FEDERAL CIRCUIT VERSUS ADMINISTRATIVE AGENCIES: PATENT EXPERT WITNESSES AFTER *KYOCERA*

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Abstract

Expert witness testimony is interwoven into the practice of patent litigation and often plays a crucial role in informing the factfinder of pertinent evidence. In the 2022 Kyocera Senco Indus. Tools, Inc. v. ITC *decision, the Federal Circuit held that to be qualified as an expert witness, the witness must be a person having ordinary skill in the art. Though apparently mundane, this requirement is directly at odds with administrative agency practice and prior precedent in the courts, and its consequences will have far-reaching effects as complexities of issued patents increase. This Article delves into the history of use of expert witness testimony in patent litigation, the intention of this testimony to assist the factfinder, and the framework of the Federal Rules of Evidence. Properly understood, whether or not a witness is a person having ordinary skill in the art should go to the weight of such testimony rather than its admissibility—aligning with the practice of administrative agencies.*

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INTRODUCTION

Expert witnesses play a crucial role in the majority of patent litigation cases.[1] Such witnesses are frequently used to educate courts in the technology at issue, allowing the factfinder to comprehend the intricacies at play in a given dispute.[2] Both parties in patent infringement disputes typically include expert witness testimony to support their arguments.[3] In complex cases, multiple expert witnesses may be used to address different elements of the case.[4] For example, some experts may be concerned with financial aspects and remedies,[5] while others address the technical (i.e., mechanical or scientific) elements in the patent at issue.[6]

But who is eligible to testify as a technical expert witness in patent cases? The Federal Circuit's 2022 *Kyocera Senco Indus. Tools, Inc. v. ITC* decision held that, for expert witness testimony to be admissible "from the perspective of a skilled artisan in a patent case—like for claim construction, validity, or infringement—a witness must at least have ordinary skill in the art."[7] The perspective of a skilled artisan is typically involved in these doctrinal areas during patent litigation.[8] Though the *Kyocera* court's statement may on its face appear mundane and obvious (after all, why would you not expect an expert

1. THE SEDONA CONF., COMMENTARY ON PATENT LITIGATION BEST PRACTICES: USE OF EXPERTS, *DAUBERT*, AND MOTIONS *IN LIMINE* CHAPTER v (Gary M. Hoffman et al. eds., 2015) ("Patent litigations typically are highly dependent on expert evidence."). Patent litigation is notoriously complex due to the requirement of understanding both the facts at issue and their application to the law. *See, e.g.*, The Honorable Kathleen M. O'Malley et al., *A Panel Discussion: Claim Construction from the Perspective of the District Judge*, 54 CASE W. RSRV. L. R. 671, 682 (2004) ("I have heard trial judges claim that they dislike patent litigation, partly because it is hard. Patent litigation is like the neurosurgery of litigation: it is hard scientifically and it is hard legally.").

2. *See* FED. R. EVID. 702 advisory committee's note to 2000 amendment ("The amendment does not alter the venerable practice of using expert testimony to educate the factfinder on general principles."); Corinne Atton & William Solander, *How Experts Can Determine Patent Cases*, MANAGINGIP 45, 45 (Nov. 21, 2016), https://www.venable.com/-/media/files/publications/2016/11/how-experts-can-determine-patent-cases/howexpertscandeterminepatentcases.pdf [https://perma.cc/6ZMR-SQZD] (describing a reason why "[e]xpert witnesses are omnipresent in US patent litigation" is the "complexity of the science and technology that is litigated, and the fact that while many US judges are experienced in patent cases, they may not have scientific or technological expertise").

3. DONALD S. CHISUM, 5A CHISUM ON PATENTS § 18.06[1][d][ii] (2007).

4. THE SEDONA CONF., *supra* note 1, at 3; O'Malley et al., *supra* note 1, at 688.

5. John D. Taurman, *Courtroom to Classroom: A Practitioner Teaches Remedies*, 57 ST. LOUIS U. L.J. 631, 644 (2013).

6. CHISUM, *supra* note 3, § 18.06[1][d][ii].

7. Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022).

8. *See* Laura Pedraza-Fariña & Ryan Whalen, *The Ghost in the Patent System: An Empirical Study of Patent Law's Elusive "Skilled Artisan"*, 108 IOWA L. REV. 247, 250–51 (2022) ("[A]lthough the PHOSITA is implicated in a wide variety of patent doctrines, its appearance in litigation is in large part related to three key doctrinal areas: obviousness, enablement, and claim construction.").

witness to have skill in the art to which they are testifying?), commentators in the patent field recognized it as a significant shift in patent jurisprudence.[9]

This Article argues that the *Kyocera* decision has unleashed substantial consequences that the Federal Circuit did not consider in rendering this decision, and those consequences will be felt beyond the International Trade Commission ("ITC"). While administrative agencies have some options for minimizing the ramifications of this decision, district courts evaluating patents will have no such escape.[10] Rather than disqualifying testimony from an expert simply because they do not qualify as a person having ordinary skill in the art, this Article proposes that whether the expert witness is a person of ordinary skill in the art should go to the *weight* of the expert's testimony, not to the *admissibility* of it.

Furthermore, *Kyocera* is directly at odds with the practice of administrative agencies. Precedent illustrates that adjudicative decisions by the ITC do not limit expert witness testimony to persons having ordinary skill in the art.[11] The *Kyocera* decision is also contrary to the United States Patent and Trademark Office's ("USPTO") approach to the same issue.[12] The Patent Trial and Appeal Board ("PTAB") is the adjudicative arm of the USPTO, and many patents are challenged before the PTAB with inter partes review, post-grant review, and covered business method proceedings.[13] The PTAB Trial Practice Guide explicitly states that:

> There is . . . no requirement of a perfect match between the expert's experience and the relevant field. . . . *A person may not need to be a person of ordinary skill in the art in order to testify as an expert under Rule 702*, but rather must be "qualified in the pertinent art." . . . For example, the absence of an advanced degree in a particular field may not preclude an expert from providing testimony that is helpful to the

9. *See* Andrew P. Siuta, *It's Not Complicated: Make Sure the Technical Expert You Retain to Testify About Infringement Has Credentials that Match the Level of Skill Required by the Court*, SUNSTEIN INSIGHTS (Mar. 4, 2022), https://www.sunsteinlaw.com/publications/its-not-complicated-make-sure-the-technical-expert-you-retain-to-testify-about-infringement-has-credentials-that-match-the-level-of-skill-required-by-the-court [https://perma.cc/W6ZE-NRB5] ("The court . . . had not, until now, addressed the *minimum* qualifications necessary to offer testimony from the perspective of a skilled artisan."); Jeremy Albright, *New Bar for Expert Testimony Warrants Legal Analysis When Selecting Experts*, NORTON ROSE FULBRIGHT (Aug. 2022), https://www.nortonrosefulbright.com/en-us/knowledge/publications/c1dfa01b/new-bar-for-expert-testimony-warrants-legal-analysis-when-selecting-experts [https://perma.cc/DCL3-JPAJ] (asserting that *Kyocera* set "a new threshold for an expert to be qualified to testify in a patent dispute"); David W. Haars, *Federal Circuit Holds that Your Technical Expert Must be a POSA*, STERNE KESSLER (Jan. 2022), https://www.sternekessler.com/news-insights/publications/federal-circuit-holds-your-technical-expert-must-be-posa [https://perma.cc/J2W8-9H4P] ("An expert that has extensive education and general industry experience may still not be an ordinarily skilled artisan if the level of ordinary skill in the art is crafted narrowly enough.").

10. *See* Haars, *supra* note 9 ("Although [*Kyocera*] was decided on appeal from the ITC, it has a number of implications for District Court and Patent Trial and Appeal Board litigation, and even original, reissue, and reexamination prosecution.").

11. *See infra* Section II.C.2 (discussing the ITC's expert witness practices, including not limiting expert witnesses to those having ordinary skill in the art).

12. U.S. PAT. & TRADEMARK OFF., TRIAL PRACTICE GUIDE UPDATE 3 (Aug. 2018) (quoting Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1363–64 (Fed. Cir. 2008)), https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf [https://perma.cc/F2EP-NMRJ].

13. *Patent Trial and Appeal Board*, U.S. PAT. & TRADEMARK OFF., https://www.uspto.gov/patents/ptab [https://perma.cc/B929-7J5L] (lasted visited Sep. 14, 2023).

> Board, so long as the expert's experience provides sufficient qualification in the pertinent art.[14]

In a decision issued nearly six months following *Kyocera*, the PTAB affirmed this stance, reiterating that precedent "does not hold that an expert must qualify as a person of ordinary skill in the art to give expert opinion testimony" and that an expert witness, though not a person having ordinary skill in the art, provided admissible testimony because that expert was nonetheless "qualified in the pertinent art" and the testimony was helpful to the PTAB's analysis.[15] Yet that has not prevented parties from arguing before the PTAB that *Kyocera*'s requirement should apply and that an expert witness should be a person of ordinary skill.[16]

"[O]rdinary skill in the art," as referred to in *Kyocera*, is a well-known term of art in patent practice.[17] A Person having Ordinary Skill In The Art ("POSITA")[18] is a legal fiction represented as "a hypothetical person who is presumed to have known the relevant art at the relevant time," that is, the time of invention.[19] The POSITA is not only aware of the relevant art (e.g., textbooks, journal articles, presentations concerning the technology at issue), but is also a person of "ordinary creativity" and is able to piece together different references or arguments in developing their opinion on a matter.[20] The POSITA is also typically aware of common solutions in the technical field, often has a certain level of education or experience, and may be advanced, depending on the sophistication of the technology.[21] The POSITA construct is applied during patent prosecution to evaluate, among other things, whether the specification would enable the POSITA to practice a claimed element[22] or would have

14. U.S. PAT. & TRADEMARK OFF., *supra* note 12, at 3 (emphasis added) (first citing SEB S.A. v. Montgomery Ward & Co., 594 F.3d 1360, 1373 (Fed. Cir. 2010); then quoting *Sundance*, 550 F.3d at 1363–64).

15. STMicroElectronics, Inc. v. Monterey Rsch., LLC, No. IPR2021-00130, 2022 WL 2112973, at *6 (P.T.A.B. June 10, 2022) (citing *Sundance*, 550 F.3d at 1363–64).

16. *See, e.g.*, Pat. Owner's Preliminary Response at 23–25, Gel Blaster, Inc. v. Spin Master, Inc., No. IPR2023-00302, 2023 WL 4629650 (P.T.A.B. Mar. 23, 2023) (arguing a potential expert witness does not qualify as a person having ordinary skill in the art and should thus be excluded from testifying); Pat. Owner's Preliminary Response at 11–14, Google LLC v. Wildseed Mobile LLC, No. IPR2023-00246, 2023 PAT. APP. FILINGS LEXIS 2086 (P.T.A.B. Mar. 16, 2023) ("Petitioner's expert . . . does not have the specific experience required under Petitioner's own definition of a POSITA . . . , and thus the Board should not credit any of his opinions rendered from the perspective of a POSITA.").

17. Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n, 22 F.4th 1369, 1377 (Fed. Cir. 2022); *see* Dennis Crouch, *An Expert of Ordinary Skill*, PATENTLYO (Aug. 28, 2022), https://patentlyo.com/patent/2022/08/expert-ordinary-skill.html [https://perma.cc/8LNS-U7MZ] ("Patent cases regularly involve expert testimony about how a 'person having ordinary skill in the art' . . . might think.").

18. Some practitioners prefer the abbreviation "PHOSITA"; others, "PSITA" (for Person Skilled In The Art). My preference is "POSA" but a strong majority of Patent Trial and Appeal Cases that use abbreviations favor "POSITA," so this Article will apply the same. Dennis Crouch, *Person (Having) Ordinary Skill in the Art*, PATENTLYO (Nov. 30, 2018), https://patentlyo.com/patent/2018/11/person-having-ordinary.html [https://perma.cc/PX7C-XSUS].

19. U.S. PAT. & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 2141 (Feb. 2023) [hereinafter MPEP], https://www.uspto.gov/web/offices/pac/mpep/mpep-2100.pdf [https://perma.cc/VP34-J9RT].

20. *Id.* (quoting KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 421 (2007)) ("A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton.").

21. *Id.*

22. ROBERT PATRICK MERGES & JOHN FITZGERALD DUFFY, PATENT LAW AND POLICY 474 (8th ed. 2021) (citing Invitrogen Corp. v. Clontech Labs., 429 F.3d 1052, 1070 (Fed. Cir. 2005)); *id.* at 477–78 (citing Auto.

considered the claimed invention to be obvious or anticipated in view of prior art references.[23]

By requiring an expert witness be a POSITA, the Federal Circuit is effectively hamstringing the availability of expert witnesses in technologically complex patent cases. In many cases, where it may be easy to find experts that are qualified as persons of ordinary skill in the art and that will also opine on a patent, this may not be an issue.[24] The discrepancy between the Federal Circuit and the PTAB will only come to light where the proffered witness is not a POSITA. However, as more complex patents are issued and thereafter litigated, the *Kyocera* decision will rear its head. This may be most evident, as discussed below, with cases where the POSITA is defined as a team of experts having multiple fields of expertise, while a given expert may only be reasonably qualified to testify as to one of those fields—not all of them.[25]

Concerningly, *Kyocera* makes its broad proclamation without any real support.[26] In its concise argument requiring an expert witness to be POSITA, it does not cite to the Federal Rules of Evidence, and only cites one case—*Sundance*—that arguably supports it.[27] But as described further in this Article, numerous decisions already argue that *Sundance* does not stand for the proposition that an expert witness must be a POSITA.[28] The only other cases cited by *Kyocera* concerning this issue are cases cited by the court to point out that they are not contrary to that decision.[29] They do not directly support the court's premise.[30] In contrast to *Kyocera*, Federal Rule of Evidence 702 stands for "the venerable practice of using expert testimony to educate the factfinder on general principles" and as discussed above, Rule 702 "simply requires that: (1) the expert be qualified; (2) the testimony address a subject matter on which the factfinder can be assisted by an expert; (3) the testimony be reliable; and (4) the testimony 'fit' the facts of the case."[31]

Techs. Int'l, Inc. v. BMW of N. Am., Inc., 501 F.3d 1274, 1276 (Fed. Cir. 2007)); *see also* MPEP, *supra* note 19, § 2164 ("The purpose of the [enablement] requirement that [sic] the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way.").

