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Using expert evidence on intellectual property: A practical perspective

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Abstract:

There have been many studies on the role and legal value of expert evidence in intellectual property (IP) disputes and infringement cases. In the case of IP dispute and infringement to be resolved in the courts, the duty of these experts is to provide professional opinions in a way that is completely impartial, independent, reasonable, and transparent. It can be said that in a majority of cases, reliance on expert evidence demonstrates the role of expert opinions in assisting IP enforcement authorities in reaching their final decision on the case although the authorities are not bound by such evidence. Based on global practices, this article attempts to answer some initial legal questions such as when does an expert opinion become evidence? Is expert evidence the product of legal expertise or technical expertise? Is the expert evidence an administrative decision, and under what circumstances can it be used?

Keywords: **expert, expert opinion, expert evidence, expertising conclusion, intellectual property.**

Classification number: **6**

1. Who is the expert?

In recent years there has been much discussion on issues related to expert evidence in the field of intellectual property (IP) such as: the role and independence of experts; form of expert evidence; and the legal value of expert evidence in IP dispute and infringement cases [1].

In terms of IP, the use of expert evidence is considered common in countries with civil law as well as case law systems such as Brazil, Germany, Israel, and the United States [2]. The role of experts and expert evidence is increasing in IP disputes, especially in countries that have established specialized courts for IP such as China, Japan, Portugal, Switzerland, and England [3, 4]. According to Ms. Justice Prathiba M. Singh, Delhi High Court (2021) [3], an expert is a person with specialized training, special skills, and working experience in a certain field. An expert recognized for having knowledge, skill, experience, training, or profession may give evidence in the form of expert opinions or otherwise if scientific, technical, or the expert's other specialized knowledge is capable of assisting the trier with facts in understanding the evidence or deciding the issue. If such evidence is based on complete data and facts, the product of reliable principles and methods can be applied to the facts of the case [4-6]. Therefore, the important issue in considering whether a person is recognized to provide an expert opinion is whether he or she fully meets the requirements for training, professional qualifications, experience, and is familiar with the related field. According to R. Manko (2019) [7], an expert is an independent person who has the necessary qualifications to be recognized by law.

According to J. Allsop (2005) [1], M. Matthew & C. Joyce (2022) [4] and Kenneth S. Cohen (2016) [8], the expert witness must be an objective party to the IP lawsuit and must not act as an advocate to interested parties. Any potential conflict of interest involving an expert that affects the objectivity of evidence must be reported to a court or dispute resolution authority, otherwise the probative value of the expert opinion will be unrecognized [9, 10]. In addition, expert evidence cannot be based on "subjective beliefs" or "unfounded conjecture" [6]. The role of the expert is to guide judges and juries on professional matters

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beyond their common understanding in an objective and impartial manner [9]. In patent-related cases, experts act as witnesses on technical aspects that require a high level of technical knowledge in the relevant technology area (such as knowledge, skills, experience, and approaches of a skilled person in the technical arts; technical conditions disclosed in the documents; characteristics of the allegedly infringing product; functions of the allegedly infringing production process...); or on legal aspects (such as interpretation of the scope of protection; assessment of novelty, inventiveness or other matters such as the nature of the product/process and technical elements analysis, opinions on infringement and patent validity in the context of prior art, or reasonable licensing fees in determining damage awards) [2, 3, 11, 12]. In trademark-related cases, experts can provide expert opinions on issues such as assessment of trademark reputation, consumer confusion, scope specification, and methods of conducting consumer surveys [3, 11, 13].

According to Kenneth S. Cohen (2016) [8], in some countries only experts recognized by the court under the prescribed legal procedure can give expert opinions. In Germany and Brazil, for example, only a court-appointed expert is considered the official source of expert evidence, while in the United States and Australia it can also be an expert appointed by the parties [2]. Expert opinions should be based on a high degree of scientific, technical, and professional certainty, as well as the training and experience of the expert. Therefore, the expert should use all known facts of the case or any information from his or her previous experience or study as the basis for forming an expert opinion. These experts may be assisted by invisible experts in preparing their opinions.

2. What is the expert evidence?

According to Kenneth S. Cohen (2016) [8], many different types of evidence exist. Evidence can be everything of what someone sees, hears, or smells; may be exhibits; and can also be someone's opinion.

