UNITED STATES
Exploiting expertise: effective use of expert witnesses in patent litigation
Expert testimony serves as a key element of virtually all intellectual property litigation. This is particularly true in patent infringement cases, where expert analysis and testimony can make or break the case. The company must identify an inside expert. That inside expert may have the best knowledge regarding how the technology at issue relates to the business of the company. The inside expert should assist with the identification of the outside expert or experts. The company may want to engage different experts for invalidity and infringement damages.

Finding the right outside expert to testify, preparing the expert for trial and incorporating the expert’s opinions into the litigation strategy strengthens the offering party’s case. Ultimately, the chosen expert must educate the court and jury (when it is not a bench trial, which is often the case in patent litigation) on a number of topics that are beyond their normal experience. The technology will likely be foreign, as will a number of the legal concepts: What is claim construction? What is § 103 prior art? What is the doctrine of equivalence? What are convoyed sales? The company’s legal and expert teams must start the case with the assumption that the fact finder has no knowledge relating to each of these questions.

Thus, selecting an expert with excellent experience, credentials and communication skills serves as the cornerstone in arguing an effective patent case and often makes the difference between winning and losing.

This article explores the importance of finding an effective inside expert, using the inside expert to identify the outside expert(s) and utilising the expert team to succeed in the case.

Identifying the inside expert
The first step in forming the expert team requires that the company and its counsel identify an inside expert to assist with the case. The inside expert plays a number of key roles:

• helping counsel stay focused on the business goals underlying the case;
• helping to identify the best outside experts, especially on technology issues;
• assisting the outside expert in applying abstract principles to the specific business usage at issue; and
• helping to provide realistic and frank reports regarding the status of the case, as these communications may be covered by the attorney-client privilege, whereas the outside expert’s may not.
The size of the company dictates the depth of the pool of potential inside experts. Factors the company should consider in selecting the inside expert include whether the candidate is likely to be a key witness – this would weigh against the candidate performing the inside expert role; whether the candidate can be objective with respect to the issues; whether the candidate has the necessary time; whether the candidate has credibility with management; and whether the candidate can interface effectively with outside counsel.

Once this selection process has been completed, the inside expert and outside counsel should turn to identifying the outside expert(s). This, as discussed below, should be as early in the case as possible.

Finding the expert
Finding the right outside expert is an early and crucial step in building a successful litigation strategy. First, the expert must be qualified regarding the issues he or she is to address. The expert must also be credible and an effective communicator. Many jurors will accept the testimony of the most credible witness even if they do not fully understand the testimony.

Right qualifications
Numerous factors should be considered when identifying the outside expert. Four of these are education, practical experience, publications and prior testimony.

Education
There is little question that academic pedigree helps to establish the credibility of an expert with the finder of fact. This includes advanced degrees from universities with strong reputations in the field at issue. Academics themselves often are viewed as carrying an objectivity that industry experts may not have.

Experience
Practical experience also can be key. An academic with no practical experience may be subject to attack for being too theoretical. Also, in some areas of technology, there simply may not be a qualified academic.

Publishing
Ideally, a potential expert witness will have authored multiple articles in the subject matter of the issues that he or she will be asked to address. This, too, adds credibility. Of course, trial counsel must make sure that the prior writings cannot be used to undermine the expert’s testimony.

Prior testimony
An expert’s previous experience testifying may help increase his or her effectiveness – the experience may alleviate the expert’s nerves during cross-examination and allow for better communication of key principles in an understandable fashion. On the other hand, a trial-savvy hired gun may appear too slick and untrustworthy.

Anticipate Daubert challenge
One key aspect of engaging an outside expert is to verify that he or she will withstand the inevitable challenge by the opposition. These challenges often are called Daubert challenges. The Daubert trilogy (which consists of three Supreme Court cases determining threshold standards for admitting expert testimony: Daubert v Merrell Dow Pharmaceuticals; Kumho Tire Co v Carmichael; and General Electric v Joiner) made the district court judge the gatekeeper for determining whether the proffered expert testimony is reliable enough for admission at trial. The trilogy grants district court judges broad discretion for making this determination. Accordingly, attorneys routinely challenge the opposing expert witnesses on the chance that the judge will not allow the testimony.

