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Unresolved Issues in Patent Dispute Evidence in Australia: Considering Arbitration as an Alternative to Litigation

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Factual issues in most patent litigation are related to very complicated techniques. Thus, the courts has emphasised that the technology in dispute has to be read and understood through the eyes of a person to whom it is directed. Therefore, among the various processes in federal litigation, most litigation in the field of patent infringement relies on at least some expert evidence. This paper focuses on issues regarding patent dispute evidence, and explore whether there are unresolved issues in evidential rules and procedures of patent proceedings. Further, this paper seeks to demonstrate that both the parties and the courts in patent disputes generally benefit from the current evidence system. However, in a number of Australian cases, the scope of expert evidence in patent cases has been strictly limited. Australian Government identified uncertain issues associated with the present patent enforcement system, due to factors such as a low level of knowledge about what patent rights entail, the high degree of uncertainty of outcome in legal proceedings, etc. Arbitration shall be reviewed and suggested as an alternative to tackling the ongoing problems in the trial system.

Key Words : Patent Infringement Litigation, Discovery, Expert Opinion, Australian Evidence Law, Confidentiality, Code of Conduct, Concurrent Expert Evidence, Hot-tubbing, Admissibility, Court's Control, Federal Court Rules 2011 (Cth), Arbitration, Australia's Commercial Arbitration Act ('CAA'), Patent Tribunal

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Ⅰ. Introduction

Evidence in patent proceedings is important in determining the factual issues of a case. In most patent infringement litigation, factual issues are related to very complicated techniques. Therefore, courts hearing patent litigation claims perform the important role of determining the factual issues of the case through scrutinising highly specialised and technical issues. If a patent in dispute is clear and readily understandable according to its ordinary meaning, a court does not need any aid in understanding the context of such technology.[1] However, it has been emphasised by the courts that the technology in dispute has to be read and understood through the eyes of a person to whom it is directed, as at the priority date. In *Kimberly-Clark Australia Pty Ltd v Multigate Medical Procedure Pty Ltd,*[2] the court observed that since the patent in dispute must interpreted according to the common general knowledge as it existed before the priority date, the court must place itself in the position of a person acquainted with the surrounding circumstances as to the state of the art and manufacture at the relevant time.[3] Recently, in *Britax Childcare Pty Ltd v Infra-Secure Pty Ltd,*[4] it has been confirmed that if technical terms are used in the patent, expert evidence is likely to be needed.[5] Therefore, the parties in patent disputes may use expert witnesses with the permission of the court, and such experts are expected to perform a vital role in such disputes by providing an independent and objective opinion.[6] Thus, among the various processes in federal litigation - such as those

1) Ian Freckelton and Hugh Serby, *Expert Evidence, Law, Practice, Procedure and Advocacy* (Thomson Lawbook Co., 5th ed, 2013) 1297.
2) (2011) 92 IPR 21; [2011] FCAFC 86 at [24].
3) Freckelton and Serby, above n1, 1298.
4) [2012] FCA 467 at [233].
5) Freckelton and Serby, above n1, 1298.

concerning real evidence, documentary evidence, and expert evidence; market survey evidence; and presentation of evidence - most Intellectual Property (IP) litigation, especially in the field of patent infringement, relies on at least some expert evidence.[7)]

This paper will focus on and address the following issues regarding patent dispute evidence in: patent infringement litigation; issues of expert opinion, such as confidentiality in discovery; the code of conduct; appropriate expert witnesses; the admissibility of expert opinion; and court's control over discovery, etc. The paper's purpose is to explore the evidential rules and procedures of patent proceedings, and whether there are unresolved issues in the relevant existing law. Many works have addressed whether these areas are well exercised in patent litigation under the Federal Court system in Australia. Further, this paper seeks to demonstrate that both the parties and the courts in current patent disputes generally benefit from the current evidence system. However, since, in some situations, this system may conflict with various interests of the parties.

In a number of Australian cases, the most notable being the decision of the Full Federal Court in *Minnesota Mining & Manufacturing Company v Tyco Electronics Pty Ltd*,[8)] the scope of expert opinion evidence in patent cases has been strictly limited.[9)] In order to benefit the economy by supporting patentees to effectively exercise their patent rights, the Australian government requested ACIP (Advisory Council on Intellectual Property)[10)] to inquire and report on issues relating to current patent enforcement system. The government identified uncertain issues associated with the present patent enforcement system, due to factors such as the probabilistic nature of patent rights, a low level of knowledge about what patent rights entail and how to manage intellectual property, the high degree of uncertainty of outcome in legal

6) Massimo Sterpi et al, *Patent Litigation - Jurisdictional Comparisons* (European Lawyer Reference, 2011) 479.

7) World Intellectual Property Organization, *WIPO Intellectual Property Handbook: Policy, Law and Use* available at 〈http://www.wipo.int/edocs/pubdocs/en/intproperty/489/wipo_pub_489.pdf〉.

8) [2002] FCAFC 315.

9) Paul Massey, *The limitations of expert evidence in patent proceedings* available at 〈http://www.findlaw.com.au/articles/1272/the-limitations-of-expert-evidence-in-patent-proce.aspx〉.

