

EXPERT WITNESSES: FROM PROPER RETENTION TO CROSS-EXAMINATION

1. Introduction

The use of expert witnesses in patent and trademark litigation is common place given the ever increasing complexity of science, technology and specialization. A Judge must often render a decision in an area where he or she has little expertise and rely on counsel to call experts who can explain the technical complexities of the case.

Expert testimony is often required in a patent case in the following areas:

- (a) Explaining what the patent means to a person skilled in the art, including an explanation of the terms used in the patent;
- (b) Testify about the prior art at the date of invention and opining as to its significance;
- (c) Explaining whether the disclosure sufficiently describes the invention in a way that would enable a person skilled in the art to make the invention or put it into practice;
- (d) Examining the clarity and breadth of the claims, including whether the claim includes an invention that does not work;

- (e) Addressing evidentiary matters concerning whether the matter claimed is obvious or inventive, including such matters as whether the claimed invention is a commercial success and has met a need. In trademark litigation, an expert is often employed to opine on the issues of the reputation and goodwill in and to the trademark and to help prove or disprove infringement by opining on whether the defendant's trademark is confusing with the plaintiff's trademark. In copyright litigation, an expert can be employed in the areas of whether the work constitutes an original work and whether there has been substantial copying by the defendant.

Increasingly in intellectual property cases, expert evidence is also employed in the area of proving damages or an accounting of profits.

Intellectual property cases are often brought in the Federal Court of Canada and, with that in mind, the procedure for calling expert opinion evidence in that Court and the workings of *Rule 482 of the Rules of the Federal Court* will be specifically addressed below.

2. Experts and Expertise

(A) Admissibility of Expert Opinion Evidence

A witness is considered an expert if he has special skills or knowledge on the factual matter being considered. Such skill or knowledge may arise by study or by experience. Evidence from an expert is admissible where the subject matter of the inquiry is such that, unless assisted by persons with special knowledge, ordinary people

are unlikely to form a correct judgment about it.¹ Although the evidence of a witness long on degrees and short on experience may be given less weight, an expert may render an opinion based on established facts, based on observed facts or based on hearsay. Further, where evidence of a particular practice is based on the witness' personal knowledge, it is not admitted as opinion evidence but rather is admitted through the expert witness as factual evidence.²

Experts may refer to textbooks in rendering their opinion as a means of strengthening or refreshing the expert's memory.³ Stated otherwise, the function of an expert witness "is to furnish the Judge or jury with the necessary scientific criteria for testing the accuracy of their conclusions, so as to enable the Judge or jury to form their own independent judgment by the application of these criteria to the facts proved in evidence."⁴

Given that an expert must have special skills or knowledge concerning the factual matter at issue, great care must be taken in choosing the proper expert. In a pharmaceutical case involving stereochemistry, for example, a chemist with expertise in that field and including in the class of compounds at issue would be preferred over one who has training only as a general chemist. Regarding patent cases, the patent specification is interpreted by "the person skilled in the art, a person of average skill, who is capable of deductive but no inductive reasoning, i.e. someone whose thinking

¹ *Kelliher v. Smith*, [1931] 4 D.L.R. 102 at 116, [131 S.C.R. 672 at 684]

² *Fagnan v. Ure, et al* (1958), 13 D.L.R. (2d) 273 and *Fagnan v. The Public Trustee*, [1958] S.C.R. 377

³ *R. v. Anderson* (1914), 16 D.L.R. 203

⁴ *Davie v. Magistrates of Edinburgh*, [1953] S.C.R. 34 at 40

represents “a triumph of the right hemisphere over the left”.⁵ This means that your expert should be someone who has some practical working experience in the art and not necessarily the most highly qualified Ph.D. on the subject. Careful attention must be paid to the inventive concept of the patent and selecting an expert or a collection of experts with experience in that area.

