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THE ADMISSIBILITY AND UTILITY OF EXPERT LEGAL TESTIMONY IN PATENT LITIGATION

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A. INTRODUCTION

The traditional view on the use of legal experts as witnesses in patent litigation was most clearly stated by Judge Learned Hand in Kohn v. Eimer, [n.1]

> We have not the slightest wish to minimize the vital importance of expert testimony in patent suits, or to suggest that we are not absolutely dependent upon it within its proper scope; but that scope is often altogether misapprehended. . . When the judge has understood the specifications, he cannot avoid the responsibility of deciding himself all questions of infringement and anticipation, and the testimony of experts on these issues is inevitably a burdensome impertinence. [n.2]

These comments were made at a time when expert testimony in general was more proscribed than it is today. The use of experts was liberalized a great deal with the enactment of the Federal Rules of Evidence. [n.3] The new rules eased the requirements for the qualification of experts [n.4] and specifically abolished the common law prohibition as to opinions on ultimate issues. [n.5] The expanded use of experts under the Federal Rules, in addition to the increasing complexity of modern laws, may have changed the prevailing judicial attitude toward the utilization of legal experts.

*362 The decision to use any experts at all is one that falls within the discretion of the trial judge. [n.6] This necessarily indicates that the use of such experts may vary widely among jurisdictions. This discretion, however, is guided by the opinions of the Courts of Appeals. In issues concerning the patent laws, and patent litigation, it is the Court of Appeals for the Federal Circuit that provides the most authoritative guidance. Accordingly, this paper will focus primarily on Federal Circuit opinions in an attempt to explore this court's views on the scope to which expert legal testimony on the patent law is both useful and permissible. This paper will address how the unique nature of the patent law affects the use of experts, and will attempt to set forth a number of specific factors which should be addressed in making the decision whether to use a patent expert.

B. USE OF EXPERTS GENERALLY

1. The Federal Rules

The use of experts and opinion testimony is governed in the federal courts by Article VII of the Federal Rules of Evidence. Rule 702 states;

If 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.

The advisory committee notes explain that the rule allows "experts to take the further step of suggesting the inference which should be drawn from applying the specialized knowledge to the facts." These suggestions are made by the expert in the form of opinions.

One major effect of the Federal Rules was to abolish the proscription on opinion testimony going to an ultimate issue. Rule 704 provides;

(a) Except as provided in subdivision (b), testimony in the form of an opinion or inference otherwise admissible is not objectionable because it embraces an ultimate issue to be decided by the trier of fact.

The advisory committee notes stress that the question of admissibility should focus on the helpfulness of the testimony and not its form. [n.7] The notes go on to point out that other rules allow for exclusion of evidence which wastes time. [n.8] These other rules provide "ample assurances against *363 the admission of opinions which would merely tell the jury what result to reach." [n.9] It is up to the trial judge to balance the usefulness of the expert's testimony with the potential for prejudice or waste of time.

2. Legal Experts

The traditional common law rule against testimony on legal issues has been eroded by the enactment of the Federal Rules. In the past, it was presumed that the judge knew the law, and thus had no need for expert testimony on legal matters. The Federal Rules make no such distinction, and instead provide that the judge may admit any evidence which will aid the trier of fact in making a decision. In addition, the abolition of the "ultimate issue" rule by F.R.E. 704, opens the door for experts to state opinions on ultimate issues, even if such opinions require legal conclusions.

In the past, the only exception to the rule against legal testimony was the allowance for an expert to testify where issues of foreign law were concerned. [n.10] This was permitted, because the presumption that the judge was aware of such law was seen to be clearly inapplicable. With the proliferation of modern statutory law, and an ever increasing number of judicial decisions on the books, the presumption that the judge is completely familiar with all aspects of U.S. law, especially the more complex and obscure areas of practice, is itself being eroded. [n.11] With the focus of the Federal Rules on helpfulness as the major criteria, courts seem more willing to admit testimony

from experts on what are technically legal issues. As will be seen below, a trial judge is afforded a good deal of discretion in making a determination that such testimony will be of aid to the trier of fact.

C. THE SPECIAL CASE OF PATENTS

The discipline of patent law is considered by many in the profession to be among the most complex, requiring a good deal of specialized knowledge. In addition, the technical nature of the factual situations to be addressed by the patent law, requires even further knowledge on the part of patent practitioners. Such considerations have made the use of experts a major component in patent litigation.

*364 Another aspect of patent law which complicates litigation is the existence of issues commonly referred to as "mixed questions of law and fact." [n.12] These are issues wherein the ultimate conclusion is a legal one, but such a conclusion must be supported by reference to underlying facts. For example, the issue of obviousness is a legal conclusion, based on; (a) the scope and content of the prior art, (b) the differences between the prior art and claims at issue, (c) the level of ordinary skill in the art when the invention was made, and (d) secondary indicia, such as commercial success and copying. [n.13] The modern trend is to allow experts to testify not only to the factual bases, but also to render opinions on the ultimate legal conclusion of obviousness. This trend has been applied to other patent law doctrines such as claim construction, and inequitable conduct.

Finally, in some limited circumstances, courts have allowed patent law experts to testify directly as to legal doctrines. [n.14] Although such cases are rare, they may be considered evidence of the growing support for the use of legal experts in patent cases.

