



POSITION STATEMENT

THE USE OF NEUTRAL EXPERTS IN INTELLECTUAL PROPERTY LITIGATION

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IEEE-USA urges courts to employ neutral experts for offering specific knowledge, advice and recommendations in the technology of a case, as a way to reduce litigation costs, and to help make technically sound decisions, particularly in intellectual property litigation.

In many instances in intellectual property litigation, the special knowledge of an expert is particularly valuable. Using a neutral expert -- either as a court-appointed expert or a special master as appropriate to the task before the court -- provides more substantial benefits overall, rather than each side presenting their own experts. Far too often, party experts become vehicles for presenting arguments, simply parroting lawyers' positions rather than promoting sound views of the technology. And they do not help the trial court in its tasks.

Determining whether a software copyright has been infringed requires filtering elements that are common practice or dictated by external considerations, followed by examining the remaining material for substantial similarity. Such tasks are very suitable for a neutral expert familiar with the technology.

In cases involving proprietary software source code, experts can address whether material is similar or claim elements are present, while preserving the trade secrets in the code. But often, a party resisting discovery requests or burying the information thwarts such a straightforward activity. Using a neutral expert to say what the source code contains discourages discovery abuses, since it is in a party's best interest to support the expert's findings.

During patent litigation, claims need to be interpreted as what they would have meant to a person of ordinary skill in the art, at the time of the invention. While patent claim construction is a matter of law, it has an inherent factual component. The Federal Circuit has said: "The descriptions in patents are not addressed to the public generally, to lawyers or to judges, but, as section 112 says, to those skilled in the art to which the invention pertains, or with which it is most nearly connected." Yet, it has not strongly endorsed a special role for neutral technology experts.

This statement was developed by IEEE-USA's Intellectual Property Committee and represents the considered judgment of a group of U.S. IEEE members with expertise in the subject field. IEEE-USA advances the public good and promotes the careers and public policy interests of more than 210,000 engineers, scientists and allied professionals who are U.S. members of IEEE. The positions taken by IEEE-USA do not necessarily reflect the views of IEEE or its other organizational units.