pp. 22-34 (Discovery), pp. 34-36 (Expert Testimony) (Nov. 2019)
- **PTAB cases:**

  Depositions

  - *Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, Paper 55 (Aug. 7, 2013) (informative) [guidelines for foreign language depositions]
  - *Focal Therapeutics, Inc. v. SenoRx, Inc.*, IPR2014-00116, Paper 19 (July 21, 2014) (precedential) [deposition conduct]

More relevant resources

- **PTAB cases:**

  Discovery, 35 U.S.C. § 316(a)(5)

  - *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (March 5, 2013) (precedential) [factors]
  - *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, CBM2013-00005, Paper 32 (May 29, 2013) (precedential) [factors]
  - *Arris Grp., Inc. v. C-Cation Techs., LLC*, IPR2015-00635, Paper 10 (May 1, 2015) (informative) [preclusion]

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Recent Request for Comments

Request for Comments on

- Director review
- Precedential Opinion Panel review
- Internal circulation and review of PTAB Decisions

- Published on July 20, 2022
- Comments will be accepted through October 19, 2022
- Federal Register:
  - https://www.federalregister.gov/documents/2022/07/20/2022-15475/request-for-comments-on-director-review-precedential-opinion-panel-review-and-internal-circulation
- Federal eRulemaking Portal:
  - www.regulations.gov search?filter=PTO-P-2022-0023

Hypothetical situations & practical problems

Hypothetical no. 1

- Petitioner's expert has a PhD in electrical engineering and 20 years of experience in industry designing audio sound systems for automobiles.
- The patent claims being challenged relate to audio sound systems for the home.
- Patent owner moves to exclude the expert's testimony on the ground that the expert's experience is in a different field from the patent.
- Petitioner moves to submit supplemental information establishing the relevance of the expert's experience to the field of the patent.

Hypothetical no. 1

In ruling on the motions, the Board should:

A. Exclude the expert's testimony because the expert is not qualified.

B. Grant petitioner's motion to submit supplemental information but provide additional discovery so patent owner can challenge the supplemental information.

C. Exclude the expert's testimony, but permit petitioner to substitute the declaration of a better qualified expert.

D. None of the above.

Hypothetical no. 1

- Petitioner's expert has a PhD in electrical engineering and 20 years of experience in industry designing audio sound systems for automobiles.
- The patent claims being challenged relate to audio sound systems for the home.
- Patent owner moves to exclude the expert's testimony on the ground that the expert's experience is in a different field from the patent.
- Petitioner moves to submit supplemental information establishing the relevance of the expert's experience to the field of the patent.

Hypothetical no. 1

Kyocera Senco Indus. Tools v. ITC, 22 F.4th 1369,1376-77 (Fed. Cir. 2022)

"To offer expert testimony from the perspective of a skilled artisan in a patent case . . . a witness must at least have ordinary skill in the art."

Hypothetical no. 1

Best Medical Int'l, Inc. v. Elekta Inc., _ F.4th _ , 2022 WL 3693470 (Fed. Cir. Aug. 29, 2022)

Provides a non-exhaustive list of factors that may guide the fact finder in finding the appropriate level of skill in the art:

(1) the educational level of the inventor;

(2) type of problems encountered in the art;

(3) prior art solutions to those problems;

(4) rapidity with which innovations are made;

(5) sophistication of the technology; and

(6) educational level of active workers in the field.

Hypothetical no. 2

- Petitioner presents an expert declaration copied from another IPR.
- Patent owner moves to compel production of the expert for a deposition, or, in the alternative, to strike the declaration.
- Petitioner opposes both motions.

Hypothetical no. 2

In ruling on the motions, the Board should:

A. Grant patent owner's motion to compel and authorize patent owner to obtain a subpoena to compel petitioner's expert to appear for a deposition.

B. Deny patent owner's motion to compel but caution petitioner that the declaration may not be admissible without cross-examination of the expert.

C. Deny patent owner's motion to compel but grant patent owner's motion to strike the declaration.

D. None of the above.

Hypothetical no. 2

- Petitioner presents an expert declaration copied from another IPR.
- Patent owner moves to compel production of the expert for a deposition, or, in the alternative, to strike the declaration.
- Petitioner opposes both motions.

