Expert Issues in Patent Litigation

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Selecting an Expert

Do I Need an Expert?

Before you start thinking about how to select an expert, you should ask yourself whether you need an expert in the first place. Although in many cases the use of experts is optional, the Federal Circuit has required the use of experts in cases involving particularly complex legal issues.

There are three main types of experts: (1) technical experts, (2) damages experts, and (3) patent law experts. Technical experts deal with the nitty-gritty of the invention, and are therefore most heavily used in analyzing claim construction, infringement, or validity. Damages experts perform market analyses, analyze complex bargaining situations, and estimate the plaintiff's lost profits, consider the impact of noninfringing substitutes on possible royalties the parties would have agreed to, or do other analysis grounded in economics. Patent law experts typically opine about the practices and procedures of the US Patent and Trademark Office (PTO).

Hiring the right expert can be the most important decision you make regarding the trial. Your expert, after all, is going to be speaking directly to the judge and the jury, and you want to put someone in front of them who can convince them that your client should prevail.

What Factors Are Important in Selecting Experts?

As with any witness, you want your expert to be credible, comprehensible, and likeable. An expert's credibility depends in part on credentials such as the expert's educational background, industry experience or other demonstrated expertise, but it also depends on less tangible factors, such as the expert's ability to withstand cross-examination or his composure on the witness stand.

How Do I Find an Expert?

The best experts to use are those previously used by you, your firm, or your client. If you know your experts' credentials, strengths, weaknesses, and track record, you will be able to make use of that knowledge in litigation. If you and your firm have little experience hiring experts, you should ask your friends and colleagues for expert references, particularly if they have litigated cases involving similar subject matter. There also are expert referral services that frequently generate great leads. Sometimes even the inventors themselves can make good experts.

When selecting among a number of qualified experts, it always is prudent to consider how your expert will be perceived by the court or the jury. For example, academics may sometimes (but not always) come across as more credible than "professional experts," in part because they are used to teaching unsophisticated audiences about complicated matters.

If you haven't had personal experience with the expert you're interviewing, you might consider running a "beauty contest." Send the case materials for review to each expert that you're considering and get the expert's assessment of the case in an interview. Some experts might bring to your attention new ideas or strategies that can help your case immensely. You can take that as a good sign that the expert will be an asset to the litigation.

You'll also want to ensure that the expert thoroughly understands the technology at issue and that the expert's opinions of the patents, technology, prior art, and the industry are consistent with yours. You don't want your expert to fall apart on the stand when pressed by opposing counsel or make statements that run contrary to your proposed claim construction.

Once you choose a few candidates, do your homework. Has the expert given prior testimony or published an article that contradicts his position in the case? Has the expert ever been disqualified or challenged on *Daubert* grounds, or openly criticized by the court in an opinion? Does a quick Internet search return any negative press or contradict the expert's stated credentials? Your opponent undoubtedly will discover where your expert's bodies are buried—it's better that you find them first.

When Should I Select an Expert?

The earlier you recruit an expert, the more the expert can help you. Experts might know the right questions to ask during discovery, whom to depose, and who might possess information that you'll want to bring out during a deposition or trial. They also can be very useful in formulating requests for production, interrogatories, and requests to admit. Accordingly, you should keep your expert informed on recent case developments and assign a point person on your team to do so.

Types of Experts

Technical Experts

Technical experts can assist you throughout litigating a case. They can support your proposed claim construction, or your infringement- and invalidity-related arguments. Your most important job in patent cases is to convince the court and the jury that your technical expert knows what a person having ordinary skill in the relevant art knows and doesn't know, and that they should accept your expert's opinion on the issues of claim construction, infringement or invalidity. Make sure that your expert had the relevant expertise at the time of the invention in suit—newbies, no matter how talented, can invite unwanted criticism once the case is underway.

If more than one technical art is at issue in a given case, it is helpful to have a separate expert for each technology. Doing so provides at least two benefits: (1) having a separate expert for each art lends each expert additional credibility in his or her art; and (2) it can provide an additional barrier if your opponent attempts to disqualify your experts. It's harder to disqualify two experts than it is one.

