

Patent Owner Tip #5 for Surviving An Instituted IPR: The Right Expert Can Save Your Patent

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The right expert can be the critical piece that saves the validity of your patent. Finding the right expert for a patent owner requires careful selection and due diligence. We [previously detailed](#) how your expert's testimony can make or break your Patent Owner's Response ("POR"). The following details what actions and considerations Patent Owners should take to locate and identify the best experts for testifying to the Board, which can be different considerations than those for other proceedings.

Pick an Expert Who Has Personal Knowledge of the Challenges in the Art at the Time of the Patent

In an IPR proceeding, the Board does not get the chance to evaluate the credibility of an expert based on live testimony. Instead, the Board relies on the written record, including a written declaration and deposition transcript. See *e.g.*, 37 CFR § 42.53. As a result, the single most important consideration for your expert search is whether the expert can meaningfully assure and convince the Board that the expert knows firsthand the challenges in the relevant art, and how the patented technology fits into and addresses those challenges. In other words, the Board is entitled to weigh the credibility of experts, and without the benefit of live testimony the Board must rely on expert qualifications, such as academic and technical credentials, educational/research credentials, and work experience, to determine if your expert is best suited for the claimed subject matter. See, *e.g.*, *Trs. of Columbia Univ. v. Illumina, Inc.*, 620 F. App'x 916, 922 (Fed. Cir. 2015). Unlike selecting a testifying expert for a jury trial, where characteristics such as the expert's temperament, demeanor, communication skills, ability to be convincing, and testifying experience are important, Patent Owners in an IPR proceeding should instead focus on the Board's evaluation of the potential expert's qualifications and seek to retain a highly qualified, reputable expert in the relevant industry rather than generic experts for hire.

3 Tips for Locating an Expert for in an IPR proceeding

Finding the right expert can be challenging, but there are several approaches Patent Owners can take to locate the most qualified expert for an IPR proceeding:

1. **Search Universities and Academic Scholars.** Patent Owners should contact professors and academic directors associated with the technology of the claimed subject matter at issue in order to identify relevant experts within the academic field.
2. **Hire a Search Firm.** Patent Owners should hire a search firm that specializes in locating experts with specific qualifications.
3. **Scour the Industry.** Patent Owners should contact reputable companies in the relevant industry in order to find current or former knowledgeable employees that specialize in the claimed subject matter at issue.

Patent Owners should undertake all of the above search methods in parallel to maximize the pool of qualified experts.

The right expert can be the difference between a valid and invalid patent, thus Patent Owners must select highly qualified experts of the claimed subject matter who will appear credible (on paper) to the Board. This will allow information conveyed to the Board from such experts to be well received and more influential in the Board's decision.

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