



How to Hire an Expert

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Table of Contents

Executive Summary.....	Page 1.
Expert Witnesses in Intellectual Property Matters.....	Page 2.
Early Expert Engagement is Key.....	Page 3.
Categories of Experts.....	Page 3.
How Experts can be Utilized.....	Page 5.
Experts Witness Fees.....	Page 6.
How to Find an Expert.....	Page 6.
Expert Witness Services.....	Page 7.
Qualities of an Expert Witness.....	Page 8.
What Expertise is Needed?.....	Page 8.
Retaining an Expert Witness.....	Page 10.
Confidentiality.....	Page 12.
Expert Reports.....	Page 13.
Deposition Testimony.....	Page 14.
Replacing an Expert Witness in the Middle of a Case.....	Page 15.
Expert Witness Opinions and Objectivity.....	Page 15.
Managing Expert Witnesses.....	Page 16.
Expert Witness Services Companies.....	Page 16.
Expert Witness Fees.....	Page 17.
Subject-Matter Expertise.....	Page 18.
Conclusion.....	Page 19.
About the Author.....	Page 20.



Executive Summary

An Expert Witness is a recognized authority in a relatively narrow area of expertise. This guidebook will focus on Experts in scientific subject-matter. Here are some fundamental essentials:

1. Generalists do not normally make the best Experts.
2. Expert Witnesses are important to the litigation process.
3. Expert Witness opinions carry great weight in the final outcome of litigation.
4. Expert Witnesses are objective, independent subject-matter experts. They are not advocates.
5. Ultimately, the Judge determines if an individual is an “Expert” in their field.

An Expert Witness should be a recognized authority in a relatively narrow area of expertise. Generalists do not usually make the best Experts. The best Expert Witness is a person who by virtue of education, training, experience and practical knowledge can assist the Trier of fact in understanding technology issues relevant to the litigation. An Expert Witness is an important component in the litigation process. The Expert Witness' opinion and testimony can carry great weight in the final outcome of litigation. An Expert Witness must be knowledgeable person in his or her field, have exceptional communication skills and be a fair and objective individual. An Expert Witness is not an advocate, but one who brings their own opinion to bear on the technical issues and opinions. The determination of who can be an Expert is initially determined by the litigation team, but ultimately the judge decides if you are an “Expert” and have the requisite expertise to give testimony.

There are very few instances in civil litigation or criminal prosecution when an Expert Witness is not required. Even in non-litigation legal activities, such as mergers and acquisitions, the advice of a subject-matter expert can be critical to a satisfactory outcome. In disputes where technical issues are key Expert Witness support is important. In any intellectual property matter, such as patent infringement, theft of trade secrets, copyright infringement, etc., Expert Witness support is vital. In intellectual property litigation, for example, timing is critical. Retaining a high-technology consultant early in IP litigation is a faster and more efficient approach to analyzing a case and conducting discovery than the traditional approach of turning associate attorneys loose on hours of research just to get a handle on whether a client has a defensible case. Below are some instances when an Expert is usually required:

1. If you are involved in litigation, you will probably need Expert Witness support.



2. If you are involved in a criminal prosecution, you will probably need Expert Witness support.
3. If you are conducting technical due-diligence for a merger or acquisition, you will probably need Expert Witness support.
4. If you are conducting financial due-diligence, you will probably need Expert Witness support.
5. If you are involved in patent infringement litigation, you will **ABSOLUTELY** need Expert Witness support.

Expert Witnesses in Intellectual Property Matters

In the typical scenario, a large IP client notifies outside counsel that they have been put on notice, accused of patent infringement. Those enforcing their patent portfolios, or patent asset management firms enforcing the portfolios of others, will demand substantial royalties based on the company's gross revenues generated from the sale of the allegedly infringing products. There are only a few options, including but certainly not limited to: 1. Capitulate and enter into a restrictive license agreement that requires years of royalty payments 2. Investigate whether or not allegations of infringement are factual given the claims of the patents being asserted. 3. Investigate whether or not the patent(s) being asserted are valid under Title 35 rules. Here are some basic guidelines:

1. Timing is critical in intellectual property litigation.
2. Retaining a subject-matter Expert early is better, faster and less expensive than attorneys' hours of research to determine if your client has a defensible case.
3. Those enforcing patent portfolios will demand substantial royalties based on the company's sales of allegedly infringing products. The alleged infringer has only a few options:
 - a. Capitulate and enter into a restrictive license agreement that requires years of royalty payments.
 - b. Investigate whether or not allegations of infringement are factual given the claims of the patents being asserted.
 - c. Investigate whether or not the patent(s) being asserted are valid under Title 35 rules.

Only option one, surrendering to the patent owner's demands, doesn't require the support of a subject-matter expert. Even for experienced lawyers, the decision can't be made until it can be determined whether their client's products actually infringe on the asserted patent claims. However, more than litigation skill is needed to make this determination.



