# LITIGATORS CORNER:
# Deposing Experts

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In my last two columns, I wrote about expert reports: who should prepare them, and why you shouldn't be cute and rely on the exception in Rule 26. In the second of the two columns, I pointed out some ways our lawyers and others have improved expert reports so that they are an aid to the expert and meet the requirements of Rule 26 and Rule 702 for reliable data, reliable methods, and the reliable application of the methods to the data.

In this column, I will consider the depositions of experts. As an adversary, you already know what you want to do: show that the expert used unreliable data and unreliable methods, or that he failed to apply his methods in a reliable way. If you score on any one of these three area, you have sunk the Bismarck.

I "grew up" as a direct examiner by questioning potential criminal defendants in a grand jury. A surprising number of them wanted to talk, particularly the con artists, even after being advised of their rights. Because of the high burden of proof, we had to explore and rebut every possible excuse and every possible defense.

That is what you want to do with an expert. I don't believe very much in the approach many civil litigators use, which is to trick a witness into using good "sound bites." First, I have never been very good at doing this. Second, it won't work with any expert who isn't an idiot. Instead, you want to nail down every nook and cranny of the expert's testimony. Challenge him. Ask him what he thinks. Force him to say that his reports are complete, and to express all of his thinking, at least to date. He is going to testify at trial anyway, so you needn't worry about being unable to deal with what he says at trial. Instead, you want to know all that he is going to say, so that you can freeze his thinking and the deficiencies in his analysis. The more you freeze the details of his testimony in a deposition, the less room he will have later to weasel, either in supplemental or rebuttal reports, or in declarations that might be used to support a summary judgment motion, or in an opposition to a motion. I mentioned this point in my last column about the expert who had no basis for the capacity element of his party's lost profits claim.

Is the expert really an expert? Find out. I don't mean that you should plod through the expert's background the way some questioners do at a deposition. But you have the raw material in the expert's report. Read it. I ran across a real estate broker a few years ago whose resume reflected attendance at some prestigious schools. A few calls revealed that he had never gone to those schools; his resume was phony. The two sides of the case were arguing about who owed who a commission for the sale of industrial real estate. I concluded the broker had lied to both sides. The case settled.

It would be rare, I agree, to catch an expert in this kind of deception, but we have now seen several instances of prominent persons who have inflated or created credentials they don't have. When possible, you do want to establish that the expert has no first-hand experience with the subject matter of his testimony. Ask your expert for permission to call all his references, and his schools, etc. Make him agree, or make him refuse, on the record.

I don't know about you, but it doesn't seem fair for a jury to rely on documents and testimony to evaluate the expertise of a witness when neither you nor the jurors can see the testimony and documents because they are covered by a protective order in another case. You may want to ask the expert about his testimony. If he declines to describe it on the basis of confidentiality — which may be perfectly legitimate — at least you have laid the basis for a later motion to exclude this evidence of his expertise.

Did the expert omit key data, or fail to record it? I have seen experts who get their information from the party's attorneys, or from the party's employees, without in any way recording the data they have received. If the expert is giving an opinion about obviousness, did he address whether the art was cumulative (the example I gave last month), and did he or another expert address secondary considerations? Did the expert speak to anyone of skill in the art to determine what the patents show, or whether there is any suggestion that they be combined? If he is a damages expert, who did he talk to and what did he look at to reach a conclusion of adequate capacity or the amount of lost profits?

In a lawsuit I wrote about a couple of years ago, the technical expert opined that the trade secrets only implicated a tiny portion of the radios in which they were incorporated. The damages expert relied on the technical expert and opined that the value of the trade secrets was two percent of the price of the radio. He had no support for this statement. The components embodying the trade secrets were essential to the radio's operation, and had never been sold separately as kits or upgrades. His opinion relied on defective data, and was excluded, along with the underlying expert.

Ask the expert for his notes of his conversations with his client's attorneys, inventors, and employees. Make him admit that there are no notes, if that is the case. Many experts and attorneys are so paranoid that they will refuse to tell you what they have. But by doing this, they are setting themselves up for a motion to exclude the opinion.

