

Lessons Learned from IPR Live Testimony: An Eye-Witness Account of the Patent Trial and Appeal Board's (PTAB) Recent Witness Questioning

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This week I had the pleasure of sitting in on the first live testimony during an *Inter Partes* Review (IPR2013-00203 re **U.S. Patent No. 7,999,721** entitled **Radar Detector with Navigational Function**). **Escort Inc.**, who is the assignee of the '721 patent, moved to present live testimony before the PTAB from the sole inventor of the '721 patent, **Stephen K. Orr**. The PTAB granted Escort's motion but strictly limited Mr. Orr's oral testimony to his declaration testimony. Escort sought Mr. Orr's oral testimony before the PTAB because the petitioner, K40 Electronics, LLC., questioned Mr. Orr's credibility with respect to Mr. Orr's declaration testimony attempting to antedate (i.e., swear behind) the two prior art references asserted by the petitioner against the '721 patent. Thus, Escort wanted the PTAB to be able to fully assess the credibility of Mr. Orr as a fact witness first hand.

Before hearing the testimony of Mr. Orr, the PTAB noted that this was a unique situation and that live testimony will be unnecessary in most oral arguments. Since the PTAB is ill equipped to hear live testimony, a portable desk was placed to the right of the judge's bench for Mr. Orr. After Mr. Orr was sworn in, counsel for Escort walked Mr. Orr through various portions of his declaration testimony in an attempt to convey to the PTAB that Mr. Orr's claimed invention antedated the asserted prior art and that his story was indeed credible.

Following direct, counsel for the petitioner indicated that they did not wish to cross-examine Mr. Orr but instead requested that a 30 minute video of Mr. Orr's deposition be shown. The PTAB declined the request to show the video during the proceeding but indicated that they would watch the video at a later time.

The PTAB then went on to ask Mr. Orr a number of questions relating to how his declaration testimony addressed particular aspects of the claimed invention. Particularly, the PTAB asked Mr. Orr questions relating to how his declaration testimony shows that he indeed had possession of the claimed invention prior to the priority dates of the asserted references (e.g., the PTAB asked Mr. Orr a number of questions relating to where the claimed "position determining circuit" could be found, whether directly or indirectly, in his declaration testimony related to testing he allegedly conducted prior to the dates of the asserted references). Clearly, the PTAB was looking for some tangible evidence in the declaration testimony with respect to how the testing conducted by Mr. Orr

corroborated his story.

In effect, the PTAB sufficiently cross examined Mr. Orr without counsel for the petitioner asking Mr. Orr a single question. The PTAB clearly knew the record, identified a number of weaknesses in the patent owner's position, and focused their questioning of Mr. Orr towards these weaknesses. The questioning by the PTAB in some respects might have been more difficult for the patent owner than had the petitioner conducted the cross examination. For one, the petitioner's position, and thus the most likely line of questioning, was fully set forth and limited by the written record. In contrast, the PTAB's inquiry was seemingly unlimited by the declarant's prior testimony. Accordingly, parties of IPR proceedings wherein live testimony is indeed permitted should expect the PTAB's scope of questioning to be unrestricted by the record.

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