23. MPEP, *supra* note 19, §§ 2131, 2141.

24. *See, e.g.*, Daedalus Blue, LLC v. Microstrategy Inc., No. 2:20-CV-551, 2023 U.S. Dist. LEXIS 111037 (E.D. Va. Apr. 9, 2023) (holding that an expert witness is a POSITA and that the majority of their report is admissible under the *Kyocera* ruling); *see generally* Shubham Rana, *The Federal Rules for Choosing an Expert Witness in Patent Litigation*, COPPERPOD INTELL. PROP. (Jun. 15, 2021), https://www.copperpodip.com/post/the-federal-rules-for-choosing-an-expert-witness-in-patent-litigation [https://perma.cc/B7UM-SWAY] (describing how to find an expert witness that is a POSITA).

25. *Infra* Section III.

26. *See* Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022) (citing several Federal Circuit cases that are "not to the contrary" of its holding).

27. *Id.* (citing Sundance, Inc. v. Demonte Fabricating Ltd., 550 F.3d 1356, 1362 (Fed. Cir. 2008)).

28. *Infra* Section II.A.3.

29. *Kyocera*, 22 F.4th at 1377 (citing AquaTex Indus., Inc. v. Techniche Sols., 479 F.3d 1320, 1329 (Fed. Cir. 2007) (addressing how expert testimony is always required for infringement under the doctrine-of-equivalents and occasionally for literal infringement); Endress + Hauser, Inc. v. Hawk Measurement Sys. Party, Ltd., 122 F.3d 1040, 1042 (Fed. Cir. 1997) (recognizing that a requirement for "an expert witness to possess ordinary skill in the art and nothing more" "would be improper" as "a person of exceptional skill in the art would be disqualified from testifying as an expert").

30. *Id.*

31. FED. R. EVID. 702 advisory committee's note to 2000 amendment.

Though some may contend that "qualified" is doing the work in *Kyocera* to require an expert witness to be a POSITA, as I discuss below, historical practice evidences that an expert need not be a POSITA in order to be "qualified."[32]

This Article proposes a reevaluation of how an expert witness is treated if the witness does not qualify as a POSITA. It should be for the factfinder to consider the *weight* of the evidence based on the expert's qualifications, rather than for the court to consider the *admissibility* of such evidence based solely on whether or not the witness qualifies as a POSITA. Part I provides a historic overview of expert witnesses in patent litigation, setting a foundation upon which more recent decisions have been crafted. Part II describes the numerous requirements already in place for expert witness testimony to be admissible—from Federal Rule of Evidence 702 to precedential cases already covering substantial ground, including *Sundance* and *Daubert*—and evaluates how agencies may react to the additional constraints of *Kyocera*. Part III points out many of the potential issues that may arise if *Kyocera* is strictly applied in patent litigation moving forward, including a gap forming in practice between the Federal Circuit and the PTAB. Part IV describes potential solutions to address *Kyocera* and the admissibility of testimony from an expert witness that is not a POSITA.

The Federal Circuit's decision in *Kyocera* will have far-reaching consequences if it is strictly applied by future courts.[33] The Federal Circuit is the sole venue for appeals in patent cases, and its decisions are often final.[34] When a court of appeals has such power, practitioners may find it "generally easier and cheaper simply to do whatever" that circuit wants, rather than argue against its arguably overly-specialized influence and dominance in the legal field.[35] It is

32. *Infra* Section II.A; *see* FED. R. EVID. 702 advisory committee's note to proposed rules (noting that experts frequently testify in opinion form, and opinions ought to be excluded in cases where "they are unhelpful and therefore superfluous and a waste of time"); Mason Ladd, *Expert Testimony*, 5 VAND. L. REV. 414, 418 (1952) ("There is no more certain test for determining when experts may be used than the common sense inquiry whether the untrained layman would be qualified to determine intelligently and to the best possible degree the particular issue without enlightenment from those having a specialized understanding of the subject involved in the dispute.").

33. *See infra* Section III (discussing the complications and potential ramifications of applying *Kyocera*).

34. This is somewhat akin to the D.C. Circuit being the premier venue for administrative agency challenges, which itself gives these courts substantial power. *See* Antonin Scalia, Vermont Yankee*: The APA, the D.C. Circuit, and the Supreme Court*, 1978 SUP. CT. REV. 345, 371 ("As a practical matter, the D.C. Circuit is something of a resident manager, and the Supreme Court an absentee landlord."); *see also* Andrew Goldberg, *Chief Justice Roberts' Recent Comment on the Federal Circuit*, THE PRIOR ART (June 3, 2009, 3:36 PM), https://thepriorart.typepad.com/the_prior_art/2009/06/chief-justice-roberts-and-the-federal-circuit.html [https://perma.cc/2AZ8-QUB7] (describing laughter in the court when Chief Justice Roberts commented that federal appellate courts cannot ignore the Supreme Court, except for the Federal Circuit).

35. GARY LAWSON, FEDERAL ADMINISTRATIVE LAW 406 (9th ed. 2022); *see* John M. Golden, *The Federal Circuit and the D.C. Circuit: Comparative Trials of Two Semi-Specialized Courts*, 78 GEO. WASH. L. REV. 553, 554 (2010) ("The D.C. and Federal Circuits both provide examples of relatively new experiments in semi-specialization."); Sapna Kumar, *Patent Court Specialization*, 104 IOWA L. REV. 2511, 2514–16 (2019) (explaining the various types of court specialization); Sapna Kumar, *The Accidental Agency?*, 65 FLA. L. REV. 229, 245 (2013) ("It would be impossible for the Federal Circuit to engage in rulemaking on any meaningful scale without specialized knowledge of patent law. Yet Congress did not intend for the Federal Circuit to become a specialized court."); Sapna Kumar, *Judging Patents*, 62 WM. & MARY L. REV. 871, 875 (2021) ("Judicial expertise and specialization [in patent law] are multidimensional, encompassing legal and technical knowledge."); Stuart Minor Benjamin & Arti K. Rai, *Who's Afraid of the APA? What the Patent System Can*

thus important that the required qualifications of the expert witness be clarified swiftly, and that it be brought back into alignment with the Federal Rules of Evidence and existing precedent.[36]

I. A BRIEF HISTORY OF EXPERT WITNESSES IN PATENT LAW

For over 200 years, witnesses with expertise have been brought into patent cases to support arguments and factfinders have evaluated such testimony to consider how much weight to afford it.[37] Expert witness testimony has long been recognized as evidence that ought to be highly considered.[38] In 1818, Justice Story stated that, though expert testimony may be admissible, it is still "but matter of opinion; and its weight must be judged of by all the other circumstances of the case."[39] Thus, it has long been the duty of the factfinder to evaluate expert witness testimony and consider how much weight to give that testimony in view of the facts of the case.[40]

Previous practice recognized that although expert witnesses were known to be potentially biased on behalf of the side for which they presented their testimony, their arguments were nonetheless set with basis in fact, and their statements concerning factual matters were "simply to be weighed, like those of all other witnesses, by their ability and disposition to disclose the truth."[41] It has

Learn from Administrative Law, 95 GEO. L.J. 269, 285–86 (2007) (showing how the Federal Circuit had invoked "striking" reasoning and took positions that "lacked a judicial antecedent"); Melissa F. Wasserman & Jonathan D. Slack, *Can There be Too Much Specialization? Specialization in Specialized Courts*, 115 NW. U.L. REV. 1405, 1411–12 (2021) ("Specialized courts have a long history in the U.S. judiciary."); J. Jonas Anderson, *Specialized Standards of Review*, 18 STAN. TECH. L. REV. 151, 164 (2014) ("The Federal Circuit maintained its mixed review of obviousness decisions even after the court's standard was questioned by the Supreme Court.").

36. *Infra* Section IV; *see* FED. R. EVID. 702 advisory committee's note to 2000 amendment ("A review of the caselaw . . . shows that the rejection of expert testimony is the exception rather than the rule.").

37. WILLARD PHILLIPS, THE LAW OF PATENTS FOR INVENTIONS; INCLUDING THE REMEDIES AND LEGAL PROCEEDINGS IN RELATION TO PATENT RIGHTS 412–13 (1837); *see, e.g.*, Barrett v. Hall, 2 F. Cas. 914, 923 (C.C.D. Mass. 1818) (No. 1,047) (acknowledging that experts may testify in patent infringement cases, but that "its weight must be judged . . . by all the other circumstances of the case").

38. *See, e.g.*, Carr v. Rice, 5 F. Cas. 140, 145 (C.C.S.D.N.Y. 1856) (No. 2,440) ("The testimony of the respectable and intelligent experts . . . is entitled to great consideration . . . ."); *see also* Greg Reilly, *Rethinking the PHOSITA in Patent Litigation*, 48 LOY. U. CHI. L.J. 501, 515–16 (2016) (explaining the high reliance on experts in patent cases due, at least in part, to difficulty lay jurors and judges have in understanding the technology in the relevant field).

39. *Barrett*, 2 F. Cas. at 923; *see also* WILLIAM EDGAR SIMONDS, A DIGEST OF PATENT CASES 310–11 (1888) (collecting patent cases decided from 1789–1888 and describing the use and importance of expert witness testimony).

40. *See, e.g.*, Dixon v. Moyer, 7 F. Cas. 758, 759 (C.C.D. Pa. 1821) (No. 3,931) (noting it is "the jury [that] must judge for themselves, as well upon the information so given to them, as upon their own view," and evaluate how much weight to give expert witness testimony).

41. 3 WILLIAM C. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS 232–33 (1890); *See, e.g.*, Washburn v. Gould, 29 F. Cas. 312, 320 (C.C.D. Mass. 1844) (No. 17,214) ([T]he experts are not agreed, and, indeed, in the course of thirty years' experience, I have never, I think, known them to agree in opinion, as to whether any machine was really an invention or not. . . . [The factfinder] will weigh their testimony and give it its proper effect."); Stephen D. Easton, *Ammunition for the Shoot-Out with the Hired Gun's Hired Gun: A Proposal for Full Expert Witness Disclosure*, 32 ARIZ. ST. L.J. 465, 598–601 (2000) (noting the numerous biases integrated into the expert witness system as a whole); Peter S. Menell et al., *Patent Claim Construction: A Modern Synthesis and Structured Framework*, 25 BERKELEY TECH. L.J. 711, 727 (2010) ("[T]he Federal Circuit is likely to formally rule that there is a role for district court fact-finding in the claim construction process, especially with regard to assessing the credibility of competing expert witnesses.").

historically been the duty of the factfinder to evaluate the statements and to deduce how best to reach the truth of the matter.[42]

Testimony from expert witnesses plays an important role in many patent litigation cases since neither the factfinder nor the judge may have sufficient background to sufficiently understand all the complexities at issue.[43] As early as the 1850s, courts recognized that:

> There is no place in which the evidence of scientific men, upon topics within their own departments of knowledge, is more to be desired than in . . . court, when sitting for the trial of patent causes; and the opinions also of such men, when duly supported by reasonings founded on ascertained facts, must of course, be valued highly.[44]

This is not to say that the testimony of an expert witness was to be taken at face value without question.[45] With expert witness testimony, "it is a mistake to suppose that, even on a question of science, opinion can be dignified here or elsewhere with the mantle of authority" and one must be particularly cautious when the expert's testimony "assumes contested facts."[46]

In patent law, expert witnesses typically agree that the data is the same, but as with any litigation, have differing opinions as to what that data may be interpreted to mean.[47] Since the 1800s it has been recognized that factfinders, and especially judges, are aware of this position, but that the benefits of having experts to explain complex issues outweighs potential issues relating to bias of that expert witness testimony.[48] In *Conover v. Roach*, District Judge Hall succinctly summarized many of the aspects introduced thus far, noting that:

> In reference to these [expert witness] opinions, it happens, as it usually does in patent cases, that the opinions of the two experts on one side are apparently, if not actually, diametrically opposed to the opinions of the two experts on the other side. Indeed, it may be assumed in this and in most other patent cases, that neither party would have called the experts on his own side, unless he had supposed that their opinions in reference to the straining point of the case, would be directly opposed to the opinions which he supposes will be expressed by the experts of his adversary. Their well-considered and deliberately-formed opinions are asked in advance, and if they are found to be adverse to the party who seeks such opinion, that expert

42. *Washburn*, 29 F. Cas. at 320.

43. *See* French v. Rogers, 9 F. Cas. 790, 797 (C.C.E.D. Pa. 1851) (No. 5,103) (explaining the need for and importance of scientific experts in patent litigation cases); ROBINSON, *supra* note 41, at 235–37 ("The opinions of experts, with their reasons, are admissible in reference to questions which are to be decided by the court, as well as upon those which are to be submitted to the jury, provided the subject-matter of the question is one to which such evidence can be properly applied.").

44. *French*, 9 F. Cas. at 797; *see also* SIMONDS, *supra* note 39, at 310–11 (describing historical patent cases where expert witness testimony was highly valued and sometimes necessary).

45. *See French*, 9 F. Cas. at 797 (asserting the opinions of experts should be "highly valued").

46. *Id*.

47. ROBINSON, *supra* note 41, at 231 n.3.

48. *See* ROBINSON, *supra* note 41, at 232 ("As no wise judge would undervalue the assistance which industrious and learned advocates afford him, . . . no tribunal engaged in the examination of inventions can safely reject the light which the skill and experience of expert witnesses, though manifestly partisans, enable them to throw upon the nature and scope of an invention . . . .").

