Standard Instructions to Expert Witnesses in Patent Litigation

Application of the Court's Guidelines

The following guidelines are to be provided to experts giving evidence on the question of inventive step (obviousness) in proceedings under the ***Patents Act*** *1990* (Cth), together with the Harmonised Expert Witness Code of Conduct (Annexure A to the Expert Evidence Practice Note (GPN-EXPT)).

These guidelines explain some key terms relevant to the Court's assessment of obviousness, describe the risk of hindsight bias arising in evidence about obviousness, and set out steps that can be taken to minimise that risk.

1. Background: the test of obviousness

Under the Patents Act, an invention is taken to involve an inventive step unless the invention would have been obvious to a person skilled in the relevant art in the light of the common general knowledge as it existed before the priority date of the relevant claim of the patent.

The common general knowledge may be considered separately, or together with pieces of prior art information, such as a document published before the priority date. These pieces of information are to be considered individually, unless the skilled person could, before the priority date, be reasonably expected to have combined some or all of them. Depending on the dates on which the patent was filed and examined, there may be other criteria relevant to determining whether prior art information may be considered.

Accordingly, key issues for which expert evidence can be especially relevant and helpful to the Court when considering the test of obviousness include the identification of the technical field(s) of the invention of the patent, the relevant expertise of the person or team skilled in the art (relevant technical field(s)) and the specific content of the information comprising the common general knowledge of the skilled person or team.

2. The priority date

The priority date is usually the date that a patent application for the invention was first filed, whether in Australia or another jurisdiction. It is possible that an expert witness will be asked to consider matters as at several possible priority dates, if the correct priority date is in issue in the proceeding.

3. The person skilled in the art

The "person skilled in the relevant art" is the hypothetical person (or team of people) from whose perspective the invention is evaluated and the patent is read and understood. They are a skilled, but non-inventive, worker or team in the field of the invention - someone who may be taken to have a practical interest in the subject matter of the invention, who will have the qualifications of, and an understanding of the practices and techniques regarded as commonplace and known in the field by, the notional worker, at the relevant priority date(s).

4. The common general knowledge

The common general knowledge of the hypothetical skilled person is the foundation for any assessment of whether an invention would have been obvious.

For older patents (ie. patents granted before 15 April 2013 or patents granted on applications for which examination had not been requested as at 15 April 2013), the relevant common general knowledge is limited to Australia and its surrounding waters and airspace. For patents more recent than that, the information that comprises the relevant common general knowledge is not restricted to Australia and its surrounding waters and airspace.

The common general knowledge is the general background knowledge that is available to all in the field. It consists of matters that the person skilled in the relevant field will have at the back of their mind when working in the field, but is not necessarily knowledge that has been memorised. It will also include material that those persons know exists and to which they would refer as a matter of course.
For instance, in some circumstances this may include standard texts or technical reference materials but only if the skilled person would refer to them as a matter of course.

A report prepared by an expert witness for use in Court relating to the question of inventive step should identify each relevant fact or matter that the expert considers forms part of the common general knowledge and why they consider it to be common general knowledge (in light of the matters set out in the preceding paragraph). The expert should clearly distinguish between facts or matters they consider were common general knowledge at the relevant priority date(s) and facts or matters that were not, for example where they knew them due to their own particular experience (eg. information or experience acquired in specific jobs or confidential projects).

Whether an expert is asked to opine as to the common general knowledge in the relevant field at the priority date of the patent in suit before the expert is provided with, or told about, the relevant patent is a matter for the lawyers assisting with the preparation of the expert's evidence.

5. What hindsight involves

Hindsight bias in the context of an obviousness assessment, refers to the use by an expert (usually inadvertently) of post-priority date knowledge and practice in an assessment of whether an invention was obvious as at the priority date of the patent, or in any decision-making process relating to that question.

Hindsight bias can arise in the evaluation of the likelihood, foreseeability or predictability of a past decision or event where a person already knows the outcome of that decision or event. It may involve:

(a) the selective recollection of information consistent with what a person already knows is true; and/or
(b) overstating the predictability of an outcome in the present, relative to its prior likelihood.

6. Why hindsight reasoning is impermissible

In patent cases, the risk of hindsight bias arises where an assessment is being made of whether a claimed invention was obvious to the relevant skilled person or team, with the common general knowledge they then had, as at the priority date of the patent. As research and development may have led to significant advances in the relevant technical field in the period between the priority date and the date of the litigation, and the invention itself may have become common general knowledge, reliance on hindsight in the assessment becomes a significant risk.

A person skilled in the relevant art acting as an expert witness may, due to their professional role/s have kept up to date with developments in the field in the period between the priority date and the date they are being asked to give their opinion. Consequently, there is a risk they unconsciously rely on that subsequent knowledge in making their assessment beforehand.

7. The need to avoid hindsight

To make a fair evaluation and provide an objective opinion to the Court, an expert must, to the extent possible, avoid reliance on hindsight.

It can be challenging for an expert, in particular one who has worked in the relevant field after the priority date, to provide a view not impacted by that later knowledge. However, an expert can take some steps to provide their opinion in a manner which minimises the risk of hindsight.

These include the following.

- Familiarising themselves with this note relating to the risks of relying on hindsight in the context of a patent case.
- Trying to fix their knowledge and the assessment they are making, as at the priority date and avoiding that knowledge being impacted by subsequent events. They could be assisted by focusing on particular events that occurred around that date - for example particular career milestones such as academic or corporate appointments or achievements.
- Avoiding conducting their own research, analysis or enquiries, including in relation to the patent in issue or post-priority date developments in the field, unless instructed to do so by the lawyers assisting in preparing the expert's evidence.
- Identifying how they first became aware of the invention in issue and when.
- In their evidence, providing transparent and detailed explanations of their logic, reasoning and information taken into account (and its source) in support of any opinions relating to the meaning of any claim or wording in a patent or whether any product, method or process was or was not routine or obvious.
- Acknowledging where hindsight is a risk (because of knowledge of, for example, the invention the subject of the patent) and explaining whether and how the expert has sought to negate the effect of hindsight.

Taking these steps should assist the expert to minimise the risk that the Court would consider that hindsight has impacted their opinion.