Experts In Patent Cases: Getting The Most Out Of Your Star Witness

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I. Introduction

In patent cases, as one respected district court judge noted, "experts and lawyers end up playing the starring roles." *Illumina, Inc. v. Affymetrix, Inc.*, No. 09-C-277-bbc, 2009 WL 3062786, at *2 (W.D. Wis. Sept. 21, 2009). Furthermore, "granting the status of expert cloaks [that witness] with some indicia of authority before the jury." *U.S. v. Wen Chyu Liu* , 716 F.3d 159, 167 (5th Cir. 2013).

Given the attention and weight that will be given to the testimony of expert witnesses, it is no surprise that litigants expend vast resources in selecting, preparing and presenting expert testimony in patent litigation. This article is aimed at providing (1) a roadmap for some of the most important issues that arise in the selection and use of both testifying and non-testifying experts; (2) an overview of the provisions concerning discovery of expert work and communications; (3) the costs and benefits in using an expert as part of claim construction proceedings; and (4) the tools available to litigants in limiting or striking portions of expert testimony prior to trial, including several recent Federal Circuit decisions that appear to have bolstered the likely effectiveness of such tools.

II. Selecting the Right Expert(s)

There are essentially three types of experts used in patent infringement litigation: (1) testifying experts; (2) non-testifying experts, whose work/opinions will be relied upon by a testifying expert; and (3) non-testifying/consulting experts. While the first two points below apply to all types of experts to varying degrees, this section focuses on the testifying expert.

A. The Testifying Expert

Conflicts. A threshold issue with all experts is the absence of conflicts. Career testifying experts will be able to run conflicts checks and alert you to any issues prior to retention. Experts with little or no litigation experience will need more hand-holding and guidance in this regard. You will be required to exercise caution and diligence in uncovering potential conflicts (while avoiding any breaches of confidentiality) and guiding the expert as to how best resolve issues that are not necessarily disqualifying.[1]

Qualifications in the relevant field of art. Often the first use of an expert is to help counsel understand the technology at issue. This job may carry over to the judge and ultimately the jury. Thus, a preliminary requirement is that the potential expert have the knowledge and background necessary to perform this job. Beyond this, the expert should have a resume that permits testifying at trial as to the particular technology at issue (i.e., avoid being excluded from trial) and, ideally, qualifications in the relevant field such that the jury is suitably impressed with his or her credentials—can counsel credibly refer to the expert in closing as "eminently qualified and recognized in their field"?

Experience as testifying expert. There may be great value in retaining an expert with experience acting in this role in litigation in general and in patent cases in particular. Such experience translates into efficiencies throughout the case—less time spent explaining the process of litigation and

[1] For a recent discussion of the type of conflict that may disqualify an expert based on a conflict with the opposing side, and citation to a number of prior relevant cases, *see Return Mail, Inc. v. U.S.,* 107 Fed.Cl. 459, 461 (Fed.Cl.,2012) (denying motion to disqualify expert witness).

the expert's role as well as conveying the demands put on their time—such as the time it takes to draft an expert report, prepare for deposition, etc. Testifying at trial gives the expert a comfort level in the courtroom (and can provide counsel with insight from those involved in prior cases as to how that expert might perform at trial). One can groom a novice expert, but it takes a leap of faith at the time of retention that the person will morph into the type of expert that will serve your client well—that the individual will be not only objective and assertive (bringing value to the case through careful thought and questioning of the issues), but will become an advocate for the positions that you ultimately develop together.

Presentation skills/personality. Unless your client has indicated that your particular matter is not going to trial (or it is highly likely to be decided on summary judgment), the likeability factor is going to come into play with any jury. The jury must be able to understand, and more importantly, believe in your expert. This requires the ability to teach as well as to inspire confidence. Characteristics to look for:

- Confidence without arrogance
- Conviction with humility
- Credibility (affecting sincerity and certainty of positions)
- Relatability
- Ability to teach
- Ability to create and relate useful analogies for difficult technical concepts
- Ability to withstand examination/scrutiny
- Sense of humor

While one can name many other personality traits that tend to make a witness appear credible, in the end this

assessment will come down to the judgment of counsel. Therefore, counsel should be extremely wary of selecting any testifying expert without an in-person interview, preferably with more than one trial team member present. While phone/video conferences can convey knowledge, experience and clarity of speech, and recommendations can provide other counsel's insight into how that witness performed in the past, only you know the particulars of your case, your judge and, most importantly, your jury pool. If you are not familiar with the latter, local counsel input should be sought and their advice carefully considered.