10) The Advisory Council on Intellectual Property (the Council or ACIP) was an independent body appointed by the Australian Government, and advised the Federal Minister for Industry and Science - and his Parliamentary Secretary - on intellectual property matters and the strategic administration of IP Australia. The Council was established in 1994, and was abolished in April 2015.

proceedings, etc. Since the ACIP's 2010 Final Report recommended non-court measures including establishment of a Patent Tribunal, arbitration shall be reviewed and suggested as an alternative to tackling the ongoing problems in the trial system.[11]

Ⅱ. Evidential Issues in Patent Litigation in Australia

1. Patent Litigation

When the defendant acts within the range of a patent without the permission of either the patentee or his or her exclusive licensee, the patent is infringed. There are two basic forms of infringement. Under Section13 of the *Patents Act 1990* (Cth), the patentee has the exclusive right to exploit the invention and to authorize another person to exploit the invention during the term of the patent, and it is thus an infringement of the rights of the patentee to exploit the invention without the authority of the patentee. And a form of contributory infringement by supply of products is provided under Section 117. Pursuant to Section 120(1), (2) and (3), either of these parties may initiate a legal proceeding against the infringement of the exclusive rights granted pursuant to a patent.[12]

Following the decision of *Olin Corp v Super Cartridge Co Pty Ltd*[13] the court in *Populin v HB Nominees Pty*[14] found that infringement was established if the potential infringer's product or process takes all the essential features or integers of the patentee's claim. On the other hand, if a particular aspect of an invention is an essential feature of the claim and the infringing product or process does not incorporate that feature, then there will be no infringement.[15] However, as in *Fisher & Paykel Healthcare Pty Ltd v Avion Engineering Pty Ltd*,[16] courts have held that

11) Dimitrios Eliades, 'Australian patent enforcement: a proposal for an expert panel opinion' (2013) 48(3) *Les Nouvelles* 114-115.
12) William Van Caenegem, *Intellectual Property Law in Australia* (Kluwer Law International, 2010) 116-117.
13) (1977) 51 ALJR 525.
14) (1982) 41 ALR 471, 475.
15) Stuart Gibson, 'Preparing for battle' (2006) 19(7) *Australian Intellectual Property Law Bulletin (newsletter)*.
16) (1991) 103 ALR 239.

omitting an inessential part of the claims, or replacing the part with an equivalent claim, will not automatically avoid court's finding of infringement. Meanwhile, defendant in an infringement action may, in general, bring a counterclaim for revocation of a patent under Section 121.[17]

2. Evidential Issues

(1) Discovery

Patent infringement litigation involves complex legal issues; thus, the basis for proving infringement involves resolving complicated questions of claim construction that require specialised scientific or technological knowledge or expertise.[18] Hence, it is critical for a plaintiff to gather and evaluate evidence to enforce its patents rights against a defendant.[19] After evidence has been adduced in person or by affidavit, the source of the evidence must be available to be cross-examined by the opposing party at the trial. If documental discovery is requested, the court requires each party to list and disclose all documents relevant to the particulars specified in the claim and cross-claim and which are in possession or control of the parties.[20] Further, the court may issue an order for inspection where the alleged infringement occurred by virtue of Section 122(2) of the *Patents Act 1990* (Cth). This order is similar to an 'Anton Piller' order enabling the plaintiff to order for inspection of anything or on any vessel, vehicle, aircraft or premises to search any evidence of infringement.[21]

(2) Expert Opinion in Patent Litigation

In addition to the discoverable documents and exchange of affidavits, expert opinion is also adduced as part of the patent litigation process.[22] As in the litigation

17) Caenegem, above n12, 117.
18) Jason Bosland, Kimberlee G. Weatherall and Paul Jensen, 'Trade mark and counterfeit litigation in Australia' (2006) 4 *Intellectual Property Quarterly* 347, 356.
19) Jochen Bühling, *Obtaining evidence when preparing patent litigation* available at 〈http://www.buildingipvalue.com/06EU/172_175.htm〉.
20) Peter Chalk, David Clark and Ben Miller, *Australian IP litigation explained* available at 〈http://www.managingip.com〉.
21) Caenegem, above n12, 121.
22) John Fairbairn and S. Stuart Clark, 'Intellectual Property Litigation in Australia' (2008) 75(2) *Def.*

procedures in other legal fields, expert opinion may be admissible if it is relevant and may affect directly or indirectly a fact in issue in a patent claim.[23] However, Mason P observed in *R v GK*[24] that 'judges should exercise particular scrutiny when experts move close to views unsupported by disclosed and contestable assumptions'.[25]

In patent proceedings before the Federal Court of Australia, the *Evidence Act 1995* (Cth) governs the admissibility of expert evidence. It allows expert witnesses to give evidence in the form of opinions and inferences. In common law, 'a witness may only give evidence of that which they have observed, so that inferences from observed facts, or opinions, are not ordinarily receivable in evidence'.[26] Section 76 of the *Evidence Act 1995* (Cth) codified the common law principle derived from *Perry*[27] which is an opinion rule that witnesses can only give factual evidence such as the evidence of number, title, and patentee of a patent, and not opinion evidence.[28]

There are exceptions to the opinion rule, one of which is found in Section 79 of the *Evidence Act 1995* (Cth), which applies to opinions based on specialised knowledge. Under Australian law, an expert's opinion evidence may be admitted if that expert has specialised knowledge based on his or her training, study, or experience and his or her opinion is wholly or substantially based on that knowledge.[29] As provided in Section 80 of the *Evidence Act 1995* (Cth), an expert may express an opinion about a fact in issue or an ultimate issue, or a matter of common knowledge. However, Mason P observed in *R v GK* that 'judges should exercise particular scrutiny when experts move close to views unsupported by disclosed and contestable assumptions'.[30] Thus, expert evidence may be admissible if it is relevant and may affect directly or indirectly a fact in issue in a proceeding.[31]

Counsel J. 142.

23) Peter Bayne, *Uniform Evidence Law* (The Federation Press, 2003) 12.

24) (2001) 53 NSWLR 317, 326-7.

25) Bayne, above n23, 295.

26) Bayne, above n23, 260.

27) (1990) 48 A Crim R 243 at 249 per Gleeson CJ.

28) Robynne Sanders, 'The Use of Expert Evidence in Court Proceedings and Oppositions' (2006) 23(3) *The Watermark Journal.*

29) Bayne, above n23, 268.

30) Bayne, above n23, 295.

31) Bayne, above n23, 12.