Damages Experts

Unlike technical experts, who assist you with legal determinations regarding the invention itself, damages experts are very useful for justifying your theory regarding the appropriate amount of damages (if any). There are two kinds of damages awards in patent cases: (1) lost profits and (2) a reasonable royalty. Lost profits are based on an analysis of the market for the parties' products, granting the plaintiff the amount of money it would have made had the defendant never infringed. The second, setting the floor for damages in infringement suits under 35 U.S.C. § 284, is "a reasonable royalty for the use made of the invention by the infringer...." Under the seminal decision in *Georgia-Pacific v. U.S. Plywood Corp.*,[1] a "reasonable" royalty is typically the amount that the parties would have agreed to on the eve of first infringement, presuming that the patent is valid and infringed.

In lawsuits involving a reasonable royalty theory only, it is common to rely on accountants, valuation experts, or former in-house licensing executives as damages experts. But in lost profits cases, which often require complex market analyses such as "but for" market reconstruction, an economist with licensing experience and a PhD may be more credible than other types of experts. No matter who you decide to hire, make sure that your expert is aware of recent Federal Circuit damages case law.

Patent Law Experts

Before the *Markman* case established that claim construction is an issue of law, patent law experts were more common. Today, they are quite rare and have become controversial—judges do not generally want witnesses offering testimony on issues of law. Patent law experts typically are individuals with "extensive experience working at the PTO as an examiner," qualified to testify as to "patent office practice and procedure."[2] Patent law experts may not, however, opine on a legal issue or the "thoroughness of the consideration of [legal] issues considered by the examiner";[3] offer "legal conclusions as to the adequacy" of a patent application's disclosure;[4] offer evidence that insinuates that the PTO has "problems" or has not done its job properly;[5] testify as an expert witness on the issues of infringement or validity, or usurp the domain of the judge to instruct the jury on the law.[6] Patent law expert testimony generally has been accepted where it goes only to PTO practice and procedures.[7] But sometimes a patent attorney whose opinion is used to rebut willfulness also can act as a *de facto* patent law expert. That is, by using the attorney's understanding of the specification and his or her claim construction, the patent attorney can opine that a patent is invalid or not infringed. This may be something to consider before moving to bifurcate.

Court-Appointed Experts

Rule 706 of the Federal Rules of Evidence provides the court an avenue to appoint its own expert if the parties do not wish to hire their own, or if the judge wants an opinion that is not "biased." In such cases, parties typically are asked to select an expert by agreement and split costs between them. At times, however, the court may choose its own expert without reference to the parties (though the parties can object for cause).

Testifying/Nontestifying Experts

Not all experts are required to testify. Some might be great on paper, but perhaps you might anticipate that they would not be effective before the court or the jury.

That doesn't mean you shouldn't use them—it just means that you'll want another expert to put on the stand at trial. A different set of discovery rules apply to testifying experts versus nontestifying experts.

The discovery rules applying to testifying experts are embodied in Federal Rule of Evidence 26(a)(2), "Disclosure of Expert Testimony," amended in 2010. As its name implies, it requires the disclosure of information about testifying experts before trial. This disclosure usually comes in the form of an expert report, which Rule 26(a)(2) requires contain:

1. A complete statement of all opinions the witness will express and the basis and reasons for them;
2. The facts or data considered by the witness in forming them;
3. Any exhibits that will be used to summarize or support them;
4. The witness's qualifications, including a list of all publications authored in the previous 10 years;
5. A list of all other cases in which, during the previous four years, the witness testified as an expert at trial or by deposition; and
6. A statement of the compensation to be paid for the study and testimony in the case.[8]

Unless otherwise ordered, those expert reports are due 90 days before trial, with rebuttal reports becoming due 30 days later.

Almost without exception, experts are bound to the statements made in their expert reports. So ensure that your expert's reports are accurate and represent your best positions, because it is very common for portions of an expert's testimony to be stricken when statements made at trial were not contained in the expert's report. (Such testimony usually will be permitted, however, if the expert gave prior deposition testimony on the issue.) But courts deal with such objections differently—interrupting the trial, particularly with a jury present, can be distracting and time-consuming, and is thus frowned upon. One former judge I argued before had an unwritten, draconian rule: If you elicit expert testimony on a critical point that was not in the expert report, and you win, a new trial will be ordered at your expense. Ouch.

