Expert Witnesses in IP Proceedings

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Conflict Resolution

- Disputes about facts, and the inferences to be drawn from them
- Disputes about the interpretation of documents, including patents
- Disputes about the applicable law
- Disputes about science

The Adversarial System

- Used in most common-law jurisdictions.
- Based on the assumption that "the mutually contentious strivings of relatively equal advocates will make truth and justice apparent" to the finder of fact.
- Witnesses give evidence:
  - As Lay Witnesses with firsthand knowledge of a fact,

  or
  - As Expert Witnesses with specialized knowledge, skill or experience,

  but,
  - Expert Witnesses are not required to have firsthand knowledge of the facts which form the basis of their opinions.

Conflict Between Law and Science

- ⇨ Both appear to rely on "evidence", expertise and testing in the search for reliability.
- ⇨ Conclusions based on accumulated evidence through logic, deduction and induction.
- ⇨ Science encourages a multitude of competing hypotheses on any one issue.
- ⇨ The law is required to resolve disputes quickly, efficiently, and finally, on the basis of the best available evidence.

Adversarial System Problems

- Judges and lawyers assume that the truth comes out when contending parties state their own (one-sided) point of view simply, forcefully and with the least amount of nuance possible.
- The judge must extract the facts from conflicting and overstated evidence, and apply the law to those facts.
- Court with little scientific training may not have sufficient knowledge to draw the proper inferences from the evidence.

Adversarial System Problems

- Court may not hear opinions from the most qualified experts, only from:
  - those favorable to their respective parties, or
  - from partisan "hired guns".
- Case result may depend more on the self-confidence than on the professional competence of the expert.
- Courts are asked to resolve science-based disputes that science itself has not resolved.

Daubert – U.S. Supreme Court

- “There are important differences between the quest for truth in the courtroom and the quest for truth in the laboratory. Scientific conclusions are subject to perpetual revision. Law, on the other hand, must resolve disputes finally and quickly.... “
- “We recognize that, in practice, a gatekeeping role for the judge, no matter how flexible, inevitably on occasion will prevent the jury from learning of authentic insights and innovations. “
- “[T]he Rules of Evidence [are] designed not for the exhaustive search for cosmic understanding but for the particularized resolution of legal disputes.”

The Frustration of Judges

- Justice Frank Muldoon, Trial Division of the Federal Court of Canada expressed his frustration with the task of assessing expert evidence as follows:
  - *A judge unschooled in the arcane subject is at difficulty to know which of the disparate, solemnly-mouthed and hotly contended scientific verities is, or are, plausible. Is the eminent scientist expert with the shifty eyes and poor demeanour the one whose "scientific verities" are not credible? Cross-examination is said to be the great engine for getting at the truth, but when the unschooled judge cannot perceive the truth, if he or she ever hears it, among all the chemical and other scientific baffle-gab, is it not a solemn exercise in silliness?*

The Frustration of Witnesses

- Experts share these frustrations:
  - "There is no opportunity to explain evidence or interpretation oneself, no assurance that counsel will explain it clearly or in a sophisticated fashion, and no opportunity to correct errors or crudities which creep in.“
  - "There is no guarantee that counsel will even understand the arguments the expert has made, and consequently no guarantee that questions which may be posed by the judges will be correctly or clearly answered.“
  - "The expert witness is almost entirely at the mercy of counsel on both sides. The expert must depend on counsel to present his or her views fairly and forcefully... [Scientists] do not get an opportunity to defend themselves against misquotation or selective quotation by opposing counsel."

Origins of Expert Evidence Rule

- Allows "expert witnesses" to provide the trier of fact with the necessary technical or scientific basis upon which to properly assess the evidence presented.
- Conceived as a means of assisting jurors in the understanding of complex scientific or technical issues.
- Permitted only in cases where the subject matter in question was beyond the capabilities of inexperienced persons who could not form a correct judgment without such assistance.
  - Folkes v. Chadd (1782), 3 Doug. K.B. 157, 99 ER 589 (KB);
  - Beckwith v. Sydebotham (1807), 1 Camp. 116, 170 ER 897 (KB)

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Independent Assistance

- The expert witness :
  - provides independent assistance to the court ,
  - should not assume the role of an advocate.
- An expert:
  - should state the facts or assumptions upon which his or her opinion is based; and
  - should not omit to consider material facts which weaken his or her opinion.
    - *The "Ikarian Reefer", [1993] 2 LLR 69, at 81-82(Q.B.(Com.Ct.)), revd [1995] 1 LLR 445, at 496-98 (C.A.)*

Is it Helpful?