Ⅲ. Confidentiality Issues in Discovery

1. Court's Control over Discovery

As litigation developed into more advanced and complex process, especially in patent disputes, it became more time-consuming and extensive wasted costs to burden not only the litigants and the counsel but also the court.[32] Consequently, in an effort to restrict the amount of discovery in Australian patent litigation, the discovery process in the Federal Court of Australia has come under increasing court control through Rules 7.22 and 7.26 of the *Federal Court Rules 2011* (Cth).[33]

Further, the Federal Court introduced the notion of categories of discoverable documents, thereby limiting the documents which are discoverable in patent litigation. The court directs the parties to adduce discovery by reference to specified categories of documents that must be relevant to the particulars of infringement in the claim -such as investor and/or researcher notes- and documents that may adversely affect the party's own case, adversely affect another party's case, and/or support another party's case.[34]

2. Confidentiality in Discovery

As provided in Rule 7.22,[35] 7.23,[36] and 20.23[37] of the *Federal Court Rules 2011*

32) Justice James Allsop, 'Discovery in Intellectual Property Litigation' (FCA) [2004] *FedJSchol* 19.
33) *Ibid.*
34) Chalk, Clark and Miller, above n20.
35) RULE 7.22 Order for discovery to ascertain description of respondent
(1) A prospective applicant may apply to the Court for an order under subrule (2) if the prospective applicant satisfies the Court that:
(a) there may be a right for the prospective applicant to obtain relief against a prospective respondent; and
(b) the prospective applicant is unable to ascertain the description of the prospective respondent; and
(c) another person (the other person):
(i) knows or is likely to know the prospective respondent's description; or
(ii) has, or is likely to have, or has had, or is likely to have had, control of a document that would help ascertain the prospective respondent's description.
(2) If the Court is satisfied of the matters mentioned in subrule (1), the Court may order the other person:
(a) to attend before the Court to be examined orally only about the prospective respondent's

(Cth), in certain cases, discovery may even permit a third party to search for documents relevant to the pleadings.[38] The principle applicable to a litigant who requests to inspect confidential information of a business competitor was addressed by Hayne JA in *Mobil Oil Australia Ltd v Guina Developments Pty Ltd*:[39]

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description; and

(b) to produce to the Court at that examination any document or thing in the person's control relating to the prospective respondent's description; and

(c) to give discovery to the prospective applicant of all documents that are or have been in the person's control relating to the prospective respondent's description.

36) RULE 7.23 Discovery from prospective respondent

(1) A prospective applicant may apply to the Court for an order under subrule (2) if the prospective applicant:

(a) reasonably believes that he or she may have the right to obtain relief in the Court from a prospective respondent whose description has been ascertained; and

(b) after making reasonable inquiries, does not have sufficient information to decide whether to start a proceeding in the Court to obtain that relief; and

(c) reasonably believes that:

(i) the prospective respondent has or is likely to have or has had or is likely to have had in the prospective respondent's control documents directly relevant to the question whether the prospective applicant has a right to obtain the relief; and

(ii) inspection of the documents by the prospective applicant would assist in making the decision.

(2) If the Court is satisfied about matters mentioned in subrule (1), the Court may order the prospective respondent to give discovery to the prospective applicant of the documents of the kind mentioned in subparagraph (1) (c) (i).

37) RULE 20.23 Discovery from non-party

(1) If a party believes that a person who is not a party has or is likely to have, or has had or is likely to have had, in the person's control, documents that are directly relevant to an issue raised on the pleadings or affidavits, the party may apply to the Court for an order that the person make discovery of the documents to the party.

(2) An application under this rule must:

(a) be served personally on the person; and

(b) be accompanied by an affidavit:

(i) stating the facts on which the applicant relies; and

(ii) identifying, as precisely as possible, the documents, or categories of documents to which the application relates.

(3) A copy of the accompanying affidavit for an application must be served on each person on whom the application is served.

(4) In this rule, a reference to an affidavit is a reference to:

(a) an affidavit accompanying an originating application; and

(b) an affidavit in response to the affidavit accompanying the originating application.

38) Allsop, above n32.

39) [1996] 2 VR 34.

> Where, as here, the problem is one of balancing the needs of a party to the litigation and the legitimate concern of a trade trial to retain secrecy of commercially sensitive information, it may well be necessary to mould orders that will distinguish between the plaintiff, its officers, its legal advisers and experts. … It is now commonplace in the courts for material to be made available only to legal advisers of the parties and nominated experts. … But they are arrangements that are made and should be made when doing so would strike a fair balance between the competing interests of the party seeking inspection and the party claiming confidentiality.[40]

However, debate is increasing concerning the appropriateness of the current scope of discovery.[41] As confirmed by Hayne JA in *Mobil Oil,* expressing scepticism as to 'whether confidentiality can be preserved where the party obtaining discovery is a trade rival of the person providing discovery',[42] discovery in patent litigation frequently involves confidential documents and information; thus, neither party wants these to be disclosed to the other party or to any other trade competitors.[43] Use of discovered information for purposes other than those of the present litigation without leave of the court is considered a contempt of court in Australia.[44]

Hence, as in *InterPharma Pty Ltd v Commissioner of Patents*,[45] courts in patent litigation claims generally make discovery orders that restrict disclosure to external lawyers, nominated independent technical experts, and sometimes the opposing party's in-house counsel, subject to preserving the confidentiality of the discovered documents and using them only for the purpose of the present litigation.[46] Furthermore, as Finkelstein J held in *Conor MedsystemsInc v University of British Columbia (No 4)*,[47] any misuse other than for the present litigation purposes results in the party breaching

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40) Jill Hunter, Camille Cameron and Terese Henning., *Litigation I* (LexisNexis Butterworths, 7th ed, 2005) 254-255.
41) Chalk, Clark and Miller, above n20.
42) Hunter, Cameron and Henning, above n40, 255.
43) Lucy Hartland, 'Discovery and in-house counsel' (2009) 21(10) *Australian Intellectual Property Law Bulletin* 208.
44) Allsop, above n32.
45) [2008] FCA 1422.
46) Hartland, above n43, 209.
47) [2007] FCA 324.

the confidentiality protocol being liable to pay damages.[48]

Meanwhile, in *Hogan v ACC (No 4)*[49] the non-publication order was revoked and the media and members of the public were granted access to the material admitted as evidence in open court. While Emmett J refused access to material that was on the court file, he lifted the usual restriction concerning evidence.[50] Moreover, LeBel J in *Person v Vancouver Sun*[51] advised, regarding the grounds for open justice, that if the evidence adduced in court is exposed to the public, there may be a better chance of any falseness being detected. However, the search for a fact will not be served if the deterrent effect of public disclosure diminishes the range of sources available to the courts.[52]

