



PATENTS ACT 1977

APPLICANT Dr Harry Nduka

ISSUE Whether patent application GB0818371.7 complies with sections 1(1)(a), 14(5)(b),(c) and 76(2) of the Patents Act 1977

HEARING OFFICER Ms J Pullen

DECISION

Introduction

- 1 Patent application GB 0818371.7 ('the application') is entitled 'Bladder Sphincter Pacemaker'. It was filed on 8 October 2008, although the claims were filed later on the 21 November 2008. It was published as GB 2464152 on 14 April 2010.
- 2 The applicant and examiner could not agree on a suitable form of amendments, a hearing was held and a decision¹ relating to the application was issued by the Office on 25 October 2011. This was subsequently appealed by the applicant. A judgment² ('the judgment') was then issued on 29 July 2013 by Mr Roger Wyand QC, sitting as Deputy High Court Judge, in which he set out a number of requirements for Dr Nduka to address and he remitted the application back to the Office for re-examination.
- 3 Dr Nduka filed amendments on 23 August 2013 which included new drawings, claims, description and patents forms 1 and 9 with the associated fees.
- 4 The examiner maintained that the claimed invention was not clear, lacked novelty, was not supported by the description and that the amendments contained added matter. In response, Dr Nduka submitted further arguments and observations before the end of the extended compliance period, however these were not considered persuasive by the examiner.

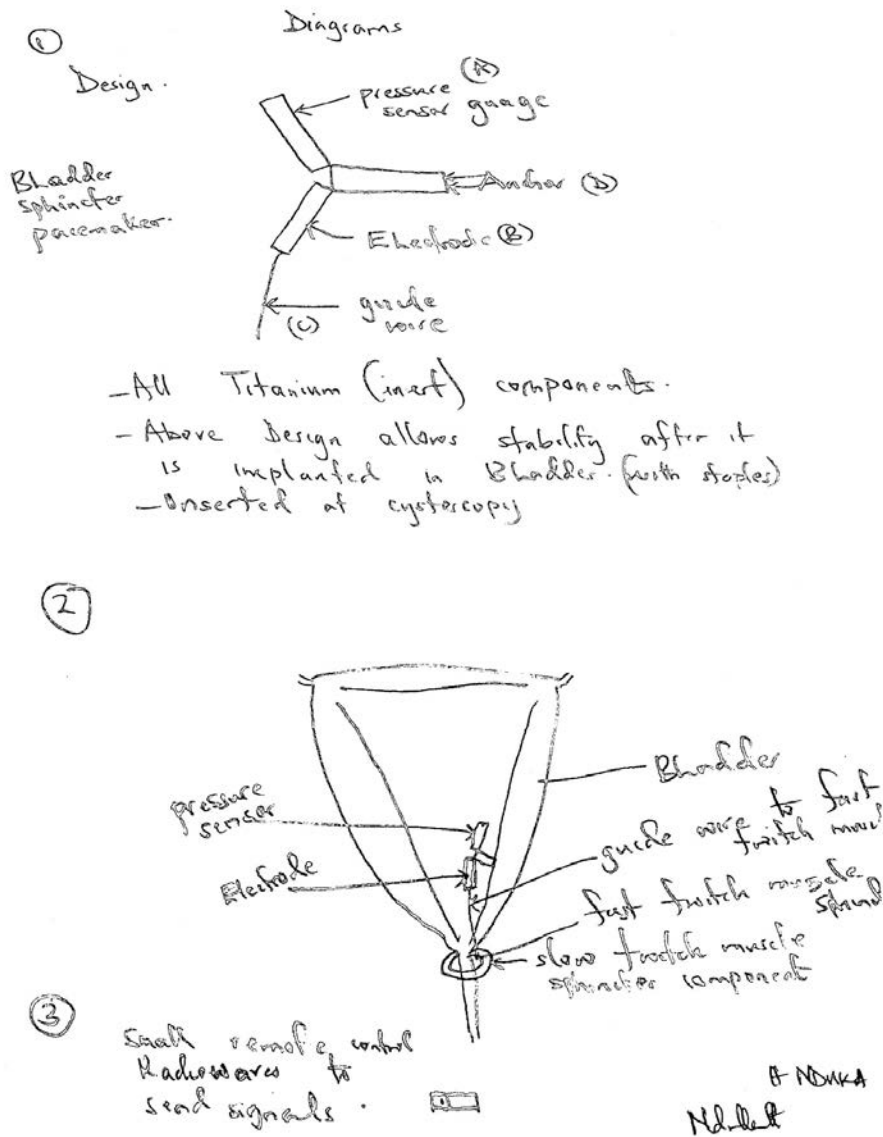
¹ BL O/365/11 http://www.ipo.gov.uk/pro-types/pro-patent/pro-p-os/p-challenge-decision-results-bl.htm?BL_Number=o%2F365%2F11&submit=Go+%BB

