

## Testimony of Expert Witness: Key Patentability Arguments in Inter Partes Review

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In a final written decision, in an inter partes review (IPR), the **U.S. Patent and Trademark Office's Patent Trial and Appeal Board (PTAB)** rejected a patent owner's motion to submit new substitute claims, concluding that the patent owner had failed to show that the substitute claims were patentable over the prior art. **SATA GmbH & Co. KG v. Anest Iwata Corp.**, Case IPR2013-00111 (PTAB, May 20, 2014) (Katz, APJ).

Petitioner SATA petitioned for an IPR of claims of a patent owned by Anest Iwata. The claimed invention relates to a low-pressure atomizing spray gun with a nozzle for improved atomization of paint. Rather than filing a Patent Owner's Response, the patent owner filed a Motion to Amend requesting cancellation of the claims under review, contingent on a finding of unpatentability, and proposing new substitute claims.

In the Motion to Amend, the patent owner argued that the Decision to Institute was made in error. On this issue, the PTAB concluded that the claims were unpatentable because rebuttal testimony provided by the patent owner's witness was not definitive on whether the cited prior art failed to teach certain claim elements. In the Motion to Amend, the patent owner argued that the substitute claims were not anticipated by the prior art cited, but the patent owner did not represent to the PTAB or provide evidence that it did not know of any other anticipatory art. This omission was adequate for the PTAB to deny the Motion to Amend.

The patent owner also argued that there was no reason to address obviousness because the PTAB had declined to analyze obviousness in the Decision to Institute, relying instead on anticipating art. The PTAB explained that although it declined to consider obviousness in its Decision to Institute, that did not apply to the entire proceeding. The patent owner had argued that there was no basis in the common knowledge of those skilled in the art, the cited prior art or prior art generally to conclude that the claim features were obvious, but the PTAB stated that, without some evidence "of what one of ordinary skill in the art would have known or understood in order to make a determination of nonobviousness," such an assertion is merely lawyer argument and insufficient to establish patentability of the substitute claims.

**Practice Note:** To establish patentability (or unpatentability) of any claim in an IPR, the patent owner (or challenger) should provide evidence, e.g., expert testimony, that addresses both anticipation and

obviousness.

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