

INTERNATIONAL JUDICIAL SYMPOSIUM ON INTELLECTUAL PROPERTY 2021:

USE OF EXPERT EVIDENCE IN CIVIL LITIGATION

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Expert Evidence: Role in Indian Legal System

- Used in both civil and criminal litigation.
- Opinion of expert treated as secondary, not primary evidence.
- Parties are permitted to file objections to expert's reports.
- An expert has to be examined in the Court. Only then, the expert's opinion is admissible as evidence.
- Experts can also be cross-examined by the parties to the litigation.

Expert Evidence: Role in Indian Legal System

Hot-Tubbing:



- Technique of hot-tubbing;
- Delhi High Court Rules incorporate the technique of hot-tubbing;
- Experts from each side are called;
- They are together given the questions;
- Pitted against each other;
- Answers are to be given before the Judge at the same time;
- So far, applicable only in commercial suits.

Micromax Informatics Ltd. v. Telefonaktiebolaget LM Ericsson

Guidelines prescribed for hot-tubbing procedure:

- Each side could call their principal lay witness, to be examined, cross-examined and re-examined.
- The respective experts would then be taken together.
- Experts prepare written reports which are exchanged and the experts are required to meet without the parties or their representatives to discuss those reports.
- Experts prepare a joint statement incorporating a summary of the matters upon which they agree, and identifying the matters upon which they disagree.
- Directed discussion on issues of disagreement.
- Questions may be asked during the discussion to test the expert's opinion.

Expert Evidence: Applicable Law

S. 45, Indian Evidence Act, 1872:

Reliance upon expert evidence in all civil cases

S. 115, Patents Act, 1970:

Reliance upon scientific advisor in cases involving patent infringement

S. 293, Criminal Procedure Code, 1973:

- Reliance upon reports of government scientific evidence in addition to examining such expert

When may be used? (Civil Litigation)

S. 45, Indian Evidence Act, 1872 (“Act”): When the Court has to form an opinion upon:

An issue of foreign law

An issue related to science or art

For handwriting or finger impressions



Types of Expert Evidence in Civil Litigation (S. 45, Indian Evidence Act, 1872)

- In suits relating to immovable property - use of expert engineers for the purpose of partition, revenue officials for the purpose of demarcation, etc.;
- In construction related, contractual disputes, experts can be relied upon by either of the parties to establish breach of a contractual condition, non-adherence to the required standards in the contract, etc.;
- In cyber related cases, experts are used by Courts to trace online violations;
- In testamentary jurisdictions experts are used for analysis of a Will;
- Handwriting experts are often used in various civil disputes;

Types of Expert Evidence in Civil Litigation (S. 45, Indian Evidence Act, 1872)

- Experts in the field of medicine can be called for by Courts, to examine the mental or physical condition of a person, in respect of whom, litigation for guardianship or otherwise may have been filed;
- Expert reports in respect of DNA can be called for by the Court;
- Ballistic experts;
- Opinion of experts can also be adduced to establish customs, usages and religious practices.

When may be used? (IPR Disputes)

- S. 115, Patents Act, 1970: Court may appoint an independent scientific adviser. Such adviser can assist the Court.
- Court can seek expert opinion after visiting a manufacturing facility to ascertain:

Nature of the product

Process/methods used

Raw materials and expedients

Opinion on infringement

Opinion on invalidity after comparing prior art



Who may be an expert? - Patents

- In Pharmaceutical patent cases, the witnesses who usually depose are:
 - Experts in bio-chemistry;
 - Doctors who treat patients in the relevant field; (*F. Hoffman la Roche Ltd.v. Cipla Ltd. (CS(OS) No. 89/2008, Delhi HC*)
 - Inventors themselves; (*Merck Sharp and Dohme Corporation and Anr.v. Glenmark Pharmaceuticals (CS(OS) No. 586/2013)*)
 - Persons involved in computation of damages.

Who may be an expert? - Patents

- In SEP Cases, the witnesses usually are;
 - Persons who can depose about the process of prescribing Standards;
 - Persons who can map Standards to the Patent claims;
 - Experts for analyzing the patents and mapping the Defendant's products to the claims, directly or indirectly;
 - Experts in the field of economics for analysing license agreements and giving opinion on FRAND rates;
 - Experts for fixing reasonable Royalty based on strength of patent portfolio and license commanded in the market.