²Dr Harry Nduka v The Comptroller General of Patents Designs and Trade Marks [2013] EWHC 2193 (Ch)

5 These matters were brought before me at a hearing, via a video conference, with Dr Nduka on 28 January 2014. The examiner, Dr Andrew Hughes and my assistant Mr Stephen Hart were also present.

The application

6 The application concerns a device for controlling incontinence using a bladder pressure sensor and a muscle stimulator. The device is in three adjoining parts and consists of a calibrated pressure sensor gauge (A), an electrode (B) attached to a guide wire (C), wherein (A) and (B) are both attached to one end of an anchor (D) depicted in the originally filed Figures 1 - 3 below:



7 The original claims of the application were filed on 21 November 2008. They read:

CLAIMS.

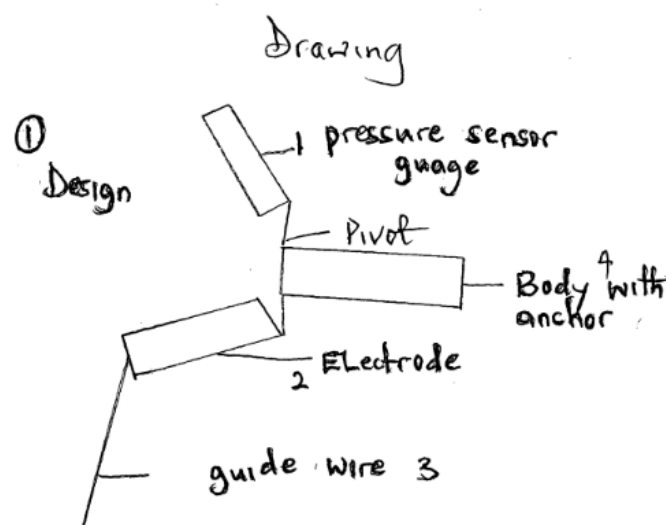
- 1, Bladder sphincter pace maker gauging the bladder pressure and stimulating the fast acting sphincter muscle to contract and stop urine leakage.
- 2, Bladder sphincter pace maker, Radio frequency controlled activation of sphincter muscle relaxation to allow passage of urine.
- 3, Bladder sphincter pacemaker Pressure gauging adjustability.
- 4, As in Claim 1 Removable.

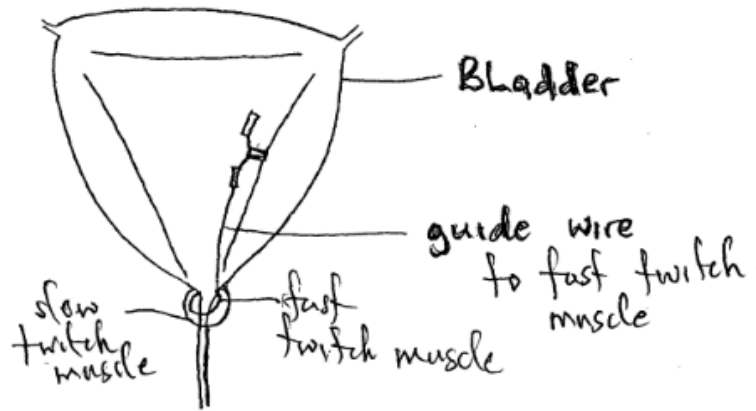
8 At the beginning of the hearing I attempted to clarify which of the documents filed on 23 August 2013 were intended to now form the application as the documents filed by Dr Nduka in effect constituted a new application. It transpired that Dr Nduka had mistakenly filed the amendments along with a request for a new application Form 1, a search Form 9A and their associated fees. Dr Nduka clarified during the hearing that the claims and description filed with the Form 1 and Form 9 should not form the basis of a new application, but were intended to be the amended pages for the application brought before me today.

