

By Paul D. Tripodi II

Using Experts in Patent Litigation

The success or failure of patent litigation can hinge upon the selection and use of experts

The outcome of patent litigation is often determined by the technical expertise of testifying experts and nontestifying consultants. As a result, selection and proper use of technical experts can cost either party its competitive advantage and, ultimately, its livelihood. Given this importance, it is quite surprising how little planning and consideration sometimes goes into the selection and retention of technical experts.

The Federal Rules of Civil Procedure distinguish between testifying experts and consultants. It is generally accepted that Rule 26 does not require the disclosure of the identity of consultants in response to an opponent's interrogatory and generally precludes discovery from such consultants, absent some showing of special need. As a practical matter in patent cases, however, disclosure of consultants is often necessary under the provisions of the applicable protective order so that a consultant may be given access to the adversary's confidential information. Nevertheless, the distinction between testifying expert and consultant remains important and may permit a party to prevent discovery from the consultant or at least delay any disclosure until a decision has been made that a consultant will testify as an expert. Practitioners should keep this distinction in mind when characterizing the relationship and obligations established in retainer agreements and in correspondence with the consultant.

Hire Early

Whenever possible, the patent owner should hire early, which generally means even before filing. That way, the plaintiff can ensure that its first choice of expert (who may be the only good choice in a given field) is available and under contract. Sometimes, a pre-filing inquiry may reveal complications in the expert's schedule—class assignments, forthcoming expiration of a noncompete agreement, or a sabbatical—that may influence the timing of suit.

Another reason to hire early is that some of the technical expert's most important work may take place prior to filing. For example, a thorough assessment of claim interpretation, likely validity challenges, and infringement can be more fruitful with the assistance of a consultant who has particularized knowledge and experience. Interaction with an informed expert may also provide the client and counsel with a theoretically impartial view of the case or bring complicating prior art to light before the litigation commences. In many cases, a technical consultant from outside the company may also have information about relationships within the relevant industry that may affect the client's decisions regarding who and where to sue.

The actual inventors of the patent-in-suit are often asked to serve as expert witnesses at trial. Thus, the patent owner should ensure that each inventor is either still employed by the patent owner or retained

as a consultant. Again, these arrangements should take place before filing. Otherwise the patentee may be surprised to find that the accused infringer has retained one or more of the inventors. Even if the inventors are still employees of the patent owner, it may be useful to establish agreements that will ensure their cooperation and availability in the event that they leave the company during the often-lengthy pendency of litigation. If the case is brought by a third party (such as an exclusive licensee), this may be particularly important.

For the defendant, one of the highest priorities following receipt of the complaint should be an identification of potential experts. Wherever possible, the accused infringer should seek to interview and, if appropriate, retain any of the former-employee inventors as consultants. In doing so, be aware that certain employment agreements may be broad enough to prohibit any potential consultant, including inventors, from using confidential information outside of their original employment relationship.

Selection Criteria

Of the many criteria that should be considered in the selection of an expert in litigation, a few patent-specific strategies deserve mention. For either party in patent litigation, it is often advantageous to have the inventor from the closest prior art patent as a consultant. For the plaintiff, prior inventors may be able to tell a convincing story about the tremendous advance facilitated by the patent-in-suit. For the defendant, earlier inventors may be able to minimize the value of the patentee's contribution to the art. Clearly, such prior inventors may be predisposed to offer one opinion over the other. It is counsel's job to determine the best way to utilize these prior inventors.

Given the life span of a patent, care should be taken to ensure that the expert is old enough to have been an expert at the time that the invention was made. Otherwise, opposing counsel may revel in making the jury aware that the proffered expert was in junior high school at the time of the invention.

In selecting an expert, counsel also should consider whether it is more likely at trial that a given expert will actually explain the technology or simply offer a highly qualified, but unintelligible, opinion. In the case of the former, it is often best to concentrate more on communication skills and less on credentials. Indeed, some commentators say that



Paul D. Tripodi II is a partner at Knobbe, Martens, Olson & Bear.

jurors forget the expert's qualifications after the first five minutes of his or her testimony. If you have any concerns, spend the day in a conference room with the potential expert and monitor his or her performance.

Never neglect due diligence. The last thing any lawyer wants is to discover that an expert has lied about his or her credentials, given prior inconsistent testimony in another case, or characterized the patent-in-suit differently in one of his or her patents. At a minimum, counsel should attempt to review any patents obtained by the potential expert and conduct an investigation into the accuracy of the information appearing on the expert's curriculum vitae. Counsel should also endeavor to perform a similar investigation concerning those items that will necessarily be disclosed under Rule 26, such as publications and testimony given in other litigation.

When the worst happens, do not assume that the case cannot be saved. Rule 26(e) explicitly contemplates such disasters, instructing that the parties are under a duty to remedy materially incomplete or incorrect information provided to the opposing side by an expert. If this becomes necessary, consider substitution of the designated testifying expert with an alternative. If you have anticipated this difficulty, you may even have a prospective expert waiting in the wings. If the withdrawn expert has not yet been deposed, it may be difficult for the opposing party to claim prejudice. Furthermore, in light of the objectives of Rule 26 in promoting fairness and preventing surprise at trial, this type of substitution may prevent your opponent from obtaining discovery from the withdrawn expert. Thus, you may find that what began as a bad situation can resolve itself into an acceptable one.

Since issues relating to testing methodology, errors, or disagreements may evolve over time, consider the use of more than one technical expert. If they are retained preemptively, they may also prevent your opponent from retaining the top experts in the field.

Finally, remember to honor the procedural distinction between consultant and expert. If the lawyer anticipates that a particular person is likely to be a testifying expert, care should be taken to limit disclosures to, and the documents or notes generated by, that person. Materials relating to early brainstorming, in particular, often prove to be menacing distractions once the case later coalesces around particular arguments and theories. A dearth of written materials, coupled with the limited capabilities of the human memory, can often eliminate case-damaging sideshows at depositions taken months or years later. ■

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