Nontestifying experts, in contrast, are not subject to Rule 26's disclosure requirements. They don't have to give reports, and their identities don't have to be disclosed prior to trial. You may want to consider this issue when drafting protective orders that require disclosure of any expert to whom highly confidential material is disclosed. But if there is ambiguity whether an expert is testifying or merely consulting, courts have erred on the side of disclosure.[9]

Nontestifying experts often are extremely helpful. They can conduct tests, sift through evidence, and many other things that testifying experts do. But they're often much less expensive than testifying experts, and perhaps most importantly, they can conduct experiments or try theories that are shielded from the testifying expert. Vetting infringement theories in pharmaceutical patent cases is a very good use of nontestifying experts. In that way, infringement, validity, or damages theories that "don't work" will never be known to the testifying expert and never disclosed to the other side.

Your nontestifying expert is not immune from disclosure, however. If your testifying expert relies on your nontestifying expert's report, analysis, or other work (which is quite common), then your nontestifying expert typically is deposed and his or her work product disclosed. Nontestifying experts can otherwise also be deposed or provide interrogatory answers pursuant to Federal Rule of Evidence 26(b)(4)(D)(ii), which requires nontestifying experts to comply with these requests "on showing exceptional circumstances under which it is impracticable for the [opposing] party to obtain facts or opinions on the same subject by other means."[10]

Lay Witnesses

Whether lay witnesses can give opinion testimony is decided on a case-by-case basis. Under Federal Rule of Evidence 701, a lay witness can testify about a subject if it is: "(a) rationally based on the witness's perception; (b) helpful to clearly understanding the witness's testimony or to determining a fact in issue; and (c) not based on scientific, technical, or other specialized knowledge within the scope of Rule 702."

As one would expect, this often leads to close questions, particularly when the testifying witness, for example, is a technical client talking about her own work. If your client, the inventor, is testifying about the circumstances under which he or she first conceived of the invention, the discussion can become technical very quickly, blurring the line between fact witness testimony (when did he or she conceive of the invention?) and expert testimony (what was the invention?). Cases have indeed disqualified inventors' testimony when it crossed the line into expert testimony.[11] These cases teach an important lesson: If you plan to call a technical, lay witness to the stand, it is better to prepare an expert report for him or her ahead of time, just in case.

Protective Orders

Protective orders allow parties to have notice of who exactly will have access to highly confidential information. There are a number of options when constructing a protective order: Each side can be required to give the other notice of disclosure, or give each the opportunity to object to a disclosure, for example, if there is a conflict

issue. On the other hand, some attorneys draft protective orders that require parties to disclose their nontestifying experts even if not required by the Federal Rules. Doing so ensures that experts do not have disqualifying characteristics such as current work for a competitor, or prior work for a party with whom the expert has a confidentiality agreement arising from such work.

Admissibility of Expert Testimony

In order to be permitted to testify at trial, a court must find your expert witness qualified under the *Daubert*[12] standard. In *Daubert*, the Supreme Court established the trial judge as the gatekeeper of scientific expert testimony, tasking the judge with allowing in only well-qualified experts who use valid scientific methodologies. The judge's job is to ensure, under Federal Rule of Evidence 702 (Rule 702), that an expert's testimony is relevant and reliable, and comprises sound technical principles using standards that are accepted in the scientific community.[13] *Daubert* established criteria for judges to examine a technical expert's credentials, opinion, and testimony when evaluating admissibility.

First, *Daubert* required that the expert witness be testifying to (1) "scientific knowledge" that (2) "will assist the trier of fact to understand or determine a fact at issue."[14] The Court went on to identify four factors for consideration of admissibility under Rule 702:

1. Whether the methodology can and has been tested;
2. Whether the methodology is subject to peer review;
3. The potential rate of error; and
4. The general acceptance of the methodology.[15]

Kumho Tire clarified and expanded the *Daubert* inquiry to reach all expert witnesses under Rule 702, including nontechnical experts.[16] It also relaxed the *Daubert* inquiry, holding that the standard should be "flexible"—able to accommodate varying factors depending on the circumstances when evaluating admissibility of expert testimony. *Kumho Tire* clarified that the objective of *Daubert* is to "make certain that an expert, whether basing testimony upon professional studies or personal experience, employs in the courtroom the same level of intellectual rigor that characterizes the practice of an expert in the relevant field."[17]