- Judge who does not have the technical education to resolve conflicts in science must determine which expert evidence to accept without independent criteria to evaluate the differing opinions.
- May create a false impression of scientific controversy.
- This may lead to prospect of uncritical acceptance of an expert opinion by the trier of fact, especially:
  - if the scientific theory cannot be explained clearly;
  - if there is no realistic opportunity of an opposing party conducting independent tests or calling experts in reply; or
  - if the evidence could be presented in less conclusive or inflammatory terms than proposed.

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Expert Evidence in Patent Cases

- Explain what the patent and words used in it mean to a person skilled in the art.
  - Only the trial judge and not an expert is permitted to explain or construe the claims of the patent.
- Explain the prior art at the relevant date and its significance
  - “the state of the art”, and “common general knowledge” at the relevant time .

Expert Evidence in Patent Cases (cont'd)

- ⇨ Explain whether the disclosure sufficiently describes the invention.
- ⇨ Examine the clarity and breadth of the claims, and the utility of the invention claimed.
- ⇨ Provide evidence relating to inventiveness.

Admissibility - Necessity

- An expert provides a ready-made inference from proven facts when the technical or scientific nature of the subject matter is likely to be beyond the fact-finder's knowledge or experience.
- Expert opinion evidence is admissible when the fact finder is unable to draw an inference or to form a proper conclusion without the assistance of experts.
  - "An expert's opinion is admissible to furnish the Court with scientific information which is likely to be outside the experience and knowledge of a judge or jury. If on the proven facts a judge or jury can form their own conclusions without help, then the opinion of the expert is unnecessary".

    R. v. Abbey, [1982] 2 SCR 24, [1982] SCJ No. 59 at 42 (Dickson J.) (SCC)

Admissibility - Relevance

- The evidence must be relevant to an issue in the case. It must be material and have probative value.
- Materiality: The evidence must be tendered to prove the existence of a fact or matter in issue.
- Probative Value: The evidence must make the existence or non-existence of a material fact more probable or less probable than it would be without the evidence.

Admissibility - Reliability

- The trial judge must determine that expert evidence tendered, including any novel scientific theory or technique, satisfies a basic threshold of reliability.
- A party may challenge the admissibility of an opinion on the grounds that the underlying science or technique is not reliable or does not satisfy the other criteria.
- A party who asserts that a previously accepted area of expertise is unreliable has an evidential burden to provide a foundation for challenging the reliability of that particular area of expertise.

“The Reliable Foundation Test”

- The Supreme Court of Canada has adopted the four factors set out in the US Supreme Court Case of *Daubert v. Merrell Dow Pharmaceuticals, Inc.,* 113 S.Ct. 2786, at 2796-97, 509 U.S. 579 (1993):
  - Has the expert’s theory has been tested? Can it be tested?
  - Has the theory withstood peer review and publication in the relevant scientific or technical community?
  - Is there a known or potential rate of error, or the existence of standards to test the application of the theory or technique?
  - Has the theory been generally accepted by the relevant scientific community?

Must Be Based On Science

- Expert evidence must be based on scientific knowledge derived from scientific validity and methodology.
- A trial judge must conduct a preliminary assessment to determine if the reasoning or methodology underlying the preferred opinion is scientifically valid and if the reasoning or methodology applies to the disputed issues.
- This evaluation of reliability applies to scientific, technical and other categories of expert evidence.

Problems with Expert Witnesses

- Expert testimony in an adversarial setting creates two types of problems.
- Litigants will seek out and use an expert prepared to express the desired opinion, leading to a "battle of the experts" with a technically untrained judge selecting between competing theories.
- If one party retains an expert, the other party will need to obtain a contrary opinion to neutralize the evidence of the other party's expert.
- Results in escalating costs and increased length of civil trials.

