EIP

Inventor as Expert, Unable to Ventilate Appropriate Evidence

In Fleur Tehrani v Hamilton Bonaduz AG & Ors [2021] EWHC 3457 (IPEC), heard before the Intellectual Property Enterprise Court, ("IPEC") the court conducted an assessment of the validity of a patent for a method and apparatus for controlling a ventilator. The court held that the patent was invalid for lack of novelty and obviousness. This case also saw the claimant/inventor appear as their own expert witness.

Background

The claimant, Professor Tehrani, is the proprietor of the UK patent entitled "Method and apparatus for controlling a ventilator" (No. 2,424,721) (the "Patent"). The defendants, collectively "Hamilton", make and sell ventilators. Some of these ventilators incorporate what is called the "Intellivent-ASV System". Professor Tehrani alleged that marketing the Intellivent-ASV System infringed the Patent.

Hamilton denied infringement and counterclaimed for revocation of the Patent.

Expert Evidence

This case saw the rare situation where the claimant, Professor Tehrani, gave expert evidence on her own behalf. The Judge acknowledged that there were situations where an expert could be closely connected to the party for which he or she is giving evidence, such as being an employee, but raised concerns that there was an inevitable risk that the expert's views could be coloured by loyalty to their employer. In circumstances where the relationship between the expert and party is close, there may be a higher than usual

requirement for the expert to show, by the answers given and manner in which they are given, that the expert's clear and primary duty while giving evidence has been to assist the court objectively and truthfully. As Professor Tehrani was both claimant and inventor of the Patent, that requirement was more acute. Unfortunately for Professor Tehrani, the Judge considered she did not show the necessary indication of her objectivity, and although she did not intend to mislead the Court, her views of the case were not always fair and accurate.

Infringement and Validity Case

The arguments over infringement and validity centred around claims 1 and 45 of the Patent. The Judge found that Hamilton's Intellivent-ASV System implemented within some of their ventilators could infringe claim 1 but not 45 if the Patent was found to be valid.

Hamilton's revocation attack came via four pieces of prior art, abbreviated in the judgment to "Anderson", "Waisel", "US 268" and the "Tehrani Paper". Only Waisel was successful in Hamilton's attack where it was found that claim 1 lacked novelty and claim 45 was obvious.

Of interest, Hamilton sought to rely on the combination of the Tehrani Paper and US 268 to render the invention of claim 45 obvious. Hamilton's basis for reading the two documents together was the fact that the Tehrani Paper included a footnote which made reference to US 268. The Judge accepted this and acknowledged Hamilton's argument for lack of inventive step using the two documents, which set out a series of steps by which the teaching of the prior art could be adjusted to ultimately arrive at the invention of the Patent. However, the Judge did not accept this resulted in lack of inventive step noting that although each of the steps may be individually obvious, the fallacy of the argument is that performing all of them, without exception, may not have been obvious.

Take Away Points

Two interesting points stemmed from this case. Firstly, it is paramount to remember that an expert witness must always be independent and remain objective. Their duty is to the Court, and not to the party who is paying them. It is inappropriate for an expert witness to advocate for a party. Their duty is to provide fair and objective evidence on matters relating to their expertise. For assistance, Part 35 of the Civil Procedure Rules and the corresponding Practice Direction, plus the Guidance for the Instruction of Experts in Civil Claims provide a good introduction on how expert witnesses are to be independent and

objective. At worst, if a Judge finds expert evidence to be tainted, it will accord little weight with the Court.

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Secondly, it is important to remember that even if a series of steps in of themselves are each obvious, this will not necessarily mean that carrying them out consecutively will render an invention obvious.

The judgment is available here.