What is required is the skill of a seasoned professional who is expert in the relevant area of technology to locate, research, analyze and interpret the associated pieces of prior art. Prior art is, by definition, all the information that has been disclosed to the public in any form one year before the patent's filing date.

Early Expert Engagement is Key

One of the key benefits of having a subject-matter expert at your disposal is to interpret the technical jargon that will be used by fact witnesses and the opposing Expert Witness. In legal proceedings that involve technological disciplines it is vitally important that the attorney litigating the case have a clear understanding of the meaning of terms and how they apply to and impact the evidence. Without a background in the applicable technology only the professional experience and expertise of a well-qualified Expert Witness can provide this assistance. In cases that involve highly technical issues, the Expert Witness should be engaged and brought to speed well before the deposition of fact witnesses to help the attorney craft meaningful interrogatories that can go to the heart of the relevant technical issues. Any litigation has four possible outcomes, (i) settlement, (ii) summary judgment, (iii) verdict or (iv) dismissal. The Expert Witness's influence can help in the ordering of these events to the benefit of the end-client

The key benefits of having a subject-matter expert at your disposal include:

1. Interpreting technical jargon that will be used by fact witnesses and opposing Expert Witnesses.
2. Assisting in patent claims construction (plaintiff) or rebutting infringement claims (defendant).
3. Helping the attorney craft meaningful interrogatories.
4. Keeping relevant technical issues in focus.

Any litigation has four possible outcomes:

1. Settlement
2. Summary judgment
3. Verdict
4. Dismissal

Categories of Experts

There are different classifications of "Expert Witnesses" depending on the role they are given by the engaging law firm. In technical matters, this can be any individual who is



likely to be either an industry practitioner or academic who has no conflicting affiliation with any of the parties, who can offer an objective opinion regarding the technical questions relevant to a case. In technology-related matters there are fundamentally four classifications of Experts:

1. The testifying technology “Expert Witness” engaged in a litigation or party to a due-diligence whose research will result in written or verbal opinion given under oath in an Expert Report, Deposition or at trial. Everything this individual has done or will do during the course of his or her engagement is discoverable by the opposing party. From the day this individual is engaged, he/she should keep no written records, notebooks, drafts or any documentation relating to research or analysis except the opinion that comprises the Expert Report. The opinion of the Expert will always be shaped by the case evidence that is made available by the attorneys managing the case. As a result the lawyer will likely limit exposure of evidence to the testifying Expert to only that information germane to the opinion for which the Expert was engaged.
2. The background or technical consulting Expert who works behind the scenes directly for the lawyers managing the litigation. This individual will not give testimony and his/her work product is privileged attorney-client work product. This individual is exposed to all the available information, even that evidence that could be considered damaging to the client’s case. The background Expert’s technical skills can identify problems in one’s relative position in the litigation. Quickly identifying potential technical problems with the client’s case is critical to a satisfactory outcome; which may include a quick settlement.
3. The economic or “damages” Expert will bring decades of experience with business valuations, economic and quantitative analysis, and market assessments including the assessment of economic damages in commercial disputes, medical malpractice, intellectual property, products liability, personal injury, and wrongful death cases. Depending on the matter, the economics or damages Expert will be brought into a matter either very early or late in the case calendar after fact discovery has concluded. In patent litigation it is once again important to bring this expertise to play early in the proceedings to establish the damages to be applied to allegations of patent infringement.
4. The Court-Appointed Expert or Judge’s Expert. In cases involving highly technical issues, such as a patent infringement matter, it is not unusual for the Judge to engage the services of his/her own Expert Witness. The role of this individual is to educate the Judge with respect to the technical arguments being presented by opposing party’s Expert Witnesses and to help the Judge frame questions to them to gain a better understanding of how technology might impact



the court's or jury's decisions. Court-appointed Expert Witnesses' fees and expenses are usually split between the adverse parties.

How Experts can be Utilized

An underlying principle of being an Expert Witness is that an Expert must always accept and comply with the direction of the attorney retaining their services. However, it is equally important that the Expert retain his/her objectivity and remain neutral. The Expert Witness is not an advocate; that is the role of the lawyer. The Expert Witness is not paid for his/her opinion but for the time it takes to research the evidence and come to an independent opinion. Attorneys use an Expert to support the litigation team in an ethical, fair, and objective manner to analyze and explain in human-comprehensible language all technical language and issues. In patent litigation, for example, the Expert Witness is used differently depending on whether he/she is retained by the plaintiff or defendant.