In regard to the selection of testifying experts, the ideal candidate has both impeccable qualifications in the relevant art and excellent presentation skills. Often times, however, counsel is faced with candidates who are strong in one area, but lacking in the other. While a minimal level of skill in both categories is a must, the question then becomes which is the deciding factor. Many courts allow multiple technical experts to give opinions on the various liability issues that can arise in patent cases, recognizing different skill sets may come into play and, moreover, that the entire technical workload may be too burdensome for one individual to carry. In that instance, you may choose to retain two (or more) experts, allocating and dividing issues to play on the strengths of each—one bringing the charm, the other the ideal technical resume. Counsel can let the charisma of one expert play to the jury, while simultaneously being able to leverage the detailed analysis and technical competence of the other.

In courts where repetition and duplication is strictly policed, counsel will need to carefully carve out discrete topics for multiple experts. Even when that is done, some judges are so strict on efficiency and avoiding cumulative testimony before the jury that only one technical expert will

be permitted. In that instance, counsel may face a choice between charisma and competence. In that instance, one must look at the particulars of their case and determine which factor has more importance. For example, in a case where validity is strongly challenged, it may be that technical expertise is of higher value. An expert discussing what would or would not be obvious in the art is open to effective attack if that expert was not in the art at the relevant time period or is not intimately familiar with the industry.

B. Non-Testifying "Supporting" Experts

There may be instances in which the knowledge of your "main"/testifying expert needs to be supplemented. In that instance, you may choose to use one in the art who can provide information and, more commonly, perform any testing that might support the opinions of your testifying expert. This supporting expert must have the particular technical skill set and means to fill this role and need not have the presentation skills that one looks for in a testifying expert. That said, the supporting expert/consultant must be fully competent, diligent and thorough in his or her work. In addition, the support experts cannot be meek or overly humble—they must have full confidence in their results and opinions as well as the ability to skillfully defend that work in deposition or, potentially, trial. Unlike testifying experts, arrogance is rarely a problem.

III. Fed. R. Civ. P. 26 Rules Governing Interactions Between Counsel and Experts

For cases filed on or after December 1, 2010, new federal rules regarding expert discovery apply.[2] While the

[2] Most courts have considered the new rules to apply to cases *pending* as of December 1, 2010. However, for cases in the midst of discovery at the time of transition to the 2010 rules, those courts not applying the new

new rules have been in place for some – albeit brief – time, an understanding the current rules is aided by looking at how the Rules were most recently amended.

A. Testimony From "Non-Experts"

Before discussing the treatment of testifying experts under the new rules, a note about individuals who may be called to testify but have not been specifically retained to provide expert testimony is in order. For these experts, the proponent of the testimony must disclose to other parties:

- (i) the subject matter on which the witness is expected to present evidence under Federal Rule of Evidence 702, 703 or 705; and

- (ii) a summary of the facts and opinions to which the witness is expected to testify.

Fed. R. Civ. P. 26(a)(2)(C).

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rules outright have handled them in a variety of ways depending upon the particulars of the case. *See CIVIX-DDI, LLC v. Metro. Reg'l Info. Sys., Inc.*, No. 2:10cv433, 2011 WL 922611 (E.D. Va. Mar. 8, 2011). Because the case had commenced before the December 1, 2010 effective date of the Rule 26 amendments, the parties filed a joint motion seeking an express ruling that amended Rule 26(b)(4) governed discovery in the case. The court ruled that since discovery had not commenced until well after the effective date of the revision and the parties had ample remaining time to conduct discovery, application of the amended rule was just and practicable. *See also Daugherty v. Am. Express Co.*, No. 3:08-CV-48, 2011 WL 1106744 (W.D. Ky. Mar. 23, 2011). The court found that it was "just and practicable" to apply the 2010 amendments to Rule 26(b)(4) to the case, even though it had commenced in federal court on January 17, 2008 and discovery had been originally set to close on December 1, 2010. Thus, documents containing communications between the expert and Plaintiff's attorney were privileged. The court did not provide express reasoning for why application of the revised Rule was "just and practicable."

While this type of "expert" testimony is encountered frequently in product liability and personal injury litigation (e.g., in the case of treating physicians or government or insurance accident investigators), it is less clear when this rule would apply in patent infringement cases. The most likely type of witness in a patent case would be an employee of the party who will give technical testimony but whose job is not to give such testimony (i.e., the employee was not retained specifically to give expert testimony).

B. Cases Interpreting Rule 26(a)(2)(B) & (C)

- *Chesney v. TN Valley Authority*, Nos. 3:09–CV–09, 3:09–CV–48, 3:09–CV–54, 3:09–CV–64, 2011 WL 2550721 (E.D. Tenn. Jun. 21, 2011).