Problems with Expert Evidence

- Hired guns can skew their testimony rather than providing a balanced view of the merits of competing theories.
- Pursuit of the truth is not absolute.
  - Court must ensure fairness and preserve the integrity of the system
  - Competing experts advancing dubious pseudoscientific theories can bring the administration of justice into disrepute.

More Problems

- ⇨ Courts are not well qualified to assess the reliability of an expert's testimony.
- ⇨ Lawyers and judges often lack even basic scientific literacy.
- ⇨ Complexities of fact and theory can make it difficult both for a lawyer to conduct an effective cross-examination that the Court can follow.
- ⇨ Often a fine line in determining question of fact between aiding and usurping the fact-finder.

Bias, Independence and Impartiality

- Bias, partiality and influence come in many forms.
- Bias generally describes predisposing influences that influence the evidence.
- Independence refers to the freedom of the expert from the influence of the litigant.
- Impartiality is used to describe the "state of mind or attitude in relation to the issues and parties of an expert witness leads to "adversarial bias".

Bias

- The partisan nature of expert witnesses may arise out of a perceived conflict of duties.
- Some judges and courts have proposed and adopted rules for experts that require an expert witness to acknowledge an over-riding obligation to the Court.
- There are four primary reasons to scrupulously control the use of expert witnesses in legal proceeding.
- Undermine the rationality of the legal process, which requires an impartial and reasoned application of the law to the facts.

Forms of Bias

- "Selection bias“ - the potentially distorting effect of having the parties select (or reject) experts based on whether they will support the desired positions.
- Selection bias can deprive courts of the best sources of information. The more measured and impartial an expert is, the less likely he is to be used by either side."
- ”Association bias” - refers to the conscious and unconscious pressures on experts to work in the interests of those they are associated with in litigation.

Self Interest of Experts

- Self-interest resulting from a range of professional influences on an expert that can skew his or her testimony, either consciously or unconsciously.
- Expert witnesses may have an interest in defending years of research or safeguarding their own credibility. Though he was no doubt over-generalizing, Roach J. made the point this way back in 1940:
  - *Experts are jealous of their special skill, ability and knowledge. They cling to their theories and opinions most tenaciously and are loath to admit any merit in opposing theories or opinions. ... They are inclined to be unduly critical of methods or technique which are not as refined or skilful as their own.*

Special Obligations of Expert Witnesses

- Expert witnesses may have a professional obligation and an obligation to the Court to provide a truthful and credible opinion.
- Some courts may impose duties on expert witnesses that go farther than the duty to be honest when they testify
- Duties are intended to ensure that "the opinions will be founded only in the training and experience of the expert and not in the exigencies of litigation or in the interest of the party in question.“
- Expert must acknowledge obligation to provide "objective, unbiased opinions," and not to act as an advocate for the cause the expert witness is called to aid.

Codes For Expert Witnesses

- Explicitly emphasize that "an expert witness is not an advocate for a party."
  - Rather, "an expert witness's paramount duty is to the court and not to any party in the proceedings."
- Explicitly require experts to work cooperatively to endeavor to reach agreement and identify areas of disagreement.
- Codes are not limited to concurrent evidence, but are applied to conventional expert evidence proceedings.

The Expert Report

- The Rules of many common law courts require expert reports or affidavits setting out a full statement of proposed evidence-in-chief before the trial.
- The expert report should be prepared by the expert, not by the lawyers or attorneys involved in the litigation.
- This has been stated by Lord Wilberforce:
  - "While some degree of consultation between experts and legal advisers is entirely proper, it is necessary that expert evidence presented to the Court should be, and should be seen to be, the independent product of the expert, uninfluenced as to form and content by the exigencies of litigation to the extent that it is not, the evidence is likely to be not only incorrect but self-defeating".

Whitehouse v. Jordan, [1981] 1 W.L.R. 246 at 256-57 (H.L)

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Qualifications and Experience

- Some Court rules provide that the expert's evidence-in-chief may be tendered by simply reading the Affidavit (or taking it as having been read).
- Common in British patent cases
- Many experienced counsel prefer to lead oral testimony by the witness who can explain what is in the Affidavit.
  - allows the expert to feel comfortable in the courtroom
  - allows the Judge to see the witness in a favorable light, before cross-examination.