1. For the Plaintiff. The Expert can assist the litigation team in the preparation of pre-litigation claims construction to demonstrate how the defendant's products infringe the patent claims. The Expert's skill and experience can be used in the analysis of infringing products, including reverse engineering. As the case moves forward, the Expert works with the litigation team in developing the claims charts and defining of patent claims terms for the claims construction Markman hearing (the Markman ruling will be an attached document). The Expert Witness is very useful in attending the depositions of fact witnesses and the deposition of the defendant's Expert to assist the litigation team in developing relevant technical questions and understanding the testimony of the participants. The Expert quantifies his/her opinion in an Expert Report that is defended at deposition. The Plaintiff's Expert Witness reviews prior art that the defendant asserts in their patent validity arguments and writes a rebuttal report relative to the relevance of the defendant's prior art and the asserted patent claims. Expert testimony will be given at deposition, Markman and trial.
2. For the Defendant. The Expert can assist the litigation team in the preparation of a response to the pre-litigation claims construction. The Expert's skill and experience can be used in the analysis of products alleged to infringe and assist in crafting a response in the form of an Expert Report. The Expert assists the litigation team in identifying and analyzing prior art that can be used to develop validity arguments. As the case moves forward, the Expert works with the litigation team in defining the terms used in the patent claims for the claims construction Markman hearing. The Expert Witness is very useful in attending the depositions of fact witnesses and the deposition of the plaintiff's Expert to assist the litigation team in developing relevant technical questions and understanding the testimony of the participants. The Expert quantifies his/her opinion in an



Expert Report that is defended at deposition. Expert testimony will be given at deposition, Markman and trial.

Expert Witness Fees

Expert Witnesses are expensive. One can expect hourly rates that average \$100-200 per hour more than the fees charged by industry consultants. The only certainty in Expert Witness fees is that there are no rules. The hourly rates fluctuate based on the Expert's academic achievement, professional experience, years in industry or academia, experience as an Expert Witness and number of times he/she has given testimony at deposition, Markman or trial. As a general rule, academics charge more than industry practitioners. Experts with extensive testimonial experience charge more than those just beginning their careers as an Expert Witness. One can expect hourly rates ranging from \$200.00 to \$1,000.00 per hour, or more. Expert Witnesses that are retained through Expert Witness Referral services will generally cost more per hour than those that are identified directly. The reason is simply that the Referral firm applies a charge that marks up the Expert's hourly rate for their services either expressed as an additional amount per hour or percentage of the Expert's base fees. Expert Witnesses tend to charge their hourly fees on a portal-to-portal basis, much like the legal profession. The basic perspective is that an "hour is an hour," meaning that there is a charge for time spent on your matter regardless of whether it is reviewing documents, meeting with attorneys or getting to and from a meeting. Some Experts charge a differential for testimonial time

How to Find an Expert

The most common sources of Expert Witnesses are prior Expert engagements, referrals, Expert Witness referral firms, Print Directories, Online Directories, Internet search, Professional Organizations and University Web Sites, among others. When one begins a search without any direction it can be a daunting task. For example, searching Google for an "Expert Witness," will produce millions of hits. To narrow the search criteria, one must get specific about what is required to support the litigation. Whether using a print directory or online service, or simply conducting an Internet search.

To narrow the search criteria, one must get specific about what is required to support the litigation. Whether using a print directory or online service, or simply conducting an Internet search The following are important criteria to establish before beginning a search:

1. Broad technical academic credentials, such as Ph.D., Masters, Bachelors.
2. Broad industry credentials, such as P.E. (Registered Professional Engineer), CPA (Certified Public Accountant), etc.



3. Specific academic credentials such as Ph.D., Electronic Engineering, Masters Mechanical Engineering, etc.
4. Broad Technical focus, such as computer science, software, electronic engineering, physics, semiconductor process, etc.
5. Detailed Technical focus such as software including relational database management systems.
6. More detailed technical focus such as software / relational database management systems / Oracle
7. Years of professional experience.
8. Years employed by or consulting to industry relevant to your litigation.
9. Patents in the relevant technology.
10. Publications in the relevant technology.
11. Litigation support experience in the relevant technology, including experience giving testimony at deposition and trial.
12. Litigation support experience relevant to the litigation such as experience in patent infringement litigation, trade secret, etc.

Expert Witness Services

The process of identifying exactly the criteria needed in your expert, conducting a search, narrowing the available choices, interviewing candidates and vetting finalists is a time-consuming task. Many clients are reluctant or simply refuse to pay an attorney's hourly rate to conduct a search for an Expert Witness; they expect you to know who and where the Experts are that will support the litigation. The loss in billings to conduct unreimbursed searches for Expert Witnesses or conversely the cost to your client can be very high. Many law firms, large and small, have learned to depend upon the services of Expert Witness referral companies, like National Expert Witness Network, LLC ("NEWN") for this purpose. Companies like NEWN have hundreds of qualified Experts already under contract in a database that can produce candidates within hours instead of weeks with Curriculum Vita's that are complete and up to date. The beauty of these services is that there are no charges until and unless an Expert Witness is engaged.

The first task is to fulfill the criteria mentioned in the previous topic "How to find an Expert Witness" and identify candidate Expert Witnesses who meet your basic standards and technical expertise. In the vetting process one must then find an individual whose appearance, demeanor and approach to research and analysis is consistent with the requirements of the client paying the bill. Appearance and image are important factors. The old aphorism "there are no second chances at first impressions," is vitally important.