The court denied plaintiff's motion to exclude defendant's expert witnesses for failure to provide expert reports as required by Rule 26(a)(2)(B) and/or to provide a summary of the facts and opinions to which each witness was expected to testify as required by Rule 26(a)(2)(C)(ii). Because defendant's witnesses were participants in the events triggering the litigation, and because they were scientists and engineers who had used their "specialized knowledge" in the course of their employment duties, they were witnesses for the purposes of Rule 26(a)(2)(C)(ii). Moreover, the disclosures provided for each witness, stating the witnesses' name, position, address and a summary of the expected expert and factual testimony, complied with Rule 26(a)(2)(C).

- *Carrillo v. Lowe's HIW, Inc*., No. 10cv1603–MMA (CAB), 2011 WL 2580666 (S.D. Cal. Jun. 29, 2011).

The court ruled that the physicians who treated the plaintiff after an accident on the defendant's premises, and who he designated as "retained" expert witnesses in his disclosures, were actually non-retained expert

witnesses under Rule 26(a)(2)(C). However, because the plaintiff had not provided a summary of the facts and opinions to be presented at trial by the physicians, their testimony was limited to that of percipient witnesses and could not extend to matters beyond the treatment they rendered to the plaintiff.

- *Graco, Inc. v. PMC Global, Inc.*, No. 08-1304 (FLW), 2011 WL 666056 (D.N.J. Feb. 14, 2011).

None of plaintiff's four "Employee Opinion Witnesses" regularly provided expert testimony as part of their job duties and therefore were not subject to Rule 26(a)(2)(B)'s requirements. Defendant, however, was entitled to a disclosure stating the subject matter and a summary of the facts and opinions proffered by the Employee Opinion Witnesses pursuant to Rule 26(a)(2)(C).

- *Downey v. Bob's Discount Furniture Holdings*, 633 F.3d 1 (1st Cir. 2011).

In a footnote, the court noted that although it had reviewed the lower court's decision in light of Rule 26(a) as it existed at the time of trial, the December 1, 2010 revisions support distinguishing on-the-scene experts from those hired in anticipation of testimony for the purposes of Rule 26(a)(2).

C. The Evolution of Expert Discovery

The biggest changes in the Federal Rules in 2010 affecting patent experts come in the area of expert discovery. Experts and attorneys no longer have to stipulate around obligations to produce draft reports or communications between experts or take extreme measures to avoid creating discoverable work product (e.g. notes, draft reports

(protected by Rule 26(b)(4)(B) or communications between experts and attorneys (protected by Rule 26(b)(4)(C))). The changes enhance the ability of experts to "collaborate with counsel to develop and refine theories and opinions."[3] The new rules are also intended to save resources by deterring opposing counsel from probing into expert-attorney work product, which (for better or worse) means the attorney can take a more open and active role in drafting expert reports.

Below is a summary of the salient areas of change in 2010, the former rule, the new rule and the relevant Advisory Committee Notes. In many instances, counsel may be familiar with this structure as parties in the past have often agreed to these types of conditions at the outset of the case, either as part of a joint pretrial statement or protective order.

Area of Change	**Former Rule**	**Current Rule**	**Advisory Committee Notes[4]**
Non-retained "expert" witnesses	Created "a tension that [] sometimes prompted courts to require reports under Rule 26(a)(2)(B) even from witnesses exempted from the report requirement." Advisory	Requires disclosure of subject matter of testimony with summary of facts and opinions. Rule 26(a)(2)(C).	Mandates that a summary of the facts and opinions to be presented at trial by any non-retained expert must be disclosed, but a full expert report is not required. "This disclosure is considerably

[3] Patrice Schiano & Thomas E. Hilton, *Comments of the American Institute of Certified Public Accountants on Proposed Amendments to Rule 26 of the Federal Rules of Civil Procedure*, Feb. 17, 2009, at 2, http://www.aicpa.org/InterestAreas/ForensicAndValuation/NewsAndPublications/Advocacy/DownloadableDocuments/FRCPFinal.pdf.

[4] *See* Fed. R. Civ. P. 26, Adv. Committee's Notes (2010).

