

Expert Witness and Litigation Consulting

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In trials, “fact” witnesses may testify about facts, but may not give opinions. A special type of witness is the expert witness, who has credentials that permit him or her to offer opinions. Bioengineers are frequently called upon to serve as expert witnesses in product liability cases where a subject is injured by a medical device, or in patent litigation where a first company sues a second company for infringement of a patent owned by the first company. A patent on an invention is granted by the government for twenty years, which grants the holder an exclusive right to practice the patent in exchange for explaining the invention to the world in a patent published by the US government patent office.

The Cold Call from an Attorney

I had been working about twenty years teaching and doing research in medical devices and instrumentation when an attorney phoned and asked if I would be interested in serving as an expert witness in patent litigation. He asked if I would read some patents and offer a written opinion on their claims. It sounded pretty good to me; they would pay me to read patents and do some writing. It was a real eye opener. I soon learned that in order to get a patent, the patent holder must reveal everything and not hold anything back. I really liked that, as I learned so many details about how medical devices and instrumentation worked. Afterwards, I could quickly turn around and teach my students or write articles or books to inform others. In fact, I am always looking to develop books written from a bioengineer’s point of view. At one time, I wanted to develop a book on cardiac pacemakers, which I consider one of the most important medical devices. But when I approached designers in companies they all clammed up because their company attorneys told them not to give away any company secrets in this competitive market. So I gave up. Later, I was asked to serve as an expert witness in cardiac pacemaker patent litigation. As I read all of the patents, I realized, “Here is all the information I need!” So, I took the detailed information from the patents and was able to develop the book.

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How Do You Become An Expert Witness?

You need a skill and you need to be unbiased. You may work for a medical device company and be skilled in design, but if so, you cannot serve as an expert witness because you would be biased. So attorneys look for skilled, unbiased expert witnesses. Frequently, they ask university faculty who have established reputations through writing books or journal articles. Private consultants are also chosen. It is most helpful if you have published extensively on the subject matter. It is also helpful if you are a teacher and can explain complicated devices to a jury with limited technical background. Holding a license as a professional engineer may be useful as well. I am a biomedical engineer with an electrical engineering background. If an attorney phones me about a case involving biomaterials, I tell them, "I am not qualified in biomaterials." It is important to accept cases only in areas where you can confidently say, "I am an expert." Otherwise the opposing side can challenge and get you disqualified.

Sometimes a broker will call you, describe a case, and offer to arrange a phone meeting with attorneys. Whether you work through a broker or directly with attorneys, the results are the same to you, except the broker will mark up your rate to the attorneys. The broker earns his markup by working for attorneys to search for and find the best expert witness. So in the beginning it is like a job interview. You should realize that the attorneys may be considering other expert witnesses and are looking for the best one. If you get the job, the work begins. If the attorney asks you to give an opinion that you do not agree with, you should decline and resign from the case.

So What Does an Expert Witness Do?

You may be asked to sign a confidentiality agreement that states that you will not disclose any confidential information supplied by the opposing side. Your first question to the attorneys should be, "Do you have an agreement with the opposing side that expert witness report drafts are not discoverable?" If yes, you can send drafts back and forth to your attorney at will. If no, be sparing in writing anything down because the opposing side may demand everything you have ever written on the case, and ask you questions on why you changed this or that. Your attorney will send you the complaint, a pile of patents, patent file histories, prior art publications, depositions, and devices. You read and examine these critically to understand them, and then must write a report by the date set by the judge. In your report, you describe your qualifications, fee, depositions and trials in the past four years, and publications for the past ten years. You attach your resume and other information as exhibits.

If you are on the plaintiff side, you analyze the language of the claims as interpreted by the specification (the main part of the patent). The judge may define the meaning of the claims. You examine and test the accused device to determine whether it is covered by the claims. If so, you write an opinion that the accused device infringes the patent claims. Infringement may be literal: the words in the claim may describe the device. The infringement may be under the doctrine of equivalents if the accused device or process performs substantially the same function, and operates in substantially the same way to achieve substantially the same

result as the claimed invention. You develop as an exhibit a two-column chart with each phrase of the claim in the left column and each matching part of the accused device in the right column.

If you are on the defendant side, you list reasons why the patent is invalid, for example, it was obvious, not novel, not useful, invented earlier as described in prior art (anticipated), the specification does not have an adequate description of how to implement the invention (lack of enablement), the patent applicant held back important information that he should have provided to the patent examiner and did not tell all (inequitable conduct), or the file history describes how the applicant restricted the meaning of the claims during patent prosecution. Not only the listed reasons above, but in addition that you have actually tested the medical device, and it does not infringe the patent because it does not contain every element of the claim or under the doctrine of equivalents.

