

THE ROLE OF THE SKILLED ADDRESSEE

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Introduction

In New Zealand, as in other English law countries, the notional or skilled addressee plays a centre-stage role in both obviousness and insufficiency challenges to the validity of a patent. There are many terms for what one New Zealand judge colourfully described as “this wraith-like creature who stalks the Reports of Patent Cases”¹. Some of these terms were collected by Finkelstein J in *Root Quality Pty Limited v Root Control Technologies Pty Limited*², namely the “notional skilled addressee”, “the uninventive skilled worker in the particular field”, “the non-inventive worker in the field”, “the person skilled in the art” and finally “the non-inventive hypothetical skilled addressee”.

The reason for this fictional character was expressed by Kirby J of the High Court of Australia in *A B Hassle v Alphapharm*³:

“The reason for interposing this fictitious person is clear. Judges themselves (or juries in the days when juries decided such questions) could not be experts in all the fields of science and technology involved. They were, therefore, invariably reliant upon expert evidence in the particular field to prove what was ‘obvious’ at the relevant date and what was not; what involved in ‘inventive step’ and what did not. It would defeat the purpose of the Act if the applicable test were to be expressed in terms of what was obvious, as such, to a jury, to a judge or even to a reasonable person.”

The test for obviousness has been described as “an objective one which does not turn on the insights gained or lacked by any particular individuals”⁴. However, the aim of the parties in any patent dispute is obviously to provide a real-life skilled addressee whose actual experience and qualifications closely match that of the hypothetical person. If the Court feels sufficiently impressed by the qualifications, evidence and demeanour of the real person, then it is likely the Court will adopt the witness’s views and opinions as reflecting those of the objective skilled addressee. In the New Zealand case *Lucas v Peterson*⁵ for example, one of the experts for the patentee expressed the view that “he would have liked to have thought of” the combination of features in the claim in issue. Fisher J observed that if the combination was not obvious to this witness “it is difficult to believe that it would have been obvious to the ordinary hypothetical skilled operator in that field at the time”⁶.

However, the Courts and the parties must be ever alert to the danger of eliding the actual witness with the skilled addressee. In the *Windsurfing International Inc*⁷ Oliver LJ emphasised the importance of not attributing to the skilled addressee human qualities either of constitutional

¹ Barker J in *Beecham v Bristol-Myers (No. 2)* [1980] 1 NZLR 192, 232. In *Windsurfing International Inc v Tabur Marine* [1985] RPC 59 Oliver LJ noted that his “cousins” were the Reasonable Man and the Officious Bystander

² (2000) 49 IPR 225 para 70

³ (2002) 56 IPR 129, 167 para 148

⁴ *Lucas v Peterson Portable Sawing Systems Limited* (2003) 57 IPR 305 para 81 per Fisher J

⁵ *Ibid* para 80

⁶ *Ibid* para 81. This case is on appeal where one of the issues is whether there was too close an identification of the actual witnesses with the hypothetical addressee

⁷ [1985] RPC 59, 71

idleness or of perception beyond the knowledge and skill in the field in which he is hypothetically supposed to operate.

The embodiment of the skilled addressee

(a) *The relevant field of art*

The obvious first step in choosing the skilled addressee is to identify the field that is relevant to the subject matter of the patent. This is a critical consideration in order to narrow down the search for the skilled worker - as well as to set the context of the common general knowledge that the hypothetical addressee will have at the priority date⁸.

If the field is defined too narrowly, then a person may appear to be inventive when in fact, in a broader context they would not be so. Yet even this proposition cannot be expressed absolutely. In other fields of scientific pursuit, quite the reverse may be true.

