

The best fit

Chris Pamplin considers how easy it is to choose the right expert

In all cases involving expert evidence it is important to try to ensure that the expert selected has the necessary skills, qualifications and experience to provide a reasoned and valid opinion on the matters at issue. This may sound obvious and straightforward, and access to a resource like the *UK Register of Expert Witnesses* can help, but it is sometimes difficult to determine exactly what constitutes necessary skills, qualifications and experience and, in grey areas, what weight should be attached to the evidence of an expert whose experience does not match exactly the requirements of a particular case.

Patent difficulties

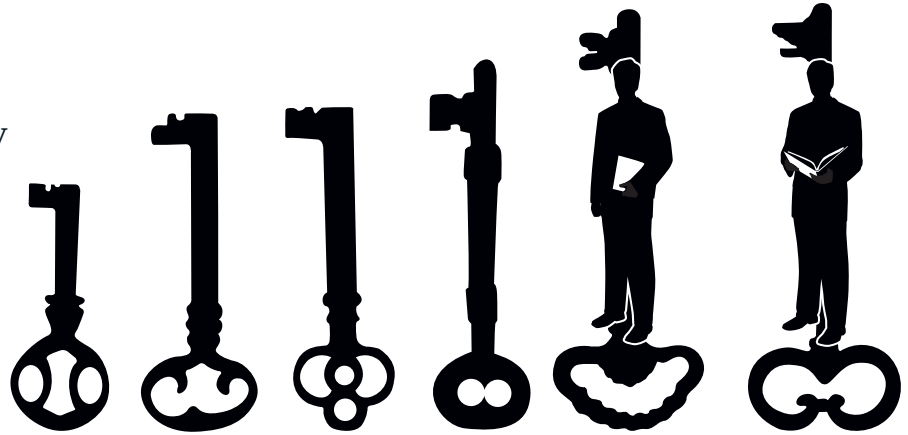
In *DataCard Corporation v Eagle Technologies* [2011] EWHC 244 (Pat), [2011] All ER (D) 199 (Feb) the High Court considered the differing qualifications of the expert witnesses involved and set out principles for weighing these qualifications.

The case revolved around the validity of patents related to different aspects of the printing of plastic cards, such as credit cards. DataCard sued Eagle Technologies for two patent infringements. One related to a means of preventing the user from incorrectly installing a ribbon (error loading patent); the other concerned the use of radio-frequency identification tags on printers and consumables employed to print identification documents such as passports and driving licences (RFID Patent). Under s 3 of the Patents Act 1977, an invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art. Critical to the determination of obviousness was the composition of the “skilled person”, in this case a team of people.

The leading case considered by the court was *Mölnlycke v Procter & Gamble* [1994] RPC 49. In that case, the Court of Appeal had held that in assessing whether an invention was obvious, the primary evidence would be that of properly qualified expert witnesses. In general, a properly qualified expert witness was held to be someone in the relevant field at the relevant time.

Mostly expert

In *DataCard*, the claimant’s expert witness was, on the face of it, eminently suitable.



He had considerable experience in the field of card printers but not, it transpired, at the relevant time. He was an inventor named in many patents, including one of the patents cited as prior art against the RFID patent. However, at the date of the RFID patent, he had limited knowledge and experience of RFID technology.

Eagle Technologies’ expert witness, on the other hand, had no involvement with card printers, but did have some experience at the relevant time with other types of printer and with RFID solutions for application in printer systems. He was felt to be sufficiently qualified (as a result of his general engineering experience and general knowledge of printers) to give admissible expert evidence in relation to the error loading patent, but was much less well qualified to speak on that patent than DataCard’s expert. However, he was better qualified to assist the court in relation to the RFID Patent than DataCard’s expert.

Defining the “skilled person”

The court considered the statement of Lord Justice Jacob in *Rockwater v Technip France SA* (formerly Coflexip SA) [2004] EWCA Civ 381, [2004] All ER (D) 63 (Apr). He said that it was not helpful to approximate real people to the notional “skilled person”. Instead, the question to be determined was whether the expert witness’s reasoning and ability were sufficient to teach the court. In reaching this decision it was relevant to consider the extent to which the expert witness’s qualifications (as opposed to his or her degree of inventiveness) approximated to those of the “skilled person”. If one expert was in the field at the relevant time, and particularly if he or she considered the problem to which the patent is addressed at that time, then that expert witness’s evidence would be likely to carry more weight than that from another not in the field at the relevant time, even if that expert was, on the face of it, more qualified.

Consequently, although DataCard’s expert witness was more likely to be able to speak to the perception of the “skilled person”, this did not mean that that expert’s opinion should necessarily be accepted. It was still necessary to consider the cogency of the expert’s reasons.

Against this was weighed the lack of specific experience of Eagle Technologies’s expert in card printers which, to some extent, had been offset by his general engineering knowledge and his involvement with similar (but not identical) technology at the relevant time.

Don’t rely on my chap, he’s not that expert!

In this case, counsel for the claimant sought to exploit the lack of specific knowledge of printer design by Eagle Technologies’s expert with a view to discrediting his evidence. But then, in his closing submissions, he relied heavily on that same expert’s statements regarding the validity of the error loading patent. The court was then subjected to the spectacle of the defendant’s counsel countering this tactic by submitting that his expert was not properly qualified to assist the court in relation to that patent. All in all, a most unsatisfactory position for both parties and for the court.

Summary

This case highlights the need for great care when selecting expert witnesses, particularly if there are separate and distinct areas of expertise involved.

It also illustrates the factors that the court will consider when weighing the admissibility or probative value of expert opinion. While it is important to ensure that an expert witness is properly qualified in the appropriate field, it is also important to ensure that the expert’s knowledge and experience is in that field at the relevant time.

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