9 Also, the new formal drawings contained several additional pages of CAD drawings (page numbers 3-6 in the filed document) that were not present in the originally filed drawings. This was brought to the attention of Dr Nduka and he confirmed during the hearing that the additional CAD drawings were not intended to be filed as replacement pages.

10 It was agreed that the amended formal drawings and claims filed by Dr Nduka to form part of the application are as follows:

Formal drawings:

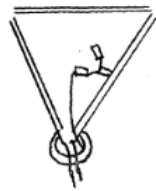




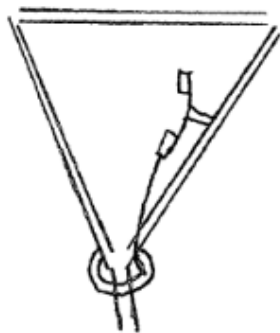
1b

②. Drawing, Diagrams

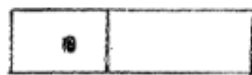
Equipment made completely from titanium



Y shape of equipment in bladder



T shape of equipment in bladder



Remote control

New claims:

Claim 1

Bladder sphincter pacemaker a Medical equipment gauging the bladder pressure , delineating and stimulating the fast portion of the sphincter muscle, adjustable and then stopping urine leakage.

Claim 2

Bladder sphincter pacemaker pressure gauging adjustability, size adjustability, shape adjustability ie Y and T Shapes.

The law

11 The sections of the Patents Act³ ('the Act') considered in this decision are set out below. The relevant parts have been highlighted in bold.

12 Section 1 of the Act sets out what is required of a patentable invention, subsection 1 reads:

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) it is capable of industrial application;*
- (d) the grant of a patent for it is not excluded by subsections (2) and (3) or section 4A below*

13 Section 14 of the Act sets out the requirements that need to be met by a patent application. Section 14(5) relates to the claims and reads:

(5) The claim or claims shall:

- (a) define the matter for which the applicant seeks protection;*
- (b) be clear and concise;**
- (c) be supported by the description; and**
- (d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.*

14 Section 76(2) of the Act relates to added matter and reads:

(2) No amendment of an application for a patent shall be allowed under section 15A(6), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.

³ <http://www.ipo.gov.uk/patentsact1977.pdf>

Analysis

- 15 From discussions at the hearing it became clear that Dr Nduka believed that the outcome of the judgment was that once he had filed amended pages within the given time limit the Office would grant his patent. He was not willing to accept that his amendments must comply with the requirements of the Act.

Clarity

- 16 In paragraph 34 of his judgment, Mr Wyand found that the claims were not clear:

34. The Hearing Officer also held that the claims as proposed are not clear. In my opinion, she is correct. Claim 3 is the most objectionable under this heading. It simply does not make sense and cannot be construed in the manner argued for by Mr Whittock. This is an objection that can only be made during prosecution and is not a ground under which a patent can subsequently be attacked. For this reason, I regard this as an important objection and one which could and should be addressed by the applicant by properly framed amendments.

- 17 The newly filed claims are very similar in form and construction to the originally filed claims, although claim 3, which was the 'most objectionable' has been deleted. Each claim is made up of a collection of words that do not define a clearly constructed sentence. Each claim fails to define the essential technical features and the interrelationship between these features. The claims are not sufficiently clear for a third party to understand the true scope of the monopoly sought.
- 18 I therefore find that replacement claims 1 & 2 are not clear as required by section 14(5)(b) of the Act and are not allowable.

