

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY AND ENTERPRISE COURT

Case No. IP-2019-000196

Neutral Citation Number: [2022] EWHC 1031 (IPEC)

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Fetter Lane
London
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Friday, 18th February 2022

Before:
HIS HONOUR JUDGE HACON

B E T W E E N:

TEHRANI

and

BONADUZ AG AND OTHERS

THE CLAIMANT appeared In Person
MR WARD appeared on behalf of the Defendant

JUDGMENT
(Approved)

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HHJ HACON:

1. On 22 December 2021, I handed down judgment in this action. I found the patent in suit to be invalid, principally because claim 1 lacks novelty over an item of prior art referred to as “Waisel”.
2. The claimant and patentee, Professor Tehrani, now applies to amend the claims of the patent under section 75 of the Patents Act 1977.
3. Professor Tehrani was professionally represented at trial but is no longer. She has a McKenzie friend who has assisted her in the preparation of this application, namely Paul Cole. Mr Cole is a patent and trademark attorney and is a partner at the firm Lucas & Co.
4. Two documents written by Mr Cole headed “Witness Statement” have been filed, although I am not sure they can be accurately said to have that status. A further statement from Mr Cole was provided in the form of an email to the Court dated 16 February 2022.
5. I have read all three documents. I have also read Professor Tehrani’s skeleton argument and that of the defendant’s counsel. There has been further oral argument. I have heard from Professor Tehrani and I also allowed a brief statement by Mr Cole.
6. The amendments sought are not complex. Claim 1 one of the patent claims an apparatus for controlling a ventilator. One of the integers of the claim requires a means for providing output data indicative of, among other things, “positive end expiratory pressure (PEEP) for a next breath of the patient”. The proposed amendment is to replace the indefinite article with a definite article, so that the output data is indicative of PEEP for the next breath of the patient.
7. Another integer of claim one requires a means for providing control signals which automatically control PEEP and the concentration of oxygen in the inspiratory gas of the patient for a next breath of the patient. A similar amendment is proposed so that the control signals would control PEEP and oxygen concentration for the next breath of the patient.
8. There would be consequential amendments elsewhere in the claims and in the body of specification.
9. In *Warner-Lambert Company LLC v Generics (UK) Ltd and another* [2018] UKSC 56, the Supreme Court discussed the effect of EPC 2000 on national laws of contracting EPC states with regard to the amendment of patents. In particular, the Court considered the question whether the discretion of national courts in relation to amendment had been extinguished. Briggs LJ said:

“114. To that question the Court of Appeal has thus far provided a clear answer. In *Nikken Kosakusho Works v Pioneer Trading Co* [2005] EWCA Civ 906, it drew a sharp distinction between (a) pre-trial patent amendments, (b) post-trial patent amendments to delete claims which had been found invalid, and (c) post-trial patent amendments designed to set up a new claim which had not been adjudicated upon at trial. If a type (c) amendment would provoke a validity challenge which required a further trial then, generally, both the principle in *Henderson v Henderson* [1843] 3 Hare 100 and the Overriding Objective in the Civil Procedure Rules would militate against giving permission to amend, if the new claim could have been put forward by amendment in time for the first trial.

115. In *Nokia GmbH v ICom GmbH & Co KG* [2011] EWCA Civ 6, the Court of Appeal took the opportunity to consider whether either *Johnson v Gore Wood & Co* [2002] 2 AC 1 or article 138(3) of the EPC (as amended in 2000) required the principles laid down in the *Nikken* case (“the *Nikken* principles”) to be reconsidered. Jacob LJ

held, at paras 108-109 that there was nothing in *Johnson v Gore Wood* inconsistent with the *Nikken* principles. Although the test was one of abuse of process and the onus on the person alleging abuse, vexing a defendant with two trials about the same patent by means of a post-trial amendment was prima facie abusive, if the amendment could have been made in time for all issues about the patent to be adjudicated upon at a single trial. As for article 138(3), the creation of a right to amend was simply designed to ensure that all contracting states provided for amendment of patents. It was not designed to override the national law of each state about the timing, grant or refusal of amendments, and certainly not to legitimise what would otherwise be the abuse of a contracting state's process: see paras 127-129".

10. The remainder of Their Lordships agreed with Briggs LJ on this part of his judgment.
11. The application by the claimant in the present case is clearly for a type (c) amendment. Claim 1 with a definite article, in the parts of the claim I have mentioned, would almost certainly provoke a validity challenge; resolving that challenge would require a new trial.
12. The judgment of the Supreme Court does not absolutely rule out the possibility that the Court may allow a trial arising from an amendment of that sort, but the rule of public policy in *Henderson v Henderson* [1843] 3 Hare 100 will be relevant, and generally, the hearing of a further trial will be contrary to the rule and contrary to the CPR overriding objective.
13. It was argued by Professor Tehrani that she could not have anticipated that the Court would attach significance to the distinction between the definite and indefinite articles in claim 1, and that was the reason she did not apply to amend the patent before the trial.
14. That cannot be correct; the distinction was squarely raised in the first report of the defendant's expert. His interpretation of "a next breath" as opposed to "the next breath" was addressed by Professor Tehrani in response in her second expert report. It was a focus of argument at the trial and discussion in my judgment. There could have been no doubt that the correct construction of "a next breath" in claim 1 was going to be a significant issue, and so it proved. Professor Tehrani could have made a conditional application to amend the patent but did not.
15. Professor Tehrani today has argued that use of the definite article was an error caused by advice she received. The advice was that according to a patent drafting convention, the indefinite article should be used.
16. I do not see that such advice now makes any difference. As I have said, the significance of a distinction between the definite and indefinite article were clearly signalled well before the trial. That was the time at which an application to amend could have been made; it was not.
17. Mr Cole made three brief points. The first was that *Warner-Lambert* is not binding. I have not in the time available gone back to check whether the judgment of the Supreme Court on post-trial amendments is part of the ratio of that judgment, although I have the impression it was. At the least the judgment is of the highest persuasive authority and I must follow it.
18. Secondly, Mr Cole said that Professor Tehrani is just seeking to maintain the argument as she always maintained and that she had no reason to suppose that I would accept the defendant's arguments in relation to the definite and indefinite article in claim one.
19. As I have already said, the point was clearly signalled well before the trial, and so I had to deal with it; Professor Tehrani could only reasonably have assumed that I would deal with it, and that one possibility would be that I would accept the defendant's rather her argument or the point.
20. The final point raised by Mr Cole was that more latitude should be given to an individual litigant. That is sometimes a factor which must be taken into account, but not on this occasion.

The law on this point is clear. Before and during the trial Ms Tehrani was professionally advised.

21. In my view, an application to amend the patent now would contravene the rule in *Henderson v Henderson* and the CPR overriding objective. I therefore dismiss the claimant's application.

End of Judgment.

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