

## 7 Ways Patent Litigators Can Leverage Inventor Testimony

By **Jeremy Edwards** (January 11, 2022, 5:02 PM EST)

Patent litigation can be a game of inches, and skilled litigators know where to mine for persuasive evidence.

One potentially powerful source of evidence is the testimony of a named inventor of an asserted patent. This is no secret, and experienced patent litigators should always look for ways to harness inventor testimony to further their clients' interests.

This article explores some of the ways that inventor testimony can be used to persuade the fact-finder in close cases and even to uncover game-changing evidence.



Jeremy Edwards

### Supporting a Written Description Defense

Recent decisions demonstrate that inventor testimony can be especially important in the context of defenses based on the written description requirement of Title 35 of the U.S. Code, Section 112. In the November *Biogen International GmbH v. Mylan Pharmaceuticals Inc.* decision, for example, the U.S. Court of Appeals for the Federal Circuit reminded us how inventor testimony can drive home a written description defense.

In *Biogen*, the U.S. District Court for the Northern District of West Virginia invalidated claims as lacking written description, and the Federal Circuit affirmed.[1] The claims were directed to a method of treating multiple sclerosis by administering a certain dose of a certain drug — dimethyl fumarate, or DMF.[2]

*Biogen* argued that disclosures in the application could be cobbled together to provide written description support for the claimed method.[3] At trial, however, the inventor testified that his work was focused on discovery of compounds and not on dosing of DMF.[4] He further testified that his work had "nothing to do with the efficacy of DMF in clinical disease and would not be helpful in identifying a therapeutically effective amount of DMF." [5]

In invalidating the claims for lack of written description support, the district court relied on that inventor testimony as evidence that the disclosures in the patent could not be cobbled together as urged by the patentee.[6] The district court even noted that ignoring the credible testimony of the inventor "would be unreasonable." [7] The Federal Circuit affirmed, citing that same inventor testimony.[8]

Similarly, in the 2020 *Noven Pharmaceuticals Inc. v. Amneal Pharmaceuticals LLC* decision, the U.S. District Court for the District of Delaware relied on inventor testimony to corroborate its conclusions that the claims were invalid for lack of written description.[9]

The claims at issue encompassed both transdermal and transmucosal drug delivery systems.[10] The inventor testified, however, that his invention was not intended for application to mucosal tissue and was never tested on any mucosal tissue.[11]

Inventor testimony can be especially persuasive in the context of a written description defense because the legal standard requires describing "possession." And as aptly put by the District of Delaware in the 2010 *Boston Scientific Corp. v. Johnson & Johnson Inc.* decision, "Logically, the inventors could not have described a knowledge that they did not possess." [12]

To be sure, in both *Biogen* and *Noven*, inventor testimony was not the centerpiece of the written description analysis. Each court properly focused on the disclosures in the patents. But the inventor testimony was a significant factor leading to invalidation of the claims.

The take-home for the accused infringer? Even if you have an otherwise strong written description defense, still you should explore whether the inventors did work directed to the subject matter that you contend is not sufficiently described. If they did not, then get that into evidence.

And for the patentee fending off this attack? If your inventors will be deposed, prepare them to articulate specific connections between the work they did and the disputed subject matter. Written description is often primarily a battle of the experts, but inventor testimony may just tip the scales one way or the other.

### **Supporting or Combating an Indefiniteness Defense**

Patent litigators can also harness inventor testimony to support or fend off an indefiniteness defense. The touchstone of indefiniteness is whether the patent conveys the scope of the claimed invention with reasonable certainty.[13] It matters what the patent would convey to a person of ordinary skill in the art, or POSITA, as of the priority date. Since an inventor necessarily had at least ordinary skill in the art at that time, his or her testimony can be persuasive.

One theory of indefiniteness relies on measurement uncertainty, where the claims require a measurable parameter to have a certain value or range of values, but whether an accused instrumentality has such a value depends on how it is measured.

The 2014 *Ethicon Endo-Surgery Inc. v. Covidien Inc.* decision in the U.S. District Court for the Southern District of Ohio is a good example of how inventor testimony can be critical to proving indefiniteness due to measurement uncertainty.[14]

In *Ethicon*, the inventors testified that there were multiple acceptable ways to measure the claimed parameter, the values obtained from measurement could vary depending on which method was used, and the values could even vary depending on which technique was used within a given method.[15] The court found the claims invalid, relying heavily on this inventor testimony.