Ⅳ. Issues in Expert Opinion

1. Code of Conduct

The current process of selecting experts is dubious because the parties select their own experts and so may have established a relationship with them. Given such relationship between the parties and the selected expert witnesses, there have long been doubts among judges concerning expert witnesses' adherence to ethical standar d.[53] The importance of establishing whether an expert is observing his or her duty as an expert witness was identified by Doussa J in *Chapman v Luminis Pty Ltd (No 4)*.[54] In addition to owing duties to their clients under the retainers, legal practitioners and expert witnesses have additional and prior duties to the court. This is because the legal practitioner is an officer of the court, and the expert witness has a duty to the court to assist in clarifying the facts of the case.[55] Under the *Supreme Court Rules (Uniform Civil Procedure Rules 2005)* in New South Wales (NSW), the Federal Court

48) Hartland, above n43, 208.
49) [2008] FCA 1971.
50) Judith Bannister, 'Before the High Court; The Paradox of Public Disclosure: *Hogan v Australian Crime Commission*' (2010) 32 *Sydney Law Review* 159, 166.
51) [2007] 3 SCR 253, 272-3, 295.
52) Bannister, above n50, 172.
53) Freckelton and Serby, above n1,308.
54) (2000) 123 FCR 62; [2001] FCA 1106 at [297].
55) Freckelton and Serby, above n1, 312.

issued 'Guidelines for Expert Witness in Proceedings in the Federal Court of Australia', which establish the 'General Duty to the Court' as follows:

1) An expert has an overriding duty to assist the Court on matters relevant to the expert's area of expertise;
2) An expert witness is not an advocate for a party even when giving testimony that is necessarily evaluative rather than inferential; and
3) An expert's paramount duty is to the Court and not to the person retaining the expert.[56]

Knowledge and the observance of the provisions by litigation parties are expected by the court.[57] Hence, expert opinion will be admissible only if the provider complies with the binding code of conduct which is part of the courts' rules.[58]

Report 109 of the New South Wales Law Reform Commission[59] ('NSWLRC') established strong endorsement of the strict compliance of expert witnesses with the requirements of the code of conduct by referring to the judgment of Einstein J in *Commonwealth Development Bank v Casssegrain.*[60] Einstein J strongly refused to use his discretion to permit the admissibility of expert evidence where there is a lack of required acknowledgment on the ground that the expert witness might have established an opinion without adhering to the code of conduct.

However, the courts do have a limited discretion to admit expert evidence in the interests of justice where there has not been exact compliance with the code of conduct.[61] In *Barak Pty Ltd v WTH Pty Ltd,*[62] the court, allowing the admission of evidence from the expert witness, decided that the non-compliance was rather 'technical', and in *Langbourne v State Rail Authority*[63] and *Jermen v Shell Co of Australia Ltd*[64] the experts had sufficient reason not to comply with the code of

56) Andrew Cannon, 'Courts using their own experts' (2004) 13(3) *JJA* 182-194.
57) Freckelton and Serby, above n1, 326.
58) Fairbairn and Clark, above n22.
59) New South Wales Law Reform Commission, *Expert Witness,* Report No 109 (2005).
60) [2002] NSWSC 980.
61) Allsop, above n32.
62) [2002] NSWSC 649.
63) [2003] NSWSC 537.
64) [2003] NSWSC 1006.

conduct but later confirmed that there was no difference without acknowledging the requirement. Their opinions were unchanged by subsequently complying with the code, and the court permitted non-compliance reports to be adduced.[65] Although Report 109 detailed cases in which the courts used their discretion to permit reports, which had not been prepared in compliance with the code of conduct, in such cases, the courts concerned identified that the intention of the Rules had been virtually reflected in the reports of these experts.[66]

2. Appropriate Expert Witness

In *Minnesota Mining,* a federal case regarding a patent infringement and a cross-claim for revocation of the patent, the plaintiff was required to show that every one of the essential claims of its patent was replicated in the defendant's device to prove infringement of the patent. Concerning the use of experts, the Full Federal Court stated that few inventions that are the subject of patent proceedings are created by a single person but rather represent the cooperation of several persons. Therefore, when a single expert is unlikely to possess expertise in all the fields relevant to an invention, it would be better to use a composite of experts to assess the invention in issue against the claims.[67] Report 100 of the NSWLRC stated that:

> The use of joint expert witnesses can reduce the partisanship that is today so closely associated with expert witnesses called by each party, and encourage the use of experts with balanced, representative, views. Similarly, the use of joint expert witnesses has the potential, in many cases, to reduce the public and private costs and the delays associated with civil litigation. For these reasons, adding the possibility of a joint expert witness to the array of options available to the court is likely to facilitate the just, quick and cheap resolution of the real issues in the proceedings.[68]

65) Freckelton and Serby, above n1, 302.
66) *Ibid.*
67) Cameron Murrell and Felicity Marks, *Expert witnesses – the Tyco case* available at 〈http://www.findlaw.com.au/articles/1335/expert-witnesses-8211-the-tyco-case.aspx〉.
68) Peter McClellan, Concurrent Expert Evidence, available at 〈http://www4.falm.info/au/journals/NSWJSchol/2007/15.pdf〉.