Examination in Chief

- ⇨ Difficult to conduct an effective direct examination.
- ⇨ Often taken for granted, but case can be won or lost by the direct examination of the party's witnesses.
- ⇨ Direct examination must be interesting and persuasive, reinforcing the key themes of the case.
- ⇨ The witness, not the lawyer, should be the center of attention.
- ⇨ Evidence of the witness can be enhanced by appropriate exhibits.

Expert Evidence in Chief

- Create the right impression.
- Establish the witness's credentials.
- The judge needs to hear the key elements of the witness's qualifications.
- Ask the witness to explain what opinions he or she has formed and the basis for the opinions.
- Hit the high points, the items that are most impressive and relevant to the issues.
- Bring out any weaknesses early.
- Focus on critical elements of the evidence.

Cross-Examination

- One of the most critical components of a case.
- Cross-examine on questions of qualifications, “bias” and reliability.
- Question qualifications on every area in which the opinion of the expert has been offered.
- Important to assess the expert’s opinions by reference to the factors permitting the introduction of expert evidence.

Why Cross-Examine?

- The primary purpose is to neutralize unfavorable testimony, not to elicit favorable testimony.
- Ask questions the witness's bias, prejudice, interest or motive:
  - Is there a relationship, family, business or otherwise between the witness and the party?
  - Does the witness benefit from a particular outcome?
  - Does the witness have a prejudice or bias against the opposing party?
  - Does the witness lose credibility through prior inconsistent statements, bad character for truthfulness, or prior bad acts?

Challenges to Expert Evidence

⇨ The expert witness should be prepared:

- ☒ to have his Curriculum Vitae and credentials questioned
- ☒ to receive questions on his or her impartiality,
- ☒ to repeat or explain tests performed,
- ☒ to receive hypothetical questions based on different facts (which the witness must answer).

Advance Preparation is Essential

- Investigate the expert's background, prior evidence given, available, reports, affidavits, articles, news pieces and litigation.
- Use leading questions.
- Be prepared to recognize and react to changing circumstances in the courtroom, and be flexible as the cross evolves.
- Be prepared to abandon lines of questioning when you determine that the expert is too well-prepared and knowledgeable.
- Control of the expert often determines the success of the cross-examination.

Challenging the Expert Witness

- Know the Facts.
  - Incorrect factual answer may cast doubt on expert opinions.
- Become proficient in the expert's area of expertise. Obtain a good understanding of the areas at issue.
  - knowledge of the terminology makes it more difficult for an expert to confuse the court with misleading language.
- Know when to cut your losses.
- Quit when you're ahead. End the cross-examination on a high note without giving the witness a chance to redeem himself.

The Professional Witness

- A witness who frequently testifies for both plaintiffs and defendants can be shown to be a "hired gun" who will testify for anyone who pays the necessary fee.
- A professional presentation, a deluge of statistics, and a plethora of technical information can be intimidating. Break the evidence down into its component parts and examine each part for weakness.

Expert Evidence – Another Way

- The Rules of Civil Procedure in Australian jurisdictions have changed in response to concerns of "Adversarial Bias".
- Expert Evidence can be presented concurrently.
- Known colloquially as "hot tubbing".
- Expert witnesses on both sides of the case can discuss the relevant matters at issue in a joint session, in the hopes of forming a consensus and in turn, to expedite the proceedings.
- The objective is to improve the quality of expert evidence by reducing or eliminating a partisan influence.

The Last Word ... from the Bench

- There is hardly anything, not palpably absurd on its face, that cannot now be proved by some so-called expert ....
  - Keegan vs. Minneapolis & St. Louis R.R. Co Minnesota Supreme Court (1899)

The Concurrent Evidence Session

- During the Concurrent Evidence sessions, experts are permitted to:
  - Make extended statements,
  - Comment on the evidence of the other experts,
  - Ask questions of the other experts, and
  - Test opposing opinions.