(B) Locating the Expert

The client is often the first resource in finding an expert witness. Expert witnesses can also be located through several other sources, including:

- (i) A University Professor teaching in the area of technology at issue may be employed as an expert or, alternatively, may refer you to an industry expert;
- (ii) Reference books, such as *Who in Science* lists leading scientists and engineers by subject matter;
- (iii) Previously reported cases involving an area of similar technology can sometimes suggest a useful witness, especially one whose evidence has been favourably accepted;
- (iv) Articles in periodicals involved in the particular field of technology may also yield a suitable expert;
- (v) Lawyers’ indexes of expert should also be consulted. The CBA Index of Experts, for example, lists a number of experts in a variety of fields;

⁵ *Beloit Canada v. Valmet Boy* (1986), 8 C.P.R. (3d) 289 (F.C.A.)

- (vi) Professional or trade associations often provide assistance in locating an appropriate expert; and
- (vii) Expert search firms may also be employed, such as the Technical Advisory Service for Attorneys (TASA) and Nedquest Limited will search locate experts for a fee, assessing the experts' strengths and limitations.

(C) Selection Criteria

As soon as you determine the need for an expert witness, steps should be taken as early as possible to retain the appropriate expert. Securing an expert early in the case is invaluable to several matters including understanding the technology, properly framing the pleading such as determining the grounds of invalidity or defences to an allegation of invalidity, interpreting the patent and determining the scope of the prior art searches and interpreting the prior art located.

An expert will also fill the role of consultant and assist in every step of the case from preparing for examining for discovery and suggesting and conducting appropriate tests and demonstrations to such pre-trial matters as assisting in the cross-examination preparation of the opponent's expert witnesses.

To properly assist in these various matters, as stated earlier, the expert's academic qualifications must be balanced with his or her technical experience in the sense of being someone who has a good practical working knowledge of the technology in issue.

Other common sense matters should be considered in selecting the expert. It is useless, for example, to hire the world's greatest expert in his or her area if he or she is unable to communicate effectively and impartially. He or she must not come across as a "gun for hire", but instead must be able to stand cross-examination and convey the feeling that he or she is someone of unquestionable integrity.

Often in patent cases, it is necessary that the expert have expertise in the art at a point in time that is several years or even decades ago. For example, in a pharmaceutical patent case concerning an anti-bacterial sulphonamide, it is obviously far better to attempt to locate the expert who actually worked with sulpha drugs 30 years ago before bacteria developed resistance to such drugs, as opposed to someone who learned about sulpha drugs as a student and has only actual working knowledge of other more advanced anti-bacterials such as quinolones. In a sense, it is very important for an expert witness to focus on the issues and to have the ability to place himself or herself back at the appropriate period of time to discuss the state of the art at that time. The expert must be an expert as at the relevant date in issue. In *Northern Electric Co. v. Photo Sound Corp.*⁶, Chief Justice Duff stated that evidence given by witnesses "in relation to the state of the art at a time when they had not much more than entered upon their studies as engineering students, is of no value".

⁶ *Northern Electric Co. v. Photo Sound Corp.*, [1936] S.C.R. 649; see also *Diversified Products Corp. v. Tysil Corp.* (1987), 16 C.P.R. (3d) 207 at 234

Another matter to consider is whether to hire the experienced expert witness or one who has never testified before. Both types of witnesses have their advantages and disadvantages. The inexperienced expert must be carefully tested to ensure that he or she will withstand the rigours of cross-examination. On the other hand, the experienced witness must be watched to ensure that he or she not appear too comfortable and too arrogant in the witness box as well as too ready to take the gloves off with opposing counsel and thus risk appearing close-minded and obstructive.

Another not uncommon failing of the seasoned expert witness is that he or she may under-prepare for the case. I have a vivid recollection of travelling to the United States with the client to prepare an expert witness. The expert arrived late, had obviously not spent much time reading the material, had spent the morning in another lawyer's office preparing for expert testimony he was to give in another case the next morning and, quite understandably, as the evening progressed, was unwilling to further prepare for our case and instead began to consider his other case that was quickly approaching the next morning. Needless to say, apart from requiring further preparation, none of this left a favourable impression with the client. The above criteria for selecting an appropriate expert witness should leave you with the impression that there is no substitute for long and painstaking preparation, including several meetings with the expert witness. It is helpful to give the proposed expert witness all relevant documents, including a briefing of what counsel then understands to be the central issues in the case. The proposed expert should be fully informed of all of the facts and issues in the case. He or she should have a complete understanding of the case, rather than simply an understanding of the issues that he or she will be facing. This full disclosure approach to an expert is

important given that the expert can be cross-examined not only on all aspects of his or her affidavit evidence, but as well on all other issues in the case in which he or she is competent to testify.⁷ This approach may be altered in the context of PM(NOC) Proceedings, where counsel may decide that the expert is better off restricting himself to a particular part of the case and have other experts address other aspects of the case.

