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Consultants, experts help law firms develop their cases

by Olivia Clarke

William M. Risen Jr. may not be a lawyer, but he's had an important role in developing a number of legal cases.

Risen, a chemistry professor at Brown University, has used his scientific expertise for the past 25 years to help law firms research and analyze cases.

One of the first cases he assisted on was *Spalding v. Acushnet*, which he worked on beginning in 1981 with Allegretti, Newitt, Witcoff & McAndrews. When the case was tried in 1989, McAndrews, Held & Malloy, a split-off firm, handled it.

The case involved the materials used to make golf ball covers. Risen was brought on board because he understood the technical information and could analyze the testing. He also helped create an understanding about the relationship between the actual composition and the composition claimed in the patent. And he helped the judge and lawyers understand the parameters of the invention and the performance, as well as the chemistry involved.

Risen's camp, which represented Spalding, won the case and that victory led the company to sue other golf ball companies.

"[Risen] helped us with understanding the underlying technology way beyond the trademarks," said George McAndrews, who worked with John Held and George Newitt on the case. "He helped us understand the laboratory notebooks that were being reviewed.

"What he had the gift of doing was liberating the highly complex and technical information and bringing it down to our level, which was considerable," McAndrews said. "We were so pleased with Bill Risen's ability to bridge the gap with esoteric chemistry and the needs of a courtroom with his teaching experience and genius that we continued to use him thereafter as a consultant."

Lise Spacapan

Geoffrey Vance

Many economists, accountants, professors, scientists, and specialized advisers assist law firms on their cases. They may work behind the scenes helping lawyers with research or they may also testify in court. Some of these experts are on staff, while others are found through networking and research.

While this practice has been going on for some time, the use of non-lawyers has become more common with the rise of intellectual property firms and the growing need for outside help when complying with the new electronic discovery rules.

One lawyer said the growing popularity of crime and court shows means more juries expect to see experts testify. And with subjects like science and medicine becoming more complex, there is a growing need for assistance from experts who have spent their lives studying a particular speciality.

"Sometimes the area is so specialized that it needs someone who works in this area," Risen said. "It's an interesting challenge to figure out the technology and science that is in dispute between people with real expertise and figure out a way to get it right and translated into a form that people who are not specialists can understand."

Working with experts

Lawyers should use caution when working with experts, said William E. Meyer, Jr., a partner at Schiff Hardin. Lawyers must maintain a clear distinction between behind-the-scenes experts and testifying experts or they could get themselves in trouble, Meyer said. And these experts have taken on an important role in today's cases.

The work done by a behind-the-

scenes consultant is typically protected under the work-product privilege, Meyer said.

"A consultant can become a testifier, but that transition is one that you have to be very careful about," Meyer said. "Once you transform a consultant into a testifier, everything that has gone on before is discoverable. Your opponents have a right to know about every communication, every piece of information."

Meyer has seen opponents pay the price for not being careful enough in how they handle consultants who become testifying experts. He gives the example of a case where his opponent had a roundtable discussion with all his experts and one of the lawyer's key experts did not agree with an aspect of that party's case. But peer pressure forced the expert to change his opinion, he said.

It was learned during a deposition that the expert had flipped his opinion under peer pressure, he said. Ultimately, those facts became critical during the expert's cross-examination at the trial. And it became one of the reasons why his opponent lost the case, Meyer said.

"It's a dangerous game," Meyer said. "You have to be very careful how you handle testifying experts."

Testifying experts have critical roles because they must help juries and judges learn about the case, he said.

"So many cases end up being a battle of the experts," Meyer said. "They are critical and at the end of the day can be the difference between winning and losing cases."

A 1993 U.S. Supreme Court decision in *Daubert v. Merrell Dow Pharmaceuticals, Inc.* affected Rule 702 involving the admissibility of expert testimony at a trial, said Lise Spacapan, a partner and co-chair of the products liability and mass tort defense practice at Jenner & Block. The essence of the opinion is that federal court judges are to be the gatekeepers of the expert testimony presented in their courtrooms, Spacapan said.