Qualities of an Expert Witness

The ability to work under pressure and maintain a calm and rational demeanor, regardless of provocation is a very important trait. Expert Witnesses must have and demonstrate the ability to support their opinions and defend them despite the barrage of “what if” metaphoric attacks that will come from opposing counsel. In technical cases, resisting this cross-examination technique is an important personality attribute. Scientists, by their very nature, education and training are problem solvers. Look for Expert Witness candidates with on-point expertise that can resist the temptation to acknowledge the relevance of opposing counsel “what if” questions designed to, at the minimum damage and at the extreme impeach the Experts sworn testimony.

Communication skills are also central to the qualities required in an Expert Witness. In patent infringement cases, for example, the Expert Witness must qualify as technically competent and be “a person having ordinary skill in the art(1)” Sometimes those of a scientific or technical persuasion have difficulty in explaining technical terms and concepts in terms that can be understood by a lay person. The litigation team and the Expert Witness must understand that the Judge and Jury will very likely not understand the technical language or issues related to a case involving technology disciplines. One must use an Expert Witness who can draw metaphors to explain complex technical concepts. Frequently used metaphors include architecture plans, for example, to help one understand the intricacies of an integrated circuit design; the flow of liquid through a pipe to describe the flow of electricity, etc.

What Expertise is Needed?

Some cases that require an Expert Witness make the choice of what expertise is needed somewhat obvious and straight forward. For example, an individual is injured by electric shock from a malfunctioning consumer product. From the perspective of an Expert Witness selection, the Plaintiff Attorney might need some or all of the following expertise:

1. An Expert in the particular type of product, such as a toaster or other appliance that generates heat and requires lots of electricity; or, an Industrial Designer or Mechanical Engineer familiar with electrical consumer products. This Expert would opine on causation to aid in the determination of financial responsibility for the injury.
2. An electrician or other Expert in residential electrical power and distribution through a residence. This Expert would opine on proper household wiring, and if a power surge was the cause of the injury.
3. An Expert in electrical shock and its affect on the human body.



4. A medical Expert to opine on the extent and long term affects of electrical shock and the specific injury to the client
5. An economic, damages or compensation Expert who can opine on the financial impact of the injury to the client's potential loss of earning power and continuing medical costs based on the medical diagnosis and prognosis.

It is typical for the Plaintiff Attorney to want these Experts nearby the law office and venue for the litigation to add convenience to interaction with the Experts and to reduce the cost for travel. It is also typical for the attorney to narrow the expertise requirement to exactly match the specifics of the complaint. For example, if the appliance that allegedly caused the shock was a toaster, a toaster expert; if the Plaintiff was employed in the food industry an expert in food industry compensation, and so forth.

One must balance the theoretical with the practical. It is important to understand that the more narrow the expertise and the closer the proximity to the law firm, the more difficult it will be to find an Expert. Many Texas law firms want Experts in a specific subject-matter that speak Texan. This isn't always possible and certainly may be unnecessary. Let's take another example. In Intellectual Property matters, for example patent infringement litigation, identifying the required expertise may be easier than finding an Expert who can qualify and serve. There is a famous technology patent that caused changes in patent rules and was the genesis for years of litigation and hundreds of millions of dollars in license fees.

US Patent 4,942,516, entitled "Single-chip integrated-circuit computer architecture", was issued to Gilbert Hyatt in 1990. This patent apparently gave full rights to the concept of the single chip microcomputer to Gilbert Hyatt, up until then a non-entity in the annals of the microprocessor. The so-called 516 patent is provided for you free as a part of this course. Caution it is a large file, over 5 megabyte, so a high-speed internet connection is desirable.

This patent apparently took 20 years to work its way through the Patent Office, long enough to build a multi-billion dollar business full of captive licensees until Texas Instruments succeeded in having the Hyatt patent overturned in 1996 and the patent invalidated in October 1998.

This patent is interesting because of the variety of technical disciplines that are embodied in it for which an Expert would be needed to assert or defend a patent infringement suit. The abstract described a Microcomputer architecture that facilitates a fully integrated circuit that functions as a computer.



The architecture includes use Read Only Memory or ROM for program storage, an integrated circuit Random Access Memory or RAM and integrated circuit logic. Additional architectural features included serial data communication, pulse modulated communication, eight bit instruction bytes, sixteen bit operand words, and shared I/O channels. Well this sounds like this patent requires a bunch of Experts, and it did.

These two examples should make one thing clear. Any litigation, whether for a malfunctioning toaster or a microprocessor, requires a clear understanding of those issues for which Expert Witness opinion is needed. Sometimes the right Expert is difficult to find. It is important to start the search for Experts as early as possible in the litigation. Identify the Experts needed, retain them and use them as required going forward. Waiting to the day before Expert designation can be a problem. In high-technology litigation, like patent infringement, it can be a disaster.

Delays in this decision process can result in a limited choice of Experts, increased travel costs, higher hourly fees and the knowledge that the opposing party has already engaged the best there is to offer.

