

PATENTS ACT 1977

IN THE MATTER of a reference under sections 37(1) and 13 (3) by Bestplate Limited in respect of Patent No. 2322466 in the name of Sandhurst Autoprint Limited

DECISION

Introduction

1. UK Patent no. 2322466 in the name of Sandhurst Autoprint Limited (“Sandhurst”) was filed on 21 October 1997 under application No. GB 9722223 without any claim to earlier priority. Sandhurst stated on Form 7/77 that it derived the right to be granted a patent from the inventors Stephen Dear (“Dear”) and Timothy Sanders (“Sanders”) “by virtue of the employment of the inventors by the applicant company”. The patent was granted on 6 January 1999.

2. On 16 June 1999 Bestplate Limited (“Bestplate”) filed an application under section 37(1) for an order that the patent be transferred from Sandhurst to Bestplate and that Mr Sanders’ name be cancelled as a joint inventor. Later, on 15 July 1999, an application under section 13(3) was also filed by Bestplate. The two actions have been consolidated.

3. A statement of case was filed on 16 June 1999, followed by a counterstatement on 22 September 1999, and subsequently the usual evidence rounds took place. The matter came before me at a hearing on 2 August 2000 at which Sandhurst was represented by Mr Ashley Roughton, instructed by patent agents RGC Jenkins, and Bestplate by patent agent Mr David Lishman. During the course of the hearing cross examination of four witnesses took place, namely Dear, Sanders, Tony McNamee (“McNamee”) Managing Director of Bestplate, and Michael Davies (“Davies”) General Manager of Bestplate.

Background

4. The patent is concerned with an apparatus for assembly of an identification plate, in particular a vehicle number plate. The identification plate comprises a clear panel to which are affixed identification symbols over a backing. The apparatus, as broadly claimed in the only independent claim, comprises a housing, positioning means on the housing for positioning digits on a backing, aligning means on the housing separate from and different than the positioning means, for aligning a plate and a backing to which digits have been positioned, and a pressure applying

means on the housing for applying pressure to secure the positioned symbols on the backing and to secure the aligned plate to the backing. In a preferred embodiment the pressure applying means is in the form of a pair of rollers positioned in a cut out in the housing such that the upper roller is positioned above the upper surface of the housing and the lower roller is positioned within the housing.

5. In the patent it is acknowledged that previously the assembly of number plates has been a laborious multi-stage process, during which excess backing has needed to be cut away.

6. The evidence filed by Bestplate consists of statutory declarations by McNamee, Davies, Christine Barrett (“Barrett”), Production Co-ordinator of Bestplate, James Rutherford (“Rutherford”), Financial Controller of Bestplate, and James Provan and David Leslie, both presently employed as Area Managers for Bestplate, as well as twenty eight exhibits. Following submissions from Mr Roughton I ruled that I would not allow four of the documents exhibited to Mr McNamee’s second statutory declaration as evidence.

7. Sandhurst’s evidence consists of statutory declarations by Dear, Sanders and Jake Rowledge, an Area Manager for Bestplate between October 1993 and August 1998, and two exhibits.

8. There appears to be no controversy between the parties about the following matters:

(i) Bestplate is a company involved in the assembly of vehicle number plates.

(ii) Dear was employed by a company called Hills 3M Ltd, a company also involved with number plates, before joining Bestplate as an Area Manager in October 1993.

(iii) Dear had known Sanders professionally and socially for about ten years but Sanders was never employed by Bestplate.

(iv) Dear first showed a prototype of apparatus of the invention as broadly claimed in the patent to McNamee on 11 September 1997 when he met him to discuss another idea of his concerning personalised number plates.

(v) Both the personalised number plate idea and the prototype were discussed at Blackpool on 15 September 1997, during which (a) at a meeting of Dear with McNamee and Rutherford, a commission agreement regarding the personalised number plates was

signed by McNamee but not Dear, and at a separate meeting (b) suggestions for improvements to the prototype were made at a meeting of Dear with Davies and Barrett, and it was agreed that Dear should arrange for a further prototype to be manufactured by Boden Sheet Metal Company (“Boden”).

(vi) Dear wrote a resignation letter to Bestplate on 26 September 1997, but due to having to work a month’s notice Dear did not cease to be employed by Bestplate until 31 October 1997.

(vii) Dear posted the further prototype made by Boden to Bestplate on 1 October 1997, claiming postage.

