

Expert witnesses

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Finding

- Client; inventors; past experts; prior art

Needs

- Patent construction – not all, danger of inconsistency. Some experts, give them the construction and seek their opinion from there
- To whom does the patent speak
- Area of expertise – specific over general – the person of ordinary skill in the art
- Previous experience being crossed

Approaching

- Calling over writing; obtaining c.v. and importance of vetting articles; Connection to client – chairs, consultancies
- Retainer agreement – no property in; but proper agreement
- What to send – NOA, patent, prior art – no specific directions/mandate
- Construction – educate on proper legal tests/frame of reference
- Meeting

Drafting

- lawyer pen to paper
- don't overextend – e.g. Nobel laureate in chemical side speaking to biology matters too
- drafts not kept – normal practice
- dockets – at least one case compelled dockets of expert

Preparing the Expert for Cross-examination

- at least two meetings devoted to cross prep – one other than the day before, and one the day before
- expert understanding the entire case
- review of opponents experts affidavits
- provide sampling of cross-examination – takes time but best way to equip expert

- alert him to expect all of the pro forma areas: his expertise, how much paid, when contacted, by whom, how many meetings, what reviewed, understanding of legal principles, who drafted, time spent – the more he knows what to expect, the less surprised and uncomfortable he will be

Cross-examining the expert

- determine amount of time spent preparing
- what reviewed – all prior art or directed to some; all patent claims or directed to some
- preparation of the affidavit
- his definition of the person of skill – if patent speaks to 3 areas of expertise and one side has experts addressing only two, the other side has a distinct advantage
- expertise – compared to areas addressed by the patent – compare to inventor’s expertise
- past involvement in patent matters
- construction – what test used
- was he the person ordinarily skilled in the art or did he put himself in those shoes
- what time frame was exercise performed
- did he limit himself to the patent or consider outside documents to construe
- is he guilty of using a “stray phrase” and improperly building that into an inventive concept
- did he look at a claim in context of all the claims and the disclosure as a whole
- under his construction, are claims duplicative
- seek agreement on a rewording of sentences in the disclosure to align with the wording/meaning of the claims being advanced by you
- does his construction interpret a phrase or word one way in one claim and differently in another claim

Anticipation

- Sanofi SCC: single piece of prior art must satisfy both a disclosure and an enablement requirement
- Be brief – questions focus on what doesn’t appear in the prior art document v. the inventive concept of the patent in issue

Obviousness

- has he applied the current Sanofi test: a) is there anything in the prior art references, or in the common general knowledge at the relevant date, as exemplified by the relevant prior art cited in the NOA, either alone or in combination, that would have led a person of ordinary skill in the art directly and without difficulty to the invention claimed;

- Do the differences that exist between the matter relied on in the cited References or the common general knowledge and the inventive concept of the claims or the claims as construed, constitute steps which would have been obvious to the person skilled in the art at the relevant time.

- b) Are the cited References and the common general knowledge at the relevant time sufficient for it to be more or less self-evident to try to find the invention at issue.
- c) Is there anything in the cited References or the common general knowledge that provide a specific motivation for the skilled person to pursue the invention at issue.
- d) Does the course of conduct which was followed which culminated in the making of the invention informs against the invention being obvious.
 - Determine what documents he considered; e.g., 100s in NOA and only address 5
 - How he selected the prior art; is he familiar with them independently of them being listed in NOA
 - Did he do his own search
 - Do any of his publications contradict the documents he now relies on
 - Do other parts of the documents contradict his reading of them – highlighting of passages in prior art and what they mean; teaching away or lack of clear direction, especially closest to invention date – be selective or risk expert bolstering his affidavit on cross
 - At least touch on each of the documents he discusses, even with simple questions - to avoid an argument that he was uncontested on points made in the documents he advanced
 - Ultimately, the Court wants to know the main prior art cites and how strong they are. Focus the cross-examination on these principle documents
 - Ability to introduce other prior art if he is familiar with them
 - Inventor history timeline and difficulty inventors had; whether he considered

Patent internal attacks: Lack of Sound Prediction/Ambiguity/Claims Broader

- Focus is on the legal tests not being properly applied
- Often best left principally to difference in expert's opinions
- Cover, but brevity recommended

Organization

- Everyone has his own style of advocacy; main point is to use yours to control the witness best you can
- Consider bringing own expert to the cross-examination
- Establish that you know mastery of facts, dates, articles, individuals, myriad of details to let the witness know he cannot take liberties
- Use ordinary language and ask simple, straightforward questions: an apparently helpful answer is useless if the question is not clear

- Always consider whether cross-examination is necessary on any given aspect; if the testimony is not persuasive or if the critical issue has not been addressed clearly or directly, consider not covering

Obtaining Admissions

- Have ready helpful passages in documents, even those authored by the witness
- Have the witness acknowledge the document/textbook/article is authoritative

Challenging the Expert's Qualifications

- Two challenges to consider: a) the witness is not qualified to opine on the subject matter at issue. That his expertise has not been established – goes to admissibility; b) the expert's experience is limited – goes to weight.

Challenging the Underlying Premise(s)

- Attempt to discredit or displace the underlying facts or premise(s) of the opinion
- Have the witness identify the sources from which he assumed the underlying facts or premises
- You need only raise doubt as to the manner in which the expert assumed the facts or premises
- Consider asking the expert's view after having him assume that the facts or premises do not exist – would his opinion still be the same
- Consider asking whether the conclusion is the only one capable of being reached. May establish the inflexibility of the witness

Bias

- Some counsel explore fees charged and testimony given in other cases
- Federal Court in NOC cases have said this is unlikely to be worthwhile, given that the Court is unable to see the witness

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