

Index

ACADEMIC BACKGROUND

- Copyright expert, **5:23**
- Trade secret experts, **4:13**

ADMISSIBILITY OF SURVEY EVIDENCE

- Trademark experts, **2:25**

ARBITRARY MARK

- Decision to use expert in trademark cases, **2:9**

ARBITRATION

- Decision to use expert in trade secret cases, **4:10**

ATTORNEY'S FEES

- Motions to compel award, **1:55**

ATTORNEY'S ROLE

- Disclosing expert witness under federal rules
 - motions to compel award of attorney's fees, **1:55**
 - rebuttal report preparation, **1:33**
 - written report preparation, **1:27**
- Trademark experts, survey evidence, **2:26**

BURDEN OF PROOF

- Disclosing expert witness under federal rules, Rule 37(c)(1) sanctions, **1:53**

CASES IN WHICH EXPERT HAS TESTIFIED

- Disclosing expert witness under federal rules, **1:25**

CHALLENGES TO IDENTIFYING EXPERT

- Copyright experts, **5:26**
- Patent experts
 - damages expert, **3:33**
 - legal expert, **3:29**
 - technical expert, **3:26**
- Trade secret experts, **4:15**

COMPENSATION

- Copyright expert, **5:30**
- Disclosing expert witness under federal rules, expert disclosures written report, **1:24**
- Patent expert, **3:41**
- Trademark expert, **2:38**
- Trade secret expert, **4:18**

CONSULTING EXPERT

- Patent experts, distinction between testifying expert and consulting expert, **3:12**

CONTENT

- Expert disclosures written report, **1:19-1:24**
- Initial disclosures, **1:7, 1:8**
- Patent expert report, **3:43**
- Pretrial disclosures, **1:36**

COPYRIGHT EXPERTS

- Generally, **5:1-5:38**
- Before trial use of expert, **5:13**
- Calling expert on copyright law, Pitfall Number 1, **5:2**
- Common challenges to identifying copyright expert, **5:26**
- Compensation, **5:30**
- Complex subject matter
 - absent, engaging expert on substantial similarity, Pitfall Number 2, **5:3**
 - present, failure to call expert on substantial similarity, Pitfall Number 3, **5:4**
- Cross examination
 - literary expert at trial, sample documents, **5:38**
 - mitigating, **5:22**
- Curriculum vitae
 - generally, **5:23**
 - engaging an expert with the wrong expertise, Pitfall Number 4, **5:5**
- Damages
 - determinations, **5:11**
 - report by damages expert, **5:35**
- Damages expert report, **5:35**
- Deposition of expert, **5:36**
- Direct examination of literary expert at trial, **5:37**
- Drafting the engagement letter
 - generally, **5:28**
 - particular issues to consider, **5:29**
- During trial use of expert, **5:14-5:22**
- Engagement letter
 - drafting, **5:28, 5:29**
 - sample document, copyright infringement actions, **5:32**

EXPERT WITNESSES: INTELLECTUAL PROPERTY CASES

COPYRIGHT EXPERTS—Cont'd

- Engaging an expert on substantial similarity when there is no complex subject matter, Pitfall Number 2, **5:3**
- Engaging an expert with the wrong expertise, or who uses unreliable principles or methodology, Pitfall Number 4, **5:5**
- Expert reports
 - issues to consider, **5:31**
 - liability-related expert reports, sample documents, **5:34**
- Failure to call expert when you need one
 - generally, Pitfall Number 5, **5:6**
 - substantial similarity expert, when there is complex subject matter, Pitfall Number 3, **5:4**
- Fair use decisions, **5:10**
- Federal rules, disclosing expert witness under, **1:1-1:58**
- Form of Disclosure** (this index)
- Foundation of trial, use of expert during, **5:20**
- Glossary of terms, **5:7**
- Hiring the expert
 - compensation, **5:30**
 - drafting the engagement letter
 - generally, **5:28**
 - particular issues to consider, **5:29**
 - Pitfall Number 1: Calling an expert on copyright law, **5:2**
 - Pitfall Number 2: Engaging an expert on substantial similarity when there is no complex subject matter, **5:3**
 - Pitfall Number 3: Failing to call an expert on substantial similarity when there is complex subject matter, **5:4**
 - Pitfall Number 4: Engaging an expert with the wrong expertise, or who uses unreliable principles or methodology, **5:5**
 - Pitfall Number 5: Failing to call an expert when you need one, **5:6**
 - timing considerations, **5:27**
- Identifying copyright expert
 - common challenges, **5:26**
 - curriculum vitae, **5:23**
 - locating the expert, **5:24**
 - qualifying at trial, **5:25**
- Infringement
 - decision to use expert, **5:9**
 - sample engagement letter in copyright infringement actions, **5:32**
- Initial Disclosures** (this index)
- Introduction of trial, use of expert, **5:16**