> is not called on his part. I do not say this, gentlemen, to impeach the integrity or fairness of the experts, or to convey the impression that they are wanting in intelligence or mechanical knowledge, for few experts possess any of these qualities in a higher degree than those called in this case; but to show you that upon these questions of mechanical equivalents, of substantial identity . . . these opinions are to be regarded by you as opinions merely, and that you must decide which opinions are correct, after carefully considering such opinions, and the reasons upon which the experts have told you they are based, in connection with the other evidence in the case . . . .[49]

In considering expert testimony in patent cases, the judges of yore appear to have been more concerned with the relative assistance the testimony could provide to the court in understanding the issues at hand, and were less concerned with the base qualifications of the experts themselves.[50] Rather than evaluating whether a given expert qualified as a person of ordinary skill in the field, the judges deemed the testimony to be admissible by considering how related the expert's testimony was to the issue at hand, and how well the opinion was applied to the facts in evidence.[51]

Thus, United States patent litigation has incorporated expert witness testimony for hundreds of years, but its practice was not to require the experts meet threshold qualifications before their testimony was admitted for the court's consideration.[52] The courts recognized the adversarial nature behind each party's selected expert witnesses, but these witnesses nevertheless served an important role in explaining concepts to the court, thus providing clarity to the factfinders.[53] Because they were aware of the adversarial nature of the testimony, the courts were well aware that the experts' opinions ought to be weighted accordingly.

II. QUALIFICATIONS OF AN EXPERT WITNESS

This Part details the evolution of expert witness qualifications. In the first Section, it describes the evolution of expert witness qualifications based on caselaw, including extensive precedent illustrating that courts did not require an expert witness be a POSITA in order to provide testimony in patent cases. In the second Section, it explores the statutory and regulatory requirements surrounding the admissibility of expert witness testimony—namely Federal

49. Conover v. Roach, 6 F. Cas. 326, 332 (C.C.S.D.N.Y. 1857) (No. 3,125).

50. S*ee* ROBINSON, *supra* note 41, at 235–37 (discussing the benefits an expert may offer to a judge in a patent infringement case, with no discussion determining that expert's precise qualifications).

51. *See* Overweight Counterbalance Elevator Co. v. Improved Ord., R.M.H. Ass'n, 94 F. 155, 161 (9th Cir. 1899) (explaining that "[n]either a court nor a jury are permitted to follow the guidance of any expert, in defiance of the results of practical operation and experiment, nor against conclusions derived by necessary inferences from established facts," with no discussion on an expert's qualifications) (internal citations and quotations omitted).

52. *See* ROBINSON, *supra* note 41, at 235–37 (explaining how expert testimony was admissible when the opinion was "in reference to questions which [were] to be decided by the court . . . provided the subject-matter of the question [was] one to which such evidence can be properly applied," with no discussion on determining an expert's qualifications).

53. *Conover*, 6 F. Cas. at 332.

Rule of Evidence 702, which governs the admissibility of such testimony today. In the final Section, this Article evaluates administrative practice in setting qualifications for expert witnesses. In total, this Part shows that the *Kyocera* requirement—that an expert witness be a POSITA in order for their testimony to be admissible—has no foundation and will likely face substantial rebuff.

A. Caselaw Requirements of Expert Witnesses

This Section proceeds in four subsections. First, the foundations of whether expert witness testimony is admissible is provided by caselaw from the pre-1900s era. Second, the evolution of more recent caselaw concerning admissibility of expert witness testimony is discussed, including discussion of courts' discretion and the gatekeeping role judges serve in allowing such testimony. Third, the *Sundance* decision—which was relied upon as support in the Federal Circuit's *Kyocera* holding—is evaluated, showing it does not broadly foreclose admissibility of relevant testimony from anyone who is not a POSITA. Finally, a brief summary of *Kyocera* is provided.

1. Foundation of Admissibility: Pre-1900s Caselaw

Substantial caselaw predated *Kyocera*, laying the foundation of what qualities are required by courts before considering expert witness testimony.[54] However, contrary to *Kyocera*, precedent illustrated that expert witness testimony was not limited to only those that were persons of ordinary skill in the art.[55] In the 1845 case of *Allen v. Blunt*, Justice Story recognized that a testifier that was not a practical artisan in the field, but nonetheless was "thoroughly conversant with the subject" at issue, would still be considered as a proper expert witness.[56] Notably, Justice Story did recognize a hierarchy of sorts: a skilled artisan (i.e., a POSITA) was "the very highest [of] witnesses" and "they were [by] far the most important and most useful to guide the judgment."[57] But Justice Story did not indicate the other witnesses ought to have their testimony barred from consideration—rather, their relative experience would go toward the weight of such testimony rather than its admissibility.[58]

The 1800s understanding of expert witness testimony was that it should be treated just as any other piece of evidence—introduced to the factfinder, who could then be the judge of the relative weight such evidence should be

54. *See* Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1360 (Fed. Cir. 2008) ("[Courts] review the admission of expert testimony for abuse of discretion"); *see also* Endress + Hauser, Inc. v. Hawk Measurement Sys. Party Ltd., 122 F.3d 1040, 1042 (Fed. Cir. 1997) (permitting an expert witness to testify based on past credentials and disposing of any argument that an expert witness must be a person of exceptional skill in the art).

55. *See* Allen v. Blunt, 1 F. Cas. 448, 450 (C.C.D. Mass. 1845) (No. 216) ("[A] mere artisan, skilled in the art with which it is connected, may in many cases be an important and satisfactory witness.").

56. *Id.*

57. *Id.*

58. *Id.*

afforded.[59] For example, *Many v. Sizer* held that courts ought to treat expert witness evidence just like any other when instructing the jury:

> [T]he opinion of experts—contrary to the general principle of law, which excludes opinions from going to a jury as evidence—is admissible in cases like this . . . in which it is presumable that the jury are not versed, and with regard to which, therefore, they may desire the aid of other persons, skillful and versed in the art or science in question. Hence it is, that the results which such skillful and accomplished persons have arrived at, in their own minds, are suffered to go to the jury as matters of evidence. But they are not to be held as conclusive. *They are to be judged of by you, and weighed by you, in the same manner as all the other evidence in the case*.[60]

Thus, the relative weight of expert testimony was to be determined by the factfinder; there was no indication that the judge should apply a threshold to cut off testimony that was otherwise deemed useful to the factfinder in coming to their conclusion.

The understanding of expert witnesses in patent cases during the 1800s was further elaborated by *Page v. Ferry*, which described at least two conditions where a witness would be considered an expert witness: when said witness is a person that is "skilled in the art or science," or, alternatively, where the witness is skilled "in a business or *art most nearly connected* with that to which his judgment or opinion is applied."[61] Thus there was flexibility baked into the system, allowing for those that perhaps did not meet the qualifications of being a POSITA to nonetheless have their testimony considered within the field at issue, so long as the field of study was sufficiently close enough.[62] Doubtless, the intent of this connection was to continue providing the informative element of expert witness testimony to the court; it is for the benefit of the court to allow expert witness testimony that would be informative.[63] Such openness to evidence is antithetical to a requirement that only a POSITA is allowed to be an expert witness.[64]

2. Recent Caselaw Concerning Admissibility

More recent caselaw shows that requirements for consideration of expert witness testimony already existed before *Kyocera* in order to ensure the factfinder is not misled.[65] For example, "the Federal Circuit requires an expert

59. *See* Head v. Hargrave, 105 U.S. 45, 49 (1881) ("[T]he jury should have applied that knowledge [gained from experts] and those ideas to the matters of fact in evidence in determining the weight to be given to the opinions expressed; and it was only in that way that they could arrive at a just conclusion.").

60. Many v. Sizer, 16 F. Cas. 684, 687 (C.C.D. Mass. 1849) (No. 9,056) (emphasis added).

61. Page v. Ferry, 18 F. Cas. 979, 983 (C.C.E.D. Mich. 1857) (No. 10,662) (emphasis added).

62. *Id.*

63. *See id.* at 983 (instructing the jury to make determinations at least in part based on the evidence presented by experts, people "who are acquainted practically with the structure and operation of similar machines, involving the same principle").

64. *See id.* (explaining that an expert may be someone "acquainted" with a field, with no requirement of a high level of skill in a particular art).

65. *See, e.g.*, Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1360 (Fed. Cir. 2008) (evaluating the various federal rules and caselaw covering the admissibility of expert witnesses and the

to set forth the factual foundation for his opinion in sufficient detail for the court to determine whether the factual foundation would support a finding of infringement."[66] However, even a lack of factual foundation is not grounds for de facto inadmissibility of the unfounded testimony; it is at the court's discretion whether such evidence is admitted.[67]

Even expert testimony to an "ultimate conclusion," (e.g., in patent cases, whether a product infringes a patent's claims or whether a claim is anticipated by a prior art reference) though often given little weight, is considered admissible for consideration by a court because the court is in position to decide how much weight to afford it, and such conclusory testimony is not binding.[68] District courts have discretion with respect to whether they consider testimony to an ultimate conclusion in view of additional supporting evidence.[69] For example, the Federal Circuit has clearly stated that "testimony on the ultimate issue of infringement is permissible in patent cases" because Federal Rule of Evidence 705 enables expert witnesses to "testify in terms of opinion or inference and give reasons therefor without prior disclosure of the underlying facts or data."[70]

Thus, expert witnesses have been enabled by the Federal Circuit to provide their opinion, even if only tenuously supported, with the understanding that the finder of fact would be able to adequately weigh such testimony in view of the sum of the evidence.[71] The courts have understood that questionable aspects of a witness's testimony will "*go to the weight, not the admissibility*, of the evidence" that was offered.[72] There exist traditional checks against bad expert

"gatekeeping role" played by the courts); *see also* Apple Inc. v. Samsung Elecs. Co., Ltd., 839 F.3d 1034, 1045 n.10 (Fed. Cir. 2016) (affirming the district court's discretion in allowing the jury to evaluate and weigh an expert witness's inconsistent statements).

66. Boston Sci. Scimed, Inc. v. Cordis Corp., 392 F. Supp. 2d 676, 685 (D. Del. 2005) (citing Novartis Corp. v. Ben Venue Lab'ys, Inc., 271 F.3d 1043, 1054 (Fed. Cir. 2001)).

67. *See* W.L. Gore & Assocs., Inc. v. Garlock, Inc., 842 F.2d 1275, 1280 (Fed. Cir. 1988) ("Where the evidence of infringement consists merely of one expert's opinion, without supporting tests or data, the district court is under no obligation to accept it.").

68. CHISUM, supra note 3, § 18.06[1][d][ii].

69. *Id.*; PATENT CLAIM CONSTRUCTION IN THE FEDERAL CIRCUIT (Edward D. Manzo, ed. 2011) § 2:75 ("[T]rial judges have 'sole discretion' to decide whether to have an expert's assistance in understanding a patent, and . . . the Court would not disturb that discretionary decision except in the clearest case.") (quoting Markman v. Westview Instruments, Inc., 52 F.3d 967, 981 (Fed. Cir. 1995)); *see also e.g.*, Novartis Corp. v. Ben Venue Labs., Inc., 271 F.3d 1043, 1054–55 (Fed. Cir. 2001) (explaining it was within a court's discretion to enter summary judgment of non-infringement where a patent owner's theory of infringement was supported only by an expert witness's conclusory opinion); *W.L. Gore & Assocs. Inc*., 842 F.2d at 1280 (finding a district court's decision on expert testimony admissibility was "not clearly erroneous").

70. Symbol Techs., Inc. v. Opticon, Inc., 935 F.2d 1569, 1575, 1575 n.2 (Fed. Cir. 1991); FED. R. EVID. 705.

71. *See* Rohm & Haas Co. v. Brotech Corp., 127 F.3d 1089, 1092 (Fed. Cir. 1997) ("Nothing in the rules or in our jurisprudence requires the fact finder to credit the unsupported assertions of an expert witness."); Apple Inc. v. Samsung Elecs. Co., Ltd., 839 F.3d 1034, 1045 n.10 (Fed. Cir. 2016) (finding a jury can properly credit and weigh an expert witness's testimony).

72. Quiet Tech. DC-8, Inc. v. Hurel-Dubois UK Ltd., 326 F.3d 1333, 1345 (11th Cir. 2003) (emphasis added); *see also* Hemmings v. Tidyman's Inc., 285 F.3d 1174, 1188 (9th Cir. 2002) ("[I]n most cases, objections to the inadequacies of a study are more appropriately considered an objection going to the weight of the evidence rather than its admissibility."); Cummings v. Standard Reg. Co., 265 F.3d 56, 65 (1st Cir. 2002) ("[W]hatever shortcomings existed in [the expert witness's] calculations went to the weight, not the admissibility, of the testimony."); *In re* TMI Litig., 193 F.3d 613, 692 (3d Cir. 1999) ("So long as the expert's testimony rests upon '"good grounds,"' it should be tested by the adversary process—competing expert testimony and active cross-

testimony, such as "[v]igorous cross-examination, presentation of contrary evidence, and careful instruction on the burden of proof" which may be used as "appropriate means of attacking [debatable] but admissible evidence."[73] For over a hundred years, it was known that "the value of . . . opinions [of expert witnesses] must be tested by the reasons on which they are built" and cannot be taken at face value; thus the factfinder is already aware of potential biases and intrinsically weighs the testimony from the beginning.[74]

This is not to say that courts could not exclude unsupported evidence—only that it was at the court's discretion whether to exclude it. In the early 1920s, the "*Frye* test" provided that courts could exclude scientific evidence—including expert witness testimony—if that evidence was not generally accepted by a substantial portion of the scientific community in that field.[75] This relatively strict test was somewhat relaxed by the Supreme Court 70 years later in *Daubert*—dealing specifically with the admissibility of expert witness testimony.[76] The Court rescinded the *Frye* standard, recognizing that "the *Frye* test was superseded by the adoption of the Federal Rules of Evidence" in 1975.[77] *Daubert* promoted a more liberal application of the Rules of Evidence when it came to allowing expert witnesses to testify.[78] In considering whether expert testimony should be admitted, *Daubert* proscribes four non-exclusive factors to consider: (i) whether the proffered theory "can be (and has been)" objectively tested; (ii) whether the theory "has been subjected to peer review and publication;" (iii) whether the theory has a "known or potential error rate" and the standards of testing; and (iv) whether it has attracted "[w]idespread acceptance" within a relevant scientific community.[79]

Applying the *Daubert* standard, a judge acts as a gatekeeper, but that gate ought to be left relatively wide open because the party opposite an expert witness has an opportunity to cross-examine the witness, present contrary evidence, and

examination—rather than excluded from juror's scrutiny for fear that they will not grasp its complexities or satisfactory[ily] weigh its inadequacies.'") (quoting Ruiz-Troche v. Pepsi Cola of Puerto Rico Bottling Co., 161 F.3d 77, 85 (1st Cir. 1998)); Wilmington v. J.I. Case Co., 793 F.2d 909, 920 (8th Cir. 1986) ("Virtually all the inadequacies in the expert's testimony urged here . . . were brought out forcefully at trial . . . . These matters go to the weight of the expert's testimony rather than to its admissibility.").

