

IP Litigator, Federal Circuit Addresses District Court Oversight of Expert Testimony on Infringement, (Jul. 1, 2025)

IP Litigator

[Click to open document in a browser](#)

Federal Circuit Addresses District Court Oversight of Expert Testimony on Infringement

Don Geiger

Don Geiger is an associate in Sheppard Mullin's Intellectual Property Practice Group, primarily working in patent litigation. He has an extensive technical background in electrical engineering and computer science and is a USPTO registered patent attorney. He can be reached at dgeiger@sheppardmullin.com.

In *Steuben Foods Inc. v. Shibuya Hoppmann Corporation*, the Federal Circuit addressed the boundaries a district court may impose on experts by deeming their testimony wrong as a matter of law.

Background

Steuben Foods Inc. ("Steuben") owns U.S. Patent Nos. 6,209,591 (the "'591 Patent"), 6,536,188 (the "'188 Patent"), and 6,702,985 (the "'985 Patent"), collectively (the "Asserted Patents"). All of the Asserted Patents are related to systems for the aseptic packaging of food products.

Starting in 2010, Steuben filed suit against Shibuya Hoppmann Corp., Shibuya Kogyo Co. Ltd., and HP Hood LLC (collectively, "Shibuya") for allegedly infringing the Asserted Patents. In 2019, the actions were consolidated and transferred to the District of Delaware.

The district court issued its claim construction order in 2020 and denied cross-motions for summary judgment of noninfringement, infringement, and invalidity in 2021. Prior to trial, the district court denied Shibuya's motion for JMOL of noninfringement under [FRCP 50\(a\)](#) as to each of the Asserted Patents. Then, after a five-day jury trial, the jury returned a verdict in favor of Steuben, finding that Shibuya infringed the Asserted Patents and that the Asserted Patents were not invalid. The jury awarded Steuben over \$38 million in damages.

Following trial, Shibuya renewed its motions for JMOL of noninfringement under [FRCP 50\(b\)](#) and moved for JMOL with respect to invalidity and damages. Shibuya also moved for a new trial on noninfringement, invalidity, and damages.

With respect to Steuben's infringement case, the district court determined that Steuben's expert, Dr. Sharon, was wrong as a matter of law for each of the Asserted Patents. For the '591 Patent, the district court found that Dr. Sharon's testimony was inconsistent with the specification of the '591 Patent. For the '188 Patent, the district court found Dr. Sharon's testimony could not have convinced a reasonable juror that accused devices were substantially similar to the claimed invention. For the '985 Patent, the district court found Dr. Sharon's testimony to be contrary to one of the parties' stipulated constructions. Ultimately, and notwithstanding the jury's verdict to the contrary, the district court granted Shibuya's motion for JMOL of noninfringement for all Asserted Patents.

The district court also preemptively granted a new trial under [FRCP 50\(c\)\(1\)](#) in the event that its JMOLs with respect to noninfringement, invalidity, or damages were reversed or vacated. The district court entered an [FRCP 54\(b\)](#) judgment in favor of Shibuya, and Steuben appealed.

Issues

1. Did the district court err in discrediting Steuben's expert testimony, and in consequentially granting Shibuya's motion for JMOL of noninfringement of the '591 and '188 Patents?

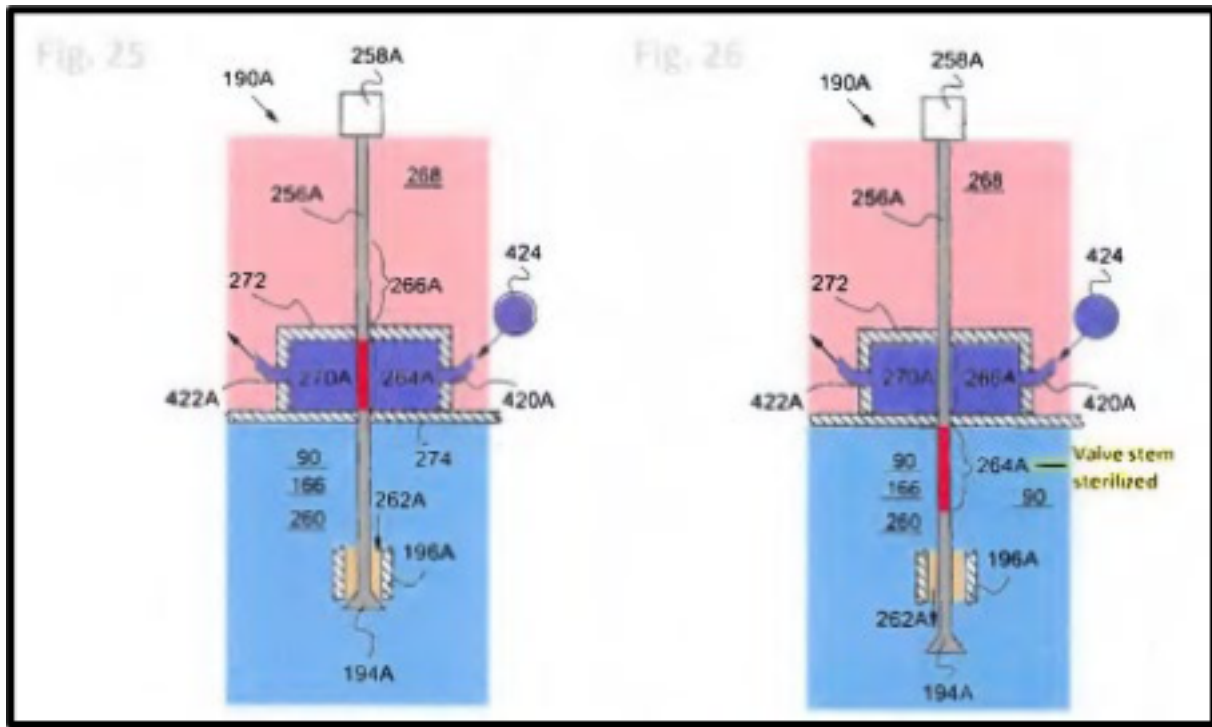
2. Did the district court err in discrediting Steuben's expert testimony, and in consequentially granting Shibuya's motion for JMOL of noninfringement of the '985 Patent?