COPYRIGHT EXPERTS—Cont'd

- Liability-related expert reports, **5:34**
- Locating expert, **5:24**
- Mitigating cross-examination, use of expert, **5:22**
- Opinion, use of expert, **5:21**
- Pitfalls
 - Number 1: Calling an expert on copyright law, **5:2**
 - Number 2: Engaging an expert on substantial similarity when there is no complex subject matter, **5:3**
 - Number 3: Failing to call an expert on substantial similarity when there is complex subject matter, **5:4**
 - Number 4: Engaging an expert with the wrong expertise, or who uses unreliable principles or methodology, **5:5**
 - Number 5: Failing to call an expert when you need one, **5:6**
 - practice tip, **5:1-5:6**
- Pretrial Disclosures** (this index)
- Pretrial use of expert, **5:13**
- Preview of trial, use of expert, **5:17**
- Proffer, use of expert during, **5:19**
- Qualification, use of expert during, **5:18**
- Qualification of expert trial transcript, **5:33**
- Qualifying expert at trial, **5:25**
- Sample documents
 - cross examination of literary expert at trial, **5:38**
 - damages expert report, **5:35**
 - deposition of expert, **5:36**
 - direct examination of literary expert at trial, **5:37**
 - engagement letter in copyright infringement actions, **5:32**
 - liability-related expert reports, **5:34**
 - qualification of expert trial transcript, **5:33**
- Sanctions** (this index)
- Settlement negotiations, use of expert during, **5:14**
- Substantial similarity
 - engaging an expert on substantial similarity when there is no complex subject matter, Pitfall Number 2, **5:3**
 - failing to call an expert on substantial similarity when there is complex subject matter, Pitfall Number 3, **5:4**
- Supplemental Disclosures** (this index)
- Timing considerations in hiring, **5:27**
- Top five copyright expert witness pitfalls, **5:1-5:6**
- When to use expert in copyright cases
 - generally, **5:12**
 - before trial, **5:13**

INDEX

COPYRIGHT EXPERTS—Cont'd

- When to use expert in copyright cases—Cont'd
 - during trial, **5:14-5:22**
 - foundation, **5:20**
 - introduction of trial, **5:16**
 - mitigating cross-examination, **5:22**
 - opinion, **5:21**
 - preview, **5:17**
 - proffer, **5:19**
 - qualification, **5:18**
 - settlement negotiations, **5:14**
- Why use expert in copyright cases
 - generally, **5:8**
 - damages, **5:11**
 - fair use, **5:10**
 - infringement, **5:9**

COUNTERCLAIMS

- Anatomy of a typical patent litigation case, **3:4**

COUNTERFEITING

- Decision to use expert in trademark cases, **2:17**

COURTS

- International Trade Court cases, patent experts, **3:20**
- Patent experts, state court actions, **3:21**

CROSS EXAMINATION OF EXPERT AT TRIAL

- Copyright literary expert, sample documents, **5:38**
- Patent damages expert, sample documents, **3:50**
- Trademark/survey expert, sample documents, **2:44**
- Trade secret expert, sample documents, **4:26**

CURRICULUM VITAE

- Copyright expert, **5:23**
- Trade secret experts, **4:13**

DAMAGES

- Copyright experts
 - determinations, **5:11**
 - report by damages expert, **5:35**
- Expert. **Damages Expert** (this index)
- Trade secret experts
 - proving damages, **4:12**
 - report of damages expert, **4:23**

DAMAGES EXPERT

- Copyright, sample expert report, **5:35**
- Patent experts
 - generally, **3:30**
 - common challenges, **3:33**

DAMAGES EXPERT—Cont'd

- Patent experts—Cont'd
 - locating, **3:34**
- Trademark, sample expert report, **2:42**
- Trade secret, sample expert report, **4:23**

DEFENSES

- Anatomy of a typical patent litigation case, **3:4**

DEPOSITION OF EXPERT

- Copyright expert, sample documents, **5:36**
- Patents, legal expert, sample documents, **3:48**
- Trade secret expert, sample documents, **4:24**

DESCRIPTIVE MARK

- Decision to use expert in trademark cases, **2:7, 2:11**

DESIGN PATENTS

- Patent experts, **3:11**

DILUTION OF TRADEMARK

- Decision to use expert in trademark cases, **2:16**

DIRECT EXAMINATION OF EXPERT AT TRIAL

- Copyright literary expert, sample documents, **5:37**
- Trademark/survey expert, sample documents, **2:43**
- Trade secret expert, sample documents, **4:21, 4:25**

