Suggested Answers to the Questions in Chapter 15

1. **Do the various justifications for the patent system seem convincing? How can patent law be reconciled with competition law?**

   The good answer will:

   - Demonstrate knowledge of the theories that justify patent protection and their relationship with patents in practice. There is a 'moral' justification based on the assertion that there is a natural property right in ideas. Appropriation of ideas is therefore tantamount to stealing (Lockean theory). The second argument is that justice and fairness demand that there should be a reward for services useful to society – this justified a temporary monopoly for the patentee (Adam Smith, John Stuart Mill and Jeremy Bentham). The third argument is that patents are necessary to secure economic development – the incentive of patent protection is necessary to ensure that inventions are made. The fourth justification is the 'exchange for secrets' theory. This argument is that if there were no patents, inventions would be kept secret in perpetuity—e.g. as 'trade secrets' held within companies—and therefore would never be 'open' to allow follow-on research by other individuals or businesses.

   - Note that there is no single settled justification for patents. This leads to the point that the notion that patents are, de facto, a good thing must not be taken as a token of faith, but rather must be questioned. Reference to academic commentary is welcome (Lemley, Thambisetty, Merges and Neson, etc).

   - Conclude by considering whether the philosophical justifications for patent law bear much scrutiny – what are the real motivations for invention?

Suggested Answers to the Questions in Chapter 15

2. Who is the 'person skilled in the art' and why is this person so important to patent law? What defining characteristics does that person have?

The good answer will:

- Begin by explaining why there is a conception of the 'person skilled in the art' or 'skilled addressee'. It is important to understand that the skilled addressee is a judicial construct (a legal fiction). This is not a real person, but a hypothetical creature through whose eyes various issues in patent law are determined. The reason for having such a person is to impart objectivity (*Lilly Icos Ltd*).
- Focus on the situations where this is used in patent law to determine the following issues objectively: to construe the claims of the patent; to determine whether an invention is new under s.2 Patents Act i.e. whether the prior art contains enough information by way of enabling disclosure that the skilled addressee could have put the invention into effect before the priority date; to determine whether an invention possesses inventive step under s.3, i.e. it was not obvious to the skilled addressee; to determine the issue of industrial application; to determine sufficiency; to determine whether there has been an impermissable amendment; to determine infringement.
- Describe how the skilled addressee concept therefore plays a crucial role with regard to the validity and infringement of patents, and that the identification of such a person is a task which has to be undertaken by any court dealing with patent litigation. Note that like the task of deciding the inventive concept, the choice of the appropriate skilled addressee is a matter susceptible to the vagaries of judicial opinion. Cite cases such as *Dyson v Hoover* (the skilled addressee was held not to have any practical experience in the use of cyclone technology, which was important to the result).
- Conclude by reflecting on the fact that it has been suggested by the Court of Appeal in *Schlumberger Holdings Ltd* that in rare cases the skilled addressee might not be the same for all purposes: where the invention involves groundbreaking technology (so that the skilled addressee's knowledge is enhanced by reading the patent) a higher standard might be required for sufficiency than for obviousness. In the case of mechanical patents the skilled addressee is likely to be a graduate engineer in the relevant discipline with practical experience in the field in question (*Dyson v Hoover*).