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Does the Expert need to be an Expert?

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One of the points of contention in cases where inventive step is discussed is which expert is better suited to express an opinion on whether or not the invention would have been obvious for the person skilled in the art. English Courts, for example, have a long-standing tradition of carefully scrutinising the experts presented by the parties to see how helpful they can be to the Court. What follows is a short commentary on a recent judgment handed down on 5 July 2012 by Commercial Court number 1 of Pamplona, which makes an additional contribution to this debate.

The case concerned a patent protecting a pharmaceutical composition used for treating pain. The plaintiff, relying on an expert opinion written by a chemical engineer with no experience in the pharmaceutical industry, filed a revocation action questioning the inventive activity of the patent. Moreover, the defendant filed an expert opinion in support of inventive activity written by a university professor who is an expert in analgesics and whose impartiality was challenged by the plaintiff on the grounds that he was the director of a university chair sponsored by the defendant.

In her judgment, the Judge relied on a handbook from Professor Alberto Bercovitz, one of the parents of Spanish patent law, to illustrate the importance of the expert when it comes to analysing inventive activity. Following Professor Bercovitz, the Judge wrote that, “In all of these matters related to expert reports, the selection of the experts has a basic effect. Not only is it necessary to ensure that the expert’s field of specialisation is adequate in view of the subject-matter of the patent, but it is also necessary to take into account that, occasionally, the patented invention, the revocation of which is sought, may refer to very advanced technology and, therefore, the average skilled person will not be in a position to make an adequate judgment, but rather it will be essential to have recourse to an expert who is sufficiently qualified in the subject, which may be advanced technology. In that respect it may be important to obtain reports from highly- qualified experts or prestigious research institutes (…)”.

In relation to the challenge to the impartiality of the expert used by the defendant, the Judge reached the following conclusions: “It is clear from all of the foregoing that, indeed, a community of interests links the expert to X, because three areas exist, i.e. the Professorship, the Foundation and the pharmacological research in which they collaborate. This situation does not lead us to reject the expert report outright, but rather we will exercise due caution when considering it.

It should be stated in this respect that we are not dealing with a Court-appointed expert, as in the case of the Judgment issued by Barcelona Provincial Court, Section 15, on 17/05/06, to which the plaintiff refers, but rather with an expert appointed by one of the parties. Even if the said disqualification had not been raised, the same credit as that given to Court-appointed expert evidence (in general) would still not have been given to the expert evidence filed by the parties because, although all of the experts act to the best of their knowledge, the fact is that the cases in which the party’s expert disagrees with the theory maintained by the party proposing him, are

totally exceptional. It should be added that it is logical to think that probably many pharmacology experts have, one way or another, a relationship with the pharmaceutical industry, given, in general, the community of interests between them, but that does not mean that we should discard their opinions, but does in fact render it more difficult to assess their expert evidence due to the shadow cast over their conclusions." In other words, the fact that the university where the expert of one of the parties teaches as a university chair is sponsored by the patent owner does not prevent the Judge from bearing his opinion in mind, although due caution will need to be applied.

Moving on to the expert used by the plaintiff, the Judge noted that, "Acting for the plaintiff is Mr Y, in respect of whom it is possible to object, as the defendant states, that he is not an expert in analgesic therapy. He is not a pharmacologist, but a chemical engineer and patent expert and, therefore, naturally, his knowledge is not as in-depth and illustrative as Mr Z's knowledge, who is an expert in analgesia. Despite these observations, it can be affirmed that, with the limitations of that lack of expertise, Mr Y's statements are not illogical."

The Court, after carefully discussing the two main pieces of literature relied on by the plaintiff's expert, reached the conclusion that the patent was invalid for lack of inventive step.

All in all, the teaching from this judgment, which may be appealed, is that the expert does not always need to be an expert.

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