

# Intellectual Property Today™

**Document Management System**  
 New From **RFCEXpress.com**  
 Download documents from recently filed Patent, Copyright and Trademark lawsuits. Get them here fast. Complaints, exhibits, briefs, orders and more

## The Case of the Arrogant Expert

By **Bob Zeidman** of **Zeidman Consulting**

**Bob Zeidman** is the president of **Zeidman Consulting**, a premier contract research and development firm in Silicon Valley and president of Software Analysis and Forensic Engineering Corporation, the leading provider of software intellectual property analysis tools. Bob is considered a pioneer in the fields of analyzing and synthesizing software source code, having created the SynthOS™ program for synthesizing operating systems and the CodeSuite® program for detecting software intellectual property theft. He has written four engineering texts — **The Software IP Detective's Handbook**, **Verilog Designer's Library**, **Introduction to Verilog**, and **Designing with FPGAs and CPLDs** — in addition to numerous articles and papers. He teaches engineering and business courses at conferences throughout the world. Bob also holds a number of patents and earned two bachelor's degrees, in physics and electrical engineering, from Cornell University and a master's degree in electrical engineering from Stanford University.

I was once an expert on an intellectual property litigation over a patent for a simple but clever transistor circuit. My client was a small company that had developed a simple circuit that used only two transistors whereas previous devices had required more transistors, precisely manufactured resistors and capacitors, and tightly regulated voltage or current supplies. All of this added up to a few more dollars of product cost in a consumer device where keeping costs low was crucial to success.

My client had been selling semiconductor chips that implemented this circuit to a major consumer electronics company for use in their products. After some time the large company bought a similar patent from a very small company and licensed the patented technology to a large semiconductor company to manufacture these same kinds of chips. The large company believed that their purchased patent protected them. In fact, the purchased patent completely described my client's invention. There was one small problem. The purchased patent was filed about one year after my client had filed its patent, and therefore my client's patent invalidated the purchased patent. After attempting to reach a solution with the large company, my client took them to court.

The large company hired an expert who had years of experience in electronics. He was about 60 years old and had held management positions at several large and well-respected companies. He had over 100 patents, most of which named him as the lead inventor. He had degrees from MIT and Stanford including a PhD. in EE. When I saw his CV I told my client's lawyer, "This guy is impressive."

"You're not intimidated, are you?" the lawyer asked.

"No, of course not," I said, trying to appear confident. "It's just that I rarely go up against someone with these kinds of credentials. It'll be an interesting case."

This was true. In recent years, with the economy faltering, I've been seeing more low-priced experts on cases. I see a lot of unemployed or retired IT professionals working as software forensics experts, something for which they're highly unqualified since most of them have only installed and maintained software, not written it or analyzed it. This guy, however, was top dollar and seemed to be worth it.

When I read over this expert's report, he had listed several patents as prior art that he claimed invalidated my client's patent. All of these patents had significant differences in how they worked. Some used a current source instead of a voltage source. Some required very precise, and thus expensive, capacitors or resistors whereas my client's invention could use inexpensive, off-the-shelf components because it was self-calibrating. There was one patent that the expert had referenced, however, that looked really good. Reading the description and the claims, it seemed similar enough to my client's patent that it might invalidate it. I told my concerns to my client's attorney. He told me that when I addressed that patent in my expert report, I should list all of the differences I could find between this patent and my client's patent without explicitly drawing a conclusion about the validity of my client's patent—we'd figure out later how to specifically address this issue. So that's what I did.

After submitting my report to the court I continued to examine this patent and discovered something very important. This "prior art" patent didn't work. The description of the circuit's function could not possibly be correct because after a transistor connecting two points in the circuit got turned on, those two points were described as having significantly different voltages and very different behaviors. A turned-on transistor acts like a short circuit and so the voltage on either side of the transistor would be nearly equal at all times. My client's attorney was very happy, but told me not to mention that their key patent was non-enabling at my upcoming deposition unless I was very specifically asked; he wanted to surprise the other side and their expert.

My deposition began normally with the standard questions about my physical and mental health and ability to understand the questions. The opposing counsel asked a little about my background, then rushed through the patents that their expert had identified as prior art but that I could easily explain away. Before lunchtime they specifically asked about their prized circuit patent. After much prodding about why I dismissed this circuit so easily, I finally answered a direct question that the circuit in their "prior art" patent simply didn't work. I explained why. The large company's attorneys went silent, then started frantically passing notes, then asked for a break and left the room. They came back maybe 15 or 20 minutes later and went into damage control mode, arguing to exclude my testimony.