It is best to err on the side of putting too much in your report, because if it is in your report, you can use the information at trial. If it is not in the report, you cannot bring it up later and use it. There should be no surprises.

It is not common, but you may receive a subpoena from the opposing side requiring you to deliver to them copies of all documents you have used in preparation of your report.

What Is a Deposition?

About a month after opposing sides exchange expert reports, you will be deposed. The deposition is usually for a day, but sometimes two days, with videotaping and a court reporter transcribing. With you under oath, the opposing attorney will ask you questions that you must answer. You cannot win anything in a deposition, you can only lose something. If you are asked if you know what time it is, you do not answer, “two o’clock,” you answer “Yes.” This is not the time to demonstrate your great learning. Just listen very carefully to the question, wait a few seconds to think about it and give your attorney time to object, then answer briefly. If the attorney begins a question with, “Is it not true that . . .?” make sure you preface your answer with, “Under the following conditions, it is true.”

At the deposition you should be ready to answer many questions: all your personal information regarding education, employment, memberships, which publications are pertinent to this suit, who engaged you and when, who wrote or assisted writing your report, what bases and reasons helped form your opinion, when you formed your opinion, and when and how you prepared for this deposition.

What Happens at the Trial?

The vast majority of cases settle just before trial because litigants prefer to avoid the large expense of a trial. But a few cases do go on to trial. Before the trial, you should help prepare demonstrative exhibits. They may include large charts that help you explain complicated concepts. Large scale models are also helpful, particularly when they include movement, sound, and/or light. One time I had to

explain what derivative (slope) meant. I drew a rising curve that showed the response of an under-the-tongue temperature sensor to a step increase. When the slope decreased to a certain threshold, the thermometer calculated the final temperature. I took a home mercury thermostat in a small box and moved it up the curve parallel to the line and showed how when the slope was steep, nothing happened, but when the slope of the box decreased to a certain threshold, the mercury made contact and an internal buzzer sounded. This is the kind of demonstration that will wake up the jury and make them pay attention and remember something during a four week trial where mostly what they hear are words.

At the trial, your attorney will ask you friendly questions that elicit the testimony that he or she wants to get into the record. In one trial, I testified for five hours on direct. Then the opposing attorney cross examined me for ten hours, challenging my testimony and trying to make me appear a fool. You do not have to memorize everything, but can ask for documents to help refresh your memory. If the opposing attorney asks for a yes or no answer to an ambiguous question, you can answer, "If by your question you mean this, then the answer is yes." When expert witnesses for the opposing side are on the stand, you can pass a slip of paper to your attorney to suggest questions he might ask.

What about Personal Injury?

When patients undergo surgery, they expect good results. When bad results occur, they may sue the physician, the hospital, and the medical device manufacturer. Modern surgery involves medical devices such as electrosurgery, anesthesia machines, and large imaging devices. Problems associated with such devices have resulted in serious burns, loss of limbs, and death. Because the bioengineer may be an expert on one of these medical devices, he or she may become an expert witness in one of these cases and offer an expert opinion on the cause of the problem.

What are Expert Witness Fees?

As of 2007, if you have a master's degree and several years of experience, \$200 per hour is reasonable. If you have a PhD and ten or more peer-reviewed publications, \$300 per hour is reasonable. If you have a PhD, have many publications and books, and are one of very few experts in your specialty area, \$400 per hour is reasonable. These are typical fees, and must be stated in the expert witness report. When an attorney calls you, I suggest that you send your resume, your previous expert witness work, and your fee schedule similar to the sample below.

Sample Fee Schedule Letter

John G. Webster, PhD

Expert witness and consultant in medical devices and instrumentation

Fee schedule

For work performed in "Location," \$\$\$/hour.

Includes research and investigation, testing of devices, reading depositions, deposition and trial preparation, telephone counseling, oral and written reports, literature searches in extensive personal library, online literature searches of all books in all campus libraries, journal literature and patent searches from computer in my office, searches in University of Wisconsin Engineering Library (which contains all patents).

Work outside “Location” will include regular hourly charge for travel time. I will use this time as efficiently as possible to review literature on your project and to prepare documents for your project.

Includes research and investigation, consultations, oral reports, travel, depositions, and court testimony. To be followed with a written report, as required.

Actual expenses reasonably and necessarily incurred, such as travel, subsistence and lodging, long distance telephone charges, professional support requirements, etc., are additional to the consulting fee and will be billed to the client at cost.

Terms: Letter of agreement that states who guarantees payment of the fees and expenses.

Billed monthly and payable net 30 days from date of invoice.

Summary

If you have expert qualifications, career or sideline work as an expert witness can be interesting, educational, remunerative, and enjoyable.

Suggested Reading

1. Poynter D. *The Expert Witness Handbook: Tips and Techniques for the Litigation Consultant*, 3rd ed., Para Publishing; 2004.