

OSSEO IMAGING, LLC v. PLANMECA USA INC., Appeal No. 2023-1627 (Fed. Cir. September 4, 2024). Before Dyk, Clevenger, and Stoll. Appealed from D. Del. (Judge Bataillon).

Background:

At trial, a jury found that Planmeca infringed Osseo's patents directed to imaging systems. The imaging systems were allegedly invented in 1999, and a person of ordinary skill in the art was determined to have a bachelor's degree in electrical or computer engineering plus 3 to 5 years of experience working in the relevant field.

After the trial, Planmeca renewed its motion for judgment as a matter of law and argued that the plaintiff's expert did not acquire the relevant experience to qualify as a person of ordinary skill in the art until nearly 10 years after the invention. Accordingly, Planmeca argued that the expert's testimony should be disregarded in its entirety. The court disagreed and held there was no requirement for the expert to acquire expertise prior to the invention. Thus, the court stated that the jury was free to credit the expert's testimony in reaching their conclusion. Planmeca appealed.

Issue/Holding:

Did the district court err in not disregarding the expert's testimony? No, affirmed.

Discussion:

Planmeca argued that the expert became a person of ordinary skill 8 to 10 years after the invention. Further, Planmeca argued that case law requires that an expert witness must be qualified to offer testimony on issues "from the vantage point of an ordinarily skilled artisan in a patent case." Based on this quote, Planmeca argued the expert here did not possess the requisite skill at the time of the alleged invention and that the expert's testimony cannot constitute substantial evidence to support a verdict of infringement.

The Federal Circuit disagreed with Planmeca and stated their argument infers too much from the language quoted above. The Federal Circuit held that precedent is clear—an expert must at a minimum possess ordinary skill in the art. Nothing more is required.

The court also reasoned that there should be no such requirement because an expert can acquire the necessary skill later and develop an understanding of what a person of ordinary skill knew at the time of the invention.

The Federal Circuit further reasoned that, in practice, the fact that the expert was not a person of ordinary skill at the time of the invention may be used during cross examination to undermine the credibility of the expert, and an expert who later acquires the requisite knowledge could avoid such potential damage to their credibility by explaining how they gained the perspective of a person of ordinary skill at the time of the invention.