Expert evidence around the world

The issues of expert evidence and what role it plays in IP cases was debated by a panel of judges in yesterday’s lunchtime session.

Dr Massimo Scuffi of the District Court of Aosta and member of Italy’s Patent & Trademark Board of Appeals noted the role of experts in Europe is diverse, and can include acting as assistant to each party, being an expert witness, being sole representative of a party or being appointed by the court.

Judge Walter D Kelley Jr, a former judge for the Eastern District of Virginia, said that the US system is adversarial and that judges decide many civil cases. “As a consequence, you have to choose experts who not only have great expertise or technical sufficiency but you also have to choose experts who can talk to a jury and who can simplify things or dumb them down, if you will, sufficiently that a jury can understand what it is that each side is advocating,” he said.

To give a sense of how partisan the system is, Judge Kelley noted that US law recognises a privilege between a party’s lawyer and their expert witness. US judges under the Supreme Court’s 1993 Daubert standard have a duty to investigate the admissibility of witnesses’ testimony. “It serves as a gatekeeper function to prevent junk science getting in front of a jury,” said Judge Kelley.

Claim construction is one of the most common things experts testify about in the US but roughly half of district court claim constructions are reversed on appeal by the Federal Court of Australia, experts are generally chosen by the parties but judges are clamping down. “The way in which the system has developed in Australia is that it is based on common law model and adversarial in nature,” said Judge Nicholas. “This has given rise to what have been perceived to be problems. Because the view that has been arrived at by the court as a collective body over many years now is that this is an overly combative system of using experts as hired guns that too readily fall into the trap of acting as advocates for a party and whose objectivity and impartiality is left at the courtroom door.”

The court developed new procedures that are aimed at impressing on legal representatives and experts that their role in giving evidence to the court carries with it some special duties that are owed to the court and not to the parties they represent. These include the expert being expressly required to agree to be candid, not to withhold information and to make a full disclosure of any instructions given to the expert by legal representatives.

Chief Judge Ryuichi Shitara of the Intellectual Property High Court of Japan noted that a party can produce a declaration of an expert in evidence. “It is possible but very rare to hear live testimony from expert witnesses because it is not usually necessary to hear it,” he said.

Room Red in the MiCo was packed at 8.30 yesterday morning for a discussion on the implications of Brexit.

The pan-European panel described the UK referendum vote as a “surprise” and a “shock” which had led to “chaos”. But chair Cesare Galli of IP Law Galli urged the audience also to consider positive possibilities: “Perhaps it can be an opportunity for all of us.”

Giving a view from the UK, Gordon Harris of Gowling WLG apologised on behalf of the 48% of people who had voted to stay in the EU. He said Brexit would have particular implications for the pharmaceutical industry, as supplementary protection certificates are based on EU Regulations, interpreted by the CJEU and implemented by the UK courts: “No SPCs in UK law is a very serious issue for the pharma industry.”

As a result, he said, the UK is likely to be under pressure to continue SPC protection post-Brexit and may even consider extending their scope, for example to medical devices or even aviation parts. “Brexit will be time-consuming and uncertain and for a long period of time industry would not know where it stood,” he concluded.

Francesca Giovannini of Osha Liang said there is “big uncertainty” about the enforcement and recognition of judgments post-Brexit. She discussed the possibility of the UK signing a reemergent Brussels Convention or (if it joined EFTA) signing the Lugano Convention. In the meantime, she said, litigants need to consider where and when to bring actions, bearing in mind their enforceability.

Tobias Dolde of Noerr set out the pros and cons of seven options for EU trade marks and designs post-Brexit. “By the time of Brexit, there will be about 1.5 million EUTMs registered – what will happen to them? Nobody knows,” he said.

Dolde said the decision about which option to follow might be determined in part by financial considerations, but added: “We can hope that discussions will take account of interests of trade mark owners.”

All the panellists agreed that IP owners and practitioners need to monitor developments, and participate when the opportunity is available. “We need to be prepared and updated on the evolution of negotiations,” said Galli.

Keep calm and be prepared for Brexit
Contributory infringement: your questions answered

What is the framework for contributory infringement? Does the supplier need knowledge? Does the supplier need to direct the customer? Is an intention to supply sufficient? What is the position on supply of kits of parts? And how are damages calculated? These were just some of the questions addressed in yesterday’s panel on contributor infringement, which offered perspectives from China, Germany, the UK and US.

The panel also considered questions written down by members of the audience on issues such as kits of parts, consumables and skinny labels. It discussed scenarios involving technologies as diverse as pharmaceuticals, coffee capsules and even pianos.

Emily O’Neill of Spectris moderated the panel and provided a UK perspective, while Matthias Leistner of the University of Bonn explained the position in Germany, describing the difference between indirect infringement and contributory infringement under the general principles of tort law. On many questions, he said, German law is “particularly complicated” and in some recent pharmaceutical cases it is “dangerous for generic manufacturers”.

MaryAnne Armstrong of Birch Stewart Kolasch Birch said US law distinguishes between inducing infringement and contributory infringement, and described the broad territorial reach of the latter. In China, said Yanfeng Xiong of China Patent Agent (HK), there is little case law, but the law is developing and in some ways US practice is followed.

Without discovery, said Xiong, damages for contributory infringement in China are hard to calculate – but will be distributed evenly between infringers if they cannot be properly split. Amendments might be made in the next revision to the Patent Law, expected soon. “There might also be room for further interpretation either by case law or by judicial interpretation,” he added.

The panel discussed recent developments regarding skinny labelling (where generic manufacturers indicate which indications their products are or are not approved for). The challenge of establishing liability for contributor infringement in these cases is compounded by the overlaps between patent law, public law and competition law, said Leistner: “The problem is the patent system is confronted with a multitude of different health finance systems.”

Further questions concerned the possibility of taking action against intermediaries, such as telecoms operators and shipping companies, and practical enforcement issues. “It’s not always practical to go after the party committing direct infringement. It may be thousands of private end users, it may be a doctor. In those cases you have to go after contributor infringement,” said Armstrong.

Contributory infringement: your questions answered

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