Federal Rule of Evidence 703 provides an important contour to the *Daubert* requirements. Under Rule 703, an expert may base his opinion on information in the case that the expert has been made aware of or personally observed. If experts in that expert's field would "reasonably rely on those kinds of facts or data in forming an opinion on the subject, they need not be admissible for the opinion to be admitted." In other words, expert opinion may be based on inadmissible evidence such as hearsay, but you cannot reveal that information to the jury unless its probative value substantially outweighs its prejudicial effect.[18]

As a practical matter, parties often attempt to preclude expert testimony *in limine* on *Daubert* grounds based on the expert's qualifications, any applicable conflicts of interest, the expert's methodology, or for exceeding the scope of the expert's report. If the expert has had a prior relationship with the opposing party, courts may disqualify an expert *in limine* if both of the following conditions are met: (1) it was objectively reasonable for the party having the prior relationship to conclude that a confidential relationship with the expert existed; and (2) confidential or privileged information relevant to the current litigation was actually disclosed to the expert.[19] When both prongs are met, courts often make additional policy-related inquiries before excluding expert testimony, such as whether a disqualification would be fair to the affected party and would promote the interests of justice.[20] Courts particularly are reluctant to allow experts to testify when they have signed confidentiality agreements with entities whose interests might be implicated by the expert's representation, or otherwise might be tempted to reveal or rely on confidential information for her opinions.[21] But a single consultation alone is not enough to disqualify an expert on impartiality grounds.[22]

Technical Experts

In the case of technical experts, there are a number of considerations that will help your expert and his or her report pass *Daubert* muster. First, ensure in particular that the testimony does not encourage the jury to improperly use hindsight to combine prior art on the issue of obviousness;[23] and that the testimony and report are not contrary to the court's mandated claim construction. Failure to do so could result in your expert's testimony and report being stricken or other sanctions against you.

Your technical expert does not necessarily need to have extensive experience in the *exact* technology or science at issue in the case. Expertise in a closely related field has been held sufficient. For example, if the technology is the arm-sleeve design of shirts, and your expert has 20 years' experience designing "socks, wristbands, headbands, and bags," that has been held sufficiently related.[24] Likewise, chemical engineering and biology have been held to be closely enough related to allow an expert in one to opine on the other.[25] But you cannot, for example, have your computer engineering and software expert testify about marketing products.[26]

Your technical expert must use methodology that generally is accepted by at least some scientists in the field.

Many courts have disqualified experts from testifying when their methods did not meet that threshold.[27] Others have disqualified experts for failing to use the methodology that they claimed to have used in their reports.[28] Finally, expert reports have been stricken in part or in their entirety if they rely on previously undisclosed noninfringement contentions or prior art.[29]

Damages Experts

Damages experts' testimony generally has been admitted when the expert's calculation is based on "facts meeting the minimum standards of relevance and reliability."[30] Testimony has met this standard even when it relied on a party's stock price to determine a reasonable royalty;[31] when the defendant's expert's opinion took the plaintiff's voluntary dismissal of other cases as evidence that the defendants in those other cases had likely developed noninfringing products;[32] and when the expert failed to consider each accused infringer individually.[33]

Damages experts' opinions have been excluded, however, when the expert relied on unrelated licenses;[34] the expert based his or her royalty on the sale price of computers bearing the software rather than the price of the software itself;[35] the expert continued to rely on the 25 percent "rule of thumb" royalty after the Federal Circuit ruled it improper to do so;[36] the expert relied only on the Nash bargaining solution;[37] the expert's supplemental report was merely a more thorough articulation of his or her original report, which was "something he should have done in the first place";[38] the expert summarily concluded that the result of his or her hypothetical negotiation would be a 50-50 split of the incremental profits attributable to the patent-in-suit without tying the hypothetical negotiation to the facts of the case;[39] the expert posited that the defendant would have "taken a risk on the infringement question and agreed to a huge, profit-eliminating... royalty obligation for itself";[40] the expert relied only on a single settlement agreement on a patent other than the patent-in-suit, without any analysis of the settlement content;[41] and where the expert equated the value of the patent-in-suit to the plaintiff's entire intellectual property portfolio.[42] In one landmark case presided over by Seventh Circuit Judge Richard Posner, sitting in the district court by designation, damages experts' reports were excluded when they were based on survey evidence that addressed consumers' valuation of a technological feature, but not the allegedly infringing aspect of that feature and failed to identify the lowest-cost alternatives to obtaining a license.[43]

