



Despite Instituting IPR, PTAB Invites Patent Owner to Re-Raise Challenge to Expert's Qualifications at Trial

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The Patent Trial and Appeal Board recently instituted an *inter partes* review where the patent owner argued that the petitioner failed to establish its expert as a person of skill in the art, which would have rendered the expert's testimony inadmissible under *Kyocera Senco Indus. Tools Inc. v. Intl. Trade Commn.*, 22 F.4th 1369 (Fed. Cir. 2022). In rejecting the patent owner's argument, the Board found the expert to be a person of at least ordinary skill in the art "for purposes of institution," but invited the patent owner to explore the issue further during trial.

The patent at issue related to systems and methods for setting up a universal remote control using voice commands. As such, the petition asserted that a person of skill in the art (POSA) must have "approximately three years of experience or equivalent study in voice-controlled devices in universal remote control systems."

In its preliminary response, after addressing the merits of each ground in the petition, the patent owner argued that the petitioner failed to establish a reasonable likelihood of unpatentability for any challenged claim because the petitioner "failed to support its [p]etition with the testimony of a [POSA]." According to the patent owner, the expert's declaration was inadmissible under *Kyocera* because the declaration failed to disclose any experience related to "voice-controlled devices" or "universal remote controls"^{3/4}specific requirements of the petitioner's own definition.

The Board, however, rejected the patent owner's argument and instituted review. In doing so, the Board noted that the petitioner's expert stated in his declaration that his "level of skill in the art was at least that of a person of ordinary skill." Moreover, according to the Board, the

declaration described some relevant experience “in the areas of voice control and speech recognition.”

Notably, the institution decision did not close the door on the patent owner’s *Kyocera* challenge. As the Board explained, “there appears to be sufficient evidence that [the expert] is a person of ordinary skill for us to consider his declaration *for purposes of institution*.” But “[d]uring the trial, the parties may further address . . . whether [the expert] possesses at least the qualifications of a person of ordinary skill” and “the legal implications of any potential deficiencies in [the expert]’s qualifications or experience.”

Practice Tip: Practitioners should pay close attention to their proposed definitions of a person of ordinary skill in the art. Given the Board’s express invitation to further explore the expert’s qualifications at trial, this case is another reminder of the importance of selecting experts that, at a minimum, meet the proposed definition of a POSA and of providing specific evidence in support of the expert’s purported qualifications.

Roku Inc. v. Universal Electronics Inc., IPR2022-01289, Paper 10 (PTAB Mar. 24, 2023).

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