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Brian Cordery (Bristows) · Thursday, April 21st, 2016

by Rachel Mumby

It would be an unusual case in which the parties did not criticise each other's experts in one way or another, and indeed patent litigators in England and Wales have become no stranger to judicial criticism of the way that experts are instructed. However, in the case of **American Science & Engineering Inc. v Rapiscan Systems Limited** [2016] EWHC 756 (Pat), handed down on 11 April 2016, both sides appear to have at least tried to follow the guidance set out by Arnold J in **Medimmune Limited v Novartis Pharmaceuticals UK Limited** [2011] EWHC 1669 (Pat). Despite this, Arnold J still found fault.

The case related to an X-ray scanning system which can be used for covert imaging whilst either or both of the scanner and the object being scanned are in motion. The X-ray source and detector are both entirely enclosed within the body of a vehicle and are therefore hidden.

Experts

Both parties first asked their expert to consider the person skilled in the art and the common general knowledge, then to consider the cited prior art, and only then to consider the patent. American Science & Engineering ("AS&E") had asked their expert to consider obvious developments of the prior art before showing him the Patent. Whilst the correct question is whether, viewed without any knowledge of the claimed invention, the differences constituted steps which would be obvious, AS&E's approach was criticized as it assumed that all obvious steps would occur to that expert, and did not take into account the fact that real people, unlike persons skilled in the art, sometimes miss the obvious. Rapiscan's expert was only asked to consider the question of obviousness after he had been shown the patent. This received greater criticism as there appeared to be no attempt to avoid hindsight in his analysis. No perfect solution was proffered, but it seems that AS&E's approach, followed by further probing about other steps which might not have occurred to that particular expert, would be closer to the mark.

Secondary evidence

In this case, the substantive points to be determined by Arnold J were few in number. Only validity was in issue (infringement had been admitted during the course of trial), and by closing submissions, there was only one piece of prior art in play – a paper referred to as "Swift". Unusually, especially in a judgment handed down by Arnold J, there is no commentary on the legal tests – there had been no dispute as to the applicable legal principles. However, of interest may be

Arnold J's analysis of some secondary evidence.

Although patentee clients are often keen to emphasise the commercial factors at play relating to an invention, and to point out that if an invention was obvious, surely it would have been made before, the courts in England and Wales have long been reluctant to give these much weight and have treated them as secondary evidence. This case was no different.

In this case, all the components were readily available, and although the time which elapsed between publication of the cited prior art and priority date was only six years, it had been an active field in that period. Arnold J considered that this provided modest support for the conclusion that claim 1 was not obvious. He also regarded as “extraordinary” the submission from Rapiscan that the reason it had not been done was because AS&E had patent protection relating to part of the technology and that the burden lay on AS&E to show that this was not the case. Arnold J reasoned that *“it is plain that, where a party which is attacking the validity of a patent on the grounds of obviousness wishes to rely upon a fact as explaining why the invention was not made before the patent, whether that fact relates to the availability of raw materials or a regulatory restriction or a commercial factor or the existence of an earlier patent owned by the patentee or a third party, then the burden of proving the existence and relevance of that fact lies upon that party.”* Having said that, he also found that even if the burden did lie with AS&E, they had discharged that burden.

AS&E also tried to rely on commercial success – specifically the commercial success of their vehicles which implemented the claimed invention. Arnold J did not permit such arguments as AS&E had not pleaded any case of commercial success. However, he did allow them to rely on the reaction of their competitor (Rapiscan) to the invention, as set out in the evidence of Rapiscan's managing director, and concluded that this provided further modest support for the conclusion that claim 1 was not obvious.

Obviousness

On the primary obviousness analysis, owing to the way that their expert had been instructed, Arnold J criticised many of Rapiscan's arguments as being tainted by hindsight. Arnold J found claim 1 to be inventive despite acknowledging that at least one of the required steps was small, and despite a throwaway suggestion which had been included in a widely-read industry journal (not deemed to be common general knowledge), relating to a key feature of the claim. This was because the throwaway comment did not address the necessary practicalities.

He held that there were plenty of obvious avenues of development from Swift that did not require invention, but the claimed invention related to changing the whole method of operation of the system and was thus far removed from the obvious developments.

Whilst it did not change the outcome of the case, Arnold J did find one of Rapiscan's arguments on obviousness persuasive – he found it would have been technically obvious to dispense with the “boom and beam catcher arrangement”. AS&E had argued that the system would not sell without the boom, but Arnold J pointed out that this related to a different question which depended to a large extent on regulatory factors (i.e. only a secondary consideration).

All in all, this case serves to remind us all of the importance and pitfalls of technical expert evidence throughout the process of litigation, in terms of initial instructions, the substance of written evidence and of course, cross-examination.

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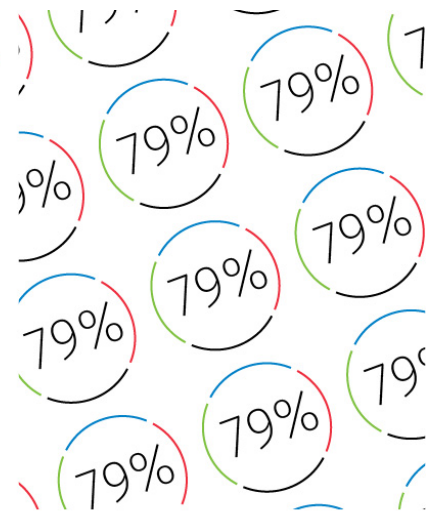
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