DISCLOSING EXPERT WITNESS UNDER FEDERAL RULES

- Generally, **1:1-1:58**
- Attorney's role in preparing written report, **1:27**
- Award of attorney's fees, motions to compel, **1:55**
- Checklist of issues to consider when disclosing experts under Rule 26(a), **1:1**
- Compensation, written report, **1:24**
- Complete statement of all opinions, **1:20**
- Content
 - expert disclosures written report, **1:19-1:24**
 - initial disclosures, **1:7, 1:8**
 - pretrial disclosures, **1:36**
- Correcting defects in original disclosure, **1:45**
- Data or other information considered by the witness, **1:21**
- Defects in original disclosure, correction, **1:45**
- Disclosures under state law, **1:4**
- Duty to supplement or correct, **1:43**
- Employee experts, **1:17**
- Exception, evidence used solely for impeachment, **1:6**

EXPERT WITNESSES: INTELLECTUAL PROPERTY CASES

DISCLOSING EXPERT WITNESS UNDER FEDERAL RULES—Cont'd

Expert disclosures
interplay between Rule 26(a)(2) and Federal Rules of Evidence
generally, **1:12**
disclosure of lay witnesses providing opinion testimony, **1:13**
objections to disclosure, **1:30**
rebuttal experts, below
timing of disclosure, **1:29**
to whom disclosures are made, **1:28**
written report
generally, **1:14, 1:19, 1:26**
attorney's role in preparing report, **1:27**
compensation to be paid, **1:24**
complete statement of all opinions, **1:20**
content of report, **1:19-1:24**
data or other information considered by the witness, **1:21**
employee experts, **1:17**
form of report, **1:26, 1:27**
"hybrid" witness, **1:18**
list of cases in which expert has testified, **1:25**
qualifications of the witness, **1:23**
retained or specially employed experts, **1:16**
summary or supporting exhibits, **1:22**
unretained experts, **1:15**
Federal Rules of Evidence. Expert disclosures, above
Filing of pretrial disclosures, **1:38**
Form
expert disclosures, written report, **1:26, 1:27**
initial disclosures, **1:9**
pretrial disclosures, **1:37**
"Hybrid" witness, written report, **1:18**
Initial disclosures
generally, **1:5-1:11**
content required
generally, **1:7**
availability of information, **1:8**
exception for evidence used solely for impeachment, **1:6**
form of disclosure, **1:9**
timing of disclosure, **1:10**
to whom disclosures are made, **1:11**
who must make disclosure, **1:5**
List of cases in which expert has testified, **1:25**

DISCLOSING EXPERT WITNESS UNDER FEDERAL RULES—Cont'd

Motion required for sanctions other than preclusion, **1:50**
Objections to disclosure, **1:30**
Objections to pretrial disclosure. Pretrial disclosures, above
Practice Tips, **1:1**
Pretrial disclosures
content of disclosure, **1:36**
form of disclosure, **1:37**
objections to pretrial disclosure
generally, **1:40**
failure to object, **1:42**
timing of objections, **1:41**
service and filing of disclosure, **1:38**
timing of disclosure, **1:39**
who must make disclosure, **1:35**
Qualifications, expert witness written report, **1:23**
Rebuttal experts
generally, **1:31**
attorney's role in preparing rebuttal report, **1:33**
disclosing testimony that responds to rebuttal report, **1:34**
rebuttal expert distinguished from initial expert, **1:32**
Recipients
expert disclosures, **1:28**
initial disclosures, **1:11**
Report. Expert disclosures, above
Retained or specially employed experts, **1:16**
Rule 37(c)(1) sanctions
generally, **1:48**
burden of proving exception applies, **1:53**
failure harmless, **1:52**
failure substantially justified, **1:51**
motion required for sanctions other than preclusion, **1:50**
"self-executing" feature, **1:49**
Sanctions
generally, **1:47**
appropriateness of sanction, **1:57**
award of attorney's fees, motions to compel, **1:55**
motions to compel, **1:54-1:56**
Rule 37(c)(1) sanctions, above
strategic considerations in seeking to remedy inadequate disclosures, **1:58**
"Self-executing" feature, Rule 37(c)(1) sanctions, **1:49**
Service of pretrial disclosures, **1:38**

INDEX

DISCLOSING EXPERT WITNESS UNDER FEDERAL RULES—Cont'd

- Specially employed experts, **1:16**
- Strategic considerations in seeking to remedy inadequate disclosures, **1:58**
- Summary or supporting exhibits, **1:22**
- Supplemental disclosures
 - correcting defects in original disclosure, **1:45**
 - duty to supplement or correct, **1:43**
 - supplemental disclosure distinguished from original disclosure, **1:44**
 - timing of disclosure, **1:46**
- Timing
 - expert disclosures, **1:29**
 - initial disclosures, **1:10**
 - pretrial disclosures, **1:39**
 - supplemental disclosures, **1:46**
- Types of disclosure required, **1:3**
- Unretained experts, **1:15**
- Who must make initial disclosures, **1:5**
- Who must make pretrial disclosures, **1:35**

DISCOVERY

- Patent experts, **3:15**

DUE DILIGENCE

- Patent Experts** (this index)

