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LITIGATORS CORNER: Use Your Client



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Patent lawsuits are swamps. No wonder they make judges, lawyers and jurors squirm. There are too many facts, and too many legal principles to deal with: claim construction, infringement, validity, literal infringement, infringement under the doctrine of equivalents, after-arising equivalents, enablement, written description, best mode, prior use, sale or publication, the meaning of every word used in the file history, the intent of the inventor and the prosecuting attorney, reasonable royalties, gross margins. The list goes on.

In a column last August (*Be Cheap: A Crucial Secret to Successful Contingent Fee Litigation*), I wrote about how to get through the swamp without spending a fortune: use contingent fee agreements to eliminate the hourly expense, and observe every cost-cutting measure you can to reduce disbursements. The ways I listed to reduce costs were numerous: minimize the number of depositions; shorten each deposition; attend depositions by telephone; skip depositions of the other side's experts; don't videotape depositions; avoid expensive experts; minimize use of on-line research services; and make the best use of your client's time and talent.

Your client is your most valuable resource in any case, and much more so in a contingent fee case. If you have an unhelpful client, the suit has very little chance of success. An enthusiastic and involved client is the key to winning, or at least to obtaining a good settlement. The right kind of client can support you in a number of ways, while the wrong client can torpedo you. In this column, I will go into more detail on one of the ways a client can assist you: as an expert.

We often recoil from the prospect of using the client as an expert. After all, the reason experts are used in many instances is because they are, to put it bluntly, mouthpieces for the lawyers. The expert is a professional; he will shoot anyone his boss wants, like Ike Clanton at the OK Corral, firing off canned opinions like bullets from his Colt. We fear that the client will say something that dooms the case, because he is too inexperienced to realize how his answer might be mis-construed by the adversary. We tell ourselves it just isn't

safe to use anyone other than "a professional," and so we go for the biggest name we can afford. Too bad.

But in these days of claim construction hearings, plaintiff-inventors are testifying as much as they ever did. Every word the inventor says is going to be construed or mis-construed by the adversary anyway, so why not make the most of it by using him or her as an expert? There are a number of good reasons to do so. First and most practically, you avoid the very high cost of a technical expert. Second, you don't have a phony as a witness, which is what too many hired experts are. Instead, your expert witness is a real inventor, someone who labored in the vineyard, not some professional "wine-sniffer" whose credibility suffers when the jury finds out how much he is getting paid, or whose lack of experience in the field of the invention makes him appear to be a technological second-guesser, opining that someone else's toil was trivial and easy. Studies of juries indicate that they resolve disputes between witnesses, including experts, based upon which witness they find more credible. In other words, using an over-paid blow-hard is likely to hurt, not help, you. Your client must learn the case anyway. You might as well get the best bang for your buck.

In my April, 2004 column, *Preparing the Inventor for Deposition, Part 3*, I described how one of our clients was helped in his deposition by having a book about his patent, which had more than fifty claims and three groups of accused products. Now carry that thought a step further. A plaintiff who serves as an expert is entitled, and probably required, to have an expert report. A good report can be a significant testimonial aid, just like the book our client spent weeks preparing.

When the plaintiff is an expert, the question that arises is whether a written expert report is necessary. You could rely on Rule 26(a)(2)(B), which says that an expert report is not required from someone who has not "been retained or specially employed to provide expert testimony in the case" and is not a person "whose duties as an employee of the party regularly involve giving expert testimony." Plaintiff-inventors who sue for infringement have not been hired just to give expert testimony. You might believe it is an advantage to use an expert who does not have to give a written report. His opinions will not be known until he testifies.