1. The Federal Circuit cases

The Federal Circuit has rarely dealt directly with the issue of the admissibility of expert legal testimony. Research into the subject uncovered only four instances where the court was called upon to review a district court's exclusion of expert testimony. These cases will be referred to as the "Exclusion" cases and are examined in the first section below. The Federal Circuit, however, has made indirect reference to the admissibility, and usefulness of expert testimony in general, by addressing the testimony of individual experts in specific cases. In a number of these situations, referred to below as the "Reliance" cases, the court either quoted from an expert's opinion verbatim, or cited such testimony with approval. On other occasions, termed the "Non-reliance" cases, the court specifically pointed to expert testimony it found to be less than convincing. In examining specific situations wherein the Federal Circuit has made use of expert legal testimony, and others wherein it declined *365 to do so, some insight may be gained into the prevailing attitudes of the court on the use of such testimony in general.

a. The Exclusion cases

In Moeller v. Ionetics, Inc., [n.15] the Federal Circuit reviewed the grant of a partial summary judgement on the issue of infringement by the Central District of California. The infringement suit involved a patent directed toward an electrode system useful for measuring ion concentrations. The district court found the claims at issue to be sufficiently simple so as to be capable of understanding without the aid of experts, and construed the claims to find no infringement. The appellant, Moeller, had attempted to provide an expert's testimony as to the meaning of the term "electrode" in the claims, and the court refused to allow this evidence. In examining the claim language, the Federal Circuit concluded that the lower court's infringement analysis was flawed due to improper claim construction. Although claim construction is a question of law, the court pointed out that "in a patent case involving complex scientific principles, . . . expert testimony is particularly helpful." [n.16] In addition, the court stated that " a lthough use of experts is generally a matter of discretion with the trial judge, Seattle Box Co. v. Industrial Crating & Packaging, Inc., 731 F.2d 818, 826.221 USPQ 568, 573 (Fed. Cir.1984), that discretion is not unlimited." [n.17] The Federal Circuit held that failure to admit expert testimony on the issue of claim construction was an abuse of the trial court's discretion and vacated and remanded. Although this case may show an implicit preference for the use of expert testimony, the reversal was of a grant of summary judgement. This indicates that the Federal Circuit may have believed the lower court's erroneous claim construction to have resulted from the existence of a material issue of fact needing expert clarification, and not any flaw in its legal analysis.

Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems, Inc., [n.18] is another instance where the Federal Circuit vacated a district court's grant of summary judgement on infringement. The District Court for the District of Minnesota accepted Scimed's proffered interpretation of the claims directed to medical balloon catheters and refused to consider ACS's expert testimony providing a conflicting interpretation. The Federal Circuit characterized the case as one "where expert testimony *366 is "particularly helpful" because the meaning of the disputed terms is not readily apparent from the patent and its incomplete prosecution history". [n.19] The court vacated the grant of summary judgement finding that the district court had erred in refusing to consider ACS's extrinsic evidence.

Judge Newman dissented in ACS v. Scimed, stating her view that there was no question of material fact at issue and that the district court was correct in its legal conclusion on claim construction. In her view, ACS's argument that the district court failed to give weight to its expert's legal conclusion as to how he would interpret the claims, went to the lower court's conclusion of law, and did not negate the propriety of summary judgement. Judge Newman's main concern seemed to be that on remand the issue of claim construction would presumably be left to the jury, with what she believed was inadequate guidance as to how the district court erred in its legal analysis. In addition, Judge

Newman stated that the majority opinion would only serve to add uncertainty as to the propriety of summary judgement in the claim construction context.

The decision in Moeller and the majority opinion in ACS v. Scimed show a preference for expert testimony on the issue of claim construction in cases where the technology is complex, but they fall short of finding such testimony necessary. The other two exclusion cases support the apparent lack of necessity. In those instances the federal Circuit affirmed the lower court's exclusion of such testimony.

In Medtronic, Inc. v. Intermedics, Inc., [n.20] a jury in the Southern District of Texas found the defendant guilty of infringing plaintiff's patent on pacemaker leads. Intermedics moved for a new trial on the grounds that the district court's exclusion of certain expert testimony amounted to prejudicial error. Intermedics offered the testimony of its patent expert, Professor Gambrell, to explain the prior art, the scope and obviousness of the asserted claims, and the infringement of those claims. Professor Gambrell did testify at trial, but the trial court circumscribed the testimony to exclude the above mentioned issues.

The Federal Circuit held the trial judge had not abused his discretion in excluding this testimony. The court, however, did not base this conclusion on any statement that such testimony would be inherently improper. Instead, the court stated that the exclusion was based on the *367 fact that Gambrell was not personally familiar with the specific patents in suit but would only have testified as to patent law in general. The district court also stated, and the Federal Circuit agreed, that Gambrell's testimony would be cumulative given the previous testimony by a number of Intermedics employees and technical experts.

Finally, the Federal Circuit affirmed the Eastern District of New York's exclusion of a defendant's patent expert in Acoustical Design, Inc. v. Control Electronics Co.. [n.21] In a seven day jury trial, Control was found guilty of infringing Acoustical's patent for a sound generator for use in a sound masking system. On appeal, Control asserted that it was error for the trial court to exclude its patent expert's testimony on how claims are drafted to avoid prior art and that the claims at issue read on the prior art. Control claimed that without the offered testimony, they "could not effectively demonstrate how applicable law would require findings of non-infringement and inequitable conduct by appellee." [n.22]

The Federal Circuit explained that because the appellants had failed to move for a JNOV or a new trial within the proper time, the only way the court could vacate and remand would be on a showing of prejudicial legal error. Stating again that the use of expert testimony is within the discretion of the trial judge, the Federal Circuit was unpersuaded that the district court was in error when it decided that the proffered expert testimony would have been of no benefit to the jury. The brief treatment of the issue in this case shows substantial deference to the trial judge. Again, however, nothing in the court's opinion indicates that the proffered testimony would be improper per se, but only

that the judge was within his discretion in finding it would not be helpful in making a decision in this instance.

b. The Reliance cases

The Federal Circuit has not made any clear statements to the effect that they find expert legal testimony to have aided in the decision making process. The court has, however, given such an impression indirectly by approving lower courts' reliance on experts, and by using such testimony to support their own decisions. In the following group of cases, the Federal Circuit has given weight to expert testimony on such varied legal issues as claim construction, obviousness, the doctrines of claim *368 differentiation and prosecution history estoppel, inequitable conduct in the prosecution of a patent, the legal effect of a prior art reference, and the functionality of a patented design.

