

Expert Witness Problems -- and Proposed Solutions

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I. Introduction

Expert witnesses in interferences, like expert witnesses in district court litigation, can make or break your case. And they can be a damn nuisance, particularly if you don't think things through carefully before hiring them.

Of course, expert witnesses, like anybody else, can die or suddenly become unavailable for medical reasons. However, what can you do if an expert witness simply flakes out--i.e., refuses to continue cooperating with you for a reason which does not elicit the sympathy of the APJ?

II. What Happened in University of Iowa Research Foundation v. University of California

Iowa's problem in University of Iowa Research Foundation v. University of California, 75 USPQ2d 1059 (PTOBPAI 2004) (non-precedential) (Moore, APJ, not joined by any other APJ), was that it had hired as its expert witness a UC professor, albeit one who worked at a different campus than UC's inventors. According to outside counsel for UC, inside counsel at UC asked Iowa's expert witness "whether he

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recognized that his testimony was adverse to UC,” but did not pressure Iowa’s expert witness in any way. Be that as it may, Iowa’s expert witness then withdrew -- terribly late in the game.³

At that point, the parties jointly requested extensions of two of the time periods which, unlike most time periods, cannot be extended by mutual agreement of the parties.⁴ However, Judge Moore initially twice denied Iowa’s unopposed motion to reset those time periods on the ground that Iowa had brought its trouble on itself by “select[ing] an expert witness from the opposite side to begin with...”⁵ --although he also asserted that UC was partially to blame because it had “not ...[kept] their employees properly advised and supervised as to the existence of conflicts of interest in their expert witnessing.”⁶

Ultimately, Judge Moore gave Iowa a break, but on a ground that is unlikely to reoccur in our lifetimes:

The APJ in charge of this interference observes that
the Board of Patent Appeals and Interferences will be
moving on October 5, 2004. As a consequence, and for the
convenience of the Board and the parties hereto and no

³ As Judge Moore explained it, the UC professor “at this late date recognized which side his bread is buttered on and requests [sic; requested] withdrawal of his declaration.” 75 USPQ2d at 1060.

⁴ Iowa was fortunate to have Danny Huntington as its opponent’s counsel. We have always found Danny to be a perfect gentleman and a pleasure to do business against.

⁵ 75 USPQ2d at 1060.

⁶ 75 USPQ2d at 1060.

other reason, the APJ in charge of this interference is resetting time periods 7 and 8....⁷

III. What Could Have Been Done

It is not easy to “properly advise[] and supervise[]” university professors as to anything, let alone “as to the existence of conflicts of interest” when there is serious money involved!⁸ This led the authors to consider ways that the party that is really aggrieved in such situations (here, Iowa) could seek redress.

IV. Breach of Contract

The UC professor who was Iowa’s expert witness presumably breached his or her contract with the law firm that retained him or her.⁹ Could Iowa have sued the professor for breach of that contract as a third party beneficiary (either express or implied, depending on how the contract was written) under that contract? In the authors’ opinion, the answer is clearly yes.¹⁰ While the damages would not be the value of the invention

⁷ 75 USPQ2d at 1060.

⁸ While this discussion focuses on professor expert witnesses, much of it applies equally to the legions of consultant expert witnesses.

⁹ We do not know the exact details of the consulting contract between Iowa’s counsel and the UC professor. Because Iowa’s counsel is based in Boston, it is reasonable to assume that the contract will be governed either by California or Massachusetts law.

¹⁰ Under Cal. Civ. Code § 1559, “A contract, made expressly for the benefit of a third person, may be enforced by him at any time before the parties thereto rescind it.”

Massachusetts adopted the Restatement (Second) of Contracts § 302 whereby “when one

(even if the expert's behavior caused Iowa to lose an otherwise winnable case), they would be the law firm's charges for finding and bringing up to speed an alternate expert witness, whatever the UC professor had previously billed, and miscellaneous expenses stemming directly from the breach.¹¹ That would probably be a sum (a) that is worth suing for and (b) that a professor expert witness (who probably bills not less than \$500/hour and who, unlike a lawyer expert witness, gets to keep most of what he or she collects) could pay.¹² The authors think that the sum would likely be in the \$100,000 - \$200,000 range.

V. UC's (Perhaps) Tortious Interference With the Law Firm's Contract With the Expert Witness

An even more interesting question is whether Iowa could successfully sue UC for tortious interference with its law firm's contract with the UC professor.¹³

person, for a valuable consideration, engages with another, by simple contract, to do some act for the benefit of a third, the latter, who would enjoy the benefit of the act, may maintain an action for the breach of such engagement." See e.g., Rae v. Air-Speed, Inc., 435 N.E.2d 628, 632-633 (Mass. 1982).

¹¹ See, e.g., Fruitvale Canning Co. v Cotton, 252 P.2d 953 (Cal. 1953) (A third party beneficiary cannot gain any rights greater than those of the promisee.)

¹² Not to mention the sweet satisfaction that suing the professor would give Iowa and/or its law firm.

¹³ The elements of intentional interference with contractual relations are: 1) a valid contract between plaintiff and a third party; 2) defendant's knowledge of this contract; (3) defendant's intentional acts designed to induce a breach or disruption of the contractual

Again, the first question would be whether Iowa is a third party beneficiary under that contract, and again it is the authors' opinion that it is -- even if the retention agreement doesn't expressly so state.

The second question would be whether UC had some sort of privilege that entitled it to lean on the professor. Of course, the professor was, in a broad sense, an employee of the university. However, being a professor employee of a university is utterly unlike being a research employee at a for-profit corporation. Professors zealously guard against any infringement of their "academic freedom"¹⁴ and, perhaps even more so, against any

relationship; (4) actual breach or disruption of the contractual relationship; and (5) resulting damage. Kucharczyk v. The Regents of the Univ. of Calif., 48 F. Supp. 2d. 964, 977 (N.D. Cal. 1999) (citing Quelimane Co. v. Stewart Title Guar. Co., 19 Cal. 4th 26, 55-56, 9 P.2d 513 (1998)). It is similar under Massachusetts law in that the plaintiff must prove that (1) he had a contract with a third party; (2) the defendant knowingly interfered with that contract; (3) the defendant's interference, in addition to being intentional, was improper in motive or means; and (4) the plaintiff was harmed by the defendant's actions. Harrison v. Netcentric Corp., 744 N.E.2d 622, 632 (Mass. 2001).

¹⁴ "Our Nation is deeply committed to safeguarding academic freedom, which is of transcendent value to all of us and not merely to the teachers concerned. That freedom is therefore a special concern of the First Amendment, which does not tolerate laws that cast a pall of orthodoxy over the classroom." Keyishian v. Board of Regents, 385 U.S. 589, 603 (1967).

change in their lifetime tenure.¹⁵ Controlling “employees” who can do what they want and whom you cannot fire without extreme measures severely limits anything a university can do to “properly advise[] and supervise[]” its faculty!

The third question would be whether UC (perhaps unlike its professor) could afford to pay the damages. The answer to that one, which of course is what makes this possibility so interesting, is “You betchum, Red Ryder!”¹⁶

¹⁵ Examples of attacks on life-time tenure for university faculty are legion. One recent example is the University of Colorado’s Board of Regents difficulties in attempting to revoke the tenure of Ward Churchill, tenured professor and head of the University’s ethnic studies department, in reaction to Churchill’s odious comments about the victims of 9/11.

¹⁶ According to counsel for Iowa, “we had no interest in pursuing legal action against the expert or California since we did not want to cause any embarrassment for this expert.” However, many entities in Iowa’s situation might not be so charitable.