As Fisher J observed in one New Zealand case⁹:

“One cannot, I think, have a person who compared with others in his or her chosen narrow field might appear to be an inventor but who would be regarded as no more than an unimaginative artisan when viewed on a larger stage. The point of patent law is to protect ideas which can properly be regarded as inventions when viewed from the perspective of the community as a whole. In practical terms this means that in this case, one must not limit the inquiry to obviousness from the perspective of the staff of the manufacturers, however highly qualified and experienced they might be. One must also consider obviousness from the perspective of the electronics industry in general, this including the consultant electronics engineers who block out the circuits for electric fence manufacturers when engaged for that purpose.”

Once the field of art has been carefully and thoroughly identified, then it is essential that the expert witness being put forward as the embodiment of the skilled addressee be appropriately qualified or have experience in that field. It is axiomatic that where an expert's experience in a particular field is limited, then the Court is likely to reject the views of that expert in favour of a witness with broader experience. For example, in *Novartis New Zealand Limited v Ancare New Zealand Limited*¹⁰ the relevant field was the make-up of anthelmintic compositions in drenches for the treatment of cattle, sheep, lambs, deer, and goats. Morris J preferred the views of an expert whose experience was of long duration and extent in drenches over the views of a witness whose experience was confined “almost exclusively” to one type of drench.

The consequences of not being appropriately qualified in the relevant field were dramatically shown in *Fina Research SA v Halliburton Media Services Inc*¹¹. There, during the course of the trial, Moore J ruled out evidence being given by a witness with general expertise of, and experience with, the petroleum industry. The real matter in issue was concerned with the functions of a drilling mud. The witness in issue had given no evidence that he had ever formulated drilling mud or addressed the various compounds of such mud. His evidence was therefore ruled inadmissible at the threshold.

⁸ *ICI Chemicals v Lubrizol Corp Inc* (2000) 106 FCR 213, 232 para 56

⁹ *Gallagher Electronics Limited v Donaghys Electronics Limited* (1992) 5 TCLR 31, 41

¹⁰ CP 480/97, High Court Auckland, Morris J, 19 June 1998

¹¹ [2003] FCA 55

(b) What happens if there is no relevant expert in the particular field in the country?

The starting point must always be proving the skilled addressee and his or her common general knowledge **in the jurisdiction** at the priority date. But in highly specialised fields, there may be no expert in New Zealand or in Australia or both. This will occur with many PCT patents where there is no indigenous industry and often no local expert.

In many scientific fields these days there are Trans-Tasman specialist groups which regularly hold conferences in one or both countries – and to which overseas experts are invited to speak. In such fields, this has led to a merging of expertise across Australasia and indeed often even wider. Accordingly it may be appropriate for a witness from Australia to give evidence in New Zealand patent proceedings or vice versa. In each case, it is a factual enquiry.

In *Amarillo Cell Culture Co Inc v Fernz Corporation Limited*¹², Barker J noted that there may be no significant difference between the common general knowledge of the skilled worker from one country to another (and *a priori* the skilled worker himself). But that cannot be assumed and must be proved¹³. In *Ancare*¹⁴, Morris J accepted the evidence of a scientist who had worked in both the UK and Australia (and not New Zealand) and was in the UK at the relevant date. This witness gave evidence that formulation practices for animal drenches were essentially the same in New Zealand and Australia and had been for many years. On this basis his evidence was admitted and indeed was preferred.

Difficulties in identifying appropriate expert witnesses in the jurisdiction are illustrated by the Australian case *Gambro Pty Limited v Fresenius Medical Care Australia Pty Limited*¹⁵. In that case the relevant art was the design of kidney dialysis machines. No designer or manufacturer of such machines was in Australia at the priority date. Dialysis technicians, who worked the machines, gave evidence. These witnesses were not responsible for improving or inventing such machines and were not fully aware of the scientific principles employed by them. This evidence was useful in identifying the prior art and its limitations but the witnesses did not fully represent the relevant skilled addressee. The Court held that the skilled addressee would be a person who designs and improves dialysis machines. Although no such person existed in Australia, the Court accepted that there would be experts with the appropriate knowledge of the underlying principles and practical workings of such machines¹⁶.

