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The role of expert evidence in a patent dispute

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In the recent case of *Mühlbauer AG v Manufacturing Integration Technology Ltd* [2010] SGCA 6, the Singapore Court of Appeal overruled a judgment from the country's High Court in *Mühlbauer AG v Manufacturing Integration Technology Ltd* [2009] SGHC 45 concerning the issues of novelty and inventive step, holding that Singapore patent No 117982 ("the Patent") was both novel and non-obvious, and therefore valid.

The Patent, owned by Mühlbauer AG (the Appellant), relates to a device for checking and rotating electronic components. In the High Court proceedings the Appellant, as Plaintiff, has alleged that the Manufacturing Integration Technology Ltd – the Respondent in the Court of Appeal proceedings (the Respondent) – had infringed the Patent. The Respondent had acknowledged in the High Court proceedings that its device infringed all ten claims of the Patent, but counterclaimed that the Patent was invalid. The Appellant subsequently appealed against the lower court's decision that the Patent was invalid for lack of novelty and inventive step.

In reaching its decision, the Singapore Court of Appeal (SCA) felt it necessary to emphasise two preliminary points. One of these preliminary points relates to the role of expert evidence in a patent dispute.

Although the SCA considered the testimony of the expert witnesses in the case to be helpful, it took the view that the experts' views were not critical except in so far as they enabled the Court to understand what the precise claims were in the Patent. The SCA further emphasised that it is the Court which decides whether or not the requisite legal provisions have (or have not) been satisfied. This is consistent with the view stated by Jacob L.J. in the English case *Technip France SA's Patent* [2004] R.P.C. 46, where he said at paragraph 12 on the role of an expert witness that:

> *"Their primary function is to educate the court in the technology – they come as teachers, as makers of the mantle for the court to don. For that purpose it does not matter whether they do or do not approximate to the skilled man. What matters is how they are at explaining things."*

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The SCA further emphasised that in the legal test for inventive step under the *Singapore Patents Act*, "a person skilled in the art" does not assume knowledge and expertise that goes beyond what a reasonable person "skilled in the art" would possess. As stated in *McGhan Medical UK Limited v Nagor Limited Case No CH 1999 1720* (28 February 2001), and followed in the Singapore case of *Ng Kok Cheng v Chua Say Tiong* [2001] 2 SLR(R) 326, *"the addressee is deemed to be unimaginative and uninventive but is equipped nevertheless with a reasonable degree of intelligence and with a wish to make directions in the patent work."*.

In summary, it is important to take note that experts engaged for the purpose of patent litigation would normally possess knowledge as well as expertise that goes beyond the notional person skilled in the art. Therefore, both parties should ensure when submitting expert evidence to the court that the experts only put themselves in the shoes of "the person skilled in the art" – *i.e.* skilled but unimaginative – and not assume knowledge and expertise that goes beyond that. Otherwise, the expert evidence may not be useful to the court.

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