EMPLOYEE EXPERTS

- Disclosing expert witness under federal rules, **1:17**

ENGAGEMENT LETTERS

- Copyright Experts**, **5:32**
- Patent Experts** (this index)
- Trade Secret Experts** (this index)

EXCEPTION

- Disclosing expert witness under federal rules, evidence used solely for impeachment, **1:6**

EXPERT REPORTS

- Copyright Experts** (this index)
- Patent Experts** (this index)
- Trademark Experts** (this index)
- Trade Secret Experts** (this index)

FAIR USE

- Copyright experts, **5:10**

FANCIFUL MARK

- Decision to use expert in trademark cases, **2:10**

FEDERAL RULES OF EVIDENCE

- Expert disclosures. **Disclosing Expert Witness Under Federal Rules** (this index)

FORM OF DISCLOSURE

- Expert disclosures, written report, **1:26, 1:27**
- Initial disclosures, **1:9**
- Pretrial disclosures, **1:37**

GENERIC MARK

- Decision to use expert in trademark cases, **2:6**

GLOSSARY OF TERMS

- Copyright experts, **5:7**
- Patent experts, **3:2**
- Trademark experts, **2:2**
- Trade secret experts, **4:2**

HIRING THE EXPERT

- Copyright experts, **5:27-5:30**
- Patent experts, **3:36-3:42**
- Trademark experts, **2:35-2:38**
- Trade secret experts, **4:16-4:18**

“HYBRID” WITNESS

- Disclosing expert witness under federal rules, **1:18**

IDENTIFYING THE EXPERT

- Copyright experts
 - common challenges, **5:26**
 - curriculum vitae, **5:23**
 - locating the expert, **5:24**
 - qualifying at trial, **5:25**
- Patent experts
 - common challenges
 - damages experts, **3:33**
 - legal expert, **3:29**
 - technical expert, **3:26**
 - damages expert
 - generally, **3:30**
 - common challenges, **3:33**
 - locating, **3:34**
 - determination of reasonable royalty, **3:31**
 - legal expert
 - generally, **3:27**
 - common challenges, **3:29**
 - locating, **3:28**
 - locating
 - damages expert, **3:34**
 - legal expert, **3:28**
 - technical expert, **3:24**

EXPERT WITNESSES: INTELLECTUAL PROPERTY CASES

IDENTIFYING THE EXPERT—Cont'd

- Patent experts—Cont'd
 - other experts, **3:35**
 - recovery of lost profits, **3:32**
 - technical expert
 - generally, **3:22**
 - common challenges, **3:26**
 - locating, **3:24**
 - qualifications, **3:25**
 - sample cases, **3:23**
- Trade secret experts
 - common challenges, **4:15**
 - curriculum vitae, **4:13**
 - qualifying at trial, **4:14**

IMPEACHMENT

- Disclosing expert witness under federal rules, evidence used solely for impeachment, **1:6**

INFRINGEMENT

- Copyright experts, **5:9, 5:32**
- Trade dress infringement, **2:15**
- Trademark infringement, **2:13**

INITIAL DISCLOSURES

- Generally, **1:5-1:11**
- Content required
 - generally, **1:7**
 - availability of information, **1:8**
- Exception for evidence used solely for impeachment, **1:6**
- Form of disclosure, **1:9**
- Timing of disclosure, **1:10**
- To whom disclosures are made, **1:11**
- Who must make disclosure, **1:5**

INTERNATIONAL TRADE COURT CASES

- Patent experts, **3:20**

LIABILITY-RELATED EXPERT

- Copyright expert, report, **5:34**

LITERARY EXPERT

- Cross examination at trial, **5:38**
- Direct examination at trial, **5:37**

LOST PROFITS

- Patent experts, **3:32**

MARKET CONDITIONS, REPLICATION

- Trademark experts, survey evidence, **2:22**

MITIGATING CROSS-EXAMINATION

- Copyright experts, **5:22**

MONETARY RELIEF

- Decision to use expert in trademark cases
 - generally, **2:30**
 - additional reading, **2:31**

MOTIONS

- Award of attorney's fees, **1:55**
- Sanctions
 - award of attorney's fees, motions to compel, **1:55**
 - failure to comply with order, motions to compel, **1:56**
 - motions to compel disclosure, **1:54-1:56**
 - Rule 37(c)(1) sanctions, **1:50**

OBVIOUSNESS

- Patent experts, obviousness and *KSR International Co. v. Teleflex Inc.*, **3:6**

OPINIONS

- Copyright experts, **5:21**
- Disclosing expert witness under federal rules
 - disclosure of lay witnesses providing opinion testimony, **1:13**
 - written report, complete statement of all opinions, **1:20**

