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The Expert in U.S. and German Patent Litigation

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The expert often plays a crucial role in patent litigation in both Germany and the United States. Determination of facts and application of law to facts frequently require a technical understanding that only an expert can provide. Despite the similarity of the problem of conveying information to the decision-maker, the role of the expert in the two systems and the manner in which the problem of providing technical knowledge necessary for the decision is solved are so very different, that German jurists who transfer their German experiences and expectations over to US procedures, are in danger of experiencing great disappointment if not disaster. [1] American practices relating to the selection and preparation of expert witnesses are so different from European practices, that their explanation to European jurists is said to cause "amazement... bordering on disbelief. " [2] Knowledge of American practices can both ease involvement in an American patent lawsuit, whether as party or as expert, and contribute to a better understanding of the risks and costs of patent lawsuits in the United States.

I. Different Roles and Different Goals

Experts have fundamentally different roles in the German and US systems of civil procedure. These different roles reflect the different roles that judges

have in the two systems and the different goals of the systems of civil procedure.

The proper role of the expert has received much attention in Germany in the recent past. [3] The different views are variations on two principal opposing positions. On the one hand, there is the view that has prevailed since the middle of the nineteenth century, that the expert's testimony is a form of proof. Just as all other forms of proof are, it is subject to the principle of free evaluation of the evidence; judges are to review the expert's proof and based on their own convictions, to determine whether to credit it. Supporting this view is raised the argument that Arts. 92 and 97 of the German constitution, which provide respectively that judicial authority shall be invested in the judges and that judges shall be independent and subject only to the law, preclude allowing experts a farther reaching competence.

The prevailing view is challenged as not in keeping with reality. Critics contend that one cannot properly speak of free evaluation of the evidence, when judges in the great majority of cases follow the opinion of the expert. Consequently, critics call for recognizing reality and propose that the expert should have the role of **Gehilfe** (helper) or **Berater** (adviser), that is, that the expert should take on a "judge-like role". Indeed, the natural conclusion of this argument is that the expert should ascend the bench ("Der Sachverständige auf der Richterbank"). Making experts into judges solves the constitutional problems posed by Arts. 92 and 97.

Experts appear in three principal roles in German patent litigation: as court-appointed experts in infringement actions, as technical judges in invalidation actions before the Patent Court, and as privately-commissioned experts. In making experts into technical judges in the Patent Court, the minority view of the expert as judge has prevailed for proceedings in that court. Except for the privately-commissioned expert, the expert in German litigation is supposed to be neutral and impartial. In German patent litigation, as in German litigation generally, the privately-commissioned expert plays a subordinate role. His testimony does not even attain the status of evidence but is treated as simply a party contention.

The role of the expert in American civil procedure is quite different. The party-commissioned expert is the rule, while the court-appointed expert is the very rare exception. In the United

States, the expert almost has the role of advocate. Just as each party has its own lawyer, in patent litigation each party

has its own expert or experts. Naturally, a party does not knowingly produce a witness to testify in favor of the other side. In American patent litigation there are no technically-expert judges. Indeed, there is little room for the expert to take on a role as adviser to the judge or even a role as technical judge, since factual questions - including technical ones - are often for a jury to decide. While the deficiencies of a system of "expert advocates" has long been noted in the United States, proposals to remedy the resulting deficiencies through introduction of a system of neutral, court-appointed experts more similar to the German approach have been largely unsuccessful. [4]

The experts' roles in the two systems of civil procedure also reflect the different goals of the two systems of civil procedure. The goal of German civil procedure is the evaluation of a concrete legal situation in a correct judicial opinion. [5] The judge requires a report that he can incorporate into a formal opinion that justifies his factual and legal holdings. American procedure has a more limited goal: settlement of concrete legal disputes. There is no attempt to record the results of an evaluation of an investigation. The emphasis is on providing a completely neutral decision-maker that after a full presentation of both sides of a controversy, resolves it in favor of one side or the other. A jury can choose between two competing views, but it is not sophisticated enough to formulate its own independent conclusions in a document resembling a German judgment.