Stemming from the civil nature of IP dispute and litigation, expert evidence is closely related to the application of the provisions on evidence of civil procedure law because, in essence, this type of evidence serves as a basis for drawing conclusions about a certain issue or event. The data and information on which expert evidence is based may include events observed by the expert himself or by others to the expert's direct personal knowledge; evidence that has been recorded or provided in the course of the case with facts presumed to be true for the expert; or facts or data that are not evidence but may be accepted as the basis for the preparation of expert opinion [2]. The purpose of expert evidence is to assist the court in understanding more about technical or other issues beyond the judge's knowledge and experience [4, 9, 11]. For example, in a patent dispute case, expert evidence is considered a type of extrinsic evidence, which plays a role in assisting the court in providing background understanding of a particular technology in the dispute, explaining the implementation of the invention, the technical aspects of the invention to the knowledge of a skilled person in the relevant art, or interpreting the terminology used in a patent description or cited prior art documents... [6]. Expert evidence should have a clear structure including hypothetical facts; the facts on which the expert's opinion is based (including experimental results or other people's data); scientific principles and methods; ways of making arguments and conclusions of experts on the subject matter; assumptions of the expert opinion due to incomplete data and information [1, 10, 13].

In accordance with the global legal system on IP, the expert evidence in IP dispute resolution and infringement cases can take many different forms. In many countries, the expert evidence can take the form of "expert testimonies" provided by experts with deep expertise in a particular scientific, technical, or professional field based on the application of reliable, scientific principles and methods, appointed by either the Court or chosen by the parties. With this form, the number of experts providing expert opinions is quite large and these experts can operate independently or in professional organizations. For the Court of Justice of the European Union (CJEU), experts can choose the form of their expert evidence (R. Manko, 2019 [7]).

3. The use of expert evidence

There have been many studies on the role and legal value of expert evidence in IP disputes and infringement cases. According to B. Picozzi (2015) [14], experts (like a solicitor general) are understood as those who provide expert opinions to the US Supreme Court (SCOTUS) in the majority of

cases (70%). These experts are usually people with competence, reputation, and expertise in the field of IP. In the case of IP dispute and infringement to be resolved in the Court (CJEU or the General Court), the task of these experts is to give professional opinions in a way that is completely impartial and independent, reasonable, transparent. Currently, in the EU, these professionals enjoy the same privileges as judges (immunity) and cannot be removed (retired from office) before the end of their six-year tenure (but can possibly be renewed). However, unlike judges, experts only have a professional advisory role and do not participate in the court's decision-making process in cases. Court opinions are given in the form of judgments, while expert opinions are based on a high degree of scientific or technical certainty or the expert's experience [8]. The basis of expert evidence is facts or anything from the expert's previous experience or study.

According to B. Picozzi (2015) [14], the SCOTUS relies on expert opinion in the majority (60-70%) of IP infringement cases. According to statistics of the CJEU, in the period 2015-2018, the number of expert opinions provided was as follows: 239 opinions (2015), 319 (2016), 301 (2017), and 305 (2018). R. Manko (2019) [7] believed that, in principle, in any case of IP dispute or infringement, the CJEU can appoint experts to provide expert evidence. Expert evidence in these cases play an important legal role although the Court is not bound by these opinions [9]. In recent years, the CJEU has tended to refer directly to the expert opinions of the particular issues as the basis for its ruling [7]. In the UK, the Patent County Court has the authority to decide whether or not to use expert evidence in a case and if so, how many experts each party is allowed to use (usually each party employs only one expert in one area of expertise)[1]. However, in Germany, expert evidence is used less commonly than in the UK or the US, accounting for only about 5-10% of patent-related cases [15]. However, increasing complexity and technical difficulty makes the role of expert evidence ever more important. In the United States, according to the Supreme Judicial Court (2019) [5], the magistrate judge has the power to decide whether or not the expert evidence supports trial decision making. In India, expert evidence is used in civil and criminal IP cases and is considered "secondary" evidence. In fact, the majority (67%) of cases resolved by the Court are based on expert analysis and assessment. According to D. Llewelyn (2013) [10], in recent years, the use of expert evidence in IP dispute and infringement cases in Singapore and the UK is also common. In Singapore, for example, courts often seek the assistance of an expert who provides expert opinion on scientific, technical, or another specialized area. It can be said that in all cases, the reliance on expert evidence and especially on survey evidence demonstrates the role of expert opinions in assisting the court in reaching a final decision on the case in an objective, fair, and reasonable manner. As mentioned above, although the Court is not bound by this evidence, in practice, expert opinions play an important role in the Court's decisions.

In some countries such as China and Japan[2], expert evidence can be provided by technical investigators or judicial research officials who are employees of the Court (as of 2019, the IP District Court of Beijing has 89 experts and the IP Court of Japan has 11 experts). These experts provide expert opinions on technical issues related to the disputes and reply to the judge's questions on such matters with their opinions being considered by the judge for decision making [15]. In the United States and Europe, expert evidence can be provided by an attorney general who is a member of the Court of Justice or the IP specialized court. Europe currently has about 10 experts who provide expert legal opinions to assist the Court in resolving the dispute, but not in assigning a judgment on the case [7][3]. Prosecutors should have appropriate knowledge and understanding of the content of the expert evidence provided and should be able to challenge the evidence [9].

