Practical Strategies for Obtaining Expert Evidence in Intellectual Property Proceedings

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Abstract

As intellectual property law develops through changes to legislation and continued litigation through the courts, and changes to Court Rules and Practice Notes occur, the ways in which experts are instructed and evidence is obtained from them has also needed to change and evolve. What may have been a tried and tested approach to obtaining expert evidence 10 to 15 years ago is no longer appropriate or the best technique. Legal practitioners and patent and trade mark attorneys need to be cognisant of this so that they can continue to develop their own practical strategies for selecting, engaging and obtaining expert evidence in an admissible form for use in court proceedings.

Introduction

Selecting an expert witness in intellectual property litigation in Australia is a critical and nuanced process. The expertise and evidence of the selected expert can significantly influence the outcome of the case. There is little doubt, if any, that this is even more so the case for patent litigation.

This article provides some practical strategies and explores the key factors involved in selecting an expert witness in intellectual property litigation, including:

- The expert's:
  - academic background;
  - previous experience as an expert witness;
  - experience as a person skilled in the art ("PSA") for patent litigation;
  - objectivity;
  - adherence to the *Federal Court Rules 2011* (Cth) *("Federal Court Rules");*
- the potential pitfalls of selecting a career expert witness; and
- how to get the most out of joint expert conclaves.

Understanding the utilisation of experts according to the Federal Court Rules

This article focuses on the Federal Court Rules as most intellectual property litigation is commenced in the Federal Court of Australia. Having said that, it should still be noted that some State courts do hear intellectual property disputes from time to time.

Adherence to the Federal Court Rules is an essential requirement for expert witnesses in Australia. The Federal Court has specific guidelines and rules governing the use of expert evidence, designed to ensure the reliability and admissibility of expert evidence.

It is trite to say that the Federal Court Rules include provisions specifically related to expert evidence. However, compliance with these Rules is critical. An expert who fails to adhere to the Federal Court Rules and Practice Notes risks having their evidence excluded or given less weight. Therefore, familiarity with the Federal Court Rules and Practice Notes and a demonstrated ability to comply with them is a key criterion when engaging an expert witness.

Some of the key Federal Court Rules and relevant Practice Notes include:

Rule 23.01: This Rule provides for a party applying to the Court to have a Court expert appointed. While this is not common in intellectual property proceedings, it remains an option for parties.

Rule 23.03: This Rule provides for the opportunity for a party applying to cross-examine the Court expert before or at trial.

The more often utilised Rule is Rule 23.11, which provides for a party calling their own expert witness. It also prescribes that the expert's report must be given to the parties to the proceeding if a party is to rely on expert evidence at trial.

Pursuant to Rule 23.12, the expert must be given a copy of the Federal Court *Expert Evidence Practice Note* (GPN-EXPT) and prepare a report that is in accordance with that Practice Note. Copies of any Federal Court Practice Notes may be obtained from the District Registry or downloaded from the Court's website <http://www.fedcourt.gov.au>. The GPN-EXPT Practice Note is discussed in more detail below.

Rule 23.13 sets out the report requirements. That is, it provides that an expert report must:

- be signed by the expert who prepared the report;

- contain an acknowledgement at the beginning of the report that the expert has read, understood and complied with the Practice Note;
- contains particulars of the training, study or experience by which the expert has acquired specialist knowledge;
- identify the questions that the expert was asked to address;
- set out separately from the factual findings or assumptions, each of the expert's opinions;
- set out the reasons for each of the expert's opinions;
- contain an acknowledgement that the expert's opinions are based wholly or substantially on the specialised knowledge identified by the expert; and
- comply with the GPN-EXPT Practice Note.

The expert's evidence must also be admissible for the purposes of the *Evidence Act* 1995 (Cth).

Given that the expert must have specialised knowledge based on their training, study or experience, and their opinion given must be wholly or substantially based on that knowledge, points of contention can arise at this point in intellectual property litigation in relation to admissibility or the weight given to the evidence. This is discussed later in this article.

The GPN-EXPT Practice Note identifies for the expert witness that their duty is to assist the Court and that this duty overrides any obligation to the party engaging the expert. It emphasises the importance of providing an independent and unbiased opinion. The Practice Note provides detailed guidance on the conduct of expert witnesses, including the preparation of expert reports and the giving of evidence in Court. It stresses the need for clarity, transparency, and thoroughness in the expert's work.