II. Use of Experts in Patent Litigation

The court-appointed expert in German patent litigation is said to be used most frequently to provide proof in infringement cases on issues relating to equivalence. Judge Neuhaus of the Düsseldorf Court of Appeals estimates that such court-appointed experts are used in about 5-10 % of all infringement cases. German judges who are regularly involved in patent litigation may do without experts if they are able to judge the arguments of the parties without them. [6] Because German court organization assigns patent infringement cases to special patent senates, the judges ordinarily are experienced with patent matters. In invalidation actions court-appointed experts have little practical importance, because these cases are tried before the Patent Court, where the bench consists of technical expert judges in addition to a professional judge. [7]

Experts are used more frequently in American patent litigation than in German litigation. Indeed, it is the rare contested case where experts are **not** used. In American patent practice, expert witnesses are usually classified as either "technical" or as "patent" experts. The technical expert is typically an engineer or scientist, while the patent expert is usually a patent lawyer. The technical expert's function is to explain the relevant technology to the trier of fact - whether judge or jury. The patent expert, on the other hand, serves to explain patent office procedures.

A patent expert is necessary in American patent litigation, because invalidation actions as well as infringement actions are tried in the regular courts by ordinary judges, where issues of fact may be determined by lay juries. Moreover, unlike in Germany, there is no specialization in the regular courts by type of case, so that judges in patent cases often have had little or no prior experience with patent cases. [8] Therefore, the significance of patent office procedures often must be explained to decision-makers unfamiliar with them.

While the technical expert of American patent litigation might seem a familiar concept to German jurists, German jurists are well-advised even with respect to this small subset of experts, not to transfer their German experience over to their expectations of American practices. Technical experts in American litigation usually have more important roles than do their counterparts in German litigation. This is partially a function of the lower level of technical expertise of American courts. In American patent litigation, judge and jury are usually unsophisticated technically. The technical expert explains to them in laymen's terms every material aspect of the inventions

concerned. Because of this lack of technical sophistication, judges ordinarily are expected to allow expert testimony even on purely legal issues such as claim construction. [9] Use of an expert may be necessary to get matters of opinion into evidence that could not be proven by lay witnesses. [10] Since experts are commissioned by the parties rather than appointed by the court, experts of one party are often used to keep experts of the other party "honest" or even to discredit them. Finally, in American litigation generally, testimony is much less focused on particular points, so that experts, like all witnesses, are questioned more broadly than are their German counterparts. [11]

III. Selection of the Expert

Just as the judge in German litigation generally controls proof-taking, the judge in patent litigation closely controls the selection and use of expert witnesses. Before an expert witness can be called, the judge must make a decision to take such evidence. In the decision to take such evidence, the judge sets out the subject of the testimony. [12] Whether the judge decides to take expert testimony lies in the judge's properly exercised discretion. [13] The judge decides which expert to call.

In German litigation, experts are supposed to be impartial. The importance of impartiality is underscored by the requirement that - in a system that does not normally require witnesses to give oaths - experts must give oaths of their impartiality. [14] A party may seek to disqualify an expert on the same grounds as a judge; the most important ground is a justified concern for bias, such as arises when the expert is an employee of a party or has some other prior connection to a party. [15]

American procedures are quite different. As in American litigation generally, the parties control the selection of expert witnesses. Bearing in mind that Ur. procedure seeks to provide each party an opportunity to present "its case" fully to an independent fact finder, it is natural that each party selects its own expert or experts. After all, the expert is offered by the party to support its own case. This means, of course, that in American litigation there are one or perhaps more experts for the plaintiff and one or more for the defendant, rather than a single court-appointed expert as in German procedure. While provisions exist that permit the American court to appoint an expert on its own motion, little use is made of this possibility. Indeed, the federal rule authorizing court-appointed experts explicitly states that "Nothing in this rule limits the parties in calling expert witnesses of their own selection. " [16] The American judge exercises comparatively little control over the use of experts. Whereas in German litigation, the parties must convince the judge of the **affirmative** need to involve an expert, in American procedure it is the reverse: they must convince the judge of the reason to **exclude** the expert offered by the opposing side. In American procedure generally, the parties

control which witnesses are to be presented, in order to assure them the fullest opportunity to present their cases. They may produce an expert whenever it will assist the trier of fact. "When opinions are excluded, it is because they are unhelpful and therefore superfluous and a waste of time. " [17] Of course, since the trier of fact is often the jury, the judge cannot easily categorically determine that expert testimony in a complex patent case is likely to be "unhelpful. " As a result, judges rarely exclude qualified expert testimony unless it is repetitive.

Under American procedures, it is for the judge to determine if an expert is qualified before permitting testimony. Under the rules of civil procedure, qualification may be based on "knowledge, skill, experience, training, or education. " In practice, parties are given a fairly free hand in designating experts to support their cases and it is relatively uncommon for a judge to disqualify the parties' choices. It is thought that the parties should have the widest possible opportunity to present their cases. So long as the expert is minimally qualified, the party should have the chance to present him. That the competing expert is better qualified goes more to credibility than to whether the expert should be permitted to testify at all.