Lawyers may now challenge on *Daubert* grounds the adequacy of the testimony of an expert before the jury is given an opportunity to hear the evidence, she said.

The Supreme Court clarified the rules and set up requirements that go beyond the expert possessing specialized knowledge and qualifications. These requirements include: he or she must give testimony based on sufficient facts; this testimony must be the product of reliable principles and methods; and the expert must take the principles and methods and actually apply them to the facts of the case, Spacapan said.

"It's a method of keeping junk science out of the courtroom and it is a wonderful rule, which is being broadly applied," she said. "What it means is that these experts, whether consulting or testifying, have even more prominence in this decade than in the last.

"This is not just seen in the area of science. It is expanding more and more to the areas of damages, engineering, and other areas of expert testimony."

Spacapan said she works regularly with a number of experts. If, for example, she handles a mass tort matter she might work with a neurologist, immunologist, epidemiologist, and a toxicologist on one case.

"I think my favorite part of practicing law, and one of the more challenging parts, is working with real scientific experts to understand what these medical causation issues are and simplifying it so they can be explained to a judge and jury," she said.

Kirkland & Ellis routinely uses testifying and non-testifying experts on certain cases, said Jonathan Bunge, a partner in litigation.

"Most big civil cases have experts involved," Bunge said. "Sometimes you need a testifying expert. You need that type of witness at a trial and your case wouldn't be complete without it. And as for consulting experts, it just helps sometimes to have somebody who has a lot of knowledge about the issues in the case because it might take years for someone to acquire that type of knowledge."

An analysis must be done to determine the benefits of these experts because they can be expensive, Bunge said. Some defendants may try to have a case dismissed at an early stage before money will have to be spent on experts, he said.

Geoffrey Vance, a partner at McDermott Will & Emery, said the Illinois Supreme Court Rule 213(f) helps make a distinction between the consultant who works behind the scenes and the testifying expert. This state addresses this distinction, while other states have not done that, Vance said.

According to Supreme Court Rule 213(f), a party must provide the identities and information about those experts who will be testifying at a trial, Vance said. But this rule does not include consulting experts who will not be providing trial testimony, he said.

"As a general rule, a party does not need to disclose the name or the opinions of a pure consulting expert, but does need to disclose the name and opinions of each retained testifying expert," Vance said.

Stephanie Scharf, partner and co-chair of the products liability and mass-tort defense practice at Jenner & Block, said she works with experts from many different areas of science and most are experts who are likely to testify. She used to find experts mainly through networking, but today also uses the Internet.

"My preference is still to network by calling colleagues and other experts to get their recommendations," Scharf said. "I have a bias toward university-based experts because I am looking for someone who is a good teacher as well as good at analysis."

Some challenges include working with experts who are not used to the litigation process, she said. This situation is typically much different from the scientific and medical world, where the cultural norm is to work in a collegial consensus.

"Sometimes the challenge is working with someone who has to take a stronger position, which is certainly warranted by the science, but that may go against the collegial culture found in medical centers and universities," she said. "The medical and science culture attempts to seek a common ground, but that is not the legal culture. And the goal is not to seek a consensus but to fully support your position."

Another challenge is that there are some experts who have made a career out of offering expert testimony, she said. A lawyer representing a defendant must make sure he or she thoroughly understands the expert's background and what mission the expert may have apart from scientific merit, she said.

"If you get to the testifying stage

you want to make sure they convey their technical story in a very non-technical way," said Anthony Ashley, a shareholder at Vedder, Price, Kaufman & Kammholz. "You may have a good expert who doesn't project well in the courtroom. One of your challenges is always to make sure your experts will convey the technical aspects of their testimony so that it is easily understood by the jury.

"They certainly help you understand the case at a much deeper level," he said. "It is very important as trial lawyers that you are one of the most knowledgeable people in the courtroom. Anytime you have an expert who understands the subject area very well, it is almost a teaching mechanism for the lawyer."

