



Challenge to a Named Inventor's Credibility on Case-Dispositive Issue Warrants Live Testimony in IPR

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“Occasionally, the Board will permit live testimony where the Board considers the demeanor of a witness critical to assessing credibility. [...] Live testimony will be necessary only in limited circumstances and requests for live testimony will be approached by the Board on a case-by-case basis.” July 2019 Trial Practice Guide Update, 12. Factors the Board considers in deciding a motion for live testimony include the “importance of the witness’s testimony to the case, i.e., whether it may be case-dispositive,” and whether that person is a fact witness. *K-40 Elecs., LLC v. Escort, Inc.*, Case IPR2013-00203, Paper 34, 3 (PTAB May 21, 2014) (precedential).

In *MPOWERED*, Patent Owner sought live testimony from Anna Stork, a named inventor of the challenged patent, regarding a few issues, including the dates of conception and reduction to practice. Patent Owner argued that emails contained within Ms. Stork’s Gmail account were necessary to prove dates of conception and reduction to practice, and that Ms. Stork’s live testimony was critical to establish the veracity of those emails. Patent Owner also argued that since Petitioner “made Ms. Stork’s credibility a central issue in this case by calling her biased and incomplete in her presentation of her invention story,” live testimony was warranted. Paper 33, 1.

Petitioner argued that any live testimony from Ms. Stork regarding her emails was irrelevant. It argued that an inventor’s testimony requires independent corroboration in order to prove conception and reduction to practice, and Ms. Stork’s emails were not “independent.” According to Petitioner, “[t]his case turns on independent corroboration – not on additional

facts at Ms. Stork’s disposal.” Paper 34, 2. “Live testimony from Ms. Stork reiterating her declaration cannot cure the lack of corroborating evidence.” *Id.* at 3.

As to the witness credibility issue, the Board pointed out that in its Reply, Petitioner directly contradicted Ms. Stork’s testimony on the issue of whether another individual is a co-inventor of the claimed subject matter. *Id.* The Board went on to state that if it were to reject Petitioner’s argument that Ms. Stork’s emails were not independent corroboration, then “this case might well turn on Ms. Stork’s credibility.” Paper 40, 4. As such, the Board determined that “Ms. Stork’s testimony may be case dispositive. In addition, Ms. Stork is a fact witness and a named inventor who, like the witness in *K-40 Electronics*, seeks to offer testimony in support of an attempt to antedate prior art references. Under the facts and circumstances present here, we determine that Ms. Stork should be permitted to offer live testimony.” *Id.* In granting the motion, the Board limited the scope of Ms. Stork’s direct testimony to her declaration and deposition testimony in this proceeding.

Practice tip: In an IPR, live testimony from a fact witness is a feasible option, especially where the witness is an inventor on the contested patent or their credibility is at issue. To maximize the likelihood of success, a Motion for Live Testimony should emphasize the factors addressed in *K-40 Electronics*.

Citation: *MPOWERED INC. v. LuminAID Lab, LLC*, IPR2018-01524, Paper 40 (PTAB November 1, 2019)

Categories

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Inter Partes Review

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