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Who Died? The Workhorse: The Patent Expert

by Charles W. Shifley
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"When you discover you are riding a dead horse, the best strategy is to dismount," Judge Thomas Penfield Jackson was quoted as saying in the February 18, 1999, Wall Street Journal. "But lawyers have other strategies including buying a stronger whip, changing riders...declaring that the horse is better, faster and cheaper dead, and finally, harnessing several dead horses speed."

While the reasons for the above words from Judge Jackson are unclear, it is clear they apply to lawyers and experts in many cases, including especially patent cases. Experts are the workhorses of patent cases. It has been said they are required to establish almost every claim and defense of a patent case. For unknown reasons, some lawyers kill their patent case experts and still try to ride their dead testimony to success.

Lawyers in patent cases perhaps kill experts most frequently by: hiring them at the eleventh hour, thus forcing them to testify without adequate preparation; failing to work with them when hired earlier, thus allowing them to testify although uninformed and ill-prepared; and cutting corners on rules of disclosure, through neglect and sometimes machination.

There are still other ways in which lawyers kill their experts. In the numerous patent trials handled by the author and his partners in the past few years, opposing lawyers have: failed to discover false credentials in their experts' resumes until too late; failed to discovery a recent felony conviction of an expert for a crime involving moral turpitude; tried to have experts present sophisticated analyses in federal court without having provided any expert reports in pretrial; tried to breeze by federal procedures with one-page letters substituted for expert reports; failed to seek leave to supplement, modify or replace the expert's report after an expert was destroyed during deposition, resulting in exclusion from trial of critical expert testimony; had technical experts testify contrary to generally accepted scientific principles; and frequently had experts testify directly contrary to their own past testimonies and publications.

The key to avoiding a Hobson's choice of riding the dead testimony your expert provides you into trial is proper preparation. Although preparing expert testimony is an arduous and often times expensive task, early preparation is essential in order to keep the testimony alive. Expert selection requires extraordinary time and attention to detail. Once selected, the expert must be given all relevant foundational facts, both helpful and harmful. Very importantly, expert reports must be labored over by the experts-who should write them-well in advance of the reports' submission dates. After an expert's report is completed, the Q & A of testimony must also be prepared thoroughly-and, the expert must be trained with witness skills.

None of this is getting easier. The U.S. Supreme Court recently ruled in Kuhmo Tire Co. v. Carmichael 119 S.Ct. 1167 (1999) that he gatekeeping function established in Daubert v. Merrel Dow Pharmaceuticals, Inc., 509 U.S. 579 (1993) applies to all experts, and that all judicial decisions to admit or exclude expert testimony are reviewed for abuse of discretion. According to some authors, a new avenue has been opened for judges to dismiss cases with prejudice, on standards lower than those for summary judgment. Rather than granting summary judgment in patent cases, where expert testimony is said to be critical to making or defeating the case, and in the specific cases where expert testimony is marginal, judges arguably may exclude the testimony as a matter of gatekeeping. Rather than being reviewed on a standard of whether a reasonable jury could have found for the nonmovant, with all inferences in favor of the nonmovant, judges may anticipate review by the court of appeals only for abuse of discretion. These lower standards for decision and review may well mean dismissal of more patent cases before trial.

Many regional circuit courts of appeals hold a strong view that if evidence is not included in pretrial expert reports, the evidence is to e excluded.
The U.S. Court of Appeals for the Seventh Circuit says exclusion is "automatic and mandatory." The Federal Circuit follows regional circuit law concerning rulings on evidence.

The lesson from the combined effects of Federal Rule of Civil Procedure 26(a)(3) (which already requires elaborate expert reports) and recent case law is evident. Early, thorough expert report preparation has now taken on heightened importance in the life or death of the patent expert because judges may resolve whether to allow expert testimony under Daubert and Kuhmo based on review of expert reports, without regard to what an expert might otherwise testify. Since every aspect of the proposed expert testimony is supposed to be contained in the expert report, courts might reason that judging the expert under Daubert and Kuhmo is appropriately done by judging the expert report, and the expert report alone.

If this comes to pass, patent claim interpretation hearings - commonly refered to as Markman hearings-may not remain the primary focus of patent case pretrial, even though the hearings have that status now. Shortly, courts may follow those Markman hearings that are favorable to patent owners with Daubert-Kuhmo hearings to assess the patent owners' proposed expert testimony. Patent owners caught unprepared for an early, detailed review of their infringement expert reports may find themselves out of court-their horses down-even after winning their Markman hearings.

Stronger whips, replacement riders, aggressive declarations, and multihorse harnesses will be useless in this new age. The workhorse, the patent case expert, will be already dead. Those lawyers who fail to recognize the new rules for riding and adapt to them will only discover their mounts down at a time when dismounting in favor of new, live horses will be impossible. Shrewder opponents will gallop to victory more than ever before.

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