73. Daubert v. Merrell Dow Pharms., Inc., 509 U.S. 579, 596 (1993).

74. Jordan v. Dobson, 13 F. Cas. 1092, 1097 (C.C.E.D. Pa. 1870) (No. 7,519); *see also* SIMONDS, *supra* note 39, at 313 ("The testimony of experts is to be considered like any other evidence. It is to be tried by the same tests that are applied to the evidence of other witnesses, and as much credit and weight given to it as it is deemed entitled to from all other circumstances, and no more.") (citing Carter v. Baker, 5 F. Cas. 195 (C.C.D. Cal. 1871) (No. 2,472)).

75. Frye v. United States, 293 F. 1013, 1014 (D.C. Cir. 1923); Gary J. Van Domelen, *The Admissibility of Novel Scientific Evidence: The Current State of the* Frye *Test in Wisconsin*, 69 MARQ. L. REV. 116, 117–19 (1985); *Frye Standard*, WIKIPEDIA, https://en.wikipedia.org/wiki/Frye_standard [https://perma.cc/4JPW-WAT5] (last visited Sept. 16, 2023).

76. *Daubert*, 509 U.S. at 585.

77. *Id.* at 587.

78. *Id.* at 587–88 ("The drafting history [of Rule 702 of the Federal Rules of Evidence] makes no mention of *Frye*, and a rigid 'general acceptance' requirement would be at odds with the 'liberal thrust' of the Federal Rules and their 'general approach of relaxing the traditional barriers to "opinion" testimony.'") (quoting Beech Aircraft Corp v. Rainey, 488 U.S. 153, 169 (1988)).

79. *Id.* at 593–94.

clarify for the fact-keeper any issues that the witness may present.[80] In *Kumho Tire*, the Supreme Court recognized that judges' gatekeeping obligation was extended to all expert witness testimony, not just relegated to scientific testimony like that at issue in *Daubert*.[81]

The liberal gatekeeping role of judges when it comes to admissibility of expert witness testimony has been embraced by the courts.[82] The Federal Circuit has itself recognized that while expert witness testimony is not always necessary in patent cases, it is useful and important in cases "involving complex technology. . . . Where the field or art is complex, [the Federal Circuit has] repeatedly approved the use of expert testimony."[83] The Federal Circuit reasoned that expert testimony is not always necessary in patent cases, such as where "the technology will be 'easily understandable without the need for expert explanatory testimony,'"[84] but that many patent cases would benefit from such expert witness testimony. This particularly makes sense with the ever-growing complexity of patented subject matter.[85]

3. Foundation of Kyocera*:* Sundance

In its *Kyocera* holding that an expert witness must be a POSITA, Chief Judge Moore points to the 2008 Federal Circuit case, *Sundance*, for support.[86] In *Sundance*, then-Judge Moore stated that "[a] witness possessing merely ordinary skill will often be qualified to present expert testimony both in patent trials and more generally."[87] In other words, the witness need not have greater than the abilities of a POSITA to testify in patent trials. The court further elaborated that, where there's an issue wherein the opinion of a person of ordinary skill in the art would be beneficial, it is necessary that the witness be "qualified as a technical expert in that art" in order to conform to Federal Rule of Evidence 702.[88]

On its face, *Sundance* appears to suggest that a witness should have at least "ordinary skill" to provide admissible testimony—buttressed by the fact that Chief Judge Moore penned both opinions. However, *Sundance* was a

80. *Id.* at 589 (identifying the gatekeeping role as ensuring "that any and all scientific testimony or evidence admitted is not only relevant, but reliable"); *see also* F. SCOTT KIEFF ET AL., PRINCIPLES OF PATENT LAW (6th ed. 2013) 964–65 ("*Daubert* says that junk science is not admissible. But how is the judge, not himself an expert, to spot junk science?").

81. Kumho Tire Co., Ltd. v. Carmichael, 526 U.S. 137, 147 (1999).

82. *See, e.g.*, Pages-Ramirez v. Ramirez-Gonzalez, 605 F.3d 109, 114 (1st Cir. 2010) ("[W]e have noted that it would be an abuse of discretion to exclude testimony that would otherwise 'assist the trier better to understand a fact in issue,' simply because the expert does not have the specialization that the court considers most appropriate.") (quoting Gaydar v. Sociedad Instituto Gineco-Quirurgico y Planificacion Familiar, 345 F.3d 15, 24–25 (1st Cir. 2003)).

83. Centricut, LLC v. ESAB Grp., Inc., 390 F.3d 1361, 1369 (Fed. Cir. 2004).

84. *Id.* (quoting Union Carbide Corp. v. Am. Can Co., 724 F.2d 1567, 1573 (Fed. Cir. 1984)).

85. John R. Allison & Mark A. Lemley, *The Growing Complexity of the United States Patent System*, 82 B.U. L. REV. 77, 79 (2002).

86. Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022).

87. Sundance, Inc. v. DeMonte Fabricating, Ltd., 550 F.3d 1356, 1363 (Fed. Cir. 2008).

88. *Id.* ("[W]here 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.").

particularly "unusual situation" where a district court judge "admitted the testimony of a patent law expert '[d]espite the absence of any suggestion of relevant technical expertise.'"[89] Other courts have been hesitant to paint its holding with as broad a brush as Chief Judge Moore, and the issue of whether an expert must be a POSITA has not yet been addressed by the Supreme Court.[90]

The facts of *Sundance* illustrate how unique it is. A district court erroneously allowed a patent attorney to serve as a technical expert witness—testifying to the scientific or technical aspects of the patent at issue—though he had no qualifications whatsoever with the technology at hand.[91] The court recognized that, given his experience as a patent attorney, the expert was "qualified to testify as to patent office procedure generally" but "was not qualified as a technical expert" given the substantial lack of experience in the field.[92]

The holding of *Sundance* should not be applied too broadly, which is what the court did in *Kyocera*.[93] Fundamentally, *Sundance* is concerned with ensuring the factfinder is provided helpful information and given an understanding of the technology at issue.[94] Judge Moore was concerned that:

> Admitting testimony from a person such as [the patent attorney], 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 [the patent attorney] 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.[95]

Sundance recognizes that the admissibility of expert testimony is governed by Federal Rule of Evidence 702.[96] Some commentators have interpreted *Sundance* to mean that when an expert witness is testifying with regards to how a POSITA would have understood an element at issue, the expert witness should be at or above the POSITA level to qualify as admissible evidence under Rule

89. SEB S.A. v. Montgomery Ward & Co., 594 F.3d 1360, 1373 (Fed. Cir. 2010) (quoting *Sundance*, 550 F.3d at 1361–62).

90. *See, e.g.*, RMH Tech., LLC v. PMC Indus., Inc., 352 F. Supp. 3d 164, 195 (D. Conn. 2018) ("[H]ere, [the expert] has relevant experience, in the field of engineering, although not nearly as much experience as [another expert].").

91. *Sundance*, 550 F.3d at 1359 n.1; *id.* at 1360 (explaining that the technology at issue concerned segmented tarpaulin covers for use in trucks, and the party seeking to include the patent attorney's testimony admitted that he did "not have experience specifically with segmented tarpaulin systems").

92. *Id.* at 1359–61 nn.1–2.

93. *See* Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022) ("To offer expert testimony from the perspective of a skilled artisan in a patent case—like for claim construction, validity, or infringement—a witness must at least have ordinary skill in the art.").

94. *See Sundance*, 550 F.3d at 1362 (explaining that expert admissibility should be based, at least in part, on the amount of help or confusion the expert will inject into the trial).

95. *Id.* (emphasis added).

96. *Id.* at 1363 ("[W]here 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."); *see also* FED. R. EVID. 702.

702.[97] In addition to causing substantial issues with application in complex patent litigation,[98] this understanding of the law overextends Rule 702 and takes out of context the basis of *Sundance*. As discussed above, Rule 702 stands for "the venerable practice of using expert testimony to educate the factfinder on general principles."[99] It does not seek to exclude expert witness testimony that would be helpful to the factfinder but does not meet the threshold legal construct of a POSITA.[100]

The Federal Circuit previously recognized that an expert witness's testimony is admissible even where the expert witness was not a POSITA.[101] In *Best Medical*, the Federal Circuit affirmed a PTAB finding of obviousness, wherein the petitioner's expert witness was qualified as a POSITA while the patent owner's expert witness was not.[102] The Federal Circuit saw no error where the PTAB admitted testimony from an expert that was not a POSITA.[103] In other words, it was not apparently erroneous that the PTAB's consideration of whether an expert witness was qualified as a POSITA went to the *weight* of the evidence rather than its *admissibility*.

Other courts have pushed back on the broad application of *Sundance*.[104] For example, the District of Connecticut refused to exclude an expert witness's testimony regardless of the opposition's citation to *Sundance* and contention that the expert was not a POSITA.[105] The court recognized that *Sundance* was limited in scope—it concerned a "proffered expert [that] had 'no experience whatsoever'" in the relevant field, while in the case at issue, the expert "has relevant experience, in the field of engineering, although not nearly as much experience" as the other side's witness.[106] The Federal Circuit itself affirmed in *SEB v. Montgomery Ward* that, in a case regarding the design of deep fryers, an expert that had no skill in deep fryer design was nonetheless able to provide admissible testimony because that expert had "relevant" experience in a tangential subject matter (polymer materials).[107]

In fact, the "Third Circuit has interpreted the 'qualification' requirement liberally, explaining: 'Qualification requires that the witness possess specialized expertise. We have interpreted this requirement liberally, holding that a broad

97. *See, e.g.*, Crouch, *supra* note 17 ("The basic rule with experts testifying about PHOSITA appears to be that the experts need to personally be at or above PHOSITA level.").

98. *See infra* Section III (discussing the complications and potential ramifications of applying *Kyocera*).

99. FED. R. EVID. 702 advisory committee's note to 2000 amendment.

100. *See id.* ("An opinion from an expert who is not a scientist should receive the same degree of scrutiny for reliability as an opinion from an expert who purports to be a scientist.").

101. Albright, *supra* note 9 (citing Mytee Prods., Inc. v. Harris Rsch., Inc., 439 F. App'x 882, 886–87 (Fed. Cir. 2011)).

102. Best Med. Int'l, Inc. v. Elekta Inc., 46 F.4th 1346, 1349 (Fed. Cir. 2022).

103. *Id.* ("The Board accordingly discounted [the plaintiff's] expert testimony . . . .").

104. *See, e.g.*, RMH Tech., LLC v. PMC Indus., Inc., 352 F. Supp. 3d 164, 195 (D. Conn. 2018) (allowing an expert witness's testimony even though he lacked some characteristics of a person of ordinary skill because those "limitations go more to weight than to admissibility").

105. *Id.*

106. *Id.* (quoting Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1363 (Fed. Cir. 2008)).

107. SEB S.A. v. Montgomery Ward & Co., 594 F.3d 1360, 1373 (Fed. Cir. 2010).

range of knowledge, skills, and training qualify an expert as such.'"[108] This is understood to be flexible, and disputes relating to the testimony should be weighted by the factfinder.[109] Other courts have also pushed back against broad application of *Sundance*.[110]

Others have also recognized that *Sundance* should not be read as upheaving the admissibility of expert witness testimony, and furthermore that Federal Rule of Evidence 702 is what provides guidance with respect to such admissibility.[111] In *Plexxikon v. Novartis*, the District Court for the Northern District of California noted that:

> [T]he Federal Circuit in *Sundance* appeared to go out of its way to note that it was not altering the *status quo*. It emphasized that "[t]here is, of course, no basis for carving out a special rule as to experts in patent cases." Rather, "[a]dmission of expert testimony [in the context of patent cases] *remains subject to the Rules of Evidence* and is committed to the discretion of the district court." The Court finds it unlikely that the Federal Circuit would emphasize the significance of the district court's discretion in admitting expert testimony on the one hand, while simultaneously placing a new and significant limitation on that discretion on the other.[112]

The *Plexxikon* court was persuaded that *SEB* affirmed that Federal Rule of Evidence 702—not parties' definitions of a POSITA, as provided for by *Sundance*—governs whether expert witness testimony is admissible.[113]

Although there are certainly cases where exclusion of expert witness testimony is laudable—such as cases where the testimony was from an expert having experience or education too far removed from the contested issue[114]—*Sundance* should not be read too broadly. Rather, the determination of whether or not expert witness testimony is admissible should continue to be predominantly governed by Federal Rule of Evidence 702.[115]

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108. Sonos, Inc. v. D&M Holdings Inc., 297 F. Supp. 3d 501, 508 (D. Del. 2017) (quoting Calhoun v. Yamaha Motor Corp., U.S.A., 350 F.3d 316, 321 (3d Cir. 2003)).

109. *Id.* (citing Thomas & Betts Corp. v. Richards Mfg. Co., 342 F. App'x 754, 761 (3d Cir. 2009)).

110. *See, e.g.*, John Mezzalingua Assocs. v. PCT Int'l, Inc., No. SA-09-CV-00410-RF, 2011 U.S. Dist. LEXIS 164648, at *12–13 (W.D. Tex. Aug. 9, 2011) (distinguishing *Sundance* and admitting expert witness testimony on mechanical issues for a patent on coaxial cable connectors); Plexxikon Inc. v. Novartis Pharms. Corp., No. 17-cv-04405-HSG, 2020 U.S. Dist. LEXIS 51894, at *7 (N.D. Cal. Mar. 25, 2020) ("It is . . . unsurprising that district courts have reached different conclusions about whether being a POSITA is a threshold requirement to testify as an expert in patent cases.").

111. *Plexxikon*, 2020 U.S. Dist. LEXIS 51894, *9.

