Practical issues – selecting an expert and getting the best out of them

Expert evidence is crucial in litigation before the English Patents Courts. A good expert witness will safely guide the Court through the perils of infringement and validity, but the corollary is that an apparently strong case can be defeated due to poor expert evidence. Although identifying the right expert is important, it is also vital to ensure that evidence from a good expert witness is not undermined by defective instructions or inadequate preparation. Perhaps most importantly, expert evidence must remain (and be seen to be) impartial, because any bias will quickly become apparent under robust cross-examination. This article examines a range of practical steps that can be taken to maximise the chances of a favourable expert performance in infringement and validity actions before the English Patents Court.

What characteristics should I look for?

When selecting an expert witness, it is important to remember that any person selected should satisfy two principal functions. Firstly, he or she is a maker of the mantle that will be donned by the Court,[1] and therefore needs to educate the Court about the technology in issue. This will require someone with knowledge and experience in the relevant field or a related one, who is capable of explaining the technology in a logical and coherent manner to the Court. It is desirable for your expert to be a fluent English speaker - if your expert will require translation assistance in Court, this will inevitably make their evidence more difficult to follow. Secondly, the expert also provides the Court with assistance on the issue of whether an alleged inventive step was obvious at the priority date, and persuasive evidence on this point is strongest from someone with relevant contemporaneous experience.

Ideally therefore, you are looking for someone who was working in the right field at the right time, and who does not have an inventive mind. In reality, it is rare to find someone who perfectly equates to the skilled person in relation to each of these requirements. It is possible for an expert witness to provide satisfactory evidence on obviousness even if they were not working in the relevant technology at the priority date, provided that they have the ability to place themselves in the position of the uninventive skilled person having regard to the common general knowledge. However, the risk in selecting an expert witness who does not approximate to the skilled person is that the other side's expert may be better placed to provide evidence as to what may or may not have amounted to an inventive step at the priority date. A related consideration is that someone with experience at the priority date is better placed to determine what was (or was not) common general knowledge. In such a situation, the other expert's evidence is likely to carry more weight on the critical issue of obviousness. No matter how persuasive or how technically capable your expert is, without contemporaneous experience, it will be difficult for your expert to rebut the opinion of someone else who approximates to the skilled person.

Beware of the hired gun. You are looking for an expert, not an advocate. A well qualified expert with independent and honest views that happen to support your client's case will be a much better choice before the English Patents Court than someone who is silver-tongued with presentational flair, but is less well qualified. It is extremely unlikely that any expert witness will wholeheartedly agree with every argument that the instructing party might want to put forward. It is much better for the instructing party to sacrifice minor aspects of

[1] *Rockwater Ltd v Technip France SA* [2004] RPC 46, per Jacob LJ

its case if the expert is ambivalent as to its merits, instead of trying to persevere with points that might expose the expert to accusations of partiality.

As a rule of thumb, if someone has already given technical evidence before a Court (or Patent Office) more than once, you will want to consider your position very carefully before appointing them as your expert. If you are tempted in this regard, you will need to do thorough research on the previous proceedings (including a detailed review of any expert reports, Court transcripts, and judgments). This will undoubtedly be time-consuming and costly, but you can be sure that the other side will go to the same lengths in the hope of discrediting your expert witness. If background research indicates that your expert has in any way expressed contrary views on a similar topic, or acted as an expert in cases involving a range of technologies where their expertise is questionable, or been the subject of criticism from another tribunal, you should reconsider your position.

Where can I find an expert?

Once you have identified the preferred characteristics of your ideal expert witness, there are a range of sources that can be used to locate someone suitable. Litigating parties are often heavily involved in research and development in the relevant area at the priority date. Reviewing the network of existing and former employees is a good starting point. This will enable you to locate the names of potential experts who were active in the relevant technology at the priority date which is exactly what you need.

If you are not so fortunate, an alternative place to start is by contacting authors of prior art cited in the disputed patent. Depending on the technology in question, there can be a vast amount of resources available on the internet. Specialist online databases storing contemporaneous documents in the relevant technology often exist, and these will contain a wealth of prior art and potential experts. It is also worth looking out for conference papers (and conference attendance sheets if available), and databases run by industry bodies. When speaking to potential experts, remember to ask whether they are able to recommend alternative contacts of their own.

You must be aware of a potential expert's commercial links and interests, including their previous employment history. Although conflicts of interest do not necessarily disqualify an expert witness, the key question is whether the expert's opinion remains independent. Both an expert and an instructing party have a duty to disclose the existence of any potential conflict of interest,[2] and any such disclosure should be contained in the expert report itself. Do not underestimate the amount of time that your expert will be required to invest in writing their report - retirees can prove attractive candidates for this reason.

How do I instruct an expert?

The starting point for all expert witnesses is compliance with Part 35 of the CPR and its accompanying Practice Direction, and the Protocol on the Instruction of Experts.[3] An expert has a duty to "help the court on matters within their expertise". One practical implication of this duty is that an expert should state in their report if a particular issue falls outside their area of expertise. An expert's duty to the Court "overrides any obligation to the person from whom experts have received instructions or by whom they are paid."[4] The Protocol articulates a useful test of independence – namely whether the expert would express the same opinion if given the same instructions by an opposing party.[5] However, those instructing an expert in patent litigation must comply with a range of additional requirements, both procedural and substantive.

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[2] *Toth v Jarman* [2006] 4 All ER 1276

[3] Creswell J. originally summarised an expert witness' duties in *The Ikarian Reefer* [1993] FSR 563.