Two Stages of Concurrent Evidence

- First stage, experts comment openly on the facts, the issues, their opinions, and the differences between them.
  - More informal than examinations-in-chief and cross-examination.
- Second stage, counsel plays an active role and directs questions to the expert witnesses.
  - Counsel begins by cross-examining the opposing experts in the usual order.
  - Allows questions to be put to more than one witness and witnesses can be asked to comment on another witness's answers.
  - Because varying degrees of control are used by the judges in a given case, counsel and experts often exercise restraint in cross-examining and questioning the other party, at least at the beginning of the second stage.

Associated Reforms

- Require parties in some cases to select a joint or single expert between them.
- Provide for a pre-trial joint meeting to identify matters on which the experts agree, matters on which they disagree and reasons for their disagreement.
- Expert witnesses in most Australian jurisdictions are required to comply with a formal protocol and are required to sign a declaration to that effect in every case.

Advantages of Concurrent Evidence

- Encourages experts to be more open, less adversarial and more objective.
- Improves a judge's ability to assess expert opinions.
- Improves communication between the parties and narrow issues further.
- Reduces the level of partisanship.
- Relieves tension between experts and encourages experts to be less adversarial and more forthcoming with their opinions.
- Ability of the Judge to recall, compare and assess opinions is enhanced.

Concerns with Concurrent Evidence

- Risk that more assertive experts dominate the joint session
- Counsel may be inclined to select dominant or uncompromising expert witnesses
- May not reduce adversarial bias
- Experts may take advantage of increased amount of latitude given by dominating the discussion with the other expert or the judge.
- Judge must remain independent and objective in order to distinguish between an illegitimate partisan opinion and a firmly held but genuine opinion.

Survey Evidence - the Team

- The trade mark attorney
- The “experts”
  - Marketplace
  - Design of questions
  - Interpretation of data
- The survey company
  - Supervisor
  - Interviewers
- Data compilers and analysers

Avoiding Bias

- ⇨ Wrong Universe
- ⇨ Improper Screening
- ⇨ Improper Sampling
- ⇨ Wrong Questions
- ⇨ Improper Analysis

Bias in Screening

- ⇨ Screening is done
  - ☒ To reduce the sample size
  - ☒ To eliminate those whose views are not relevant
  - ☒ To reduce costs
- ⇨ Screening may introduce bias
  - ☒ May tell interviewee why he or she has been selected

Bias in the Questions

- ⇨ “I am going to show you some anti-depressants with the name removed”
- ⇨ (product shown)
- ⇨ “Can you see the product as clearly as you would see a product that had been prescribed for you”
- ⇨ (product removed)
- ⇨ “What if anything came to mind when you saw the product I just showed you.”

Bias through Speculation

- The question should not: '"...direct the person answering the question into a field of speculation upon which that person would never have embarked had the question not been put"'.
  - *Imperial Group v. Philip Morris*

Bias in the Survey Process

- ⇨ Prompt and probe for answers
- ⇨ Encourages guessing
- ⇨ Guessing favours known brands
- ⇨ Controls may avoid this bias

Controls

- When capsules are the same colours, what, if anything, does it mean to you?
- When bank cards are the same colours, what, if anything, does it mean to you?
- When chewing gum packages are the same colours, what, if anything does it mean to you?

Conducting the Survey

- Establish and maintain the locale
- Follow the script
  - Interviewers should have no room for improvisation
  - Where appropriate, probe for all possible answers
- Supervise the interviews
- Record the results

Analysis of the Results

- ⇨ Subcategories of respondents
- ⇨ “Coding” of the answers
  - ☒ “don’t know/maybe/don’t remember
  - ☒ “the one I saw was not that colour”
- ⇨ Statistical analysis
- ⇨ Calculation of error
- ⇨ Conclusions

Presentation of the Results

- Complete disclosure of the methodology chosen and reasons for rejecting others
- Confirmation that all interviewers followed the chosen methodology
- Complete disclosure of all results, including any that are not favourable.
- Analysis of results
- Conclusions Drawn

Who Should Give Evidence

- ⇨ Survey Designer
  - ☒ Instructions received
  - ☒ Explanation for design of survey
- ⇨ Survey or market research company
  - ☒ How survey was conducted
  - ☒ How results were recorded and analyzed
- ⇨ Marketing Expert
  - ☒ May give evidence on survey conducted by someone else