(viii) Dear and Sanders set up Sandhurst to produce car number plates also on 1 October 1997. Sanders was a director of the company from its incorporation, but Dear only started working for Sandhurst at the start of November 1997, becoming a director of Sandhurst in March 1998.

(ix) On 16 March 1999, Sandhurst informed Bestplate of the existence of the patent.

The law

9. Bestplate has made the reference and application and the onus therefore rests in the first place with Bestplate.

10. Section 39(1) lays down the rights to employees’ inventions and reads-

“Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this act and all other purposes if-

(a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or

(b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer’s undertaking.”

It should be noted here that Section 39(1)(a) has two separate limbs, ie the invention must both have been made in the course of the normal duties of the employee (or duties specifically assigned to him) and that the circumstances were such that an invention might reasonably be expected to result. Section 39(1)(b) does not seem applicable in the particular circumstance of this case for the circumstances sent out below.

11. As far as a definition of “inventor” is concerned, section 7(3) reads -

“In this Act “inventor” in relation to an invention means the actual deviser of the invention and “joint inventor” shall be construed accordingly.”

12. The reference has been made under section 37(1), which states -

*“ 1. After a patent has been granted for an invention any person having or claiming a proprietary interest in or under the patent may refer to the comptroller the question -
(a) who is or who are the true proprietor or proprietors of the patent,
(b) whether the patent should have been granted to the person or persons to whom it was granted, or
(c) whether any right in or under the patent should be transferred or granted to any other person or persons;
and the comptroller shall determine the question and make such order as he thinks fit to give effect to the determination.”*

13. In addition an application has been made under section 13(3) which reads -

“ When a person has been mentioned as sole inventor or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.”

The cross examination

14. Mr Lishman and Mr Roughton were not evenly matched in their cross examination questioning skills, Mr Lishman experiencing some difficulty in phrasing his questions so that they were not leading, and, during re-examination of the witnesses, in not trespassing beyond the ground covered during the earlier examination of that witness.

15. I find it surprising that Mr Lishman, in his questioning of Sanders and Dear, did not seek to establish exactly when and where and by whom the invention was devised. But he did not and so I must take it that the invention was made in January 1997 jointly by Dear and Sanders, as they claim, or at any rate prior to being shown to McNamee on 11 September 1997. The questioning of Sanders by Mr Lishman merely related to how he could have validly claimed to file a patent in the name of Sandhurst when he did not employ him until later, and did not attack his claims to be a partial inventor. Thus, the referrers have not made out a case with regard to Sanders on the cross examination at all.

16. Further, the paragraph in the referrers' statement to the effect that the further prototype had all the features of claims 1-3 and 11, and that any contribution by Sanders must therefore have related to means conventional in the art, presupposes that the only contribution by the latter took place after the 15 September 1997 meeting and not prior to it. They have provided no proof to support that contention. Also, Davies in his second declaration refers to the fact that there is no evidence to show Sanders was in fact involved. That is not good enough - the onus is on the referrers to show positive evidence that he was not so involved.

17. Thus, as far as Sanders is concerned. I find that the referrers have failed in their reference under Section 13(3). Thus, the best they can hope for, should they succeed in making their case regarding Dear, is joint ownership with Sanders regarding the invention.

18. When it comes to Dear himself, I find it surprising that Dear quite so freely showed his idea to McNamee, Davies and Barrett if he was intending to lay claim to it personally at that stage. I find it equally surprising that he did not mention Sanders' involvement at the outset given his claim that the basic invention had been jointly created by the first time he showed it to McNamee. This was in marked contrast to his behaviour with respect to the personalised number plates idea where he had mentioned his wife's involvement at the outset. His excuse, ie that at the time he had no reason to mention Sanders' involvement because the latter was still at that stage a customer with no interest in making number plates perhaps does not ring entirely true. It might well be that Davies in his second affidavit has touched upon the true state of affairs when he links Dear's dissatisfaction with the deal offered him under the personalised number plate idea with his resignation from Bestplate and the subsequent rapid setting up of a separate company to produce and market the number plate kit in issue. However, that being the case or not, it does not give any real indication of whether or not the invention was within the normal ambit of his duties. So what were Dear's normal duties?