Area of Change	**Former Rule**	**Current Rule**	**Advisory Committee Notes[4]**
	Committee Notes.		less extensive than the report required by Rule 26(a)(2)(B)."
Drafts of reports	The old rule was that, absent the parties' agreement to the contrary, all drafts shared with counsel were subject to discovery.	Drafts of reports or disclosures from testifying experts are no longer subject to discovery regardless of the form in which the draft is recorded. Rule 26(b)(4)(B).	Discovery "regarding draft expert reports or disclosures, is permitted only in limited circumstances and by court order."
Communica-tions with counsel	Communications between experts and counsel were discoverable.	Communications protected regardless of the form of the communications, subject to three exceptions: (i) compensation; (ii) facts or data the expert considered in forming opinions; and (iii) communications that identify assumptions	"The addition of Rule 26(b)(4)(c) is designed to protect counsel's work product and ensure that lawyers may interact with retained experts without fear of exposing those communications to searching discovery."

Area of Change	Former Rule	Current Rule	Advisory Committee Notes[4]
		relied upon by expert. Rule 26(b)(4)(C).	
Information considered by expert witness	Experts were required to disclose all "data or other information" considered.	Experts are required to disclose only "facts or data considered." Rule 26(a)(2)(B)(ii).	"The refocus of disclosure on 'facts or data' is meant to limit disclosure to materials of a factual nature by excluding theories or mental impressions of counsel. At the same time, the intention is that 'facts or data' be interpreted broadly to require disclosure of any material considered by the expert, from whatever source, that contains factual ingredients."

Importantly, Rules 26(b)(3)(A)(i) and (ii) leave the door open for discovery into:

1. Materials otherwise discoverable under 26(b)(1); and
2. Materials for which the party has substantial need and could not otherwise obtain without undue hardship.

D. Cases Interpreting Discoverability Under Rule 26(b)

- *Skycam, Inc. v. Bennett*, No. 09-CV-294-GKF-FHM, 2011 WL 2551188 (N.D. Okla. June 27, 2011).

Defendant sought to compel production of an attorney's notes taken in connection with interviews of experts and/or preparation of expert reports in order to demonstrate, for *Daubert* purposes, that the experts were nothing more than a "conduit" for attorney argument. Citing amended Rule 26(b)(4), which the court was applying retroactively, the court found that the notes were not discoverable.

- *Dongguk University v. Yale University*, No. 3:08-CV-00441, 2011 WL 1935865 (D. Conn. May 19, 2011).

An expert witness' hand-written notes did not qualify as drafts of an expert report or communications between the expert and counsel and were therefore not protected by Rule 26(b)(4)(B) or (C). Additionally, redacted statements of facts and assumptions in a memo provided by plaintiff's counsel, and relied upon by the expert, were discoverable. Conversely, redacted statements in the memo that did not relate to compensation, facts or counsel's assumptions did not fall under Rule 26(b)(4)(C) exceptions and were protected from disclosure.

- *D.G. v. Henry*, No. 08–CV–74–GKF–FHM, 2011 WL 1344200 (N.D. Okla. Apr. 8, 2011).

  Notations or highlights made by a retained expert on case files did not constitute facts or data and were not discoverable under Rule 26(a)(2)(B)(ii). In contrast, statutes and policies considered by the expert in forming his opinion were facts or data and were ordered to be provided. Moreover, summaries prepared by the expert's readers from which he prepared case examples provided in his report also qualified as facts or data and were not protected drafts under Rule 26(b)(4)(B).

- *Sara Lee Corp. v. Kraft Foods Inc.*, 273 F.R.D. 416 (N.D. Ill. 2011).

  Defendants' expert served two roles for the same case—that of a testifying expert on one issue and that of a non-testifying consultant on a separate issue. The materials generated uniquely in the expert's capacity as a consultant were not discoverable unless plaintiff could show exceptional circumstances under which it was impracticable to obtain the same subject by other means. Further, because the requested materials were merely suggestions on how defendants might conduct a study, they were not "facts or data" (Rule 26(a)(2)(B)(ii)) or assumptions provided by counsel and therefore were protected under Rule 26(b)(4)(C).

- *National WesternLife Insurance v. Western National Life Insurance*, No. A-09-CA-711 LY, 2011 WL 840976 (W.D. Tex. Mar. 3, 2011).

  A Texas district court held that a retained testifying expert's communications with a consulting expert were fair game for discovery only to the extent that the testifying expert relied upon or would rely upon those

communications to form his opinions. Under revised Rule 26(a)(2)(B), the defendant was only required to produce the "facts or data" relied upon by the testifying expert in forming his opinions. "Thus, only to the extent communications from [the non-testifying expert] included 'facts or data' that [the testifying expert] relied upon, would such communications be subject to discovery." Because the defendant had produced all such e-mails between the experts that contain facts or data, the court found it had complied with Rule 26. The court further found that the plaintiff had not shown any entitlement to discovery from the non-testifying expert under Rule 26(b)(4)(D)—"facts known or opinions held" by a non-testifying expert are not discoverable unless the party seeking the discovery shows "exceptional circumstances under which it is impracticable for the party to obtain facts or opinions on the same subject by other means."