In Snellman v. Ricoh Co., [n.23] the Federal Circuit affirmed a jury verdict finding Ricoh guilty of infringing Snellman's patent on an improved paper sorter used in a photocopy machine. The jury based its finding of infringement in large part on Snellman's patent expert's testimony relating to the construction of the patent claims, and his ultimate conclusion that the claims were infringed. [n.24] In affirming the Northern District of California's denial of a JNOV, the Federal Circuit quoted directly from the patent expert's testimony. The court concluded;

Accepting Mr. Dunner's interpretation of the claim and his expert conclusion on infringement, as the jury obviously did, and in view of the language of the specification, there was substantial evidence to support the jury verdict of infringement. [n.25]

Although the court did not explicitly say so, it is clear from the opinion that the Federal Circuit believed the expert's legal testimony to be helpful to the jury, and properly relied upon in construing the claim so as to reach their conclusion on infringement.

Unique Concepts, Inc. v. Brown, [n.26] is another case where the court made use of expert testimony on the issue of claim construction. In this dispute over a patent directed toward an "assembly of border pieces" used to attach a fabric wall covering to a wall, each side presented only one witness, a patent expert. [n.27] The trial was had before Judge Pollack in the Southern District of New York, who heard testimony from both sides on the proper construction of the patent claims, and the legal elements necessary for a finding of infringement under the doctrine of equivalents. Both the trial judge, and the federal Circuit quoted from the testimony of Brown's expert in making its determination of the scope of the claims. [n.28] The majority opinion affirmed the trial judge's verdict on infringement.

Judge Rich dissented in Unique Concepts, obviously disagreeing with the district court and the majority on the issue of claim construction. *369 Judge Rich gave little weight to Brown's expert, [n.29] and applied his own construction of the claims which conflicted with that of the majority. He characterized the expert's testimony as "wholly incredible" and "with no support whatsoever" for his conclusions. [n.30] Judge Rich clearly believed

the testimony of the expert to be in error, but he did not fault the district court for admitting the evidence. Apparently, the admission of the evidence was proper, but just not very helpful, as far as Judge Rich was concerned.

In two other cases, Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H., [n.31] and H.H. Robertson Co. v. United Steel Deck, Inc., [n.32] the court gave weight to expert testimony on claim construction. In Tol-O-Matic, a jury in the District of Colorado found plaintiff's patent for a rodless piston-cylinder not to be infringed. The Federal Circuit quoted extensively from the testimony of the patent experts, which were offered by both sides. In affirming, the Federal Circuit stated;

> We have reviewed the record and conclude that the jury, hearing the conflicting opinions from the patent experts for each side, and having the specification and prosecution history before it, could have reached the verdict of noninfringement. [n.33]

The court in H.H. Robertson also had before it "extensive testimony on the issue of claim construction, including the conflicting views of experts on both legal and factual questions." [n.34] The Federal Circuit affirmed the district court's claim construction and grant of a preliminary injunction in favor of the patentee. This case provides further evidence that the Federal Circuit seems willing to allow district courts to entertain expert opinion evidence on the legal issue of claim construction, and in certain circumstances, to affirm a lower court's explicit reliance on an expert's opinion.

In Seattle Box Company, Inc. v. Industrial Crating & Packaging, Inc., [n.35] Industrial argued that the District Court in the Western District of Washington improperly relied on the testimony of Seattle Box's expert on the issue of obviousness. The Federal Circuit found this argument to be without merit. "A trial judge has sole discretion to decide whether *370 or not he needs, or even just desires, an expert's assistance to understand a patent". [n.36] Although the court did not address the expert's testimony specifically, they affirmed the district court's analysis and holding on the issue of obviousness. This case is a good example of the deference the Federal Circuit shows to a district court's discretion as to allow expert testimony, even of a legal character.

One Federal Circuit opinion states clear support for expert legal testimony. In Yarway Corp. v. Eur-Control USA, Inc., [n.37] a patent lawyer was called upon to testify on the legal doctrines of claim differentiation and the nature and effect of a patent file wrapper. "In a manner not unusual in patent cases, he testified about questions of patent law as if it were foreign law." [n.38] The court conclusion, based in part on the expert's testimony, was that there was no misapplication of the law of file wrapper estoppel or error in claim construction on the part of the district court. This is one of the most clear statements made by the Federal Circuit in support of expert legal testimony. [n.39]

Another interesting use of expert legal testimony can be found in Beckman Instruments, Inc. v. LKB Produkter AB. [n.40] In this case, the Judge in the District of Maryland allowed the jury to hear expert testimony on the legal effect of a prior art reference. Specifically, the expert testified to the effect that a reference that "does not work" could not be used as prior art to invalidate a patent. [n.41] Recognizing this testimony to be an

incorrect statement of the law, the trial judge instructed the jury that a reference is prior art for all that it teaches, regardless of whether it discloses an inoperable device. The appellant challenged the jury instruction on appeal, arguing that the jury was confused. The Federal Circuit rejected this argument stating;

If in fact the jury was confused by the combination of the jury instruction and the expert testimony, then the fault is with the expert testimony, not the jury instruction. In such a case, LKB should not try to correct the error by objecting to the jury instruction, but by discrediting the erroneous expert testimony either through cross-examination or through its own expert testimony. [n.42]

*371 Even in this case where the expert was in error, the Federal Circuit did not find fault with the admission of the testimony. In fact, the proposed solution was not less testimony, but more, either through effective cross- examination or by putting forward another expert who would contradict the initial testimony. This case is evidence of the Federal Circuit's belief that this kind of testimony will aid the trier of fact, and its faith in the sophistication of the trial court to weigh conflicting testimony to reach a correct result.