Handling electronic discovery

Several law firms said they see a growing need to work with non-lawyers on electronic discovery due to changes in the rules.

New Federal Rules of Civil Procedure provisions went into effect in December that detail electronic discovery obligations and protections for litigants whose computer-generated documents are requested by opposing parties.

The issue of electronic discovery is complicated right now, and there are vendors who routinely help search and produce electronic information during big cases, Bunge said.

Internally, Kirkland & Ellis also employs legal assistants who are knowledgeable about electronic discovery issues, he said.

Vance said McDermott Will & Emery has used outside help with electronic discovery. This outside help aids clients in how to preserve the right information, and how to collect, organize, manage, review, and ultimately produce it, Vance said.

But the firm recently increased its internal staff to help lawyers and clients deal with these electronic discovery issues, he said.

The firm's litigation technology department is comprised of 12 people nationwide, and has a full range of experts, such as an electronically stored information consultant, and technology project managers who help with all the technology throughout the case. There are also internal experts who train lawyers on how to use this technology in litigation.

"You can buy all the software you want, but unless you train the lawyers in how to use the software, the software is worthless," Vance said.

Thomas Wimbiscus

Ralph Gabric

"The electronically stored information consultant is our internal bridge to the technology gap and really the knowledge gap," he said. "We talk to clients to make sure, on both the legal and technical side, they are doing what they are supposed to do to preserve the right information."

Explaining intellectual property

Thomas Wimbiscus, a board member at McAndrews, Held & Malloy, said one of the first stops for finding an expert is within his law firm.

Almost all of the firm's 90 lawyers have a bachelor's, master's, or doctorate degree in one of the sciences. And some employees in the office are patent agents or advisers who assist on technological matters, Wimbiscus said.

The firm's patent agents, for example, work with lawyers to prosecute patents and they also play a supportive role. They are skilled and technically trained, and some of them have industry experience they also draw upon, he said. When the firm needs an outside consultant for a case, this person can be found by turning to the client, looking in academia or doing an overall search of the industry, he said.

"Hopefully [these experts] provide for a winning case," Wimbiscus said. "We want to do our homework. We are dealing with very complex subject matter."

Wimbiscus gave the example of a patent infringement case that he tried with McAndrews years ago. They obtained a judgment of $80 million, but it was reversed on appeal and remanded for retrial.

They used a handful of experts to attempt to prove infringement of their client's patent — which covered a process for making organoclay — and to prove the patent's validity, he said. Organoclays are used in the manufacture of inks, paints, coatings, and other goods to impart desirable physical properties, he said.

The firm worked with such experts as a university professor with industry experience on clay science, and an industry expert on laser light scanner equipment who could analyze and interpret the measurements.

The lawyers also worked with a university professor who confirmed that the sampling and measurements were statistically significant. A damages expert helped analyze and deal with such issues as lost profit damages, including price erosion, and reasonable royalty damages. And a patent law expert communicated patent issues and patent office procedures to the jury.

Finding the right experts "may take an ongoing search," he said. "Everyone who is well-degreed is not necessarily sufficiently or adequately experienced in a particular technology niche. It can be an involved search."

Brinks Hofer Gilson & Lione works with between 10 and 15 on-staff scientific advisers/patent agents, said Ralph Gabric, partner and chair of the client service committee.

These scientific advisers are not lawyers, but most have advanced degrees. They work on drafting patent

applications, and the prosecution of patent applications before the patent office. They will also assist on litigation that involves their areas of technical specialty, Gabric said.

Gabric, for example, may take a witness's deposition and need to cross-examine the person on a highly technical issue. He will sit down beforehand with a scientific adviser and get his or her input on where the technical weaknesses may be found.

"If you are going to be a full-service IP firm you really need to have these types of people," Gabric said. "From the litigation standpoint, the big challenge is to understand the technology and the subtleties of the technology. My job is to make the guy on the street understand it."

