Your Claim Is Invalid — My Expert Says So

Law360, New York (May 31, 2013, 12:14 PM ET) -- In patent litigation, experts are not only helpful, but are often an essential aspect of the lawsuit. See Outside the Box Innovations LLC v. Travel Caddy Inc., 695 F.3d 1285, 1296 (Fed. Cir. 2012) (“[P]atents are not for inventions of law; they are for inventions of technology. The exclusion of a technical expert may deprive the decision-maker of knowledge and perspective relevant to the adjudication.”).

A readily apparent example is the expert testimony of a person who is of at least ordinary skill in the art. See Sundance Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1361–63 (Fed. Cir. 2008) (explaining that issues of infringement and invalidity are “analyzed in great part from the perspective of a person of ordinary skill in the art, and testimony explaining the technical evidence from that perspective may be of great utility to the factfinder”). This article addresses the requirement for using a technical expert skilled in the art to testify regarding several validity issues, and explains that an expert witness is generally but not always required to invalidate a patent claim.

The opinions of a person skilled in the art are normally presented by a technical expert. While lay witnesses can testify in the form of an opinion, their testimony cannot be “based on scientific, technical, or other specialized knowledge within the scope of Rule 702.” Fed. R. Evid. 701. This requirement is intended “to eliminate the risk that the reliability requirements set forth in Rule 702 will be evaded through the simple expedient of proffering an expert in lay witness clothing.” Fed. R. Evid. 701, 2000 advisory committee note. Thus, testimony from a person who is offered as one skilled in the art should be in accordance with Rule 702, which governs “Testimony by Expert Witnesses.”

Technical experts frequently provide testimony pertaining to anticipation and obviousness issues. See KSR International Co. v. Teledex Inc., 550 U.S. 398, 420 (2007) (explaining that the obviousness inquiry is focused on “whether the combination was obvious to a person with ordinary skill in the art”). In assessing the scope and content of the prior art, a court may be faced with the question of whether it should “independently review the prior art references and weigh their import absent the guidance of an expert.” See Allergan Inc. v. Barr Laboratories Inc., 2013 U.S. App. LEXIS 2122, at *16–17 (Fed. Cir. Jan. 28, 2013) (nonprecedential).

In Allergan, the claim was directed to bimatoprost, and the Federal Circuit repeated the district court’s finding that the technology was “sufficiently complex to fall beyond the grasp of ordinary laypersons.” Id. at *18. Thus, “the district court did not err in finding that common sense and logic were not sufficiently illuminating” to carry the accused infringer’s burden of proving obviousness. Id. at *19.

Given a standard based on the knowledge and understanding of one skilled in the art, expert testimony is essential for a finding that a patent involving a sufficiently complex subject matter is invalid by clear and convincing evidence. See, e.g., In re Brimonidine Patent Litigation, 643 F.3d 1366, 1376 (Fed. Cir. 2011) (“[I]t is well within a trial judge’s discretion to require expert testimony supporting technical references that are relied on to establish obviousness.”); Proveris Scientific Corp. v. Innovasystems Inc., 536 F.3d 1256, 1267 (Fed. Cir. 2008) (holding the district
court did not abuse its discretion by requiring an alleged infringer to present expert testimony regarding invalidity of a complex calibration device); Koito Mfg. Co. Ltd. v. Turn-Key-Tech LLC, 381 F.3d 1142, 1145 (Fed. Cir. 2004) (holding that a party who merely entered a reference into evidence without providing testimony relating to that evidence did not present substantial evidence).

Nonetheless, there is no “invariable requirement that a prior art reference be accompanied by expert testimony,” and the exclusion of prior art where the “technology involved is simple,” merely because it was not addressed in an expert report, is error. Meyer Intellectual Properties Ltd. v. Bodum Inc., 690 F.3d 1354, 1374 (Fed. Cir. 2012). Similarly, in Wyers v. Master Lock Co., 616 F.3d 1231, 1242 (Fed. Cir. 2010), the court rejected the argument that expert testimony was required to consider prior art references when “the references and the invention are easily understandable.” See also Union Carbide Corp. v. Am. Can Co., 724 F.2d 1567, 1573 (Fed. Cir. 1984).

“Generally, a party seeking to invalidate a patent as obvious must ‘demonstrate by clear and convincing evidence that a skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so.’” In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig., 676 F.3d 1063, 1068–69 (Fed. Cir. 2012). The motivation, suggestion, or reason to combine items of prior art may come from the knowledge of one of ordinary skill in the art, including “the inferences and creative steps that a person of ordinary skill in the art would employ.” KSR, 550 U.S. at 418.

Yet, “an expert is not the only source for evidence that it would be obvious for one skilled in the art to combine references to reach the claimed method.” Innogenetics NV v. Abbott Labs., 512 F.3d 1363, 1374 (Fed. Cir. 2008). The suggestion or motivation to modify prior art teachings may appear within the prior art or from the nature of the problem addressed by the invention. Princeton Biochemicals Inc. v. **Beckman Coulter Inc.**, 411 F.3d 1332, 1338–39 (Fed. Cir. 2005). Moreover, “the legal determination of obviousness may include recourse to logic, judgment and common sense, in lieu of expert testimony.” Wyers, 616 F.3d at 1239.

