ALLEN & OVERY

Expert Evidence in patent cases: recent guidance from the Bench

As Lord Justice Arnold highlighted in one of his last judgments as a trial judge, the Patents Court "*depends on the assistance it receives from expert witnesses*".

Last year, there was a flurry of decisions regarding the practical aspects of expert evidence in patent cases. These decisions afford a most welcome opportunity to review this aspect of patent litigation. In these cases, various judges of the Patents Court provide guidance on the preparation of expert evidence and once again highlight the role of experts and of those instructing them. These aspects are discussed below, drawing upon examples from the judgments of Lord Justice Arnold in *FibroGen v Akebia*[1], Mr Justice Meade in *MSD v Wyeth*[2] and *Fisher & Paykel v Flexicare*[3] and Mr Justice Marcus Smith in *Neurim v Mylan*[4].

01_[2020] EWHC 866 (Pat)
02_[2020] EWHC 2636 (Pat)
03_[2020] EWHC 3282 (Pat)
04_[2020] EWHC 3270 (Pat)

Preparation of expert evidence

A common theme expressed throughout these judgments is the level of care required in preparing expert evidence. The task of preparing expert evidence is a demanding one and it is incumbent on the expert to present evidence that is technically correct and accurately reflects their opinion. In *Neurim v Mylan*, Marcus Smith J was heavily critical of one of the experts; he considered the expert's reports to be "*disingenuous documents, written in a manner that seemed to me calculated, not to assist, but to mislead, the court*". That is a stark reminder of the expert's duty to assist the court by providing their objective and unbiased opinions.

The risk of hindsight

Of particular note is the reminder of trying to avoid, or at least reduce, hindsight. Practitioners are all too aware of the importance in minimising the risk of the expert being tainted by knowledge of the invention, since such knowledge can unfortunately lead to their evidence being undermined.

For this reason, the practice of instructing expert witnesses to deal with issues in sequence – first asking them about the common general knowledge; then showing them the prior art, and asking what steps would be obvious to take in light of it; and only then showing them the patent – has been well established over the years. Ultimately, it protects the expert's credibility. Arnold LJ reiterated the advantage of such practice in his judgment in *FibroGen v Akebia*, where he explained that this procedure is known as "sequential unmasking" in the psychological literature, and referred to the following book in this context: *Blinding as a Solution to Bias*, edited by C.T. Robertson and A.S. Kesselheim.

Whilst it is desirable to instruct experts in sequence, sometimes there are practical problems in doing so. In Arnold LJ's judgment in *FibroGen v Akebia*, he refers to the obvious example of discussing the common general knowledge (the 'CGK'), which must start by identifying the skilled person or team. That can only be done by reference to the patent, which begs the question: how can such a discussion on the CGK ensue without showing the expert the patent? As Arnold LJ explains, one solution is to ask the expert to make an assumption, which they can then confirm later once they see the patent. This may be particularly useful in cases where a patent is addressed to a skilled person who is working as part of a wider team, and the skilled person is reliant on gaining certain knowledge from another member of that team, so that they can be in a position to provide their expertise in implementing the invention.

Another obvious example is the expert's prior knowledge of the patent. Despite this, and as Meade J explains in *Fisher & Paykel v Flexicare*, there may still be value in showing the documents in sequence in order to focus the expert's mind on avoiding hindsight. However, as Meade J highlights: "*the opportunity to give a completely untainted view of the prior art does not exist; the expert has to discipline themself carefully to avoid hindsight*". Meade J goes on to state that in situations where an expert is already aware of the invention, then it is important for the expert to disclose this and explain how and when they knew about the invention. In addition, the expert should reflect carefully on how their prior knowledge may influence their views on obviousness. Meade J found that one of the experts in *Fisher & Paykel lacked such care and thought in this regard and consequently found that "[the expert's] views on obviousness have to be treated with a good deal of scepticism*".

It is worth emphasising here the responsibility of those instructing the expert to ensure that the expert is fully aware of, and, as necessary, reminded of the importance of avoiding hindsight when giving their opinions. This is all the more so since, as Meade J explains, "*If they do so well, then there is no reason why they cannot give cogent evidence on obviousness*".

Citations

An additional theme pervading these decisions is the importance of the expert disclosing relevant publications. In Arnold LJ's judgment in *FibroGen v Akebia*, he refers back to his well-known decision in *MedImmune v Novartis*[5] where he stressed the need for the instructing lawyers to make sure that experts disclose their own previous relevant publications. This is because, as Arnold J (as he then was) explained, the opposing party's lawyers are likely to comb through the expert's publications and if they find something relevant that has not been disclosed, then the expert may be accused in cross-examination of failing in his duty to assist the court.

In a similar vein, Meade J cautions against a complete lack of citations. In his judgment in *MSD v Wyeth*, Meade J explained that one of the expert's evidence involved theories which were not supported by documents, and that the expert's "*speculative ideas…should not have [been] advanced without some proper support*". The only citation to that expert's written evidence was their CV, which, unsurprisingly, did not suffice. That is not to say that every view expressed by the expert needs to be backed up with a literary citation. This is where it is important to keep in mind the test for what constitutes the CGK, and the expert's role in giving their evidence on that issue. As such, the expert should disclose relevant examples in the literature that support their views on the CGK. As Pumfrey J observed in *Conor v Angiotech*[6], "*The most difficult part of any obviousness case is the attribution of the relevant skill and knowledge to the notional addressee of the patent. When the common general knowledge is identified, the height of the bar is set*." Thus, the expert's evidence on what constitutes the CGK is crucial; it provides the court with a basis upon which it can make its finding of fact as to whether the alleged inventive step would be obvious to the skilled person who is acquainted with the relevant CGK.

