

Bias in Patent Law: Inevitable? Problematic? Neither? Both?

Dr Siva Thambisetty

Associate Professor of Law

London School of Economics and Political Science



Bias

1. Patent law is an epistemic system
2. Incentives to litigate are skewed.
3. 'We see the world not as it is, but as we are.'



wiseGEEK

4. Textual devices in patents reflect multiple needs.

Cognitive burden on experts

Inventive step: Windsurfing/Pozzoli test (steps 1,2,3 and 4)

- 1a. Don the mantle of the notional, unreal person skilled in the art
- 1b. Map the common general knowledge to be distinguished from the state of the art; and ask her to forget post-priority common general knowledge

2. Inventive concept



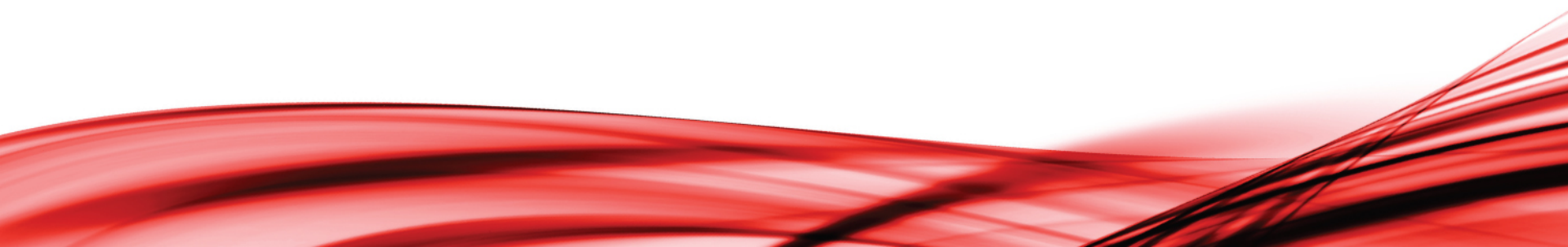
Relationship between 3rd and 4th step

- Identify differences between alleged invention and matter cited as known or used
- Decide whether without any knowledge of the known invention, whether these differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention.

Reconstructing non-obviousness

A black art.

American Sci & Engg v Rapiscan [2016] EWHC
756



Question 1

Is cognitive blinding
(asking expert to decide
as if she was not aware
of the invention?)
equivalent to
conventional blinding (no
awareness of invention)?



UK protocol on expert witnesses

8.1 Guidance to experts as well as those instructing them. Experts report must contain substance of all material instructions given.

Report is an iterative process between lawyer and expert. (Medimmune v Novartis [2011] EWHC 1669)

Question 2.

Who is this legal test addressed to? And what difference does this make?

Patent examiner (benefit of doubt at UKIPO)

Judge

Expert

Factors that help the judge

- Work within constraints of the legal test addressed to the court.
 - Purposive construction (Purpose & meaning not same)
 - Inventive Step
- Secondary factors, including commercial success or long felt need (not always available during patent prosecution)

Question 3

Should we not see hindsight as a subset of the existing contrivance of decision making?

But **inappropriate weighting (bias)** becomes a function of adequate instruction, quality of your expert, judicial competence.

A decorative graphic at the bottom of the slide consisting of flowing, overlapping red and black lines that create a sense of movement and depth.

European Patent Office: constrained by legal test

The problem solution approach: Technical problem drawn from **closest** prior art

Hindsight built into the test, **technical prejudice** could be a problem, and **secondary considerations** not often used/allowed.

European Unitary Patent Court

Without the UK's involvement, the use of experts likely to be minimized.

More like the German version?



Bias

- Cognitive burden of decision making in patent law very high, convoluted, contrived.
 - Hindsight one of the contrivances, does not necessarily lead to unjustified weighting
 - Is it inevitable? probably. Is it problematic? Not always.
- 