

Preparing the Expert for Cross-Examination

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Experts are people who know much about a little and continue to learn more about less until they know everything about almost nothing.

Lawyers know a little about a lot, learning less about more until they know nothing about almost everything

Judges begin knowing everything, but end knowing nothing, owing to lawyers and experts¹.

Expert witnesses play a vital part in most intellectual property law dispute proceedings: a computer science professor may be retained in a patent impeachment action, a consumer psychologist in a passing-off action, a process chemist in a PM(NOC) proceeding, and an accountant in a copyright action. This has been the case for decades. In 1977, Justice Collier in *Xerox of Canada Ltd. v. IBM Canada Ltd.* commented on the role of expert witnesses: "...[I]n the case of expert witnesses the trier of fact may accept or reject the beliefs or opinions tendered, or any part of those beliefs or opinions. Always, opinion evidence must be scrutinized with great care."²

In determining whether or not to accept an expert's opinion, judges of the Federal Court are usually swayed by the following qualities: experts who remained objective and fair, even in cross-examination; experts who conceded points that seemed obvious; and experts who tended to be advisers and objective rather than advocates and adversary. Just recently, Justice Layden-Stevenson remarked about an expert witness who had testified in trial: "he was forthright, fair and reasonable in answering all questions...he answered thoughtfully and directly...He, in my view, exemplifies the requisite characteristics and qualities of an expert witness."³

Given the role of experts in intellectual property proceedings, it is crucial for counsel to prepare experts for their cross-examination, the purpose of which is to undermine the expert's

¹ *Anon.*

² *Xerox of Canada Ltd. v. IBM Canada Ltd.* (1977), 33 C.P.R. (2d) 24 at para. 30 (F.C.T.D.).

³ Confidential reasons of Justice Layden-Stevenson, dated April 30, 2008, at para. 205 (F.C.).

opinions and attack his or her credibility. The purpose of this short paper is to provide some practical guidelines for preparing expert witnesses for cross-examination in intellectual property litigation.

1) Tell the truth

A witness should tell the truth to counsel, tell the truth during preparation for cross-examination, and tell the truth during cross-examination. A lie goes directly to the expert's credibility and may cause your client to lose the case.

2) Do not give opinions outside field of expertise

Experts should not give opinions or accept responsibility in areas in which they are not truly qualified. If an expert reaches outside his expertise and is discredited in that area, he will lose credibility in the more important areas of his true expertise. The expert should know the confines of his defined expertise, and should be wary of questions designed to tempt him beyond those confines.

An expert should be prepared accordingly to ensure that he is aware of the exact issue or issues which counsel expects the expert to address. Counsel may determine that information given to the expert should be limited so as to narrow the focus of potential expert testimony. However, counsel should bear in mind that for the expert's testimony to be credible, he must be reasonably well-informed on any and all issues in the case which may relate to the basis of the ultimate opinion expressed by him. Counsel must therefore know what the expert has reviewed and that the examined material provides a credible basis for his opinion.

3) Review prior writings and/or courtroom testimony

All the expert's professional writings, presentations and previous testimony should be reviewed thoroughly by counsel since it will definitely be reviewed thoroughly by the cross-examining counsel and potentially used during cross-examination. A careful review should be undertaken to ensure that inconsistent positions are not taken. In particular, counsel should determine whether the expert has written or testified previously with conclusions inconsistent to those being taken in the case at hand.

If the expert has always testified for the same side, the expert's objectivity may be at issue and he may be seen as a "hired gun". An impartial expert should consistently apply his skills on behalf of both plaintiffs and defendants. Also bear in mind that although previous litigation experience will likely make the expert less nervous and thereby better able to respond during cross-examination, contrary positions taken in previous proceedings will be used by opposing counsel as ammunition to attack the expert's credibility.

4) An advisor and objective, not an advocate and adversary

An expert witness must have an open mind and a willingness to conduct an independent analysis of all issues. As succinctly explained by Justice Harrington in *Biovail Pharmaceuticals Inc. v. Novopharm Ltd. et al*, expert evidence presented to the court should be "the independent product of the expert uninfluenced as to form or content by the exigencies of litigation."⁴

An expert should not argue and advocate on behalf of the retained party, rather he must explain and defend his opinions and the basis of his opinions. The mixing of argument and opinion is objectionable.⁵ Although the expert's opinions favour one side, the expert must maintain an attitude of being an independent servant of the court.

An expert should not be overconfident or overly certain of his opinion, for he may then appear to have a closed mind and lack the capacity to recognize distinctions. An expert should also not lose his temper and argue with opposing counsel. Being courteous is a good way to make a good impression. An expert will only lose credibility if he loses control of his emotions.

5) Concede obvious points

The expert witness should concede anything which seems obvious or logical, and concessions should not be made reluctantly or grudgingly, or at the intervention of the Court. Justice Collier noted with discontent regarding one expert witness: "When a simple, obvious answer should have been given, it often was not."⁶ A concession made graciously and quickly will demonstrate that the expert is fair and flexible. An expert who shows unwillingness to

⁴ *Biovail Pharmaceuticals Inc. v. Novopharm Inc. et al* (2005), 37 C.P.R. (4th) 487 at para. 16 (F.C.).

⁵ *Eli Lilly & Co. v. Novopharm Ltd.* (1997), 73 C.P.R. (3d) 371 (F.C.T.D.).

⁶ *Xerox of Canada Ltd. v. IBM Canada Ltd.* (1977), 33 C.P.R. (2d) 24 at para. 54 (F.C.T.D.).

acknowledge an obvious favourable point of the opponent, or to admit the possibility of a reasonable alternative view, will not be credible.

