



Alerts

Experienced Patent Lawyer Unqualified to Testify Regarding Standard of Care and Causation

February 15, 2011

Lawyers for the Profession® Alert

Byrne v. Wood, Herron & Evans, LLP, et al., 2010 WL 3394678 (E.D. Ky. 2010)

Brief Summary

The U.S. District Court for the Eastern District of Kentucky granted summary judgment in a legal malpractice action arising out of underlying patent litigation against a manufacturer. The court held that plaintiff's proposed expert testimony was insufficient to support the legal malpractice elements of breach and causation where the proposed expert did not have the necessary qualifications in the art of string trimmers, and plaintiff failed to show that he was personally qualified as an expert by knowledge, skill, experience, training or education.

Complete Summary

Plaintiff retained defendant law firm and its attorneys to prosecute a patent application for his invention, which was a weed trimmer equipped with a stabilizing guide for the string, which converted the weed trimmer into something that could be used as an edger. In May 1992, plaintiff received U.S. Patent No. 5,115,870 (the '870 patent). In December 1992, however, defendants filed a re-issue application because of errors in the '870 patent that resulted in a failure to claim the full scope of the patent rights. In January 1995, U.S. Letters Reissue Patent No. 34,815 (the '815 patent) was issued to plaintiff. It contained the term "generally planar flail stabilizing surface" in every re-issue claim.

In 2004, defendants filed a patent infringement action against the manufacturer on plaintiff's behalf alleging infringement of the '815 patent. The issue in that case was whether the wire edge guide on the manufacturer's trimmers included a "generally planar surface." Relying on the dictionary definition of the term "surface," the district court determined that the manufacturer's wire edge guide did not have a "surface" so as to bring it within the claimed limitations of the '815 patent, and summary judgment was granted in favor of the manufacturer.

Plaintiff appealed. The U.S. Court of Appeals for the Federal Circuit affirmed the grant of summary judgment. The court found that the "surface" of the manufacturer's wire edge guide was not "generally planar," and thus held that the manufacturer's device did not infringe the '815 patent.

Plaintiff then filed his legal malpractice action, alleging that defendants were

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negligent in the patent application/reapplication process by including the term "generally planar" in the '815 patent claims. Plaintiff alleged that defendants should have pursued his hypothetical claim, which did not include this term. Plaintiff asserted the hypothetical claim would have been patentable over the prior art (i.e., the Bartholomew patent).

Defendants argued that inclusion of the term "generally planar" was necessary in order for plaintiff's invention to be patentable in light of the Bartholomew patent. Defendants argued that plaintiff could therefore not prevail on the legal malpractice claim. In opposition to defendants' summary judgment motion, plaintiff presented his affidavit and an affidavit of his proposed expert witness, a patent attorney. Defendants then filed motions to strike significant portions of the affidavits.

The district court noted that in legal malpractice actions, in order to prove breach, the plaintiff must provide expert testimony to establish that the defendant violated the standard of care, unless the negligence is so apparent that a lay person with general knowledge would have no difficulty recognizing it.

The district court previously found that plaintiff's expert was not qualified to testify as an expert regarding the standard of care in the patent application process. Thereafter, plaintiff moved to supplement with a second affidavit of the expert that further explained his claimed qualifications. After considering both affidavits, the court found that the expert was qualified to offer expert testimony regarding the standard of care applicable to patent attorneys in the patent application process. But the court concluded that the expert was not qualified to offer technical opinions as to plaintiff's patent.

Plaintiff acknowledged that his expert was not skilled in the art of string trimmers, the technical art at issue. But plaintiff claimed that his expert relied upon plaintiff's affidavit and that plaintiff was skilled in the art of string trimmers. The court held that plaintiff was not qualified as an expert on string trimmers, and portions of his expert's affidavit (which relied on plaintiff's affidavit on technical matters) was stricken. Further, the court held that the expert could not opine as to what the patent examiner would have done or was thinking.

The court then considered the causation element of the legal malpractice claim. When considering the "suit within a suit," the plaintiff must show that he would more likely have prevailed in the underlying action but for the defendants' alleged negligence. The court determined that "[plaintiff] must show that his infringement suit against [the manufacturer] would more likely been successful had the defendants not included the 'generally planar' language in the '815 patent and instead pursued and obtained his hypothetical claim."

The court then reviewed plaintiff's affidavit to determine whether it was sufficient to support the causation element. Plaintiff's affidavit provided no information upon which the court could conclude he was qualified to testify as an expert. Plaintiff had a bachelor of science degree in an unspecified area of study, and he had experience "operating a landscaping company that maintained the lawns of apartment complexes and condominiums." These qualifications alone did not provide enough support to qualify him as an expert in the technical aspects of string trimmers. Plaintiff thus failed to show he was qualified as an expert by knowledge, skill, experience, training or education and he could not testify concerning the causation element of his legal malpractice claim.

Based on the foregoing, the court granted defendants' motion to strike portions of plaintiff's affidavit and portions of his expert's affidavit. It also granted summary judgment in favor of defendants.

Significance of Opinion

This decision underscores the importance of retaining qualified experts on the standard of care of the particular attorney/defendant, along with qualified expert(s) on the underlying subject matter as well (if necessary).

For more information, please contact [Terrence P. McAvoy](#).

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