

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 (IP) litigation.

In many instances of IP litigation, an expert's special knowledge is particularly valuable. Rather than relying on opposing parties to present their own experts, use of neutral experts--either as a court-appointed expert, or a special master, as appropriate to the task before the court--provides more substantial benefits overall. Far too often, party experts becomes vehicles for presenting arguments, simply parroting counsels' positions, rather than promoting sound technological views. These biases 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 software, neutral experts can examine source code to address whether material is similar, or claim elements are present, while preserving the trade secrets in the code. Often a party resists discovery by burying information. Using a neutral expert to examine source code contents discourages discovery abuses since it is in a party's best interest to support the expert's findings.

During patent litigation, claims must be interpreted as what they would mean 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 Court 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, the court has not strongly endorsed a special role for neutral technology experts.

This statement was developed by the IEEE-USA 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 the more than 200,000 engineering, computing and allied professionals who are U.S. members of the IEEE. The positions taken by IEEE-USA do not necessarily reflect the views of IEEE or its other organizational units.