However, single joint experts may not be the right choice when the subject matter of the proceedings is controversial or contentious, as in claims concerning sophisticated technical issues. In *Casey v Cartwright*,[69] Dyson LJ – with whom Keene and Hallett LJJ agreed – stated that, in general, single joint experts have an invaluable role to play in low-value litigation, especially in claims concerning simple and uncomplicated technologies. However, the judges accepted that, at least until some test cases have been decided at High Court level, they should be careful to direct that expert evidence on the causation issue be given by a single joint expert as causation issue is still controversial.[70]

Face with the need for greater control of judicial case management, concurrent expert evidence ('hot-tubbing') was developed in Australia and has been extensively used by the courts.[71] Concurrent expert evidence is, in essence, a discussion chaired by the judge in which the various experts, the parties, their advocates, and the judge engage in an endeavour to identify the issues, especially in litigation concerning technical issues - such as patent infringement - and, where possible, reach a common resolution regarding each of them.[72] Regarding the issues on which agreement is not possible, a structured discussion, with the judge acting as chairperson, allows the experts to give their opinions without constraint by the advocates, in a forum which enables them to respond directly to each other. The judge is not confined to the opinion of one advisor but has the benefit of multiple advisors who are rigorously examined in a public forum.[73]

Currently, patent disputes are becoming more complicated and controversial. Thus, the courts are increasingly relying upon a composite of experts to assess technical issues and explore differences in the technical processes in dispute at trial.[74] While concurrent expert evidence in patent disputes is innovative, it cannot resolve the problems caused by the biased nature of adversarial proceedings. For example, there is a risk that experts with different specialist skills may be examined based on different set of questions and factual assumptions.[75]

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69) [2007] 2 All ER 78.

70) McClellan, above n68.

71) Steve HuygHe Sr et al., 'The evolution of expert witness law under the UK and US jurisdictions' (2011) 8(4) *Const. L. Int'l* 14, 17.

72) McClellan, above n68.

73) *Ibid.*

74) The prevalence of hot tubbing (concurrent expert evidence) in international arbitration, which procedurally draws on a number of different influences, varies considerably among different jurisdictions; however, the approach is becoming more prevalent.

3. Admissibility of Expert Opinion

As demonstrated by the decision of the Full Federal Court in *Minnesota Mining,* Sections 79 and 80 of the *Evidence Act 1995* (Cth) have been given a restrictive interpretation in a number of Australian cases. Consequently, the scope of expert opinion evidence in patent cases has been strictly limited. In *Makita (Australia) Pty Ltd v Sprowles*,[76] Heydon J provided several detailed outlines of the requirements for the admissibility of expert opinion evidence, as an exception to the opinion rule. Thus, where the court is not certain of the applicable requirements, expert opinion evidence is inadmissible.[77] The approach in *Makita* was supported by the decisions in *Duncan &Ors v IBEB Pty Ltd & Anor,*[78] *De CostiSeafoods (Franchises) Pty Limited and Anor v Wachtenheim and Anor (No 3),*[79] and *Turano v Bartlett.*[80][81] Thus, expert evidence in patent litigation is not admissible unless the following requirements outlined by Heydon J are satisfied.

First, a party seeking to rely on expert evidence must present specific evidence as to a field of "specialised knowledge" of the "expert", which has been agreed or demonstrated in relation to the subject about which the opinion is expressed. There must be an identified aspect of that field in which the expert demonstrates "specialised knowledge" by reason of specified training, study or experience, through which the individual has become an expert.[82] Therefore, if a party is to rely on expert opinion evidence, he or she should ensure that the expert providing the evidence has the relevant and appropriate knowledge and qualifications to do so.

In *Abbott Laboratories v Corbridge Group Pty Ltd*,[83] Corbridge - the party seeking

75) Albert Monichino, 'Aspects of Expert Evidence: Briefing of Experts and Finalising the Report' (Paper presented at IAMA 'Expert Evidence Fundamentals: Tips and Traps' Seminar, Melbourne, 8 October 2012).
76) (2001) 52 NSWLR 705; [2001] NSWCA 305 at [85].
77) Robert McDougall, 'Some thoughts on calling expert evidence' [2009] *NSWJSchol* 18, 12.
78) [2010] NSWDC 275 (9 December 2010).
79) [2013] NSWDC 54 (3 May 2013).
80) [2014] NSWDC 32 (16 April 2014).
81) Penelope Wass SC, *Expert evidence since Makita - A District Court of NSW perspective* available at 〈http://www.salvoslegal.com.au/papers_march_2015/expert_evidence_since_makita_-_a_district_court_of_nsw_perspective.pdf〉.
82) Freckelton and Serby, above n1, 207.
83) [2002] FCAFC 314 at [70].

patent revocation[84] - carried the onus of proving obviousness (inventiveness)[85] by relying on the evidence of Professor Alexander regarding whether the claimed invention would have been obvious to the unimaginative and non-skilled technician equipped with the common general knowledge. In this case, Professor Alexander was a research scientist, rather than the required skilled but unimaginative non-inventive technician. His knowledge at the time did not represent the common general knowledge. Therefore, Corbridge failed to establish the relevant common general knowledge that is the baseline from which to judge the obviousness of the invention. Thus, the Full Federal Court refused to admit Professor Alexander's evidence as to the common general knowledge in the particular field because he was neither "unimaginative" nor "non-inventive".[86]

Second, the opinion evidence proffered by the expert must be "wholly or substantially based on the witness's expert knowledge".[87] This requirement presents difficulties in cases where the expert's opinion evidence is related to a question of mixed fact and law.

In *Minnesota Mining*,the Full Court expressed the view that whether a claimed invention is obvious, or did not involve an inventive step, involves questions of law or questions of mixed fact and law. An opinion on such matters will generally not be based solely on an expert's specialised knowledge: it will also be based on an understanding of patent law. The great majority of experts will, however, have little, if any, understanding of patent law and, consequently, expert evidence on such matters may not be admissible.

