

16th May 2008

PATENTS ACT 1977

Conversor Products Ltd (CPL)

Applicant
(Claimant)

PROCEEDINGS

Application under section 72 of the Patents Act 1977 for
revocation of patent N^o GB 2 267 412 C

HEARING OFFICER Stephen Probert

DECISION

- 1 This decision concerns an unusual, but by no means unique, situation in which the proprietor of a patent has applied to revoke his own patent. More specifically, Conversor Products Ltd (“CPL”) says that the patent, GB2267412, (the “CPL patent”) should be revoked because the invention defined in some of the claims lacks novelty and/or does not involve an inventive step.
- 2 CPL also says that the patent is very similar to a European patent EP 0563194B1 (the “EP patent”) that was revoked for lack of inventive step following opposition proceedings before the Opposition Division of the European Patent Office (“EPO”).
- 3 Following the filing of CPL’s statement of grounds, the Comptroller notified several persons who appeared to him to be likely to have an interest in the case that proceedings had started, as required by rule 77(2) of the Patents Rules 2007; no counter-statement was filed.
- 4 One might be inclined to think that in a case such as this — ie. a patentee seeking revocation of his own patent, the EP equivalent of which has already been revoked for lack of inventive step — the Comptroller need not look too closely into the grounds for revocation, not least because no counter-statement has been filed. However, the history of this patent up to this point has been far from straightforward and I think it is necessary to set out some of the complications surrounding this case that might not otherwise be apparent.

A Brief History of the Patent

- 5 The register shows that the patent has been assigned and re-assigned on several occasions. The inventor of the patent, Mr Andrew James Jamieson Hall, has made two attempts under section 37 to establish that his company (or he personally) is the true proprietor of the patent. On the first occasion, the Comptroller declined to deal with the application¹, but Mr Hall did not take the matter to the Court and neither did he appeal against the Comptroller's decision to decline to deal. Instead, he filed a second reference before the Comptroller under section 37.
- 6 The Comptroller indicated that he was minded to strike out the second reference as an abuse of process because it raised essentially the same issues as the previous reference, and concerned essentially the same parties. Mr Hall was offered a hearing if he disagreed with the Comptroller's preliminary view, but he withdrew the reference instead.
- 7 Nevertheless, Mr Hall has not given up his claim to ownership of the patent. He has requested a correction of the register under rule 50 of the Patents Rules 2007. Mr Hall's request to correct the register has no part in these proceedings, except insofar as he maintains that if he succeeds in having the register 'corrected' to show himself as the registered proprietor (or co-proprietor), he would have the right to amend the patent (with a view to avoiding revocation) under section 75.
- 8 However, I note that Mr Hall was one of the persons who was considered likely to have an interest in this case, and he was notified that proceedings had started. He chose not to file a counter-statement. Therefore I must treat Mr Hall as supporting CPL's case as required by rule 77(9). This rule says:
- (9) Where—
- (a) a person was notified under paragraph (1) or (2); and
- (b) that person fails to file a counter-statement under paragraph (6) or (8),
- the comptroller shall treat him as supporting the claimant's case.
- 9 The history between Mr Hall and CPL leads me to suspect that Mr Hall may not have been aware of the consequences of rule 77(9) when he decided not to file a counter-statement. Nevertheless, the wording of rule 77(9) is absolutely clear, and there is no room for discretion. The Comptroller must treat Mr Hall as supporting this application for revocation. (As it turned out, my decision does not rely on treating Mr Hall as supporting CPL's case.)
- 10 More significantly as far as my decision is concerned, it is not clear to me that Mr Hall could now take advantage of section 75, even if the register were to be 'corrected' to show him as the registered proprietor, for two reasons: firstly, section 75(1) begins with the words "In any proceedings ...", but Mr Hall is not "in" these proceedings because he chose not to file a counter-statement; secondly, even if Mr Hall succeeds in having the register 'corrected' he would

¹ Decision BL O/296/07 dated 5th October 2007.

become the “registered proprietor” and section 75(1) only gives the Comptroller discretion to allow the proprietor (not the registered proprietor) to amend the patent.

