

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARCTIC CAT, INC.,
Petitioner,

v.

POLARIS INDUSTRIES INC.,
Patent Owner.

Case IPR2017-00433
Patent 9,217,501 B2

Before KARL D. EASTHOM and PHILLIP J. KAUFFMAN,
MICHAEL W. KIM *Administrative Patent Judges.*

KAUFFMAN, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding

37 C.F.R. § 42.5

Introduction

We authorized Patent Owner to file a Motion for Live Testimony (“Motion”) of their expert, Dr. Bower, at oral argument. Paper 68. The day the Motion was due, Patent Owner requested via email that the Motion be authorized to include a request that two of Petitioner’s fact witnesses (Mr. Schoenecker and Mr. Spindler) appear at the oral hearing, alternatively, Patent Owner requested authorization for a motion seeking the live testimony of the two additional witnesses. *See* Ex. 3003 (email). The panel did not act on the email request prior to the filing deadline later that day, and Patent Owner submitted that Motion with a footnote mentioning the request for the additional two witnesses. Paper 78. The panel denied the request for authorization of a motion regarding the two additional witnesses because the request should have been made sooner, and because there was not sufficient time to permit such briefing. Paper 83.

In the Motion, Patent Owner argues that live testimony is warranted because the expert witnesses for each party disagree regarding the obviousness of claims 1–9, and because in previous related cases between the parties, the Board credited or discredited one expert’s testimony over another. Paper 78, 4–5.

Petitioner opposes Patent Owner’s Motion. Paper 82.

Standard

Board rules are “construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *See* 37 C.F.R. § 42.1. The Office Patent Trial Practice Guide states that “[t]he Board does not envision that live testimony is necessary at oral argument,” and states that the Board

“[o]ccasionally” will require live testimony “where the Board considers the demeanor of a witness critical to assessing credibility.” 77 Fed. Reg. 48756, 48,768 (August 14, 2012), 48,762; *see also* 37 C.F.R. § 42.53(a) (authorizing live testimony). The Guide provides examples of where such testimony has been ordered as: “cases where derivation is an issue, where misconduct is alleged to have occurred during the proceeding, or where testimony is given through an interpreter.” 77 Fed. Reg. at 48,762.

Our rules explicitly permit a party to request presenting live testimony at oral argument. *See* 37 C.F.R. § 42.53(a). Nevertheless, presenting live testimony at the oral argument is an imposition of time and cost on all parties, and also, the Board, which weighs against our mandate to conduct “speedy” and “inexpensive” proceedings. Of course, Board proceedings also must be “just,” and insofar as presenting live testimony at the oral argument advances that purpose, it must be weighed against our other mandates. In that respect, the examples provided in the Guide are instructive, in that we discern that all involve case dispositive issues, where observing witness demeanor is critical to assessing credibility. *See* 77 Fed. Reg. at 48,762, 48,768. We analyze Patent Owner’s request under that rubric.

The panel agrees with Petitioner’s observation that Board decisions are reflective of this guidance, in that requests have ordinarily been denied and only occasionally granted. *See* Paper 82, 2.

Analysis

In support of the Motion, Patent Owner cites three prior related cases between the parties as evidence that the Board has credited one expert over the other. *See* Paper 78, 4–5. We address these cases in turn.

In IPR2014-01427, in the analysis of independent claim 1, the Board observed that Patent Owner’s expert made conflicting observations, and did not balance a disadvantage of a proposed modification against advantages of that modification. *See* IPR2014-01427, Paper 58 at 21. The Board’s analysis of claim 1, and the remaining challenged claims, involved numerous other factors. *See id.* at 11–38.

In IPR2015-01781, the Board credited the testimony of Petitioner’s expert (Dr. Davis), and discredited the testimony of Patent Owner’s expert (Dr. Moskwa), because Dr. Moskwa interpreted a claim as requiring a low center of gravity, when the claim did not include such a requirement. IPR2017-01781, Paper 47 at 34, 35, and 39–40. The Board’s analysis of the challenged claims involved numerous other factors, including secondary considerations. *See id.* at 14–62.