Hypothetical no. 2

- **37 C.F.R. § 42.51 – Discovery**

(b)(1)Routine discovery. Except as the Board may otherwise order:

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(ii) Cross examination of affidavit testimony *prepared for the proceeding* is authorized within such time period as the Board may set.

Hypothetical no. 2

- **Hearsay – prior testimony**
  - Declarations from other proceedings
  - Transcripts from other proceedings
  - FRE 804(b)(1) exception:
    - Declarant "unavailable as a witness"
    - Party had "an opportunity and similar motive to develop it by direct, cross-, or redirect examination."

Hypothetical no. 3

- Petitioner supports its obviousness challenge with an expert declaration.
- Patent owner does not present expert testimony with its opposition.

Hypothetical no. 3

In a final written decision, the Board should:

A. Enter judgment for petitioner because patent owner did not rebut the testimony of petitioner's expert.

B. Weigh the evidence but discuss the failure of patent owner to present expert testimony as a factor in reaching the decision.

C. Weigh the evidence without mentioning the lack of expert testimony from patent owner.

D. None of the above.

Hypothetical no. 3

- Petitioner supports its obviousness challenge with an expert declaration.
- Patent owner does not present expert testimony with its opposition.

Hypothetical no. 3

- ***Fanduel, Inc. v. Interactive Games LLC*, 966 F.3d 1334, 1342 (Fed. Cir. 2020)**

  "Further confirming that the burden cannot shift to the patentee post institution, the IPR regulations do not require a patent owner to submit any response to the petition, either before or after institution."

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Hypothetical no. 4

- Petitioner's reply relies on the cross-examination of petitioner's expert by patent owner.
- Patent owner moves to strike the testimony and preclude petitioner from relying on it.

Hypothetical no. 4

In ruling on patent owner's motion, the Board should:

A. Grant the motion because petitioner can't rely on patent owner's cross-examination of petitioner's own expert.

B. Deny the motion because patent owner's cross-examination of petitioner's expert is part of the record.

C. Grant the motion because the testimony of petitioner's expert is not reliable.

D. None of the above.

Hypothetical no. 4

- Petitioner's reply relies on the cross-examination of petitioner's expert by patent owner.
- Patent owner moves to strike the testimony and preclude petitioner from relying on it.

Hypothetical no. 4

- **37 C.F.R. § 42.53 – Taking Testimony**
  - (f) *Manner of taking deposition testimony*

    ***
  - (7) Except where the parties agree otherwise, the proponent of the testimony must arrange for providing a copy of the transcript to all other parties. *The testimony must be filed as an exhibit.*

Hypothetical no. 5

- Petitioner's expert unexpectedly withdraws after institution of the IPR and declines to provide an excuse.
- Petitioner moves to designate a substitute expert who will adopt the testimony of the withdrawing expert.
- Patent owner opposes the motion.

Hypothetical no. 5

In ruling on petitioner's motion, the Board should:

A. Deny petitioner's motion as prejudicial to patent owner.

B. Authorize a subpoena to the expert to obtain information on the reason for the withdrawal.

C. Grant petitioner's motion conditioned on the substitute expert being available for cross-examination by patent owner.

D. None of the above.

Hypothetical no. 5

- Petitioner's expert unexpectedly withdraws after institution of the IPR and declines to provide an excuse.
- Petitioner moves to designate a substitute expert who will adopt the testimony of the withdrawing expert.
- Patent owner opposes the motion.

Hypothetical no. 5

- ***Alzehon Inc. v. Risen (Suzhou) Pharma Tech Co.*, IPR2021-00347, Paper 26 (Feb. 2, 2022)**
  - Granting patent owner's request to substitute the declaration of original declarant with an essentially identical declaration by a substitute declarant.

Wrap-up – some things to consider

- Expert testimony does not take the place of disclosure in a reference. *See Consolidated Trial Practice Guide* at 36 and cases cited there.
- Emerging issue – Are the expert's qualifications commensurate with the scope of testimony?
- Cross-examination of testimony from another proceeding is not new testimony subject to routine discovery – Is the testimony hearsay? Does an exception apply? Can/should cross examination be compelled? If not, exclude, weigh less? Fairness?

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