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Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | [customerservice@law360.com](mailto:customerservice@law360.com)

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## 6 Tips For Using An Expert Witness To Win An IP Trial

By **Erin Coe**

Law360, San Diego (September 14, 2015, 2:54 PM ET) -- One challenge lawyers face in an intellectual property trial is how to break down intricately technical and often arcane subject matter for the jury, but picking the right expert witness who resonates with jurors can be a critical factor for bringing home a win.

"Experts can be extraordinarily helpful in taking complicated, technical information and making it comprehensible to a lay jury," said Steven Hollman, a partner at Hogan Lovells. "They can make a complicated story simple and in a way that supports the narrative the trial lawyer is trying to build for the case."

Often, the expert witnesses are the ones who can make or break a case, according to Case Collard, a Dorsey & Whitney LLP partner.

"The ability of technical experts to act as a trusted translator is unbelievably important," he said. "A lot of jurors are somewhat reluctant to trust themselves with the technical issues, and they need a technical expert who they believe has a strong understanding of the subject matter and can speak to them on their level without being condescending. ... A lot of patent cases come down to whose expert gets trusted more."

Here, IP litigators share six tips on how to get the most out of your expert witness.

### **Look for Traits That Spell Credibility**

Expert witnesses touting degrees from top universities, a long list of academic publications or years of industry experience in the same area as the patents-in-suit are factors for attorneys to consider, but sterling credentials may not be enough to make them the right fit for a case, according to attorneys.

Barry Shelton, head of Pillsbury Winthrop Shaw Pittman LLP's IP group for its Austin, Texas, office, said he always looks for an expert who is going to work well with his team and who will serve as a good representative for his client and the case.

"It really is a fine and delicate balance to find the perfect expert for your case," he said. "What I want is more than credentials. I want someone to take the stand that the jury or judge will resonate with and want to believe. I chalk all that up to credibility. A lot of experts are geniuses and tops in their field, but they make terrible witnesses."

He steers clear of expert witnesses who come off as arrogant or have trouble keeping their temper or ego in check, while homing in on those who present themselves as earnest, believable and somewhat humble.

"It's really tough to find someone who appears polished, but not too polished, like a slick politician," he said. "You never want a jury or judge to sense that they are being sold a bill of goods by a used car salesperson."

Jordan A. Sigale, a director at Dunlap Codding, said because his trial team sometimes works with technical expert witnesses for hundreds of hours during the course of a case, he takes the vetting process very seriously.

In addition to checking whether potential witnesses have the relevant subject-matter expertise and are skilled in teaching others, he also studies whether they believe in what they are saying.

"I look for expert witnesses who take a position and whatever they believe, they hold it to their core, which either works for my case and I hire them, or it doesn't, and I either figure out a way to use that opinion or I don't hire them," he said. "If I only go with an expert that adopts the opinion I want to hear, opposing counsel is going to shake the crud out of the expert."

Attorneys should never ask an expert to take a position that is technically indefensible, according to Shelton.

"If experts don't believe what they are saying, they carry that sense into the courtroom, and the jury will pick up on that squeamishness," he said. "I've seen experts on the stand who've been browbeaten to give the opinion the lawyer wants, but I've never seen it work."

### **Consider Witnesses' Litigation Experience**

Attorneys also want to look at whether the expert witness has had much trial experience.

"It can be downright frightening to take an expert on his or her first trial or deposition, but on the other hand, someone who has testified at 30 trials might be something of an Achilles' heel if your adversary spins the expert as just a professional witness," Shelton said.

Sigale said he's reluctant to use professional witnesses, particularly those who hold themselves out to be experts in multiple fields.

"They're a jack-of-all-trades, but a master of none," he said. "In the computer software area, sometimes I will see the same person called in a video game case as in a business database case, and that troubles me a lot. But maybe it's a reflection that the lawyer prefers to present a difficult subject in a clear way rather than having subject matter expertise. Clearly, there has to be a balance."

Attorneys should be careful with having their witnesses overreach what they claim to be experts about, according to Hollman.

Hollman recalled one condemnation case where the other side's witness was presented as an expert economist and offered an opinion about the value of the property being condemned. But in voir dire, when Hollman asked the expert to read his business card, the expert testified that it said he was a professor of geography.

"An easy way to lose credibility is to say your expert is an expert in something he or she is not,"

he said. "It's important to keep experts confined to what they are experts in."

### **Weigh How Many Technical Experts to Use**

Attorneys also need to figure out whether they want to use the same technical expert to analyze the infringement and validity claims in the case, or whether they want separate experts for each issue, according to Collard.

Using the same person can help make sure that there is a uniform position across both sets of analysis, he said.