Experts are not "hired guns" and you should be cautious not to have inappropriate communications when instructing an independent witness.[2]

It is also important to note there is no principle of law or practice, nor is there anything in the Practice Note that obliges a party to embark on the costly task of engaging a "consulting expert" (or sometimes called a "dirty expert") to avoid "contamination" of the expert who will give evidence.[3]

Experts have a duty to the Court to give relevant and impartial evidence.[4]

If it is possible, parties are to discuss whether they have a conference of expert witnesses and whether a joint report is desirable.[5] Unless the Court orders otherwise, the parties' lawyers will not attend the conference, but will be provided with a copy of any conference report.[6]

Rule 23.15 sets out orders that a party can apply to Court for in relation to the expert. These include:

- that the experts confer, either before or after writing an expert report;
- that the experts produce to the Court a document identifying whether the expert opinions agree or differ;
- that the expert's evidence in chief be limited in content to the expert's expert report; and
- that all the factual evidence relevant to expert's opinions be produced before the expert is called to give evidence.

Rule 5.04 sets out the directions that the Court can make pre-trial regarding experts, including the number of experts to be called, and the parties jointly instructing an expert to provide a report in relation to a particular issue.

The GPN-EXPT Practice Note must be read in conjunction with the Federal Court *Central Practice Note* (CPN-1), the *Federal Court of Australia Act* 1976 (Cth), the Evidence Act, Part 23 of the Federal Court Rules and, where applicable, the Federal Court *Survey Evidence Practice Note* (GPN-SURV).

Part 11 of the CPN-1 Practice Note sets out considerations to be had when using and preparing evidence and witnesses, including the use of:

- statements of agreed and disputed facts;
- joint reports and concurrent expert evidence; and
- organisation of evidence, where appropriate, into discrete components (e.g. preliminary issues, splitting liability and quantum, etc).

The GPN-SURV Practice Note may be relevant for litigation concerning claims for trade mark infringement or the tort of passing off.

It sets out guidelines for survey reports,[7] common pitfalls of survey evidence,[8] and case management principles for survey evidence.[9] This is relevant to trade mark and passing off cases which tend to use surveys that assess brand recognition and reputation as evidence.

There are guidelines for the reports which include:

- the purpose of the survey;
- a definition of the target population;
- a description of the sample population;
- a description of the sample design;
- a copy of the survey instrument;
- calculations and estimates of sampling error;
- clearly labelled statistical tables;
- a copy of the interview and instructions;
- coding and related instructions;
- quality control measures; and

- details of unforeseen problems encountered in the course of survey work that it must be reasonable to expect might impact the quality or reliability of the data or results.

Best practices for identifying, selecting and engaging with experts

Academic background and industry expertise

A strong academic background is often, but not always, important when selecting an expert witness for certain intellectual property litigation, particularly for matters involving patents. The academic qualifications of the expert can establish the foundational credibility and authority needed to provide reliable evidence. In certain cases it may be essential to select an expert with a strong educational background relevant to the specific field of the patent in question.

Experts with advanced degrees, such as a Ph.D. in a relevant discipline, are sometimes valuable. For instance, in a patent case involving pharmaceuticals, an expert with a Ph.D. in pharmacology may possess the necessary depth of knowledge to understand and explain complex scientific concepts. Their academic achievements can provide some comfort to the Court regarding their expertise.

In other cases, an undergraduate degree or no degree at all may be all that is required, provided that the expert has direct and relevant experience to the relevant industry and issue in question. The level of industry experience of an expert can add to the weight the Court attaches to the expert's evidence.

In *Boehringer Ingelheim Animal Health USA Inc v Elanco New Zealand,*[10] Professor Wainwright not only had an undergraduate degree and a Ph.D., but he also had more than 30 years' experience in anti-microbial chemotherapy and had written in excess of 120 papers in the field, and therefore had "developed specialised knowledge in that field".

In this respect, an expert's publication record in peer-reviewed journals is an important indicator of their active engagement with the field and recognition by their peers. Publications in reputable journals reflect the expert's ongoing contribution to their area of expertise and can lend weight to their evidence. When evaluating potential experts, it is beneficial to consider the impact and relevance of their published research.