Patent Law Experts

As noted earlier, patent law experts generally are limited to testifying about the practices, procedures and goings-on of the Patent Office. However, in some cases patent law experts have been permitted to branch out of that role. For example, patent law experts were permitted to testify about the written description requirement generally[44] or about infringement that was relevant to work the expert had done as an examiner at the PTO.[45] But of course, they may not go so far as to give bare legal conclusions or suggestions about how the case should be resolved,[46] or to testify about noninfringement or invalidity as a nontechnical expert.[47] Of course, under no circumstances are they allowed to usurp the role of the judge by telling the jury what the law is.[48]

Discovery of Experts

General Rules

As a general rule, no attorney-client privilege or work-product privilege exists between counsel and a testifying expert. That is because what you are seeking from the testifying expert, and what your expert seeks from you, is not legal advice; it is expert advice. This means that none of your conversations with your expert, draft reports, deposition or trial preparation materials, invoices, or other materials can be shielded from discovery based on privilege.

Prior to the amendments to Federal Rule of Civil Procedure 26 (FRCP 26) promulgated in 2010, discussed below, that created many difficulties in working with testifying experts and led to practices that undermined the effectiveness and quality of the expert's work. To avoid their discovery, attorneys often limited written communications with experts as much as possible and waited to draft reports until the expert's opinion was fully developed. This practice added needless but rational inefficiency to patent litigation.

To get around those difficulties, before the amendments parties typically agreed (formally or informally) to limit the extent of expert discovery concerning the preparation of expert reports or testimony. Those agreements usually captured drafts of reports, all communications between experts and counsel, experts' billing statements, and other related materials. As a result, lawyers and experts were able to discuss and prepare expert reports and testimony freely, if both sides were able to come to an agreement.

Amendments to FRCP 26

Starting December 1, 2010, the amendments to FRCP 26 established discovery protection of draft reports of and communications with testifying expert witnesses

in exchange for the enhanced disclosure requirements imposed by FRCP 26(a)(2)(B), which were discussed above in the discussion of testifying and nontestifying experts. Protection of the draft reports themselves was implemented in FRCP 26(b)(4)(B), and protection of communications between the party's attorney and any testifying witness—other than the expert's compensation, or facts, data, and assumptions in the report based on information provided by the party's attorney—was implemented in FRCP 26(b)(4)(C). Importantly, courts have been broadly applying these new rules to cases that were pending when the rules took effect,[49] though not universally.[50]

Conclusion

Expert witnesses are a critical tool in patent litigation. Selecting the right experts and having their support on and off the witness stand can determine the outcome of your case. Select your experts early, and consider their strengths and weaknesses carefully before hiring them. Think about what avenues of attack your adversaries will pursue if you choose one expert over another. When helping your experts write their reports, make sure to include every relevant argument and opinion to avoid having your expert's testimony stricken at trial. If you invest in your experts, they will be able to repay you.

