BEHIND THE CURTAIN: TECHNICAL ADVISORS IN COMPLEX LITIGATION

Date: 2 June 2016

Antitrust, Competition & Trade Regulation Alert

By: Christopher S. Finnerty, Morgan T. Nickerson, Jason C. Weida

Complex litigation today often requires a working knowledge of intricate aspects of social and natural sciences. While a litigant can educate herself on the relevant science by retaining a consulting expert, the federal rules provide no such mechanism for the judge who will preside over, if not also decide, a complex technical dispute. What can a judge in such a case do to educate herself on the relevant science? An increasingly common answer is to appoint a technical advisor.

WHAT A TECHNICAL ADVISOR IS NOT

A technical advisor is not a court-appointed expert. Although appointed by the court, such experts are *witnesses* who may give testimony that is received as evidence and therefore are subject to specialized procedural rules.[1] For example, court-appointed expert witnesses must disclose their finding to the parties, may be deposed by any party, and may be cross-examined by any party (even the party that called the expert).[2] These rules ensure fundamental fairness in the presentment of evidence.

In contrast, the appointment of a technical advisor is not governed or authorized by any rule. The seminal authority for their appointment is the district court's inherent authority, first recognized by the Supreme Court almost a century ago.[3] Technical advisors function in some ways like a law clerk – serving the judge as "a sounding board . . . helping the jurist to educate himself in the jargon and theory disclosed by the testimony and to think through the critical technical problems."[4] They may not testify (without triggering the procedural requirements for court-appointed experts) or be deposed. And their communications with the court are entirely *ex parte*. The jury need not even know of their existence in a given case.

One of the first appointments of a technical advisor, in fact, was under the law clerk rubric. In 1950, Judge Charles E. Wyzanski (D. Mass.) appointed a Harvard economist to assist him in *United States v. United Shoe Machinery Corp.*, a complicated civil antitrust case against an alleged shoe monopolist.[5] Much like a law clerk, the economist communicated with the judge *ex parte*, observed the trial and at its conclusion submitted a memorandum that the parties were not permitted to inspect. *United Shoe* set an example that was followed by district courts until the courts of appeals established more defined procedures, described below.[6]

WHEN A TECHNICAL ADVISOR IS APPROPRIATE

A technical advisor is not appropriate in every case. In *Reilly v. United Sates*, a 1988 decision that was the first to address the question squarely at the appellate level, the First Circuit warned that technical advisors "should be reserved for truly extraordinary cases where the introduction of outside skills and expertise, not possessed by the judge, will hasten the just adjudication of a dispute."[7] Despite that caveat, the panel held that the dispute in

question — involving a complicated damages assessment in a medical malpractice case against the federal government — was a truly extraordinary case that warranted the district court's appointment of an economist as a technical advisor.

Although not subject to the same rules as court-appointed experts, technical advisors are subject to certain court-imposed procedural safeguards. For example, in the First Circuit, parties must be notified before the district court makes the appointment and be given an opportunity to object on grounds such as bias or inexperience.[8] A district court should preformulate a written "job description" for the advisor; and, when the appointment is over, the court should instruct the advisor to file an affidavit (but not an expert report) attesting to her compliance with it.[9]

Similarly, in 2002, the Federal Circuit — which hears patent appeals from all districts — suggested a "fair and open procedure for appointing a neutral technical advisor."[10] It advised courts to approach the issue by "addressing any allegations of bias, partiality or lack of qualifications in the candidates; clearly define and limit the technical advisor's duties, presumably in a writing disclosed to all parties; guard against extra-record information; and make explicit, perhaps through a report or record, the nature and content of the technical advisor's tutelage concerning the technology."[11] Two years later, the Ninth Circuit adopted a nearly identical set of safeguards.[12]

