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intellectual property

Expert Evidence in Intellectual Property Matters

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IP Disputes

➔ IP disputes sometimes described as “contests between experts”



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Typical Issues in Dispute in IP Matters

Patent Cases:

- Relevance of the prior art
- Construction of the claims
- Comparison between the allegedly infringing product and the claims
- Experiments
- Questions of law
- Typically not factual issues such as the nature of the allegedly infringing product (some exceptions e.g. entitlement issues)



Typical Issues in Dispute in IP Matters

Trade Mark Cases:

- Whether marks are deceptively similar
- Whether goods or services are closely related
- Typically not factual issues such as the identity of the allegedly infringing mark



The Place of Expert Evidence

- Opinions of properly qualified experts are admissible as evidence
- Expert evidence cannot supplant the function of a tribunal or court
- Generally role of the expert is to assist the tribunal or court – not an advocate for a party
- Court can appoint expert



Strategic advantage held by IP owner

- Interview prospective experts before issuing proceedings or placing infringer on notice
- Settle strategy early
- In some fields, only limited number of experts available

Selection of Expert

- Relevant expertise
- Good communicator and educator
- No actual or perceived bias
- Agrees with your position and understand the legal issues
- Has available time
- Retirees, consultants, universities

Relevant Expertise

- Sufficient to avoid standard rule of evidence on opinions
- Not necessarily a person having up to date expertise
- Special knowledge beyond that of the average person
- Experts can be over qualified

General Tire & Rubber Company v Firestone Tyre & Rubber Company Limited [1972] RPC 457

- Consider relevant legal principles – does the expert have appropriate expertise for the issue at hand and did she or he have that expertise at the relevant time and in the relevant place?
- Using multiple experts

Communicator & Educator

- Expert should be persuasive, collected and articulate
- Assist your understanding as well as the Courts
- Should not appear to be an advocate for one party's cause
- Examples:

the evidence of Professor Phillips in *Meyers Taylor Pty Ltd v Vicarr Industries Ltd* (1977) 137 CLR 228

the evidence of Dr Beaton in *Red Bull Australia Pty Ltd v Sydneywide Distributors Pty Ltd* 53 IPR 481

Communicator & Educator (cont)

Packaging & Labels in Red Bull Case:



Communicator & Educator (cont)

- Familiarisation with court environment
- Challenge evidence
- Cannot coach

Actual or Perceived Bias

- Preferably not employed by one of the parties
- Preferably no personal or financial interest in the outcome
- Preferably not a professional witness
- Preferably not the inventor
- No other possible conflict of interest
- Directly enquire with proposed expert witness

Supports Your Overall Position

- Expert witness can generally be examined on any issue
- Even if the expert is to be used on one issue, ensure that he does not disagree with the client's position on other important matters
- Ensure no published papers or statements from the proposed expert are inconsistent with your client's case
- Expert must understand the legal framework

Agreement with Expert Witness

- Confidentiality
- Not to act for any other party to the proceedings
- Remuneration
- Return of documents

Traps and Special Issues

Privilege and Waiver

- Confidential communications between lawyers and experts generally privileged or confidential
- Communications between patent attorneys and experts are often not privileged, e.g. Canada and Australia
- Service of evidence and implied waiver
- Implied waiver can result in the forcible disclosure of instructions provided to the expert, copies of all reports, opinions and other information provided by the expert to the adviser, drafts of expert's affidavit provided to the expert by the adviser and file notes of discussions with the expert made by the adviser
Warner Lambert v Cardinal Health Inc (2006) APO 14
- Consider using an additional expert that will not give evidence



Inventive Step Evidence

- Problems of hindsight
- Showing the expert the patent
- *3M v Tyco* 56 IPR 248
- Alternative approaches
- Be prepared to start again with a new witness

Survey Evidence

→ Admissibility – hearsay

→ *Sun Life Insurance Co Canada v Sunlife Juice Limited* (1988) 22
SPR (3d) 244

→ Construction of survey

Ritz Hotel Limited v Charles of the Ritz Limited (1998) 15 NSW
LR 158

Mothercare UK Limited v Penguin Books Limited [1998] RPC 113

Avoid the “unnatural question in an unnatural surrounding”



Survey Evidence (cont)

Some Guiding Principles

- the interviewees should be a representative cross-section of the relevant purchasing public;
- sample size must be large enough to be of relevance;
- there needs to be full disclosure of how many surveys were carried out, how they were conducted, and how many people were involved;
- leading questions must not be posed;
- desirably, there should be a combination of open-ended and closed questions;
- the full answers given by the interviewees should be recorded;
- wherever possible, you should avoid hypothetical circumstances remote from the actual consumer environment;
- disclosure of the company (your client) commissioning the survey should not be made to interviewees.

“Hot Tubbing” of Experts

- Experts presenting evidence at the same time in panel format
- Experts questioning experts
- Areas of real dispute quickly identified
- Advisers lose some control

Court Guidelines

Federal Court Guidelines in Australia

- the expert witness has an overriding duty to assist the court;
- the expert witness is not an advocate for a party;
- a report from an expert should identify and state the qualifications of the person and any tests or experiments carried out upon which the expert relied in compiling the report;
- an expert's report should declare that the expert has made all enquiries he or she believed to be desirable and appropriate, and that no matters of significance that the expert regards as relevant have been withheld from the court; and
- there should be included in or attached to an expert's report a statement of the questions or issues that the expert was asked to address, the factual premises upon which the report proceeds, and the documents or other materials that the expert has been instructed to consider.

Checklist

- The proposed expert has expertise to address the relevant issues
- No conflict or bias issues
- No earlier conflicting statements
- Agrees to confidentiality arrangements
- The proposed expert agrees with your client's position on all relevant matters
- The proposed expert is a good educator
- The proposed expert has sufficient time to assist
- You have considered whether multiple experts required
- You have considered non-testifying expert assistance

Final Comments

- ❖ A good expert witness in the context of an IP matter is someone who understands the technical issues and can apply his or her expertise in a constructive way to the questions of law that are relevant to the matter at hand
- ❖ *“An expert is an ordinary fellow from another town”* – Mark Twain