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The Role of Scientific Advisers in the English Patents Court

Brian Cordery (Bristows) · Thursday, March 14th, 2024

A short but nevertheless interesting judgment was handed down last week on the different roles that technical experts on the one hand and scientific advisers on the other have to play in proceedings in the English Patents Court. The decision of Mellor J followed a case management conference in an entitlement dispute between Dr Vanessa Hill and her former employer, Touchlight Genetics. The patents and patent applications in suit relate to aspects of a synthetic DNA vector called doggybone DNA or dbDNA and its enzymatic production. Part of Dr Hill's case is that she made the inventions in the patents and patent applications in suit before she was employed by Touchlight and only assigned part of these inventions to Touchlight, retaining other aspects for herself. For its part, Touchlight disputes this.

The parties were agreed that it would be beneficial for the court to have assistance understanding the technology and the relevant technical documents. Dr Hill's legal team contended that the most appropriate way to educate the court would be for it to appoint a scientific adviser whereas Touchlight's position was that technical experts instructed by the respective parties would be a preferable solution.

The decision from Mellor J contains a condensed summary of the role of scientific advisers. Unlike some other European countries such as Italy, where patent attorney experts are regularly engaged by the court to assist with technical issues, the judges of the English Patents Court, and particularly those empowered to hear the most technically challenging cases, will have several decades of experience of working on patent cases and most likely a scientific background of one sort or another. In these circumstances, the Judge can usually gain a sufficient understanding of the issues using written technical primers, experts' reports and legal submissions from the parties' representatives. However, there are cases at the cutting edge of science, where even the most experienced judges have considered that a non-controversial "teach-in" would be desirable and so the Court, pursuant to procedures laid down in the rules that govern procedure, has appointed a scientific adviser to assist it with getting to grips with the relevant concepts. Such teach-ins have been more commonplace in the Court of Appeal where it is almost inevitable that at least one, and usual more, of the panel of three judges will not be steeped in the relevant science and have had limited exposure to patent law.

In contrast to scientific advisers, party-instructed technical experts are virtually ubiquitous in proceedings before the English Patents Court where validity and/or infringement is in issue. As Jacob LJ, in characteristically colourful fashion, put it in Technip [2004]: "they come as teachers, as makers of the mantle [of the common general knowledge] for the court to don." Most of the

court time at a typical patents trial is devoted to the cross-examination of the experts following which the court will carefully weigh the views put forward by the experts and more importantly, the reasons for these views, when deciding how the skilled person would view a particular invention or piece of prior art. It is hard to overstate the importance of technical experts in most patent cases.

In the present proceedings, Dr Hill's legal team pointed out that this was an entitlement case – neither infringement nor validity were in issue – and the Court would need to base its ruling in part on Dr Hill's subjective state of mind. In contrast in validity and infringement proceedings, the Court is required to evaluate for example the impact that a given piece of prior art would have had on the skilled person at the priority date of the patent in suit when assessing e.g. inventive step. Noting that this issue was one that had not arisen previously, Mellor J considered that it would be appropriate to permit the parties to adduce expert evidence but with certain restrictions as to its scope. This was because he could not be satisfied that there would be no technical disputes at trial and, the role of the scientific adviser was not to resolve such disputes. This was the domain of technical experts.

The decision is an interesting essay on the different roles that various potential actors in a patent litigation dispute in the English Courts can play. The take-home message is that in the English system, scientific advisers cannot be called upon to resolve disputed technical issues.

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