112. *Id.* (quoting Sundance, Inc. v. Demonte Fabricating Ltd., 550 F.3d 1356, 1360 (Fed. Cir. 2008)) (emphasis added).

113. *Id.*, *5–6, *9.

114. *See, e.g.*, Extreme Networks, Inc. v. Enterasys Networks, Inc., 395 F. App'x 709, 715 (Fed. Cir. 2010) (holding that an expert's testimony was inadmissible because "[g]eneral experience in a related field may not suffice when experience and skill in specific product design are necessary to resolve patent issues," and, in this case, the invention specifically required a substantial background in switches, bridges, and routers, and the non-admitted expert had never worked on such switches, bridges, or routers); Flex-Rest, LLC v. Steelcase, Inc., 455 F.3d 1351, 1360–61 (Fed. Cir. 2006) (excluding an ergonomics expert where the invention related to ergonomic keyboard design in particular).

115. *Plexxikon*, 2020 U.S. Dist. LEXIS 51894, *9.

4. Kyocera

The Federal Circuit significantly constrained admissibility of expert witness testimony in its 2022 precedential decision, *Kyocera*.[116] The expert witness issues began with a proceeding before the International Trade Commission ("ITC") concerning powered nailers (i.e., nail guns), and more specifically, gas spring nailers.[117] Kyocera Senco Brands, Inc. ("Kyocera") complained that Hitachi Koki U.S.A. Ltd. ("Hitachi") was importing nailer products that infringed a number of Kyocera's patents.[118]

The case was brought to the Federal Circuit following a muddying of the waters when an expert witness was deemed by the ITC as qualified to speak to literal infringement of a patent, but the ITC excluded the same expert's testimony when applied to an evaluation of the claimed technology under the doctrine of equivalents due to a lack of qualifications.[119] Expert testimony evaluation of literal infringement and infringement under the doctrine of equivalents are both taken from the perspective of a skilled artisan, so if *Sundance* was applied broadly, it would deem the testimony inadmissible as to both parts.[120]

In patent litigation, parties may stipulate or argue regarding what qualifications would transform a person into a POSITA.[121] Parties often propose a definition of POSITA that best suits their case, but in *Kyocera* one party's offered definition was not contested.[122] Hitachi proposed that a POSITA would have one of three levels of combined education and experience in the field, but, importantly, each of the three levels specifically included experience "in powered nailer design."[123] This definition of POSITA was not contested by Kyocera, and Kyocera also appeared to adopt that definition when its expert witness, Dr. John Pratt, indicated that he had applied Hitachi's proposed level of ordinary skill in his own evaluation of the issues in the case.[124] The ITC held

116. Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022); *see also* Certain Gas Spring Nailer Prods. & Components Thereof, Inv. No. 337-TA-1082, USITC Pub. 5075 (June 2020) [hereinafter USITC Pub. 5075] (providing factual background of the case).

117. USITC Pub. 5075 at 26–36; Blake Brittain, *U.S. Court Halts Import Ban on Hitachi Nail Guns in Kyocera Patent Case*, REUTERS (Jan. 21, 2022, 1:34 PM), https://www.reuters.com/legal/transactional/us-court-halts-import-ban-hitachi-nail-guns-kyocera-patent-case-2022-01-21/ [https://perma.cc/37EB-3SLF].

118. USITC Pub. 5075 at 4–5.

119. *Kyocera*, 22 F.4th at 1376.

120. *See* Alexander P. Ott, *Nailed It: Expert Must at Least Meet Ordinary Skill Level to Testify from POSITA Perspective*, MCDERMOTT WILL & EMERY: IP UPDATE (Jan. 27, 2022), https://www.ipupdate.com/2022/01/nailed-it-expert-must-at-least-meet-ordinary-skill-level-to-testify-from-posita-perspective/ [https://perma.cc/W7EA-TC97] ("The Federal Circuit reversed the ITC's decision, holding that it was error to permit any infringement testimony from Kyocera's expert and explaining that a witness must at least have ordinary skill in the art to offer testimony from the perspective of a skilled artisan for claim construction, validity or infringement, whether literal or under the doctrine of equivalents.").

121. *See, e.g.*, *Kyocera*, 22 F. 4th at 1376 ("Kyocera chose not to contest, and even seemed to adopt [its adversary's] articulation of the ordinary level of skill in the art.").

122. *Id.*

123. USITC Pub. 5075 at 252–53 ("One of ordinary skill in the art would have at least (i) a Master's Degree in mechanical engineering with at least two years of experience *in power nailer design*; (ii) a Bachelor's Degree in mechanical engineering with at least five years of experience *in powered nailer design*; or (iii) ten or more years of experience *in powered nailer design*.") (emphasis added).

124. *Id.*; *Kyocera*, 22 F.4th at 1376.

that Dr. Pratt's qualifications—which did not include experience with powered nailer design—rendered him as "not qualified as a person of ordinary skill in the art."[125] The ITC nevertheless admitted Dr. Pratt's testimony in evaluations other than infringement under the doctrine of equivalents, recognizing the "wide latitude" provided by courts under *Sundance*.[126] The ITC was only restrained in that the Federal Circuit had previously held that—specifically with regard to the doctrine of equivalents—an expert witness must be a POSITA.[127]

The Federal Circuit embraced the uncontested definition for POSITA and expanded *Sundance*, holding that "[t]o offer expert testimony from the perspective of a skilled artisan in a patent case . . . a witness must at least have ordinary skill in the art."[128] The Federal Circuit was apparently concerned that without meeting this threshold definition of POSITA, the testimony would be "neither relevant nor reliable" since it would have no basis in "knowledge, training, or experience that would be helpful to the fact-finder."[129]

The Federal Circuit thus upheaved the historical foundations of admissibility of expert witness testimony[130] and planted a flag in the ground, requiring that future expert witness testimony concerning a perspective of one skilled in the art to come from someone who is at least qualified as a POSITA. This flies in the face of the intentions behind Federal Rule of Evidence 702.[131]

In its decision, the Federal Circuit provided minimal support for its holding—citing only to *Sundance* to back its opinion, and noting the holding was not contrary to a few other cases.[132] The opinion did not cite to a statute or regulation to support its contention that an expert "witness must at least have ordinary skill in the art."[133] Most shocking, the court did not even discuss Federal Rule of Evidence 702, which governs admissibility of evidence, including expert witness testimony.[134]

Lacking significant support, the court nonetheless opined that without the expert being a POSITA, their testimony would lack "any specialized knowledge, training, or experience that would be helpful to the fact-finder."[135] But this conclusion is erroneous. The witness in question would bring specialized knowledge and experience to the table, and such experience—insofar as it

125. USITC Pub. 5075 at 238–44.

126. *Id.* at 242–43; *see* Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1360 (Fed. Cir. 2008) ("We note that admission of expert testimony is within the discretion of the trial court.").

127. USITC Pub. 5075 at 242 (citing AquaTex Indus., Inc. v. Techniche Sols., 479 F.3d 1320, 1329 (Fed. Cir. 2007)).

128. *Kyocera*, 22 F.4th at 1376–77.

129. *Id.* at 1377.

130. *See supra* Section II.A.1 (discussing the foundation of admissibility for the expert witnesses in pre-1900s caselaw, and how expert admissibility was not limited to persons of ordinary skill in the art).

131. *See infra* Section II.B (discussing the statutory and regulatory requirements governing the admissibility of expert witnesses).

132. *Kyocera*, 22 F.4th at 1377.

133. *Id.* at 1376–77.

134. *Id.*; *see also* FED R. EVID. 702 ("A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion . . . .").

135. *Kyocera*, 22 F.4th at 1377.

related to the issue at hand—would doubtless be beneficial to the factfinder.[136] Indeed, in the underlying *Kyocera* ITC case, the administrative judge understood that "a witness could qualify as an expert in the 'pertinent art,' without meeting the specific requirements of one of ordinary skill in the art" and that courts enjoyed "wide latitude" with regard to admissibility before permitting Dr. Pratt's testimony in part.[137] In contrast, for the Federal Circuit to support its contentions, the court offered the extreme counter-example that admitting testimony from an expert "*with no skill* in the pertinent art serves only to cause mischief and confuse the factfinder."[138]

Thus, the Federal Circuit has significantly constrained admissibility of expert witness testimony in patent cases concerning any aspects that are evaluated from the perspective of a person of skill, but its main support for doing so relies on fears that a proffered expert—such as a patent attorney—will have no technologically relevant skill whatsoever, and will nonetheless sway a factfinder.[139] But requiring an expert witness to be a POSITA is substantially more than simply requiring the witness have some beneficial perspective for the factfinder based on their learning or experience.[140] There is lush ground in the middle where a witness could assist the factfinder yet not be POSITA; this isn't to say that they lack any skill or knowledge whatsoever. Judges already have discretion to exclude testimony that would not be beneficial to the factfinder,[141] and the *Kyocera* requirement is at odds with the intentions of Federal Rule of Evidence 702.[142]

Case law thus suggests that expert witness testimony need not be excluded solely because the witness is not a POSITA, even when dealing with substantive patent issues such as invalidity or infringement.[143] Historically, any testimony deemed helpful to the factfinder would be allowed for consideration.[144] Trial judges act as gatekeepers for the introduction of expert witness testimony, and the Federal Circuit has established it will not disturb the judge's discretion "except in the clearest case."[145] The Federal Circuit also recognizes that the

136. *See, e.g.*, John Mezzalingua Assocs. v. PCT Int'l, Inc., No. SA-09-CV-00410-RF, 2011 U.S. Dist. LEXIS 164648, at *12–13 (W.D. Tex. Aug. 9, 2011) (finding a mechanical engineering professor would offer beneficial testimony to a case concerning coaxial cable connector patents).

137. Certain Gas Spring Nailer Prods. & Components Thereof, Inv. No. 337-TA-1082, USITC Pub. 5075 at 241–42 (June 2020).

138. *Kyocera*, 22 F.4th at 1377 (citing Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1362 (Fed. Cir. 2008)) (emphasis added).

139. *Id.* at 1367–77.

140. *See supra* Section II.A.3 (discussing the requirements of an expert witness after *Sundance*, how *Sundance* was an unusual case, and how it was generally accepted that an expert witness need only provide help to the factfinder for admission).

141. *See supra* Section II.A.2 (describing ways judges can exclude expert witness testimony and act as a gatekeeper to evidence, including under *Daubert*).

142. *Kyocera*, 22 F.4th at 1376–77; *see also* FED R. EVID. 702 advisory committee's note to 2000 amendment ("The amendment does not alter the venerable practice of using expert testimony to educate the factfinder on general principles.").

143. *See Sundance*, 550 F.3d at 1362 (refusing to admit an expert's testimony because he is a patent attorney with not relevant technical experience, not because he is not a POSITA); *see also supra* Section II.A.2 (discussing the admissibility of expert testimony through recent case law).

144. *See supra* Section II.A.1 (discussing the historical caselaw requirements of expert witnesses).

145. ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT 714 (6th ed. 2003) (citing Gen. Electro Music Corp. v. Samick Music Corp, 19 F.3d 1405 (Fed. Cir. 1994), Abbott Labs. v. Brennan, 952 F.2d 1346

relative skill of the expert witness goes to the persuasiveness of that witness when it comes to their explanation of complex technology.[146] Because the *Sundance* holding should not be construed as being broadly applicable, expert witness testimony from those not qualified as a POSITA should nonetheless be admissible under Rule 702.[147] The lack of experience or education should go to the *weight* of that testimony rather than its *admissibility*.[148]

B. Statutory and Regulatory Requirements of Expert Witnesses

In historical practice of patent litigation, there was no statutory requirement that an expert witness be a POSITA.[149] Until 1938, the Federal Equity Rules governed the procedural aspects of equitable suits in federal courts, which included patent litigation.[150] There was little prohibition when it came to admissibility of expert witness testimony in patent cases, leaving it for judges to ascertain.[151] Equity Rule 48 simply stated that, in cases regarding validity or scope of patents or trademarks, a district "court may . . . order that the testimony in chief of expert witnesses . . . be set forth in affidavits" and that any affidavit could be considered as evidence unless the affiant refused to comply with cross-examination.[152] Insofar as federal statutes were considered in admissibility of expert witness testimony, this was regulated by 28 U.S.C. § 636, which in turn pointed practitioners back to the equity rules.[153]

After the Federal Rules of Civil Procedure took effect in 1938, the 1912 Equity Rules were relegated to the past.[154] Federal Rule of Civil Procedure 43 replaced 1912 Equity Rule 48, and the updated rule was similarly silent

(Fed. Cir. 1991), Acoustical Design, Inc. v. Control Elecs. Co., 932 F.2d 939 (Fed. Cir. 1991), Seattle Box Co., Inc. v. Indus. Crating & Packing, Inc., 731 F.2d 818 (Fed. Cir. 1984), and Milmark Servs., Inc. v. United States, 731 F.2d 855 (Fed. Cir. 1984)).

146. *See* Mitsubishi Elec. Corp. v. Ampex Corp., 190 F.3d 1300, 1313 (Fed. Cir. 1999) ("It is well recognized that the persuasiveness of the presentation of complex technology-based issues to lay persons depends heavily on the relative skill of the experts.").

147. *See* SEB S.A. v. Montgomery Ward & Co., 594 F.3d 1360, 1373 (Fed. Cir. 2010) (describing the situation in *Sundance* as "unusual"); FED R. EVID. 702 (permitting an expert to testify so long as "the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue").

148. *See supra* note 72 and accompanying text (explaining how multiple appellate courts have ruled that questionable aspects of a witness's testimony will go to the weight, not admissibility, of that testimony).

149. *See supra* Section I (discussing the historical caselaw requirements of expert witnesses in patent cases).

150. *See* THOMAS D. ROWE, JR. ET AL., 2020 SUPPLEMENT TO CIVIL PROCEDURE 14–15 (5th ed. 2020) (explaining American antecedents to the current civil procedure system, including the 1912 Equity Rules, which were replaced by the enactment of the Rules Enabling Act of 1934 and the promulgation of the Federal Rules of Civil Procedure, taking effect in 1938); Wallace R. Lane, *One Year Under the New Federal Equity Rules*, 27 HARV. L. REV. 629, 636–37 (1914) (describing patent cases applying the Federal Equity Rules).