In IPR2015-01783, in the analysis of independent claim 60, the Board credited the testimony of Petitioner’s expert (Dr. Davis). IPR2015-01783, Paper 49 at 34. The Board’s analysis of the challenged claims involved numerous other factors. *See id.* at 13–46.

In light of this, although we agree with Patent Owner that the credibility of each expert was a factor in the prior related cases, such credibility was only one of numerous factors in each case, and Patent Owner has not shown persuasively that such credibility was case dispositive. Further, our review of the record of those proceedings indicates that the

credibility of each expert was based on the plausibility of various aspects or portions of their theories, which, in turn, were based on analysis and evidence presented by those experts on paper, and not on demeanor. This suggests that, in those cases, live testimony would not have been more useful to the Board than a review of the paper record, informed by presentation made by counsel at oral argument.

In the case at hand, Petitioner asserts that Patent Owner's expert, Dr. Bower, made some concessions that amount to inconsistent testimony. *See* Paper 78, 5 (citing Paper 47, 7, 11, 14). Patent Owner implies that the Board observing live testimony from Dr. Bower, at oral argument, will assist the Board, as the fact finder, in assessing credibility with respect to that inconsistent testimony. When we perform our weighing in view of the above guidance, however, we are unpersuaded that Patent Owner has sufficiently made its case. While certainly Dr. Bower's credibility is at issue, upon reviewing Dr. Bower's testimony, we are unpersuaded that Patent Owner has shown sufficiently that the credibility determination at issue here, deals with anything other than the standard assessment of the plausibility of the witness's theories, as opposed to the witness's demeanor. Further, Patent Owner has not shown sufficiently that the credibility of Dr. Bower is a case dispositive issue. There are numerous other disputes in this case, such as Patent Owner's assertion that Petitioner copied the claimed subject matter, an issue that will require a weighing of many factors in the aggregate. *See* Paper 33, 43–58.

As other support for the Motion, Patent Owner asserts that Petitioner's expert (Dr. Davis) did not describe something clearly, refused to concede a point, and refused to answer a repeated question. *See* Paper 78 (citing Paper

62 ¶¶ 23–25). We have reviewed the testimony cited by Patent Owner. In that testimony, Petitioner’s expert disagreed with the points Patent Owner’s counsel was trying to make. This appears to be routine cross-examination, and we are unpersuaded that Patent Owner has identified anything about that cross-examination, for example, something out of the ordinary, that would warrant live testimony. More importantly, Patent Owner has not explained persuasively how these assertions regarding Petitioner’s expert justify deviating from the standard Board practice, in view of the guidance set forth above.

As support for the Motion, Patent Owner cites *K-40 Electronics, LLC v. Escort, Inc.*, Case IPR2013-00203 (PTAB, May 21, 2014) (Paper 34). Paper 78, 1. *K-40* is distinguishable in that it involved the live testimony of a fact witness (the named inventor) while, here, the witness at issue, Dr. Bower, is an expert witness. *See id.* at 2. As the Board observed in *K-40*, the credibility of experts often turns less on demeanor and more on the plausibility of their theories. *Id.* at 3. As detailed above, such is also the case here. Further, in *K-40* the witness’s testimony was regarding antedating two references, a dispositive issue in that case. *Id.* Here in contrast, as detailed above, Dr. Bower’s testimony is not regarding a dispositive issue.

Conclusion

We agree with Petitioner that it is often the case that the experts for each party disagree on the obviousness of the challenged claims and Patent Owner has not provided a persuasive reason why the case at hand is different. *See* Paper 82, 2 (asserting “Polaris fails to identify any reasoned

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basis that this case sands out from the rest and requires the presentation of live expert testimony.”).

Consequently, Patent Owner has not persuaded us that the Motion should be granted. *See* 37 CFR § 42.20(c).

ORDER

Patent Owner’s Motion for the Live Testimony of Dr. Bower is *denied*.

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