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What is a “practical interest” in the subject matter of an invention?

Brian Cordery (Bristows) · Friday, May 6th, 2016

by Steven Willis

Judgments from the Courts of England and Wales concerned with the construction of patents will invariably cite the classic formulation of Lord Diplock from *Catnic Components v Hill & Smith Ltd* [1982] R.P.C. when addressing the identity of the person skilled in the art:

“…a patent specification is a unilateral statement by the patentee, in words of his own choosing, addressed to ***those likely to have a practical interest in the subject matter of his invention*** *(i.e. “skilled in the art”)…*” [emphasis added]

In the recent judgment in *Saertex v Hexcel* [2016] EWHC 966 (IPEC), handed down on 4 May 2016, the Intellectual Property and Enterprise Court (HHJ Hacon), has offered guidance as to what it means to have such a “practical interest” in an invention.

As is typical in proceedings before the IPEC, the parties had been asked to identify the technical field from which the skilled person and therefore experts should come at a case management conference. Both parties agreed that the skilled person would be a manufacturer of reinforced plastic products. Accordingly, it was ordered that each party could provide evidence from one expert in that field. However, both parties subsequently submitted in their skeleton arguments (and in the Defendant’s case in expert evidence) that the skilled person would in fact be a skilled team comprising various other individuals concerned with manufacturing products of the type with which the patent was concerned.

Hacon HHJ rejected this attempt to broaden the membership of the skilled team and clarified that the “*practical interest in the subject matter of the invention*”, that Lord Diplock had ascribed to the skilled person or team in *Catnic* referred to “*an interest which is held by the putative skilled person in directly performing the invention as claimed – either by himself or, where the facts require, in co-operation with one or more other skilled persons each with different expertise*”. As such, while a person skilled in using a product made according to a patented method may have a keen practical interest in the invention, it does not mean that persons skilled in using the product must join the skilled team. Consequently, Hacon HHJ held that only one skilled person was required: a manufacturer of treated reinforcements.

This judgment is a useful addition to the jurisprudence on the person skilled in the art which

includes the Court of Appeal decision in *Rockwater v Technip* [2004] EWCA Civ 381 in which the recently retired Jacob LJ famously suggested that "*the person skilled in the art …, if real, would be very boring – a nerd … But the skilled man is not a complete android*". Although it should be noted that in the same case, Pill LJ observed, perhaps more conservatively, that, "*I hope that those working in this field will not regard 'men skilled in the art' as figures from science fiction who lack social skills*". The other oft-cited case in this area is the Court of Appeal decision in *Schlumberger v Electromagnetic Geoservices* [2010] EWCA Civ 819 in which it was held that the composition of the skilled team could vary depending upon whether a pre-grant issue, such as obviousness, or a post-grant issue, such as sufficiency was under consideration. The recent Saertex decision emphasises that the *Schlumberger* principles will likely be confined to somewhat unusual circumstances.

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