Disclosing the Results

- [S]urvey evidence … can only be of weight if … the fullest possible disclosure of … how many surveys [were] carried out, … how those surveys were conducted and the … number of persons involved, because otherwise it is impossible to draw any reliable inference that answers given … in one survey might … indicate that similar answers would be given [in] a survey covering the entire … population
  - *Imperial Group v. Philip Morris, UK 1984*

Evidence Required

- "The affidavits of the persons who actually conducted the interviews were not offered as evidence by the appellants.
- “The affidavits of [the experts] are of little assistance in determining how representative the results of this survey actually are since they were not present while it was being conducted. “
  - *Joseph E. Seagram & Sons Ltd. Vs. Seagram Real Estate Limited*

Evidence Required

- “Here there was no affidavit from anyone actually involved in the survey's completion, and no direct evidence of the manner in which questionnaires were completed or the accuracy of the completed returns.”
  - *Joseph E. Seagram & Sons Ltd. Vs. Seagram Real Estate Limited*

What should be in Court

- ⇨ Initial survey design
- ⇨ Pre-testing results and any changes to survey
- ⇨ Instructions to interviewers
- ⇨ Materials used to select respondents
- ⇨ Records of all interviews
- ⇨ Tabulation of results
- ⇨ Statistical analysis

Analysing the Numbers

- ⇨ There are no magic percentages that mean win or lose
- ⇨ Validity of results depends on all variables in the survey
- ⇨ Significance of the results depends on market and on the consumers
- ⇨ Significance of the results depends on the issues in the case and the remedies

Challenging the Survey

- ⇨ The Survey Expert's credibility can be challenged by showing
  - ☒ Lacking or questionable qualifications;
  - ☒ Bias, prejudice or motive to shade testimony; or
  - ☒ Prior inconsistent statements.
  - ☒ Lack of academic credentials, knowledge, skill, experience and or training in the area in which the witness is being offered as an expert.
  - ☒ Instances in which the witness's survey was not accepted by the court, or for example, cases in which various courts have questioned the witness's qualifications, credibility, motives, etc.

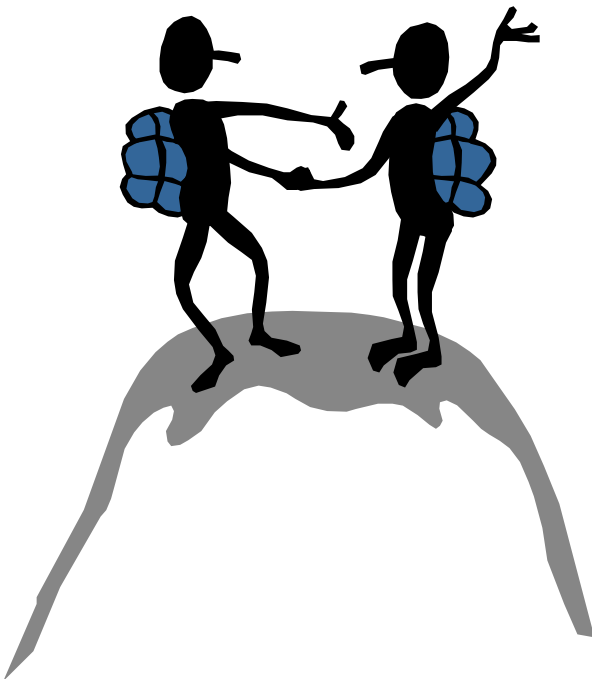
Some Survey Criticisms

- ⇨ absence of evidence as to the manner in which the questionnaires were completed
- ⇨ limited locations where the surveys were conducted
- ⇨ absence of control questions
- ⇨ weakness of word association surveys compounded by artificial stimuli introduced into the questions
- ⇨ ambiguity in the interpretation of the survey

Conclusions

- A properly conducted survey is essential to any significant trade mark litigation
- Surveys are expensive, but attempts to cut corners will lead to problems
- No survey, however well it is done, will be of any use if it is not properly presented to the court

Questions?



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