Kluwer Patent Blog

An expert does not need to be an expert. Really?

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As readers know well, one of the issues carefully considered by courts around the world when examining inventive activity is the qualifications and experience of the experts designated by the parties to illustrate to the court what the understanding of the hypothetical "person skilled in the art" would have been on the priority date of the patent examined. English courts, for example, tend to carry out a very detailed analysis of aspects such as the age of the experts on the priority date and the specific hands-on experience in the specific technical field of the invention. Likewise, Spanish courts of appeal have traditionally paid little attention to expert opinions written by persons who were not actually experts in the technical field of the invention. The Court of Appeal of Madrid (Section 28) has been particularly demanding in this respect.

Against this background, the Spanish Supreme Court has recently surprised the patent community with a judgment of 20 May 2016, in which it has expressed the odd view that it is not necessary for an expert to be an expert. The judgment rejected an appeal filed by the patent owner against a second instance decision that found the patent to be invalid following an expert opinion of an expert in Pharmaceutical Technology (i.e. a formulator). In the appeal, the patent owner alleged that an expert opinion from a formulator was insufficient to prove that the skilled person would have been motivated to develop the patented formulation, among other reasons, because the Court of Appeal had accepted that the "skilled person" would comprise both a formulator and a psychiatrist, and the only psychiatrist who took part in the proceedings argued that on the priority date a psychiatrist would not have been motivated to demand such formulation.

The Court of Appeal rejected this argument on the grounds that "*for an expert to be able to bring the point of view of a skilled person – necessary in this case to examine the inventive activity -, it is not essential that the expert be an expert, but that due to his/her training and experience, he/she be capable of putting himself/herself in the position of the "person skilled in the art.*" Following this logic, the Court of Appeal considered that an expert opinion from a formulator was sufficient to prove what the understanding of a psychiatrist would have been on the priority date of the patent, as the formulator would be able to put himself or herself in the shoes of the psychiatrist.

Believe it or not, this is the principle that now appears to have been endorsed by the Supreme Court's judgment of 20 May 2016. In particular, the judgment dismissed the patentee's appeal on the following grounds:

"*It is well known that a judgement on inventive activity (if the solution that the invention provides, in view of the state of the art and the problems detected, was obvious), must be made from the parameter or point of reference of an "average skilled person". This "average skilled person" is a hypothetical specialist in the field of the invention who has the general common knowledge of the subject-matter. He/she has access to the state of the art in its entirety, on the relevant date, and in particular to the documents of the "search report". He/she is more of an expert in the field of the technical problem, than in that of the solution. He/she is not creative, lacks special ingenuity (he/she is not an inventor)*

and is affected by the prejudices existing at the time in the state of the art.
But this person skilled in the art should not be confused with the expert who gives his/her opinion in a dispute over the inventive activity of a patent. What the expert has to provide is the perspective of the "person skilled in the art". As we stated in Judgment 325/2015, of 18 June, "the expert does not necessarily have to be an average person skilled in the art in order to inform on what said skilled person would have considered in view of the teaching of the patent and the state of the art existing on its priority date. What is relevant is not that the expert be a skilled person, but that he/she inform us of what a skilled person would have considered in those conditions. What is important is that the expert be qualified to make this assessment, in view of the content of the invention". In order to do so, he/she must necessarily taken into account the common and general knowledge of the art, existing at the time of the patent application, which often, above all in the case of chemical and pharmaceutical patents, is contained in textbooks, manuals, encyclopaedias, treatises, review articles and other general works of reference.
As such, it is accurate to say that the affirmation contained in the appealed judgment stating: "for an expert to be able to bring the point of view of a skilled person – necessary in this case to examine the inventive activity -, it is not essential that the expert be an expert, but that due to his/her training and experience, he/she be capable of putting himself/herself in the position of the "person skilled in the art"". And in this case, the judgment takes into account that the team comprising the "person skilled in the art" would contain a person skilled in the formulation of medicinal products and a psychiatrist, and would include the knowledge of a psychiatrist when performing the judgement of obviousness attributed to the average skilled person, even if in many cases it is done on the basis of opinions given by an expert who is not a psychiatrist, but who takes his/her vision into account."
No comments are needed, except that for the sake of the proper administration of justice and the benefit of the prestige of Spanish case law on patent cases, towards which so many Spanish Judges, including those at the Supreme Court, are working very hard, it is desirable that this judgment soon become an isolated accident on the way towards making Spanish case law on patents second to none.

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