(c) The embodiment and attributes of the skilled addressee or team

In New Zealand in *Beecham v Bristol-Myers (No. 2)*¹⁷, Barker J noted the following general principles:

- (a) The skilled addressee is presumed to be a skilled technician, knowledgeable in the relevant literature, including patent specifications, but incapable of a scintilla of invention;
- (b) The notional addressee need not be an individual but may be a research team;
- (c) It is to be presumed that the notional addressee would seek advice on aspects with which he is not familiar¹⁸;

¹² CL 52/93 High Court Auckland, 3 October 1994, Barker J

¹³ *Wellcome Foundation Limited v V R Laboratories Pty Limited* (1980-1) 148 CLR 262, 284

¹⁴ *Supra* fn 10

¹⁵ 2004 FCA ...

¹⁶ *Ibid* paras 356-9

¹⁷ [1980] 1 NZLR 192, 232

¹⁸ Citing *Tectra Molectric Limited v Japan Imports Limited* [1976] RPC 547, 583 per Buckley LJ

- (d) It is presumed that the notional addressee believes what he finds in the documentation to be true.

As to proposition (c), although Barker J stated this as a general principle, it would need to be established as a matter of fact in each case whether the notional addressee would seek such advice.

With many patents, particularly in the pharmaceutical field, it is now commonplace that the skilled addressee comprises a **team** of different scientists¹⁹. For example, a pharmaceutical for treating heart conditions may require the skilled team to comprise a cardiologist, a medicinal chemist and a pharmacologist. In *Ancare v Novartis*²⁰ Morris J held that in respect of anthelmintic compositions and drenches, the skilled addressee was a team comprising a toxicologist, a chemist and a formulator.

However where the field is occupied by practical tradesmen rather than by scientists, claims to an invention “should be considered against the background of **that** field, not of some unreal field peopled by a technological elite. What must be taken into account is the common general knowledge and skill of the relevant calling”²¹.

The skilled addressee or team may very well differ depending on whether the ground of challenge is obviousness or insufficiency. Sometimes different skills are required to make an advance in the art, i.e. inventive step, as opposed to determining the sufficiency of the description in the patent. With insufficiency, the test is whether the complete specification as a whole contains such instructions as will enable all those to whom the specification is addressed to produce something within each claim by following the directions of the specification without any new invention or additions of their own²².

In *Genentech Inc’s Patent*²³, Mustill LJ in the UK Court of Appeal suggested that in the complex field of recombinant DNA technology, the amino acid sequencer who would be a vital member of the discovery team would be redundant when it came to assessment of insufficiency. This was because the addressee reading the patent would already know the full length of the protein sequences because they were in the patent.

(d) The level of skill of the uninventive skilled addressee

The level of skill which the skilled addressee has is a critical consideration. It is axiomatic that if the level of skill is pitched too high then it may be that every so-called inventive step will be obvious. Conversely, pitching the level of skill too low will virtually ensure that the patent will be found to contain an inventive step.

It is generally true to say that with pharmaceuticals and veterinary compositions, the expectation is that the addressee or team will have PhD qualifications in a relevant field of science and this is expressly recognised in the cases²⁴. Members of the skilled team may have different levels of academic qualification and practical experience²⁵.

¹⁹ *Dow Chemical Company (Mildner’s Patent)* [1975] RPC 165, 169 per Scarman LJ; *Boehringer Mannheim GmbH v Genzyme Limited* [1993] FSR 716, 720 Aldous J; *Ancare* [2000] 3 NZLR 299, 316 para [66] CA