The expert should not be spoon fed all of counsel's research and prior art searches but rather, ideally, should be the one who supervises or personally conducts the searches. Both counsel and the expert should always be aware that the expert's methodology and conclusions will be subject to intense scrutiny by the other side. The more independent research and study that the expert performed in arriving at his or her opinion, the better able he or she will be to withstand cross-examination and persuade the Judge to prefer his or her conclusions over those of the opposing experts. 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

⁷ *Rex v. Anderson*, [1938] 3 D.L.R. 317 at 333 (Man. C.A.)

litigation to the extent that it is not, the evidence is likely to be not only incorrect but self-defeating”.⁸

The initial meeting with the expert witness should be held after he or she has reviewed all of the relevant materials forwarded by counsel. At the initial meeting, the expert witness should be prepared to discuss his or her preliminary views while counsel should be sensitive not to direct the witness to a particular conclusion on any given issue. Counsel should recognize the expert has not fully explored all of the facts and issues and, therefore, should refrain from expressing a final opinion. On occasion, one is faced with retaining experts who are the client’s employees. Ideally, one should select an expert witness who is totally independent of either of the parties and has a well-balanced academic and practical background concerning the technology in issue. If you are faced with the prospect of calling your client’s employees as expert witnesses, careful preparation will ensure that these witnesses are objective, credible and fair in their testimony. By way of example, in the patent trial in *Xerox v. IBM*.⁹ Justice Collier balanced the evidence of 3 Xerox expert witnesses who were senior employees of Xerox Corporation against 3 expert witnesses for IBM Canada who were independent of IBM. Justice Collier “unhesitantly accepted” the evidence of the Xerox witnesses notwithstanding their lack of independence from the plaintiff and concluded that they were objective and fair in their testimony whereas the 3 IBM witnesses were, in certain respects, lacking in objectivity and were unresponsive. This case illustrates the

⁸ *Whitehouse v. Jordan*, [1981] 1 W.L.R. 246 at 256-57 (H.L)

⁹ *Xerox of Canada Ltd., et al v. IBM Canada Ltd.* (1977), 33 C.P.R. (2d) 24

importance of witness selection and preparation to ensure that you avoid the “hired gun” syndrome which can taint your whole case.

3. Typical Case Application

(A) Procedure for Preparing the Expert’s Affidavit

The role of the expert in the Federal Court of Canada must be considered in the context of *Rule 482* of that Court. Rule 482 requires that before an expert can tender evidence--in-chief at trial, counsel must deliver an expert Affidavit setting out a full statement of proposed evidence-in-chief not less than 30 days before the trial. Further, no rebuttal evidence relating to the Affidavits is allowed at trial unless an Affidavit addressing such evidence is delivered 15 days before trial.

The Rule is designed to temper criticism that in the industrial property field where the Court and counsel are dealing with technical, factual and legal problems, trials tend to be lengthy and expensive.¹⁰

Rule 482 also provides that the expert’s evidence-in-chief may be tendered by simply reading the Affidavit (or taking it as having been read). Such a procedure is the norm in British patent cases but I would recommend that counsel elect to lead oral testimony by the witness who would explain what is in the Affidavit. This approach

¹⁰ This problem was addressed by Lord Eshr, M.R. in *Ungar v. Sugg* (1892), 9 R.P.C. 113 at 116-17: it used to be said that there was something catching in a horse case: that it made the witnesses purger themselves as a matter of course. It seems to me that there is something catching in a patent catch that it make everybody argue, and ask questions to an interminable extent - a patent case with no more difficult question to try than any other case instead of lasting 6 hours is invariably made to last 6 days, if not 12. I am sure there ought to be some remedy for it... now, what is the result of all this? Why, that a man better have his patent infringed or have anything happen to him in this world short of losing all his family by influenza, then have a dispute about a patent. His patent is swallowed up, and he is ruined. Whose fault is it? It is really not the fault of the law; it is the fault of the motive conducting the law in a patent case. That is what causes all this mischief.

allows the expert to feel comfortable in the courtroom surroundings and allows the Judge to see the witness in perhaps his or her most favourable light prior to being exposed to cross-examination.