IV. Use of Experts in Claim Construction

Claim construction is one of, if not the, most important elements of a patent case. It is thus unsurprising that litigants generally retain and work with an expert (or multiple experts) as part of developing a claim construction strategy. However, while working with an expert to vet claim construction positions with regard to infringement and invalidity is obviously prudent, the question of how much visibility the expert should have—whether in the form of a written declaration supporting claim construction or active participation in a *Markman* hearing—is a more complicated question. This section discusses the primary considerations one should include in determining how active a role their expert should play in claim construction.

In construing claim terms, the starting point for any court is the intrinsic evidence, namely, the claims themselves, the specification and the prosecution history. *Teleflex, Inc. v. Ficosa N. Am, Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002). Expert testimony technically constitutes extrinsic evidence, which is "less significant" than intrinsic evidence and generally regarded as less reliable in determining an appropriate construction. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317-18 (Fed. Cir. 2005) (en banc). District courts, however, must also give claim terms their "ordinary and customary meaning," that is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Id.* at 1312-13. A retained expert—or an inventor essentially providing expert testimony—is often the best source for understanding how one of ordinary skill in the art would understand any given claim term, thus opening the door for expert testimony to be considered more valuable than many other sources of extrinsic evidence (e.g., dictionaries or other resources). However, district courts retain discretion to reject an expert's testimony on claim construction if that opinion is outweighed by the intrinsic evidence. *See, e.g., Inpro Licensing, S.A.R.L. v. T-Mobile USA, Inc.*, 450 F.3d 1350, 1357 (Fed. Cir. 2006) ("This Court has recognized that extrinsic evidence and expert testimony can help to educate the court concerning the invention and the knowledge of persons of skill in the field of the invention, even as we have cautioned against undue reliance on experts. The decision as to the need for and use of experts is within the sound discretion of the district court.").

There are several issues to consider in electing to insert an expert into your claim construction proceedings—whether simply in support of briefing or as a participant in a *Markman* hearing.

First, does the complexity and size of the case require the use of an expert in claim construction? It is not uncommon that cases settle shortly after the claims are construed. Experts will typically require a substantial up-front investment to get up to speed, with additional costs coming from potential deposition and attendance at the *Markman* hearing. While many attorneys and clients instinctively muster every possible source of evidence in support of their claim construction, financial realities should not be ignored. This is particularly true in cases where the claim terms are likely to be readily understood by the court.

Second, do the majority of your proposed constructions rest on "plain meaning" or on (arguably) clear definitions propounded by the inventor in the patent itself (i.e., has the inventor acted as his or her own lexicographer)? If so, it may be in your best interests to avoid the use of an expert so that you can credibly dismiss your opponent's efforts to "obfuscate" the plain meaning of the term through the use of its expert. Obviously, the converse position is also important to consider. If the lion's share of your likely proposed constructions are more nuanced, requiring an explanation of why "plain meaning" in a vacuum differs from the more appropriate "plain meaning" to one of ordinary skill in the art, then it may be invaluable to include an expert declaration in support of your briefing.

Third, how experienced is your judge? This would encompass not only experience in patent litigation generally—which may indicate the court may be better positioned to evaluate arguments on the briefs alone—but also experience handling your particular technological area. While it is relatively uncommon for district court judges to have advanced technical knowledge, certain judges have gained substantial expertise in particular technical fields simply by presiding over matters in that field in the past. Finally, what is the perception about your judge's willingness

to review and ability to comprehend what may be very complicated legal and technical arguments? Whether because of workload or personal habit, some courts can be expected to enter the *Markman* hearing with an understanding of the central disputes, while others may be relying on a bench brief drafted by a clerk with little or no technical or patent litigation experience. If your arguments are going to be meaningfully evaluated for the first time during a hearing, having an expert available may be more important.

Fourth, how does the potential value of using your expert during *Markman* proceedings compare to the dangers associated with exposing the expert to an early deposition and cross examination at the hearing? Most courts will permit an early deposition of an expert that submits a declaration in support of claim construction briefing. While the party offering the expert can try to limit the scope of the deposition to claim construction issues, there is undoubtedly a risk that the opposing party will obtain some valuable testimony that might later be used as part of infringement or invalidity disputes. This danger is compounded because the deposition is taken relatively early in the case, often before a party may have nailed down all of its positions with respect to infringement and invalidity.