Objectivity

Objectivity is the foundation of an expert witness' role in patent litigation. The expert must provide an unbiased, independent opinion based on their knowledge and experience. Their primary duty is to the Court, not to the party that has engaged them. Ensuring that the expert maintains objectivity throughout the case is vital to ensure the credibility of their evidence and to meet the requirements set out in the GPN-EXPT Practice Note.

To assess an expert's objectivity, it is important to consider their track record and reputation. Experts who have demonstrated impartiality and integrity in their previous engagements are more likely to provide reliable evidence. Reviewing prior judgments in which an expert is mentioned can help to identify any patterns of bias or partiality.

An expert should be willing to acknowledge the strengths and weaknesses of their opinions. An expert who is transparent about the limitations of their analysis and who provides balanced, reasoned arguments is likely to be perceived as more credible by the Court. Their ability to remain detached from the outcomes and to focus solely on the technical and factual aspects of the case is crucial.

Preparation of expert reports

The preparation of expert reports is a crucial aspect of the expert witness' role. These reports must be comprehensive, well-structured, and clearly written to ensure that they are easily understood by the Court. The expert must explain their methodology, the evidence they considered, and the rationale behind their opinions.

A well-prepared expert report should include all of those elements set out in Rule 23.13(1) of the Federal Court Rules as identified above.

Ensuring that the expert is capable of preparing reports that meet these standards is essential. Their ability to communicate complex technical information in a clear and accessible manner can significantly impact the effectiveness of their evidence.

It used to be the case that experts prepared their reports with a letter of instruction being provided to them. The better practical approach, it would appear, is to do so in affidavit evidence with the expert recounting the instructions provided in the same affidavit in which the opinion evidence is contained.

Previous experience as an expert witness

Previous experience as an expert witness can be a critical consideration in the expert selection process. An expert who has served in similar cases brings valuable input and a practical understanding of the litigation process. This experience enhances their ability to present complex technical information in a manner that is comprehensible to the Court.

When assessing an expert's prior experience, it is important to consider the types of cases they have worked on, the outcomes of those cases, their performance under cross-examination and the Court's findings about the expert and the reliability of their evidence. An expert with a proven track

record of giving effective evidence in high-profile patent cases is likely to be more adept at navigating the challenges of litigation.

Experience as an expert witness also includes familiarity with legal procedures and the ability to collaborate effectively with legal teams. Experts who have successfully prepared reports, and have given evidence in court, understand the importance of adhering to court protocols and deadlines. Their prior experience can significantly contribute to the overall strategy and success of the case.

However, there is a limitation on this if the expert is a "career expert" as discussed below.

Career experts: benefits and disadvantages

When selecting an expert witness, it is important to be cognisant of the concept of a career expert. A career expert is an individual who has made a profession out of providing expert evidence across numerous cases, often spanning various fields. The reason for that is that they are usually very good and can be easy to work with for the legal representatives.

Benefits of career experts

There are further practical benefits for using career experts as identified below.

Career experts often have extensive experience in providing oral evidence in court, which can make them skilled at handling cross-examination, joint expert conclaves and understanding courtroom procedures.

Their repeated involvement in litigation can result in polished and professional presentation skills, making their evidence clear and persuasive.

Disadvantages of career experts

Courts and opposing lawyers are more likely to perceive career experts as less credible due to their frequent participation in litigation. There is a risk that their evidence could be seen as biased, motivated by financial incentives or less likely to be considered relevant to the industry in question (discussed later in this article).

Career experts may have limited ongoing practical experience in the field they testify about, as their primary focus is on providing expert evidence, rather than working within the industry. This is particularly the case for a career expert that has essentially retired from day-to-day work within the industry to have a second career as an expert witness.