- 11 To anyone not familiar with patent law, this may seem like splitting hairs; but it is well established that registration as proprietor is not proof that the person registered is in fact the proprietor of the patent. As section 32(9) of the Act makes clear, the register is only *prima facie* evidence of proprietorship. The question of proprietorship can be determined conclusively, for example, following a reference under section 37. In this case, given the Comptroller’s decision to decline to deal, that means that the court would have had to decide who is the proprietor; but Mr Hall appears to have missed his opportunity to take the question of proprietorship to the court ².
- 12 As far as these proceedings are concerned, I am directly interested in the validity of the patent, and not who owns it. I realise also that there is a public interest in removing invalid patents from the register. For these reasons I have determined CPL’s application to revoke the patent without waiting for the final outcome of Mr Hall’s request to ‘correct’ the register.

The Law

- 13 The Comptroller’s powers to revoke a patent on the application of another person are set out in section 72(1). With respect to the validity of the claims, the relevant parts read as follows:

Power to revoke patents on application

72.-(1) Subject to the following provisions of this Act, the court or the comptroller may by order revoke a patent for an invention on the application of any person (including the proprietor of the patent) on (but only on) any of the following grounds, that is to say –

- (a) the invention is not a patentable invention;
- (b) ...

- 14 In relation to section 72(a) above, I must also consider section 1(1) which defines the requirements for a patentable invention. It reads:

Patentable Inventions

1.-(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say –

- (a) the invention is new;
- (b) it involves an inventive step;
- (c)

and references in this Act to a patentable invention shall be construed accordingly.

² Under Civil Procedure Rule 63.11, where the Comptroller declines to deal with an application under section 37(8), any person seeking the Court’s determination of that application must issue a claim form within 14 days of the Comptroller’s decision.

- 15 The following parts of sections 2 and 3 are also relevant, since they define what is meant above by 'new' and 'inventive step'.

Novelty

2.-(1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

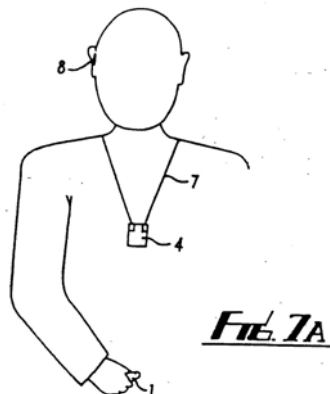
(3) ...

Inventive Step

3. An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

The Invention

- 16 The invention is a hearing aid system made up of three distinct components:
- a. A portable device including a transmitter and a microphone;
 - b. A receiver unit including an amplifier;
 - c. An ear-piece for connection to the receiver unit.
- 17 The transmitter unit with the microphone can be held in the hand or placed near the sound source eg. on a table in front of a television. It transmits a signal from the microphone to the receiver unit which would typically be worn as a pendant around the user's neck. The receiver unit is 'connected' wirelessly to an ear-piece. For example, the neck cord may include an induction loop driven by the amplifier in the receiver unit, thereby enabling a conventional ear-piece (in the 'T' mode) to receive a signal from the receiver unit via the induction loop.
- 18 Figure 7a of the patent (below) gives a good indication of the relationship between the three components of the system, labelled 1, 4 and 8 respectively.



The claims

19 There are eighteen (18) claims in the patent, six (6) of which are independent claims. Claims 4 to 18 are said to correspond almost exactly to the claims (1 to 15) in the EP patent that has already been revoked. In my view, claim 2 of the CPL patent is the broadest claim, and in the event it is the only claim that I have considered in detail. It reads as follows:

2 . A hearing aid system comprising: a portable device having a microphone and a transmitter adapted to provide aural focus upon the command of the user; a receiver unit for receiving a signal from the transmitter unit; the receiver unit being contained in a housing with an amplifier; and an ear-piece for connection to the amplifier so as to receive a signal therefrom and for transmitting an audio signal.

20 CPL suggests that claim 5 (below) is the broadest claim, probably because the corresponding claim of the EP patent (claim 2) was considered to be the broadest claim during the EPO opposition proceedings.

5. A hearing aid system comprising:

an elongate transmitter unit which is remote from the user's head for the avoidance of head shadow and whistling feedback and has a microphone disposed at one end, a switch for selecting either a unidirectional or omnidirectional microphone mode and a transmitter, the transmitter unit being adapted to be held in the hand and to provide aural focus upon the manual command of the user without dependence upon and without prejudice to either head movement of the user, the user's field of vision, or both, said aural focus being achieved by holding the transmitter unit in the hand and pointing the transmitter unit in the desired direction and by selecting the unidirectional microphone mode;

a receiver unit separate from the transmitter unit for receiving a signal from the transmitter unit the receiver unit being contained in a housing with an amplifier; and

an earpiece for connection to the amplifier so as to receive a signal therefrom and for transmitting an audio signal.