Reasoning and Outcome

1. The Federal Circuit held that the district court erred in discrediting Steuben's expert testimony, and in consequentially granting Shibuya's motion for JMOL of noninfringement of the '591 and '188 Patents.

The specification of the '591 patent described a valve wherein a secondary sterile region (purple in Fig. 1 below) is supplied with a sterilizing media (item 424 in Fig. 1 below), such that a portion of the valve stem (red in Fig. 1 below) is sterilized when the valve stem leaves the primary sterile region (blue in Fig. 1 below):

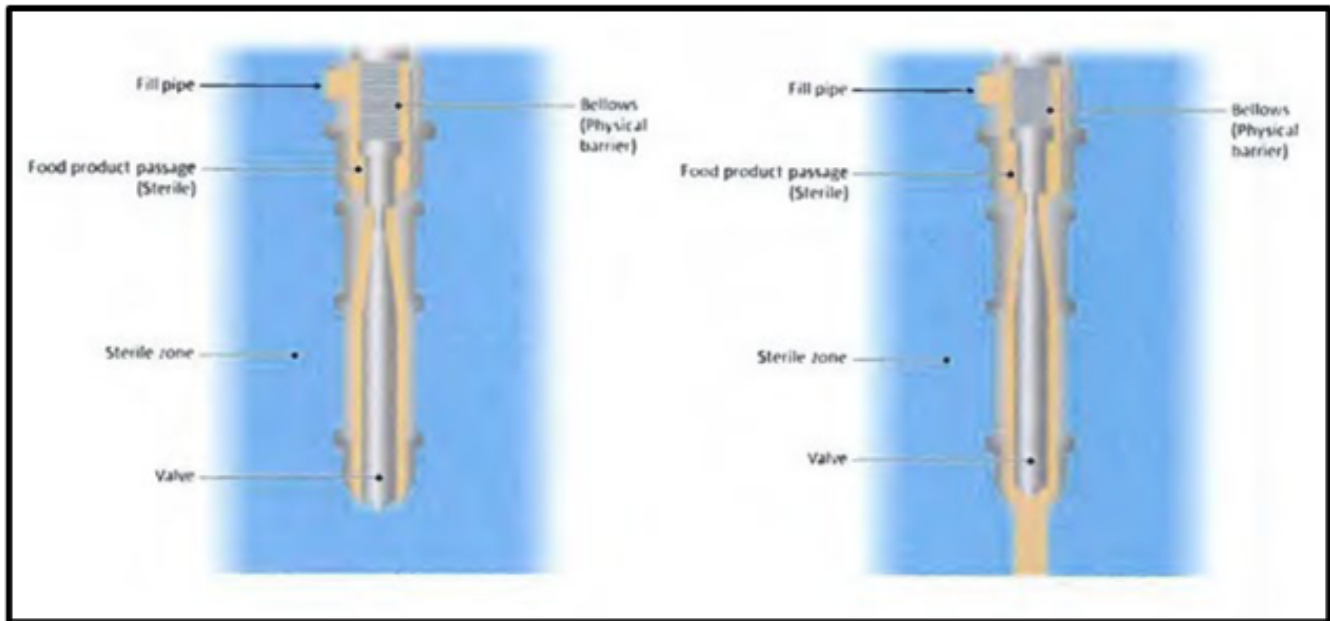
Figure 1: An illustration of the invention described in Steuben's '591 Patent.



The relevant limitation of the claim at issue read “a second sterile region positioned proximate said first sterile region.” Notably, the supplied sterilizing media was described in the specification of the '591 Patent but was not recited in the claim at issue.