Courts generally strive to ensure that expert

[1]At the first instance hearing, the content of a report provided by an expert of one party may be cross-checked by an expert of the other party, and this report is usually exchanged between the parties within a certain period (usually about 1-2 months before the first instance hearing) [11]. In the report, the expert should detail the documents and information used and the basis for giving the expert opinion.

[2]See more on https://www.ip.courts.go.jp/eng/documents/expert/index.html, https://www.managingip.com/article/b1kbm1qrw3v8cd/china-patent-china-builds-technical -patent-investigator-system.

[3]The time for expert opinion is usually about 3-4 months from the time the disputing parties argue before the court, but in complicated cases, the above-mentioned time can be much longer [7].

evidence is sufficiently reliable to be admissible and that expert opinions are relevant to the issues of the case. In the United States, under Rule 702 and Daubert in patent proceedings, the federal trial court must act as a "gatekeeper" in patent cases, specifically ensuring that any and all accepted expert evidence are not only relevant but also reliable. Expert evidence that does not meet those requirements cannot be admissible, whether or not the expert is a scientist [6]. According to Douglas G. Smith (2015) [6], reliability in expert opinions is required for all aspects of evidence: methods, data on which expert opinions are based, and relationships between facts and conclusions... Courts generally consider the following factors to determine the reliability of expert opinions: the extent and quality of the data used to base the expert opinion; validity and factual basis of the method used to form an opinion; reliability of the secondary data; and the adequacy of the information used to form an perceived expert opinion [9]. In IP cases, expert evidence may be challenged by the disputing parties, especially opinions on infringement of rights, interpretation of the scope of protection, and enablement of the inventions [6]. Even so, the parties have the right to cross-examine the other party's expert as well as object to the expert's evidence, and only when the expert of the other party is examined by a court are their opinions accepted as evidence [3].

4. Expert evidence in Vietnam: Some implications from practical perspectives

Expert evidence is used in many cases of IP rights disputes in Vietnam in the form of expertising conclusions. Expert conclusions are one source of evidence for competent agencies to settle the case and do not conclude on IP rights infringement activities or finally conclude on the dispute (Article 201.5 of the revised IP Law 2022). However, in practice, there are still misconceptions and confusion about the legal validity and use of this type of expert evidence. From this practice, there are some initial legal questions, such as when does an expert opinion become evidence? Is expert evidence the product of legal expertise or technical expertise, IP specialized expertise or judicial expertise? Is the expert evidence an administrative decision, and under what circumstances can it be used? Up to now, since the promulgation of the IP Law 2005 and its regulations, the above issues have not been uniformly recognized. There does not seem to be any study that directly discusses this topic.

First of all, according to the civil procedure law in Vietnam (Civil Procedure Code 2015), evidence in a civil case are factual things that are handed to Courts by involved parties, agencies, organizations, and individuals, or gathered by Courts and are used by Courts as bases to determine objective details of the cases as well as to determine whether the involved parties' claims or protests are well grounded and lawful or not (Article 93) with expertising conclusions considered as a source of evidence (Article 94). Expertising conclusions are considered evidence if such opinions are conducted in accordance with the procedures prescribed by law (Article 95). Thus, to be considered as evidence, the IP expertising conclusions must be: (i) true; (ii) lawfully provided or obtained; and (iii) related to the issue or event under consideration. Therefore, they can be used as a basis for conclusions about that issue or event. The competent agency to settle IP disputes and infringement cases has the right to decide on the evidence validity of the expertising conclusion, that is, the right to accept or refuse an expertising conclusion as evidence if it is found that the above requirements are not met. However, especially in civil or criminal procedures, experts are both procedural participants and judicial experts according to the case and IP expertising conclusions are not only expert evidence but also used by the Court as the basis to settle the case. In order to demonstrate the true nature of the case, the process of providing expert opinions needs to be accessible to objective facts and the reliability of this expert opinions depend mainly on the information or data provided by the interested parties, information on the legal status of the IP right in question, and information on market practices.

In Vietnam, few studies refer to the use of expert evidence as expertising conclusions on IP rights. For example, the project on IP Strategy to 2030 states that one of the most important supporting activities for the IP protection system are IP expertising conclusions. This is a service dedicated to providing "expert opinions" or "expert evidence" on issues related to the enforcement of IP rights including: determining the scope of protection of IP rights; determining the similarity between the alleged infringing object and the IP right protected object; identifying infringement upon a certain IP right; and determining the value of

damage caused by infringement of IP rights. Thus, in patent-related cases, the content of expert evidence is not purely about the technological aspects of the invention, but considers the legal aspects of the scope of protection as well as the analysis of infringement. In other words, in Vietnam expert evidence are the product of legal expertise and not technical expertise. The experts providing the expertising conclusions are not technical experts and their role is not to interpret the technical aspects of the invention.