The Federal Circuit has also supported the use of expert testimony on the issue of inequitable conduct before the Patent Office. In Allen Organ Co. v. Kimball International, Inc., [n.43] the Northern District of Illinois allowed testimony to the jury from an expert as to what a patent attorney should have disclosed to the patent office. The Federal Circuit quoted the expert's opinion that the failure to disclose in this case was harmless, because the reference at issue had been disclosed by the attorney in connection with a parallel application. [n.44] The court held that a reasonable jury could have determined from the evidence that the failure to disclose was inadvertent and find a lack of intent to deceive on the part of the patent attorney. In addition, in Rohm & Haas Co. v. Crystal Chemical Co., [n.45] the court made passing reference to the testimony of a patent expert on the requirements of the duty of candor in support of its reversal of the trial court's finding on inequitable conduct. [n.46]

Finally, the Federal Circuit made significant reference to a patent expert's opinion as support for vacating a grant of preliminary injunction for infringement of a patented design. In Power Controls Corp. v. Hybrinetics, Inc., [n.47] the Northern District of California granted the plaintiff a preliminary injunction in a suit charging infringement of a design patent. The Federal Circuit vacated the injunction, finding that the defendant had put forth sufficient evidence to rebut the presumption of validity of the patent. That evidence consisted primarily of an affidavit from the defendant's expert, a patent lawyer, that the design of plaintiff's patented package was dictated by functional considerations and not primarily ornamental. The Federal Circuit stated;

In view of the strong and clear showing of functionality made in [the expert's] affidavit, it was incumbent on Power Controls "to come forward with countervailing evidence" tending to establish validity. [n.48]

*372 The court found that Power Controls had failed to rebut the defendant's evidence on the issue of validity and vacated the preliminary injunction.

The previous discussion of the "Reliance" cases indicates a willingness on the part of the Federal Circuit to allow expert legal testimony. Although the court does not explicitly state approval, or preference for such evidence, the court's apparent repeated reliance on expert legal opinions is indirect evidence of the court's openness to the admission of legal experts. It must be reiterated, however, that the decision to admit an expert's testimony lies in the first instance with the trial court. Although the Federal Circuit has shown a willingness to utilize expert testimony on legal issues, and in some cases to rely heavily upon such evidence, it has fallen short of making any statements to the effect that such evidence is necessary, or even preferred.

c. The Non-reliance cases

In fact, the specific statements that have been made by the Federal Circuit on the use of "patent experts" have been more likely to be negative. The following group of cases are examples of where the court has either given little weight to an expert's legal testimony, or made affirmative statements that such testimony is unnecessary or even undesired.

The court addressed the issue of an expert's testimony on claim construction in Del Mar Avionics, Inc. v. Quinton Instrument Co.. [n.49] Quinton appealed the Western District of Washington's ruling that Quinton infringed Del Mar's patent on an "elecrocardiac computer." [n.50] Quinton asserted that the trial court erred in refusing to adopt the claim construction offered by Quinton's patent expert. The Federal Circuit rejected this contention stating that a "district court is not obliged to adopt a conclusion stated by an expert witness." [n.51] The Federal Circuit further explained that the "court's obligation is to weigh expert and other testimony, but it is the court's, not the expert's, responsibility to decide the case." [n.52]

In McGill, Inc. v. John Zink Co., [n.53] the Federal Circuit reversed the Northern District of Oklahoma's denial of a JNOV on the issue of infringement. In this case both sides presented patent experts who *373 rendered opinions as to the scope of the claims. While the court conceded that "testimony by expert witnesses may be used to construe the claims," [n.54] the court found that the testimony provided could not support the jury's legal conclusion on the issue of infringement. Although it held that the expert testimony was not worthy of reliance by the jury, the Federal Circuit did not find its admission improper.

The Federal Circuit has also on occasion given little weight to expert testimony on the issue of obviousness. In three cases, the court held that conflicting opinions of patent experts on the ultimate issue of obviousness will not preclude a grant of summary judgement. Union Carbide Corp. v. American Can Co., [n.55] involved a grant of summary judgement by the Northern District of Illinois holding Union Carbide's patent directed toward flexible bag dispensers invalid under 35 U.S.C. § 103 as obvious in view of the prior art. Union Carbide claimed that the affidavit of its patent expert raised a material issue of fact on the issue of obviousness. The Federal Circuit stated that the

district court was justified in giving "little weight" to the affidavit because it "expressed no more than an unsupported conclusory opinion which ignored, rather than conflicted with, the evidence of record." [n.56]

In Petersen Manufacturing Co. v. Central Purchasing, Inc., [n.57] the Central District of California granted summary judgement finding plaintiff's patented design for a locking adjustable wrench to be obvious. The patentee appealed arguing that the decision of the Court of Customs and Patent Appeals in In Re Nalbandian, [n.58] required the use of expert testimony on the issue of obviousness of a design. The Federal Circuit rejected this argument and stated that the issue of obviousness of a design is legal in nature. "Opinion testimony by experts concluding that an invention would or would not have been obvious may influence a court's decision, but conflicting opinions on a legal issue vel non raise no issue of fact." [n.59] Opinions of patent experts on the issue of obviousness may be heard by the trial court, but they cannot by themselves preclude a finding of summary judgement.

