TECHNOLOGY LAW UPDATE

Centricut, LLC* *v.* *The Esab Group, Inc.

Nos. 03-1574, -1614
Federal Circuit
Dec. 6, 2004

[I]n a case involving complex technology, where the accused infringer offers expert testimony negating infringement, the patentee cannot satisfy its burden of proof by relying only on testimony from those who are admittedly not expert in the field.

On December 6, 2004, the Federal Circuit, *inter alia*, reversed the district court's judgment following a bench trial that Centricut infringed U.S. Patent No. 5,023,425, and dismissed as moot the cross appeal of the $2,182,972 damages award. The patented technology related to plasma arc torch electrodes. The Federal Circuit stated:

> The patentee has the burden of proving infringement by a preponderance of the evidence. Centricut argues that Esab did not satisfy its burden of proof on infringement because it did not show that the accused device satisfied the work-function limitation. . . . Esab urges (a little half-heartedly) that the district court's reasoning was correct. [T]he district court found the work-function tables showed that the accused device met the work-function limitation by a preponderance of the evidence, even though the only expert testimony directly contradicted this conclusion. . . . Esab points to no expert testimony or contrary testimony supporting the use of the tables. . . .
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> Centricut presented extensive expert testimony by Dr. denBoer that longer useful life could be attributed to a number of different factors, including temperature, the geometry of the electrode, the thermal and electrical conductivity of the sleeve, or the sleeve's resistance to oxidation, and that it was not reasonable to conclude that longer useful life was attributable to work function. Dr. denBoer, Centricut's work-function expert, stated unequivocally that, while he did not know why the sleeve affects useful life, the useful life tests conducted by Esab told him "absolutely nothing about work function."
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> [E]ach of Esab's three theories suffers from the same deficiency: none is supported by expert testimony. The first theory, adopted by the district court, rests on the district court's own interpretation of the evidence. The latter two theories rest on the testimony of witnesses who were admittedly not experts on work function.
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> In many patent cases expert testimony will not be necessary because the technology will be "easily understandable without the need for expert explanatory testimony." But there is no claim that this is such a case. Indeed, in this case the technology involved was complex. The district court concluded that "the field of technology from which [the invention] sprang is so poorly understood that it qualifies as a 'black art.'"
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> In other areas of the law courts have held that relevant expert testimony regarding matters beyond the comprehension of laypersons is sometimes essential. Expert testimony may be similarly important in patent cases involving complex technology such as this one. Where the field or art is complex, we have repeatedly approved the use of expert testimony to establish infringement.
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> We do not state a per se rule that expert testimony is required to prove infringement when the art is complex. Suffice it to say that in a case involving complex technology, where the accused infringer offers expert testimony negating infringement, the patentee cannot satisfy its burden of proof by relying only on testimony from those who are admittedly not expert in the field. That is what happened here, and the patentee thus failed to satisfy its burden of proof. This case stands as an apt example of what may befall a patent law plaintiff who presents complex subject matter without inputs from experts qualified on the relevant points in issue when the accused infringer has negated infringement with its own expert.

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