Congress codified the Daubert standard for admitting expert testimony in December 2000. The Federal Rules of Evidence, consistent with the Daubert trilogy, require that the district court judge act as gatekeeper for all expert testimony, entrusting to the court evaluation of whether the planned testimony is grounded, well reasoned and not speculative before allowing the expert to testify. Experts testifying to any technical or specialised knowledge must meet this standard of reliability, as neither Daubert nor the Federal Rules of Evidence restrict the gatekeeper function to scientific expert evidence alone. In Daubert, the Supreme Court listed the following as non-exclusive factors district court judges may consider when determining the reliability of the proffered testimony:

- whether the theory can be tested;
- whether the theory has been subjected to peer review and publication;
- whether the offered technique has a known or potential error rate; and
- whether the theory has been accepted by the scientific community.

A district court need not consider each of these factors, as the court did not include these factors as a definitive checklist. The witness may qualify as an expert based on his or her knowledge, skill, training, experience or education. The judge need only find
the potential expert qualified under one of these areas for the expert to testify as an expert. An expert basing his opinion solely on experience must explain how his experience has led to the opinion.

Where to look for your outside expert

As briefly mentioned above, experts can be hired from many different environments, but the source of the expert may speak volumes for their credibility. Universities, government agencies, expert consulting firms and corporations are examples of where to find potential experts. Many attorneys prefer hiring experts from academia, believing that juries find professors more trustworthy and impartial than experts hired from other areas.

The geographic location of the expert also may affect the jury’s ability to relate to the expert. Choosing the right expert requires knowing what will and will not resonate in the forum where the case is pending. For example, a slick expert from New York will not be received by a jury in the rural South as well as a professor from a local university or business. Finding an expert with a connection to the geographic region of the court is preferred; this does not, however, trump the need for the expert to be qualified in the relevant technology.

Once a potential expert has been located, all of the expert’s former testimony and articles should be studied for any potentially impeaching or contradictory material. Depending on the trial experience and prolific nature of the chosen expert, this review may be an expensive and time-consuming task, but it must be done. The other side will most certainly pour through these documents to find any way to discredit the expert on the stand, and preparing the witness to reconcile any seemingly contradictory statements before trial will help save the expert’s credibility with the judge or jury.

Soon after selection, an engagement letter should be provided to the expert delineating the scope of his or her services. Communicating your expectations for the expert’s service helps eliminate misunderstandings between you and your key witnesses. The engagement letter can also be used to limit the scope of an expert’s preparation, allowing the expert to focus on the section of the case on which you will rely on him.

Keep track of documents given to expert

The expert’s report should list the documents and other information considered by the expert. Consequently, someone should be designated with the responsibility of tracking all information provided to the expert. This, too, will have the additional benefit of helping control the flow of the information.

Early engagement

Assessing strengths and weaknesses of case

Actively engaging an expert in the early stages of a case can strengthen the litigation strategy. An experienced expert can help determine the strength of your case and recommend strategies based on his or her understanding of the technology involved and review of key documents and information provided by the attorneys. The expert should begin researching the technology and any documents provided by the attorney soon after engagement.

Outside experts often complain that they have not been given enough fodder to support their opinions. Expert discovery typically (but not always) occurs at the end of the general discovery period, but the outside expert should not, if at all possible, be brought into the process at the end of general discovery. Let the outside expert help you form the foundation for his or her testimony.

Beware of preliminary opinions

While the expert should be brought in early in the process, the expert should be encouraged not to reach any conclusions until the fact record is developed. Many potential experts like to take notes that could be construed as final opinions. When those ideas change as the expert receives more information (eg, the final claim construction), the opposition may argue that the expert has flip-flopped. Don’t expose your expert to this.

Expert reports

After the preliminary research, the first key work product of the expert witness is typically the expert report. The Federal Rules of Civil Procedure (the Rules) mandate that all testifying experts submit written expert reports detailing opinions they will express at trial. Rule 26 includes strict requirements for the reports, and an expert can be barred from testifying if the required disclosures are not made in a timely and substantive manner. For example, all information supporting the expert’s opinions and qualifications must be submitted with the report at least 90 days before trial. This includes data supporting the opinions set forth in the report, any exhibits cited therein, a list of all publications authored by the witness within 10 years of testimony, information regarding any compensation for the testimony and a list of all testimony in any previous cases.