PATENT AND TRADEMARK OFFICE PROCEEDINGS

- Patent experts, **3:19**

PATENT EXPERTS

- Generally, **3:1-3:50**
- Anatomy of a typical patent litigation case
 - claim construction, **3:5**
 - claims, defenses, and counterclaims, **3:4**
 - obviousness and *KSR International Co. v. Teleflex Inc.*, **3:6**
- Claim construction in typical patent litigation case, **3:5**
- Claims, typical patent litigation case, **3:4**
- Common challenges
 - damages expert, **3:33**
 - legal expert, **3:29**
 - technical expert, **3:26**
- Compensation, **3:41**
- Conflicts in hiring, **3:38**
- Contents of the expert reports, **3:43**
- Costs in hiring, **3:40**
- Counterclaims, typical patent litigation case, **3:4**
- Cross examination of patent damages expert, **3:50**

INDEX

PATENT EXPERTS—Cont'd

- Damages expert
 - generally, **3:30**
 - common challenges, **3:33**
 - locating, **3:34**
- Defenses, typical patent litigation case, **3:4**
- Deposition of legal expert, **3:48**
- Design patents, **3:11**
- Determination of reasonable royalty, **3:31**
- Direct of patent damages expert, qualification of expert, **3:49**
- Discovery, **3:15**
- Distinction between testifying expert and consulting expert, **3:12**
- Drafts and drafting
 - engagement letter, **3:42**
 - expert reports, **3:44**
- Due diligence by defendant, **3:10**
- Due diligence by patentee
 - generally, **3:8**
 - Rule 11, **3:9**
- Due diligence in hiring, **3:37**
- During trial use of expert, **3:17**
- Engagement letter
 - drafting, **3:42**
 - sample engagement letter, **3:45**
- Expert reports
 - contents of the report, **3:43**
 - drafts, **3:44**
 - legal expert report, sample, **3:47**
 - technical expert report, sample, **3:46**
- Federal rules, disclosing expert witness under, **1:1-1:58**
- Form of Disclosure** (this index)
- Future of patent law, **3:13**
- Glossary of terms, **3:2**
- Hiring the expert
 - compensation, **3:41**
 - conflicts, **3:38**
 - costs, **3:40**
 - drafting the engagement letter, **3:42**
 - due diligence, **3:37**
 - interviewing potential expert candidates, **3:39**
 - timing considerations, **3:36**
- Identifying patent expert
 - challenges
 - damages experts, **3:33**
 - legal expert, **3:29**
 - technical expert, **3:26**

PATENT EXPERTS—Cont'd

- Identifying patent expert—Cont'd
 - damages expert, above
 - determination of reasonable royalty, **3:31**
 - legal expert, below
 - locating
 - damages expert, **3:34**
 - legal expert, **3:28**
 - technical expert, **3:24**
 - other experts, **3:35**
 - qualifications of the technical expert, **3:25**
 - recovery of lost profits, **3:32**
 - technical expert, below
- Initial Disclosures** (this index)
- International Trade Court cases, **3:20**
- Interviewing potential expert candidates, **3:39**
- Invalidation of patent based on violation of law or rules, **3:7**
- KSR International Co. v. Teleflex Inc.*, **3:6**
- Legal expert
 - generally, **3:27**
 - common challenges, **3:29**
 - locating, **3:28**
 - report, **3:47**
- Legal expert report, **3:47**
- Locating
 - damages expert, **3:34**
 - legal expert, **3:28**
 - technical expert, **3:24**
- Markman* hearing, **3:16**
- Obviousness and *KSR International Co. v. Teleflex Inc.*, **3:6**
- Other experts, **3:35**
- Other proceedings, **3:18**
- Patent and Trademark Office proceedings, **3:19**
- Practice Tips, top five patent expert witness pitfalls, **3:1**
- Pretrial Disclosures** (this index)
- Qualifications
 - direct examination of patent damages expert, **3:49**
 - technical expert, **3:25**
- Recovery of lost profits, **3:32**
- Sample cases, **3:23**
- Sample documents
 - cross examination of patent damages expert, **3:50**
 - deposition of legal expert, **3:48**
 - direct of patent damages expert, qualification of expert, **3:49**
 - expert witness engagement letter, **3:45**

EXPERT WITNESSES: INTELLECTUAL PROPERTY CASES

PATENT EXPERTS—Cont'd

Sample documents—Cont'd

legal expert report, **3:47**

technical expert report, **3:46**

Sanctions (this index)

State court actions, **3:21**

Supplemental Disclosures (this index)