1. Georgia-Pacific Corp. v. U.S. Plywood Corp., 318 F.Supp. 1116, 1121 (S.D.N.Y.1970), modified, 446 F.2d 295, 170 U.S.P.Q. 369 (2d Cir.), *cert. denied*, 404 U.S. 870, 92 S.Ct. 105, 30 L.Ed.2d 114 (1971).
2. Eli Lilly & Co. v. Actavis Elizabeth LLC, 676 F. Supp. 2d 352, 360 (D.N.J. 2009).
3. L'Oreal S.A. v. Revlon Consumer Prod. Corp., No. 98-424, 2008 WL 5868688, at *1 (D. Del. Sep. 30, 2008).
4. Trading Tech. Int'l, Inc. v. ESpeed, Inc., 595 F.3d 1340, 1360 (Fed. Cir. 2010).
5. Bausch & Lomb, Inc. v. Alcon Labs., Inc., 79 F. Supp. 2d 252, 255–256 (W.D.N.Y. 2000).
6. Sundance, Inc. v. Demonte Fabricating Ltd., 550 F.3d 1356, 1361 (Fed. Cir. 2008).
7. *See, e.g.*, Illinois Computer Research, LLC v. Harpo Prods., Inc., No. 08-C-7322 (N.D. Ill. June 7, 2010); Brigham & Women's Hospital v. Teva Pharms., No. 08-464 (D. Del. Sep. 21, 2010).
8. Fed. R. Civ. P. 26(a)(2)(B).
9. *See* Greenwood 950, LLC v. Chesapeake Louisiana, L.P., No. 10-cv-0419, 2011 WL 1234735, at *1 (W.D. La. Apr. 1, 2011).
10. *See* Oracle Am., Inc. v. Google Inc., No. C10-03561 (N.D. Cal. Nov. 15, 2011), available at *https://ecf.cand.uscourts.gov/doc1/035118707674* (permitting depositions of fact witnesses that damages expert interviewed and relied on in his report); Apple, Inc. v. Samsung Elecs. Co., No. 11-1846 (N.D. Cal. Oct. 29, 2012) (permitting deposition of experts who submit declarations concerning post-trial injunctive relief).
11. *E.g.*, James River Co. v. Rapid Funding, LLC, 658 F.3d 1207 (10th Cir. 2011); Innovatier, Inc. v. CardXX, Inc., No. 08-0273, 2011 WL 4536970, at *3 (D. Colo. Sep. 29, 2011).
12. Daubert v. Merrell Dow Pharms., 509 U.S. 579 (1993).
13. One common measuring stick for an expert's qualifications is the expert's previous experience as an expert witness. If your expert has never testified before, had no experience with patent licenses, and learned about patent damages by reading cases and the Poltorak treatise, that might not be enough to survive a *Daubert* challenge. These were the exact facts of Info-Hold, Inc. v. Muzak LLC, No. 1:11-cv-283 (S.D. Ohio Aug. 20, 2013) (disqualifying plaintiff's damages expert where he had "never testified as a damages expert in a patent case before, and indeed has never testified as an expert in a federal court case before. He has no prior experience with the Georgia-Pacific factors or with patent damages calculations at all, and no prior experience with patent licenses").
14. *Daubert*, 509 U.S. at 592.
15. Liquid Dynamics Corp. v. Vaughan Co., 449 F.3d 1209, 1220–1221 (Fed. Cir. 2006) (*citing Daubert*, 509 U.S. at 592).
16. Kumho Tire Co. v. Carmichael, 526 U.S. 137 (1999) (The trial court's gatekeeping obligation applies "not only to testimony based on 'scientific' knowledge, but also to testimony based on 'technical' and 'other specialized' knowledge.").
17. *Id.* at 152. This standard often is further relaxed in a bench trial. *E.g.*, David E. Watson, P.C. v. United States, 668 F.3d 1008 (8th Cir. 2012).
18. Experts may rely on the version of the facts proffered by the expert's party, even if the facts are disputed. *See* Micro Chem., Inc. v. Lextron, Inc., 317 F.3d 1387, 1394 (Fed. Cir. 2003); Net Airus Tech., LLC v. Apple, Inc., No. cv-10-3257 (C.D. Cal. Oct. 23, 2013).
19. *See, e.g.*, Hewlett Packard Co. v. EMC Corp., 330 F. Supp. 2d 1087, 1092–1093 (N.D. Cal. 2004) (*citing* Koch Ref. Co. v. Jennifer L. Boudreaux MV, 85 F.3d 1178, 1181 (5th Cir. 1996)).