MORE COURTS ARE USING TECHNICAL ADVISORS

With the imprimatur of these appellate decisions, the use of technical advisors has increased. As foreshadowed long ago in *United Shoe*, district courts have appointed technical advisors in several recent antitrust and trade regulation cases.[13] For example, in an antitrust case challenging a company's efforts to prohibit merchants from steering consumers to other credit cards, a judge in the Eastern District of New York appointed an economist to "offer an independent assessment of conflicting economic models, [and] the economic value and effect of the proposed rule changes."[14] Similarly, in a class action against an alleged monopolist of football video games, a judge in the North District of California appointed an economist "based on the complexity of the economic issues and theories presented, especially related to injury and damages."[15] And, in an FTC false advertising action against a marketer of weight loss products, a judge in the Central District of California appointed a physician-nutritionist "to evaluate matters related to the science at issue, and to advise the Court with respect to his opinions related to the science."[16]

The use of technical advisors is not limited to any one category of cases. As one judge wrote, a technical advisor can be "extraordinarily helpful to any judge faced by complex technical litigation."[17] One dramatic example is intellectual property litigation.[18] Over the last decade, numerous technical advisors have been appointed in patent disputes in California,[19] Massachusetts,[20] Pennsylvania,[21] Texas,[22] and Washington.[23] The relatively large number of appointments in the Eastern District of Texas could be explained by the sheer volume of patent cases filed in that district and the growing preference of its judges for technical advisors in complex cases. As one practitioner commented, "if the court gets into an advanced area of technology, it will use technical advisors . . . . There will be a dialogue with the advisor and judge so that the judge can understand the technology."[24]

Another less pronounced but more recent example is environmental litigation. In 2013, Chief Judge William E. Smith (D.R.I.) appointed a chemist as his technical advisor in a Superfund case involving the fate and travel of

dioxin contamination.[25] The court reasoned that "the science involved in this case is of such a technical and intricate level, it believes that the introduction of outside skills and expertise . . . will hasten the just adjudication of the dispute without dislodging the delicate balance of the juristic role."[26] As contemplated in the appointment, the technical advisor remained involved when the case was tried to the bench in 2015.

CONCLUSION

The above cases are just illustrations of the rise of technical advisors in complex litigation. Any case that calls for scientific expertise may prompt a judge (or counsel) to suggest the appointment of a technical advisor. Early in the litigation, counsel should scrutinize whether the case is an appropriate candidate for such an appointment and be prepared to address the issue if and when it comes up. If a technical advisor is appropriate (or appointed regardless), counsel should ensure that the technical advisor's role complies with all procedural safeguards.

Notes:

[1] *See generally* Fed. R. Evid. 706.

[2] *Id*. 706(b).

[3] *See Ex parte Peterson*, 253 U.S. 300 (1920); *see also Gen. Elec. Co. v. Joiner*, 522 U.S. 136, 149 (1997) (Breyer J., concurring opinion) (endorsing the use of "specially trained law clerks" in "cases presenting significant science-related issues"

[4] *Reilly v. United States*, 863 F.2d 149, 158 (1st Cir. 1988.)

[5] *See* Carl Kaysen, In Memoriam: *Charles E. Wyzanski, Jr.*, 100 HARV. L. REV. 705, 713-16 (1987) (discussing *United States v. United Shoe Mach. Corp.*, 110 F. Supp. 295 (D. Mass. 1953)); Note, *Improving Judicial Gatekeeping: Technical Advisors and Scientific Evidence*, 110 HARV. L. REV. 941, 957 (1997) (same.)

[6] *E.g., Reilly v. United States*, 682 F. Supp. 150, 161 (D.R.I. 1988), *aff'd* 863 F.2d 149, 158 (1st Cir.) ("Within our own First Circuit, one court has provided an exemplary guide to the worth and vitality of this practice to courts of law. Judge Wyzanski of the United States District Court for the District of Massachusetts appointed a technical advisor to assist and advise him *in camera* during an especially complicated antitrust case.") (discussing *United Shoe*).

[7] *Reilly*, 863 F.2d at 156.

[8] *Id*. at 159.

[9] *Id*.

[10] *TechSearch L.L.C. v. Intel Corp*., 286 F.3d 1360, 1379 (Fed. Cir. 2002).

[11] *Id*.

[12] *F.T.C. v. Enforma Natural Products, Inc.*, 362 F.3d 1204, 1215 (9th Cir. 2004).