151. Wallace R. Lane, *Federal Equity Rules*, 35 HARV. L. REV. 276, 292–93 (1922) (detailing the Federal Equity Rule for testimony of expert witnesses and how judges would be the ones deciding whether or not to admit expert testimony).

152. Robert H. Talley, *The New and the Old Federal Equity Rules Compared*, 18 VA. L. REV 663, 667 (1913); *see also* LEON H. AMDUR, PATENT LITIGATION 243 (1933) (illustrating Equity Rule 48 was applied to patent litigation as of 1933); *see generally* Lane, *supra* note 150 (summarizing the promulgated Equity Rules).

153. EMERSON STRINGHAM, PATENT INTERFERENCE EQUITY SUITS § 7934 (1930) ("The federal statutes on evidence and witnesses are assembled in 28 USCA, sections 631–704. . . . This statutory provision . . . is now effective under the equity rules of 1912. . . . Rule 48 provides for affidavits by experts in patent causes.").

154. ROWE ET AL., *supra* note 150, at 15.

regarding mandatory qualifications of an expert witness to provide testimony.[155] Insofar as the Federal Rules of Civil Procedure dictated admissibility of expert witness testimony, these rules gave way to the Federal Rules of Evidence upon their enactment in 1975.[156] More specifically, Federal Rule of Evidence 702 governed the admissibility of expert witness testimony and in line with past practice, it did not require that expert witness testimony be given by a POSITA in order to be admissible.[157]

Today, admissibility of expert witness testimony continues to have basis in Federal Rule of Evidence 702, though the Supreme Court has further shaped the understanding of what individual may testify as an expert witnesses.[158] The Advisory Committee on Evidence Rules' notes to Rule 702 provide additional factors to consider in determining whether an expert's testimony is reliable,[159] but notes that "the *admissibility* of all expert testimony is governed by the principles of Rule 104(a),"[160] which merely states that a court "must decide any preliminary question about whether a witness is qualified" but that "[i]n so deciding, the court is not bound by evidence rules, except those on privilege."[161]

The Federal Rules of Evidence thus establish the requirements of expert witness testimony.[162] A purpose of expert witness testimony under the Rules of Evidence is to facilitate "the venerable practice of using expert testimony to educate the factfinder on general principles."[163] The Rules of Evidence, however, do not require a witness be a person of ordinary skill in the art. Instead, they only require that, where specialized knowledge will benefit the trier of fact in understanding the evidence or some factual issue, "a witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise."[164] The focus is on enabling the factfinder to fully understand and evaluate the issues.[165]

Federal Rule of Evidence 702 would allow consideration of testimony from "a witness . . . qualified as an expert" even if that witness is not a POSITA.[166]

155. FED. R. CIV. P. 43; *see id.*, advisory committee's note to 1937 amendment ("This rule abolishes in patent and trade-mark actions, the practice under [former] Equity Rule 48 of setting forth in affidavits the testimony in chief of expert witnesses whose testimony is directed to matters of opinion.").

156. Rules of Evidence for United States Courts and Magistrates, Pub. L. No. 93–595, § 101, 88 Stat. 1926, 1929 (1975).

157. FED. R. EVID. 702.

158. Lewis v. Citgo Petroleum Corp., 561 F.3d 698, 705 (7th Cir. 2009) ("The admissibility of expert testimony is governed by Federal Rule of Evidence 702 and the Supreme Court's opinion in *Daubert* . . . ."); Daubert v. Merrell Dow Pharms., Inc., 509 U.S. 579, 597 (1993).

159. FED. R. EVID. 702 advisory committee's note to 2000 amendment (disclosing additional factors of reliability include: (1) whether the testimony relates to matters growing naturally and directly from research conducted independent of the litigation; (2) whether the expert unjustifiably extrapolated from an accepted premise to an unfounded conclusion; (3) whether the expert adequately accounted for obvious alternative explanations; (4) whether the expert is being as careful as he would be during his regular professional work outside the paid litigation consulting; and (5) whether the field of expertise is known to reach reliable results for the type of opinion the expert would give).

160. *Id.* (emphasis added).

161. FED. R. EVID. 104(a).

162. KIMBERLY PACE MOORE ET AL., PATENT LITIGATION AND STRATEGY 150–51 (1999).

163. FED. R. EVID. 702 advisory committee's note to 2000 amendment.

164. FED. R. EVID. 702.

165. FED. R. EVID. 702 advisory committee's note to 2000 amendment.

166. FED. R. EVID. 702.

Impliedly, the factfinder would be able to weigh the testimony accordingly, thus an expert not being a POSITA should go to the weight of the evidence, not its admissibility, since such evidence will nonetheless "assist the trier of fact to understand the evidence or to determine a fact in issue."[167]

C. Administrative Requirements of Expert Witnesses

This Section details how administrative agencies evaluate whether expert witness testimony is admissible and, in particular, how those agencies rely on Federal Rule of Evidence 702 in making their decisions. Although the *Kyocera* decision is beginning to come to the forefront of administrative adjudication, some early outcomes indicate these agencies have not embraced the Federal Circuit's viewpoint that an expert witness must be a POSITA in order to provide testimony.[168]

1. United States Patent and Trademark Office

Adjudication before the Patent Trial and Appeal Board (PTAB) differs in numerous ways from district court cases.[169] For example, while Federal Rule of Evidence 706 allows the appointment of neutral experts to inform judges on complex issues, PTAB judges have refused to consider such neutral expert testimony because its members are already competent in both legal and scientific ability.[170] The Board also anticipated that most petitions before it would include obviousness cases, and that the Board could review *any* objective evidence of non-obviousness by patent owner where appropriate.[171] This did not exclude types of expert witness testimony.

The Federal Circuit's holding in *Kyocera* conflicts directly with PTAB practice.[172] The PTAB Trial Practice Guide embraces the broader understanding of Federal Rule of Evidence 702, explicitly stating:

> A person may not need to be a person of ordinary skill in the art in order to testify as an expert under Rule 702, but rather must be "qualified in the pertinent art." . . . For example, the absence of an advanced degree in a particular field may not preclude an expert from

167. *Id.*; *see supra* note 72 and accompanying text (explaining how multiple appellate courts have ruled that questionable aspects of a witness's testimony will go to the weight, not admissibility, of that testimony).

168. *See* U.S. PAT. & TRADEMARK OFF., CONSOLIDATED TRIAL PRACTICE GUIDE 34 (Nov. 2019), https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=TrialPracticeGuideConsolidated [https://perma.cc/9AXT-E3YL] ("A person may not need to be a person of ordinary skill in the art in order to testify as an expert under Rule 702, but rather must be 'qualified in the pertinent art.'") (quoting Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1363–64 (Fed. Cir. 2008)).

169. *Federal Circuit Holds that the PTAB and District Courts May Reach Different Conclusions*, BUCHANAN PTAB REPORT (Apr. 11, 2017), https://buchanan-ip.com/PTAB/federal-circuit-holds-ptab-district-courts-may-reach-different-conclusions/ [https.perma.cc/3EFV-KVWG].

170. CHISUM, *supra* note 3, § 7.2.4.6 (quoting Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48680, 48643 (Aug. 14, 2012) (codified at 37 C.F.R. pt. 42)).

171. *Id.* (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48755, 48763 (Aug. 14, 2012) (codified at 37 C.F.R. pt. 42)).

172. *See generally* Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022) (explaining that an expert witness in patent cases must be a person of ordinary skill in the art).

> providing testimony that is helpful to the Board, so long as the expert's experience provides sufficient qualification in the pertinent art.[173]

Although this is in direct opposition to the *Kyocera* requirement that an expert witness be a POSITA, one can understand why the PTAB may be afforded more latitude with the admissibility of its expert witness testimony. While Chief Judge Moore was concerned with misleading or confusing the factfinder in *Kyocera*, the factfinder in PTAB cases are the administrative patent judges themselves—and are thus much less at risk of being misled compared to the average juror.[174] Furthermore, as an administrative agency, it is not beholden to the same application of the Federal Rules of Evidence.[175]

Regardless of whether the Federal Circuit agrees that PTAB judges are in a better position to assess witness credibility, those PTAB judges are moving forward with their own standards of admissibility for expert witness testimony. Almost half a year after *Kyocera* was decided, the PTAB reiterated that its prior practice "does not hold that an expert must qualify as a person of ordinary skill in the art to give expert opinion testimony."[176] Furthermore, even if an expert witness was not a POSITA, that testimony could nonetheless be admissible if the expert was "qualified in the pertinent art" and the PTAB found such testimony beneficial in its analysis.[177]

The Federal Circuit will have to take a firm stand against the PTAB if it seeks to force its perspective onto the agency. It is known that the Federal Circuit should not overturn a lower court's decision with regards to admissibility of expert witness testimony unless there's *clear error*.[178] Error would also need to be found with the USPTO's promulgated rules—namely 37 C.F.R. § 42.62 (generally incorporating the Federal Rules of Evidence into PTAB proceedings)[179] and § 42.65 (detailing expert witness testimony).[180] These rules do not limit admission of expert witness testimony to those that have a certain level of expertise; they only state that expert testimony that lacks underlying facts or data results in an opinion that "is entitled to little or no weight."[181] Thus, the promulgated rules of the agency provide that the PTAB is to embrace the Federal Rules of Evidence (including Rule 702) in evaluating admissibility of

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173. U.S. PAT. & TRADEMARK OFF., *supra* note 12, at 2–3 (emphasis added) (quoting Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1363–64 (Fed. Cir. 2008)).

174. *See* 35 U.S.C. § 6(a) ("The administrative patent judges shall be persons of competent legal knowledge and scientific ability.").

175. 37 C.F.R. § 42.62.

176. STMicroElectronics, Inc. v. Monterey Rsch., LLC, No. IPR2021-00130, 2022 WL 2112973, at *6 (P.T.A.B. June 10, 2022) (citing Sundance, Inc. v. Demonte Fabricating Ltd., 550 F.3d 1356, 1363 (Fed. Cir. 2008)).

177. *Id.*

178. Rebecca S. Eisenberg, *A Functional Approach to Judicial Review of PTAB Rulings on Mixed Questions of Law and Fact*, 104 IOWA L. REV. 2387, 2407 (2019).

179. 37 C.F.R. § 42.62(a) ("Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a proceeding.").

180. 37 C.F.R. § 42.65(a) ("Testimony on United States patent law or patent examination practice will not be admitted").

181. *Id.*; 1 STERNE, KESSLER, GOLDSTEIN & FOX, P.L.L.C., PATENT OFFICE LITIGATION 336–37 (Robert Greene Sterne et al. eds., 2012).

testimony, and doubts as to the support of such testimony go to the *weight* of that evidence rather than its *admissibility*.

The promulgated rules appear to expand the bounds of what would be considered admissible in PTAB practice.[182] Strictly following the Federal Rules of Evidence, expert witness testimony should be "based on sufficient facts or data" and must be "the product of reliable principles and methods."[183] In contrast, 37 C.F.R. § 42.65 expands admissibility to allow even expert testimony that "does not disclose the underlying facts or data," but notes that the lack of such information can lead to the PTAB discounting the weight of that testimony.[184]

Although the USPTO has "adopt[ed] the more formal evidentiary rules used in district courts in view of the adversarial nature of the proceedings before the Board," there are distinctions in how expert testimony is treated between PTAB and district court litigation.[185] Because the PTAB administrative patent judges are, by statute, necessarily "persons of competent legal knowledge and scientific ability,"[186] they have a technical background and thus are able to consider expert testimony in a light that is distinct from district court practice.[187] Furthermore, even in its adoption of district court rules, the USPTO was hesitant to adopt all its facets—for example, unlike the practice in many district courts, expert testimony "on United States patent law or patent examination practice will not be admitted" in PTAB proceedings.[188]

The PTAB disagrees fundamentally with even the foundation upon which the Federal Circuit built its *Kyocera* holding.[189] The Board stated that,

182. *See* 37 C.F.R. § 42.62(a) (seemingly applying the Rules of Evidence to the PTAB).

183. FED. R. EVID. 702.

184. 37 C.F.R. § 42.65(b); 1 STERNE, KESSLER, GOLDSTEIN & FOX, P.L.L.C., *supra* note 181, at 336–37.

185. Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,624 (Aug. 14, 2012) (codified at 37 C.F.R. pt. 42); *see* Blaine M. Hackman et al., *Expert Discovery Protections: Comparing District Courts with the PTAB*, 19 CHI.-KENT J. INTELL. PROP. 504, 504–06 (2020) (contrasting PTAB discovery in attorney-expert witness communications with district court practice); Matthew Bultman, *Depositions at PTAB Vs. District Court: What to Know*, STERNE KESSLER (Apr. 18, 2018), https://www.sternekessler.com/news-insights/news/depositions-ptab-vs-district-court-what-know [https://perma.cc/Z7LE-EXUT] (describing differences in depositions of expert witnesses between the PTAB and district courts and explaining that "[l]awyers cannot come into a PTAB deposition expecting it to be like a district court deposition").

186. 35 U.S.C. § 6(a).

187. *See* Janet Gongola, *The Patent Trial and Appeal Board: Who are They and What do They do?*, USPTO, https://www.uspto.gov/learning-and-resources/newsletter/inventors-eye/patent-trial-and-appeal-board-who-are-they-and-what [https://perma.cc/ZQ38-JUUL] ("[E]very APJ must have a technical background, in addition to a law degree, and experience in the legal field.") (last visited Sept. 17, 2023); Scott McKeown, *CAFC Explains PTAB Expertise & Its Role in IPR Fact Finding*, WOLF GREENFIELD (Dec. 14, 2016), https://www.patentspostgrant.com/cafc-explains-ptab-expertise-its-role-in-ipr-fact-finding/ [https://perma.cc/B7P7-RLBF] ("[T]here are more differences than similarities between [PTAB and district court practice].").

188. 37 C.F.R. § 42.65(a); Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,676 (Aug. 14, 2012) (codified at 37 C.F.R. pt. 42).