20. *See, e.g.*, TiVo, Inc. v. Verizon Commc'ns Inc., No. 2:09-cv-257 (E.D. Tex. July 28, 2011). One case in which the district court excluded an expert for a conflict of interest was 3D Sys., Inc. v. Envisiontec, Inc., No. 05-74891, 2009 WL 1868728 (E.D. Mich. June 29, 2009), where the defendant's expert was a former director of research and development for the plaintiff for nearly 10 years and had worked on many confidential projects for the plaintiff, including the patent-in-suit. In another case, the plaintiff's expert previously had been retained by the defendant as a consulting expert in two cases. There, the court also disqualified the expert because it deemed too great the risk that the expert would use confidential information, even if inadvertently. Nike, Inc. v. Adidas Am. Inc., No. 9:06-CV-43, 2006 WL 5111106 (E.D. Tex. Sep. 29, 2006).
21. *E.g.*, Surfcast, Inc. v. Microsoft Corp., No. 2:12-cv-333 (D. Me. Sep. 30, 2013) (expert disqualified when he spent 23 minutes on the phone with plaintiff's counsel and signed confidentiality agreement); Broadcom Corp. v. Emulex Corp., No. 09-1058 (C.D. Cal. Apr. 5, 2010) (inventor-expert disqualified when expert signed confidentiality agreement with employer, the original patent owner); Lifewatch Servs. Inc. v. Braemer Inc., No. 09-C-6001, 2010 WL 3909483 (N.D. Ill. Sep. 28, 2010) (defendant's expert was former employee of plaintiff for nine years and had gained confidential information); Oracle Corp. v. Druglogic, Inc., No. C-11-00910, 2012 WL 2244305 (N.D. Cal. June 15, 2012) (plaintiff's expert was consultant for defendant's subsidiary for six years and had signed two confidentiality agreements and a non-disparagement agreement).
22. *See, e.g.*, Northbrook Digital LLC v. Vendio Servs., Inc., No. 07–2250, 2009 WL 5908005 (D. Minn. Aug. 26, 2009) (defendant's expert not disqualified when expert only had a single consultation before case commenced); Butamax Advanced Biofuels v. Gevo, Inc., No. 11–54–SLR, 2012 WL 4815593 (D. Del. Oct. 10, 2012) (defendant's expert not disqualified when, although expert had signed confidentiality agreement with plaintiff's counsel in connection with possible engagement in the case, no actual confidential information was exchanged, the conversation was brief and not substantive, and no fees were paid).
23. *See, e.g.*, Innogenetics, N.V. v. Abbott Labs., 512 F.3d 1363 (Fed. Cir. 2008).
24. Frey v. Accessory Brands, Inc., No. 11-60486-CIV (S.D. Fla. May 31, 2012).
25. Saffran, M.D., Ph.D. v. Johnson & Johnson, No. 2:07–CV–451, 2011 WL 197871 (E.D. Tex. Jan. 20, 2011).
26. *See* Northmobiletech LLC v. Simon Prop. Grp., Inc., No. 11-cv-287 (W.D. Wisc. July 9, 2012).
27. *See, e.g.*, MEMC Elec. Materials, Inc. v. Mistubishi Materials Silicon Corp., 248 Fed. App'x 199 (Fed. Cir. 2007), *cert. denied*, 128 S. Ct. 1485 (2008).
28. *See, e.g.*, Rembrandt Vision Techs., L.P. v. Johnson & Johnson Vision Care, Inc., No. 3:11-cv-819 (M.D. Fla. June 4, 2012).
29. Oracle Am., Inc. v. Google, Inc., No. C10-03561 (N.D. Cal. Oct. 11, 2011) (expert report stricken when it relied on untimely disclosed prior art); Extreme Networks, Inc. v. Enterasys Networks, Inc., No. 07-cv-229 (W.D. Wis. Sep. 7, 2011).
30. I4i Ltd. V. Microsoft Corp., 598 F.3d 831, 856 (Fed. Cir. 2010).
31. Function Media, LLC v. Google, Inc., No. 2:07-CV-279-CE, 2010 WL 272409, at *3 (E.D. Tex. Jan. 15, 2010).
32. In re Gabapentin Patent Litig., No. 00–2931, 2011 WL 1807448 (D.N.J. May 12, 2011).
33. LecTec Corp. v. Chattem Inc., No. 5-08-cv-00130 (E.D. Tex. July 28, 2009) ("[The expert] has simply concluded that in analyzing the Georgia-Pacific factors and other relevant evidence, [two different defendants] are so similarly situated with respect to Plaintiff, and the relevant facts remained so consistent between the hypothetical negotiations with each of them, that the same reasonable royalty rate applies to both.").
34. Resqnet.com, Inv. v. Lansa, Inc., 594 F.3d 860 (Fed. Cir. 2010).
35. Lucent Techs., Inc. v. Gateway, Inc., 580 F.3d 1301, 1338 (Fed. Cir. 2009).
36. Uniloc USA, Inc. v. Microsoft Corp., 632 F.3d 1292, 1315 (Fed. Cir. 2011).
37. Oracle Am., Inc. v. Google, Inc., 798 F. Supp. 2d 1111, 1120 (N.D. Cal. July 22, 2011). The Nash solution is a hypothetical mode that, according to the