Retaining an Expert Witness

Now you know the definition of “Expert Witness,” where to find one, and how to vet the best candidates to end up with your final selection. In engaging and retaining an Expert Witness you must first ensure that the selected candidate is free of conflicts. From the Expert’s perspective, being void of conflicts means not working for and against the same client at the same time on the same case. The Expert’s view of conflicts and the rules of ethics relative to conflicts are far different for the Expert than the engaging law firm or attorney. Before retaining the Expert, one must:

1. Disclose to the candidate Expert the names of all the parties to the litigation, any “interested” parties, i.e., corporate entities, subsidiaries, etc. and disclose the law firms and attorneys representing the opposing parties, including co-counsel in different states because of venue requirements.
2. Determine if the Expert has entered into any Non-Disclosure Agreements with company’s party to the suit or that could otherwise restrict the Expert’s ability to work and be exposed to confidential information or that would otherwise cause a motion to disallow the Expert from working on the case.
3. Ensure the Expert’s schedule is compatible with the case schedule for which he/she is being considered.



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4. Confirm with the Expert and obtain an agreement with respect to the hourly rate of the Expert and any special requirements in the Expert's fee schedule, i.e., payment for travel, expense limitations, travel restrictions, etc.
5. To the extent possible, determine if the Expert candidate has any personal or medical limitations such as Dyslexia, a disability in which a person's reading and/or writing ability is significantly lower than that which would be predicted by his or her general level of intelligence. This is a disorder not uncommon in very intelligent individuals that can greatly increase the number of hours for research and reporting.

Most large law firms have a standard Expert Witness Retention Letter they use when retaining an Expert Witness or background consultant. Expert Witness Referral Companies also have standard Engagement Agreements that stipulate their terms for engaging an Expert through their services. Frequently, these two documents are merged together to gain a common set of contract language acceptable to both parties. On rare occasions, the Expert has a Retention Agreement that stipulates the Expert's specific terms. Once again, all these Agreements have to be somehow merged to accommodate all the interested parties. At a minimum, the Engagement Agreement must contain:

1. Stated agreement between the named parties.
2. Style for the matter for which the Expert is being engaged.
3. Names of the parties and law firms.
4. Language restricting the Expert from working for the opposing party.
5. Statement of the Expert's hourly fees.
6. Statement of the retainer or deposit amount required.
7. Expense limitations, if any.
8. Payment terms and rights with respect to delinquency.
9. Names of the financially responsible party.
10. Confidentiality and/or privilege work-product language.
11. Dispute resolution
12. Written, i.e., signature, acknowledgement of all parties to the retention

Ultimately, the party who has hired a law firm to represent them in litigation, including the engagement of Expert Witnesses, is financially responsible for the Expert's fees and expenses. What can differ is the contractual means through which this payment arrangement is consummated. Many large law firms require that the Expert's retention be directly with their client, the "end-client," and that they be invoiced directly for Expert fees and expenses. Normally the attorney managing the work product of the Expert



approves the Expert's invoice and forwards it to the end-client for payment. Retention by some law firms is directly with the law firm who pays for the Expert's fees. They in turn will seek reimbursement for these fees from the end-client.

Let's review the overall process of engaging the Expert and how the Expert functions with the law firm and litigation team. This sequence is more or less ordered:

1. Engagement Letter consummated.
2. Protective Order and any non-disclosure Agreements consummated.
3. Expert briefed by litigation team.
4. Expert analyzes all relevant documents provided by or directed to by the litigation team.
5. The Expert consults with the litigation team on all technical matters.
6. The Expert assists in the preparation of patent claims construction, preparation for Markman hearing, preparation of Expert Report and formulation of deposition questions of opposing parties and Experts.
7. The Expert prepares Expert Report(s).
8. Expert deposition.
9. Expert trial testimony

Confidentiality

One should never assume the Expert is conversant with legal requirements and his/her responsibilities relative to work-product, privilege and the propriety of case information. Frequently, the terms of confidentiality are spelled out in a court ordered Protective Order. Often, the end-client will require a non-disclosure agreement to protect proprietary information. An Expert engaged as a testimonial Expert should be advised that virtually anything he/she has ever written either in an industry or legal context is discoverable. The Expert needs to know that he/she cannot write, FAX, email or otherwise provide written communications in any way unless explicitly instructed to do so by the litigation team. As a general rule, confidentiality has the following restrictions:

1. Expert shall not be bound by the obligations restricting disclosure and use set forth in the non-disclosure agreement or Protective Order with respect to confidential information, or any part thereof, which:
 - a. was known by the Expert prior to disclosure, as evidenced by its business records;



- b. was lawfully in the public domain prior to its disclosure, or business publicly available other than through a breach of this the non-disclosure agreement or Protective Order;
- c. was disclosed to the Expert by a third party provided such third party or any other party from whom such third party receives such information is not in breach of any confidentiality obligation in respect of such information;
- d. is independently developed by the Expert, as evidenced by its business records, or
- e. is disclosed when such disclosure is compelled pursuant to legal, judicial, or administrative proceeding, or otherwise required by law