²⁰ CP 480/97, High Court, Auckland, 19 June 1998

²¹ *Leonardis v Sartas (No. 1) Pty Limited* (1996) 67 FCR 126, 146

²² *Blanco White Patents for Invention* 5th edition para 4-502

²³ [1989] RPC 147

²⁴ For example, *Genentech* [1989] RPC 147, 241 per Dillon LJ

²⁵ *Genentech* [1989] RPC 147, 278 per Mustill LJ

A decidedly complicating factor is that in highly technical fields, a degree of inventiveness, ingenuity or initiative is a pre-requisite for being involved in the field in the first place. This can cause real tension when laid alongside the requirement that the addressee be incapable of a scintilla of invention. In *Boehringer Mannheim*²⁶ Aldous J noted the requirement that the skilled addressee not have the imagination required to invent but observed “in practice it is unlikely that such persons exist, and none of the witnesses called to give evidence were incapable of invention”²⁷. Where one or more expert witnesses possess inventiveness, the Court must perform the difficult task of discounting those aspects of the witness’s evidence which portrayed or involved inventiveness.

(e) *The resources, equipment and staff of the skilled addressee or team*

An allied issue is to ascertain what sort of resources, equipment and staff the skilled addressee or team might have. This is not a usual enquiry but was touched on by the UK Court of Appeal in the *Genetech* case²⁸. Dillon LJ regarded it as “beside the point” to consider such matters as how long the hypothetical team would have been allowed for their work or what money from what source would have been available to finance them²⁹. He took it as accepted that there were no such constraints. Mustill LJ³⁰ was prepared to regard the hypothetical team as having “the best available equipment to see whether, so equipped, they could have found their way to a solution ...”. It seems therefore that the team must be credited with sufficient time and the best available equipment.

If the evidence shows that a skilled team at the priority date sub-contracted certain work to outside workers or an outside laboratory, then this too may need to be factored into the skill level or resources of the team³¹.

(f) *The common general knowledge possessed by the skilled addressee*

The extent of the common general knowledge held by the skilled addressee is plainly a critical issue in an assessment of both obviousness and insufficiency. In general terms with obviousness, the more extensive the knowledge base of the skilled addressee then the greater likelihood of a patent claim being found to be obvious. In the case of insufficiency, where the skilled addressee has a greater knowledge base, this can often increase the chances of the patent being found to provide a sufficient description of the invention and the method by which it is to be performed.

It is important to contrast the scope of common general knowledge in the UK, Australia and New Zealand with particular reference to obviousness.

In the UK, the combination of sections 3 and 2(2) of the Patents Act 1977 defines the “state of the art” against which obviousness falls to be considered:

“The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of the invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.”

²⁶ [1993] FSR 716

²⁷ Ibid 726

²⁸ [1989] RPC 147

²⁹ Ibid 246

³⁰ Ibid 278

³¹ See comments of Dillon LJ at 245; Mustill LJ at 278

The net result is that the skilled addressee is assumed to have read and understood all the available prior art anywhere in the world³².

In Australia, for patents subject to the 1952 Act, the position is very different as a result of the High Court of Australia decision in *A B Hassle v Alphapharm*³³. Prior art only forms part of the common general knowledge if it can be proved to actually form part of the common general knowledge of those in the relevant field. The test is therefore a factually based enquiry.

Under the 1990 Patents Act and the 2001 Amendment in Australia, it is possible to combine pieces of information found in prior disclosures provided that the skilled addressee could “be reasonably expected to have ascertained, understood and regarded as relevant” the information and would have regarded the disclosures as a single source of information³⁴.

In New Zealand, the statutory test for obviousness is measured against “what was known or used before the priority date of the claim in New Zealand”³⁵. The New Zealand Court of Appeal in *Ancare*³⁶ noted that exactly the same words are used in the New Zealand statutory provisions for obviousness and lack of novelty and that in two first instance decisions, New Zealand Courts had adopted a narrower approach to what was known in New Zealand when it came to obviousness. The Court expressly noted³⁷ that this was “not the approach preferred in the *Windsurfing* case” – i.e. which had applied an all documents approach to the common general knowledge. Unfortunately, the Court of Appeal decided that it did “not need to reach a final view on just what documents should be regarded as ‘known’ for the test of obviousness”.