Technical expert

generally, **3:22**

common challenges, **3:26**

locating, **3:24**

qualifications, **3:25**

report, **3:46**

sample cases, **3:23**

Technical expert report, **3:46**

Timing considerations in hiring expert, **3:36**

Top five patent expert witness pitfalls, **3:1**

Trial phase, use of expert during, **3:17**

When to use expert in patent cases

generally, **3:14**

discovery, **3:15**

during trial, **3:17**

International Trade Court cases, **3:20**

Markman hearing, **3:16**

other proceedings, **3:18**

Patent and Trademark Office proceedings, **3:19**

state court actions, **3:21**

Why use expert in patent cases

generally, **3:3**

anatomy of a typical patent litigation case

claim construction, **3:5**

claims, defenses, and counterclaims, **3:4**

obviousness and *KSR International Co. v. Teleflex Inc.*, **3:6**

design patents, **3:11**

distinction between testifying expert and consulting expert, **3:12**

due diligence by defendant, **3:10**

due diligence by patentee

generally, **3:8**

Rule 11, **3:9**

future of patent law, **3:13**

invalidation of patent based on violation of law or rules, **3:7**

PRETRIAL EXPERT WITNESS DISCLOSURES

Content of disclosure, **1:36**

Filing, **1:38**

PRETRIAL EXPERT WITNESS DISCLOSURES—Cont'd

Form of disclosure, **1:37**

Objections

generally, **1:40**

failure to object, **1:42**

timing of objections, **1:41**

Service and filing, **1:38**

Timing, **1:39**

Who must make disclosure, **1:35**

PRETRIAL PHASE

Copyright experts, use before trial, **5:13**

Disclosing expert witness under federal rules. **Pretrial Expert Witness Disclosures** (this index)

Trade secret experts, use before trial, **4:8**

PTO PROCEEDINGS

Patent experts, **3:19**

QUALIFICATIONS

Copyright experts

expert trial transcript, **5:33**

qualifying expert at trial, **5:25**

use of expert during qualifications, **5:18**

Curriculum Vitae (this index)

Disclosing expert witness under federal rules, **1:23**

Patent experts

damages expert, **3:49**

technical expert, **3:25**

Trademark experts

direct examination of trademark/survey expert, **2:43**

hiring trademark expert, **2:35**

Trade secret experts

direct examination, **4:21**

qualifying at trial, **4:14**

REASONABLE ROYALTY

Patent experts, **3:31**

REBUTTAL EXPERTS

Disclosing expert witness under federal rules

generally, **1:31**

attorney's role in preparing rebuttal report, **1:33**

disclosing testimony that responds to rebuttal report, **1:34**

rebuttal expert distinguished from initial expert, **1:32**

Initial expert distinguished, **1:32**

Trademarks, rebuttal survey expert report, sample document, **2:41**

INDEX

REBUTTAL REPORTS

- Attorney's role in preparing rebuttal report, **1:33**
- Disclosing testimony that responds to rebuttal report, **1:34**
- Sample trademark rebuttal survey expert report, **2:41**

RECOVERY OF LOST PROFITS

- Patent experts, **3:32**

REPORT BY EXPERT

- Copyright Experts** (this index)
- Patent Experts** (this index)
- Rebuttal Reports** (this index)
- Trademark Experts** (this index)
- Trade Secret Experts** (this index)

REPORT ON EXPERT DISCLOSURES

- Disclosing Expert Witness Under Federal Rules** (this index)

RESPONSES

- Disclosing expert witness under federal rules, testimony that responds to rebuttal report, **1:34**
- Trademark experts, responding to opponent's survey, **2:27**

RETAINING EXPERT

- Disclosing expert witness under federal rules, **1:15, 1:16**
- Hiring the Expert** (this index)
- Trademark experts, **2:37**

RULE 26(1)

- Checklist of issues to consider when disclosing experts under Rule 26(a), **1:1**

RULE 26(A)

- Interplay between Rule 26(a)(2) and Federal Rules of Evidence, **1:12, 1:13**

RULE 37(C)(1) SANCTIONS

- Generally, **1:48**
- Burden of proving exception applies, **1:53**
- Failure harmless, **1:52**
- Failure substantially justified, **1:51**
- Motion required for sanctions other than preclusion, **1:50**
- “Self-executing” feature, **1:49**

SANCTIONS

- Generally, **1:47**
- Appropriateness of sanction, **1:57**
- Award of attorney's fees, motions to compel, **1:55**
- Motions to compel, **1:54-1:56**

SANCTIONS—Cont'd

- Rule 37(c)(1) Sanctions** (this index)
- Strategic considerations in seeking to remedy inadequate disclosures, **1:58**

SECONDARY MEANING

- Decision to use expert in trademark cases, **2:11**

SPECTRUM OF DISTINCTIVENESS

- Decision to use expert in trademark cases, **2:5**

STATE COURTS

- Patent experts in state court actions, **3:21**

STATE LAW

- Disclosing expert witness, **1:4**

SUBSTANTIAL SIMILARITY

- Engaging expert on substantial similarity when there is no complex subject matter, Pitfall Number 2, **5:3**
- Failing to call expert on substantial similarity when there is complex subject matter, Pitfall Number 3, **5:4**

