Intellectual Property Office

BL O/0133/23

07 February 2023

PATENTS ACT 1977

APPLICANT	Professor Fleur T Tehrani
ISSUE	Application to correct GB2423721 under section 117 of the Patents Act 1977
HEARING OFFICER	Phil Thorpe

DECISION

Introduction

1. In a decision[1] dated 22nd December 2021, Hacon HHJ, sitting in the Patents Court, declared UK Patent No. GB2423721 (the Patent) in the name of Professor Fleur T Tehrani invalid.

2. The Patent had the title "Method and apparatus for controlling a ventilator", and related to a system for controlling a ventilator, i.e. an artificial respirator for a patient. Claim 1 of the patent, that was found to lack novelty over an item of prior art referred to as “Waisel”, read as follows:

> *1. An apparatus for automatically controlling a ventilator comprising:*
>
> *first means for processing data indicative of at least a measured oxygen level of a patient,*
>
> *and for providing output data indicative of required concentration of oxygen in inspiration gas of the patient (*FiO_2*) and positive end-expiratory pressure (PEEP) for a next breath of a patient,*
>
> *wherein* FiO_2 *is determined to reduce the difference between the measured oxygen level of the patient and a desired value;*
>
> *wherein PEEP is determined to keep a ratio of PEEP/* FiO_2 *within a prescribed range and while keeping the ratio within the prescribed range, to keep the measured oxygen level of the patient above a predefined value; and*
>
> *second means, operatively coupled to the first means, for providing control signals, based on the output data provided by the first means, to the ventilator*

[1] *Tehrani v Bonaduz AG and Others* [2021] EWHC 3457 (IPEC))

wherein the control signals provided to the ventilator automatically control PEEP, and FiO_2*, for a next breath of the patient.*

3. Central to the judgement of Hacon HHJ was the meaning to be ascribed to the phrase “a next breadth of the patient”. Hacon HHJ noted that:

> “52. The point in issue was whether "a next breath" should be construed to mean "the next breath", implying that the control signals adjust FiO2 and PEEP for every breath of the patient. Alternatively "a next breath" just means a breath some time in the future.”

4. He went on to conclude, having regard to the ordinary meaning of the use of the indefinite article in "a next breath", that it meant the latter – “a breadth some time in the future.” This subsequently led to the patent being found invalid.

5. Following the judgement, Professor Tehrani sought to amend the claims of the Patent under section 75 of the Patents Act 1977 (the Act). The amendment sought was to simply replace “a next breadth” with “the next breadth” in the claim. Hacon HHJ. dismissed[2] the application to amend on the basis that to allow the amendment would be at odds with the rule in *Henderson v Henderson*[3] and the Civil Procedure Rules (CPR) overriding objective[4]. Both Henderson and the Overriding Objective go against allowing amendments that are likely to require a further and new trial.

6. Professor Tehrani did not appeal either the earlier judgement finding the patent invalid or the later judgement refusing permission to amend.

7. Professor Tehrani has however now requested that the Comptroller correct the patent under section 117 of the Act to replace “a next breath” with “the next breath” in claim 1.

8. Professor Tehrani has in separate proceedings also requested a review under section 74B of an Opinion[5] issued by the IPO that concluded that the patent was invalid.

9. This request under section 117 raises a number of issues which I summarise as follows:

    i. Can the provisions of Section 117(1) be used to correct a patent that the courts have found to be invalid?
    ii. If so, is it appropriate to exercise the Comptroller’s discretion in this specific case?
    iii. If it is appropriate would the proposed correction meet the general test for assessing whether a correction is allowable namely:
        a. Is it clear that there is an error, and

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[2] Tehrani v Bonaduz AG and Others [2022] EWHC 1031 (IPEC)

[3] *Henderson v Henderson* (1843)

[4] Civil Procedure Rules – Overriding Objective

[5] Opinion 26/20

b. If so, is it clear what is now offered is what was originally intended?

10. In an email to Professor Tehrani dated July 11th 2022, I indicated my initial thoughts and reasons as to why I thought such a correction was not allowable so as to assist Ms Tehrani in deciding if she wished to be heard on the matter.