21 But I don't think there can be any doubt that claim 5 is narrower than claim 2³ because it further specifies eg. an elongate transmitter unit, and a switch for selecting either a unidirectional or an omnidirectional microphone mode. Claim 1 (not reproduced here) is also narrower than claim 2 because it requires an induction loop connected to the amplifier and an ear-piece capable of receiving a signal from the induction loop, whereas claim 2 merely says that the ear-piece must be connected to the amplifier (in the receiver unit) so as to receive a signal from it.

No need for evidence

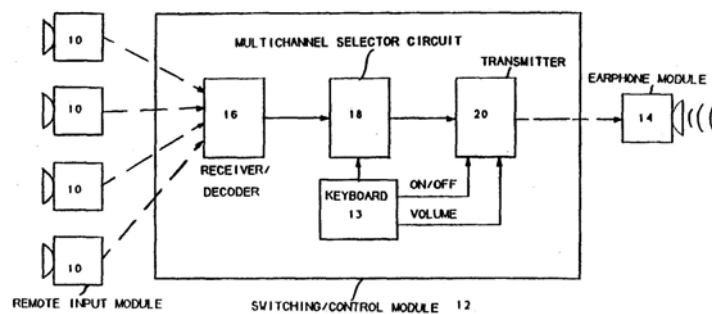
22 CPL has not filed any evidence in these proceedings — appropriately in my opinion; none was needed. The statement of grounds lists the relevant prior

³ NB. There was no equivalent to claim 2 in the EP patent.

art, and a copy of the Opposition Division's decision to revoke the EP patent was appended to the statement of grounds.

The Prior Art

- 23 At least twenty prior art documents were presented to the Opposition Division of the EPO. CPL has helpfully identified US 4,920,570 ("West et al") as the most relevant. The Opposition Division also considered that this was the most pertinent prior art — it was referred to as 'D3' in those proceedings. In the particular circumstances of this case, D3 is the only prior art document that I needed to consider. It was published before the earliest date of CPL's patent, and it describes a hearing aid system comprising three units that perform in a very similar way to CPL's hearing aid system. Figure 1 (below) from D3 conveniently illustrates the three components.



- 24 The hearing aid system described in D3 includes all the features required by claim 2 of CPL's patent. The embodiment shown in figure 1 has four transmitter units with microphones **10**, and a keypad on the receiver unit that enables the user to select one or more sound sources. These additions do not prevent the disclosure from anticipating claim 2.
- 25 D3 does not disclose an elongate transmitter unit or a switch for selecting between either a unidirectional or omnidirectional microphone mode. This was an issue that the Opposition Division of the EPO had to deal with because these are both features of the broadest claim in the EP patent. But they are not features of claim 2 of the CPL patent, so they do not concern me.
- 26 Similarly, D3 does not disclose the use of an induction loop as the means of connecting the receiver unit to the ear-piece. However, while this is a requirement of claim 1, claim 2 is not so limited. The transmitters of D3 are adapted to provide aural focus upon the command of a user because the user can select (or deselect) a particular transmitter from the receiver unit, and the transmitters can be pointed in any particular direction.
- 27 The only remaining feature of claim 2 that must be found in D3 if it is to anticipate claim 2 is the amplifier contained in the receiver unit. It is true that the word "amplifier" is not used in D3 in connection with the receiver unit. Nevertheless, the Opposition Division of the EPO concluded that it was implicit in the disclosure. I think this must be correct. As an Electrical Engineer myself, I consider that the skilled person reading D3 would understand that somewhere within the receiver unit, there must be an amplifier circuit of some description. It simply could not work without one. In my view it is not explicitly

mentioned in D3 because the author of that patent was addressing himself to readers who would not need to be told that the receiver unit must contain an amplifier.

Conclusion

28 I have concluded that the state of the art (eg. US 4,920,570) discloses a hearing aid system that completely anticipates claim 2 of CPL's patent GB 2 267 412C. It follows that CPL's patent is invalid for want of novelty as it stands. As there appears to be no prospect of any amendment of the patent under section 75, I can see no reason for me to go on and consider whether any of the other claims are either obvious or not new. I therefore order that patent GB 2 267 412C be revoked in accordance with Section 72(1) of the Patents Act 1977.

S J PROBERT

Deputy Director acting for the Comptroller