Since the parties select the experts and present the experts to support their cases, they naturally only want to present experts that will help their cases. Inasmuch as experts are presented and paid by the parties, they are recognized as being predisposed toward the side that presents them. [18] Consequently bias is not a general ground to disqualify an expert and connection to a party is no ground for disqualification. Indeed, in patent cases, it is said the inventor is "the ideal expert witness. " [19] Commonly, experts are employees of parties to the litigation.

Characteristics of a desirable expert witness are not all the same in the United States as in Germany. To be sure, some characteristics are the same, such as, for example, eminence in the field. Eminence contributes to authority and persuasiveness alike. However, because the form of the expert's testimony is different, as are the audience and the use to which it is put, certain external characteristics assume an importance in selection in the United States that are not generally considered so important in Germany. In Germany, the expert's testimony is usually set out in a written report and only incidentally

commented upon in open court. In the United States, in contrast, the expert's testimony is usually given orally in open court. The expert is subject to sharp questioning by the opposing attorney to try to break that testimony. In Germany, the evidence of the expert is considered by a professional judge, who has experience with patent litigation. The German judge may incorporate the expert's opinion into the judgment of the court and should be convinced of the reasoning used. In the United States, the evidence of the expert is heard by technically unsophisticated people - whether judge or jury. They must be persuaded of the correctness of the one expert's testimony as contrasted to that of the opposing expert; they need not be convinced or even understand the reasoning of either expert. Consequently, in the United States, attorneys selecting experts must be particularly conscious of the external impression that the expert makes on laymen. Does the expert have a pleasing demeanor? Does the expert seem sincere? Is the expert able to respond intelligently to unexpected questions such as may arise in cross-examination? American lawyers give a lot of thought to these externalities when they select the most persuasive expert possible.

IV. Direction of Expert's Investigation

In German patent litigation, the judge focuses the activities of the expert witness. Commonly, the judge first sends the file of the case to the expert for review and then sets a hearing to instruct the expert. [20] At the hearing the judge ordinarily advises the expert about the facts in the case that the judge views as established, informs the expert which facts the expert is to investigate, and instructs the expert in the peculiar problems of patent law. [21] The parties state their positions and the expert has the opportunity to ask questions of both the judge and the parties. [22] The expert is then instructed to prepare a written report.

There is no comparable direction by the American court of the activity of the expert witness, indeed, there is virtually no direction of the expert by the judge at all. Instead, the expert works closely with the attorney for the party that has retained him. It is the party's attorney who decides in general what the expert is to testify about at trial. Usually, as is often done with ordinary witnesses, the party's attorney prepares a script in question and answer form that incorporates the testimony that the expert is to give in open court. [23] The primary form that the expert's report then takes is responding to questions before the judge or jury posed by the parties' attorneys.

In German writing on Ur. procedure it is reported that American expert witnesses are "saxophones," [24] that is, they are instruments that play the tune called for by the party's attorney. While this criticism is not without support, it is an exaggeration, especially when applied to patent litigation. It overlooks that often there is not a single "correct" answer and that there may be room for a range of legitimate expert opinions that differ from each other. To be sure, in patent litigation as elsewhere, the parties' attorneys only call experts that support their positions. They work closely with their experts to shape the experts' testimony at trial in order to make a good

impression ("coaching").. But it is probably uncommon for an expert in a patent case to take a position ' simply because the party's attorney asked him to. Attorneys in American patent litigation are counseled by their colleagues to be wary of the expert who agrees too readily with the desired position. They are told not to attempt to persuade an expert to take a position that the expert is not comfortable with. [25] Experts, as all witnesses do, take an oath to testify truthfully. [26] In particular, accomplished experts are not likely willingly to take positions that can be successfully attacked as incorrect.

V. Evaluation and Control of the Expert's Proof

In German patent litigation, once the expert presents the report, the parties have an opportunity to comment on it in writing. Then a hearing is held and the parties may question the expert about the report. The expert may be asked to make a further report or the judge may even order that an additional expert be used. [27] The judge then reviews the report and the parties' comments and, at least in theory, reaches his own conclusion whether to credit the report. The judge then incorporates so much of the report as deemed appropriate into his judgment.

In American litigation, there is rarely an evaluation of expert testimony in the sense of an independent formulation of it in the conclusion of a formal opinion of judge or jury. That is because there is no opinion in a jury case and even in a bench trial, there is often no opinion similar to a German judgment. [28] Usually, there is either acceptance or rejection of the expert's conclusions. Consequently, when speaking of American litigation, rather than speaking of evaluation, it is better to speak of control of the expert's testimony.