Third, it is important for experts to identify and admissibly prove the extent to which their opinion evidence is based on facts they have "observed". To the extent the opinion evidence is based on "assumed" or "accepted" facts, such expert evidence must be identified and also proved in another way. If the facts or assumptions relied on by the expert in providing his or her evidence fails to be identified or proved, the tendered expert evidence will be unreliable.[88]

In *Idoport Pty Ltd v National Australia Bank Ltd*,[89] Einstein J held that although the

84) Section 138(3)(b) of the *Patents Act 1990* (Cth).
85) Section 18(1)(b)(ii) of the *Patents Act 1990* (Cth).
86) Massey, above n9.
87) Freckelton and Serby, above n1, 207.
88) Freckelton and Serby, above n1, 208.

witness' evidence was admissible as expert evidence, it needed to be "very closely scrutinised indeed". This decision was based on the fact that an expert witness had an interest as partisan and partial. However, the court held that this is not a legitimate reason for the expert evidence to be deemed inadmissible.[90] In *Skanska Constructions UK Ltd v Egger (Barony) Ltd*,[91] an expert was engaged to provide a lengthy and sophisticated report that assessed a construction project. Since there had been time pressures upon the preparation of the report, it was mainly produced by the expert's employees. Thus, the expert himself did not adequately research and check the facts of the report. Consequently, the expert was entirely unfamiliar with the report's details of. In summary, the report was based on factual data provided by agents and employees of the expert, and it was not proved by separate evidence at the hearing of the matter. The court declined to accept the expert evidence on the basis that the data in the report was unreliable. The court also observed that unless the expert proves the facts upon which their opinion is based, expert opinion evidence will be worthless no matter how sophisticated the form in which it is provided.[92]

Fourth, it must be established that the facts on which the opinion evidence is based form a proper foundation for it, and the expert's evidence must explain how the field of "specialised knowledge" in which the witness is expert, and on which the opinion evidence is "wholly or substantially based", applies to the facts he or she has assumed or observed to produce the opinion evidence propounded.[93]

In *Maudsley v Proprietors of Strata Plan Number 39794*,[94] Powell J found that the plaintiff's expert failed to provide the court with the necessary scientific criteria on which his opinion was based and failed to test the validity of his asserted conclusions; consequently, the court was unable to understand the report. The New South Wales Court of Appeal also declared that the expert's evidence was inadmissible and upheld the decision of the trial judge that the appellant was unable to establish the expert opinion evidence. The court observed that the expert should provide the necessary

89) [1999] NSWSC 828 at [275].
90) Freckelton and Serby, above n1, 35.
91) [2004] EWHC 1748.
92) Allens, *Expert evidence: do not ignore the facts* available at 〈http://www.allens.com.au/pubs/const/focondec04.htm〉.
93) Freckelton and Serby, above n1, 207
94) [2002] NSWCA 244.

scientific criteria to identify the facts on which their opinion is based.[95]

While evidence will not be admissible when any of the requirements of Section 79 of the *Evidence Act 1995* (Cth) are not met, question remains whether admissibility or weight is to be decided. In *Sydneywide Distributors Ply Ud v Red Bull Australia Pty Ltd,*[96] Branson J advocated weight as a better critical factor in deciding whether to accept expert opinion evidence, and that detailed consideration of the admissibility of the evidence hinders the efficient flow of trials. Weinberg and Dowsett JJ in the same case stated that:

> It would be very rare indeed for a court at first instance to reach a decision as to whether tendered expert evidence satisfied all of [Heydon JA's] requirements before receiving it as evidence in the proceedings.[97]

Furthermore, it was said that many of the requirements in *Makita*, 'involve questions of degree, requiring the exercise of judgment'; hence, the weight of evidence should be considered rather than examining whether all of the statutory requirements for admissibility have been satisfied. Since the common law formulation does not exist in the legislation, the premise on which the admissibility of evidence is based remains of practical issue.[98] Further, Section 135 of the *Evidence Act 1995* (Cth) gives the courts a statutory discretion to exclude evidence if that evidence might be unfairly prejudicial to a party, be misleading or confusing, or cause or result in undue waste of time. In some circumstances, Section 135 may apply to expert evidence; accordingly, expert evidence may be inadmissible initially on the basis that the expert does not have the required expert knowledge, and subsequently as it falls within the court's general discretion to exclude.[99]

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95) Allens, *Understanding expert evidence* available at 〈http://www.allens.com.au/pubs/ldr/focljul03.htm〉.
96) [2002] FCAFC 157.
97) McDougall, above n77, 13-14.
98) New South Wales Young Lawyers Civil Litigation Committee, *The Practitioner's Guide to Civil Litigation* (The Law Society of New South Wales, 3rd ed, 2011) 211.
99) Sam Ricketson, 'The place of expert evidence in unfair competition cases: the Australian experience' in Andrew T. Kenyon et al. (eds), *The law of Reputation and Brands in Asia Pacific* (Cambridge University Press, 2010) 211.

4. Court's Control over the Expert Opinion

At common law, there is an exclusionary rule of expert evidence which prevents experts from being asked to give evidence on the ultimate issue in the dispute, such as assessing obviousness in patent litigation.[100] In *Joseph Crosfield& Sons Ltd v Techno-Chemical Laboratories Ltd*,[101] the court stated that 'The admission of the opinion of eminent experts upon the issues leads to the balance of opinions and tends to shift responsibility from the bench or the jury to the witness box'.[102] It appeared in *Lincoln v R Co*[103] that:

> Opinions, belief, deductions from facts, and such like, are matters which belong to the jury and by which they arrive at their verdict; when the examination extends to these and the judgment, belief, and inferences of a witness are inquired into as matters proper for the consideration of a jury, their province is in a measure usurped: the judgment of witness is substituted for that of the jury.

In *People v Collins*,[104] it was posited that 'expert testimony would "cast a spell" over jurors. Thus, experts were prohibited to give opinion evidence regarding the ultimate issues'.[105] The maintenance of the restriction of expert opinion on ultimate issues derives from concerns about the possible bias of experts and the courts' competence to evaluate expert witnesses and their testimony on subjects with which the courts are not familiar. Ultimately, the courts are responsible for determining important issues of fact and/or law. However, there were criticisms regarding the effect of this rule that experts would only be able to give the same evidence as is admissible from concerned lay witnesses.[106]