For the accused infringer pursuing such an indefiniteness theory, counsel should consider establishing all

techniques, methods and variables the inventors used to measure the claimed parameter. Counsel should also explore whether the inventors were aware at the time of any alternative measurement methods, and any examples of how measured values fall inside or outside the claim, depending on the test method employed.

For the patentee expecting to be confronted with such issues, counsel should determine a strategy for preparing the inventor for deposition. If, for example, the inventor does not recall much about the measurement methods at issue, it may be best to let him or her testify to that effect.

But if the inventor has something helpful to say, for example that he or she did not regard other measurement methods as standard or accurate at the time, then counsel may want to make sure the inventor is prepared to testify to this effect.

### **Antedating or Disqualifying Alleged Prior Art**

When a patentee is confronted with alleged Section 102(a) prior art, inventor testimony can be used to "swear behind" or antedate the art. To do so, the inventors must show that they conceived of the invention before the date of the art and thereafter diligently worked to reduce the invention to practice. Such testimony must be corroborated in some fashion.[16]

Similarly, when a patentee is confronted with alleged Section 102(e) prior art, inventor testimony can be used to establish that the art was the work of a common inventive entity, i.e., not the work of another, and is therefore not prior art. Such testimony must also be corroborated.[17]

Because the corroboration requirement is often rigorously applied, antedating or disqualifying prior art is not a walk in the park. Patentees and their counsel may have to invest significantly to find corroboration in the documentary record. But if the anticipation or obviousness theory at play can be eviscerated through antedating or disqualifying asserted art, the payoff can be worth it.

### **Supporting or Undermining an Obviousness Defense**

Often, an expert witness will testify as to how a POSITA would have approached some scientific or technical task, but the proposition is so general or mundane that it is challenging to find prior art literature supporting or refuting it. This may arise, for example, in obviousness battles, in which experts try to synthesize the prior art into a coherent story about the motivations, behaviors and expectations of a POSITA.

Patent litigators should not overlook that inventor testimony can be persuasive in such circumstances. Indeed, the inventor's own motivations, behaviors and expectations can be used to support or undermine the expert testimony, because the inventor was necessarily at least a POSITA at the time of the invention.

Counsel advancing an obviousness defense knows that under the patent statute, "[p]atentability shall not be negated by the manner in which the invention was made." [18] And usually, the inventor is a fact witness who has not submitted an expert report and, thus, cannot provide expert opinion testimony. But a skillful, prepared advocate can thread this needle to elicit persuasive inventor testimony.

For example, let's say the experts disagree as to whether a POSITA would have been motivated to select

a certain ingredient in developing a new pharmaceutical formulation. The inventor's testimony may be persuasive in one direction or the other. If the inventor testifies that he or she only used the ingredient because he or she had it handy at the time in the lab, this serendipity may support nonobviousness.

But if the inventor instead testifies that he or she chose that ingredient because he or she and his or her colleagues always looked first to that ingredient because it was de rigueur, this may support obviousness.

Further, inventor testimony can be used as evidence regarding secondary considerations of nonobviousness, such as unexpected results and skepticism. Counsel for the patentee should consider exploring whether the inventor recalls anyone, themselves included, exhibiting skepticism about their work, or surprise at the outcome.

Counsel for the accused infringer should consider exploring these same issues in deposition of the inventors. They may be able to probe and undermine such testimony on the spot. In any event, simply knowing that the inventor might testify to that effect at trial is beneficial. Counsel can then disclose it to their obviousness experts to avoid having them later painted as failing to consider relevant evidence.

### **Telling and Countering the Invention Story**

Telling the story of the invention is perhaps the most conventional use of inventor testimony, and for good reason.

For the patent owner, such testimony can be very persuasive, especially before a jury, and especially if the inventor is genuinely proud of the invention and has a personal story about how he or she developed it. A human story of struggle, serendipity, or surprise can be a powerful counterpunch to an invalidity challenge.[19]

Counsel for patentees should explore whether such testimony is available from a credible inventor.

On the other hand, counsel for the accused infringer should consider ways to reduce the impact of such inventor testimony. For example, if asserting defenses characterizing the claims as overbroad — such as obviousness, written description, or enablement — counsel may try to show that the inventor had no role in crafting the overbroad patent claims, so that the invalidity attack is not aimed so much at the likable scientist, but instead at countering the work of overzealous patent attorneys.

