

## Selecting Experts In Patent Cases

### A Few Simple Considerations

Part One of a Two-Part Series

By Benjamin Hershkowitz and Bradley W. Micsky

In light of the ever-increasing cost and complexity of patent cases, the hiring of experts is one of the most important decisions in which a party must engage. In patent cases, potential experts range from technical experts to financial experts to Patent Office procedure experts to even marketing experts. Deciding whether, and whom, to hire can often have a large influence on how discovery and the case are handled. This article discusses several simple considerations that confront a litigant in a typical patent case.

#### ARE EXPERTS REQUIRED?

The first question a litigant must ask is whether a witness with a particular expertise (*i.e.*, an expert) is required. In patent cases, for matters concerning technical infringement and validity issues, the answer is almost always an emphatic “yes.” The need for an expert to address infringement comes directly from the Court of Appeals for the Federal Circuit (“Federal Circuit”) and common-sense litigation tactics.

Although experts are not explicitly

required by any statute or rule, the Federal Circuit has indicated that an expert can play a *necessary* role in infringement matters. For example, in *Centricut, LLC v. The ESAB Group, Inc.*, a patent holder based its infringement case on the testimony of several non-expert witnesses while the defendant relied on an expert for its non-infringement evidence at trial. 390 F.3d 1361 (Fed. Cir. 2004). The Federal Circuit held that the patent holder did not meet its burden to prove infringement by offering only non-expert testimony and stated that “in a case involving complex technology, where the accused infringer offers expert testimony negating infringement, the patentee cannot satisfy its burden of proof by relying only on testimony from those who are admittedly not expert in the field.” Therefore, a patent litigant must have an expert, not to satisfy any legal requirement, but instead to offer evidence that can be considered at the same level as the opposition’s expert.

Although the discussion in *Centricut* only involves infringement, an argument can be made that this same rationale could, depending on the particular circumstances of the case, be applied to invalidity and damages issues. The details of these issues involve nearly identical technical material, in the case of invalidity, and of similar complexity, in the case of damages. Thus, a patent litigant must retain experts for each of these important issues. An expanded discussion of the *Centricut* case can be found at

Benjamin Hershkowitz and Mark Raskin, “Are Experts Required?,” *Patent Strategy & Management*, Aug. 2005.

#### ARE EXPERTS ALLOWED?

In contrast to the necessity of having an expert for the complex and technical aspects of infringement, invalidity, and damages issues, some courts have excluded expert testimony in certain areas. In patent cases, patent law experts are often not permitted to testify. While this seems counterintuitive, courts often find patent law experts offer little in the way of useful testimony.

Patent law experts are retained when litigants want to offer expert testimony explaining Patent Office procedures and/or the intricacies of patent laws in general. This information can be useful to educate the jury, but a concern expressed by some commentators is that if left unregulated, this practice can just as easily become a forum for the expert to become nothing more than an extension of counsel or to testify on matters outside his expertise. See Joseph N. Hosteny, “The Misuse of Patent Law Experts: An Embarrassment to Our Profession,” *Patent Strategy & Management*, Jan. 2005. It is this downside that has made some courts skeptical of the usefulness of patent law expert testimony. As a result, some courts have shied away from allowing patent law experts to testify at all in order to avoid their misuse. Other courts have limited the testimony of such experts to, for example, only

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Patent Office procedure issues. The preference for allowing or preventing the testimony of patent law experts varies widely by court and is impossible to generalize.

When considering whether to retain a particular type of expert, a litigant must consider the nature of the testimony the expert will offer and the particular court's proclivity to allow expert testimony in that area. Because of the uncertainty surrounding patent law experts, litigants should explore both the context of the testimony, and the court's preferences, before initiating any substantive work with the expert.

### **WILL THE EXPERT SURVIVE DAUBERT?**

Once a patent litigant has identified the issues that require expert testimony, it must ensure that its chosen expert will be allowed to offer evidence. Rule 26 of the Federal Rules of Civil Procedure and Rule 702 of the Federal Rules of Evidence govern the use of expert testimony, and the Supreme Court laid out the four factors for applying these rules in *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579 (1993). Under *Daubert*, the trial court can, at its discretion, admit expert testimony if it: 1) can be tested; 2) has been subjected to peer review; 3) has understood levels of error; and 4) has attained general acceptance within the scientific community. Any type of expert including technical and damages experts can be prevented from testifying if their proposed testimony fails the *Daubert* analysis. See *MEMC Electronic Materials, Inc. v. Mitsubishi Materials Silicon Corp.*, 2007 WL 2728376 (Fed. Cir. Sept. 20, 2007) (an infringement expert could not testify because the tests performed on defendant's products could not be used to show infringement); *MicroStrategy Inc. v. Business Objects, S.A.*, 429 F.3d 1344 (Fed. Cir. 2005) (damages expert's testimony was not allowed because of incorrect financial analysis).

*Daubert* issues are a concern for both technical and damages experts, so litigants should keep these requirements in mind when considering a

potential expert in order to prepare for any challenges.