The Federal Rules allow attorneys to participate in preparing the expert report. However, the opinions ultimately expressed in the expert report must be those of the expert and not of the attorney. The fact finder likely will discount an expert’s findings as biased if he or she was unduly influenced by the attorney. The attorney should ensure that the expert opines on all theories...
involved in the case as anticipated in the engagement letter. The attorney also should ensure that the expert’s opinions are not in direct conflict with any previous testimony or article authored by him or her. Finally, the attorney should ensure that the opinions expressed in the expert report are well reasoned and supported by the facts of the case.

As stated above, ensuring that the positions taken in the expert reports do not appear to conflict with any opinions expressed in the expert’s previous testimony and articles requires the attorney to collect and study all previous opinions stated by the expert. The expert’s credibility will suffer if opposing counsel exposes an article authored by the expert that seems to contradict the opinion taken on the stand and the expert is not prepared to reconcile clearly the two for the judge or jury.

**Depositions**

The expert will be deposed on his or her report. An entire article could be dedicated to the issue of preparing an expert for deposition, but only several key points will be noted here:

1. Time – it takes time to prepare a witness; don’t skimp.
2. Don’t assume that even an experienced witness has been properly prepared for previous depositions – he or she may have not have been.
3. Make sure the expert has thoroughly reviewed all relevant materials.
4. Make sure the expert understands the legal ramifications of his or her statements – the expert may say something that would be understood one way in his or her discipline but another way under the Rules.

**Trial**

Preparing witnesses is a crucial part of trial preparation, particularly with expert witnesses. Regardless of an expert’s qualifications or experience, relying on an unprepared expert witness to relay critical elements of a litigation strategy can sabotage an otherwise well-prepared case. Experts must know how to communicate difficult technology to the judge and jury on an understandable level, retain composure while defending their positions on cross-examination and use demonstratives effectively. Proper preparation should begin with the expert report and follow through to the deposition testimony.

As mentioned, expert reports should explain every opinion stated at trial. Experts not only should be familiar with the positions taken in the report; they should also be well versed in the data supporting the opinion and the process of forming the opinion. The expert also should be able to differentiate and discredit adverse positions taken by opposing counsel’s expert reports.

Once trial begins, the attorneys and expert witnesses must remember that the judge and jury know very little about the technology presented to them. Although the judge may have immersed himself or herself in the briefs leading up to trial and construed the claims in the *Markman* hearing, he or she will likely struggle to understand any highly technical information submitted at trial. A jury, on the other hand, enters the courtroom without the benefit of briefs explaining background information, the underlying technology or the theories involved in the case. Therefore, if a jury serves as fact finder, the testimony should be presented in an even more basic format than if presented to a judge.

Attorneys and expert witnesses must present information on a level that both the judge and jury will understand and build on that knowledge throughout the trial. Juries will most likely adopt positions presented in a more comprehensive and understandable manner. Thus, attorneys must prepare experts for the challenge of relaying information in an understandable method while dealing with the duress of cross-examination. Generally speaking, conveying expert opinions on a level that an eighth-grade student could understand is the most effective way to educate the jury. The jury will contain a cross-section of society and be made up of people with all levels of education – showing the ability to break complicated matters down into easily understandable ideas increases the weight juries will place on the testimony.

Attorneys should work with experts on their testimony. The courtroom can be a foreign, unsettling venue for any witness. Attorneys should prepare the witnesses by running through all questions planned for direct questioning and anticipated questions for cross-examination. Effective communication requires that the expert relay information clearly on direct questioning and defend his opinions on cross-examination. Demonstratives, if used correctly, can simplify complicated subject matter for the jury. Any demonstratives planned for use during the expert’s testimony should be developed with the expert. The attorney also should instruct the expert on how to use the demonstrative to enhance testimony.

**Conclusion**

No one approach can ensure a successful patent case. However, in each case the company must carefully consider the selection of inside expert and outside legal team to select and prepare the outside expert for the key reports and testimony that are to follow.
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