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Datacard provides clarity on the selection of Expert Witness

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It is difficult to over-estimate the importance of expert evidence in patents cases before the English Court. In a typical trial well over half of the time will be devoted to cross-examination of the parties' experts in front of the Judge who will be guaranteed to listen carefully and form an opinion.

The choice of expert witnesses is therefore a very important step in English patent litigation. But should a party select for instance an outstanding academic who may have won international recognition in his or her field? Or should a party try to find an expert who is closer to the ordinary skilled worker in the field? Does it matter if the expert was not working in the right field at the priority date of the patent in question but came to the art later?

In the early years of the new millennium, these questions were grappled with by patent practitioners with many insisting that the chosen expert should have been working in the field at the relevant time.

Clarification as to the correct approach to take was given by the Court of Appeal in 2004 in Technip's Patent where Jacob LJ opined: *"I must explain why I think the attempt to approximate real people to the notional [skilled person] is not helpful. It is to do with the function of expert witnesses in patent actions. Their primary function is to educate the court in the technology – they come as teachers…for that purpose it does not matter whether they do or do not approximate to the skilled person. What matters is how good they are at explaining things*". Later, the same Judge held: *"Because the expert's conclusion (e.g. obvious or not), as such, although admissible, is of little value it does not really matter what the actual attributes of the real expert witness are. What matters are the reasons for his or her opinion. And those reasons do not depend on how closely the expert approximates to the skilled person"*.

These observations were considered and explained in the recent judgment of Arnold J. in Datacard Corporation v Eagle Technologies Limted (decision of 14 February [2011] EWHC 244). In this case Arnold J held that: *"Given that what matters are the experts' reasons [for their opinions] and whether they would be perceived by the skilled person, it is relevant to consider to what extent the experts' qualifications (as opposed to their degree of inventiveness) approximate to those of the skilled person. If one expert was in the field at the relevant time, and particularly if he considered the problem to which the patent is addressed at that time, then his evidence is likely to carry more weight than that of another expert who was not in the field at the relevant time"*.

In the case at hand, it was held that the expert for one side was more suitably qualified to assist the

court in respect of one of the patents in question and the expert for the other side was better placed to opine on the other.

Going forward, practitioners will need to bear in mind the overarching purpose of expert evidence – to educate the Court – but, if there were any doubt, Datacard indicates that if possible, the chosen expert should have been active in the relevant field at the time of the patent. If he or she had considered the problem that the patent purports to solve, so much the better.

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