SUGGESTIVE MARK

- Decision to use expert in trademark cases, **2:8**

SUPPLEMENTAL DISCLOSURES

- Correcting defects in original disclosure, **1:45**
- Duty to supplement or correct, **1:43**
- Original disclosure distinguished, **1:44**
- Timing of disclosure, **1:46**

SURVEY EVIDENCE AND EXPERTS

- Trademark Experts** (this index)

TESTIFYING EXPERT

- Patent experts, distinction between testifying expert and consulting expert, **3:12**

TIMING

- Copyright experts, hiring, **5:27**
- Disclosing expert witness under federal rules
 - expert disclosures, **1:29**
 - initial disclosures, **1:10**
 - pretrial disclosures, **1:39**
 - supplemental disclosures, **1:46**
- Patent experts, hiring, **3:36**
- Trade secret experts, hiring, **4:16**

TRADEMARK EXPERTS

- Generally, **2:1-2:44**
- Additional reading, survey evidence, **2:29**
- Admissibility and weight, survey evidence, **2:25**

EXPERT WITNESSES: INTELLECTUAL PROPERTY CASES

TRADEMARK EXPERTS—Cont'd

- Arbitrary mark, **2:9**
- Attorney's role, survey evidence, **2:26**
- Cases analyzing survey evidence, **2:28**
- Common challenges, survey evidence, **2:24**
- Compensation, **2:38**
- Counterfeiting, **2:17**
- Courts' "gatekeeper" function, survey evidence, **2:19**
- Cross examination of trademark/survey expert, **2:44**
- Damages expert report, **2:42**
- Decision to use expert in trademark cases
 - generally, **2:3**
 - arbitrary mark, **2:9**
 - counterfeiting, **2:17**
 - descriptive mark, **2:7**
 - descriptive mark with secondary meaning, **2:11**
 - fanciful mark, **2:10**
 - generic mark, **2:6**
 - monetary relief
 - generally, **2:30**
 - additional reading, **2:31**
 - protectability of trademark, generally, **2:4**
 - secondary meaning acquired by descriptive mark, **2:11**
 - spectrum of trademark distinctiveness, **2:5**
 - suggestive mark, **2:8**
- Descriptive mark, **2:7, 2:11**
- Dilution of trademark, **2:16**
- Direct examination of trademark/survey expert, qualification of expert, **2:43**
- Exclusion of experts, **2:12**
- Expert reports
 - damages expert, sample documents, **2:42**
 - rebuttal survey expert report, sample document, **2:41**
 - survey expert report, sample documents, **2:40**
- Fanciful mark, **2:10**
- Federal rules, disclosing expert witness under, **1:1-1:58**
- Form of Disclosure** (this index)
- "Gatekeeper" function of courts, survey evidence, **2:19**
- Generic mark, **2:6**
- Glossary of terms, **2:2**
- Hiring trademark expert
 - expert's compensation, **2:38**
 - expert's qualifications, **2:35**
 - locating the trademark expert, **2:36**
 - retaining the trademark expert, **2:37**
- Infringement
 - trade dress infringement, **2:15**

TRADEMARK EXPERTS—Cont'd

- Infringement—Cont'd
 - trademark infringement, **2:13**
- Initial Disclosures** (this index)
- Locating the trademark expert, **2:36**
- Market conditions, replication, survey evidence, **2:22**
- Methodology of survey, survey evidence, **2:20-2:23**
- Monetary relief, use of expert
 - generally, **2:30**
 - additional reading, **2:31**
- Practice tips, Top Five trademark expert witness pitfalls, **2:1**
- Preliminary injunction, **2:33**
- Pretrial Disclosures** (this index)
- Protectability of trademark, generally, **2:4**
- Qualification of expert
 - direct examination of trademark/survey expert, **2:43**
 - hiring trademark expert, **2:35**
- Rebuttal survey expert report, **2:41**
- Replication of market conditions, survey evidence, **2:22**
- Responding to opponent's survey, survey evidence, **2:27**
- Retaining the trademark expert, **2:37**
- Sample documents
 - generally, **2:39**
 - cross examination of trademark/survey expert, **2:44**
 - damages expert report, **2:42**
 - direct examination of trademark/survey expert, qualification of expert, **2:43**
 - rebuttal survey expert report, **2:41**
 - survey expert report, **2:40**
- Sanctions** (this index)
- Secondary meaning acquired by descriptive mark, **2:11**
- Spectrum of trademark distinctiveness, **2:5**
- Suggestive mark, **2:8**
- Suggestive questions, survey evidence, **2:23**
- Summary judgment, **2:34**
- Supplemental Disclosures** (this index)
- Survey evidence, decision to use expert
 - generally, **2:18, 2:20**
 - additional reading, **2:29**
 - admissibility and weight, **2:25**
 - attorney's role, **2:26**
 - cases analyzing survey evidence, **2:28**
 - common challenges to survey evidence, **2:24**
 - courts' "gatekeeper" function, **2:19**
 - methodology of survey, **2:20-2:23**
 - replication of market conditions, **2:22**