[13] Among antitrust practitioners, the normative benefit of technical advisors in antitrust litigation is unsettled. *Compare* Jonathan Tomlin and David Cooper, *Unprofessional Economic Testimony: Why It Is a Problem and How Technical Advisors Can Help*, 7 ECON. COMM. NEWSL. 12 (2007), *with* Lisa C. Wood, *Court-Appointed Independent Experts: A Litigator's Critique*, 21 ANTITRUST 91 (2007).

[14] *In re Am. Exp. Anti-Steering Rules Antitrust Litig.*, No. 11-MD-2221, 2015 WL 4645240, at *11 (E.D.N.Y. Aug. 4, 2015).

[15] *Pecover v. Elec. Arts, Inc.*, No. 08-2820, 2012 WL 1029531, at *2 (N.D. Cal. Mar. 26, 2012).

[16] *Fed. Trade Comm'n v. Enforma Nat. Products, Inc.*, 362 F.3d 1204, 1212-15 (9th Cir. 2004).

[17] *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 78 n.3 (D. Mass. 2001).

[18] *See generally* Joshua R. Nightingale, *And Empirical Study on the Use of Technical Advisors in Patent Cases*, 93 J. PAT. & TRADEMARK OFF. SOC'Y 400 (2011) (examining the rise of technical advisors in patent cases following the Federal Circuit's decision in *TechSearch L.L.C.*).

[19] *Software Rights Archive, LLC v. Facebook, Inc.*, 2013 BL 392571 (N.D. Cal. July 31, 2013).

[20] *Biogen Inc. v. Amgen, Inc.*, CA No. 95-10496-RGS (D. Mass. Dec. 10, 1996); *MediaCom Corp. v. Rates Tech., Inc.*, 4 F. Supp. 2d 17, 30 (D. Mass. 1998); *Amgen*, 126 F. Supp. 2d at 166.

[21] *Comcast Cable Commc'ns, LLC v. Sprint Commc'ns Co.*, 2014 BL 91662, 2 (E.D. Pa. Apr. 01, 2014).

[22] *Net Navigation Sys., LLC v. Extreme Networks, Inc.*, 2014 BL 301960, at *6 (E.D. Tex. Oct. 27, 2014); *Affinity Labs of Tex., LLC v. Samsung Elecs. Co.*, 968 F. Supp.2d 852, 859 (E.D. Tex. 2013); *Seoul Semiconductor Co. v. Nichia Corp.*, 596 F. Supp. 2d 1005, 1020 (E.D. Tex. 2009); *LG Electronics, Inc. v. Petters Group Worldwide, LLC*, 2009 BL 177036 (E.D. Tex. Aug. 19, 2009); *Ariba Inc. v. Emptoris, Inc.*, 2008 BL 165063, at *14 (E.D. Tex. Aug. 07, 2008); *Iovate Health Sciences, Inc. v. Bio-Engineered Supplements & Nutrition, Inc.*, 2008 BL 119338, at *6 (E.D. Tex. June 05, 2008).

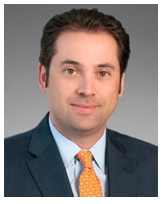
[23] *Telebuyer, LLC v. Amazon.com Inc.*, 2014 BL 291379, at *4 (W.D. Wash. Oct. 16, 2014); *Biomedino, LLC v. Water Techs. Corp.*, 2005 BL 76501 (W.D. Wash. Oct. 27, 2005).

[24] Daniel F. Perez and Sanford E. Warren, Jr., *The Eastern District Of Texas: A Magnet For Patent Litigation*, METROPOLITAN CORP. COUNSEL (Sept. 1, 2006) (Perez responding to editor's question).

[25] *Emhart Industries, Inc. v. New England Container Co. Inc.*, No. 06-218 (Doc. No. 324).

[26] *Id*. Order, Doc. No. 324, pg. 3.

KEY CONTACTS



CHRISTOPHER S. FINNERTY
PARTNER

BOSTON
+1.617.261.3123
CHRIS.FINNERTY@KLGATES.COM

MORGAN T. NICKERSON
PARTNER

BOSTON
+1.617.261.3134
MORGAN.NICKERSON@KLGATES.COM

