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District Court Precludes Experienced Patent Attorney from Testifying as Expert Based on Lack of Pertinent Technical Expertise

April 3, 2024

Reading Time : **2 min**

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A district court recently precluded a patent attorney from testifying as an expert in a patent infringement lawsuit where the proposed expert lacked the requisite technical expertise to assist the trier of fact in understanding the evidence.

The accused infringer in the case proffered an expert with a degree in mechanical engineering, a Juris Doctor, and an LLM in intellectual property law to opine on the materiality of allegedly undisclosed prior art, the validity of the asserted patent, and whether the accused system was "non-infringing prior art." Although the expert possessed an engineering degree, the accused infringer conceded that the expert was not a person of ordinary skill in the pertinent art ("POSITA"), namely paint inspection lighting technology. The patent owner moved to exclude the expert's opinions based on a lack of technical expertise in lighting inspection systems.

In opposing the motion, the accused infringer argued that its expert would not be testifying from the perspective of someone skilled in the field, but would provide permissible testimony "from the perspective of a reasonable patent attorney." Specifically, the expert would aid the factfinders in understanding the prosecution history of the patent, including the applicant's claim amendments to overcome rejections and the disclosure of certain prior art. The court, however, disagreed with this characterization of the proffered testimony, finding that the expert report contained opinions regarding invalidity, the scope and content of prior art, and differences between the claims and the prior art.

Based on its review of the report, the court found that "practically all of [the expert's] proposed testimony [was] impermissible." The court relied primarily on the Federal Circuit's 2008 *Sundance, Inc. v. DeMonte Fabricating Ltd.* decision, which held that a witness may not testify as an expert on noninfringement or invalidity if he or she is not qualified as an expert in the art. The district court found that, despite a substantially impressive resume, the proposed expert was not a POSITA in the relevant field and, therefore, was not qualified to opine on invalidity and infringement.

Notably, the district court appears to have used "POSITA" to refer to the level of knowledge necessary to qualify as an expert in the pertinent art, as opposed to whether the expert met the specific, definitional criteria for a POSITA applied in the case. The court's reliance on *Sundance*, as opposed the Federal Circuit's more recent *Kyocera Senco Industrial Tools Inc. v. International Trade Commission* establishing a bright-line rule based on meeting the POSITA definition, supports this interpretation.

Practice Tip: For certain issues in a patent case, such as inequitable conduct during prosecution, it may be permissible for a patent attorney to testify as an expert from the perspective of a reasonable patent attorney. However, when proffering a patent attorney as an expert, parties should take care to avoid addressing any technical opinions on which the attorney is not an expert, such as scope of the art or claim interpretation. Crossing this line into technical matters risks exclusion of that testimony, which is particularly true in the wake of *Kyocera*, where the Federal Circuit has applied a stricter test to exclude patent experts that do not meet the definition of a POSITA.

Tecossl, Inc. v. Avid Labs, LLC, No. 5:19-cv-00043, D.I. 183 (E.D. Ky. Feb. 9, 2024)