Control of the expert's testimony comes about in two principal ways. Since experts are presented by the parties, the opposing side has the opportunity to

present its own experts. Thus, the trier of fact has a choice of testimony to accept. The other way the expert's testimony is controlled is through cross-examination, that is, through questioning of the expert by the opposing party's attorney.

A. Discovery

In order for cross-examination to be effective, the other side must know beforehand what the expert will testify. [29] The acquisition of this knowledge takes place in the so-called "discovery" phase of pretrial proceedings, when the parties investigate the case largely unsupervised by the trial judge. Special rules govern discovery of expert witnesses [30] and a fair amount of "gamesmanship" is needed to deal with this discovery. [31] The party's expert is only subject to discovery once the expert has been designated as a trial witness by a party. Consequently, the party presenting the expert usually defers designation as a trial witness until the last possible moment. So long as the expert remains just a "consultant," his activities need not be disclosed. On the other hand, the party that wishes to discredit an expert in cross-examination, wants to get discovery of the expert as soon and as often as possible. That party's goal is to get the expert to commit himself to a position that he will regret later. [32]

During the discovery phase, each side can require the other to identify the experts it intends to call at trial and to state the substance of the experts' testimony. [33] The other side often answers such a request, except on the very eve of trial, by saying it has not yet decided which persons it intends to call as experts. In order still better to learn the content of the expert's intended testimony, upon application to the court, which is liberally granted, the attorneys may question the expert in a deposition.

B. Cross-Examination

The goal of the "control" of the expert's testimony is nothing less than the "successful debilitation" of the expert, or as colloquially put by one author, "cracking the egg." [34] It is hard to convey to European lawyers unfamiliar with techniques of American cross-examination just how

brutal that can be. In a patent case, often the focus of cross-examination will not be the correctness of the expert's testimony on critical issues in the case, but rather the expert's

credibility. The American attorney is advised to "set up" the witness and then to "destroy" the expert's credibility. [35]

The basic technique of an attack on credibility is to confront the expert with inconsistent statements. One American litigator counsels: "Prior inconsistencies, like rare coins, are not easily found. They must be discovered or created." [36] They are discovered by searching the record closely - by examining everything relevant that the expert has ever said or published. Prior inconsistencies are created in discovery and at trial. In discovery, the attorneys try to get the other side's experts to commit themselves to positions. They drag out depositions to increase the likelihood that there will be inconsistent statements. At trial, they try to "control" the testimony of the experts they cross-examine. They "lead" the expert witnesses to desired answers with questions that can only be answered yes or no. Trial lawyers are advised that they "should almost never allow the expert to give a narrative answer." [37] They are told that experts should "be led without deviation. " [38] They are to "surprise" the witness, to "generate conflict" and to "focus on weakness. " For as one litigator advises: "An expert may testify to 10 correct facts and one incorrect fact. If the cross-examination focuses on the one incorrect fact and the expert's credibility is impeached, in all likelihood the expert's entire testimony will also be tainted. " [39]

VI. Conclusion

It should be no surprise that expert testimony in U.S. patent litigation is much more costly than in Germany. The costs in time and money are absolutely necessary if disaster at trial is to be avoided. Experts must be carefully interviewed until the "right" one is found who will testify the right way. The chosen expert must be carefully coached before he takes a position and before he is presented to the other side for deposition. The expert must be prepared on a wide range of topics before being subjected to cross-examination in deposition or at trial. The expert must be relied upon to check the opposing expert's testimony. Compared to the focused German procedure, it is no wonder that costs in time and money are so much higher - costs which ordinarily fall not on the losing party, but on the party incurring them, as is generally the rule in "American litigation. [40]

Whether expert testimony is a general matter more or less reliable in Germany or the United States is a question less easily answered. Accurate testimony in the United States may be successfully upset in cross-examination on grounds wholly unrelated to its correctness. On the other hand, inaccurate testimony in Germany may be accepted without ever being subject to close scrutiny because the judge is unwilling or unable to do his duty and evaluate the evidence himself. The German system, in allowing for only one expert, may work better where there is only one "correct" answer. The American system, on the other hand, may better respond to those situations where there is no single "correct" answer and only a range of possibly right answers.

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[1] Cf. SCHACK, "Einführung in das US-amerikanische Zivilprozeßrecht" 57 (Munich. 1988). Generally as to the danger of transferring German expectations to U.S. procedures. see MAXEINER, "Die Gefahr der Übertragung deutschen Rechtsdenkens auf den US-amerikanischen Zivilprozeß," 1990 RIW 440.

