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Patentee's Expert's Testimony Regarding 40-Year-Old Reference Does Not Overcome the Reference Disclosure

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After finding that a French patent published 40 years earlier disclosed certain limitations in the claim-at-issue in the asserted patent, the U.S. Court of Appeal for the Federal Circuit reversed a district court's denial of **judgment as a matter of law (JMOL)** of invalidity, vacated its summary judgment of infringement and remanded the case for judgment for the defendant. **Krippelz v. Ford Motor Co.,** Case No. 11-1103 (Fed. Cir., Jan. 27, 2012) (Prost, J.).

Plaintiff Jacob Krippelz, Sr., sued Ford Motor for infringement of his patent directed to a downward-shining lamp attached to a car's side-view mirror used to alert other drivers of the car's presence during inclement weather. After the district court granted summary judgment of infringement for the plaintiff, the case proceeded to trial on validity. After losing on the issue before the jury, Ford filed a motion for JMOL seeking a ruling of invalidity based on the Dubois prior art, which the district court denied. The district court found that the reference did not anticipate the claim-at-issue as it failed to disclose "a conical beam of light" and a lamp "adjacent to the window" as required by the claim.

The district court reasoned that the jury's verdict was sustainable because of the "conical beam of light" limitation. The district courts analysis was based on the plaintiff's expert testimony on the Dubois prior art. The plaintiff's expert testified that based on his measurements of the angles in the DuBois lamp diagram, light from the lamp would scatter so as not to produce the conical beam of light. Further, even if it was a beam, it was not necessarily "conical" as it was impossible for a conical beam of light to illuminate a rectangle as taught by DuBois. Thus, (the plaintiff's expert contended) a conical beam of light was unlikely to be effective to accomplish Dubois' purpose. As for the lamp "adjacent to the window" limitation, the expert testified that while based on the figures in DuBois the light source "might be" adjacent, it was certainly not "clearly adjacent." The district court found the jury's verdict sustainable for this reason as well. Ford appealed.

On appeal, the Federal Circuit, after noting that a conclusory statement by an expert cannot be used to create a fact issue from the prior art, found the patent owner's expert statements as to the "conical" limitation were too conclusory to provide the substantial evidence necessary to sustain the jury verdict. His statements taken as a whole indicated that he failed to account for entire DuBois disclosure and sought to raise "teaching away" issues that had no place in an anticipation analysis. To the contrary, the Court found that DuBois disclosed a "headlight," which the Court concluded taught the necessary "beam of light." Second, the Court found that DuBois did not require that the

rectangle be lighted only with non-conical light beams. Rather, DuBois disclosed that the rectangle could be illuminated by more than one light source and many of its figures depict triangles of light which, without any indication of disavowal, were most naturally interpreted as two-dimensional depictions of light cones. Addressing the expert's statements regarding the lamp "adjacent to the window," the Federal Circuit again disagreed with patentee's expert as there was no question that a person of ordinary skill, reviewing the DuBois figures, would understand them to show mounting the lamp adjacent to the side-view window. In coming to its decision, the Federal Circuit emphasized that that the opinions of an expert cannot substitute the actual prior art disclosure.

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