Patent cases - Experience as a PSA

In patent litigation, in relation to issues of construction of the claims of a patent and also when the validity of the patent is in question and inventive step is being considered, it is essential to select an expert who qualifies as the notional PSA. This term refers to a non-inventive individual (a person who does not look for solutions within an art remote from the problem that the claimed invention is directed to solving) with ordinary skill and knowledge in the relevant field of technology at the time of the patent's priority date. The expert's role as the PSA is to provide insight into what was commonly known and practised within that field at the specific time. Entire articles and judges' addresses have been devoted to this issue, so this article can only really provide a broad overview.[11]

An expert's experience as a PSA involves practical, hands-on experience in the relevant industry. This practical knowledge allows the expert to contextualise the patent within real-world applications and practices. For example, in a case involving software engineering, an expert with extensive experience in developing software systems may be highly valuable.

The expert's familiarity with the state of the art at the time the patent was filed is crucial. The expert should be able to explain what was known, what was obvious, and what advancements the patent purportedly introduced. This requires a deep understanding of the technological landscape, including any prior art that could affect the patent's validity.

In *Britax Childcare Pty Ltd v Infa-Secure Pty Ltd,*[12] the Court held that the skilled addressee required an understanding or experience of the installation and operation of child seats and their tethering systems as at the priority dates. The Court also noted that the skilled addressee did not need to have expertise specifically in the child restraint industry if his or her expertise and experience was sufficient to give reliable evidence on the state of the common general knowledge of a skilled addressee in the relevant art as at the priority dates.[13]

Again in that case, the Court noted that if Britax's expert in that case, Mr Hunter, "is not the appropriate skilled addressee then his evidence would be irrelevant, even if the evidence otherwise conforms with section 79 of the Evidence Act".[14]

Apart from contending that Mr Hunter lacked the necessary expertise and experience, Infa also contended that "Mr Hunter's evidence should be rejected because he is impermissibly 'inventive', and thereby disqualified as irrelevant 'person still in the art'".[15] However, the Court ultimately held that highly qualified experts, even if they have capacity for original research, should not on that basis be disqualified from assisting the Court.[16]

In *Firebelt v Brambles Australia,*[17] the High Court of Australia noted that Dowsett J at first instance had made the observation about Brambles' expert, Mr Ahrens, as follows:

> *It is true that Mr Ahrens considers himself to be an inventor, but that of itself cannot disqualify him from giving evidence as to obviousness. To describe oneself as an inventor is merely to say something about one's capacity to identify and solve a problem. The line between a competent technician, able*

> *to solve problems on the basis of an established state of knowledge in his or her industry and an inventor will not always be easily discerned. For the person who is an inventor may well also perform non-inventive work.*

Further, as the Full Court of the Federal Court stated in *Jupiters v Neurizon:*[18]

> *… Section 7(2) of the Act refers to the hypothetical person 'skilled in the relevant art in the light of the common general knowledge which is existent in the patent area before the priority date of the relevant claim'. That person is wholly hypothetical. Much evidence is admissible from persons none of whom would precisely answer the statutory description … the usual problem in cases of this sort is the over-qualified expert.*

In Merck Sharp & Dohme Corporation & Anor v Wyeth,[19] the Court emphasised that the expert must have practical knowledge in the field at the time of the priority date and that talking to others who are experts at the time and being an expert in a related field is not convincing as an expert who was practically involved at the time. That case can also be relied on to support the proposition that an expert can speak to sub-aspects of 'the field' if they are specialised in related fields. In this regard, Justice Burley noted:[20]

> *There is force in the submissions advanced by MSD, although they go too far in submitting that Professor Dalby's evidence should be given no weight. His evidence is useful in considering the appropriate construction of the specification in the claims, and the grounds of invalidity advanced. Plainly his knowledge and experience qualify him to give such evidence. When it comes to consideration of the ground of lack of inventive step, his lack of experience as a vaccine formulator causes me to place greater emphasis on the evidence of Professor Petrovsky.*

The importance of selecting appropriately skilled expert witnesses for patent infringement cases was highlighted in the recent decision of *Calix Limited v Grenof Pty Ltd & Aquadex Pty Ltd.*[21] In that case, Grenof argued that Calix's expert was not a PSA and that his evidence, if admitted, should be given low weight, if any. Additionally, to the extent that any evidence given by the parties' respective expert witnesses differed, Grenof's expert's evidence should be preferred.

