

LITIGATORS CORNER: A Different Kind of Expert Witness



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Patent cases are full of experts; perhaps too full. It's true that patent infringement suits abound with issues that ordinary jurors and judges do not confront every day. These include technical questions about infringement, either literally or under the doctrine of equivalents; Patent Office practice or procedure; and so forth. Then there are the financial questions, such as reasonable royalties, calculation of damages using incremental income theories and price erosion, market definitions and share, capacity, pre- and post-judgment interest, and the like. There are all kinds of technical experts, legal experts, economists, accounting experts, and more.

But there is another kind of expert witness, although this person is not often thought of as an expert witness, whose use should definitely be considered by the defense in patent infringement cases. This witness is a lawyer (not the lawyer who is

trying the case) who will give the defendant an opinion that the patent that has been asserted against the defendant isn't valid, or isn't infringed, or is unenforceable because of inequitable conduct. Such an opinion, if properly rendered, protects the defendant against being found liable for willful infringement. In other words, even if the client is found to infringe, there will be no treble damages, because the client obtained an opinion of non-infringement. Properly prepared, such a witness gives your client a powerful weapon at trial. Instead of just arguing about infringement, this witness will testify early on under oath that there is no infringement or that the patent is invalid, or both. He or she can discuss the underlying facts at length, as well as draw conclusions and reach opinions about those facts, even embracing ultimate conclusions and therefore invading the province of the jury. Indeed, such a witness has considerable potential.

Most defendants accused of infringement, however, do not effectively use such a witness and are, instead, prone to seek bifurcation of a determination of willfulness, so that this question is reached only after — and only if — a jury has found there is infringement. At such a late point, a jury may well be inclined to disbelieve such a witness. I suggest that the traditional strategy is the wrong strategy. In some cases, where a defendant has a solid opinion, and a good witness to testify about that opinion, reason suggests that such an expert witness should testify in the main part of the case.

You will not have the option to present this witness without laying the foundation. So, the process should begin much earlier, and there are a number of things to do before such a witness is ready to testify. First, the defendant who wishes to have an opinion of non-infringement or invalidity must seek out a competent attorney, who will also make a good witness, since he or she may well be deposed, and is likely to wind up on the witness stand.

Once a good lawyer/expert witness has been located, the next step is to insure a full disclosure of the relevant facts. You cannot hold back; keeping important facts

from your lawyer/expert may explode in your face at trial. So give him all the facts, including the details of the accusation of infringement, the patent, its file history, any communications between the patent owner and the defendant, the design of the accused products, their commercial success, and how these products came to be. Equally important is the defendant's knowledge (or lack thereof) of the plaintiff's patent or patented products: was there any copying? If so, was the product copied known to be covered by an existing patent?

You get my point. The gathering of relevant information must be thorough, and its gathering must be documented in some way. At trial, you, as the attorney for the defendant, will have to be able to prove that your client did a more-than-adequate job of collecting information for the attorney who is rendering the opinion. Your attorney/expert, in order to defend his positions of non-infringement or invalidity, has to be armed with all relevant information.

But getting a full disclosure to the attorney isn't all that's important. Once that attorney has formed his or her written opinion, it must be communicated to your client in writing. Oral opinions are not worth much.

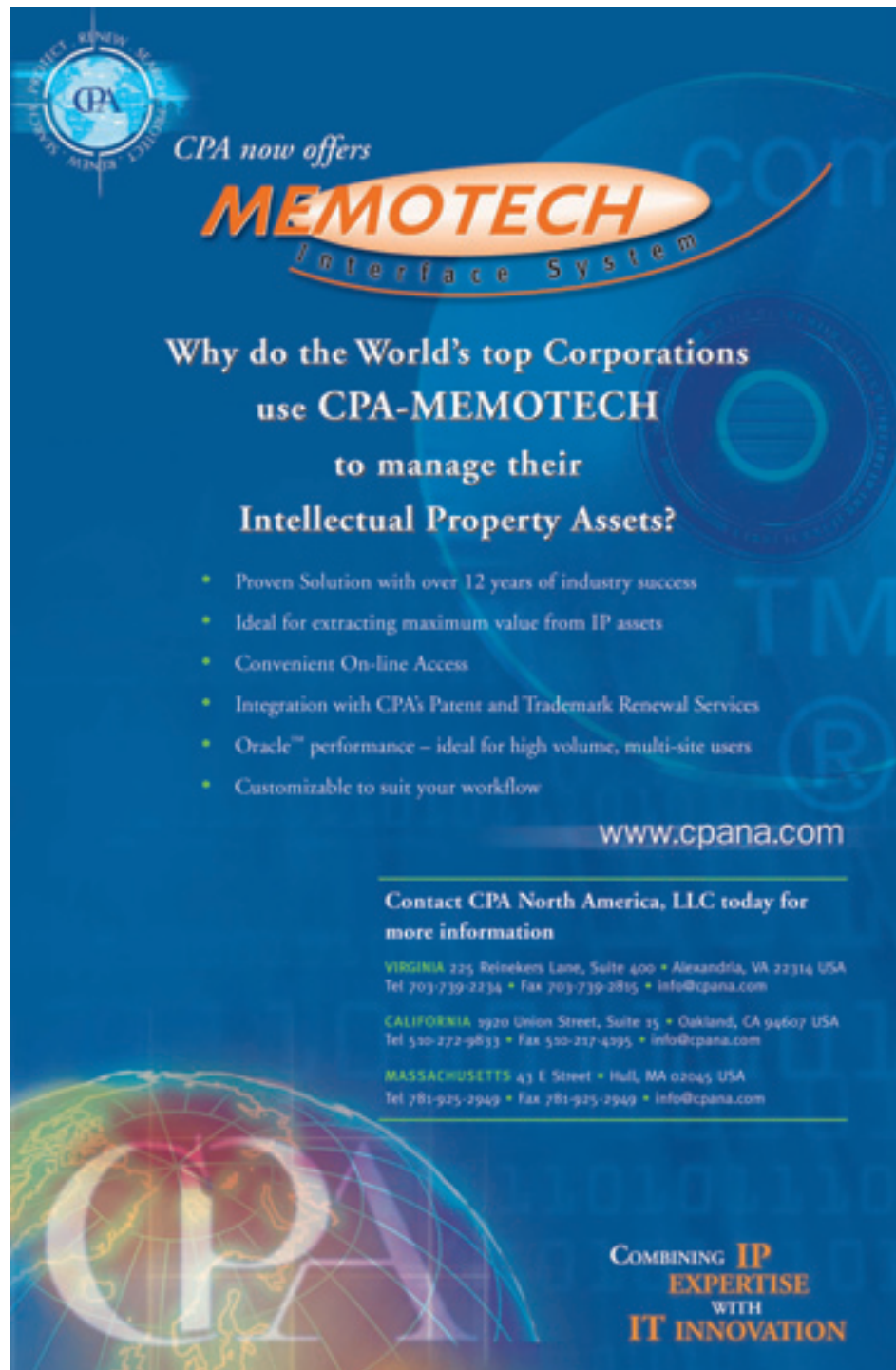
Finally, and most important, your client must do its best to follow the attorney/expert witness's advice. Then you will have to prove at trial that the defendant did its best to carry out the instructions provided by the opinion. The opinion has to be communicated to those who will insure it is carried out — for example, the persons responsible for the design of your client's products. They need to know why the products don't infringe so that they can avoid trouble.