Brinks also has a proofreader with an English degree who studies briefs, client letters, and other documents to make sure they are grammatically correct, he said.

"I don't think we could operate without them," Gabric said about the various non-lawyers on staff. "The clients have come to rely on them. It streamlines the clients' business. It frees me up to do what I am supposed to do, which is being a lawyer."

Mindy Rittner, a scientific adviser and patent agent at Brinks, said she didn't even know a job like this existed until two years ago when she started with the firm. Rittner worked in the nanomaterials field for more than a decade prior to joining Brinks, initially as a scientist at Argonne National Laboratory and Northwestern University, and then as Director of Nanotechnology Research at BCC Research, Inc.

About 60 to 75 percent of her work is spent on patent preparation and prosecution, the rest involves being a scientific adviser.

She does much research and writing when putting together patent applications. An examiner looks at the application and usually sends it back with a rejection of the claims. She must then prepare arguments in response to the examiner and show why a patent is deserved.

"We come to a firm with very strong analytical skills," she said. "Before you can even send a draft of a patent application there is a lot of writing. It is important to have an ability to speak the language of inventors and scientists."

In her role as a scientific adviser, Rittner said she sits down with lawyers, and sometimes their clients, and uses her technological background to assist in preparing opinions and due diligence investigations.

When Banner & Witcoff starts working with experts early in a case, these experts typically help the lawyers make sure they are going in the right direction, said Janice V. Mitrius, a partner at the firm.

The practice of using consultants who do not testify is less frequent at her firm, Mitrius said.

Behind-the-scenes consultants are used, she said, "when you are trying to test out theories and determine what's the best type of testing to do in order to provide whatever elements of your case you need to prove."

Using outside resources

CRA International, which has been in business for about 40 years, works with U.S. and international firms, including such local firms as Banner & Witcoff. It provides both testifying experts and behind-the-scenes consultants, said vice president John Bone. The company offers in-house experts as well as experts outside of the company who are generally from academia.

The company, for example, could provide a damages expert who is allowed under a protective order to look at both parties' information to determine whether damages exist and, if they do exist, to quantify the extent of the damages. This is based on independent research and information produced as part of the litigation, Bone said.

A damages expert can do such things as assess lost profits, price erosion, and reasonable royalties. He or she can determine patent, trade secret, or copyright damages, he said.

"It allows the lawyers to put forth an independent third-party expert who can express an opinion on damages, and where the expert has access to all of the information," Bone said.

If these experts weren't available, a client would be forced to figure out the estimates of the damages based on incomplete information, he said. These experts know the case law and know which analysis is likely to withstand the test of trial, Bone said.

While each case is different, ideally, lawyers engage an expert shortly after the case is filed to work with them on identifying what information should be requested from the opposing party and the client, Bone said.

They may help in the preparation of questions and actually attend the depositions. The expert may prepare a report and may be deposed if he or she becomes a testifying expert, Bone said.

"They are most critical on the front end when they can work with lawyers and lay out what are going to be some of the key analyses that need to be done," said Philip Rowley, senior managing director at LECG.

LECG, which was started in 1988, also provides expert witness testimony and litigation support, Rowley said. The majority of its experts are in-house, but it also has a network of affiliates throughout the country who are oftentimes professors, he said.

While there are not certain areas that are more popular than others, he said certain issues might drive the number of requests for particular experts. This past year, for example, there was more talk about backdating of stock options, which required people with expertise in forensic computers and forensic discovery. The issues of antitrust, discrimination, and labor also required experts who could relate to these areas, he said.

He said law firms are "dealing with very complex issues and they are constantly looking for the absolute best experts — someone who has years of experience, and who has written or authored papers.

"The lawyers are very much sophisticated buyers," Rowley said. "They won't necessarily turn to one person and say, 'hey can you do this?' It is very much about trying to find the best person and that is dependent upon a variety of variables."★

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