Justice Nicholas generally preferred the evidence of Grenof's expert witness (particularly in any areas where there was a material disagreement between the experts' evidence).[22]

The Court regarded the evidence of Calix's expert to be "contradictory and unreliable"[23] and was also not persuaded that Calix's expert was

> *… a person with a practical interest in the subject matter of the Patent or that his prior training or experience qualifies him to give relevant evidence as to the common general knowledge or state of the relevant art at the priority date.[24]*

Once the PSA has been located and retained, questions arise as to how to engage with them and instruct them correctly. In this respect, in relation to the issue of obviousness, it was noted in one case that "to give the patent to a prospective witness is tantamount to leading the witness".[25]

This statement has been applied in many subsequent cases, including as recently as 2024 in *MSA 4x4 Accessories v Clearview Towing Mirrors.*[26]

The real issue is avoiding the effect of hindsight when considering the issue of the obviousness. It is a real problem, and one which Justice Jagot has previously written an article about.[27] In that article, her Honour suggests implementing:

- the development of a comprehensive standard set of detailed instructions to experts about the PSA, the common general knowledge, the test of obviousness, what hindsight involves, why hindsight reading is impermissible, and the consequential need to avoid hindsight; and
- early case management to facilitate agreement between the parties or determination of the factual information which may be provided to the experts and the questions the experts should be asked.[28]

A problem with this occurs with what can be seen, anecdotally, with courts placing greater pressure on legal teams to limit their reliance on experts to one. If only one expert witness is used in a patent infringement case, in order to construe the claims of the patent and then consider the issue of infringement, the expert needs to see the patent and the infringing product. However, that same expert witness cannot then, based on the cases, provide evidence on the issue of obviousness, as they will have had the benefit of hindsight. Legal teams will need to make submissions to the Court on this issue if the Court insists on one expert witness per party.

Trade Mark/misleading or deceptive conduct/passing off cases

It is often the case that parties that allege trade mark infringement, also allege misleading or deceptive conduct in contravention of the *Australian Consumer Law*[29] (previously under the *Trade Practices Act* 1974 (Cth) ("TPA")) and the tort of passing off.

In Cadbury Schweppes Pty Ltd v Darrell Lea Chocolate Shops Pty Ltd (No 8),[30] Cadbury brought a claim against Darrell Lea Chocolates for using the colour purple in connection with chocolate. Cadbury claimed that Darrell Lea had engaged in misleading or deceptive conduct and also passed off its products as those of Cadbury. The primary judge held that the expert opinion provided by Cadbury's experts were inadmissible[31] and, upon appeal, the Full Court decided that the primary judge had erred in the course of making that evidence ruling and allowed the evidence.[32]

At the final hearing, the trial judge re-heard the case and found in favour of Darrell Lea.

Cadbury relied upon three experts to provide evidence in support of its case. It relied on experts with academic qualifications and a managing director in a design consultancy firm.

The Court ruled that, in relation to all three experts, it was not persuaded that Darrell Lea, by using the colour purple, had passed off business or products as those of Cadbury or had contravened the TPA.

The Court agreed with Darrell Lea's submissions that the experts' "lack of practical experience in retail confectionary market is consistent with Cadbury's case as a whole".[33]

In *Sydneywide Distributors v Red Bull Australia,*[34] the first appellant, Sydneywide, was the importer of non-alcoholic drinks, and the second appellant, Mr Klimis, was the managing director of Sydneywide, who imported and sold an energy drink called "Livewire", which Red Bull asserted contravened ss.52 and 53 of the TPA and constituted passing off. The appeal court upheld the trial judge's decision in favour of Red Bull and noted that experts called by both parties were qualified in the field of marketing.[35]

The Court's decision effectively gave an indication that Red Bull's comprehensive expert evidence came to grips with the marketing issues more effectively than Sydneywide's evidence and assisted in finding that Sydneywide's conduct was in breach of s.52 of the TPA and constituted passing off.[36]

In *Optical 88 Limited v Optical 88 Pty Limited,*[37] the Federal Court was required to deal with survey evidence conducted by Optical 88 Limited. It is authority for the proposition that if a survey is conducted, it needs to present the responses accurately and ask questions to help determine the extent to which the survey population of interest was misled or deceived.