court, "would invite a miscarriage of justice by clothing a 50 percent assumption in an impenetrable façade of mathematics." *Id.*

38. Aeritas, LLC v. United Alaska Air Grp., Inc., No. 1:11-cv-967 (D. Del. Oct. 25, 2013).
39. Suffolk Techs. LLC v. AOL, Inc., No. 1:12-cv-00625 (E.D. Va. Apr. 12, 2013).
40. WesternGeco LLC v. ION Geophysical Corp., No. 4-09-cv-01827 (S.D. Tex. July 16, 2012).
41. AVM Techs., LLC v. Intel Corp., No. 1:10-cv-00610 (D. Del. Feb. 21, 2013).
42. Oracle Am., Inc. v. Google Inc., No. 10–03561, 2012 WL 4017808 (N.D. Cal. Apr. 10, 2012).
43. Apple, Inc. v. Motorola, Inc., No. 1:11-cv-08540 (N.D. Ill. May 22, 2012) (Posner, J., sitting by designation). This opinion is on appeal to the Federal Circuit and reports from the oral arguments suggest the opinions are likely to be modified or reversed.
44. Trading Techs. Int'l, Inc. v. ESpeed, Inc., 595 F.3d 1340, 1360 (Fed. Cir. 2010).
45. SEB S.A. v. Montgomery Ward & Co., 594 F.3d 1360, 1373 (Fed. Cir. 2010).
46. *E.g.*, Pfizer Inc. v. Teva Pharms. USA, Inc., No. 04-754, 2006 WL 3041097, at *2–3 (D.N.J. Oct. 26, 2006).
47. *E.g.*, Asphalt Prods. Co. v. Pelican Ref. Co., No. H–09–1145, 2012 WL 1936416 (S.D. Tex. May 29, 2012).
48. *See, e.g.*, Safco Prods. Co. v. Welcom Prods., 799 F. Supp. 2d 967, 998, 2011 U.S. Dist. LEXIS 71941 (D. Minn. 2011).
49. *See, e.g.*, Republic of Ecuador v. Bjorkman, No. 11–cv–01470–WYD–MEH, 2012 WL 12755 (D. Colo. Jan. 4, 2012); In re Application of Republic of Ecuador, 280 F.R.D. 506 (N.D. Cal. 2012); Daugherty v. Am. Exp. Co., No. 3:08–CV–48, 2011 WL 1106744 (W.D. Ky. Mar. 23, 2011); Graco, Inc., v. PMC Global Inc., No. 08–1304, 2011 WL 666056 (D.N.J. Feb. 14, 2011); Civix-DDI, LLC v. Metro. Reg'l Info. Sys., Inc., 273 F.R.D. 651 (E.D. Va. 2011); Dongguk Univ. v. Yale Univ., No. 3:08–CV–00441, 2011 WL 1935865 (D. Conn. May 19, 2011); United States v. Sierra Pac. Indus., No. S–09–2445, 2011 WL 2119078 (E.D. Cal. May 26, 2011).
50. *See, e.g.*, Rafferty v. Erhard, No. 09CV1019, 2012 WL 2577473 (W.D.N.Y. July 3, 2012); Echevarria v. Caribbean Aviation Maint. Corp., No. 09–2034, 2012 WL 118485 (D.P.R. Jan. 13, 2012); Watkins v. Action Care Ambulance, Inc., No. 07–cv–02598, 2011 WL 4017986 (D. Colo. Sep. 9, 2011).