The involved parties have the right to request the Court to solicit expert evidence or to request expertise by themselves. At the request of the involved parties or when deemed necessary, the judge shall issue a decision to solicit expertise (Article 102 of the Civil Procedure Code). Thus, IP expertising conclusions are provided at the request of one or more parties to an IP right dispute or as designated by an IP enforcement agency in order to serve the process of settling IP infringement cases. Statistics for the period 2009-2020 show that the demand for industrial property expertise services is increasing at an average of 15% per year and mainly from businesses and individuals, accounting for 87% of requests for expertising conclusions. During the period 2009-2021, about 7,500 cases of expertise were carried out of which 12.8% were solicited by the competent authorities, mainly by IP enforcement agencies (57.2% from inspection agencies, 49.9% from market management forces, and only 1.02% from courts). The majority of expertise requests are aimed at dealing with industrial property rights infringement (82%) and counterfeit goods (6.3%). According to the IP Vietnam (2017) [16], "the practice of industrial property expertising services as well as settlement of IP rights infringement shows that not all expertising conclusions requests are for the purpose of using these conclusions as a source of evidence for the settlement of industrial property rights disputes, but in many cases, it is the need to seek administrative conclusions to serve as a basis for issuing sanctioning decisions." In many cases, the expertising conclusion requests are also made on matters within the knowledge of the enforcement agencies. The report on 10 years of implementation of IP Law stated that, "there is inconsistent understanding of the legal validity of IP expertising conclusions provided by Vietnam Intellectual Property Research Institute - VIPRI," and "most enforcement agencies when dealing with IP rights infringement still have to rely heavily on the expert opinions." Meanwhile, practice shows that the understanding and application of legal principles on determining the scope of protection and analysis of rights infringement are inconsistent, leading to difficulties and confusion for IP enforcement agencies when making decisions on IP rights infringement.

In order to be recognized as an expert providing IP expert opinions, an individual must have a university degree or higher in a major relevant to the field of expertise, have professional activities in that field for at least five years, and satisfy the requirements of professional examination (Article 201.3 amended IP Law 2022). With such conditions, there are currently only four experts in the country recognized as IP experts providing expertising conclusions. According to the law on civil and criminal procedure, an expert witness is a person who has the necessary professional knowledge and experience as prescribed by law. In the field of IP, governmental agencies such as the Ministry of Science and Technology (MOST) and the People's Committees of provinces or cities can issue decisions to recognize case-by-case judicial experts, demonstrating that compared to the above-mentioned experts, these people have met the conditions of knowledge and experience but have not undergone any examination or requirements for the actual practice of professional activities. Currently, there are six case-by-case judicial experts under the management of the MOST[4]. This shows that in practice the conditions for becoming an IP expert who can provide expertising conclusions are higher than that of a judicial case-by-case expert, while the nature of providing expert opinions is the same and the role of the evidence and experts in IP judicial proceedings is even higher than that of ordinary IP dispute and infringement proceedings.

5. Conclusions

In summary, IP is a specialized field of expertise that is not only related to legal issues of IP rights but also to the application of knowledge, experience, and skills in technical and economic aspects. When there is a situation of conflict or dispute over IP rights, the resolution must be based on objective grounds

[4]See more on the Decision No. 1229/QD-BKHCN dated July 11, 2022 of the Minister of Science and Technology on the publication of the list of organizations and case-by-case judicial experts in science and technology activities under management authority of the Ministry of Science and Technology in 2022.

of the related issues. Practices in many countries around the world and in Vietnam in the past show that, for many IP dispute and infringement cases, the IP enforcement agencies and/or stakeholders tend to use expert opinions as evidence to determine grounds and draw conclusions on a certain issue. In the future, in order for IP expert opinions to become evidence in Vietnam, they need to effectively assist the settlement of IP disputes and infringements. Regulations on the implementation of the amended IP Law 2022 need to focus on clarifying the principles of determining the scope of protection and analysing the infringement of rights in a clear, consistent manner based on theoretical and practical aspects. At the same time, it is necessary to have appropriate conditions for the recognition of case-by-case judicial experts, ensuring that these conditions are not lower than those required for IP experts. The IP enforcement agencies and other parties involved in a dispute should also understand the evidential value of expert opinions to avoid misinterpreting such expert opinions as the result of administrative procedure as if they were the subjects of an administrative appeal. Whether to accept the evidential value of expert opinions depends on the discretion of the IP enforcement agency.

COMPETING INTERESTS

The author declares that there is no conflict of interest regarding the publication of this article.

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