Expert Reports

The format of an Expert Report is as varied as the law firms that engage Expert Witnesses who are required to produce Expert Reports. The litigation team will set the parameters for the content of the Expert Report; a jointly produced table of contents helps to avoid misunderstandings. The Report must be the unbiased work product of the Expert alone. Under no circumstances should an Expert permit the litigation team to write the report or determine the Expert's opinions. The judge will determine the admissibility of and the weight to be given to any Expert Report. Expert Reports range from the very brief, a few pages, to extensive analysis involving substantial written work. The litigation may require more than one Expert Report, each of which must be defended by the Expert Witness in deposition. There is no obligatory format. Most Expert Reports, however, contain the following information:

1. Curriculum Vita, biographical summary or written qualifications of the Expert Witness.
2. Purpose for the Expert Report.
3. List of documents reviewed with respect to the subject-matter of the Report.
4. Analysis by the Expert within a stated research methodology or testing methodology in the case of the examination of physical products or software.
5. Observations or opinion of the Expert with regard to the issues relevant to the Report as they relate to the Expert's analysis.
6. Conclusions drawn by the Expert after review of the aforementioned documents, observations and opinion.
7. Exhibits, attachments and any relevant documentation that supports the Expert's opinion.



8. An Expert Report expresses the opinions of the Expert; its form and content will often differ from ordinary scientific or engineering reports.
9. The Expert Report must apply in an objective and consistent manner a theory and/or methodology to the facts of a particular case.

Deposition Testimony

One of the reasons why law firms like to engage Experts who have experience giving testimony in deposition and trial is that they are already “trained” for the process. By reference, the engaging law firm can determine how the Expert handles the pressure of deposition, deals with adversity and articulates his/her findings. The experienced testimonial Expert makes this job much easier. When your otherwise ideal Expert candidate has no testimonial experience there is a risk as to how the Expert will handle being deposed. Some firms put the Expert in a room with a parade of Associates who take their turn at drilling the Expert and ensuring that the Expert can handle the pressures and deliver succinct answers to questions without giving away information otherwise harmful to the client’s case. There is no substitute for preparation. The Expert must know the issues relevant to the deposition, be totally familiar with the documentation supporting his/her opinion and have taken care to leave no issue open for legitimate argument. The Expert must remember the minimal rules:

1. The 5-second rule. Always take at least 5 seconds to ensure the question is understood and to give the litigation team time to object to the question. The Expert should never hesitate to ask that the question be asked a second time or rephrased if the question’s meaning is not completely understood.
2. The 30-second rule. If the answer is taking longer than 30 seconds, the Expert is probably providing too much information. The Expert must not elaborate on any answer or expand the answer to include what could be damaging testimony.
3. The "I can’t speculate" rule. When asked for an opinion on any subject for which the Expert has not been prepared or asked a question relative to documents not reviewed, the Expert must never guess or try to appease the deposing attorney. The answer should be, “I haven’t reviewed that and therefore I can’t speculate on the answer.” This has some legal significance because an Expert cannot be asked or forced to speculate on an opinion. If the deposing attorney produces a document never seen before or analyzed before by the Expert and asked to opine, the Expert is entitled to take all the time necessary to study the document before answering.

A successful deposition will produce sworn testimony that the Expert can rely upon at trial or be impeached by the opposing attorney at trial if his/her opinion at trial is



inconsistent with prior testimony or written opinion. Again, prior preparation is the key; having at one's fingertips the supporting documentation for the Expert's opinion and committing to memory any and all information relevant to the Expert's opinion. The Expert will be subject to Voir Dire (French for "to tell the truth") a process of preliminary questioning at trial through which the competence of an expert to testify may be challenged. Giving testimony at trial is the Expert's most important role. It is vital that the Expert follow the pre-testimony preparation and avoid any epiphanies or flashes of insight on the stand. The Expert should be instructed to treat the Judge and all other Court personnel with the respect and courtesy they are due and remain calm and focused during cross examination responding to questions with answers directed to the judge or jury.

Replacing an Expert Witness in the Middle of a Case

While this is a rare occasion, it does happen. In an important trade secret matter involving very sophisticated technology the primary testimonial Expert Witness was replaced three times. This is a nightmare for the law firm and a huge expense to the end-client. The first Expert became conflicted when he became associated with a start-up company one of the venture capital sources for which was the opposing party to his client in the litigation. The second Expert's schedule was compromised by personal problems that could not be ignored. Fortunately for the law firm, the original engagement was through an Expert Referral company like NEWN and their database of experts had sufficient depth in the particular area of expertise involved in the suit, that substitute Experts were quickly located and vetted for the client. It is important in the initial vetting process to rank candidates and keep their contact information up to date in the event the primary Expert Witness is or has to be removed from the litigation. They are probably the best replacement source.