But there are two reasons not to do this. The Rule also says that the Court can direct the parties to vary from the requirements of Rule 26(a)(2)(B); my observation is that some, perhaps many, judges feel it is unfair to have expert testimony without a written

report from the expert. Courts have gone both ways on this issue. See, for example, *Duluth Lighthouse for the Blind v. C.G. Bretting Mfg. Co.*, 2000 U.S. Dist. LEXIS 19863 (D. Minn. October 12, 2000) or *Navaho Nation v. Norris*, 189 F.R.D. 610 (E.D. Wa. 1999). Neither required an expert report. That is a reasonable reaction. Other courts have disagreed. In one of our cases in Ohio, our judge told us that no expert would ever testify in her courtroom without a report.

Second, not doing a report hurts you and your case in a very important way: you and the plaintiff-expert are deprived of the dual benefits of producing the report, and then of being able to rely on it when the expert is testifying. For both of these reasons, your plaintiff-expert should have a report.

Remember I said that patent suits are swamps. So, even if you use your client as an expert, don't forget that there are patches of quicksand along the way. Let me tell you about two of them. In one of our recent cases, we used the plaintiff-inventor as an expert. He was quite knowledgeable about his patent, and about how it was infringed. Much or most of the information about infringement was public. The plaintiff prepared an expert report with our help and submitted it.

The adversary's attorneys had a clever idea. They argued that the plaintiff had to produce everything he had ever looked at concerning his patent. After all, they argued, a party had the obligation to produce anything an expert had relied on, looked at, or considered in the course of preparing his opinion. Since our client had applied for a patent and participated in the prosecution, those were matters that he had in mind when he prepared his opinion. Because he had communicated with his prosecuting attorney and his litigation attorneys, those too were things he had in mind when he prepared his expert opinion. Our opponent argued that all of this material had to be disclosed and that our client, by functioning as an expert, had waived his attorney-client privilege.

We responded that the defendant had gone too far. Because Rule 701 barred lay testimony "based on scientific, technical or other specialized knowledge," it was much more likely that an inventor might have to file an expert report in order to testify about his invention. Before the 2000 amendments to Federal Rule of Evidence 701, inventors offered opinions in the form of lay opinions. Those opinions were based on the inventor's status as an actor and percipient witness. But with the 2000 amendments, scientific and technical opinions must now filter through Rule 26(a)(2). Designating

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an inventor as an expert under Rule 26 became necessary to enable an inventor to provide scientific or technical opinions about his invention at trial.

That amendment could not mean, however, that an inventor would entirely waive his attorney-client privilege. We argued for a different outcome: only those materials used, considered, relied on or reviewed by the expert in connection with preparing his report and testimony were legitimately discoverable. We found support in a CAFC decision, *In re Pioneer Hi-Bred Int'l Inc.*, 238 F.3d 1370 (Fed. Cir. 2001), where the Federal Circuit considered the scope of a waiver for a Rule 26 expert. It held that "documents and information disclosed to a testifying expert in connection with his testimony are discoverable by the opposing party, whether or not the expert relies on the documents and information in preparing his report."

"In connection with his testimony" was the key. Our judge was concerned that "somebody who's an inventor must disclose everything that he's ever considered in connection with the patent simply because he's being called as an expert." The judge agreed with us that the defendant was asking for too much. Nor would the court accept the defendant's argument that

changes by our client in his views of claim construction would bear on his credibility. Our court said the jury would not hear if our client had changed his claim construction, that it was tangential and confusing, and did not go to credibility. Cross-examination on that subject would not be permitted. That strikes me as a reasonable guideline, given the high error rate in claim constructions. The scope of the waiver was limited to documents "considered in preparation for testimony" and did not extend to every document ever seen by our client.

As you can see, using the inventor as an expert is not free of risk. The case law is not clear-cut. Our client's expert report was limited to infringement, which meant that privileged communications about other subjects, like invalidity, were not at risk of disclosure. Nevertheless, it is a strategy you should consider. Your expert will be knowledgeable, prepared, and interested in doing well. As an inventor, he is going to be grilled anyway. He might as well be ready.

There is another aspect to using the client as an expert, and it deals with how to handle confidential information. I will discuss that in a future column. 