05_[2011] EWHC 1669
06_[2006] R.P.C. 28

Role of experts

Undoubtedly, expert witnesses play a vital role in patent litigation. As Jacob LJ famously explained in *Technip France SA's Patent*[7] – "*Their primary function is to educate the court in the technology – they come as teachers, as makers of the mantle for the court to don*". This role, and the responsibilities that come with it, is echoed at various places throughout these recent decisions.

Two key points arise. The first point derives from the expert's overriding duty to assist the court by providing their independent and unbiased opinions. Given that expert witnesses in patent cases often require considerable assistance from the instructing lawyers in drafting their report(s), this just highlights the need for the expert to satisfy themselves that their opinions are accurately reflected in the report(s). This point is borne out by Marcus Smith J in *Neurim v Mylan* – "*An expert is responsible for his or her evidence, including the precise wording of any report submitted to the court under the name of that expert*".

The second point arises in relation to giving evidence on obviousness. What really matters is the expert's reasons for their opinions, not their conclusions. This is reiterated by Meade J in his judgment in *Fisher & Paykel v Flexicare*. Thus, the expert should give cogent reasons for their views as to why the skilled person could (or could not, as the case may be) get to the idea of the claimed invention.

07_*Rockwater v Technip* [2004] EWCA Civ 381

Role of instructing lawyers

It is also important to consider the role of those who instruct the expert. Collectively, these recent decisions remind lawyers of their responsibility to ensure that expert witnesses are properly instructed. This is crucial in ensuring that the experts, in turn, can fulfil their role in assisting the court. Indeed, given that the instructing lawyers are often heavily involved in drafting the expert's report(s), it is paramount that the lawyers keep in mind the expert's responsibility to remain impartial throughout the process.

In *Neurim v Mylan*, Marcus Smith J considered that one of the experts in the case lacked the necessary understanding of what he described as the "nuts and bolts" of patents and patent law, and that consequently, this had the effect of undermining the expert's evidence.

Marcus Smith J's comments arose in the context of summarising the attributes of the skilled person and in particular, their knowledge of patent law. He noted that the skilled person must have a sufficient understanding of patent law to appreciate the general nature and function of a patent specification and the claims. This principle was established following the famous case of *Kirin-Amgen v Hoechst Marion Roussel*[8] in which Lord Hoffmann observed: "*But the person skilled in the art (who must, in my opinion, be assumed to know the basic principles of patentability) might well have thought that the claims were restricted to existing technology because of doubts about sufficiency rather than lack of foresight about possible developments*." Marcus Smith J also referred to the well-known case of *Virgin v Premium Aircraft Interiors*[9], where the Court of Appeal applied Lord Hoffmann's principle and held that the skilled person, probably with the benefit of skilled advice, would know and take into account explicit drafting conventions by which the patent and its claims are framed. The Court of Appeal also held that the skilled person would know about the practice of divisional patent applications.

The unfortunate consequence in *Neurim v Mylan* illustrates the importance of providing clear instructions to the expert so that they acquire a sufficient understanding of patent law and the principles involved. Understandably, grappling with these issues is not an easy task for experts and it is for this reason that expert witnesses require a high level of instruction by the lawyers.

Multiple experts

In cases where more than one expert is called, due consideration should be given as to the order in which their evidence is given. In *FibroGen v Akebia*, two experts were called by each party: a medicinal chemist and a nephrologist. Each pair of experts was heard sequentially in that order. However, Arnold LJ stated that they should have been called the other way round. In his judgment, he put in a strong plea that experts are called in logical order and reminded the instructing lawyers that they "*do their utmost to try to ensure that this is done*".

Confidentiality issues and practical measures that can be taken

A final point to note relates to the practicalities of experts giving evidence. In *MSD v Wyeth*, one of the experts refused to confirm whether or not he had done various things in his capacity as a co-founder of a drug development company (this all related to ascertaining the areas in which the expert lacked the relevant experience). The expert refused to do so on the grounds of confidentiality which he owed to his customers, despite being questioned in general terms. Meade J expressed some disapproval of this approach; he was of the view that a simple "yes-or-no" answer would not have compromised any duty of confidentiality. Meade J voiced some surprise that the instructing lawyers had not identified a possible solution and thought that "*more foresight and explanation to the [expert] about the issues and possibilities, such as sitting in private*" would have avoided the issue. Practitioners should heed this advice and be pragmatic. So long as there is no disclosure of sensitive information, such as the name of a customer or the details of advice sought, then there should be no risk of the expert inadvertently breaching any duties of confidentiality.

Comment: These decisions from 2020 provide many helpful reminders and guidance on instructing experts and the preparation of expert evidence. It is worth practitioners taking stock of the judges' remarks, especially given Arnold LJ's warning in *FibroGen v Akebia* that "*If practitioners continue not to observe the standards required of them, the Patents Court will have to take steps to enforce those standards*".

08_[2004] UKHL 46
09_[2009] EWCA Civ 1062