11. Professor Tehrani was asked on a number of occasions whether she wished to withdraw her request for a correction or whether she wished to be heard on the matter. The latest was an email dated October 7th 2022, which noted:

> "In terms of the matters outstanding at the IPO then you have requested that the patent be corrected under section 117. I have set out the IPO's preliminary view that no correction of the patent is possible. You have been asked if you wish to be heard on the matter before a decision on that matter is issued. You have not clearly indicated you wish to be heard. If the IPO does not hear within 4 weeks of this email that you do want to be heard then it will proceed to issue a decision on the basis of the submissions you have made to date. The second outstanding issue is the review you requested of opinion 26/20 under Section 74B. That review was stayed pending the outcome of the court proceedings. You can if you wish continue with the review though that would seems to be merely an academic exercise as even if the opinion was set aside it would have no impact on the Court judgement declaring the patent invalid. I would again reiterate that reviews of opinions are limited to considering whether an opinion on the basis of the material before the examiner reached a conclusion that is clearly wrong. In any review consideration may need to be given to any court judgement on any relevant matter. If in light of this explanation you now wish to withdraw your request for a review then can you please advise us of that within 4 weeks of this email."

12. In an email response dated 7th October 2022, Professor Tehrani again repeated a number of previously filed arguments and questions. On the specific request for clarification if she wanted to be heard on either the matter of the correction or the request for a review of the opinion she noted:

> "Please be informed that I am not consenting to any decision on the Opinion to be made on paper and without a hearing."

13. In light of an absence of any explicit indication that Professor Tehrani wished also to be heard on the question of the correction, this decision has proceeded on the basis of the papers.

Can the provisions of Section 117 be used to correct a revoked patent?

14. Section 117(1) of the Act states:

> *The comptroller may, subject to any provision of rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.*

15. The use of Section 117 to correct an application that was taken to be withdrawn was considered by Falconer J in *Payne's Application*[6] who noted that:

> "*The application now, under the statute, must be deemed to be withdrawn or rather, to take the exact words of the statute, must be taken to be withdrawn, so that it is no longer there. It follows that section 117(1) cannot be applied to correct an application which is no longer there, which no longer exists, which has been withdrawn*."

16. While *Payne's Application* related to a patent that had been withdrawn there are parallels to the present case. Indeed, the conclusion reached in *Payne's Application* would seem to apply even more here given that when a patent is revoked it is deemed never to have been granted.

17. The same reasoning appears to have been applied by the hearing officer in *GMC Tools (UK) Ltd v Makita Corporation*[7] when considering whether to allow a correction whilst revocation proceedings were ongoing:

> *"Further, whilst disposing of the correction action won't dispose of the revocation action, disposing of the latter could dispose of the former in that if the patent were revoked, there would be nothing to correct."*

18. It is clear that the decision of Hacon HHJ declaring the patent invalid means that the patent is deemed never to have been granted. As such, there is no longer a patent to correct and hence Professor Tehrani's request to correct under Section 117 must fail.

19. Given the clear position on the first question – is it possible to correct a patent found to be invalid? - it is not necessary for me to go on and consider whether it would have been appropriate to exercise the Comptroller's discretion to allow a correction and also whether the proposed correction would have met the legal test. I would however note briefly that I can see no basis on which the Comptroller would exercise his discretion to allow a correction that is identical in effect to an amendment that was refused by the Court. I am also not persuaded that the proposed correction would meet the two-stage test for corrections. However, as I have indicated I do not need to decide these matters here.

Conclusion and finding

20. GB2423721 has been declared invalid by the Court. There is therefore no basis on which it can now be corrected. Hence Professor Tehrani's application to correct the patent under section 117 is refused.

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[6] *Payne's Application* [1985] R.P.C. 193

[7] *GMC Tools (UK) Ltd v Makita Corporation* BL O/121/07

Appeal

21. Any appeal must be lodged within 28 days after the date of this decision.

Phil Thorpe

Deputy Director, acting for the Comptroller