

## Expert Must Meet POSITA Standard to Testify on Infringement

FEBRUARY 17, 2022

*Kyocera Senco Industrial Tools Inc., fka Kyocera Senco Brands Inc. v. ITC / Koki Holdings America Ltd. fka Hitachi Koki U.S.A. Ltd. v. ITC*, Nos. 2020-1046, 2020-2050 (Fed. Cir. Jan. 21, 2022)

The Patentee filed a complaint with the ITC alleging that certain imported gas spring nailer products were infringing. The ALJ found the accused products did not infringe. The ITC reviewed the ALJ's decision and reversed it. The parties then separately appealed several of the ALJ's findings and the ITC's decision.

A key issue on appeal was the partial exclusion of Patentee's expert witness. During claim construction, the ALJ adopted a POSITA standard requiring experience designing power nailers. The Patentee's expert did not meet this standard and was therefore precluded from testifying on infringement under the doctrine of equivalents. The expert was allowed, however, to testify about literal infringement. The Patentee argued that the expert should have been allowed to testify about both issues, and the alleged infringer argued that he should not have been allowed to testify about either. The Federal Circuit agreed with the alleged infringer and vacated the decision, holding that the expert should have been precluded from testifying about infringement entirely.

Expert testimony is always required to prove infringement by equivalents but is only sometimes required for literal infringement. The Federal Circuit explained, however, that any expert testimony on infringement—whether literal or equivalents—must come from an expert possessing at least ordinary skill in the art; otherwise, it is not relevant or admissible. The ALJ therefore should have excluded the Patentee's expert testimony in its entirety.

1 Min Read

### Related Locations

Charlotte

Chicago

Houston

Los Angeles

Silicon Valley

Washington, DC

### Related Topics

Infringement

International Trade Commission

Experts

---

## Related Capabilities

Patent Litigation

Intellectual Property

## Related Professionals

---



David Enzminger



Brian E. Ferguson



Kelly C. Hunsaker



Ivan Poullaos



Mike Rueckheim



Danielle Williams