Optical 88 Limited engaged Dr Bednall, an Associate Professor of the School of Management and Marketing at Deacon University, to conduct a survey of individuals in two groups of shopping centres in Sydney, who were resident in Sydney and born in Hong Kong, Macau, Singapore or Thailand. The first group of shopping centres all contained Optical 88 Pty Limited's stores and the second group comprised shopping locations where Optical 88 Pty Limited did not conduct business. The survey was designed such that there would be 180 interviewees in each group with a minimum of 30 in each location.

Optical 88 Pty Limited relied on expert evidence from an experienced market researcher, Mr McCallum, who criticised Dr Bednall's presentation of the responses.

The Court found that the survey by Dr Bednall did not measure the extent to which the population of interest was misled or deceived by Optical 88 Pty Limited. It also found that approximately 41 per cent of the interviewees had come to live in Australia in or before 1993 and would have been aged eight years or less at the time the respondent had obtained a trade mark. Due to these reasons, the Court supported the opinion of McCallum that the data provided by Dr Bednall was inaccurate.[38]

In *Apple Inc v Registrar of Trade Marks,*[39] use of survey evidence and linguistic expert evidence in a trade mark dispute was discussed. The relevant take away from that case is that evidence of linguistic experts is not necessarily convincing. Judges prefer to construe the meaning of phrases at a more basic level in trade mark disputes and use their own skills of deduction.

Similarly, survey evidence will not necessarily be more convincing than other forms of evidence. In this case, the survey evidence was being used to show a relationship between the term "App store" and the company Apple. However, evidence that showed that the term "App" and "App store" was being used before Apple commenced using its mark, was much more convincing.[40]

Design cases

Although the Court must decide questions of infringement in design cases, the use of experts can be illustrative in more complex design cases.[41] There a few cases that provide helpful comments on the use of experts, but *Dalgety Australia Operations Ltd v Seeley Nominees Pty Ltd*[42] highlighted the need to find an expert who has academic qualifications and greater experience in industrial design.

In *Multisteps Pty Limited v Source and Sell Pty Limited,*[43] in relation to the use of experts, the Court (per Justice Yates) noted:

> *I found this process, and the debate that it generated, to be of some help. It has assisted my consideration of the comparison the Court is required to undertake under section 19 of the Designs Act. Having been so assisted, I have proceeded on the basis of my own evaluation of the visual significance of similarities in differences, not that of the experts.*[44]

However, in considering a challenge to one expert's evidence for looking at differences between designs instead of looking at similarities, the Court held that this expert's evidence showed a "clear inclination to favour individual design differences rather than to consider the overall impression created by the registered designs and the design of each accused container".[45]

Copyright cases

Expert evidence is common enough in copyright cases across the different types of "works". Such evidence is discussed in a

paper delivered by Justice Rares (as he then was) at the 14th Biennial Copyright Law and Practice Symposium (hosted by the Australian Copyright Council and the Copyright Society of Australia) at Sydney in October 2009.[46]

A common area where expert evidence is used in copyright cases relates to artistic works being house design or architectural plans. In *Barrett Property Group v Dennis Family Homes,*[47] an expert, Mr Miller, gave evidence particularly in relation to design trends, which the Court found were not based on or illustrated by reference to claims of which he was independently aware, but depended on selling the plans provided to him by Dennis' solicitors. The Court relevantly found that, "Mr Miller gave no evidence of independent research or of an independent library of relevant material to support his opinions".[48]

Use of joint experts and how to get the most out of conclaves and expert reports

The Federal Court's Concurrent Expert Evidence Guidelines (Annexure B to the GPN-EXPT Practice Note) are intended to inform parties, practitioners and experts of the Court's general approach to concurrent expert evidence, the circumstances in which the Court might consider ordering expert witnesses to give evidence concurrently, and if so, the procedures by which the evidence may be taken.

In many cases, the use of concurrent expert evidence is a technique that can reduce the partisan or confrontational nature of conventional hearing processes and minimises the risk that experts become "opposing experts" rather than independent experts assisting the Court.

The technique may also allow the experts to more effectively focus on critical points of disagreement between them, identify or resolve those issues more quickly and narrow the issues in dispute.

It is essential that such process has the full cooperation and support of the individuals involved, including the experts and counsel involved in the questioning process.