189. *See* David W. Haars & Daniel S. Block, Kyocera *and the Brewing Debate Over Expert Qualifications at the PTAB*, STERNE KESSLER, https://www.sternekessler.com/news-insights/publications/kyocera-and-brewing-debate-over-expert-qualifications-ptab [https://perma.cc/KCA9-RAZ3] ("In the wake of *Kyocera*, PTAB panels have applied its holding and accorded no weight to testimony from experts who do not possess

"*Sundance* does not hold that an expert must qualify as a person of ordinary skill in the art to give expert opinion testimony" and point to the Consolidated Trial Practice Guide as noting that "[a] person may not need to be a person of ordinary skill in the art in order to testify as an expert under Rule 702."[190] Though an expert witness may not be a POSITA, the PTAB will nonetheless admit testimony from the expert witness if it is helpful to the Board, even if the expert's experience is not a direct match with the field of the POSITA.[191]

Therefore, the adjudicative arm of the USPTO is unlikely to embrace the Federal Circuit's holding of *Kyocera* and will instead continue to base its admissibility practice on Federal Rule of Evidence 702. It is unclear at this time whether the Federal Circuit will defer to the PTAB and allow it to continue admitting such testimony, or if conflict will come to a head in the future.[192]

2. International Trade Commission

Though *Kyocera* directly concerned an appeal from the ITC, precedent illustrates that adjudicative decisions by the ITC did not historically limit expert witness testimony to persons having ordinary skill in the art.[193] The ITC, like the USPTO, looks to Federal Rule of Evidence 702 in considering whether expert witness testimony is admissible.[194] Also like the USPTO, the ITC recognizes that admissibility of expert witness testimony is discretionary and should be used when that testimony will be helpful to the trier of fact in understanding the issues at hand.[195]

Because the factfinder in ITC adjudication is an administrative judge (rather than a lay juror), Chief Judge Moore should be less concerned about expert witness testimony hoodwinking the factfinder. Prior ITC decisions argued that Rule 702 allowed admissibility of expert witness testimony even if there is little evidence supporting that testimony since the administrative judge was unlikely to be improperly swayed by that testimony, yet the testimony could still contain beneficial aspects in evaluating the issues at hand.[196] The ITC explicitly recognized that in evaluating such expert witness testimony, the

ordinary skill. . . . That said, PTAB panels have thus far been reluctant to disregard testimony from an expert who is currently a skilled artisan but was not at the time of the invention.").

190. STMicroElectronics, Inc. v. Monterey Rsch., LLC, No. IPR2021-00130, 2022 WL 2112973, at *6 (P.T.A.B. June 10, 2022) (quoting U.S. PAT. & TRADEMARK OFF., *supra* note 12, at 2–3).

191. *Id.*

192. Haars & Block, *supra* note 189.

193. Certain Starter Motors and Alternators, Inv. No. 337-TA-755, USITC Pub. 4398, 2011 ITC LEXIS 2038 (July 2011) [hereinafter USITC Pub. 4398]; Certain Integrated Repeaters, Switches, Transceivers and Products Containing Same, Inv. No. 337-TA-435, USITC Pub. 3547, 2002 ITC LEXIS 615 (Oct. 2002) [hereinafter USITC Pub. 3547].

194. USITC Pub. 4398 at *4.

195. *Id.*

196. *See* Certain Mobile Devices with Multifunction Emulators, Inv. No. 337-TA-1170, 2020 ITC LEXIS 587, at *3–4 (2020) ("Dynamics essentially argues that the opinion is based on such scant evidence so as to fail to assist the trier of fact under Federal Rule of Evidence 702 . . . . In general, the harm from expert testimony that does not assist the trier of fact . . . *is greatly diminished in the absence of a jury*—as in the present investigation. If, as Dynamics argues, [the expert's] testimony fails to assist me in determining the salient facts, I will give it no weight.") (emphasis added).

administrative judge "will evaluate each experts' testimony, which goes to the *weight* of the evidence, rather than admissibility."[197]

Therefore, both administrative agencies emphasize an evaluation of expert witness testimony admissibility under Federal Rule of Evidence 702. Because the administrative judges are more apt at discerning flaws in testimony than lay jurors, both the USPTO and ITC allow for the consideration of testimony that may otherwise be rejected in district courts. Thus, both the USPTO and ITC approach the admissibility of expert witness testimony in a manner directly at odds with the holding of *Kyocera*—these agencies do not require an expert witness to be a POSITA in order to testify.[198] The administrative judges are well-suited to consider the background of witnesses and weigh their testimony accordingly.[199]

III. COMPLICATIONS OF APPLYING *KYOCERA*

By requiring an expert witness be a POSITA to provide admissible testimony, *Kyocera* unwittingly unleashes numerous issues likely to arise in future patent litigation. Patents are becoming more complicated, meaning that the pool of persons who could even qualify as a POSITA is continually shrinking, and it is likely that patents will issue in the near future where no one person could by themselves qualify as a POSITA.[200] Additionally, who qualifies as a POSITA is locked in time to when the invention came into being, so as time marches forward and memories fade, the number of persons qualified to testify is further constrained.[201] In the end, courts—and in particular, administrative courts—may simply ignore *Kyocera*'s holding and instead continue adhering to Federal Rule of Evidence 702 to allow helpful testimony in a significantly less constrained manner.[202]

Some may propose that any issue of applying *Kyocera* could be readily avoided if litigants simply played with their proffered definitions of POSITA. It truly may have been beneficial for *Kyocera* to have at least argued for a broader POSITA in order to embrace its own expert witness in the *Kyocera* case detailed

197. Certain Ammonium Octamolybdate Isomers, Inv. No. 337-TA-477, USITC Pub. 4384, 2003 ITC LEXIS 59, at *2–3 (2003) [hereinafter USITC Pub. 4384] (emphasis added); *id.* at *3 ("As this proceeding is being tried in front of administrative law judge, not a jury, [the party's] concerns about the reliability of the data . . . rel[ied] upon are not necessary.").

198. STMicroElectronics, Inc. v. Monterey Rsch., LLC, No. IPR2021-00130, 2022 WL 2112973, at *6 (P.T.A.B. June 10, 2022) (quoting U.S. PAT. & TRADEMARK OFF., *supra* note 12, at 2–3); USITC Pub. 4384, at *2–3.

199. *See* USITC Pub. 4384, at *2–3 (asserting that administrative law judges are able to appropriately weigh expert testimony).

200. *See* David W. Haars, *Federal Circuit Court Holds that Your Technical Expert Must be a POSA*, STERNE KESSLER (Jan. 2022), https://www.sternekessler.com/news-insights/publications/federal-circuit-holds-your-technical-expert-must-be-posa [https://perma.cc/475C-YS2N] ("An expert that has extensive education and general industry experience may still not be an ordinarily skilled artisan if the level of ordinary skill in the art is crafted narrowly enough. Offensively, practitioners on both sides should seek to exclude an opposing expert's testimony if he does not meet the narrowly crafted qualifications for a skilled artisan.").

201. Haars & Block, *supra* note 189.

202. *See id.* ("For the time being, it appears that PTAB panels are generally unwilling to extend the *Kyocera* ruling . . . .").

above.[203] But what will happen when more complicated technology than nail guns is at play and a singular individual cannot qualify as a POSITA? Strictly requiring that a real expert witness qualify as a hypothetical POSITA is untrodden territory with particularly complex technologies.

Contrary to some commentators that do not foresee complications arising in the application of *Kyocera*,[204] finding expert witnesses eligible to testify from the perspective of a POSITA will become more difficult as complexities of issued patents increase.[205] Some may not foresee an issue since many patents still cover subject matter that is relatively straightforward, but with the rising complexity of issued patents, the required qualifications of a corresponding POSITA rise in tandem, and eventually conflict will come to a head.

The increasing complexity of patents arises, in part, from the number of inventors associated with an issued patent and the interdisciplinary nature of many inventions.[206] There has been a clear trend over time of an increasing average number of inventors on issued patents.[207] By 2018, close to a quarter of issued patents listed four or more inventors.[208] Further exacerbating complexity, interdisciplinary research is, as a whole, on the rise.[209] As patents are becoming more "often major team projects," and less individual enterprises,[210] complexity is further compounded with inventions stemming from interdisciplinary efforts.[211]

When an invention requires the input of numerous researchers having extensive education and experience in vastly different fields of study, it begs the question—what one person could even be qualified to speak as a POSITA? The

203. *See supra* notes 116–27 and accompanying text (explaining that Kyocera did not contest its adversary's proposed POSITA definition).

204. *See, e.g.*, Siuta, *supra* note 9 (attributing the *Kyocera* outcome to Kyocera not challenging its adversary's definition of POSITA, and not acknowledging any potential complications from the ruling).

205. *See* Allison & Lemley, *supra* note 85, at 3 (explaining how technology and patents have increased in complexity since the 1970s).

206. *Id.*; Dennis Crouch, *Teams of Inventors: Trends in Patenting*, PATENTLYO (Jan. 30, 2019), https://patentlyo.com/patent/2019/01/inventors-trends-patenting.html [https://perma.cc/S9PP-7M2E].

207. Crouch, *supra* note 206. *But cf.* Eric S. Hintz, *The Persistence of American Independent Inventors*, SMITHSONIAN NAT'L MUSEUM OF AM. HIST. (Aug. 17, 2021), https://invention.si.edu/persistence-american-independent-inventors [https://perma.cc/9WU7-YELQ] ("[T]he individual genius—in the garret, in the garage, and in the dorm room—has long been, and will always remain, an important source of new technologies.").

208. Crouch, *supra* note 206.

209. Richard Van Noorden, *Interdisciplinary Research by the Numbers*, 525 NATURE J. 306, 306 (2015).

210. Crouch, *supra* note 206.

211. *See* Luke Tregilgas, *Multidisciplinary Approaches – The Rise of Multidisciplinary Inventions*, MURGITROYD: BLOG (May 6, 2021), https://www.murgitroyd.com/ga/blog/multidisciplinary-approaches/ [https://perma.cc/J2VZ-FBG9] (describing the rise of multidisciplinary inventions, which "refers to an invention requiring a technical understanding of two or more of the classical patent disciplines: life sciences (biology, biochemistry and pharmaceuticals); chemistry; digital technologies, physics and electronics; and mechanical engineering"); Michal Shur-Ofry, *Connect the Dots: Patents and Interdisciplinarity*, 51 U. MICH. J.L. REFORM 55, 74 (2017) ("[W]ith the advance of sophisticated search technologies, some courts seem to suggest that modern PHOSITAs are expected to be familiar with a broader scope, possibly even the entire universe, of prior art."); *id.* at 74 n.93 ("[T]he definition of the PHOSITA should take into account that the development of a patent is 'a multidisciplinary process.'") (quoting Schering Corp. v. Apotex Inc., No. CV-09–6373, 2012 WL 2263292, at *15 (D.N.J. June 15, 2012)); Pablo E. Pinto et al., *Exploring the Topology and Dynamic Growth Properties of Co-invention Networks and Technology Fields*, 16 PLOS ONE, Sept. 2, 2021, at 3 ("The examination of inventor networks over time reveals the increased complexity of all technology sectors . . . . [W]e find evidence that inventors tend to diversify into new fields that are less mature.").

POSITA is a hypothetical construct that can encapsulate all the knowledge of all the inventors, but there is no requirement that this hypothetical construct reflect realistic education and experience levels that an expert witness could obtain.[212]

There are already real-world examples of patent challenges that require a particularly complex POSITA.[213] For example, in *Best Medical*, a patented invention required a POSITA that understood "how radiation treatment works and its impact on tumor growth" in addition to "computer programming to implement the particular algorithms."[214] In the underlying PTAB case, when an expert witness was proffered that had substantial experience in radiation treatment, but minimal experience with computer programming, the Board considered all of the expert witness's testimony *admissible* but "highly discounted his testimony regarding obviousness of the computer programming aspects of the invention."[215] Thus the PTAB *admitted* the testimony, but considered the expert's background to go toward the *weight* of that evidence. If the Board was forced to apply *Kyocera* to this testimony, it would deem this testimony inadmissible because the expert failed to meet the high bar of POSITA with respect to computer programming—notwithstanding the beneficial aspects such testimony could provide concerning radiation treatment.

The Federal Circuit affirmed the PTAB's finding that the expert's testimony was admissible in *Best Medical* by considering that "the level of skill in the art is a question of fact" that the Federal Circuit "review[s] for substantial evidence."[216] Without the expert witness being qualified as a POSITA with respect to computer programming, the Federal Circuit nonetheless conceded that the PTAB could consider the expert's testimony.[217]

Due to the highly complex nature of interdisciplinary patents having numerous inventors, and because the POSITA is a legal fiction, it is possible to have constructions of a POSITA that are absurd, and it would correspondingly be absurd to argue that an expert witness necessarily must possess all the skills of the POSITA in order to provide admissible testimony.[218] For example, in *Cephalon*, the parties agreed that "POSITA would have had the skills, education, and expertise of *a team of individuals* working together" and that the team would include: (i) individuals with a PhD in a science related to pharmaceuticals (or commensurate work experience), (ii) familiarity with liquid injectable drug formulations; (iii) a team member with "expertise in analytical chemistry;" and (iv) "access to an individual with a medical degree with experience in treating

212. *See*, Haars, *supra* note 9 ("An expert that has extensive education and general industry experience may still not be an ordinarily skilled artisan if the level of ordinary skill in the art is crafted narrowly enough.").

213. *See, e.g.*, Cephalon, Inc. v. Slayback Pharma LLC, 456 F. Supp. 3d 594, 603 (D. Del. 2020) ("The parties agree that a POSITA would have had the skills, education, and expertise of a team of individuals working together to formulate a liquid injectable drug product.").

214. Crouch, *supra* note 17 (citing Best Med. Int'l, Inc. v. Elekta Inc., 46 F.4th 1346 (Fed. Cir. 2022)).

215. *Id.*; Varian Med. Sys., Inc. v. Best Med. Int'l, Inc., No. IPR2020-00071, 2021 WL 1599184, at *7 (P.T.A.B. Apr. 23, 2021).

