

EIP



Expert's Attempt to Swot-up in Patent Dispute is Insufficient to Comply with Court Requirements in Sycurio v PCI-PAL

PCI-Pal succeeded in the High Court of England & Wales in its patent dispute with Sycurio. Sycurio's patent was found invalid for obviousness. But even if Sycurio's patent had been found valid, there would have been no finding of infringement. Interestingly, the Judge made some preliminary observations about the duties and responsibilities of expert witnesses in patent cases, and the corresponding obligations of the solicitors who assist those witnesses in preparing their evidence.

The Patent

The patent in suit, GB 2473376 (the "**Patent**"), concerns a technical solution for the problem of agent fraud at call centres. Sycurio claimed that PCI-Pal were infringing the Patent by their cloud-based secure card payment system known as Agent Assist. PCI-Pal challenged the validity of the Patent on various grounds, denied infringement and sought declarations of non-infringement.

Validity

Of the three pieces of prior art before the Judge, it was concluded that claim 9 of the Patent (the claim in issue) was invalid for obviousness based on both the Van Volkenburg and the Shaffer documents. The Judge then saw no need to consider any further validity arguments.

Infringement

Although the Judge felt that it was not necessary for her to consider the infringement arguments, given her findings on validity, the Judge addressed them in case the matter went further and those points became relevant. The Judge subsequently found that even if the Patent had been found valid, there would have been no infringement.

Duties and Responsibilities of Expert Witnesses in Patent Cases

There was no dispute that an expert witness in a patent case was subject to the rules of CPR Pt 35 and that this included the expert's duty being "to help the court on matters within their expertise" and the requirement for an expert's report to comply with Practice Direction 35. The Judge was aware that there would be times when an expert may need to read in to enhance their existing knowledge or to be able to understand the context of the questions being asked of them that were within their field of expertise. This additional reading was permitted so long as the expert did not begin to opine on those matters that they had read up on because they thought they had a "sufficient" grasp on the matter to express a view.

As to the process by which an expert report is prepared in patent cases, Arnold J's (as he was then) judgment in *Medimmune v Novartis* [2011] EWHC 1669 was agreed to be the correct position. The specialist nature of patent cases and the fields of technology involved often require a "high level of instruction by the lawyers", and that in practice expert reports in patent cases are often drafted by the lawyers on the basis of what the expert has told them, with the expert then amending the draft report as appropriate.

Sycurio's Expert Witness

The Judgment dedicates several paragraphs to Sycurio's main expert who specialised in payment card processing, including call centre payments, at an operational level. She did not claim to have any expertise in the technical solutions used to implement the card processing systems and said she would usually work with engineers to implement systems she had specified. Yet, the expert's evidence addressed the issues in the action as a whole, including the scope of the CGK, novelty and obviousness over the prior art, and infringement. As a result, the Judge noted that the expert struggled during the cross-examination process when asked questions on the technical documents. The expert explained that she had been struggling due to a number of issues, including lack of sleep and medical issues. The expert also provided details on how her evidence was prepared by her instructing solicitors and how she had to carry out an extensive amount of extra research in order to understand the technical materials. She maintained that the final

reports were signed off by her as she had read them carefully and agreed with all the points made therein.

The Judge was sympathetic towards the expert's issues and accepted that she had the best intentions when reading around to ensure she understood as fully as she could the points being made, but ultimately there were points where she clearly did not have the correct field of expertise and it was not appropriate for her to provide evidence. As a result, the Judge could not give any weight to any evidence provided beyond the scope of her expertise.

Take-away Points

This judgment highlights the importance of carrying out the relevant due diligence when looking to instruct an expert. It is vitally important to keep at the forefront of one's mind that an expert's duty is to assist the court by providing objective, unbiased opinions on matters within their expertise. When preparing expert evidence, it is important to ensure that the expert does not stray into giving evidence on matters falling outside their expertise. Ultimately it falls on the instructing solicitors to explain to the expert, in detail, the requirements of CPR Pt 35 and the respective Practice Direction to ensure that the expert is fully aware of the duties imposed on them as an expert witness.

The judgment is available here at [Sycurio Ltd v PCI-Pal PLC & Anor \[2023\] EWHC 2361 \(Pat\) \[25 September 2023\]](#)