Even if an Affidavit or Report is filed, there is no obligation to tender that evidence and call the expert at trial. Further, when an expert is called, counsel may elect to allow in only part of the Affidavit. In this instance, however, opposing counsel will be able to cross-examine on any part of the Affidavit filed.¹¹

The advantage of *Rule 482* is that it minimizes the element of surprise. On the other hand, the Rule introduces a certain inflexibility into the trial process, particularly for the defendant who is placed in the position of having to commit itself well in advance. A further problem with *Rule 482* is that counsel may not be certain what scientific facts must be established at the time the Affidavit is drafted. The technology in issue is often unfamiliar to the Judge. Care must be taken to ensure that the technology, including the special terminology applicable to the patent, are explained to the Court.

A further difficulty experienced in filing an Affidavit in advance is that the Affidavit generally addresses both scientific facts that are and are not in controversy. Where a defendant addresses the non-controversial facts through the expert, it may open the expert to cross-examination on the controversial facts. By the time the trial commences, the ground has shifted and the Affidavit may no longer be particularly applicable or desirable.

¹¹ *Steel Co. Of Canada Ltd. v. Sivaco Wire & Nail Co.* (1973), 11 C.P.R. (2d) 153 at 166 (F.C.T.D.)

Finally, the flexibility of making decisions as the case unfolds at trial is greatly limited with the requirement that expert rebuttal evidence must also be disclosed by way of Affidavit 15 days in advance of trial.

The approach in the Federal court in these matters can be contrasted with that of the Ontario Court. Ontario Court *Rule 30.03(2)(b)* requires that even privileged expert reports must be described in a party's Affidavit of Documents. *Rule 31.06(3)(a)* requires disclosure on discovery of "the findings, opinions and conclusions" of the expert formed in preparation for the litigation in the expert will be called at trial. Counsel in that instance should consider not obtaining an expert's report and only informally consulting with an expert before completion of examinations for discovery.

One author has suggests that: "to meet the abuse of non-disclosure contrary to Rule 31.06(3), examining counsel at discovery might consider adopting this three-fold strategy, request that name and address of all experts consulted, request the "findings, opinions and conclusions" of all experts consulted and request an undertaking not to call experts "engaged" whose name and "findings, opinions and conclusions" have not been disclosed."¹²

It is suggested that if the above questions are asked, the opponent will be under an obligation under *Rule 39.09(1)* to provide subsequently acquired information, which would include the identity, opinions and conclusions of an expert engaged after examinations for discovery are completed.

¹² H. T. Strosberg and E. W. Ducharme, "On Finding, Instructing and Deploying Experts and their Reports in Civil Trial Cases: Some Practical Considerations" presented at Intensive Civil Advocacy Programme (Canadian Bar Association - Toronto, May 5, 1989) at 3

Last, in contrast to the Federal Court practice, Ontario Court *Rule 53.03* stipulates that if a party intends to call an expert at trial, then it shall serve a report setting out the substance of the expert's proposed testimony at least 10 days before trial. Such a report is often less detailed than what has come to be seen as a requirement of filing an expert's Affidavit under the procedure required in the Federal Court of Canada.

(B) Preparation of the Expert's Opinion

Given that your opponent will have your expert's evidence-in-chief and rebuttal Affidavits in advance of trial and will have his or her own expert assist in preparing cross-examinations thereon, the importance of preparing your expert witness cannot be over-stated. The process should start early where, as indicated above, the expert is provided with all the materials relevant to his or her testimony even in advance of an initial meeting. Prior to the initial meeting, the expert should also be provided with a summary of the facts and of the issues he or she will be asked to consider.