Further, with respect to obviousness, counsel may try to show that the inventor's pride is understandable but ultimately uninformed, because the inventor was not aware of key aspects of the prior art. After all, obviousness is measured from the perspective of a hypothetical POSITA, who, unlike most real-life inventors, is presumed to be aware of all the prior art.[20]

### **Identifying Contributions by Noninventors and Identifying Unnamed Inventors**

Inventors might testify that certain aspects of the claimed invention were conceived or suggested by someone who is not a named inventor. This can set up an argument that those aspects of the claimed invention were obvious, explaining why the person who contributed them was not named as an inventor.[21]

While this is not necessarily a core principle of obviousness, it is a creative angle that counsel for an

accused infringer could explore through inventor testimony.

Relatedly, in rare cases, there could be a more dramatic upshot of identifying inventive contributions of an unnamed inventor. Counsel for accused infringer should explore whether there exists an unnamed inventor with an unassigned inventorship interest. If so, and other circumstances align, the accused infringer can purchase that unassigned interest, thereby negating allegations of infringement.[22]

Counsel for the patentee, on the other hand, should investigate and resolve any inventorship issues as part of their presuit diligence.

### **Uncovering, Proving or Countering Allegations of Inequitable Conduct**

Inventor testimony can be central to uncovering, proving or countering allegations of inequitable conduct. This is a highly fact-intensive inquiry.

By way of example, if the inventor is the individual who allegedly engaged in inequitable conduct, counsel for patentee should consider whether that inventor can credibly testify about their approach to satisfying their duty of candor to the patent office. Credible testimony that the inventor was unaware of the alleged misrepresentation or omission can be powerful evidence against any intent to deceive.[23]

### **Summary**

The discussion above is not meant to be exhaustive, but rather to illustrate some of the opportunities available to the patent litigator to explore, harness and counter the persuasive power of inventor testimony.

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*Jeremy J. Edwards is a founding partner at Maddox Edwards PLLC.*

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[1] Biogen Int'l. GMBH v. Mylan Pharmaceuticals Inc., No. 17-cv-116, 2020 WL 3317105 (N.D. W.Va June 18, 2020), aff'd at 18 F.4th 1333 (Fed. Cir. 2021).

[2] Biogen, 18 F.4th at 1337.

[3] Biogen, 2020 WL 3317105 at \*9-12.

[4] Id. at \*12.

[5] Id. (cleaned up).

[6] Id.

[7] *Id.* at \*12, n. 18.

[8] *Biogen*, 18 F.4th at 1337.

[9] *Noven Pharms., Inc. v. Amneal Pharms. LLC*, No. 18-cv-699-LPS, 2020 WL 11191445 (D. Del. Sep. 4, 2020).

[10] *Id.* at \*12.

[11] *Id.*

[12] *Boston Sci. Corp. v. Johnson & Johnson Inc.*, 679 F. Supp. 2d 539, 555 (D. Del. 2010).

[13] *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014).

[14] *Endo-Surgery v. Covidien, Inc.*, No. 11-871, 2014 WL 10212909 (S.D. Ohio Jan. 22, 2014).

[15] *Id.* at \*23-26.

[16] See, e.g., *ATI Techs. ULC v. Iancu*, 920 F.3d 1362 (Fed. Cir. 2019).

[17] *Duncan Parking Techs., Inc. v. IPS Grp., Inc.*, 914 F.3d 1347 (Fed. Cir. 2019).

[18] 35 U.S.C. §103.

[19] See, e.g., *Regents of the Univ. of Cal. v. Broad Inst. Inc.*, 903 F.3d 1286 (Fed. Cir. 2018) (relying on statements by inventors about challenging nature of their work).

[20] *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985).

[21] See, e.g., *Hess v. Advanced Cardiovascular systems, Inc.*, 106 F.3d 976 (Fed. Cir. 1997).

[22] 35 U.S.C. § 262; *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456 (Fed. Cir. 1998).

[23] See, e.g. *Osram Sylvania, Inc. v. American induction Techs., Inc.*, No. 09-8748, 2011 WL 5143630 at \*3-4 (C.D. Cal. Oct. 28, 2011).