[2] LANGBEIN, "The German Advantage in Civil Procedure," 52 University of Chicago Law Review 823, 835 (1985).

[3]With respect to this controversy, see generally ARENS, "Stellung und Bedeutung des technischen Sachverständigen im Prozeß," in GILLES (ed.). "Effektivität des Rechtsschutzes und verfassungsmäßige Ordnung," 299 (Cologne, ete., 1983); MARBURGER, "Wissenschaftlich-technischer Sachverstand und richterliche Entscheidung im Zivilprozeß," (Heidelberg. 1986); PIEPER, BREUNUNG & STAHLMANN, "Sachverständige im Zivilprozeß: Theorie. Dogmatik und Realität des Sachverständigenbeweises" (Munich. 1982).

[4]E.g., American Law Institute, Model Code of Evidence 198-216 (Philadelphia. 1942). See also ENDLICH, "proposed Changes in the Law of Expert Testimony," 32 American Law Review 851 (1998); 1 WIGMORE, Evidence § 563 (Boston, 2d ed., 1923).

[5]Cf. PIEPER in PIEPER ET AL., at 12.

[6]NEUHAUS, "Der Sachverständige im deutschen PatentverletzungSprozeß," GRUR Int. 1987 483 . 485 .

[7]BENKARD ET AL.. "Patentgesetz Gebrauchsmustergesetz. Kurzkommentar" § 88. Point 6 (Munich, 8th ed., 1988).

[8]Only at the appellate level is there a special patent court, the Court of Appeals for the Federal Circuit. Its members are jurists and not technical judges such as the German Patent Court has.

[9]Moeller v. Ionetics, Inc., 794 F.2d 653, 657 (Fed. Cit., 1986).

[10]See Federal Rule of Evidence 701.

[11]See MAXEINER, 1990 RIW 444.

[12]NEUHAUS, GRUR Int, 1987 485 .

[13]Federal Supreme Court decision, Metronidazol, GRUR 1975 425 . 428 ; NEUHAUS, GRUR Int, 1987 485 .

[14]Code of Civil Procedure. Sec. 410 (I).

[15]Code of Civil Procedure. Sec. 406 (I). To this extent. the view of the expert as a "Rechtsgehilfe" is accepted in current law. See THOMAS & PUTZO, "Zivilprozeßordnung" (Munich. 16th ed., 1989).

[16]Federal Rule of Evidence 706 (d). Since almost all patent litigation takes place in federal court. only federal rules are discussed. State practices are, however, generally similar,

[17]Note of the Advisory Committee to Federal Rule of Evidence 702. citing 7 WIGMORE, "Evidence" § 1918. The Rule provides: "Of scientific. technical. or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill. experience. training, or education. may testify thereto in the form of an opinion or otherwise. "

[18]HAYES, "Cracking the Egg: Cross-Examining the Expert in a Patent Case," Trial. Vol. 25. No. 6, 56 (June 1989); JESSUP "Patent Expert as Trial Witness," 71 Journal of the Patent and Trademark Office Society 59, 64 (1989).

[19]HOFER, "Experts in Patent Cases," Litigation. Vol. 8. No. 2. 44. 45 (Winter 1982).

[20]NEUHAGS, GRUR Int, 1987 485-86 .

[21]NEUHAUS, GRUR Int. 1987 486 ; THOMAS & PUTZO § 402 "Vorb."

[22]NEUHAUS, GRUR Int, 1987 486 .

[23]See JESUS at 61.

[24]SCHACK. at 57.

[25]JESUS at 60. 61.

[26]Federal Rule of Evidence 603.

[27]See LANGBEIN 839; NEUHAUS, GRUR Int. 1987 486 : THOMAS & PUTZO, § 411.

[28]See MAXEINER, 1990 RIW 441.

[29]See Advisory Committee Note to Federal Rule of Civil Procedure 26 (b) (4), 1970 Amendment,

[30]Federal Rule of Civil Procedure 26 (b) (4).

[31]See JESUS at 60, 62.

[32]See JESSUP at 62, HAYES, at 56.

[33]Federal Rule of Civil Procedure 26 (b) (4) (A) (i).

[34]HAYES, at 56, 59.

[35]HAYES, at 60.

[36]HAYES, at 56.

[37]HAYES, at 56.

[38]HAYEs, at 56.

[39]HAYEs, at 60.

[40]See JESUS at 64-65; Crawford Fitting Co. v. Gibbons, 482 U.S. 437 (1987).