The expert witness' C.V. should be reviewed thoroughly. All of his or her papers, articles and transcripts of prior testimony should be reviewed to ensure that the expert is willing to opine on in your case is consistent with the position he or she has taken on the matter in the past. I recall an instance of cross-examining an expert witness who, when pressed, admitted that he had performed little research prior to preparing his opinion and that the Affidavit was drafted by counsel (although he had reviewed it). I then led him to an early paragraph in his Affidavit indicating some of his previous learned writings and had him agree that he indeed personally authored the writings and concerning one in particular, that it was a preeminent source, widely referred to by

others. During the course of the cross-examination, I then had the witness agree that he had always held the view set out in his Affidavit. At the end of the cross-examination, I produced the work previously agreed to have been authored by the witness and led him to the passage where his view expressed, only 1 year earlier, was directly contradictory to the view expressed in his Affidavit, a view that he had previously stated that he had always held. This example illustrates how it can be well worth the effort to spend the time reading all of the prior writings of the opponent's expert witness and when it comes to your own expert witness, you should realize that if you do not perform this exercise, you cannot expect your opponent not to prepare in the same fashion.

After the initial meeting with the expert, the expert will then be instructed to complete his research and, if required, any testing, all with a view to refining his opinion. During this period, counsel and the expert will consult each other regularly. It is important, however, that the lawyer balance his or her involvement in the preparation of the expert's opinion. How the expert's Affidavit was prepared can be subject to cross-examination. An expert should not be pushed into an opinion that he or she is not comfortable holding. Normally, counsel will outline the framework of the Affidavit and, with the witness' input, the text of the Affidavit itself. Throughout the process, however, both counsel and the expert witness must be satisfied that the expert witness was intimately involved in the research leading up to and the preparation of the Affidavit.

An expert's Affidavit may be amended so long as the expert continues to retain the opinion as his or her own. Care should be taken not to make a substantive change to the opinion simply on the suggestion of counsel.¹³

Such a caution does not extend, however, to suggesting changes to format or the order of the Affidavit or to adopting wording which better expresses the thought or to directing the witness on how to properly articulate scientific principles in a manner that the Court would best understand.

(C) Pre-trial Preparation

Any expert is only as good on the stand as is the quality of his preparation. You should remind the expert that his or her premises, methodology and ultimate conclusion will be critically reviewed by the opposition and that even on cross-examination, he must feel comfortable and be able to persuade the Judge that his or her premises, methodology and conclusions are to be preferred over those of the opposition.

When the expert affidavits from the opposition arrive, your expert should again be consulted to assist you in preparing for cross-examination of those experts and to consider filing rebuttal evidence.

One area during the pre-trial preparation that often causes uneasiness amongst counsel is the question of privilege. While U.S. patent attorneys are extremely sensitive to putting communications with experts in writing, in Canada the protection from production in this area seems more reasonable. Generally, all documents created or

¹³ *Strosberg, supra*, note _____, at 16

obtained as part of the “lawyer’s brief” are privileged.¹⁴ Further, in *Bell Canada v. Olympia and York Developments Ltd.*¹⁵ The Court held that the other side is not entitled to production of documentary evidence that had been provided to the expert by counsel. One important exception to this rule, however, concerns notes and correspondence given to the expert that are not subsequently reflected in his or her opinion and that may be adverse to the client at trial. In *Pichét v. Lecours Lumber Co.*¹⁶, the Court held that if facts supplied are not found in other evidence or if certain assumptions are asked to be made in the instructing documents, privilege claimed for those facts or assumptions should be considered waived. This caveat underlines the importance of counsel being careful in how he or she prepares the expert.