Prior to the hearing at which expert evidence may be given concurrently, parties and their lawyers should confer and give general consideration as to:

- the agenda;
- the order and manner in which questions will be asked; and
- whether cross-examination will take place within the context of the concurrent evidence or after its conclusion.

At the hearing itself, the way in which concurrent expert evidence is taken must be applied flexibly and having regard to the characteristics of the case and the nature of the evidence to be given.

In 2010, Justice Rares (as he then was) wrote an excellent article on joint expert evidence.[49] It remains relevant, particularly given the continued use of joint expert conclaves in intellectual property cases heard in the Federal Court. The following extract from the article's conclusion is particularly helpful:

> *Because the experts have conferred and produced joint reports before going into the "hot tub", the field of dispute is generally narrowed. Not all cases will suit the process. It may be that in patent cases, where the whole case revolves around conflicts within fields of expertise, concurrent evidence is not likely to assist a judge. Heerey J's expedient of an assessor may prove a better alternative. But concurrent evidence allows advocates to focus on the critical differences, with the assistance of their respective experts in the box, and, at the same time to hammer home the strengths of their own, and the inadequacies in the other, expert's reasoning processes. In the end, concurrent evidence is generally likely to produce more ounces of merit which will be worth more to a judge than pounds of charisma or demeanour.*[50]

Conclusion

Selecting an expert witness in intellectual property litigation in Australia involves a thorough evaluation of their academic background, previous industry experience and experience as an expert witness and experience as a PSA (for patent cases), objectivity, and adherence to Federal Court Rules and Practice Notes. Additionally, it is crucial to consider the potential benefits and disadvantages of selecting a career expert witness.

An expert with a strong academic background and relevant qualifications can assist in establishing a solid foundation for their expertise. Their previous experience as an expert witness provides valuable input into the litigation process and enhances their ability to present and defend their opinions effectively. However, career expert witnesses run a real risk of not having their report admitted into evidence or carrying less weight. Experience as a PSA ensures that the expert can understand the patent within the relevant technological field, providing a practical perspective on the issues at hand.

Objectivity is obviously highly important, as the expert's primary duty is to the Court, not to the party engaging them. Ensuring that the expert maintains impartiality and integrity throughout the case is critical for the credibility of their evidence. Adherence to Federal Court Rules and Practice Notes, including the preparation of comprehensive and well-structured expert reports or affidavit evidence, ensures that the expert's evidence is reliable and admissible.

By carefully considering these factors, legal teams can select expert witnesses who are not only highly qualified and experienced, but also capable of providing independent, credible and admissible evidence that can impact the outcome of intellectual property litigation cases.

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2 Federal Court of Australia, *Expert Evidence Practice Note*, 25 October 2016, [3.1] and [3.2].

3 Federal Court of Australia, *Expert Evidence Practice Note*, 25 October 2016, [3.2].

4 Federal Court of Australia, *Expert Evidence Practice Note*, 25 October 2016, [4.1].

5 Federal Court of Australia, *Expert Evidence Practice Note*, 25 October 2016, [7.3].

6 Federal Court of Australia, *Expert Evidence Practice Note*, 25 October 2016, [7.4].

7 Federal Court of Australia, *Survey Evidence Practice Note*, 25 October 2016, [5.1].

8 Federal Court of Australia, *Survey Evidence Practice Note*, 25 October 2016, [4.2].

9 Federal Court of Australia, *Survey Evidence Practice Note*, 25 October 2016, [3.1]–[3.4].

10 *Boehringer Ingelheim Animal Health USA Inc v Elanco New Zealand* (2021) 164 IPR 17, [169].

11 See, for example: a presentation by the Honourable Justice Jagot at the 2022 IPSANZ Conference which was subsequently published as an article: Justice Jayne Jagot, 'Some Evidentiary Issues in Patent Law' (2022) 130 *Intellectual Property Forum* 9; Milena Dryza, 'Not So Ordinary: Who is the "Person Skilled in the Art?"' 131 (March 2023) *Intellectual Property Forum* 51.

12 *Britax Childcare Pty Ltd v Infa-Secure Pty Ltd* (No 4) (2015) 113 IPR 280.

13 *Britax Childcare Pty Ltd v Infa-Secure Pty Ltd* (No 4) (2015) 113 IPR 280, 311 [217].