Expert Witness Opinions and Objectivity

An Expert Witness is not a member of the client's legal team. The Expert is not an advocate for the client that is the role of the law firm. Experts generally are not lawyers or legal experts and should not be asked to opine on legal issues. Most important, quality Expert Witness is never a "hired gun" that will do anything or say anything for a fee. Few disputes that find their way to litigation involve "black and white" issues. They are normally various shades of gray. Neither party is completely right or completely wrong. Accordingly, it is not difficult for the skilled Expert Witness to find a way to support the opinions and goals of his/her client without compromising his/her integrity and objectivity. Nevertheless, if the Expert Witness finds that his client's opinion or position has no defensible basis, that Expert should so inform the client and withdraw from the case.



Building a team of Expert Witnesses is analogous to building the litigation team. Depending on the situation, one might find that the most efficient method is to assign the task of managing the Experts to a single attorney. Sometimes, in particular in large patent infringement matters involving multiple patents, it is most efficient to divide the tasks by relevant technology and assign attorneys and Experts to the patents most relevant to their expertise. Expert Witness teams are frequently separated into background consultants and testimonial Experts. Depending on the nature of the litigation these individuals may never meet or discuss or otherwise their respective work product or opinions. In cases where huge files of software code require analysis it is often more efficient to have a lead Expert Witness who is managing his own group of background consultants who perform the arduous task of code review and analysis. A similar approach can be taken to the analysis of large groups of patents, in particular, in pre-litigation patent infringement matters where large numbers of patents are analyzed to find those most likely to be infringed.

Managing Expert Witnesses

As a general rule, Expert Witnesses requires close supervision. While Experts may be highly credentialed and even experienced Expert Witnesses they should not be left to their own devices with respect to research or the development of Expert Report opinion. Certainly, an Expert can be given documents, patents and other research material and left to read and make analysis. Some tasks such as prior art research in a patent litigation, can be open ended with respect to time and require a time-budget to keep fees and expenses in order. In very large patent infringement or complex litigation matters where multiple Experts are engaged consider engaging a Project Manager to manage the Experts. This provides a single point of contact for the attorney in managing multiple Experts and can result in a more manageable work product. Don't wait until the last minute to provide your Expert with documentation for review. Your Expert is a busy person and probably not waiting by the phone for your call; Expert Witnesses frequently are involved in several matters simultaneously; they are busy and their schedules fill quickly. Advanced planning is essential to a satisfactory outcome.

Expert Witness Services Companies

The major disadvantage in dealing with Experts directly is (i) locating the right candidates and (ii) pulling together all their biographical information to create a meaningful and complete curriculum vita. When Experts don't have the protection of an Expert Witness Service company like NEWN acting as their billing agency, being their bill collector and providing other logistical services, they can sometimes impose restrictive retention terms. Certainly, the rate for a directly-engaged Expert is less than through an Expert Witness Service, but one must take into consideration the time involved in performing the work of the Expert Witness Services Company.



National Expert Witness Network, Inc. How to Hire an Expert Witness

The most efficient and fastest way to locate, vet and engage an Expert Witness is through an Expert Witness Referral service like the National Expert Witness Network, LLC, or NEWN. There are many Referral companies serving the legal profession; those that specialize in high-technology Experts like NEWN, those that specialize in medical and surgical Experts and those that have a database of Experts, in everything. Referral services like NEWN maintain a database of senior Experts who have a non-exclusive contract to provide Expert Witness services to NEWN's clients. The NEWN database covers over 1600 individual technical disciplines in nearly 60 major technology categories.

Typical of Referral companies, nearly 50% of NEWN's database have advanced degrees (Ph.D., D.Sc.), and includes a high percentage of Registered Professional Engineers and other professionals. These companies pride themselves in identifying candidates who fit the specific needs of the law firm and responding within hours with candidate curriculum vitas that are complete and up to date. Charges for Experts engaged through Expert Referral services will average \$125-150 per hour in addition to the hourly rate of the Expert. Some companies charge a percentage of the Expert's rate that can actually be higher than the hourly rate markups. Albeit NEWN does not, some referral firms markup expenses and have other hidden charges. Comparison shopping is a good idea.

Expert Witness Fees

Expert Witness fees can be very expensive, sometimes more than the attorneys handling the case. They are various ways to budget an Expert's costs. The easiest is to engage the Expert with a "work-down" retainer. This retention method is analogous to a product sale using C.O.D. terms. A retainer is paid to the Expert or Expert Referral Service in advance; an amount equal to n-hours of work exclusive of expenses. If, for example, the retainer was \$5,000.00 and the Expert's hourly rate was \$300.00, 16.7 hours of the Experts' time has been paid for in advance. The Expert will stop work until the retainer is replenished; thus providing a budgetary control of cost. The problem with arrangement is the work is interrupted during the retainer replenishment period. This can be minimized by paying a larger retainer and pre-purchasing more hours in advance.