Finally, it is difficult to generalize about the use of experts at *Markman* hearings because of the wide range of claim construction procedures used in district courts across the country. Many courts do not automatically hold such hearings, and instead require that the parties move for one. The Western District of Wisconsin—one of several popular patent venues—now requires that the parties explain why each particular term requires a hearing; otherwise, claim construction is done as part of summary judgment briefing. In contrast, the local patent rules of the Northern District of California—another popular patent venue—contemplate an

early, separate *Markman* hearing involving expert testimony.[5] Furthermore, there are a wide range of views amongst district court judges about the value of expert testimony. Given these variances in procedure, it is important for any defendant to quickly research (and discuss with local counsel) the claim construction procedures used by any given court. As discussed above, these procedures, and most notably whether the court accepts expert testimony at a *Markman* hearing, may be valuable inputs in the expert selection process.

V. Tools for Limiting or Striking Expert Testimony

"Vigorous cross-examination, presentation of contrary evidence, and careful instruction on the burden of proof are the traditional and appropriate means of attacking shaky but admissible evidence." *Wellogix, Inc. v. Accenture*, L.L.P. 716 F.3d 867, 881 (5th Cir. 2013) (quotations omitted). However, the Supreme Court's *Daubert* and *Kumho Tire* cases and their progeny reinvigorated the trial court's "gatekeeper" function to ensure that expert testimony is relevant and reliable. *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579 (1993); *Kumho Tire Co. v. Carmichael*, 526 U.S. 137 (1999). Given the often paramount importance of expert testimony in patent litigation, it is unsurprising that there is extensive precedent from the Federal Circuit concerning the appropriateness of pretrial motions to strike or limit expert testimony. In this section, we will discuss some of the basic precedent for moving to strike or limit expert testimony, as well as recent indications from the Federal Circuit that pretrial motions, particularly in the damages context but potentially in other areas as well, may more effectively be used to limit expert testimony that heretofore would have likely been subject to attacks merely as to weight and not admissibility.

[5] *See* N.D. Cal. Patent L.R. 4-3.

A. The Federal Circuit's Recent Precedent Suggests Additional Avenues for Excluding Expert Opinion

Federal Rule of Evidence 702 governs the admissibility of expert testimony and states that an expert is permitted to provide an opinion if "(1) the testimony is based upon sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness has applied the principles and methods reliable to the facts of the case." In *Daubert*, the Court emphasized that Rule 702 requires that trial courts "ensure that any and all scientific testimony or evidence admitted is not only relevant, but reliable." 509 U.S. at 589. Subsequently, in *General Electric Co. v. Joiner*,[6] the Supreme Court confirmed that the trial court's exclusion of expert testimony was subject to the highly-deferential abuse of discretion standard. *Id.* at 142-43. In so doing, the Court also clarified that a trial court should examine not only the methodology an expert uses, but also the expert's conclusion based on that methodology. The Court held that it is appropriate to strike an expert's opinion where that opinion "is connected to the existing data only by the *ipse dixit* of the expert. A court may conclude that there is simply too great an analytical gap between the data and the opinion proffered."

District courts have used, and the Federal Circuit has upheld, the use of *Daubert* and its progeny to strike expert opinions for a wide range of reasons. Some more recent examples include: (1) the expert's failure to rely for his infringement opinion on nothing more than marketing materials that did not, by themselves establish that the asserted claim limitations were present in the accused device[7]; (2) the failure of an expert to undertake sufficient

[6] 522 U.S. 136 (1997).

[7] *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342 (Fed. Cir. 2007).

review of the accused products and how they function, and to account for alternative explanations for alleged proof of infringement[8]; and (3) the expert's basing their opinion on claim constructions contrary to those adopted by the court.[9]

While litigants have been using *Daubert* to exclude experts in patent litigation for years, several recent Federal Circuit decisions have indicated that such motions – particularly in the damages context but not necessarily limited thereto – may result in the exclusion of opinions that heretofore would have simply been subject to cross examination as to weight. *See, e.g.*, *Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292 (Fed. Cir. 2011); *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301 (Fed. Cir. 2009); *ResQNet.com Inc. v. Lansa, Inc.*, 594 F.3d 860 (Fed. Cir. 2010).

While a detailed discussion of the impact of these cases on the merits of certain theories of recovery will be left to others, this section will address how these cases may be used to limit or strike an expert's opinion heading into trial.

In *Uniloc* the Federal Circuit rejected the use of the so called "25% rule of thumb" in determining a reasonable royalty, finding that it

> [I]s a fundamentally flawed tool for determining a baseline royalty rate in a hypothetical negotiation. Evidence relying on the 25 percent rule is thus inadmissible under *Daubert* and the Federal Rules of Evidence, because it fails to tie a reasonable royalty base to the facts of the case at issue." 632 F.3d at 1315.