INDEX

TRADEMARK EXPERTS—Cont'd

- Survey evidence, decision to use expert—Cont'd
 - responding to opponent's survey, **2:27**
 - universe of participants, **2:21**
 - use of suggestive questions, **2:23**
- Survey expert
 - cross examination, sample documents, **2:44**
 - direct examination, qualification, sample documents, **2:43**
 - expert report, sample documents, **2:40**
 - rebuttal survey expert report, sample documents, **2:41**
- Survey expert report, **2:40**
- Top Five trademark expert witness pitfalls, **2:1**
- Trade dress infringement, **2:15**
- Trademark dilution, **2:16**
- Trademark infringement, **2:13**
- Unfair competition, **2:14**
- Universe of participants, survey evidence, **2:21**
- Use of suggestive questions, survey evidence, **2:23**
- When to use expert in trademark cases
 - generally, **2:32**
 - preliminary injunction, **2:33**
 - summary judgment, **2:34**
- Why use expert in trademark cases
 - exclusion of experts, **2:12**
 - survey evidence, above
 - trade dress infringement, **2:15**
 - trademark dilution, **2:16**
 - trademark infringement, **2:13**
 - unfair competition, **2:14**

TRADE SECRET EXPERTS

- Generally, **4:1-4:26**
- Arbitration proceedings, **4:10**
- Before trial use of expert, **4:8**
- Common challenges in identifying trade secret expert, **4:15**
- Compensation, **4:18**
- Cross examination of expert at trial, sample documents, **4:26**
- Curriculum vitae, **4:13**
- Damages
 - proving damages, **4:12**
 - report of damages expert, **4:23**
- Damages expert report, **4:23**
- Deposition of expert, **4:24**
- Direct examination of expert
 - at trial, **4:25**

TRADE SECRET EXPERTS—Cont'd

- Direct examination of expert—Cont'd
 - qualification of expert, **4:21**
- Drafting the engagement letter, **4:17**
- During trial use of expert, **4:11**
- Economic value in keeping a trade secret, **4:4**
- Engagement letter
 - drafting, **4:17**
 - sample engagement letter, **4:20**
- Expert reports
 - damages expert report, **4:23**
 - issues to consider, **4:19**
 - sample documents, **4:22**
- Federal rules, disclosing expert witness under, **1:1-1:58**
- Form of Disclosure** (this index)
- Glossary of terms, **4:2**
- Hiring expert
 - compensation, **4:18**
 - drafting the engagement letter, **4:17**
 - timing considerations, **4:16**
- Identifying expert
 - common challenges, **4:15**
 - curriculum vitae, **4:13**
 - qualifying at trial, **4:14**
- Initial Disclosures** (this index)
- Misappropriation, **4:6**
- Practice Tips, top five trade secret expert witness pitfalls, **4:1**
- Pretrial Disclosures** (this index)
- Proving damages, **4:12**
- Qualifying at trial, **4:14**
- Reasonableness of efforts to maintain secrecy, **4:5**
- Sample documents
 - damages expert report, **4:23**
 - deposition of expert, **4:24**
 - direct examination of expert, qualification of expert, **4:21**
 - direct examination of expert at trial, **4:25**
 - expert report, **4:22**
 - expert witness engagement letter, **4:20**
- Sanctions** (this index)
- Settlement negotiations, **4:9**
- Supplemental Disclosures** (this index)
- Timing considerations, **4:16**
- Top five trade secret expert witness pitfalls, **4:1**
- When to use expert in trade secret cases
 - generally, **4:7**
 - arbitration proceedings, **4:10**

EXPERT WITNESSES: INTELLECTUAL PROPERTY CASES

TRADE SECRET EXPERTS—Cont'd

When to use expert in trade secret cases—Cont'd
before trial, **4:8**

during trial, **4:11**

proving damages, **4:12**

settlement negotiations, **4:9**

Why use expert in trade secret cases

generally, **4:3**

economic value in keeping a trade secret, **4:4**

misappropriation, **4:6**

reasonableness of efforts to maintain secrecy, **4:5**

TRANSCRIPT

Copyright expert, qualification of expert trial transcript,
5:33

TRIAL PHASE

Copyright experts, use during trial, **5:14-5:22**

Cross Examination of Expert at Trial (this index)

Direct Examination of Expert at Trial (this index)

Patent experts, use during trial, **3:17**

Qualifying at trial

copyright experts, **5:25**

trade secret experts, **4:14**

Trade secret experts, use during trial, **4:11**

UNFAIR COMPETITION

Decision to use trademark expert, **2:14**

WEIGHT OF SURVEY EVIDENCE

Trademark experts, **2:25**