Keep in mind that the Expert will be task-oriented with a strong desire to research all the available facts, study the data in depth so an informed opinion can be made. The time involved to complete the job from the Expert's perspective may not be in synchronization with the financial budgets of the end-client. Expert Witnesses are a significantly important aspect to any client's case. They earn incremental income by performing Expert Witness services and they expect to be paid in a timely fashion, or they will stop work (usually at the most inopportune time) until they are paid in full for all outstanding



invoices. Keeping the Expert happy with prompt payment is a smart way to manage litigation.

When an Expert is told to stop work, either because the case has gone into settlement talks or the court has order mediation, they will do just that; stop mid-stream. It is the custom of Experts not to return materials unless specifically asked to do so. They will invoice for their time and expenses to date and typically not restart until outstanding invoices and expenses are paid. Stop work orders should be communicated to Experts in writing with return receipt of the order required.

Subject-Matter Expertise

Relevance in the technology is always paramount to the choice of a candidate expert and their ultimate selection by the law firm. Since the Daubert rule came into play following an Appellate Court ruling in 1993, the question of subject-matter relevance to the issues of litigation has been clarified. By virtue of the fact that the relevance of an Expert's expertise can be challenged by opposing counsel ensures close scrutiny to one's education, professional experience, and core areas of expertise. Also, and perhaps more important to the Expert, is the loss of credibility if an Expert fails a Daubert challenge.

The Daubert rule stems from the case styled: *Daubert et ux., Individually and as Guardians and Litem for Daubert, et al. V. Merrell Dow Pharmaceuticals, Inc. certiorari to the united states court of appeals for the ninth circuit No. 92-102*. Argued March 30, 1993 -- Decided June 28, 1993. In essence this ruling found: "Faced with a proffer of expert scientific testimony under Rule 702, the trial judge, pursuant to Rule 104(a), must make a preliminary assessment of whether the testimony's underlying reasoning or methodology is scientifically valid and properly can be applied to the facts at issue." There are numerous citations on the Internet regarding Daubert, including a site (<http://www.dauberttracker.com/>) an online database of all reported Daubert cases with focus on challenged experts and their disciplines; links to core documents including briefs and opinions.

If you're the new law firm in an ongoing matter, you also inherited the Expert Witnesses retained by the original firm and approved by your new client. Re-interviewing these Experts is good practice. If there is a personality or other compatibility problem between your firm and the original Experts it can only present problems going forward. It is expensive to bring a new Expert up to speed, but no more so than engaging a new law firm. The end-client making the decision to change law firms should be advised of that fact.



Expert Witnesses are individuals, not companies, albeit in economic damages assessment companies that specialize in the area of damages can involve the engagement of a company and teams of people, however, there is usually only one testifying Expert.

Each Expert will have a different philosophy and attitude with respect to prompt payment. Some Experts invoice every two weeks to keep cash flow coming, most invoice monthly but get very nervous if payment isn't received within 30 days. A large percentage of Experts will simply stop work if payments are delinquent. Accordingly, the end-client's financial problems are yours. Sometimes the only way to keep the Expert working through difficult financial times with the end-client is for the law firm to take responsibility for the Expert's fees and expenses. While this sounds like a prudent idea, especially if the case is well downstream and nearing trial, in practice it rarely happens. There are Experts who have great patience with regard to payment; but frankly they are rare. Like the end-client and the attorneys who represent them, they want a check on payday, not six-months later.

Conclusion

In conclusion, here are some important points to remember: 1. It makes sense to engage an Expert Witness early in a litigation to take advantage of his/her experience and expertise to avoid wasting time and expense 2. In disputes with a high-technology content Expert Witness support is important 3. In Intellectual Property Disputes the support of an Expert Witness is essential 4. As early in the case as practical, identify the number and type of Experts you will need to support your case; testifying and/or background consultant 5. Match the professional experience and expertise of the Expert to the specific technology needs of your matter. Not only technical expertise, but litigation support and testimonial experience 6. Use all the available resources at your disposal to quickly find and vet Experts for your case 7. Establish a protocol for managing your Expert(s) and controlling the flow of information. 8. Ensure your Expert is well-prepared for the rigors of deposition, even experienced testifying Experts should be subjected to intense preparation. 9. Help your Expert articulate the strengths of your case at trial, support him/her with demonstrative evidence and other trial aids. The presentation can be as important as the message.



About the Author

David McDonald has over 40-years of experience in product marketing & development, sales and corporate management and legal support consulting. His industry experience includes the founding of two expert witness referral service firms, creating a R&D team to develop a new wireless test system, securing venture capital to start a communications test measurement company and creation of a highly successful technical manufacturers' representative, consulting, marketing and training organization.

Mr. McDonald has been directly involved in the Expert Witness Services business for over fifteen years. He has worked as an Expert in numerous matters and built an extensive community of independent industry practitioners and academics who serve as Experts for his clients. Mr. McDonald has also created two training companies, including Technology CLE that provides online technology training for continuing legal education credit.