Who may be an expert? - Patents

- In cases involving other technologies -
 - Persons familiar with regulatory procedures;
 - Persons who can analyse prior art documents and give an opinion on validity of patents;
 - Persons who can assist the Court on working related requirements;
 - Experts who can analyse manufacturing processes;
 - Experts with knowledge of the relevant industry - market share, segment of product, etc.

Who may be an expert? - Trademarks

- In trademark or disparagement related cases-
 - Advertising professionals;
 - Experts who may have conducted market surveys;
 - Experts for award of damages;
 - Experts who can analyse increase or reduction in market share.

Who may be an expert? - Copyright

- In copyright related cases, mostly experts would be required in the area of Compulsory licensing. Such experts would be those who can analyse license agreements, fixation of royalties payable etc.;
- In case of authorship or infringement disputes, experts could be produced from publishing industry, broadcasting industry, music industry, moral rights etc.

Who may be an expert?- Qualification

- S. 45 of the Indian Evidence Act, 1872 defines an expert as a person who is especially skilled in a given field.
- A person may have specialized educational qualifications or;
- Expertise arising out of experience due to working in a particular field;
- A person may be an expert even without possessing specialized educational qualifications, as long as experience is established - Delhi High Court in *Vringo Infrastructure Inc. and Anr. V. ZTE Corporation and ors. (FAO(OS) 369/2014, dated 13th August 2014)*

Who may be an expert? Vringo Infrastructure Inc. & Anr. v. ZTE Corp. & Ors. (Contd.)

- Plaintiffs claimed that they had been assigned a patent by Nokia in 2009 for a technology designed to make handover decisions in mobile phones, i.e. switching mobile towers' base station for better network connectivity, basis signals from base station controllers.
- Plaintiff claimed that the defendants had infringed this patent because the defendants were manufacturing, selling and importing equipment, such as base station controllers.
- To establish that their technology was being infringed upon by the Defendant, the Plaintiff had filed an affidavit by one Mr Regis J Bates.

Who may be an expert? Vringo Infrastructure Inc. & Anr. v. ZTE Corp. & Ors. (Contd.)

- Single Judge Decision: Observed that Mr Regis would not qualify as an “expert” due to lack of educational qualifications

“The reason for this is that before his opinion in the form of the present affidavit could be termed to be the opinion of an expert, he ought to have some basic degree in science or telecommunication or B.Tech engineering dealing in telecommunication and electronics and thereafter some research work having been conducted by him which would have qualified him to be an expert within the definition of Section 45 of the Patents Act, 1970

...

He has also not shown any special technical knowledge about the telecommunication or the technology in question and by simply stating that he has written books or research papers would not be good enough to term him an expert in the light of the fact that the opinion of an expert under Section 45 of the Evidence Act, 1872, is relevant.”

Who may be an expert? Vringo Infrastructure Inc. & Anr. v. ZTE Corp. & Ors. (Contd.)

- **Division Bench:** Observed that an educational qualification is not necessary for an expert

“It is accepted and recognized that a person could be an expert in an area of specialized knowledge by experience and he or she need not hold a degree in the field of specialized knowledge. A person can also become an expert by virtue of one’s avocation or occupation.”

Way Forward: Expert Evidence in IPR Disputes

- The Delhi High Court is in the process of finalizing its rules for the newly formed Intellectual Property Division. Rules specifically governing patent suits (“*Patent Rules*”) have already been put up for stake holders’ comments and both these provide for expert evidence.
- The Patent Rules contemplate the filing of the following documents:
 - claim construction briefs;
 - infringement briefs;
 - technical primers, wherein the role of experts is clearly recognized.

Way Forward: Expert Evidence in IPR Disputes

- The proposed Patent Rules as also the Rules pertaining to the IP Division contemplate creation of a **List of Experts** which the Court can maintain for assistance on a day-to-day basis.
- The Rules are yet to be notified. But the role of experts in IPR cases is likely to increase in the future, especially with the abolition of the Intellectual Property Appellate Board (“**IPAB**”) and all matters being transferred to the High Courts.

THANK YOU