What were the expert's methods? Explore them. For example, in one of our cases a few years ago, our damages expert used interviews of our client's employees to determine how costs and prices would vary with increases in production. He wanted to determine the increase in our client's gross margin under a lost profits theory, where our client was also asserting that its prices had been depressed by the infringement. By interviewing a number of individuals, the expert identified those costs that were fixed, those costs which varied with production, and the higher prices that could have been charged in the absence of infringement. The increased profits lost to the infringer's activity could then be calculated.

Our judge didn't like the interview technique. Instead, as a former economist, he preferred a regression analysis, a mathematical technique that derives an equation from a set of gathered data, so that the equation can be used to calculate results where no data are available. Using the equation, one can estimate the missing sales, and take into account how much the price could be raised without stifling demand for the patented product. As a result, the damages were not as high as we had hoped. This is an example of a complicated scientific technique that must meet the standards of the *Daubert* and *Kumho* cases I mentioned in my earlier column. You must prepare thoroughly in order to find out whether this technique, or other techniques, are accepted for such use and whether the technique used was carried out in a manner which ensures its accuracy. That is a difficult task.

Ask the validity expert if he did any search of his own for prior art, or if he considered those parts of the references that teach away from the invention. Another example of an unreliable technical method (or perhaps the unreliable application of the standard of obviousness) is the use of hindsight by an expert who says that the invention is obvious. What does this expert start with? Most experts start by speaking to the infringer's attorneys, who have thoughtfully gathered for them the selection of prior art they are using to invalidate the patent. Here is what one court had to say about such an expert:

> Its technical witness . . . is not an expert in either kidney disease or catheter design. . . . He explicitly followed the forbidden strategy of decomposing the patented device into elements and seeing whether he could find them in some other catheter. [He] added that he thought it obvious how to reassemble them to get the [patented invention].

Then such experts don't pay attention to secondary considerations, or refer to anyone who addresses evidence of commercial success. A successful cross-examination can lead directly to the exclusion of the expert's opinion as unreliable.

You can explore the expert's thinking by varying the hypothetical, too.

Here is an example:

> Here's my question. Let's suppose that it was the inventor's honest belief that what was described in these letters was worse than useless; that it was positively disadvantageous for use in the [invention]. If that is correct, then can [the inventor] have had an intent to mislead the Patent Office with respect to the material in these letters?

The witness tried to evade, and I gave him some room to waffle because my question was too long. I should have approached it in pieces; nevertheless, the evasion still gave me some of what I was looking for: an admission that, if the jury believed our inventor, then there was no inequitable conduct, even according to the infringer's expert.

A better chain of questions might have been like this:

**Q** I want you to assume that the inventor saw these letters. Will you assume that for now?

**A** Okay.

**Q** I want you to assume, second, that he read these letters carefully. Will you assume that for now?

**A** Okay.

**Q** Finally, I want you to assume that he believed that these letters did not show his invention. Will you assume that?

**A** Okay.

**Q** Last, you know that the letters were never sent to the Patent Office, right?

**A** Correct.

**Q** If those three assumptions are true, then the inventor cannot have deceived the Patent Office, right?

**A** Argue, argue, argue, etc.

Write the assumptions down, if the witness professes that he can't remember them. Mark the assumptions as an exhibit and put the exhibit in front of the witness. If he claims not to have enough information, add the assumptions to the list. Sooner or later, he will agree with you. The end result is to get the expert to agree with your argument, assuming the facts are as you present them to the jury.

These are just a few ideas. What you will actually do depends on the kind of expert, the issues in your case, and how well prepared your adversary is. But you won't go wrong if you organize your examination of the expert around the reliability of his data, the reliability of his methods, and the reasonable application of his methods to the data. If you pin him down, and can show that the expert's work is incomplete or unreliable, you have eliminated, or at least reduced the possibility of, surprises at trial, and created an opportunity to exclude the expert. IPT