6) Be responsive but only answer the question asked and watch out for garden paths

The expert's answers during cross-examination should not go beyond the question. Volunteering information may result in new lines of cross-examination, and may disclose information to which opposing counsel may not have otherwise been privy. The expert should answer open-ended questions as concisely as possible. Justice Layden-Stevenson recently noted that an expert's verbiage led to confusion: "In many instances, several paragraphs could (and should) have been compressed into a few sentences."⁷

If several questions are combined together and/or the expert does not understand the question, the examining counsel should be asked to repeat the question. The expert should also be counseled to listen carefully to the question so as to not be led down the garden path. The question should not be answered until its meaning is easily understood. An expert should not allow himself to be rushed, and should give sufficient thought to the question in order to formulate an answer. As most litigators know, pausing before answering the question not only enables the witness to give a thoughtful answer, but also allows counsel to consider objections. The expert should also fully review any document about which he is asked before answering questions pertaining to the document.

7) Do not guess

An expert witness should never guess. Guessing can only hurt the expert's credibility. Sometimes "I don't know" is the best answer. The expert should simply refuse to speculate: the "I don't know, but..." reply is usually one of the most damaging.

8) Beware of hypotheticals

Hypothetical statements can be a persuasive tool in the cross-examination of experts. The expert's knowledge and the value and accuracy of his opinion are tested by setting out a

⁷ Confidential reasons of Justice Layden-Stevenson, dated April 30, 2008, at para. 204 (F.C.).

group of facts and asking the expert to hypothesize on the possible outcomes. Experts should be wary of hypothetical questions since they must accept facts which may not even relate to the case and are inaccurately framed. Experts should ask that the question be specified since generalities often lead to inaccuracies. Moreover, experts should be well-versed in the facts of the case so that they are able to compare the hypothetical with the case facts to show, if necessary, that the hypothetical was not accurate to the facts of the case.

9) State assumptions and avoid absolute words

Absolute words such as “always” and “never” are often an invitation for cross-examination. The best way to proceed is to avoid absolute statements since there are always exceptions to every statement. The expert should not make unsupported or unsubstantial assumptions in an attempt to answer questions during cross-examination. If an assumption is made, especially in response to a hypothetical question, the expert should clearly state that assumption and how it differs from the facts at issue in the case.

10) Do not vary the methods of interpretation

Experts should not vary their methods of analysis or interpretation in order to achieve consistency with their opinions or support one party. This essentially ruins the objectivity of the expert and his assistance to the Court. An expert who varied his methods interpretation did not impress Justice Collier:

Dr. Hendricks, in testifying as to the teachings of the prior art or of the patents in suit, sometimes, in my opinion, varied his methods of interpretation in order to reach a desired result. At times he read passages absolutely literally. At times he divorced some parts from the whole. Frequently he did not read them in the role of a skilled addressee, but in the role of an unskilled workman in the art.⁸

11) Communicate in simple language

The expert witness has knowledge that is not commonly possessed by the average person, however that knowledge has to be communicated to a judge, who often does not have a technical

⁸ *Xerox of Canada Ltd. v. IBM Canada Ltd.* (1977), 33 C.P.R. (2d) 24 at para. 50 (F.C.T.D.).

background. According to Justice Binnie, the pursuit of truth in science by lawyers in a courtroom is akin to “the incomprehensible chasing the unteachable”.

An expert who speaks in technical jargon risks being misunderstood by the judge. Therefore it is important that the witness explain himself in clear, simple language. The expert witness must be able to communicate effectively and persuasively, and construct clear arguments out of abstract facts.

12) Pick troublesome statements and do a mock cross-examination

The expert should be fully aware of all facts upon which the opinion is based, and which facts are significant such that a change in the facts would necessitate a change in the opinion. Each of the key facts should be analyzed with the expert to determine how the expert’s opinion would change given certain factual changes. Undoubtedly there will be at least one troublesome or sensitive statement and counsel should review all such statements with the expert witness.

Mock cross-examinations, especially for inexperienced expert witnesses, will help minimize surprises and anxiety, and is excellent preparation. Mock cross-examinations will also assist with training the expert to listen carefully to the question, including hypothetical questions, and to state all assumptions when responding.

13) Prepare for re-examination

Counsel has an obligation to explain the process leading up to and after the cross-examination, including the availability of re-examination. As re-examination occurs directly after cross-examination, it is imperative that counsel prepare the witness for re-examination along with cross-examination. The expert should be aware that re-examination may be the proper opportunity to re-establish the credibility of a witness by introducing a prior consistent statement after a suggestion on cross of inconsistent positions, or by clarifying matters raised in the cross-examination.

14) Prepare, prepare, prepare

Make sure your expert understands how his opinions fit into the general argument of the case, knows the relevant dates, and is using data that is pertinent to those dates. An expert should be retained early in the case and be thoroughly prepared so that the expert is capable of educating the judge.

As soon as the expert is retained and well-before final conclusions are reached, an expert should explain favourable and unfavourable facts, false or weak assumptions, opinions upon which reasonable minds may differ, and available testing methods to address challenges. In addition, the expert's resume should be thoroughly reviewed, and his education, publications, memberships and awards should be verified.

The expert should also be warned that he may be asked questions about a subject which he did not address in his report, and should be prepared for such questions. In addition, forewarn your expert of potential areas of cross-examination, including attacks upon qualifications, attacks upon the basis of the opinion, and attacks upon hypothetical or changed facts. Opposing counsel will also attempt to discredit the facts or premises that the expert has adopted in order to express his opinion, therefore it is important that the expert understand and/or state all the underlying facts or premises.

An objective expert witness who is properly prepared by counsel is a valuable asset in an intellectual property case.