The Federal Circuit more recently reaffirmed this premise in Avia Group International, Inc. v. L.A. Gear California, Inc.. [n.60] The court affirmed *374 the grant of summary judgement by the District Court for the Central District of California holding the patented design on athletic shoes not invalid and willfully infringed. On appeal L.A. Gear asserted that the trial court was required to defer to its expert testimony with regard to the obviousness of the design. The court cited Petersen when it stated that "an expert's opinion on the legal conclusion of obviousness is neither necessary nor controlling." [n.61] It also cited Union Carbide for the proposition that conflicting expert opinions on the issue of obviousness raise no material issues of fact. [n.62] These cases illustrate the court's (or at least some of the judges') less than supportive opinion of the value of expert testimony on the legal issue of obviousness.

The court has made an even stronger statement with regard to the use of experts on the issue of the standard of inequitable conduct before the Patent Office. In Argus Chemical Corp. v. Fibre Glass-Evercoat Co., [n.63] Argus put forth testimony of its expert patent attorney as to the practice of disclosing references to the patent office. After a bench trial, the Central District of California held the alleged infringer liable, and this decision was appealed. On appeal Fibre Glass reiterated its contention that the patent was unenforceable due to inequitable conduct. In response, Argus again pointed to its expert's opinion. The Federal Circuit rejected this testimony completely stating;

> The question of the appropriate standard for determining inequitable conduct in procuring a patent is one of law. Thus, the testimony of an attorney on the practice which some attorneys followed is irrelevant. [n.64]

The court did not find the admission of the expert's testimony to be in error, but it did reverse the lower court's finding on the issue of inequitable conduct, implying that such a finding was based on improper evidence.

Although the Federal Circuit does not state in any of these cases that the admission of expert legal testimony on the various issues was reversible error, the court did find that

such opinion testimony was either "irrelevant", to be afforded "little weight", or insufficient to raise an issue of fact to preclude a finding of summary judgement. These cases give the impression that although expert legal testimony is not inadmissible, it is of little to no aid to the trier of fact. This is not to say that the Federal Circuit will reverse a district judge's decision to hear *375 such evidence, only that it will not hesitate to reverse a holding if it feels the judge gave too much credence to an expert opinion the Federal Circuit finds unsupportable.

2. Other Courts

Although the Federal Circuit has written opinions which indicate both positive and negative views on the use of legal experts, they seem willing to give a good deal of deference to a trial court's decision whether to admit such evidence. Other courts have been routinely open to the admission of expert legal testimony in the patent context, from a number of sources, and on a variety of issues.

Before the formation of the Federal Circuit, the Ninth and Fifth Circuits approved the use of patent experts in cases before them. In Northrop Architectural Systems v. Lupton Manufacturing Co., [n.65] the court stated; "That an expert's opinion on the highly technical issues of obviousness and infringement is of significant value to the trier of facts is the law of this circuit." [n.66] The court recognized that the issue of obviousness was ultimately one of law, but it found sufficient evidence in the expert's affidavits to raise enough doubt on the obviousness of the patent at issue to reverse a summary judgement. In a later case, the Ninth Circuit affirmed a lower court's admission of the testimony of a professor of patent law used to aid the jury in interpreting the scope of the disputed claims. [n.67] The court stated that it was not improper for the trial judge to admit this testimony even though it would embrace "the ultimate question for determination by the jury." [n.68] In Van Gorp Manufacturing, Inc. v. Townley Industrial Plastics, Inc., [n.69] the Fifth Circuit found the testimony of a patent attorney/engineering school dean to be "clear and convincing" enough to reverse the lower court's judgement on the issue of obviousness. [n.70] The Fifth Circuit quoted extensively from the witnesses testimony to support its reversal.

In addition, research for this paper uncovered a number of district court opinions giving weight to legal testimony. Such testimony was received from former patent examiners, [n.71] former patent commissioners, [n.72] *376 law professors, [n.73] as well as practicing patent attorneys. [n.74] In these cases, testimony was received on the duty of disclosure before the Patent Office, [n.75] Patent Office practice and inequitable conduct, [n.76] reexamination practice, [n.77] the requirements of 35 U.S.C. § § 102 [n.78] and 112, [n.79] and claim construction. [n.80] One district court ruled that the issue of claim construction related to a count in an interference was so complex as to require expert testimony. [n.81]

On other occasions, courts have also declined to admit, or to make use of expert testimony. The Northern District of Illinois in Bela Seating Co. v. Poloron Products, Inc.,

stated that "[l]egal conclusions, such as whether a claim is infringed and whether a claim is valid, should be made by the Court, and opinions as to legal conclusions from a patent expert are never binding upon the Court". [n.82] The Second Circuit upheld the exclusion of expert testimony on claim construction and file wrapper estoppel in view of the fact that the district judge was himself a patent attorney with extensive experience in patent prosecution. [n.83]

*377 3. Some Generalizations

Although expert legal testimony is not admitted on all occasions, courts do seem willing to allow it most of the time. The courts have great latitude to determine the weight of such evidence both at the trial and appellate levels. It is difficult to distill any clear trends or preferences on the part of the Federal Circuit due to the fairly even distribution of positive and negative references found in the case law.

a. Possible Contributing Factors

From an examination of the case law, and reference to some learned commentators, it may be possible to suggest some factual elements which may affect a judge's determination as to the helpfulness of an expert's testimony on legal issues.

Because broad discretion lies with the trial judge as to the admission of evidence, the characteristics of the judge will have an impact on the use and weight given to an expert's testimony. [n.84] At least one case supports the assertion that if the judge has experience with patent law and patent cases, he will be less receptive to an attempt by an expert to testify as to legal issues. [n.85]

Another factor pointed to by the commentators is whether the case is tried before the judge or a jury. It has been argued that a trial court is more likely to accept aid in the form of legal testimony where there is no danger that such testimony might confuse a jury. [n.86] Although such a theory is plausible, the Federal Circuit does not seem to adhere to it. Certain cases indicate that the court has faith in the jury's ability to sort out conflicting testimony, even when it is in conflict with the judge's instructions. [n.87]

Another factor indicated by the cases and commentaries is the level of technical complexity of the underlying facts of the case. The courts have made statements to the effect that where the technology involved is complex, expert testimony is "particularly helpful". [n.88] Although this applies predominantly to technical experts, the indications are that testimony of patent experts to aid in the application of the law to the technically complex facts is also appreciated.

