June 27, 2024

Declaration sans oath - No harm, no foul

by John C. Alemanni

In a decision today, the Federal Circuit excused the lack of an oath with a declaration, finding no prejudice resulted. Case No. 2022-2133. Liquidia Technologies filed an IPR petition challenging claims of United Therapeutics Corporation's ("UTC") patent and in the petition cited the declaration of Dr. Winkler. The Winkler declaration was signed but lacked an oath. UTC deposed Dr. Winkler during the course of the IPR, but subsequently filed a motion to exclude the declaration. In its Final Written Decision, the Board denied the Motion to Exclude and found the challenged claims unpatentable.

UTC appealed the Board's decision, including its denial of UTC's motion to exclude. The Federal Circuit reviewed the Board's denial of UTC's motion under the abuse of discretion standard. The court first noted, "[w]hether required by statute or regulation, it is clear any declaration or affidavit submitted in IPR proceedings must contain an oath or declaration." Slip at 7. The court observed that Dr. Winkler confirmed during his deposition that he had signed his declaration and there were no issues concerning the truthfulness of it. The court noted, "Under the APA, we will not overturn an agency's decision unless it produced an error that was genuinely harmful or prejudicial." *Id.* at 8 (citations omitted). Here, the court concluded that UTC suffered no prejudice and "under the facts here, substance beats form." *Id.* at 9.

This case serves as a reminder to carefully review filings to ensure they comply with the statute and the Board's rules. Failure to do so in this case resulted in significant additional work at the PTAB and before the Federal Circuit. And as the court notes, "[l]itigation is a risky business, and careful inclusion of an oath or affidavit can eliminate the risk that both UTC and Liquidia bore here." Slip at 10.