



PTAB Precedential Ruling: Expert Declaration Devoid of Supporting Evidence Dooms IPR Petition

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The Patent Trial and Appeal Board recently rejected an *inter partes* review petition that relied on a conclusory and unsupported expert declaration. The expert's written testimony, which repeated portions of the petition verbatim, did not provide the necessary evidence to support the conclusion that one of skill would have understood the prior art as either teaching a limitation or rendering obvious the claims at issue.

A petitioner challenged all claims of a patent directed to a mobile ticketing system for detecting fraudulent activity. That patent's sole independent claim included a limitation that required associating certain data with a user's account if fraudulent activity was identified. A prior art reference disclosed a system where a user was blocked from further activity if fraudulent activity was identified. According to the Petitioner, one of skill in the art would have (1) understood that the limitation was necessarily taught by the prior art reference, or (2) found it obvious in light of that reference. The Patent Owner argued that there were ways to block a user other than by associating data with the user's account and that Petitioner relied only on conclusory statements about the knowledge of one of skill in the art to supply a limitation not taught by the reference.

The Board agreed with the Patent Owner and concluded that both of Petitioner's arguments were conclusory because they failed to explain why the limitation was necessarily present or why it would have been obvious in light of the reference's disclosure. Petitioner's only evidence related to that limitation was the opinion of its declarant. But Petitioner's declarant did not offer any support for his conclusions, nor cite any additional evidence. He simply

repeated verbatim the conclusory statements found in the petition. The Board reiterated that unsupported expert testimony that does not disclose the underlying facts or data on which it is based is entitled to little weight. That was the case here and the Board concluded that Petitioner had failed to meet its burden and declined to institute review.

Practice Note: When relying on an expert to support an argument of unpatentability in an IPR proceeding, a petitioner must ensure that the expert fully explains his or her opinion and provides the necessary supporting facts. Conversely, patent owners should scrutinize an adversary's expert declaration and ensure that the expert has properly supported and explained his or her opinions.

Xerox Corp. v. Bytemark, Inc., IPR2022-00624, Paper No. 9 (Aug 24, 2022) (designated precedential Feb. 10, 2023)

Categories

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