4. Trial

(A) Examination-in-Chief

Counsel should meet with the expert again just prior to the expert taking the stand. The affidavit and objectives of the testimony should again be reviewed in detail. Some counsel prefer a few dry runs and others even prefer to videotape this exercise as a means of showing the expert how he or she comes across in a situation that attempts to mirror the real thing. Apart from preparing the expert witness in the same way that a fact witness would be prepared (i.e. by counselling him or her in such areas as: do not be argumentative, speak in a clear voice, use plain language and maintain your cool, listen carefully to the question and ask that it be clarified or repeated if you do

¹⁴ *Susan Hosiery Ltd. v. Minister of National Revenue*, [1969] 3 Ex. C.R. 27 at 33; and *Pichét v. Lecours Lumber Co.* (1993), 13 O.R. (3d) 193 at 195 (Gen. Div.)

¹⁵ *Bell Canada v. Olympia and York Developments Ltd.* (1989) 68 O.R. (2d) 103 (H.J.C.)

¹⁶ *Pichét v. Lecours Lumber Co.*, supra

not understand it, etc.), the expert witness should be prepared to have his Curriculum Vitae and credentials questioned, to receive questions on his or her impartiality (fees charges, relationship with the party, previous retainers by the same solicitors), to repeat or explain tests performed, to receive hypothetical questions based on different facts (which the witness must answer without getting overly caught up on whether he or she agrees with the hypothesis posed).

Importantly, the expert witness should be told how counsel intends the examination-in-chief to proceed. While counsel would like to illicit a narrative from the expert which should not appear stilted, this does not mean that the questions or answers should be long-winded. The expert should give a short answer to a short question and should not volunteer information but rather let counsel set the order and pace of the evidence.

The expert witness should be challenged on his or her theories or interpretation of the proposed testimony must as he or she would be during cross-examination. Any demonstrative evidence or tests should be carefully reviewed with the expert to ensure that they are accurate and not misleading.

When you call your expert witness to the stand, as mentioned earlier, you have a few options. You may have the expert identify his or her Curriculum Vitae and allow opposing counsel an opportunity to contest the expert's qualifications before the Judge makes a ruling on his or her ability to give expert evidence. Thereafter, you may ask that his or her Affidavit be taken as having been read and turn the witness over to cross-examination by your opponent.

A preferred approach, with a view to ensuring the witness is comfortable in the trial surroundings before exposing him or her to cross-examination, is to lead him or her through the highlights of his or her Curriculum Vitae and to have him or her address various issues in his or her Affidavit during examination-in-chief. Similarly, you should not necessarily accept a concession from your opponent that he or she is not challenging the expert's qualifications as this may deprive you of the opportunity to impress upon the Court that your expert is indeed a leading expert in the field. While there are some things that can be taken as having been read and should be crossed over because opposing counsel does not contest them, it is always a question of strategy to leave the matter alone. The whole purpose of the trial is an exercise in persuasion and that should not be lost sight of in the interests of apparent expediency.

Given that an expert's opinion is based either on facts within his or her personal knowledge or facts otherwise proven in evidence, it is important to have the expert present to hear the evidence of the other witnesses.

Hypothetical questions may be posed to the witness that involves relying upon contested facts or facts not yet established (in which case an undertaking to adduce such evidence proving the facts must be made). The way to frame a hypothetical question should start with adducing the underlying relevant facts by posing the question in a way that particularizes the facts. Thereafter, the expert is asked for his or her opinion and then asked to explain how he or she arrived at that opinion.¹⁷

¹⁷ For an example of how to pose hypothetical questions, see *Olah, Trial Advocacy* (1990), Chapter 4 or - 37 - 39

In patent cases, charts or diagrams are often prepared in advance and discussed by the expert during examination-in-chief. For example, a diagram showing a claim by claim comparison to the prior art or a marked up blue print may be the subject under discussion. The expert should be familiar with these diagrams or blueprints and should even be prepared to further explain them or any other theory or principle through use of such devices as an electronic drawing board where the expert's drawings may be directly reproduced as exhibits at trial. A good expert, properly prepared, can advance the persuasive ability of counsel in helping the Court reach the proper conclusion in the case.