Added matter

- 19 Paragraphs 23 and 24 of the judgment read:

23. The Hearing Officer had the informal drawings in mind as indicated in paragraph 23 of her decision set out above and noticed the difference between them and the formal drawings filed later. But rather than considering the disclosure in them she stated that because the formal drawings were different, this suggested to her that the shape change was not considered to be of significance when the application was filed. This is not a relevant test and it is not right to use the drawings in this way to try to interpret what the applicant considered, or did not consider, to be of significance in the application. The sole question is whether the claims are supported by the description in the application as filed. I believe that on a true reading of the whole document as filed there was support for the claims. The Hearing Officer ought to have found that the claims were supported by the application as filed and given Dr Nduka the opportunity to amend to reinstate what had been removed from the application by the filing of the formal drawings. This is a material error in the Hearing Officer's decision. That said, it is the applicant, Dr Nduka, who has submitted the drawings that do not accord with the original informal drawings and it is this that has led the Hearing Officer to have erred.

24. In my opinion, the applicant should not have been allowed to file the formal drawings that he did file. In order to regularise the position, he should amend his application to file formal drawings that properly accord with the informal drawings filed with his application originally. This would not, of course, result in added matter and would rectify the position so far as support for the invention is concerned. At the moment, the Hearing Officer is correct that the claims are not supported by the description but this is a state of affairs that should not have been allowed to occur.

- 20 Mr Wyand gave Dr Nduka the opportunity to file formal drawings which reinstated the matter that had been removed from the application and also which properly accord with the originally filed informal drawings. Mr Wyand clarified that doing this would not result in added matter. Therefore, I must consider whether the formal drawings properly accord with the originally filed drawings.
- 21 The page of new formal drawings labelled '1 Design' discloses two drawings, one drawing with the device outside and one drawing with the device inside the bladder. These two drawings generally correspond to the original informal drawings 1 and 2. Original drawing 1 discloses that the sensor arm and the electrode arm directly abut against the anchor arm, however, the new formal drawings show the sensor arm and electrode arm are each separated from the body by an intervening element that is denoted by a line. This intervening element was not present in the original drawings and is considered to add matter. The same could be said for the intervening elements in the other new formal drawings.
- 22 There are also new formal drawings on the page labelled '2 Drawing, Diagrams'. These were not present in the originally filed drawings and show the device to have both 'Y' and 'T' shaped formations within the bladder. As the originally filed drawings show the device having a 'T' shape when in the bladder and a 'Y' shape when outside the bladder this is also adds matter.
- 23 These are differences between the originally filed drawings and new formal drawings which I find add matter under section 76 of the Act. They do not properly accord as directed by Mr Wyand, and are not allowable.

Support and novelty

- 24 Mr Wyand found that the claims could be considered novel due to the adjustability of the device, this was clearly stated in paragraph 33 of his judgment:

33. The Hearing Officer was correct that, as proposed, claims 1, 2 and 4 were anticipated but she was not correct in suggesting that claim 3 was anticipated. If, as I believe, the adjustability of the device is a feature of the application as filed, then that feature could confer novelty on the claims.

- 25 The adjustability of the device is a feature contained in each of the amended claims, as such they can be considered novel. For these novel claims to be allowable there must be support for this feature in the application as filed. Mr Wyand was clear that this feature could be found in the drawings of the application as originally filed (see paragraphs 23 and 24 of his judgment above).

- 26 I have considered the allowability of the drawings in paragraphs 15-19 above. As Dr Nduka has not filed drawings which are considered to be allowable I must rely on the previous formal drawings. These do not provide support for the adjustability of the device and as such the specification does not meet the requirements of section 14(5)(c) of the Act.

Other matters

- 27 The examiner, in his report of 4 September 2013, has set out a number of other objections, such as added matter, relating to the amended claims and description. I have not considered these additional objections as Dr Nduka has failed to adequately address the issues set out in the judgment and the application fails for these reasons.

Conclusion

- 28 Dr Nduka's amendments do not adequately address the issues set out in Mr Wyand's judgment. The application in its amended form does not meet the requirements of sections 14(5)(b),(c) and 76(2) of the Act. I therefore refuse the application.

Appeal

- 29 Any appeal must be lodged within 28 days.

J Pullen

Deputy Director, acting for the Comptroller