"If my client owns a patent, for infringement purposes, it wants to interpret the patent broadly, but for validity purposes, it wants to interpret it narrowly so that it is different from the prior art," he said. "As a result, there is always tension in the case. One expert that truly understands the arguments on both sides of the line can help you stay consistent in your arguments and avoid one expert impeaching the other."

However, if a case involves patents where there is a lot of prior art or the suit involves several patents as well as multiple defendants and accused products, it may be worth the extra cost to hire separate infringement and validity experts, he said.

"When the work is going to be so voluminous that you doubt a talented expert would be able to keep it all straight, such as five patents-in-suit and five defendants and who knows how many prior art references, at that point, attorneys may want to have two experts who focus on one task," he said.

### **Allow for Some Wiggle Room in Expert Reports**

Attorneys also need to make sure that witnesses are drafting expert reports and forming opinions that aren't overly rigid as new information comes to light over the course of a case, according to Collard.

For instance, in cases where parties are disputing how broadly or narrowly to read a patent claim and the judge sides with the party arguing for a broad interpretation, the party that sought a narrower interpretation should include language in its expert opinion that still allows it to make its best arguments in light of the adverse ruling.

"Expert reports need to be written with a measure of flexibility to account for different rulings the judge might make," he said. "You need to maintain flexibility before trial because a lot can change by the time an expert takes the stand."

### **Use Experts to Highlight the Big Picture**

Trial lawyers are always looking for ways to tie the evidence and legal standards together so that the jury understands their significance, and lawyers should make use of expert witnesses as another opportunity to put all the details into context, according to Jeffrey Homrig, a partner at Latham & Watkins LLP.

"Expert witnesses are uniquely positioned to tie things up in a bow," he said. "They can sift through evidence and help the jury see what is important to the case or why what the other side is focusing on doesn't matter."

But for expert witnesses to do that, attorneys need to prep them on what the trial themes are and

how to communicate those most effectively to the audience, he said.

"If you're on defense and your expert is trying to show how a product is different from what is in a patent claim by only focusing on the engineering details, it will probably just go over the jurors' heads or feel defensive," he said. "But if the expert explains what the difference is and takes it one step further by saying why it matters in the real world, that can help the jurors understand that the difference is important because it makes the product work the way it does or because it makes the product so popular."

Expert witnesses are central to patent cases because they are able to bridge the gap between the accused technology and the patent, according to Sigale.

"The expert witness is the one telling the story of why a product infringes the patent or why the patent is novel," he said.

Sigale secured a win a few years ago for Celsis In Vitro Inc. when a district court issued a preliminary injunction against Life Technologies Corp. in Celsis' case alleging infringement of its patent for a method of preparing multi-cryopreserved hepatocytes, a type of liver cell used in various in vitro cell testing applications, and he attributed that success in part to his expert witness.

"He was an expert in cryopreserved hepatocytes, so his subject-matter expertise was right on the money," he said. "And he was able to convincingly explain how the patented invention, which replaced human toxicity testing of potential drugs, could seem so simple yet be novel and non-obvious."

### **Give Witnesses a Feel for Cross-Examination**

Whether an expert witness is new to trials or a courtroom staple, lawyers should make sure to prepare the expert for intense grilling by opposing counsel.

"Attorneys should give them a walk-through of a cross-exam and actually cross them while making it as real as possible," Homrig said. "I've seen experts who you would think would present well, but they were skewered when they were on the stand because they were caught off guard by the style, pace or nature of questions by the opposing counsel. If you expose the witness to that, it helps them develop tools to fend off the questioning and the better off they are likely to do."

While lawyers may be jousting back-and-forth during a trial, it's important that the expert witness stays above the fray, according to Shelton.

"I've seen experts on cross-exam that have been so defensive to the point that I've had to ask the judge to instruct the expert to answer," he said. "That looks terrible to a jury, especially when an expert won't answer a question on cross after singing like a canary on direct-examination."

The goal is for expert witnesses to be as accessible and likeable during cross-exam as they are when their own attorney is questioning them, according to Homrig.

"Expert witnesses sometimes have the sense that their job on a cross is to give the opposing counsel no information," he said. "That's sometimes true, but it's usually wrong. You want the expert to be the same person on cross as they are on direct."

Instead of fighting with opposing counsel, smart expert witnesses simply say, "I disagree," and

leave it at that, according to Shelton.

“As a cross-examiner, am I going to open a can of worms with a smart professor about why he or she doesn’t agree?” he said. “I think that response is genius. But many experts don’t have that kind of self-control. They say ‘no’ and blather on, which gives attorneys plenty to attack.”

--Editing by Jeremy Barker and Emily Kokoll.

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