### **IS THE EXPERT QUALIFIED?**

The next issue litigants must examine is whether their prospective expert is qualified to give the opinions being offered. In patent cases, for infringement and validity experts this inquiry usually centers on the technical training and expertise of the potential expert. Litigants must ensure that their expert has both the necessary technical degree and practical experience to competently offer opinions on the subject matter at issue in the litigation.

Unfortunately, in many instances the required knowledge can be extremely narrow such that finding a competent expert is difficult. Many potential experts will be forthright regarding their experience level because if an expert overstates his or her expertise, a court may opine that the expert is unqualified, thereby limiting the expert's future credibility. Regardless, attorneys should be careful to verify the relevant experience prior to retaining the expert.

### **DOES THE EXPERT HAVE SKELETONS IN THE CLOSET?**

The competency concerns discussed above are only part of the background investigation litigants should undertake. Before retaining an expert, a litigant should investigate if there are any of the proverbial "skeletons" in the potential expert's "closet." The first place to look is in prior court decisions. Has a court struck the expert's testimony or otherwise found it of limited or marginal value? While this will not necessarily preclude an individual from serving as an expert, it does raise flags that are best discussed in advance.

Even if a court has not opined on the expert, anecdotal information from counsel who have worked with or against a particular testifying expert can often be helpful. Litigants are required pursuant to Fed. R. Civ. P. 26(a)(2)(B) to provide a list of any cases in which the expert has testified within the past four years. Care should be taken to follow up on these

prior engagements to determine the effectiveness of the expert. This practice will very often provide insight into whether an expert is easy or difficult to work with and makes the necessary time available; it also offers insight as to how the expert may perform when providing deposition or trial testimony. Needless to say, even though it may have no bearing on an expert's skills, prior issues that reflect on an expert's veracity can undermine an expert's credibility.

*Next month's installment will address knowing why you hired an expert, whether the expert will be persuasive with the finder of fact, and agreements on the scope of discovery.*



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*Last month's installment discussed the necessity of analyzing whether experts are required, allowed, and qualified; Daubert considerations; and issues pertaining to "skeletons in the closet." The conclusion of this series addresses knowing why you hire an expert, whether an expert will be persuasive with the finder of fact, and agreements on scope of discovery.*

#### KNOW WHY YOU HIRED THE EXPERT

Even before considering any particular expert, a litigant must determine why it is hiring an expert, *i.e.*, a litigant must decide exactly what role it expects the expert to fulfill. Experts can be either consulting experts or testifying experts, and their designation impacts the scope of their role, disclosure obligations, and associated discovery concerns. Testifying experts must be disclosed to the opposing party whereas consulting experts may be kept anonymous. This distinction also impacts discovery because under Fed. R. Civ. P. 26, discovery is allowed on all documents and things considered by the expert in formulating his or her opinions, while materials relating to consulting experts enjoy protection under the work product doctrine.

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Because of these different treatments, litigants must carefully consider how their expert will be used.

This becomes a problematic distinction when a litigant decides to use an expert in both the consulting and testifying roles. If an expert is involved in both roles then the boundaries on discovery protections are harder to maintain and can complicate the protection afforded information involving the expert. The *Schwab v. Phillip Morris USA, Inc.* case is illustrative of the problems of classifying expert materials when an expert is used in a dual role. 2006 WL 721368 (E.D.N.Y. March 20, 2006). *Schwab* illustrates how courts are more likely to allow discovery than to block it, especially if it is impossible to clearly compartmentalize which information is related to each of the expert's roles. In settling discovery disputes in these situations, courts will place the burden on the party that is fighting disclosure to show that the discovery sought was clearly within the consultancy role. If it is unclear that the information was solely used in a consultancy role, then courts will generally order disclosure.

These discovery issues highlight the risks associated with using experts in dual consultant and testifying roles. Before using any expert, litigants should set clear boundaries on the expert's role to avoid facing, and litigating, these discovery problems.

#### WILL THE EXPERT BE PERSUASIVE WITH THE FINDER OF FACT?

For testifying experts, the ultimate question is will the expert be persuasive with the finder of fact. In other words, when evaluating an expert, a litigant must not forget to consider how any potential expert would be received by a

jury. A highly qualified technician is rendered of limited worth if he or she appears nervous, unsure, or is unable to both clearly articulate his or her position and professionally address the opposition's cross-examination.

#### AGREEMENTS ON SCOPE OF DISCOVERY

A related concern in dealing with experts is whether parties agree to limit the discovery relating to testifying experts. Because the Federal Rules of Civil Procedure allow such extensive discovery relating to testifying experts, attorneys can be hindered in their dealing with their own experts and the resulting trial preparation. The most common embodiment of these types of agreements between parties usually forbids the discovery of communications between the attorneys and the testifying expert in addition to the work product relating to the expert's testimony. The bar allows freer communication between the lawyers and the expert and eliminates the risk of e-mails or other written communications unintentionally leading to a privilege waiver.

#### CONCLUSION

Litigants face numerous concerns when choosing experts. The above issues should be kept in mind before deciding to utilize a prospective expert and the role that expert will play.