14 *Britax Childcare Pty Ltd v Infa-Secure Pty Ltd* (No 4) (2015) 113 IPR 280, 311 [214].

15 *Britax Childcare Pty Ltd v Infa-Secure Pty Ltd* (No 4) (2015) 113 IPR 280, 312 [222].

16 *Britax Childcare Pty Ltd v Infa-Secure Pty Ltd* (No 4) (2015) 113 IPR 280, 314 [228].

17 (2002) 188 ALR 280, 291 [44].

18 (2005) 222 ALR 155, 187 [154].

19 *(No 3)* (2020) 155 IPR 1, 138 [660]–[666].

20 *Merck Sharp & Dohme Corporation & Anor v Wyeth (No 3)* (2020) 155 IPR 1, 138 [660]–[666].

21 (2023) 171 IPR 582.

22 (2023) 171 IPR 582, 603 [89].

23 (2023) 171 IPR 582, 593 [47].

24 (2023) 171 IPR 582, 593 [46].

25 *Minnesota Mining & Manufacturing Company v Tyco Electronics Pty Ltd* (2002) 56 IPR 248, 258 [45].

26 [2024] FCA 24.

27 Justice Jayne Jagot, 'Some Evidentiary Issues in Patent Law' (2022) 130 *Intellectual Property Forum* 9.

28 Justice Jayne Jagot, 'Some Evidentiary Issues in Patent Law' (2022) 130 *Intellectual Property Forum* 9, 13.

29 Schedule 2 to the *Competition and Consumer Act* 2010 (Cth).

30 (2008) 75 IPR 557.

31 *Cadbury Schweppes Pty Ltd v Darrell Lea Chocolate Shops Pty Ltd* (2007) 159 FCR 397, 399 [3].

32 *Cadbury Schweppes Pty Ltd v Darrell Lea Chocolate Shops Pty Ltd* (2007) 159 FCR 397, 423 [128].

33 *Cadbury Schweppes Pty Ltd v Darrell Lea Chocolate Shops Pty Ltd (No 8)* (2008) 75 IPR 557.

34 *Sydneywide Distributors Pty Ltd v Red Bull Australia Pty Ltd* (2002) 234 FCR 549.

35 *Sydneywide Distributors Pty Ltd v Red Bull Australia Pty Ltd* (2002) 234 FCR 549 [40].

36 *Sydneywide Distributors Pty Ltd v Red Bull Australia Pty Ltd* (2002) 234 FCR 549.

37 *Optical 88 Limited v Optical 88 Pty Limited (No 2)* (2010) 275 ALR 526.

38 *Optical 88 Limited v Optical 88 Pty Limited (No 2)* (2010) 275 ALR 526, 601 [406].

39 (2014) 227 FCR 511.

40 (2014) 227 FCR 511 [208].

41 *GME v Uniden Australia* (2002) 166 IPR 551.

42 (1985) 68 ALR 458 and *Dalgety Australia Operations Ltd v Seeley Nominees Pty Ltd* (1986) 64 ALR 421.

43 *Multisteps Pty Limited v Source and Sell Pty Limited* (2013) 214 FCR 323.

44 *Multisteps Pty Limited v Source and Sell Pty Limited* (2013) 214 FCR 323, [47].

45 *Multisteps Pty Limited v Source and Sell Pty Limited* (2013) 214 FCR 323, [45].

46 See Justice Steven Rares, 'Expert evidence in copyright cases – concurrent expert evidence and the hot tub' (FCA) [2009] *Federal Judicial Scholarship* 37.

47 (2011) 279 ALR 12.

48 *Barrett Property Group Pty Ltd v Dennis Family Homes Pty Ltd* (2011) 279 ALR 12, 52 [216].

49 Justice Steven Rares, 'Using the 'hot tub': how concurrent expert evidence aids understanding issues' (Summer 2010–11) *Bar News* 64 (paper presented to the New South Wales Bar Association Continuing Professional Development Seminar: 'Views of the "Hot Tub" from the Bar and the Bench', Sydney, 23 August 2010).

50 Justice Steven Rares, 'Using the 'hot tub': how concurrent expert evidence aids understanding issues' (Summer 2010–11) *Bar News* 64, 71.