Steuben's theory of infringement was that Shibuya's accused product (illustrated in Fig. 2 below) contained a first sterile region in the form of a sterile fill pipe (tan in Fig. 2 below) which was proximately positioned from a surrounding second sterile region (blue in Fig. 2 below):

Figure 2: An illustration of the invention described in Shibuya's accused product



The district court structured its analysis with respect to infringement of the '591 Patent based on the RDOE. The Federal Circuit recited the relevant case law on RDOE:

An alleged infringer may avoid a judgment of infringement by showing the accused “product has been so far changed in principle [from the asserted claims] that it performs the same or similar function in a substantially different way.” *SRI Int'l v. Matsushita Elec. Corp. of Am.*, [775 F.2d 1107](#), 1124 (Fed. Cir. 1985). A patentee alleging infringement bears the initial burden of proving infringement. *Id.* at 1123. If the patentee establishes literal infringement, then an accused infringer claiming noninfringement under RDOE bears the burden of establishing a prima facie case of noninfringement under RDOE. *Id.* at 1123–24. If the accused infringer meets this burden, then the burden shifts back to the patentee to rebut the prima facie case. *Id.* at 1124.

Shibuya's expert, Dr. Glancey, testified that the principle of operation of the invention of the '591 Patent was the supply of a sterilizing media to actively maintain the second sterile region. Because Shibuya's accused product had no such supplied sterilizing media, the district court determined that Dr. Glancey's testimony satisfied Shibuya's burden to raise a prima facie RDOE defense.

In rebuttal, Steuben's expert, Dr. Sharon, testified that the principle of operation of the invention was “...having these two sterile regions that the valve is sort of constrained to so that as it opens and closes, it only stays within those two regions and it does not go into any non-sterile region [...]” Although the jury apparently accepted Dr. Sharon's version with regard to the principle of operation, the district court found Dr. Sharon's testimony contrary to the specification of the '591 Patent and entitled to no weight. As a consequence, the district court granted JMOL because Steuben had failed to rebut Shibuya's prima facie RDOE defense in the eyes of a reasonable juror.

In reversing the district court, the Federal Circuit found that Dr. Sharon's testimony regarding the principle of operation of the '591 Patent's invention constituted substantial evidence for the jury's rejection of Shibuya's RDOE defense. Thus, the district court erred by discrediting Dr. Sharon's rebuttal testimony regarding Shibuya's RDOE defense, and in granting JMOL of noninfringement of the '591 Patent.

With respect to the '188 Patent, Dr. Sharon again testified, this time regarding the substantial equivalents of elements defined via mean-plus-function language. Dr. Sharon testified that Shibuya's accused neck grippers and rotary wheels operate in substantially the same way as the conveyors and conveyor plates defined in the '118 Patent's specification. Shibuya's expert, Dr. Glancey, testified that there were several differences between the accused rotary systems and the claimed conveyor systems.

The district court granted JMOL of noninfringement, finding that Dr. Sharon's testimony was wrong as a matter of law and entitled to no weight. Like with Dr. Sharon's testimony on Shibuya's RDOE defense, the district court believed no reasonable juror could credit Dr. Sharon's testimony that neck grippers and rotary wheels operate in substantially the same way as conveyors and conveyor plates.

According to Federal Circuit precedent on means-plus-function language, "the individual components, if any, of an overall structure that corresponds to the claimed function are not claim limitations. Rather, the claim limitation is the overall structure corresponding to the claimed function." *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1268. In the eyes of the Federal Circuit, the district court focused too much on the individual components and failed to consider infringement in the context of the claimed function, for which Dr. Sharon's testimony constituted substantial evidence.

The Federal Circuit reversed the district court's grant of JMOL of noninfringement and reinstated the jury's verdict of infringement with respect to both the '188 and '591 Patents.

2. The Federal Circuit held that the district court did not err in discrediting Steuben's expert testimony, and in consequentially granting Shibuya's motion for JMOL of noninfringement of the '985 Patent.

The '985 Patent included a limitation wherein "atomized sterilant is intermittently added to said conduit[.]" Steuben and Shibuya had stipulated to a construction of "intermittently added" as "[a]dded in a non-continuous matter." It was also undisputed that Shibuya's accused machines added sterilant in a continuous matter.

Steuben's expert, Dr. Sharon, testified that the accused product's continuous sterilization was substantially equivalent to the "intermittently added" limitation under the Doctrine of Equivalents (the "DOE") because "... in the end, the point is to get the right amount of sterilant into the bottle." The district court determined that the "intermittently added" limitation could not be met under the DOE by a continuous addition of sterilant because "intermittently" and "continuously" are antonyms of each other. Consequently, the district court deemed Dr. Sharon's testimony wrong as a matter of law and granted JMOL of noninfringement of the '985 Patent.

According to Federal Circuit precedent, DOE may not apply where "the accused device contain[s] the antithesis of the claimed structure," such that the claim limitation would be vitiated. *Deere & Co. v. Bush Hog, LLC*, [703 F.3d 1349](#), 1356 (Fed. Cir. 2012). The Federal Circuit found no error with the district court's reasoning because finding infringement under DOE where the parties had stipulated to a construction antithetical to the operation of the accused device would vitiate the claim limitation.

The Federal Circuit affirmed the district court's grant of JMOL of noninfringement with respect to the '985 Patent.

This article has been reprinted with permission from Sheppard Mullin. The article originally appeared on the firm's Intellectual Property Law Blog.