19. Both McNamee and Davies stated under cross examination that they had not issued Dear with a list of specific duties. Presumably no one else in the Company, eg the Sales Manager to whom Dear reported, had done so either, because we might have been expected to hear about it. Despite Dear being styled an “Area Manager”, it would appear that he had no say in the running of the Company and no staff working to him, ie he was a glorified salesman. For this reason, I confirm that I do not see Section 39(1)(b) as having any applicability.

20. McNamee was questioned extensively about Dear’s terms and conditions of employment both individually and vis-a-vis his fellow “Area Managers”. He claimed that Dear had demonstrated to him in the course of their meetings before and since he started employment at Bestplate in late 1993 that he was a man of ideas, for example he proposed a kit in late 1994, and that Dear continued to have ideas but not all of them would be taken up. For that reason Dear had been appointed on a salary of £22000, one third higher than the other sales managers who were on £16000, because he was a ‘better calibre person’. He further said that Bestplate had meetings on an individual and collective basis with all its area managers to discuss their project ideas, the company was always looking for improvements and if there was a meeting with the area managers they would be asked how they could do the job better and how the company could improve its products. Mr Roughton asked whether Dear’s job would have been at risk if he had not come up with ideas, to which McNamee replied that Bestplate was not a hire and fire company, although he implied that he would have expected Dear’s salary to alter over a period of time, perhaps suggesting that he did not expect the same degree of innovative input from Dear’s colleagues. That being the case, I do not see the specific duties required of Rowledge on the one hand or Provan or Leslie on the other as giving any real assistance in ascertaining what Dear’s normal duties were, particularly since they were paid of the order of one third less per annum. Clearly all were invited to periodic meetings with the Sales Manager wherein they were asked to feedback ideas or comments from the customers, what their competitors were up to, and any suggestions from themselves as to how the product might be improved. These were, however, clearly low level meetings not expected to generate inventions as such.

21. McNamee was then asked by Mr Roughton about Bestplate’s patent holdings and he stated that Bestplate has a few patents, but he was unable to think of any off hand. He explained that Bestplate did have an R&D department some time ago and it presently has an art room for drawing, but that it is not a big enough company to have one area or one person just allocated to development. He agreed that there would have been occasions when Dear did nothing else but try and develop an idea, but added that the firm could not afford to have a person working just on ideas five days a week, 52 weeks in a year. McNamee also said that Dear worked at home on a more regular basis than anyone else.

22. I questioned McNamee about Dear’s personalised number plate idea and why it had been

considered in a different category regarding ownership basis to the number plate kit idea of the patent in issue, particularly given that the two ideas were active at the same time. McNamee told me it was slightly different, saying that he had been put in a difficult position and was trying to stop Dear setting up business with his wife and that he had not wanted to lose Dear. Being further questioned on the commission agreement, he stated that he considered that the commission agreement that had been put to Dear was very generous. A copy of the commission agreement, signed by McNamee but not by Dear, is on file and includes a clause that:

“On ceasing to be an employee Stephen Dear will not be employed or associated with any company/individual who may be considered to be involved in products in direct competition with Bestplate Limited”.

I questioned McNamee about the inclusion of such an open ended clause. He maintained that he thought it was fairly reasonable. Mr Roughton came back in to ask whether Dear had been put under pressure to sign the commission agreement but McNamee claimed that the 15 September 1997 meeting about the personalised number plates idea had been amicable and the meeting had finished with Dear saying it was a good offer but that he needed time to think about it before signing it, and McNamee had thought that fair enough.

23. McNamee also confirmed to me that he saw the prototype of Dear’s new apparatus on 11 September 1997 when Dear took it out of the boot of his car and he agreed that the invention in its broadest terms was already produced by that date. However, he pointed out that the patent is very different from the prototype and that it is the changes, which were brought about after the 15 September meeting and with the involvement of Davies and Barrett, which make it workable. However, having compared the first prototype which is illustrated at exhibit ‘MD1’ to Davies’s first declaration with the patent itself, I can see little difference beyond the optional positioning of the roller in the casing body.

24. Next in the witness box, Davies explained to Mr Lishman that he had known Dear for a good number of years before the meeting on 15 September 1997, saying that he had been through the same sort of sequence of events before with Dear about one of his previous ideas which Bestplate had taken up. He claimed that Dear had been enthusiastic about his new apparatus and keen for Bestplate to take it on board. Davies confirmed that Barrett was present at the 15 September meeting and said that he and she had looked at the prototype and discussed how they might be able to improve it so that it would be able to do various different things, such as different sizes of plates and different component materials used on the plates. Davies stated that his preference would have been to involve GW Plastics Limited in making the further prototype,

but he had agreed to Boden making it at Dear's request because Dear was obviously enthusiastic about it and keen to continue his involvement.