The Law Reform Commissions of Australia (1987, para 413) recommended the

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100) Caron Beaton-Wells, *Proof of Antitrust Markets in Australia* (The Federation Press, 2003) 303.
101) (1913) 29 TLR 378, 379.
102) Colin Tapper, *Cross and Tapper on Evidence* (Oxford University Press, 11th ed, 2007) 328.
103) 23 Wend 425 at 432 (1840), cited in McCord (1987, p 74, n 246).
104) 438 P 2d 33 (1968).
105) Freckelton and Serby, above n1, 148-149.
106) *Ibid.*

abolition of the ultimate issue rule; based on this recommendation, Section 80 of the *Evidence Act 1995* (Cth) was introduced to permit an expert to provide an opinion upon an ultimate issue.[107] In *Papakosmas v The Queen*,[108] McHugh J stated that 'reliability … is not a concern of relevance, a concept that is concerned with logic and experience, nor is any supposed "weaknesses of the piece of evidence"'. In Festa v The Queen,[109] Gleeson CJ stated that:

> If evidence is of some, albeit slight, probative value, then it is admissible unless some principle of exclusion comes into play to justify withholding it from a jury's consideration. It is not enough to say that it is "weak", and, as already mentioned, whether it is weak might depend on what use is made of it.[110]

The Australian Law Reform Commission (ALRC) confirmed that only a minimum correlation between the evidence and the facts in issue is required. Accordingly, it is sufficient that the evidence could make the fact in issue more or less probable.[111]

However, in *Makita (Australia) Pty Ltd v Sprowles*,[112] it was stated that 'although the jury must hearken to the opinion evidence, it is not obliged to take the opinion to contradict it'.[113] In *Minnesota Mining,* the court stated that there is a limitation in permitting an expert to give an opinion as to a fact in issue or an ultimate issue due to the fact that the ultimate issue in most cases will be related to a question of law anyway.[114] The Full Court's view in the case was that if experts are to give an opinion regarding the ultimate issue, they needed to have an understanding of patent law to satisfy the legal requirements of "obviousness for the purposes of patent law" regarding the claimed invention.[115] Most experts, as noted above, lack sufficient background knowledge to understand certain aspects of patent law. Thus, a court is

107) Freckelton and Serby, above n1, 153.
108) (1999) 196 CLR 297 at 321 [80].
109) (2001) 208 CLR 593 at 599 [14].
110) Bayne, above n23, 15.
111) Bayne, above n23, 14.
112) (2001) 52 NSWLR 705 at 745 [87].
113) Bayne, above n23, 296.
114) Massey, above n9.
115) Cameron and Marks , n67.

expected to admit little expert evidence regarding the ultimate issue or fact in issue of obviousness or inventiveness.[116)]

Therefore, an exercise of the court's residual discretion under Section 135 of the *Evidence Act 1995* (Cth) may still be applied to expert evidence. In addition, the weight given to such evidence will be determined at a later stage, when the court is able to conclude whether the remainder of the available evidence supports the expert's evidence.[117)] Section 135 requires the trial judge to assess the following matters:

> 1) whether the evidence adduced by a party creates a danger of being "unfairly prejudicial" to another party and, if so, the nature of that danger;
> 2) the probative value of the evidence; and
> 3) whether that probative value "substantially" outweighs the danger of the unfair prejudice to the other party'.

If the evidence in question fails to satisfy these admissibility criteria, the court must refuse to admit the expert evidence, even when it meets the abovementioned requirements of Sections 79 and 80 of the *Evidence Act 1995* (Cth).[118)] In *Cadbury Schweppes Pty Ltd v Darrell Lea Chocolate Shops Pty Ltd*,[119)] the Full Court of the Federal Court observed that:

> First it is necessary to consider the probative value of the opinion evidence in question. Next, it is necessary to assess the danger that the evidence might cause or result in undue waste of time. Finally, the section requires determination of whether the former substantially outweighs the latter.[120)]

Considering a wide range of issues in patent litigation, the courts can decide whether evidence tendered by a party is relevant.[121)]

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116) Massey, above n9.
117) McDougall, above n77, 22.
118) Bayne, above n23, 52.
119) (2007) 159 FCR 397; 239 ALR 662; [2007] FCAFC 70.
120) Freckelton and Serby, above n1, 218.
121) Bayne, above n23, 14.

V. Conclusion: Arbitration as an Alternative in Patent Dispute

Writing in 'Beyond the Adversarial System', former Federal Attorney-General Michael Lavarch commented:

> As part of the shift away from the adversarial system, some cases may be dealt with more efficiently by experts, who are not judges, albeit within the court system. Placing the control of proceedings in the hands of recognised and specially trained experts or specialists could potentially improve the effectiveness of the civil justice system.[122]

Lord Bingham has also made the following observations:

> Judges do not have the great advantage which advocates enjoying pupil of prolonged, informal discussion with experts so that the rudiments of the subject, starting if necessary from first principles, can be methodically and even laboriously explained. The constraints of presentation in court make this in practice very difficult, if not impossible, to achieve with the judge as a pupil, and even if achievable involves the parties at very great expense. In the small minority of cases in which problems of this kind arise, might it not be desirable for a judge to sit with the assistance of an expert assessor or for an independent expert to be appointed to assist the court.[123]

Thus, it is expected that the use of expert evidence will increase as not only the number of patent proceedings continues to increase, but also the technological complexity of these claims increase, and it will truly benefit parties in the current patent trial system. However, there remain unresolved issues to be clarified and settled; consequently, arbitration has been used as an alternative to the trial system.

Recently recognition of the growing importance of technologies in many industries

122) McClellan, above n68.
123) McClellan, above n68.

has contributed to companies relying heavily on the exclusive rights granted by patents. Thus, patent disputes frequently involve technically oriented corporations. After the pleading stage of the proceedings, parties are required to exchange documents which reveal the evidence on which each party will seek to rely. However, an issue of confidentiality may arise where the opposing parties' experts gain access to technical evidence. As noted in this paper, some courts have advocated the view that if the evidence adduced in court is exposed to the public, there may be a better chance of detecting any falseness.[124] Therefore, depending upon the stance of the presiding court, the problem of public scrutiny may be unavoidable in the course of litigation.