Thus, the motivation to combine references may boil down to a question of “common sense.” Id. at 1240; see also Perfect Web Techs. Inc. v. InfoUSA Inc., 587 F.3d 1324, 1329 (Fed. Cir. 2009) (“[R]ecourse to logic, judgment, and common sense available to the person of ordinary skill [does] not necessarily require explication in any reference or expert opinion.”); Ball Aerosol & Specialty Container Inc. v. **Limited Brands Inc.**, 555 F.3d 984, 993 (Fed. Cir. 2009) (reasoning that “the combination would have been entirely predictable and grounded in common sense”).

Expert witnesses often establish the level of skill in the art. However, if the prior art itself provides sufficient guidance as to the level of ordinary skill in the art, then an expert’s testimony is presumably unnecessary. See Byrne v. **Wood, Herron & Evans LLP.**, 450 F. App’x 956, 964 (Fed. Cir. 2011) (“Thus, there may be situations in which the technology at issue is at such a level that it does not require technical expert testimony, and the failure to identify a level of skill in the art will be harmless.”); Chore-Time Equipment, Inc. v. Cumberland Corp., 713 F.2d 774, 779 (Fed. Cir. 1983).
For the objective indicia of nonobviousness, including commercial success, copying, long-felt but unsolved need, and failure of others, lay testimony will often be sufficient, even if unaccompanied by expert testimony. See In re Cyclobenzaprine, 676 F.3d at 1082–83 (holding that the district court erred when it rejected an argument of longfelt need supported by nonexpert evidence).

Regarding indefiniteness, “[g]eneral principles of claim construction apply … [and courts] primarily consider the intrinsic evidence consisting of the claim language, the specification, and the prosecution history.” Biosig Instruments Inc. v. Nautilus Inc., 2013 U.S. App. LEXIS 8486, at *12 (Fed. Cir. Apr. 26, 2013). Thus, the need for a technical expert arises when an apparent ambiguity in the claims and specification cannot be resolved without extrinsic evidence of the usage and meaning of a term in the context of the invention. See Verve LLC v. Crane Cams Inc., 311 F.3d 1116, 1119 (Fed. Cir. 2002). In Biosig, for example, expert testimony demonstrated that the claims provided “inherent parameters sufficient for a skilled artisan to understand the bounds of” the claim term at issue. 2013 U.S. App. LEXIS 8486 at *21.

Turning to written description, the Federal Circuit stated in Ariad Pharmaceuticals Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc), that “the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” The court further stated that “the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” Id. “Because the specification is viewed from the perspective of one of skill, in some circumstances, a patentee may rely on information that is ‘well-known in the art’ for purposes of meeting the written description requirement.” Boston Scientific Corp. v. Johnson & Johnson, 647 F.3d 1353, 1366 (Fed. Cir. 2011).

Nevertheless, in Univ. of Rochester v. G.D. Searle & Co. Inc., 358 F.3d 916, 927 (Fed. Cir. 2004), the court rejected the argument as “contrary to our case law” that “a patent may not be held invalid on its face.” Even so, the more complex the technology, the greater the likelihood that, without expert testimony, the patent alone will not provide sufficient evidence of invalidity.

The enablement requirement “is met when at the time of filing the application one skilled in the art, having read the specification, could practice the invention without ‘undue experimentation.’” Cephalon Inc. v. Watson Pharms., 707 F.3d 1330, 1336 (Fed. Cir. 2013). Thus, fundamental to an enablement inquiry is what the patent text discloses to an ordinarily skilled artisan, which makes it unlikely that this defense can be successfully proven without the use of expert testimony. There is case law suggesting that the enablement defense can be supported by lay testimony. In Union Pacific Resources Co. v. Chesapeake Energy Corp., 236 F.3d 684, 692–93 (Fed. Cir. 2001), for example, the court found no reversible error in allowing eight witnesses with industry experience to give lay opinions as to whether a written description enabled a claim.

However, that decision is likely the final relic of the law as it existed before the change to Rule 701 in 2000. Although the 2000 notes state that the amendment does not purport to change the law that lay opinion testimony can be presented in view of particularized knowledge of a
witness, offering the example of “the value or projected profits of a business,” stretching this business owner exception to the enablement defense seems unlikely. Fed. R. Evid. 701, 2000 advisory committee note.

Utility is closely related to the requirement for enablement, and similarly requires that the specification be read in the light of the knowledge of those skilled in the art. Thus, if not readily apparent from the specification, expert testimony might be useful to establish whether the invention is useful and operable. Janssen Pharmaceutica NV v. Teva Pharms. USA Inc., 583 F.3d 1317, 1326 (Fed. Cir. 2009) (“Nor was there evidence that someone skilled in the art would infer [the claimed compound’s] utility from the specification, even if such inferences could substitute for an explicit description of utility.”).

While the foregoing demonstrates there are situations when the testimony may not be essential in establishing the invalidity of a patent, those situations are uncommon. Going forward, critical factors in the calculus of whether to produce expert testimony regarding invalidity are (1) the complexity of the patented invention, (2) the content and complexity of the prior art, and (3) the type of invalidity argument being made.

Whether a technology is simple or complex, litigators are well advised to be consistent — when offering extensive expert testimony on one invalidity issue, they should carefully consider providing it on all related invalidity issues. See Alexsam Inc. v. IDT Corp., 2013 U.S. App. LEXIS 10009, at *29 (Fed. Cir. May 20, 2013) (rejecting an argument of technological simplicity in an obviousness analysis where the parties introduced extensive prior art expert testimony).

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