

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Patent Trial and Appeal Board Boardside Chat: Use of Expert Witness Testimony

Thomas Giannetti, Administrative Patent Judge

Brian McNamara, Administrative Patent Judge

Tim Fink, Partner, O'Melveny & Myers LLP

Naveen Modi, Partner, Paul Hastings LLP

September 15, 2022

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# 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]

# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# 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](http://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:

\*\*\*

(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.”

# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# 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

- ***Alzheon 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?

# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# Next Boardside Chat



- October 13, 2022, at 12-1 pm ET
- Register for and learn about upcoming Boardside Chats, and access past Boardside Chats at:

<https://www.uspto.gov/patents/ptab/ptab-boardside-chats>