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[8] *Furminator, Inc. v. Kim Laube & Co., Inc.*, 2010 WL 5184899 (E.D. Mo. 2010).
[9] *Hochstein v. Microsoft Corp.*, 2009 WL 2022815 (E.D. Mich. 2009).

While this element of the decision, by itself, presented a substantial change in damages jurisprudence, *Uniloc* is also noteworthy for the court's going further in discussing the general applicability of *Daubert* in patent cases—and in so doing apparently giving more teeth to potential motions to limit or strike expert testimony.

For example, after addressing the 25% rule of thumb directly, the court continued by apparently signaling a greater willingness to entertain *Daubert* (or *Kumho*) motions in other contexts:

> The bottom line of *Kumho Tire* and *General Electric Co. v. Joiner* . . . is that one major determinant of whether an expert should be excluded under *Daubert* is whether he has justified the application of a general theory to the facts of the case.[10]

The *Uniloc* court went further when, citing *ResQNet*, it held that "[t]o be *admissible*, expert testimony opining on a reasonable royalty must carefully tie proof of damages to the claimed invention's footprint in the marketplace." *Id.* at 1317 (emphasis added). The court's use of the term "admissible" is telling because neither *ResQNet*, nor *Lucent*, were on appeal based on the exclusion of expert testimony, but were instead based on the court's overturning damages verdicts that the Federal Circuit believed improperly relied on nonanalogous license agreements and an improper application of the so-called "entire market value rule." The implication is that a party should now aggressively move to strike, as opposed to simply cross examine, opinions that are based on such agreements, or any other evidence that arguably is not "carefully tied" to a damages claim.

[10] *Id.* at 1316 (quoting *ResQNet.com Inc.*, 594 F.3d at 869).

While the foregoing paints a picture of the Federal Circuit's willingness to support more aggressive *Daubert* motions, at least one other recent case indicates that experts must be given the latitude to advocate by selectively relying on evidence bolstering their position. In *i4i Limited Partnership v. Microsoft Corp*., the court rejected an argument that i4i's damages expert's opinion was improper because there was evidence clearly contradicting that opinion:

> Microsoft is correct that i4i's expert could have used other data in his calculations. The existence of other facts, however, does not mean that the facts used failed to meet the minimum standards of relevance or reliability [under Fed. R. Evid. 702]….While the data were certainly imperfect, and more (or different) data might have resulted in a "better" or more "accurate" estimate in the absolute sense, it is not the district court's role under *Daubert* to evaluate the correctness of facts underlying an expert's testimony.

598 F. 3d 831, 855-56 (Fed. Cir. 2010). Nor will reference to the 25% rule automatically result in inadmissibility, if the expert relies more prominently on other factors. *Energy Transp. Group, Inc. v. William Demant Holding A/S*, 697 F.3d 1342, 1356 -57 (Fed. Cir. 2012) (finding reference to the 25% rule did not "irretrievably damage the reasonableness" of the expert's method and result in arriving at recommended royalty rates).

It appears that neither the Federal Circuit nor the district courts have cited *Uniloc* in excluding liability opinions. However, the more general language in *Uniloc*, when read in concert with *Daubert* and *GE*, would arguably support more aggressive motions to strike such opinions.

B. How and When to Move to Strike or Limit Expert Testimony

There are several potential points in litigation at which to try to limit or strike an expert's opinion. This section will focus on three of the most common: (1) in the form of a discrete motion brought any time after the expert has filed their expert report; (2) as part of a summary judgment motion; and (3) as part of motions *in limine* immediately prior to trial, or at trial. Each of these presents different risks and potential benefits.

1. Discrete motion to strike or limit testimony

There are no particular limitations on when a party may separately move to strike an expert's opinion. Obviously, such a motion should be brought after the expert has filed any opening and, if expressly permitted, supplemental report. The advantage of this approach is to potentially gain substantial leverage relatively early in the case. However, it is likely that, to the extent discovery is ongoing and trial is not imminent (i.e., the danger of prejudice to the nonmovant is low), a court could be persuaded to simply permit supplementation rather than the extreme sanction of striking an expert opinion. It is important to understand the individual judge's preferences in this regard before electing to move discretely, as opposed to in conjunction with the additional options discussed below.

2. Motion brought as part of summary judgment

There are several benefits to including a motion to strike as part of summary judgment. First, summary judgment has been referred to as the "put up or shut up" phase of litigation, and a court may be less sympathetic to a party's request for supplementation at that point in litigation.