*378 The identity and background of the expert may also play a part in the weight afforded the testimony. Although the Federal Circuit has approved of the use of patent attorneys as expert witnesses, it has been argued that such testimony comes too close to

advocacy, and not the views of an impartial expert. [n.89] Lower courts seem more willing to accept testimony from legal scholars such as law professors and deans, and from persons with experience from the Patent Office when the testimony concerns office practice and inequitable conduct.

Whether the witness is a professor or an attorney, it is important that they have a good grasp of the patents at issue from firsthand experience, rather than attempt to testify on issues of patent law in general. [n.90] The courts tend to grant greater weight to the conclusory opinions of experts who have examined the specific patents and file histories at issue in the case. [n.91] In addition, a "Patent Expert" who also has extensive experience in the particular technology (though not as much as a technical expert would) seems more likely to influence the outcome through his testimony.

Finally, the specific legal issue to be addressed by the expert testimony may have an impact on its reception. The courts have been most likely to accept testimony on the issues which call for a legal conclusion based on factual bases, the so called "mixed questions of law and fact". Testimony on the proper construction of claims as a basis for an analysis of infringement seems to be the most popular issue addressed. Testimony on the issue of obviousness is less well liked, but is sometimes allowed. The courts also seem to appreciate testimony related to the details of practice before the Patent Office. [n.92]

D. THE CASE FOR PATENT EXPERTS

Although the Federal Circuit, as well as other courts, have both made use and declined to use expert legal testimony, no court has made explicit its reasoning for such use in general. There are a number of considerations which support the utilization of legal experts in patent trials. These considerations are aimed primarily at the improvement of the accuracy of patent trials and supported at a basic level by the emphasis placed by the Federal Rules of Evidence on the helpfulness of the evidence to the trier of fact.

*379 1. To Assist the Judge

In many cases the trier of fact in a patent dispute will be the trial judge. As was discussed previously, the traditional view that the judge is presumed to know all the law is no longer convincing given the rapid expansion of the American legal system. [n.93] In the highly complex discipline of patent law, the average trial judge may indeed require some assistance in understanding the full range of the legal issues before her.

The presumption of knowledge of the law has always been supported by the notion that even if the judge was not familiar with the law before the case, she has effective means of educating herself on the relevant authority. The traditional means include the use of her Law Clerk, conducting legal research on her own, and soliciting views amicus curiae.

Although such efforts will improve the judge's working knowledge of the law, the use of an expert can be a better method of education. [n.94] The predominant improvement is the interactive nature of the inquiry made possible by the presence of a live expert. [n.95] The judge may ask questions and seek explanations for specific issues that are unclear. The give and take of live expert testimony may also be better at holding the judge's interest and provide a deeper understanding of the legal doctrine than research alone.

One may argue that an expert, who is being paid by a party, will act as an advocate and seek to provide the judge a view of the law that is slanted in favor of his party's case. The judge can counter any attempt a number of ways. Initially, a close questioning of the expert can elicit a fuller description of the applicable law than narrative testimony alone. [n.96] In addition, the judge may balance the testimony of a party expert with that of the opposite party's own expert, or the judge may appoint a neutral expert to provide legal background. This ability to balance the testimony will provide the judge a range of options to educate herself in the relevant law much more thoroughly than through traditional means such as legal research. Finally, the judge has the discretion to completely disregard the testimony of an expert when rendering her decision, provided that such disregard does not lead the judge to commit legal error.

*380 2. To Aid the Jury

Expert legal testimony has similar advantages in the jury context. The interactive testimony of an expert, guided by questions from counsel or the judge, provides a much more interesting exposition of the law than a long, narrative instruction from the judge. [n.97] The testimony of the expert can guide the jury, step by step, through the analysis necessary to understand therelevant legal issues, and be more prepared to find the facts required of them. [n.98]

A possible danger of such testimony is that the jury will not truly seek to understand the testimony, but simply side with the expert they find more appealing. [n.99] This possibility exists equally with all witnesses and is handled by the adversarial process, including the use of cross examination. These tools will work equally well to safeguard against a jury attaching too much weight to any individual's testimony. [n.100] In addition, the judge may still instruct the jury as to the proper state of the law, which in most cases will be a confirmation of the testimony of the experts. The judge also has the power to exclude the testimony of the experts if she feels that it is in conflict with her own view of the law, or will cause confusion in the jury, outweighing its usefulness. This requires that the judge review the proposed testimony before its submission to the jury, and exclude that which fails to be helpful. [n.101] Finally, if after trial the judge feels the jury has given too much weight to an experts testimony which has resulted in an erroneous conclusion, the judge has the power to enter a JNOV or grant a new trial.

E. CONCLUSION

There are undoubtedly other factors taken in to consideration by judges when deciding to hear, or credit, expert testimony. Unfortunately, courts have not made an effort to describe such considerations. The best that can be done is to attempt to derive some meaning from an examination of the facts of individual cases and extrapolate possible future conduct. One thing that is apparent from the case law is that testimony by experts on legal questions related to patents is being admitted and given weight by the federal courts. There is no longer a blanket prohibition *381 on such testimony, due in part to the emphasis placed by the Federal Rules of Evidence on helpfulness. If a trial judge believes that the testimony of an expert will aid in clarifying a difficult question of patent law, or in the application of the law to complex sets of facts, then such evidence will be admitted, and possibly relied upon heavily. The authority from the Federal Circuit on the subject indicates that the court will continue to grant deference to the decision of the trial judge to admit the evidence, whether or not the Federal Circuit chooses to credit the particular expert in any given case. Although no express statements have been made, it appears that the courts are beginning to recognize the advantages of expert legal testimony in the patent context, and may be more amicable to its use in the future.