Concerns have been raised regarding the discovery process of litigation concerning the disclosure of confidential information to parties not involved in the dispute. Under Section 27E(2) of Australia's Commercial Arbitration Act ('CAA'), the disclosure of confidential information is expressly prohibited unless expressly allowed under certain exceptions.[125] Further, the protection of confidential information must be weighed against the public interest.[126] Since there are provisions in arbitration law regarding the arbitration tribunal's power to protect confidential information, arbitration can be a particularly useful means of protecting confidentiality in the course of dispute resolution.[127]

In the course of arbitration, the parties or the tribunal instructing an expert to deliver an opinion on specific issues or questions. The expert then prepares a written report to the parties or the tribunal containing an opinion on the issues specified in his or her instructions.[128]

During the discovery process in the proceeding, expert evidence is also exchanged by the parties. The court will only admit an expert's evidence if the expert agrees to observe the courts' code of conduct and if such observation is identified by the court. The main reason for an expert to be bound by the code of conduct is to generate an overriding duty to assist the court on matters relevant to the expert's area of expertise, and not to act as an advocate for a retaining party.

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124) Bannister, above n50, 172.

125) Commercial Arbitration Acts that had been passed in all states and territories collectively referred to as the CAAs are based on the UNCITRAL Model Law.

126) Doug Jones, *Arbitration Guide*: Australia, International Bar Association (March 2012) 10.

127) Mitchell Smith,'Mediation as an alternative to litigation in patent infringement disputes', (2009) 11(6) *ADR Bulletin* 115.

128) Jones, above n126, *above n* 12.

Arbitration laws and rules do not offer guidance on expert witnesses' ethical responsibilities to the arbitration tribunal. However, the 2010 revision of the International Bar Association (IBA) Rules on the Taking of Evidence in International Arbitration ('the IBA Rules') imposes on expert witnesses a duty to be independent of the parties, their legal advisors, and the Arbitral Tribunal.[129] Meanwhile, many experts' own professions have adopted codes of professional ethics that provide guidance to their members when serving as expert witnesses.[130] Hence, they are expected to remain independent and impartial, delivering their opinions to assist the tribunal to reach the right decision.

In general, arbitration tribunals appoint experts to obtain reports on specialised issues. Since this is not a mandatory provision, arbitration tribunals should not appoint experts besides those that may have been appointed by the parties.[131] Since the issues involved in patent litigation are becoming increasingly complicated and controversial, the Australian courts are increasingly relying upon a composite of experts in assessing technical issues to reduce disagreements. Currently, the courts are increasingly using concurrent expert ('hot-tubbing') in technical disputes. Hot-tubbing (or 'conferencing') refers to the process of taking evidence from witnesses in the presence of other witnesses and allowing them to question each other as to the accuracy of claims. Hot-tubbing is especially effective in highly technical disputes involving complicated factual and technical issues that need to be resolved.[132]

There are no guidelines or rules provided by arbitral institutions to facilitate hot-tubbing.[133] Nevertheless, hot-tubbing is increasingly being adopted by arbitration tribunals to resolve problems arising from traditional witness examination and cross-examination procedures. The guidance on the court's use of joint conferences of expert witnesses is equally applicable to arbitrations. A potential disadvantage of hot-tubbing with non-expert (i.e. lay) witnesses is the possibility that the evidence of one witness may affect that of another, especially if they are forced to confront each other. However, this not a concern with expert witnesses, as their opinions are less

129) Mark Kantor, 'A code of conduct for party-appointed experts in international arbitration, Can one be found?' (2010) 26(3) *Arbitration International* 323, 329.
130) Kantor, above n129, 374.
131) Jones, above n126,12.
132) Dough Jones, *Commercial Arbitration in Australia* (Lawbook Co., 2011) 373.
133) Jones, above n126, 13.

likely to be affected by those of their fellow experts.[134]

As detailed above, in *Makita (Australia) Pty Ltd v Sprowles*,[135] Heydon J provided several applicable requirements regarding the admissibility of expert evidence as an exception to the opinion rule. However, in *Minnesota Mining*, the abovementioned criteria were given a restrictive interpretation, permitting the courts to reject expert evidence if its probative value is substantially outweighed based on Section 135 of the *Evidence Act 1995* (Cth); consequently, the scope for expert opinion evidence in patent cases has been strictly limited.

Arbitration tribunals have discretion to determine the admissibility, relevance, and weight of evidence.[136] The IBA Rules provide factors to be taken into account by the tribunal when considering whether to exclude certain evidence.[137][138] Australian general evidence law provides that expert evidence may be inadmissible if the expert falls within the court's general discretion to exclude.[139] However, arbitration may broaden the admissibility of evidence by alleviating the parties' duty to abide by evidence law.

Due to the increased transparency in the litigation process, the court is unlikely to admit prejudiced evidence which is intended to lead the expert from those instructions. In patent dispute, court may need an expert's opinion on the ultimate issue in order to reach a fair decision. However, the exclusionary rule of expert evidence prevents

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134) Jones, above n132, 373-374..

135) (2001) 52 NSWLR 705; [2001] NSWCA 305 at [85].

136) Jones, above n126, 12.

137) Article 9.2 of the Rules provide as follows:

(a) lack of sufficient relevance or materiality;
(b) legal impediment or privilege under the legal or ethical rules determined by the Tribunal to be applicable;
(c) unreasonable burden to produce the requested evidence;
(d) loss or destruction of the document that has been reasonably shown to have occurred;
(e) grounds of commercial or technical confidentiality that the Tribunal determines to be compelling;
(f) grounds of special political or institutional sensitivity (including evidence that has been classified as secret by a government or a public international institution) that the Tribunal determines to be compelling;
(g) consideration of fairness or equality of the disputing parties that the Tribunal determines to be compelling; or
(h) failure to comply with the requirements for making a proper document request as set forth in the Document Production Order.

138) Jones, above n132, 372.

139) Ricketson, above n99, 211.

experts from being asked to opine on the ultimate question. In arbitrations, experts may be motivated to perform to the highest standards on some of the issues due to the lack of public disclosure. Further, the tribunal comprises members with high levels of qualification and experience. Therefore, less extensive cross-examination is expected in arbitration than in litigation to resolve a given dispute.[140]

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