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5 Ways Ineffective Expert Witnesses Can Doom Patent Cases

By **Ryan Davis**

Law360 (September 3, 2019, 5:05 PM EDT) -- Expert witnesses are crucial in patent trials, since juries of laypeople need a guide through arcane technology, but an ineffective or ill-prepared expert can cripple a case. Here's a look at some of the biggest mistakes made by experts and the attorneys working with them.

Crafting powerful expert testimony begins years before a jury is selected, and involves choosing a person with the right experience and demeanor, educating them about the case and the law, and crafting graphics that make the technology clear. It is such a make-or-break part of litigation that it demands the attention of the highest levels of the trial team.

"I've seen experts in jury trials who have lost cases that should have been won," said Michael Abernathy, co-leader of the intellectual property disputes practice at Morgan Lewis & Bockius LLP. "That's where lead counsel ought to be spending his or her time, on the expert side of the case. It's not something to outsource to less experienced folks."

Bad Teachers Make Bad Experts

The best expert witnesses are skillful teachers, helping light bulbs go on for jurors as they begin to grasp topics like semiconductor fabrication that they may never have encountered before. Not everyone can do that, even professors with impressive resumes, so the first job for attorneys is to assess the expert's teaching ability.

When interviewing potential experts, it can be helpful to ask them to explain the subject of their doctoral dissertation, their current research, or the most challenging technical problem they've ever encountered, said Mark Supko, former chair of the IP group of Crowell & Moring LLP.

"Through the course of those answers, you're going to find out whether or not they're able to teach," he said. "Because I'm not going to know, at that point in the case, all that much about the technology. If they can't explain their technical expertise to me in a way that I can understand it, I wouldn't have lot of

confidence that they're going to be able to do that with the technology of our case, explaining it to a jury."

In-person interviews give the best sense of a potential expert's teaching skills, Abernathy said, adding, "I've passed on retaining well-credentialed, industry-leading experts because I thought they could not relate well to people."

"If they are very academic, if they immediately try to get into the weeds without first introducing the overall concept, that's usually a dangerous signal," he said.

Yet it's equally important not to dumb down the material so much that it's oversimplified. That can come off as condescending to jurors and may omit information that is key to the case, and attorneys need to make sure it doesn't happen.

Michael Morin, global co-chair of the IP practice at Latham & Watkins LLP, recalled that he worked on a case where the opposing side's expert compared a complex medical device to a bus, an analogy that was too elementary and didn't really explain the technology.

"He ended up being exposed as simplifying it to the point that it was inaccurate and incomplete. It's important for your expert to have integrity and credibility in front of the jury," he said.

Cross-Examination Meltdowns Sink Credibility

Dazzling jurors with a technical expert's academic pedigree, industry track record or teaching ability may help make them believable, but that impression can be short-lived if the expert's behavior on cross-examination casts doubt on their honesty and trustworthiness.

Attorneys must strive to avoid situations where an expert's polished demeanor on direct examination falls away upon adversarial questioning and "when it gets to cross-examination, they're like a different person," Supko said.

"They're obstructive, their personality changes, they get closed," he said. "All that goes to credibility. Juries pick up on that."

Experts who are obstructionist or confrontational on cross-examination, or refuse to concede any point while criticizing the questions, are certain to make jurors think twice about the arguments they made.

"If there's a big difference in their demeanor, that suggests to the viewer that there's something wrong," said Michael Rader, former co-chair of the litigation group at Wolf Greenfield & Sacks PC. "Either they're on the defensive, or they're hiding something, or they're not comfortable."

Role-playing by attorneys during trial preparation to simulate cross-examination can mitigate that. Trying to push the expert's buttons and make it as difficult and stressful as possible is key, Supko said,

because "if you just roll the dice and hope that they can do it without having practiced it, I think that's pretty risky."

"They need to understand that you can't do a Jekyll and Hyde when you're being questioned by the other side," he said. "That's not to say you want to roll over when you're getting cross-examined; you still want to stick to your guns. But you have to have the same personality and the same type of presentation."

Weak Graphics Can Be Fatal

There's virtually no chance a jury is going to be able to understand the technology in a patent trial just by being told about it in words, even by the best teacher. Graphics and other demonstratives are crucial to getting them to wrap their heads around it, so attorneys, the expert, and the graphics team must work closely together on visual elements of the presentation from the very start and "really perfect it to the nth degree," Rader said.

"Sometimes these things get left to the last minute and people are scrambling the week before the trial," he said. "In my opinion, that's a huge mistake."

Abernathy said the importance of a dedicated graphics team cannot be underestimated, because experts left to their own devices may create slideshows that are overly complex, cover too much ground or just consist of sentences on the screen that they end up reading aloud.

"Jurors' eyes will just glaze over if there's a lot of things on the screen, and they will stop listening, I guarantee that," he said. "You need to use graphics to reinforce persuasion, and your graphics are serving just the opposite goal: They're causing people to turn off."

A trial where a judge praised his expert's graphical presentation "seared in my soul" how important it is to start working on them as soon as the expert is retained, Abernathy said.

"What I'm describing is expensive, no doubt about it," he said. "But patent cases that are going to go to trial tend to have lot riding on them, and I think you're at a very, very big disadvantage if you don't do that."

Nevertheless, graphics can't look too slick or overproduced, Morin warned, since "people tend to think that things that look like Hollywood might not be true."

Information Overload Befuddles Jurors

Experts who usually have an entire semester to explain themselves may struggle with the time limits in a patent trial, so attorneys must make sure they use that time judiciously, rather than cramming in as much as possible.

"It often comes as a shock to an expert that they're going to have to present infringement or invalidity issues across a dozen claims to a jury and they're only going to have two or three hours to do it," said Derek Walter of Weil Gotshal & Manges LLP. Attorneys and experts therefore must focus on things that "give you the best bang for your buck from a legal standpoint," he said.

That means identifying the best arguments that will read on the most products or knock out the most claims, because marshaling a litany of alternative theories can backfire. If your best and second-best arguments aren't persuasive, your third-best is going to be even less so, Rader said.

"The expert is not going to be able to maintain the enthusiasm level on the fifth prior art reference either," he said. "It's going to come across as, We're throwing in the kitchen sink."

An effective expert witness is animated and engaged, and excited to explain to the jury just how persuasive their argument is, Rader said, "so maintaining focus and keeping it relatively simple is very important."

Similarly, a single expert might be better than a small army each focused on different issues, since "it's harder to maintain consistency across the different experts," Walter said, and one person is better able to tell a coherent story and establish rapport with the jury.

There Are No Shortcuts

The best expert presentations at patent trials are often the products of hundreds of hours of work, often stretching across years, and cutting corners will come back to bite the expert and threaten the case.

"I've had so many times where experts on the other side didn't do the work," Rader said.

He cited one patent owner's expert who never tested the devices and based infringement contention on things the defendants said in internal documents. Such arguments crumbled in the face of detailed models and experiments by his expert showing just the opposite, making the patentee's expert "come across looking silly," he said.

Being an expert witness is a big job, so attorneys need to be realistic about that up front and find someone with the time and energy to devote to it.

"If they don't work hard before they get to the stand, they're going to be exposed," Morin said.

--Editing by Brian Baresch and Alanna Weissman.

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