[4] CPR Part 35.3

[5] Para 4.3, Protocol on the Instruction of Experts

The recent decision of *Medimmune v Novartis Pharmaceuticals*[6] contains clear guidance from the High Court as to the sequence in which documents should be provided to an expert in patent cases. It is important to get this right when you first make contact with any potential expert, because it will not be possible to rectify any error at a later stage.

Firstly, the expert should be provided with the prior art, and asked to express his opinions on each individual document in light of the common general knowledge that existed at the priority date. It is self-evident that the instructing solicitors will have to ask specific questions to enable the expert to focus on the relevant areas (particularly because he or she will not be guided by the patent). For example, it will be necessary to ask the expert their views on obviousness. You may also want to reformulate the obviousness question in accordance with the various different tests proposed in case law (e.g. the EPO's problem / solution approach, obvious to try etc.). These interpretations may be put forward by the other side in their evidence, and it will be more difficult for the expert to consider any such reformulations after seeing the patent.

Secondly, the expert should be shown the priority documents, and provided with a series of questions, to ascertain what the priority documents disclose. Only after the expert has formed a view on the prior art and priority documents should the expert witness be shown the patent in dispute. The High Court also confirmed that the structure of the expert report should follow the same sequence.

Of course, situations will arise where it is not possible to comply with this prescribed sequence of documents being presented, for example, if prior art is introduced after the expert has already been shown the patent in dispute. However, in light of the Court's clear guidance, these recommendations should be adhered to as far as possible to maximise the impact of the expert evidence, and avoid the reproach of the Court.

The hypothetical skilled addressee knows that a patent claim is for the purpose of defining the monopoly and that the claims are intended to claim something new. This knowledge can affect interpretation of the claim. In practice, experts are unlikely to be sufficiently knowledgeable about patent law, and an instructing solicitor is therefore required to educate the expert on these matters so that they possess these attributes of the skilled addressee. Indeed in the Virgin Atlantic v Premium[7] case the Court of Appeal held that the skilled person would have a degree of knowledge of patent practice e.g. the system of divisional patents and the role of reference numbers in the claims and the two part claim structure (pre-characterising and charactering parts).

The question of experiments may arise. There is a risk that experiments may undermine the case put forward by your expert, and such experiments must be disclosed where the expert is aware of them. As a matter of good practice, an expert should include the statement "I know of no experiment which is inconsistent with my evidence" in their report.[8] A party should therefore carefully consider whether experiments should be conducted on a particular issue before instructing an expert to do so.

It goes without saying that the expert must be a believer in the case as well – without that he/she will become unstuck at trial.

The expert report

The House of Lords (now Supreme Court) has observed that some consultation between an expert witness and legal advisers is entirely proper, but emphasized that this should not

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[6] *Medimmune Limited v Novartis Pharmaceuticals UK Limited and Medical Research Council* [2011] EWHC 1669 (Pat)

[7] Virgin Atlantic v Premium – CA [2009] EWCA 1062

[8] Practice Direction (Patents Court) [1998] 1 WLR 1414

affect the independence of the expert's evidence.[9] The appropriate extent of cooperation will vary in each case, with special considerations applying in patent disputes.

In *Medimmune v Novartis Pharmaceuticals*, the High Court recognised that expert witnesses in patent actions stand in a rather unusual position. Mr Justice Arnold recognised that due to the complex technology and legal issues involved, expert reports are typically drafted by lawyers on the basis of what the expert has told them, with the draft being subsequently amended by the expert.[10] The practical effect of this iterative process is that instructing lawyers "bear a heavy responsibility" to ensure that an expert witness is not put in a position where the expert can be made to appear to have failed in their duty to the Court. This duty goes further than simply providing the expert with copies of the relevant parts of the CPR and the Protocol.

The Court identified two potential pitfalls that could undermine expert evidence. Firstly, the instructing solicitors must draw aspects of the prior art, priority documents or patent which do not support the expert's opinion to the expert's attention and ensure that these matters are specifically mentioned in the expert report so as to provide a balanced account. Secondly, the Court concluded that the expert report must disclose any previous involvement with a similar invention to that in the patent. In practice, this could result in a lengthy list of inventions of questionable relevance at the start of the expert report, but this is preferable to having your expert's evidence undermined through allegations of partiality.

Preparation for trial

Preparation and familiarity with the patent and prior art is key, and regular meetings in the run up to trial are important to ensure the expert is comfortable with their evidence. Additionally, the legal team instructing an expert should ensure the expert understands and is familiar with the other side's evidence, including any criticisms that are likely to be levelled at his/her expert evidence.

Your expert witness is unlikely to have experience of English litigation. It is therefore usually beneficial for the expert to attend court to watch expert cross-examination in the English Patents Court, in advance of trial. This reassures the expert, and provides an insight as to the extent to which their own evidence will be tested in Court.

Before the trial, the instructing solicitors should brief the expert on the layout of the room and Court procedure, and have someone on hand to bring the expert to Court on the first day of trial. It might also be appropriate to arrange accommodation and transport for the expert witness. These may seem like trivial considerations, but an expert who is not at ease is unlikely to perform to the best of their ability.

Many of the practical considerations regarding expert evidence apply equally in continental Europe, although the appointment process and specific rules on evidence vary depending on the jurisdiction. For example, in France, experts provide written statements on technical matters, but no cross-examination is possible. The Netherlands is somewhere in between the position in France and England, in that party-appointed experts are not subject to cross-examination, but there may be cross-examination where the Court appoints an expert. In Germany, experts are appointed by the Court (often on the suggestion of a party).

In the end success at trial can be dependant upon the expert report and the way the expert comes across at trial. Preparation and care and close attention to the rules is key.

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[9] *Whitehouse v Jordan* [1981] 1 WLR 246

[10] *Medimmune Limited v Novartis Pharmaceuticals,* as above.