216. *Best Med. Int'l, Inc.*, 46 F.4th at 1353.

217. *Id*. at 1354.

218. *See* Shur-Ofry, *supra* note 211, at 74 (explaining that a POSITA, who may be the product of a multi-disciplinary invention process, may be expected to be familiar with the entire universe of prior art).

patients" with the relevant disease.[219] *Cephalon* is not alone in requiring that the hypothetical POSITA construct be representative of a team of skilled individuals.[220] If the court were to apply the *Kyocera* standard here—requiring that the individual expert witness must be a POSITA, which in turn comprises multiple persons with expertise in different fields of study—it would be near-impossible to find a qualified witness to explain the technology to the factfinder.[221]

In previous instances where a POSITA was complex and defined to be a team, it was understood that multiple expert witnesses could be used, each opining to their relevant field of study.[222] This makes sense. Each expert can testify to their corresponding expertise and the court can correspondingly weigh that testimony, minimizing consideration if the expert strays outside of their field.[223] But that's not what *Kyocera* prescribes. Reading *Kyocera* strictly, not one of the experts would individually, by themselves, qualify as a POSITA, thus none of their testimony would be deemed admissible.[224]

The complexity of applying *Kyocera* is further exacerbated when one recognizes that the defined POSITA is centered at a specific timepoint.[225] By strictly requiring that an expert witness be a POSITA, this could exclude beneficial testimony to the factfinder and render finding a relevant expert even more difficult. For example, in *Flex-Rest v. Steelcase*, the court evaluated whether an expert was a POSITA "at the time of the invention," and finding that the expert was not, that expert's testimony was excluded.[226]

Allow this to be taken to an extreme: since utility patents remain in effect for 20 years following the filing date (and can be sued on for an additional number of years), it is not unlikely that a case will be litigated 18 years after it had been filed.[227] What if a proposed expert witness would have been qualified as a POSITA a day *after* the filing of the invention, but did not meet the qualifications on the date in question (e.g., if they finished their Ph.D. the

219. Cephalon, Inc. v. Slayback Pharma LLC, 456 F. Supp. 3d 594, 603 (D. Del. 2020) (emphasis added).

220. *See, e.g.*, Pfizer, Inc. v. Teva Pharms. USA, Inc., 803 F. Supp. 2d 409, 442 (E.D. Va. 2011) ("The consensus was that a POSITA would have knowledge and skill in several scientific disciplines and would comprise a team of scientists with Ph.D.s or M.D.s with knowledge of medicinal chemistry, pharmacology, and urology.").

221. *Compare* Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022) ("To offer expert testimony from the perspective of a skilled artisan in a patent case—like for claim construction, validity, or infringement—a witness must at least have ordinary skill in the art."), *with Cephalon*, 456 F. Supp. 3d at 603 ("The parties agree that a POSITA would have had the skills, education, and expertise of a team of individuals working together to formulate a liquid injectable drug product.").

222. *See, e.g.*, *Pfizer*, 803 F. Supp. 2d at 415 n.11, 444 n.80, 447 n.85 (discussing the testimony of distinct experts in medicinal chemistry, urology, pharmacology and enzymology, and economics of the pharmaceutical industry).

223. *See id.* (discussing the testimonies offered by various experts and affording them proper consideration based on their areas of expertise).

224. *Compare Kyocera*, 22 F.4th at 1376–77 (requiring an expert "witness must at least have ordinary skill in the art"), *with Pfizer*, 803 F. Supp. 2d at 415 n.11, 444 n.80, 447 n.85 (offering testimony from various individual expert witnesses based on their areas of expertise).

225. *See* Flex-Rest, LLC v. Steelcase, Inc., 455 F.3d 1351, 1360 (Fed. Cir. 2006) (holding a district court did not abuse its discretion when it determined an offered expert witness "was not one of ordinary skill in the art at the time of the invention").

226. *Id.*

227. 35 U.S.C. § 154 (a)(2); *id.* § 286.

following day)? Applying *Kyocera* strictly, that expert's testimony would be inadmissible. Such is the absurdity of *Kyocera* when pushed to its extremes—which will occur more frequently as patent complexity increases.[228] This example serves to illustrate why the advisory notes on Federal Rule of Evidence 702 are so important[229]—the purpose of this testimony is to assist the factfinder. Judges already have other means to remove unhelpful expert witness testimony without requiring that experts be a POSITA as a threshold matter.[230]

Given the numerous complications that will arise with the strict application of *Kyocera*, it is likely that courts will simply ignore its holding in complicated cases, or otherwise craft new adaptations of POSITA to wedge experts into the defined role.[231] Yet, this simply increases the burdens on courts to decide whether testimony is admissible and makes it more difficult for parties to identify experts that can assist the factfinder in understanding the technology at issue. Some judges are already dismissing or altogether ignoring *Kyocera*,[232] but there may be other means of addressing the Federal Circuit's decision.

IV. REINING IN *KYOCERA*

If *Kyocera* is to be applied both broadly and strictly, it has dire implications in future cases, especially as patents become more technologically complex. Its holding should be reined in to balance the concerns of the Federal Circuit with the realistic applications of experts qualifying as POSITAs, while also considering the benefits expert witness testimony is intended to provide under Federal Rule of Evidence 702.[233] While it may be most beneficial to read *Kyocera* narrowly so that its holding does not negatively impact a wide swathe of cases, its holding should at least be relegated to Article III courts, allowing administrative agencies to continue applying their broader understanding of Rule 702. Alternatively, either Congress or the Supreme Court should provide clarity as to what qualifications are required for an expert witness to testify in patent litigation.

Federal Rule of Evidence 702 provides the foundation for what evidence is deemed admissible, including whether expert witness testimony is admissible in a given case.[234] Rule 702 is intended to continue "the venerable practice of using

228. *See* Allison & Lemley, *supra* note 85, at 3 ("By almost any measure—subject matter, time spent in prosecution, number of prior art references cited, number of claims, number of continuation applications filed, number of inventors—the patents issued in the late 1990s are more complex than those issued in the 1970s.").

229. FED. R. EVID. 702 advisory committee's note to 2000 amendment ("The amendment does not alter the venerable practice of using expert testimony to educate the factfinder on general principles.").

230. *Supra* Section II.A.2.

231. *See supra* notes 200–02 and accompanying text (explaining the complications of applying *Kyocera* and how courts may choose to ignore *Kyocera*).

232. *See supra* Section II.C.1 (explaining how PTAB judges are moving forward with their own standards for expert witness admissibility and are effectively disregarding *Kyocera*).

233. See *supra* Section III (explaining the complications of applying *Kyocera*, including the difficulty in finding a POSITA for complicated patents); FED. R. EVID. 702 advisory committee's note to 2000 amendment (explaining the purpose of an expert witness is to aid the fact finder).

234. FED. R. EVID. 702; *see also supra* Section II.B (describing the foundational underpinning of Rule 702).

expert testimony to educate the factfinder on general principles."[235] There is nothing in the Federal Rules of Evidence requiring expert witness testimony be from a person qualified as a POSITA; there is a broader consideration in the Federal Rules of Evidence: ensuring the factfinder understands the subject matter at issue.[236]

Insofar as Federal Rule of Evidence 702 is in conflict with *Kyocera*, the Federal Rule of Evidence ought to be supreme.[237] Since the Federal Rules of Evidence were adopted following an order directly from the Supreme Court, a Federal Circuit interpretation of what qualifies as admissible evidence should not supersede those rules.[238] Because Federal Rule of Evidence 702 seems to suggest that qualifications of expert testimony goes to the *weight* of such evidence, rather than its admissibility, this is the understanding that should be embraced by courts more generally.[239]

Even if *Kyocera* is interpreted to not conflict directly with Rule 702, it is clear that its holding does conflict with past practice in administrative adjudication.[240] These administrative courts have long recognized that qualifications of an expert witness will go to the weight of the evidence rather than requiring a threshold to be met for admissibility.[241] The USPTO goes further to explicitly state that in its proceedings, expert witness testimony need not come from a POSITA.[242] Since factfinding in administrative adjudication is conducted by the administrative judges themselves (as opposed to lay jurors), there is a significantly decreased risk that the factfinder will be confounded by misleading testimony.[243] Thus, the administrative judge ought to have the authority to consider expert witness testimony regardless of whether they are a POSITA and weigh said testimony accordingly. Judges already have discretion to refuse admission of expert witness testimony if it is unlikely to be helpful to the factfinder.[244] If expert testimony will be helpful to the factfinder, its

235. FED. R. EVID. 702 advisory committee's note to 2000 amendment.

236. *Id.* ("Rule 702 simply requires that: (1) the expert be qualified; (2) the testimony address a subject matter on which the factfinder can be assisted by an expert; (3) the testimony be reliable; and (4) the testimony 'fit' the facts of the case.").

237. *See* 28 USC § 2072 ("The Supreme Court shall have the power to prescribe general rules of practice and procedure and rules of evidence for cases in the United States district courts (including proceedings before magistrate judges thereof) and courts of appeals. . . . All laws in conflict with such rules shall be of no further force or effect after such rules have taken effect.").

238. FED. R. EVID. historical note ("The Federal Rules of Evidence were adopted by order of the Supreme Court on Nov. 20, 1972, transmitted to Congress by the Chief Justice on Feb. 5, 1973, and to have become effective on July 1, 1973."); 28 USC § 2072.

239. *See* FED. R. EVID. 702 ("A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion.").

240. *See supra* Section II.C (discussing how administrative agencies have evaluated whether expert witness testimony is admissible, which includes relying on the Federal Rules of Evidence and the fact that administrative judges commonly have technological backgrounds).

241. *Id*.

242. *Supra* Section II.C.1.

243. Certain Mobile Devices with Multifunction Emulators, Inv. No. 337-TA-1170, 2020 ITC LEXIS 587, at *4 (2020) ("In general, the harm from expert testimony that does not assist the trier of fact . . . is greatly diminished in the absence of a jury.").

244. *See supra* Subsection II.A.2 (assessing modern judicial discretion in the admissibility of expert witness testimony).

admission as evidence should not be prohibited simply because the expert does not meet a threshold definition of a POSITA.[245]

Alternatively, Congress can more clearly lay the boundaries of what qualifies as expert witness testimony in patent litigation.[246] Much of the understanding of what type of restrictions surround expert witness testimony come from common law.[247] If Congress provides a clearer definition, it will increase efficiency of patent litigation (since this element will no longer go through the adversarial process) and will also expand the number of potential witnesses available to parties.[248] Alternatively, the Supreme Court could step in and either update the Federal Rules of Evidence to more clearly spell out what, if any, qualifications are mandatory for an expert witness to testify from the perspective of a person of skill, or otherwise consider the *Kyocera* holding to establish a clearer picture of whether the witness must actually be a POSITA.[249]

Finally, while district courts may be required to apply *Kyocera* to any evaluation of whether an expert witness is qualified to provide expert witness testimony, administrative agencies are not inherently bound to apply the Federal Rules of Evidence.[250] As described further above, the USPTO adopted a modified understanding of the Federal Rules of Evidence into its PTAB practice.[251] Thus, if no other outlet is made available, agencies could individually alter their evidentiary practice to better comport with their desired application of expert witness testimony rather than be beholden to the Federal Circuit's *Kyocera* decision. This would, however, raise complications where, e.g., similar (or even identical) patents are litigated in both district court and administrative agencies such as the PTAB.[252] Additionally, any alterations to the rules would require a prolonged and complicated administrative informal hybrid rulemaking process.[253] Therefore, while administrative agencies may have their own arguable way out from *Kyocera*, applying it would be complicated and require agency-by-agency rulemaking. A broader judicial or congressional fix to the applications of the Federal Rules of Evidence, with respect to expert witness testimony, would be a more straightforward correction.

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245. *See id*. (assessing courts' ability to properly gatekeep expert witness testimony in the absence of a POSITA standard).

246. *See* Hanna v. Plumer, 380 U.S. 460, 472 (1965) ("[T]he constitutional provision for a federal court system (augmented by the Necessary and Proper Clause) carries with it congressional power to make rules governing the practice and pleading in those courts.").

247. *See supra* Section II.A (discussing the evolution of caselaw on the admissibility of expert witness testimony).

248. *See supra* Section III (discussing the complications that arise from the post-*Kyocera* landscape, including the difficulty in obtaining expert witnesses that qualify as a POSITA).

249. 28 USC § 2072 ("The Supreme Court shall have the power to prescribe general rules of practice and procedure and rules of evidence for cases in the United States district courts (including proceedings before magistrate judges thereof) and courts of appeals.").

250. Richard J. Pierce, Jr., *Use of the Federal Rules of Evidence in Federal Agency Adjudications*, 39 ADMIN. L. REV. 1, 2–4 (1987).

251. *Supra* Section II.C.1.

252. *See id.* (discussing the procedures adopted by the PTAB and how they differ from typical district court procedures).

253. *See* LAWSON, *supra* note 25, at 400–511 (describing the complex informal rulemaking process in administrative law).

CONCLUSION

Patent litigation frequently employs expert witness testimony to describe elements from the perspective of a person having technical background in the issue at hand.[254] This testimony is beneficial to the factfinder to ensure they understand complex technology and can make a reasoned decision.[255] While substantial past practice and precedent has not required that expert witnesses be POSITAs in order to provide their testimony, the recent case of *Kyocera* has held otherwise—arguably conflicting with Federal Rule of Evidence 702.[256] Because a strict adherence to this holding may lead to absurd results in complex patent litigation, it would be unsurprising if administrative adjudication simply ignored the Federal Circuit's *Kyocera* holding and instead continued to apply their own understanding of Rule 702. It would be advantageous if additional clarity could be provided as to whether *Kyocera* should be applied both broadly and strictly, or if administrative agencies have a more proper understanding of what qualifies as admissible expert witness testimony under Rule 702. For efficiency purposes, the best reading of *Kyocera* is a narrow one, leaving administrative agencies wide berth to continue their practice of allowing admission of expert witness testimony, even in cases where the expert witness is not a POSITA.

254. *See supra* Section I (discussing the fundamental purpose and benefits of expert witnesses in patent cases).

255. *Id.*

256. *Supra* Section II.A.4.