(B) Cross-examination

Mention has been made above regarding preparing your witness for his or her cross-examination. Another cross-examination matter on which you should work with your expert involves your preparation for cross-examination of your opponent's expert. Should you determine the opponents expert's evidence goes to critical points in the case and that you therefore should cross-examine him, you then must thoroughly prepare for what has been termed "a battle, not a skirmish".¹⁸ Given that you already have the opponent's expert's evidence-in-chief filed in Affidavit form prior to trial, you should actively engage your expert in assisting you with your cross-examination. You should instruct your expert to list all of the issues raised by the opponent's testimony and to specifically point out in detail where it may be misleading or incorrect. Your expert is essential in helping you to qualify or discredit the evidence of your opponent's

¹⁸ Ian A. Blew, "*Cross-Examining the Expert*", in L.S.U.C. - C.L.E., The Success at the Hearing: Advocacy Before Administrative Tribunals (November 23, 1985), Page C-1

expert. Instructions to your expert should be to focus on what you have now determined are the main issues in the case so that your expert maintains some focus in undertaking the task at hand. Where the opponent's expert has performed tests and, assuming you have not been invited to observe those tests when they were being performed, you should have your expert attempt to recreate the tests and look for any potential weaknesses in the methodology or conclusions reached.

Apart from the value of having your witness present for preparation, he or she should also be present for the cross-examination itself. Often times, your expert witness can assist you in further pursuing a line of questioning based on the answers you are receiving from your opponent's expert during cross-examination. Sometimes the mere presence of your expert is unnerving to your opponent's expert, especially when your expert is seen to be passing you notes during the cross-examination. Your opponent's expert should be left with the impression (and hopefully the reality) that you are well prepared to tackle him or her in their field of expertise.

(C) Legal Implications: Admissibility of Expert Evidence on the Ultimate Issue

There are a number of ultimate issue questions that arise during patent litigation which the expert may present evidence. Generally speaking, ultimate issue evidence is admissible in patent cases concerning questions of fact or mixed fact and law. For example, questions of infringement anticipation¹⁹ and obviousness²⁰ are questions on

¹⁹ *Zelon Industries Ltd. v. Bonar & Bemis Ltd.* (1978), 39 C.P.R. (2d) 5; *Invacare Corp. v. Everest & Jennings Canada Ltd.* (1987), 14 C.P.R. (3d) 156 (F.C.T.D.); but see *J. N. Voith GMBH v. Beloit Corp.* (1989), 27 C.P.R. (3d) 322 (F.C.A) where the Court of Appeal held that a witness commenting on what was taught by the prior allegedly anticipatory publication constituted an inadmissible parole evidence upon which the Trial Judge was in error in accepting.

²⁰ *Beloit Canada v. Valmet Boy*, supra at 295; *Xerox of Canada Ltd. v. IBM Canada Ltd.* supra at 3 6

which the expert may present evidence. Concerning questions of law, such as the construction of a patent or of the prior art, the Federal Court of Canada takes the position that these questions are for the Court to answer, once properly instructed by expert evidence and without the expert taking over the role of the Court.²¹

With respect to an expert's role in construing patents, evidence has been accepted by the Court as to what a disclaimer meant²², and what the invention was²³, what certain words and phrases in the claims meant²⁴ and as to what were, in the expert's opinion the essential features of the invention.²⁵

²¹ *Rucker Co. v. Gavel's Fulcanizing Ltd.* (1985), 7 C.P.R. (3d) 294 at 313-16 (F.C.T.D.); *Amfac Foods Inc. v. Irvin Pulp & Paper Ltd.* (1984), 80 C.P.R. (2d) 59 (F.C.T.D.)

²² *Standal's Patent Ltd. v. SweCan Int'l Ltd.* (1989), 28 C.P.R. (3d) 261 at 276 (F.C.T.D.)

²³ *Pro-Vertic (1987) Inc. v. Int'l Diffusion Consonmatur S.A.* (1989), 26 C.P.R. (3d) 528 at 536-7 (F.C.T.D.)

²⁴ *Nekoosa Packaging Corp. v. AMCA Int'l Ltd.* (1989), 27 C.P.R. (3d) 153 at 168 (F.C.T.D.)

²⁵ *Stiga Aktiebolag v. SLN Canada Inc.* (1990), 34 C.P.R. (3d) 216 (F.C.T.D.)