

PATENTS ACT 1977

IN THE MATTER OF a reference under sections 8 and 12 by Paris Misak Herouni in respect of certain patent applications in the names of Solargen Energy Corporation BVI and Adrian Gaye

PRELIMINARY DECISION

1. This reference relates to international patent applications WO 95/35469 and WO 95/35470, in the joint names of Solargen Energy Corporation BVI and Adrian Gaye, and the GB applications from which they claim priority. Professor Paris Misak Herouni is named as the inventor of the inventions to which these applications relate (and is therefore also named as applicant/inventor for the USA). It is Professor Herouni who has filed the present reference, and the joint patent applicants have opposed it. For simplicity, I shall refer to the patent applicants as “Solargen”.

2. Solargen are represented in these proceedings by their patent agents Keith W Nash & Co. Professor Herouni is not using an agent, and is conducting these proceedings personally from his work place in Armenia. Professor Herouni is not familiar with the British legal system and English is not his native language. I have therefore tried to keep the wording of this decision simple.

3. Professor Herouni has filed his main evidence and we have been waiting for Solargen to file *their* evidence. They asked for an extension of time to do this, and Professor Herouni objected. The sole issue I have to decide at this stage is whether I should grant Solargen the extension they request. The parties have agreed that I should decide this by considering the arguments they have submitted in writing, without having an oral hearing.

The background

4. I will start by looking briefly at the history of these proceedings. Professor Herouni first wrote to the Office about the entitlement to these patent applications in May 1996. There were some exchanges of letters, and eventually he formally started these proceedings six months later, in November 1996, by filing Patents Form 2/77 and a statement. There were, however, problems with his statement because he had referred to a number of documents but not supplied copies of them. He also decided to change his statement. As a result, the Office was not in a position to invite Solargen to file a counterstatement until March 1997. Solargen responded within the two month period allowed, but the proceedings were then delayed again whilst there was discussion about Professor Herouni's statement. It was not until mid August that the evidence rounds could start.

5. Professor Herouni was given two months to file his main evidence. However, he didn't really understand what was meant by "evidence", so there was a further delay whilst this was explained to him. As a result the period for filing his evidence was extended by one month. Thus the period for Solargen to file *their* evidence did not start until 10 November. They were given the usual two months in which to do so. On 9 December they wrote to the Office asking for a two month extension of this period. They said that having regard to the intervention of Christmas and New Year they needed this extension because they wished to seek advice from Counsel before deciding what evidence to file. The Office offered a one month's extension, to 10 February 1998. This was subject to any comments from Professor Herouni, but he did not make any comments. On 5 February Solargen faxed the Office saying they were unable to meet the new deadline and asking for a second extension of one month. The issue I have to decide is whether to allow a second extension.

The arguments

6. Solargen said they need the extension because they were unable to arrange a conference with Counsel until the last week in January. As a result of that conference they decided to file statutory declarations from two people, Mr Gaye and a Mr Malim. They prepared them in

draft, but were, they said, unable to finalise them and get them signed by 10 February because both Mr Malim and Mr Gaye were very busy and had been out of the country, and indeed Mr Malim would not be back until mid February. Subsequently they filed Mr Gaye's declaration on 20 February and Mr Malim's on 24 February.

7. Professor Herouni has objected to the extension for two reasons. Firstly, he feels it is giving Solargen more favourable conditions than him. He points out that he too is a very busy person who had to travel a lot, and in addition he has difficulties with the English language and has no lawyer. Nevertheless he had managed to get his own statutory declaration filed in time. Secondly, he feels the request for an extension is all part of an attempt by Solargen to deceive him. He had just received a letter from Solargen offering to do a deal in connection with some shares in the company, but he does not trust them and thinks this letter and the request for an extension are all part of a plot.

My conclusion

8. I have considered Professor Herouni's arguments very carefully. I accept that once he understood what he had to do, he prepared and filed his own evidence quite quickly. However, he had already been given a month's extension of time to do this. Further, his own actions caused delays in the proceedings at the start. I am not blaming him for this - it happened largely because Professor Herouni did not really understand what he had to do - but the fact is there were delays and Solargen were not in any way responsible for them. Against this background, I do not think Professor Herouni can fairly complain that by granting an extension to Solargen I would be giving them more favourable treatment than he has been given himself. As for his second argument, I will express no opinion on whether the offer to do a share deal is a genuine attempt to reach a settlement. I am, however, sure he is wrong to believe the request for an extension has anything to do with the share deal because Solargen have actually filed their evidence without waiting for the deadline for the share deal to pass.

9. It is a pity it took Solargen quite so long to get a conference with Counsel, although I know this is a common problem. However, having had that conference they have acted quickly to

get there evidence together. Taking account of all the circumstances, I grant them an extension of the period for filing their evidence until 24 February 1998, which is the day on which they actually filed their second piece of evidence.

10. There is one other matter I must deal with. Professor Herouni has objected because Solargen are filing two Statutory Declarations whereas he has only filed one, and he feels this is unfair. I think Professor Herouni has misunderstood the position, and I will use this opportunity to explain it. When someone is invited to file evidence, they can file as many Statutory Declarations as they feel they need to in order to prove their case. Thus Professor Herouni could have filed Statutory Declarations from other people as well as himself. This was explained to him in a letter from the Patent Office dated 10 October, which said:

“Since you were one of the people involved, you will obviously want to file the main sworn statement yourself, but you could also ask other people to file sworn statements to support the bits of the story they were involved in.”

Just because Professor Herouni only filed one Statutory Declaration does not mean Solargen could only file one. They could (within reason) have filed as many as they wished. They have chosen to file two, and they are allowed to do this.

The next steps

11. Professor Herouni now has two months, beginning today, in which to file his “evidence in reply”. That means he can now file one or more further Statutory Declarations to deal with matters that have arisen from Solargen's evidence. There are three points I would like to emphasise:

C He doesn't *have* to file any evidence now. If he feels the evidence he has already filed is sufficient to deal with all the matters arising from Solargen's evidence, he should tell the Office and we will then go ahead and arrange the main hearing.

- C If he does file further evidence it must be confined to matters arising from Solargen's evidence. This is *not* an opportunity for him to put in evidence on completely fresh matters.

- C If he does file further evidence it can, if he wishes, include Statutory Declarations from other people.

Appeal

12. As this is a decision on a matter of procedure, under the Rules of the Supreme Court, any appeal from this decision should be lodged within two weeks.

Dated this 25th day of February 1998

P HAYWARD

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE