

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SOUTH-TEK SYSTEMS, LLC AND POTTER ELECTRIC CO, LLC,  
Petitioner,

v.

ENGINEERED CORROSION SOLUTIONS, LLC,  
Patent Owner.

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Case IPR2016-00136  
Patent 9,144,700 B2

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Before WILLIAM V. SAINDON, BARRY L. GROSSMAN, and  
JEREMY M. PLENZLER, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request  
to Present Live Testimony at Oral Argument

*Conduct of the Proceedings – Oral Argument*  
37 C.F.R. § 42.5

By an e-mail to the Board, sent on January 25, 2017, Patent Owner requested authorization to present live testimony at the hearing to be held on February 6, 2017. The requested live testimony is from Patent Owner's expert witness, Mr. Robert O'Neill. Pursuant to an e-mail sent to the parties on January 25, 2017, we authorized a motion by Patent Owner addressing the request and a reply to the motion by Petitioner. Patent Owner filed its motion. Paper 48 ("Motion"). Petitioner filed its Reply. Paper 49 ("Reply"). Having considered the Motion and Reply, Patent Owner's Motion is denied.

There appears to be some confusion between the parties as to whether Mr. O'Neill is a fact witness or an expert witness. *See* Reply 1 ("Patent Owner now purports to present Mr. O'Neill not as an expert, but as a PHOSITA<sup>[1]</sup> – that is, a fact witness."). Thus, we first clarify that Mr. O'Neill's is proffered as an expert witness in this case.

Patent Owner identified Mr. O'Neill as an expert witness in its response to the Petition. Paper 27, 7 ("PO Resp.") ("As explained by ECS's expert, Robert O'Neill, P.E. . . ."); *see also id.* at n.1 ("Based on his experience and qualifications, Mr. O'Neill is unquestionably an expert in the relevant field." (citation omitted)). Mr. O'Neill stated clearly that his declaration testimony "is based on my personal knowledge as a Senior Fire Protection Engineer and my opinions as an expert in the field of fire sprinkler systems." Ex. 2019, ¶ 1. Mr. O'Neill also testified that he was "retained as an expert witness on behalf of Engineered Corrosion Solutions, LLC ("ECS") for this IPR." *Id.* at ¶ 2.

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<sup>1</sup> We understand "PHOSITA" to be patent law jargon and an acronym for a "person having ordinary skill in the art."

In its Motion, however, Patent Owner states, without citation of any authority, that “[i]t is undisputed that Mr. O’Neill is a PHOSITA.” Motion 1. This one statement is what has caused the apparent confusion as to Mr. O’Neill’s status. Mr. O’Neill has testified that he is *not* a PHOSITA, or “Typical Sprinkler Designer,” as he refers to it in his Declaration testimony. Ex. 2019 ¶¶ 10–11 (“While I believe that my extensive experience means that I am not a Typical Sprinkler Designer myself . . .”).

Accordingly, based on the totality of the evidence in this proceeding, we determine that Mr. O’Neill has been offered as, and is testifying as, an expert witness, not as a fact witness. We consider the Motion in the context that Mr. O’Neill is testifying as an expert witness.

Patent Owner seeks to present “no more than 10 minutes of live testimony” from Mr. O’Neill. Motion 1. Patent Owner identifies six specific topics for the proposed live testimony:

- (1) how corrosion-induced water leaks in fire sprinkler systems was a long-felt but unsolved need (*see* Exhibit 2019, ¶¶ 15–38);
- (2) how Mr. O’Neill attempted to address the long-felt but unsolved need (¶¶ 44–48);
- (3) Mr. O’Neill’s observations of industry efforts to address the same long-felt but unsolved need (¶¶ 44–48);
- (4) how the industry was skeptical of ECS’s claimed invention (¶ 50);
- (5) how ECS’s claimed invention solved the long-felt but unsolved need (¶¶ 40–43, 49); and
- (6) why the claimed invention would not have been obvious to a PHOSITA (¶¶ 62–63).

*Id.* at 2. Patent Owner also asserts that live testimony is needed because Petitioner’s “attacked Mr. O’Neill’s credibility” on the issue of “long-felt need.” *Id.* at 1.

Petitioner opposes the Motion on the basis that it is untimely. Reply 1. Petitioner also states it has not “attacked” Mr. O’Neill’s credibility in offering his testimony. *Id.*

*Discussion*

The Board does not envision that live testimony will be necessary at many oral arguments. *See* Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). However, under very limited circumstances, cross-examination of witnesses may be ordered to take place in the presence of an administrative patent judge. *Id.* at 48762. For example, the Board may occasionally require live testimony where the Board considers the demeanor of a witness critical to assessing credibility. *Id.* The Board envisions that live testimony will be necessary only in limited circumstances and intends to approach requests for live testimony on a case-by-case basis. *K-40 Elec., LLC v. Escort, Inc.*, IPR2013-00203, Paper 34, p. 3, (May 21, 2014); *see also* 81 Fed. Reg. 18750, 18760 (Apr. 1, 2016) (“. . . the Office noted that it will continue its present practice of considering requests for presentative of live testimony in an oral hearing on a case-by-case basis, but the Office does not expect that such live testimony will be required in every case where there is conflicting testimony.”).

One of the factors to be considered in deciding whether Mr. O’Neill’s live testimony will be helpful to the resolution of this proceeding is whether he is a fact witness or an expert witness. *K-40 Elec.* at p. 3. Here, as discussed above, Mr. O’Neill is testifying as an expert witness. The credibility of experts often turns less on demeanor and more on the plausibility of their theories. *Id.* (citing *Andreu v. Sec’y of HHS*, 569 F.3d 1367, 1379 (Fed. Cir. 2009) (“A trial court makes a credibility

determination in order to assess the candor of a fact witness, not to evaluate whether an expert witness' medical theory is supported by the weight of epidemiological evidence.”).

As is evident from the citations to numerous paragraphs from Mr. O'Neill's 22 page Declaration (Ex. 2019) in identifying six topics on which Patent Owner seeks live testimony (Motion 2), Mr. O'Neill has already testified on each of these topics. Patent Owner has not directed us to persuasive evidence or argument as to why additional live expert testimony is required on these topics.

Moreover, we are not persuaded that Mr. O'Neill's credibility has been “attacked.” In its reply (Paper 30) to Patent Owner's response (Paper 27) to the Petition, Petitioner disputed Mr. O'Neill's conclusions and opinions regarding the issue of long-felt need. *See* Motion 1 (identifying the disputed testimony). Petitioner states it does not question Mr. O'Neill's factual testimony or his credibility in offering it. Reply 1.

In view of the foregoing, we determine that it would not be helpful to the Board to receive live testimony from Mr. O'Neill that is entirely redundant to declaration testimony that is already of record. We are not persuaded that observation of Mr. O'Neill's demeanor will be helpful in assessing the reliability of his opinions and conclusions as an expert witness.

#### ORDER

In view of the foregoing, it is hereby

ORDERED, that Patent Owner's Motion to present live testimony of Mr. O'Neill at the hearing on February 6, 2017, is DENIED.

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