A real problem follows here, if the process leading to the ultimate opinion is performed sloppily. This disclosure of an opinion involves a partial waiver of the attorney-client privilege. Thus, more than just the expert/lawyer's opinion will have to be disclosed. Nearly all cases hold that the waiver covers the normally privileged and confidential communications between the attorney and client that touch on the same subject matter. However, some courts have gone further, and have held that anything reviewed by the attorney, even if not communicated to the client or sent by the client to the lawyer, must also be disclosed. In one of our cases, the court required the disclosure of memos and notes exchanged between lawyers working on the opinion without any showing that (1) these matters had been revealed at any time to the client,

or (2) received from the client. Quite clearly, in these instances, the client did not — and could not — rely on what it could not see, yet some cases require production. The disclosure is required by this line of cases, even if the memos or notes do not in any way undermine the opinion given.

You must therefore plan for the possibility of broad production. The over-arching principle is to write everything as though a judge or juror will read it later on. A corollary is that the creation of haphazard scraps of notes and the like is a bad idea. In one of our cases where we prepared an opinion and were also the trial counsel, we had a lively exchange of views about infringement and what advice was best for our client. Not giving it sufficient thought, we put all these scribbles away in files, and correctly gave our client only the end result of all our thinking. Then we were subpoenaed, and wound up having to produce evidence of an honest internal debate. The plaintiff, of course, did its best to color these events in such a way as to depict us as not truly believing in the advice we had given our client. That unfair depiction could have spilled over and tainted a fact-finder's view of our client, too. Fortunately, we prevailed on a summary judgment motion of non-infringement. No jury trial was necessary.

It is often best to use an attorney/expert from another firm to provide an opinion, if you are the trial counsel. There is no universal case law prohibition against having someone in your firm rendering the opinion, although you should check the rules of conduct for your jurisdiction. Some will argue that, even if the opinion author is not one of the trial counsel, the whole firm should be excluded from representing the defendant at trial. In the case I mentioned above, we had written the opinion of non-infringement. So far so good. The lawyers in our firm trying the case were advancing the same position taken by the author of the opinion. However, once our firm had to produce the evidence of our internal debate before reaching our legal conclusions, it became much more difficult for us to continue as trial counsel. Imagine it. One of our firm's lawyers would be on the stand testifying that the patent was not infringed. He would be cross-examined by the plaintiff's attorney, who would be using the notes of another of our firm's lawyers — notes which revealed a point of view challenging the one adopted by the author of the opinion. Two lawyers from the same firm would have been expressing conflicting views. We

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rightly decided to get another lawyer from a different firm to try the case.

So long as you follow the ground rules, a defendant can develop a powerful witness on its behalf at the same time it is carrying out its duty of respect for the patent rights of the plaintiff. The ground rules are simple: Find a good lawyer who can also be a good witness. Give that lawyer a full and honest disclosure of factual information. Communicate knowing that all the communications between your client and the opinion writer, as well as, perhaps, the opinion

writer's internal communications, will be produced. Have a solid written opinion. Communicate that opinion to those who need to know; then insure the opinion is followed. Finally, consider whether it is really worthwhile to seek bifurcation of the issue of willfulness. If you can present your opinion witness in the main part of the case, this testimony about facts, about the law, and about a good faith belief in non-infringement could be quite powerful. This opinion witness could be the best expert witness of all for your client. **IPT**