

PATENTS ACT 1977

IN THE MATTER OF references
under sections 8 and 13 in respect of
Patent Application No GB9703821.0
and under section 12 in respect of Patent
Application PCT/GB98/00594, both
applications being in the name of Shostar Ltd.

DECISION

1. On 17 February 1998, Mr Phillip Denne referred to the Comptroller under sections 8 and 13 the question of the entitlement of Patent Application No GB9703821.0 and requested that he be named as inventor and that all rights in the application be transferred to him or his nominee. Shostar Ltd opposed the reference and the normal rounds of evidence followed. Subsequently, on 16 November 1998, Mr Denne requested, under section 12, that the Comptroller declare that the invention in PCT/GB98/00594, which claims priority from the GB patent application, should belong to him. Again this was opposed by Shostar. With the agreement of both parties the two actions were consolidated.

2. In January 1999 Shostar Ltd went into liquidation and on 16 February 1999 Linear Motion Technology Inc (“LMT”) bought the rights in the PCT application from the Liquidator. Whilst there was no clear legal assignment of the GB application the Liquidator consented to LMT being substituted for Shostar in the Patent Office proceedings on both applications, indicating at least an equitable assignment of the GB application.

3. In August 1999 Mr Denne withdrew as referrer under the assumption that he had assigned his rights in the patent applications to LMT but he was reinstated when it was realised that this was a false assumption. LMT formally changed its name to Advanced Motion Technologies on 27 August 1999 and in a letter dated 24 November 1999, Mr Lieberman, the President of Advanced Motion Technologies stated that the company wished to withdraw from both actions, leaving the references uncontested. Mr Denne then withdrew the section 13

reference since the absence of any published GB application or granted GB patent rendered the action futile.

4. In the absence of any opposition in respect of the section 8 reference on Application No GB9703821.0 and the section 12 reference on Application No PCT/GB98/00594 I am satisfied that the rights in these applications belong to the referrer, Mr Denne. Accordingly I direct that the applications proceed in his name and not that of Shostar Ltd. Mr Denne has withdrawn his request for costs, so I make no order in that respect.

5. Since this is a decision on a substantive matter the period for appeal is six weeks.

Dated this 2nd day of December 1999

(Mrs J A Wilson)

Deputy Director, acting for the Comptroller.