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[n.1]. 265. F. 900 (2nd Cir.1920).

[n.2]. Id. at 902.

[n.3]. 28 U.S.C.A § § 702-705 (1984 & Supp.1991).

[n.4]. Fed. R. Evid. 702.

[n.5]. Fed. R. Evid. 704.

[n.6]. Seattle Box Company v. Industrial Crating & Packing, Inc., 221 U.S.P.Q. 568 (Fed. Cir.1984).

[n.7]. "The basic approach to opinions, lay and expert, in these rules is to admit them when helpful to the trier of fact." Advisory Committee Notes to Rule 704 (1972).

[n.8]. See Fed. R. Evid. 403.

[n.9]. Advisory Committee Notes to Rule 704 (1972).

[n.10]. See Friedland, Expert Testimony on the Law: Excludable or Justifiable?, 37 U. Miami L.Rev. 451, 456 (1983).

[n.11]. Id. at 470.

[n.12]. See e.g. U.S. v. Sisson, 294 F.Supp. 520, 522-23 (D.Mass. 1968) (Judge Wyzanski discussing the use of legal experts in patent cases as part of a discussion of expert legal testimony in general).

[n.13]. See Graham v. John Deere Co., 383 U.S. 1 (1966).

[n.14]. See, e.g., Yarway Corp. v. Eur-Control USA, Inc., 227 U.S.P.Q. 352 (Fed. Cir.1985) (Claim Differentiation and File Wrapper Estoppel); Beckman Instruments, Inc. v. LKB Produkter AB, 13 U.S.P.Q.2d 1301 (Fed. Cir.1989)(Affect of prior art reference on issue of obviousness).

[n.15]. 229 U.S.P.Q. 992 (Fed. Cir.1986) (Nichols). [The name of the judge authoring the majority opinion is included after each case citation]

[n.16]. Id. at 995.

[n.17]. Id.

[n.18]. 12 U.S.P.Q.2d 1539 (Fed. Cir.1989) (Bissell).

[n.19]. Id. at 1542 (citing Moeller and Snellman v. Ricoh, 8 U.S.P.Q.2d 1996 (Fed. Cir.1988)).

[n.20]. 230 U.S.P.Q. 641 (Fed. Cir.1986) (Davis), cert. denied, Intermedics, Inc. v. Medtronic, Inc., 479 U.S. 1033 (1987).

[n.21]. 18 U.S.P.Q.2d 1707 (Fed. Cir.1991) (Lourie), cert. denied, Control Electronics Co. v. Acoustical Design, Inc., 502 U.S. 863, 112 S.Ct. 185 (1991).

[n.22]. Id. at 1709.

[n.23]. 8 U.S.P.Q.2d 1996 (Fed. Cir.1988) (Friedman), cert. denied, Ricoh Co. v. Snellman, 491 U.S. 910 (1989).

[n.24]. Snellman's Patent expert was Mr. Dunner, an experienced patent attorney.

[n.25]. Snellman, 8 U.S.P.Q.2d at 2000.

[n.26]. 19 U.S.P.Q.2d 1500 (Fed. Cir.1991) (Lourie).

[n.27]. Id. at 1502-1503.

[n.28]. Id. at 1505.

[n.29]. "Since Brown's so-called "expert" -- expert only in the sense that he was a patent lawyer -- knew no more than the members of this panel, his speculations are of no value to us." Id. at 1507.

[n.30]. Id.

[n.31]. 20 U.S.P.Q.2d 1332 (Fed. Cir.1991) (Newman).

[n.32]. 2 U.S.P.Q.2d 1926 (Fed. Cir.1987) (Newman).

[n.33]. Tol-O-Matic, 20 U.S.P.Q.2d at 1338.

[n.34]. H.H. Robertson, 2 U.S.P.Q.2d at 1929.

[n.35]. 221 U.S.P.Q. 568 (Fed. Cir.1984) (Nichols).

[n.36]. Id. at 573.

[n.37]. 227 U.S.P.Q. 352 (Fed. Cir.1985)(Nichols).

[n.38]. Id. at 356.

[n.39]. Judge Nies did dissent in Yarway, but on the issue of infringement under the doctrine of equivalents. She felt the district court to be unclear on the doctrine, and found fault with the court's lack of factual findings. Judge Nies did not find fault with the district court's use of the expert witness.

[n.40]. 13 U.S.P.Q.2d 1301 (Fed. Cir.1989) (Rich).

[n.41]. Id. at 1304.

[n.42]. Id.

[n.43]. 5 U.S.P.Q.2d 1769 (Fed. Cir.) (Newman), cert. denied, 488 U.S. 850 (1988).

[n.44]. Id. at 1778.

[n.45]. 220 U.S.P.Q. 289 (Fed. Cir.1983) (Rich).

[n.46]. Id. at 300.

[n.47]. 231 U.S.P.Q. 774 (Fed. Cir.1986) (Friedman).

[n.48]. Id. at 778 (citation omitted).

[n.49]. 5 U.S.P.Q.2d 1255 (Fed. Cir.1987) (Newman).

[n.50]. Id. at 1256.

[n.51]. Id. at 1259.

[n.52]. Id.

[n.53]. 221 U.S.P.Q. 944 (Fed. Cir.) (Kashiwa), cert. denied, 469 U.S. 1037 (1984).

