

The Ins and Outs of Expert Witness Work

Talk #3:

- *Finding Work*
- *Types of Cases*
- *Patent Case Example*

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Williams Background

- In the industry for over 37 years: ex Bell Labs
- Consultant for over 27 years
- Involved in all phases of software development through director level
- Expert Witness work sporadically for over 10 years – more in the past few years
- Involved in PATCA and IEEE_CNSV
- Dual client “skins” EW & Product Development:

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How to Find Assignments

- The usual way : “Network, Network, Network”
- Assignments find you:
 - Web presence, publications, presentations
- Brokers - examples:
 - Chatham Group – Jerry Klein – PATCA member
 - NEWN – National Expert Witness Network
 - Teklicon
 - Round Table Group
- Web Directories – examples:
 - JurisPro
 - HGExperts.com
 - Calif-Legal.com
 - ALM Experts
 - SF Bar Association
- Law firm’s internal lists

Types Of Assignments

- Non-Testifying - good place for a technical newbie
 - Provide initial review of materials and advise attorneys of issues.
 - Educate attorneys on non-legal issues: technology briefings, industry practices & procedures, etc
 - Research issues as they come up.
- Testifying – more rigid rules – responsible to court.
 - Look at all materials relevant to opinions to be expressed
 - Form an “expert” opinion – give basis and consider alternatives
 - Defend opinion:
 - Expert reports: opinions, supplemental, rebuttal ...
 - Deposition – makes IRS audit look like fun.
 - Trial - theater
 - Also provide some non-testifying services.
- Court Expert – rare

Types of Cases

- *Patent Infringement*
- *Contract Dispute*
- Trade Secret
- Product Liability/Construction Defect
- Wrongful Termination
- Personal Injury

Patent Infringement Case

- Plaintiff wants Testifying Expert to:
 - Prove product infringes
 - Respond to alleged patent invalidity
 - Respond to alleged non-infringement
- Defendant wants Testifying Expert to:
 - Prove product does not infringe
 - Show that patent is invalid
 - Prior Art
 - Obvious

Patent Infringement Cases

The Patent

Patents include two parts of major interest:

- Disclosure
 - Background of invention & “Prior Art”
 - Preferred embodiment – example of how to make it
- Claims
 - The actual explanation of the invention.
 - Very very very carefully worded: legal definitions
 - example: “consists of” “comprises”

Patent Infringement Cases

Markman Hearing

Often cases will boil down to interpretation of words used in the claims, usually resolved by a Markman Hearing.

Each side presents its interpretation of the word or phrase, other side responds. Expert often contributes to this.

Definition depends on disclosure, general industry interpretation, and lastly, dictionary or other generic sources.

The judge decides disputed definitions.

Wi-Fi Case - 23 pages on definition of “segmentation”

Katz patents: “format” means “software program”.

In Conclusion ...

- Find assignments by networking, hooking up with brokers, and listing in directories.
- Various types of cases
- Most interest to technical PATCA members are patent are trade secret, product liability.
- Most interest to non-technical PATCA members are contracts, HR related.
- Experts in patent cases: testifying & non-testifying – best to start with non-testifying.