- [Blogs](#)
- [Executive Search](#)
- [Expert Witness](#)
- [File Wrappers](#)
- [For Sale](#)
- [IP Law Firms](#)
- [Jobs](#)
- [Office Space](#)
- [Patent & TM Searches](#)
- [Patent Drafting](#)
- [Patent Enforcement](#)
- [Patent Translations](#)
- [Referral Services](#)
- [Situations Wanted](#)
- [Sequence Searching/Listing](#)
- [International Litigation Support](#)

At the lunch break I called my wife, who was also my office manager, to check in. She asked me how it was going. "Good," I replied, "but I wouldn't want to be the other expert. Right now he's probably calling his wife, telling her he won't be home tonight, and preparing for a sleepless night in preparation for his own deposition tomorrow."

The rest of the deposition went fairly normally with the opposing counsel avoiding any questions about the non-working circuit. The next day I arrived at the other expert's deposition. I figured he'd have dark circles under his eyes from staying up all night to explain his report, understand his mistake, and strengthen his remaining arguments. But he looked rested. In fact, I walked in a couple minutes late and he was already raising his voice with my client's attorney who was deposing him. Usually the first few minutes of a deposition are devoted to explaining procedures and making introductions. Even the first few hours are often used to just get background information on the expert's qualifications and analysis techniques. An expert rarely raises his voice, especially when he's being video-taped for possible use in court. It just didn't go over well with a judge or jury for an expert to be angry and defensive. But this guy was downright condescending. "How dare you question my expertise." "I was designing circuits before you were born." And "I'm the expert here." Statements like that.

My client's attorney was a darned good engineer and a clever attorney. He simply remained calm and said things like, "I apologize. I didn't mean to question your expertise. You've been doing this for a long time. Could you just explain to me how this circuit works when these two points are connected by a closed transistor?"

The expert would momentarily calm down and say things like "It would take a lot of time to go through all of the signal transitions." Remember this is a two-transistor circuit. So my client's attorney responded, "We have all day and the important thing is to make sure all of our facts are correct. Please go ahead." He then slid a notepad and pen toward the expert who reluctantly mapped out various signals in the circuit and attempted to show, essentially, that 2 equals 1. After minutes of drawing signals and not getting them to come out as shown in the patent, the expert said something like "Maybe the initial voltage is negative" and slid the notepad back to my client's attorney. My client's attorney responded, "Okay, let's assume the initial voltage is negative" and slid the notepad right back.

I was surprised, and amused. When I had pointed out the obvious flaw in the circuit, any undergrad electrical engineer would have to admit the circuit didn't work. But not this guy. Finally after about 2 hours he admitted defeat. Not that he had made a mistake, because that would have hurt his obviously inflated ego, but he said something else that really floored me. He said, "It looks like there was a mistake in the report. I didn't write this report. The attorneys wrote the report. I advised them on it."

As the expert it's his responsibility to independently perform the work, come to a conclusion, and write up the results. Rather than admit that he made a stupid mistake, he actually jeopardized his career instead. My attorney tried to give him an out. "Did you edit the document?"

"I had a remote connection while they wrote it up." He added, "I observed, but they did the typing."

The deposition went downhill from there. The expert answered the questions, but he took very long pauses and snapped at the attorney every time he was "interrupted," claiming he hadn't finished answering the question. By the end of the deposition, nerves were raw. My client's attorney turned to the videographer and asked how long she'd been taping so far. "Oh, exactly seven hours," she replied. Federal Rules of Civil Procedure state that depositions can last no more than 7 hours per day. The expert knew that. Tearing off his microphone he exclaimed, "Then I'm out of here" and walked out.

His client's attorney watched him leave, then turned to my client's attorney and asked "Is it ok if I bring him back for a few direct questions to clarify some of his answers?" Attorneys working with an expert will often ask a few questions at the end of a deposition. This is especially true if the expert got confused or made a mistake or just didn't explain something well.

"You heard what he said," responded my client's attorney. "He's outta here." He then took off his own microphone. The large company's attorneys weren't happy.

I sometimes stick around to talk to the videographer and stenographer. Their jobs are not particularly interesting, recording highly technical legal proceedings with little knowledge of the terminology and its relevance. This one was different. They both were talking about one of the more interesting depositions they've attended. It was one of the more interesting ones that I've attended too. The emotion and the interplay between expert and attorney were fascinating. On the other hand, I wondered if justice was being served. It started me wondering if many expert witnesses were simply blind champions for their clients rather than the neutral authorities they are supposed to be. My staff and I always struggle with presenting the facts without unintentional bias, though obviously in the best light possible for our client. The longer I've worked as an expert witness the more times I've come across other expert witnesses who don't seem to struggle with this. Which has also got me thinking that maybe the system needs to be changed. Or at least monitored better.

© Copyright 2012 Intellectual Property Today

[Home](#) • [Issues](#) • [News](#) • [Classified](#) • [Jobs](#) • [Reports](#) • [Poster](#) • [Subscribe](#) • [Links](#) • [Contact](#)

[Legal Statement](#) • [Privacy Policy](#) • [Terms of Use](#) • [RFC Express](#) • [Sitemap](#)