[n.54]. Id. at 950 (citation omitted).

[n.55]. 220 U.S.P.Q. 584 (Fed. Cir.1984) (Nies).

[n.56]. Id. at 588-89.

[n.57]. 222 U.S.P.Q. 562 (Fed. Cir.1984) (Nies).

[n.58]. 211 U.S.P.Q. 782 (CCPA 1981).

[n.59]. Id. at 1548 (citation omitted) (emphasis in original).

[n.60]. 7 U.S.P.Q.2d 1548 (Fed. Cir.1988) (Nies).

[n.61]. Id. at 1554 (citation omitted).

[n.62]. Id.

[n.63]. 225 U.S.P.Q. 1100 (Fed. Cir.)(Nies), cert. denied, 474 U.S. 903 (1985).

[n.64]. Id. at 1102.

[n.65]. 168 U.S.P.Q. 623 (9th Cir.1971).

[n.66]. Id. at 624.

[n.67]. Crom Corp. v. Crom, 215 U.S.P.Q. 1103 (9th Cir.1982).

[n.68]. Id. at 1105.

[n.69]. 174 U.S.P.Q. 367 (5th Cir.1972).

[n.70]. Id. at 371.

[n.71]. See e.g. Chromalloy American Corp. v. Alloy Surfaces Co., 173 U.S.P.Q. 295 (D.Del. 1972).

[n.72]. See e.g. Kaiser Industries Corp. v. Jones & Laughlin Steel Corp., 181 U.S.P.Q. 193 (W.D. Penn. 1974) (Former Commissioners Ladd and Schuyler as well as Robert Larson, former President of the APLA); Swift Agricultural Chemicals Corp. v. Mississippi Chemical Corp., 230 U.S.P.Q. 755 (S.D. Miss. 1986)(Former Commissioner Dann and Professor Kayton).

[n.73]. See e.g. Swift Agricultural, supra (Professor Irving Kayton); Oakwood Manufacturing, Inc. v. Novi American, Inc., 212 U.S.P.Q. 261 (E.D. Mich. 1981) (Professor Martin Adelman); Ricon Corp. v. Adaptive Driving Systems, Inc., 229 U.S.P.Q. 731 (C.D. Cal. 1986), aff'd unpublished opinion, 824 F.2d 980 (Fed. Cir.1987) (Professor Adelman).

[n.74]. See e.g. Chemcast Corp. v. Arco Industries, 5 U.S.P.Q.2d 1225 (E.D. Mich. 1987); Thermal Engineering Corp. v. Clean Air Systems, Inc., 8 U.S.P.Q.2d 1908 (W.D.N.C. 1987).

[n.75]. Chromalloy American, 173 U.S.P.Q. at 304.

[n.76]. Swift Agricultural, 230 U.S.P.Q. at 759-60; Kaiser Indus., 181 U.S.P.Q. at 214-16.

[n.77]. Ricon Corp., 229 U.S.P.Q. at 734.

[n.78]. Oakwood Mfg., 212 U.S.P.Q. at 263-66.

[n.79]. Thermal Engineering, 8 U.S.P.Q.2d at 1913; Chemcast Corp., 5 U.S.P.Q.2d at 1235.

[n.80]. Chemcast Corp., 5 U.S.P.Q.2d at 1229-30.

[n.81]. "While the court is, of course, not bound by this expert testimony, it can accept it as advisory or rely rather heavily on it as the situation warrants. . . . But in any event the issue should not be resolved absent such testimony." Sunbeam Corp. v. S.W. Farber, Inc., 145 U.S.P.Q. 36, 44 (S.D.N.Y. 1965).

[n.82]. 160 U.S.P.Q. 646, 659 (N.D. Ill. 1968) (citations omitted), aff'd, 168 U.S.P.Q. 548 (7th Cir.), cert. denied, Poloron Products, Inc. v. Bela Seating Co., 403 U.S. 922 (1971).

[n.83]. Capri Jewelry Inc. v. Hattie Carnegie Jewelry Enterprises, 191 U.S.P.Q. 11 (2nd Cir.1976) (Affirming District Judge Conner).

[n.84]. Both Professor Gambrell and Roy Hofer list the identity of the judge as the number one factor to be considered when offering expert legal testimony. James Gambrell, Experts in Patent Law, 1976 Patent Law Annual 163, 182 (1976); Roy Hofer, Experts in Patent Cases, in Expert Witnesses 411, 422 (Faust Rossi ed., 1991).

[n.85]. See, Capri Jewelry, 191 U.S.P.Q. at 13.

[n.86]. See, Note, Expert Legal Testimony, 97 Harv. L. Rev. 797, 805 (1984).

[n.87]. See, Beckman Instruments, supra.

[n.88]. See, Moeller v. Ionetics, supra.

[n.89]. See, 3 Robert A. White, Patent Litigation: Procedures & Tactics § 702 [2] (1991).

[n.90]. See, Medtronic v. Intermedics, supra.

[n.91]. See, Van Gorp v. Townley, supra.

[n.92]. See Kaiser v. Jones & Laughlin, supra. But see Judge Nies' opinion in Argus Chemical, supra.

[n.93]. See, Friedland, supra note 10, at 457.

[n.94]. See, Friedland supra, at 458-59.

[n.95]. Although the relevant law should be thoroughly explained in the briefs filed, the use of live testimony is considered more memorable and dramatic. Gambrell, supra note 84, at 195.

[n.96]. See, Note supra note 86, at 806-808.

[n.97]. See, Note supra note 86, at 812-813.

[n.98]. See, Friedland, supra note 10, at 459.

[n.99]. Id. at 460.

[n.100]. Id.

[n.101]. See, Note supra note 86, at 811; Gambrell, supra note 84, at 197- 198.