EIP

Balancing Expertise: Mellor J's Ruling on Scientific Advisers vs. Expert Evidence

Hill v Touchlight Genetics Ltd & Ors [2024] EWHC 533 (Pat) (08 March 2024)

~~Summary~~

This judgment concerns a novel issue in the Patents Court which arose at the second CMC in this action, regarding whether the Court should appoint a scientific adviser ("SA") or order the exchange of expert evidence.

This issue stems from a rare set of circumstances in a patent entitlement dispute. The defendants and counterclaimants, jointly "Touchlight", own patents related to the field of biotechnology. The claimant, Dr Hill, is a molecular biologist who was a director and employee in the first defendant until she resigned in 2009.

Dr Hill contends that before her employment with Touchlight, she made and disclosed to Touchlight the inventions in their patent filings that led to the patents in dispute, and that she only assigned part of these inventions under her service agreement. Consequently, she claims entitlement to joint ownership of the disputed patents and patent applications.

The parties have agreed a list of issues for determination at trial, which the Court will need a thorough understanding of the technology and the inventive concepts to resolve. The Court will likely need to assess oral disclosures, their context, and the potential influence of memory on Dr. Hill, considering the significant time elapsed (16 years) since the events.

Dr Hill contended that assistance could be provided to the Court by the appointment of a

SA, without the need for expert evidence, while Touchlight submitted that expert evidence alone is required to address the technical aspects of the issues in dispute.

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~~The Law~~

There is no dispute that the Court has the power to appoint a SA. (1) The issue is as to where the dividing line lies between the roles of a SA and expert evidence.

Touchlight emphasised the limited role for a SA to provide non-controversial scientific background for the Court, detached from the issues in dispute, as highlighted by Birss J (as he then was) in previous cases such as Actavis (2) and Electromagnetic Geoservices (3) .

Touchlight presented Mellor J with a historical overview of SA appointments in patent cases, indicating that, among other things, in almost all of those cases there was no SA at first instance, since the trial was conducted before one of the category 4/5 patent judges. They emphasized that in no case was a SA appointed without evidence from technical experts and, as such, they are not intended to replace expert evidence.

Dr Hill did not dispute these submissions on the law but drew attention to the fact that issues in entitlement disputes differ significantly from traditional patent infringement actions. Dr Hill relied on evidence that, subject to one exception, all entitlement disputes in the UKIPO or High Court were decided without technical expert evidence.

~~Dr Hill's Submissions~~

Dr Hill argued that the Court's challenge is in understanding the technology, which requires an explanation of the fundamental science by reference to the documents and patents in issue, rather than typical expert evidence in patent actions where validity is in issue. Consequently, Dr Hill submitted that the Court would be able to comprehend the technology best via a SA.

Dr Hill's counsel emphasised the importance in this action of Dr Hill's subjective understanding of the inventions and disclosures to Touchlight, suggesting that expert evidence was unsuitable for such matters.

~~Touchlight's Submissions~~

Touchlight argued against appointing a SA without also having expert evidence, deeming it unprecedented and contrary to authority. They emphasized the need for expert evidence to address disputed matters and core issues in the case, which they argued goes beyond the SA's role.

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Furthermore, Touchlight submitted that it is in the interest of fairness that the parties have the opportunity to present evidence and cross-examine effectively, which would be usurped by the SA's private communication with the Court.

They submitted that a category 4/5 judge should be able to understand the issues with the assistance of the expert evidence and the parties' submissions.

~~Mellor J's Decision~~

Mellor J explained that both a SA and technical expert evidence serve the purpose of educating the Court on the relevant technology in patent proceedings. However, it is important to note a clear distinction: while a SA educates the Court, they do not address technical disputes, which is the role of expert evidence, where appropriate and admissible.

Mellor J acknowledged that while many entitlement disputes may not require expert evidence, it ultimately depends on the specific issues involved. Mellor J anticipated technical disputes at trial, and the possibility that some may only emerge during Dr Hill's cross-examination. Consequently, he granted permission for expert evidence rather than a SA. He agreed with Touchlight's assertion that appointing a SA without expert evidence would be unprecedented, inappropriate, and against established authority.

Mellor J also ordered that the expert evidence should be sequential (as the parties jointly agreed). He directed a discussion between the experts for the purpose of seeking to reach agreement on the technical issues and preparation of a statement setting out the issues on which they agree and disagree with reasons for disagreement.

~~Conclusion~~

This judgment emphasises that while it is, of course, highly fact-dependent, the dividing line between the role of a SA and the role of expert evidence is that expert evidence will assist the Court to address any technical disputes. In this regard, a SA is only appointed by way of supplement, not in substitution, to the expert evidence.

The judgment can be accessed here.

[1] s.70(3) of the Senior Courts Act 1981 and CPR r35.15

[2] Actavis Group PTC EHF v Actavis UK Ltd [2016] EWHC 1476 (Pat) at [21]

[3] Electromagnetic Geoservices ASA v Petroleum Geo-Services ASA ("EMGS") [2016] EWHC 27 (Pat) at [27]-[36]