Identifying the Issues at Hand and Conducting Research

**Early in any intellectual property litigation case**, the legal team identifies the key legal issues. The scientific advisor is involved from this initial stage and helps to clarify the scientific issues which support the legal arguments. In many ways this is the equivalent of developing a hypothesis in a problem-based research program.

The next step in the process for a scientific advisor is to identify key scientific articles and patents that will support the legal argument.

This step requires a great deal of comprehensive research. In most cases, these scientific articles and patents, collectively referred to as “prior art” have been available to the public before a given date. Efficiency in prior art searches comes with experience and although research literature searches provide a good base, prior art searches are more comprehensive and involve searching patent databases.

Analytical and Deductive Thinking

Experience in the preparation of scientific manuscripts and drafting of patent applica-
tions enables more adept identification and analysis of information available to the public before a given date.

When reviewing scientific articles and patent documents, the purpose of the document must always be kept in mind, that is, what information it provides to a scientist reading it. Comprehending the words in the context that they are used and not “filling in the blanks” with assumptions for what scientists or inventors may have meant is very important. One important aspect of reviewing prior art is that it has to be done through the eyes of a “person skilled in the art”. The person skilled in the art is a legal term that refers to a fictional person or persons with skills and knowledge in a particular field, but one whom does not have any imagination or creativity in terms of how they view the information, thus someone who can provide assessment solely on the merit or content or the subject rather than trying to evolve the idea further. This may be difficult for a scientist, as it is contrary to most scientific training. More often than not scientists engage in long discussions with colleagues and peers about the latest publications in their field which lead to brainstorming sessions and new ideas which may become scientific discoveries.

In some cases, the prior art may have been written 40 or 50 years ago. Scientific terminology has changed since then, and sometimes it becomes challenging to read these articles through the eyes of a scientist at the time of publication. This requires the ability to distinguish current state of knowledge on a topic from what was known at the time the article or the patent was filed and published. In addition, it requires understanding of what the scientist/s was/were trying to convey at that time based on the data presented. It is at this stage that experts in the field are engaged in the litigation process.

Written and Verbal Communication

Both written and verbal communication skills are critical to the scientific advisor in intellectual property litigation. Valuable experience in communication is gained during scientific training when writing up hypotheses, methodologies, experimental designs and conclusions. In general, methodology and experiments are written in detail while hypotheses and conclusion are written to the point. The experience of abstract writing is particularly useful as a scientific advisor because it requires flushing out in writing the essence of the research. Equally important, is to always have the reader in mind. In intellectual property litigation cases, science should not be left to the imagination. Clear and concise communication to the reader, in most cases a judge, is paramount.

Scientific communication in the legal field requires simultaneous focus on the scientific issues, as well as the legal issues relevant to the case. As a scientist, this presents an opportunity for continuous learning of relevant legal issues that relate to patent litigation.

While the bulk of communication in the legal field is in written form, scientific concepts are often communicated verbally to the internal legal team. Scientific evidence is presented to the courts in the form of affidavits from scientific experts in the relevant fields. Identification of and communication with such experts in the relevant scientific field and serving as a liaison between them and the legal team are part of the responsibilities of a scientific advisor. Effective communication in expert affidavits often requires concise distillation of the information so that the information most relevant to the case and to a
Science Communication in Intellectual Property Litigation

Rahimpour

Science communication in intellectual property (IP) litigation is a critical aspect of the legal process, particularly when experts provide technical evidence. The target audience in IP litigation is generally the judge who will make the decision by construing the written documents. The challenge in presenting an evidence-based argument is to preserve accuracy in communication and to remain true to what was conventionally known about the topic and any inherent uncertainty of the subject at the time of publication.

Conclusion

In many ways, my scientific research training fostered the development of a set of transferable skills that I have put to use in my current position as a scientific advisor. Some of these skills have been highlighted above including written and verbal communication skills, research skills, critical thinking, and analytical and deductive problem solving. In addition, organizational, and project and time management skills are all strongly applicable to the legal work I am involved in. Being a scientific advisor to a legal team of extremely competent lawyers can be very exciting, challenging and rewarding.

About the Author

Rosa Rahimpour is a scientific advisor with Goodmans LLP, providing technical and scientific expertise to the litigation team. Rosa graduated from Yale University with a Ph.D. in Organic Chemistry and has worked as a medicinal chemistry consultant on intellectual property and drug discovery strategies. Further, as a Senior Research Scientist with a pharmaceutical company, she led a medicinal chemistry team in developing potential therapeutics in the areas of pulmonary hypertension, cognitive impairment and inflammation.