Second, by moving to strike as part of a summary judgment filing, the movant can place an expert's deficiencies in the broader context of the case. For example, with regard to an obviousness claim, it is one thing to criticize an expert's failure to adequately explain why a person of ordinary skill in the art may have been motivated to combine certain references, but it will be significantly more persuasive to make the same argument while pointing to the extensive contrary evidence from your own expert. Finally, moving to strike an expert's report, even if denied, can serve to further undermine the credibility of the expert's arguments, thereby potentially impacting the court's consideration of the merits of the motion as a whole.

3. Motion brought *in limine* immediately prior to trial or during trial

Of the three options identified above, this may be the most common means to try and strike an expert's opinion. Discovery has closed, so there is little or no danger that the court will permit supplementation. However, the court may nonetheless be concerned about pulling the rug out from under the nonmovant, and elect to simply let the jury hear the contested opinion while reserving its authority to overturn the verdict as a matter of law. The danger in this reservation, of course, is that briefing for JMOLs can take place weeks or months after trial, and the court's own view of the evidence may be colored at trial. Furthermore, even if an expert lacks a legally defensible basis for an opinion, there is always a danger that the expert, through sheer force of personality, can impact the trial even beyond the subject of their own testimony.

In evaluating means to limit expert testimony, it is important to not only consider striking an opinion, but also ensuring that an expert does not attempt to expand upon their

written opinion during trial. Rule 26 requires that the expert's report must include "a complete statement of all opinions the witness will express and the basis and reasons for them." Litigants must aggressively police adherence to the written report (and any supplementation if applicable) to avoid potential disaster during trial. For example, a patentee's expert may have offered an opinion concerning literal infringement in their report, but not infringement under the doctrine of equivalents. During trial, for any one of a number of reasons, it may become apparent that the patentee desires to give the jury at least the possibility of equivalents, and may attempt to slip in an opinion concerning that theory of infringement during the expert's direct examination. Similarly, an expert may have rendered an obviousness opinion based on a certain combinations of references in their written report, only to discover during final pretrial preparations that other combinations may be more palatable to a lay jury. The opposing party would have compelling arguments to preclude any such expansion of the expert's opinion at the 11th hour.

C. A Motion to Strike or Limit Expert Testimony Must Be Evaluated in Light of Overall Trial Strategy

While the Federal Circuit's recent string of cases has bolstered the likely effectiveness of pretrial motions aimed at limiting or striking expert opinions, in considering the use of such tools it is important to evaluate them in the context of overall trial strategy. For example, a motion to strike certain portions of an expert report based on the misplaced reliance on an (arguably) nonanalogous license agreement may simply serve to remove a compelling ground for cross examining the expert in front of the jury—cross examination that might have adversely colored the jury's perception of even the expert's more well-grounded opinions. It is often true that a more focused case is a more effective case, and

trial attorneys must be careful to consider whether the short term gains from striking portions of an expert's opinion are outweighed by the value to impeachment down the road.

VI. Potential Safety Valve

As a final note, one should not always view the exclusion of expert testimony as a death knell for the underlying claim or defense, if there is another witness that can bring in the supporting evidence. For example, in *Meyer Intellectual Properties Ltd. v. Bodum, Inc*., the Federal Circuit upheld the district court's exclusion of expert testimony regarding certain prior art that was not fully disclosed in the expert's report. 690 F.3d 1354, 1374 (Fed. Cir. 2012). *However*, the Federal Circuit reversed the obviousness determination, finding that the district court went too far in preventing the defendant from introduce this prior art through other witnesses:

> Where, as here, the technology involved is simple, we can think of no explanation for excluding prior art that was disclosed in interrogatory responses but was not relied upon in an expert report. As this court recently reiterated, "[t]here is no invariable requirement that a prior art reference be accompanied by expert testimony." *In re Brimonidine Patent Litig.*, 643 F.3d 1366, 1376 (Fed.Cir.2011) (citation omitted). It is well-established, moreover, that, where the technology involved is easily understandable, expert testimony is not required. *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1242 (Fed.Cir.2010); *see also Centricut, LLC v. Esab Group, Inc.*, 390 F.3d 1361, 1369 (Fed.Cir.2004) ("In many patent cases expert testimony will not be necessary because the technology will be 'easily understandable

without the need for expert explanatory testimony.' " (citation omitted)).

Id.

VII. Conclusion

The selection and use of experts are two of the key drivers for success in patent litigation. Given the extensive considerations involved, it is vital that litigation (and specifically trial) counsel make an early and substantial investment in these areas. Furthermore, such counsel must be aware of the myriad tools at their disposal to potentially limit or strike their opponent's expert completely, and be able to evaluate the potential value of these tools as part of overall case strategy.