This leaves New Zealand practitioners with some difficulties. Is the approach the *Windsurfing* test of considering all documents which can be shown to be available in New Zealand with the Court then giving appropriate weight to the documents and whether they would be considered by the skilled addressee? Or is the approach that of the *diligent searcher* used by Barker J in *Beecham v Bristol-Myers (No. 2)*³⁸ or by Fisher J in *Gallagher Electronics*³⁹ i.e. what was or ought to have been known to a diligent searcher⁴⁰.

Plainly the issue would benefit from some judicial elucidation. There is a possibly a hint in *Ancare* that the *Windsurfing* approach is to be preferred - as later in its judgment the Court specifically adopted the *Windsurfing* approach that “what is to be postulated is a skilled person or team at least sufficiently interested to read the cited material e.g. the Bayer patent and consider how praziquantel might be formulated in admixture with other materials active against nematodes to achieve a broader spectrum of activity”.

(h) Briefing the expert witness

When briefing the expert witness in New Zealand, it is a requirement to provide the witness with the Code of Conduct for expert witnesses contained in Schedule 4 of the High Court Rules. As

³² *Cairnstores Limited v A B Hassle* [2002] All ER 60 at 94; *A B Hassle v Alphapharm* (2002) 56 IPR 129 at paras 47-49

³³ (2002) 56 IPR 129

³⁴ S7(2) Patents Act 1990 as amended in 2001. See discussion in *Australia: A Patentee's Paradise?* O'Connell & Cooke [2003] EIPR 481, 484

³⁵ S41(1)(f) Patents Act 1953

³⁶ [2000] 3 NZLR 299, para 42

³⁷ Para 42

³⁸ [1980] 1 NZLR 197, 231-2

³⁹ (1992) 5 TCLR 31, 41

⁴⁰ Per dictum of Lord Reid in *Technograph Printed Circuits v Mills & Rockley* [1972] RPC 346, 355

in other countries, the requirements are that the witness has an overriding duty to assist the Court impartially and not to be an advocate for the party engaging the witness.

The Australian Full Court decision in *3M v Tyco Electronics Pty Limited*⁴¹ has had an impact on briefing practices in respect of expert witnesses in New Zealand. In that case, the witness was provided with a copy of the patent. The Full Court found that as a result “relatively little weight should be given to certain of that evidence ...”. To give the patent to a prospective witness is tantamount to leading the witness⁴².

In New Zealand it appears that most professional advisers have adjusted briefing practices so as to no longer provide the patent to the witness. This makes the briefing process more difficult and also likely involves a two stage brief where the expert is fully briefed on obviousness in the absence of seeing the patent. If the witness is also to be used in respect of insufficiency issues, it is only after a full brief has been taken on obviousness that the witness sees the patent.

Conclusion

It can be seen that the role of the skilled addressee involves a series of separate enquiries as to the appropriate field, the common general knowledge, the appropriate skill level and the equipment and resources available. Further, any inventiveness on the part of the skilled addressee must be discounted. Each of these assessments can be critical to whether a claim in a patent is obvious or insufficient.

The risk for the Courts is that the plain words of the statute can be lost if too elaborate a construct rises in a particular case. This was particularly identified by Kirby J in *A B Hassle v Alphapharm*⁴³:

“The foregoing exposition illustrates why this field of law has become encumbered with verbal expressions, sometimes remote from the statute. Unfortunately, such expressions are then picked up and applied to the case in hand in place of the statute itself. The special difficulties inherent in constructing the fictitious worker in a field such as pharmaceutical formulation were recognised by the primary judge. The process has introduced so many layers of obscurity that there is now a real danger of entering upon ‘a degree of unreality ... going well beyond reasonable hypothesis’⁴⁴ so that even a conscientious decision-maker will lose the way and forget that the statute is ultimately the only true statement of the governing law.”

⁴¹ (2002) 56 IPR 248

⁴² *Ibid* para 45

⁴³ (2002) 56 IPR 129

⁴⁴ *Lubrizol* (2000) 49 IPR 513, 533