

Sundance, Inc. v. DeMonte Fabricating Ltd.

Nos. 08-1068, -1115, Fed. Cir. (Dyk, Prost, Moore*)

[I]t is an abuse of discretion to permit a witness to testify as an expert on the issues of noninfringement or invalidity unless that witness is qualified as an expert in the pertinent art.

On December 24, 2008, the Federal Circuit reversed the district court's judgment as a matter of law that U.S. Patent No. 5,026,109, which related to retractable segmented covering systems, was not invalid for obviousness. The Federal Circuit stated:

We first consider the district court's admission of testimony from DeMonte's patent law expert, Mr. Bliss [who] opined on how the disclosed invention, accused system, and prior art operate, including his opinions as to the noninfringement and invalidity of claim 1 of the '109 patent. Mr. Bliss's pre-trial expert report details his years of experience as a patent attorney, including preparation of opinions on invalidity and knowledge of USPTO practice and procedure. The report does not present Mr. Bliss as having any personal technical experience, or skills in the field of mechanics, much less covers. . . . Indeed, his report opines that the level of ordinary skill in the art "would be someone with a high school education and one or more years of experience in the field of tarps or covers"—experience that he himself lacks. . . .

Admitting testimony from a person such as Mr. Bliss, with no skill in the pertinent art, serves only to cause mischief and confuse the factfinder. Unless a patent lawyer is also a qualified technical expert, his testimony on these kinds of technical issues is improper and thus inadmissible. Because Mr. Bliss was never offered as a technical expert, and in fact was not qualified as a technical expert, it was an abuse of discretion for the district court to permit him to testify as an expert on the issues of noninfringement or invalidity. [I]t is an abuse of discretion to permit a witness to testify as an expert on the issues of noninfringement or invalidity unless that witness is qualified as an expert in the pertinent art. Testimony proffered by a witness lacking the relevant technical expertise fails the standard of admissibility under Fed. R. Evid. 702. Indeed, where an issue calls for consideration of evidence from the perspective of one of ordinary skill in the art, it is contradictory to Rule 702 to allow a witness to testify on the issue who is not qualified as a technical expert in that art. We understand that patent lawyers are often qualified to testify as technical experts, but such a qualification must derive from a lawyer's technical qualifications in the pertinent art.

We do not, of course, suggest that being a person of ordinary skill in the art automatically entitles a witness to testify as an expert on these or other matters. On the other hand, our opinion should not be read as suggesting that Rule 702 requires a witness to possess something more than ordinary skill in the art to testify as an expert. A witness possessing merely ordinary skill will often be qualified to present expert testimony both in patent trials and more generally. . . .

With regard to invalidity, for example, a witness not qualified in the pertinent art may not testify as an expert as to anticipation, or any of the underlying questions, such as the nature of the claimed invention, what a prior art references discloses, or whether the asserted claims read on the prior art reference. Nor may a witness not qualified in the pertinent art testify as an expert on obviousness, or any of the underlying technical questions, such as the nature of the claimed invention, the scope and content of prior art, the differences between the claimed invention and the prior art, or the motivation of one of ordinary skill in the art to combine these references to achieve the claimed invention.

DeMonte has failed to demonstrate any possible relevancy or reliability of Mr. Bliss's testimony as to technical matters in light of his lack of relevant technical expertise. Mr. Bliss lacks the necessary expertise to be of assistance to the court or the jury on the technical aspects of this case. The court, in its role as gatekeeper, must exclude expert testimony that is not reliable and not specialized, and which invades the province of the jury to find facts and that of the court to make ultimate legal conclusions. Allowing a patent law expert without any technical expertise to testify on the issues of infringement and validity amounts to nothing more than advocacy from the witness stand. The district court's denial of the motion in limine to exclude the testimony of Mr. Bliss, a person not skilled in the pertinent art, was an abuse of discretion. . . .

The consequence of our holding that the testimony of Mr. Bliss should have been excluded is that there was no expert testimony supporting a holding of obviousness; we conclude, however, that no such testimony was required because there are no underlying factual issues in dispute as to obviousness. The technology is simple and neither party claims that expert testimony is required to support such a holding. We reverse the district court's grant of JMOL and conclude as a matter of law that claim 1 of the '109 patent would have been obvious and is therefore invalid. [T]he segmented truck cover claimed in the '109 patent represents the "mere application of a known technique to a piece of prior art ready for the improvement." . . . Neither party has suggested that the combination of the removable cover sections of Hall with the cover system of Cramaro yields anything "more than one would expect from such an arrangement," nor is any such result apparent. We conclude that a cover designer of ordinary skill, at the time of the invention, would have found it obvious to incorporate the removable cover sections of Hall into the cover system of Cramaro.

The previous statements are for information purposes only, and do not constitute legal advice. Questions regarding the matters discussed above, and any requests to be subscribed to the free electronic distribution of this publication, may be directed to Lawrence M. Sung, Ph.D., at +1 202.346.7850 or lsung@dl.com, or to any other Dewey & LeBoeuf LLP attorney with whom you regularly consult.

NEWYORK|LONDONMULTINATIONALPARTNERSHIP|WASHINGTON,DC
ALBANY|ALMATY|AUSTIN|BEIJING|BOSTON|BRUSSELS|CHARLOTTE|CHICAGO|DUBAI
FRANKFURT|HARTFORD|HONGKONG|HOUSTON|JACKSONVILLE|JOHANNESBURG (PTY)LTD. | LOSANGELES
MILAN | MOSCOW | PARISMULTINATIONALPARTNERSHIP | RIYADHAFFILIATEDOFFICE | ROME | SANFRANCISCO | SILICON VALLEY | WARSAW