25. When questioned by Mr Roughton, Davies acknowledged that he had not asked whether anybody else had been involved in the development of the new apparatus and had had no reason to suppose that it had been anything other than Dear's idea. On repeated questioning by Mr Roughton, Davies stated, besides the idea for a new number plate kit introduced in the second half of 1994, that Dear's previous ideas were about all sorts of things, such as alterations to the roller unit, literature describing the products and he had identified a source of transfer digits used in manufacturing the number plates, but that he, Davies, had not considered them to be inventions and neither had he considered the new apparatus to be an invention in September 1997. He claimed that patenting of any of these ideas of Dear had never crossed his own mind, explaining that patenting is not something he is commonly involved with or used to dealing with, and it would not necessarily have been up to him to take that decision anyway. He said that Dear reported direct to the sales manager but that he himself had regular contact with Dear. He claimed that there had been no question in his mind at the 15 September meeting that Dear's intention had been to develop the new apparatus for the benefit of Bestplate and that there was no other person involved in the development of the apparatus.

26. Dear, the most crucial witness when questioned by Mr Lishman, claimed that he and Sanders had agreed the final concept of the invention in January 1997 and had then had a prototype made, Sanders coming up with the practical solutions to his ideas. He agreed that when he had shown the prototype to McNamee he had not told him that it was confidential and that at that stage he had not been intending to get a patent for it. After taking the decision to part from Bestplate, Dear had however contacted a patent agent, George Whitton of RGC Jenkins & Co, who had advised him that his share of the invention belonged to him and that he and Sanders had agreed that their joint rights in the patent should be filed in the name of Sandhurst. However, he was unable to satisfactorily explain why the patent application had been filed on 21 October 1997 in the name of Sandhurst when he was still working for Bestplate until 31 October 1997 and did not start working for Sandhurst until the start of November 1997.

27. Dear further stated he had shown the prototype to Bestplate in September 1997 because he worked for them and could see no reason not to do so, although he did not concede he had any duty to tell Bestplate about his ideas. Dear claimed that he had no reason to tell Bestplate about Sanders since at that time Sanders was a customer and had no interest in manufacturing the apparatus. He also claimed that he had posted the further prototype to Bestplate on 1 October

1997 because he was still employed by Bestplate at that time and that Sanders' offer of employment was spontaneous and came after he had been put on the spot over the personalised number plates, adding that if the employment by Sanders had been planned in advance he would not have shown the prototype to Bestplate.

28. In answer to a question from myself, Dear said that he could not remember how the further prototype differed from the first prototype. He said that Sanders came up with the idea of putting the roller inside the box prior to that and that Davies may also have suggested it. I feel this was symptomatic of the questioning of Dear, he was very difficult to pin down.

29. Sanders was then questioned. As I have previously indicated, Mr Lishman concentrated solely as to how Sanders could have validly claimed to file a patent in the name of Sandhurst when Dear was not employed by the latter firm at that time.

Submissions

30. Mr Lishman submitted to me that Bestplate should be the proprietor because (i) Dear had been employed at all relevant times by Bestplate, (ii) Dear had voluntarily told Bestplate about his new apparatus and had not said it was a confidential disclosure in relation to other people, (iii) it was obviously confidential as far as Bestplate was concerned because he was an employee and he was expected to keep his mouth shut about what he was doing for them and had done so once before on a kit which was taken up and sold by them, (iv) Dear had not had plans to take out a patent application in September 1997, and (v) the new apparatus was taken up by Bestplate and used by them.

31. Mr Lishman pointed out to me that the patent was obtained on an incorrect disclosure as to how the alleged owners got it, because there was no Sandhurst when the invention was conceived and so Sandhurst could not have employed Dear or Sanders. Mr Lishman put it to me that Dear, in saying that he disclosed the invention to McNamee because he worked for Bestplate, had in effect said that he disclosed it to his employer as part of his employment. It was irrelevant whether Dear was employed as a 100% inventor. Bestplate employed Dear as a brilliant salesman with ideas and had given him a significantly higher salary. Dear was not expected to produce inventions in that he was told to go away and invent but was recognised as a man of ideas who would come up with new apparatus one day, which he did, as part of his job. Mr Lishman said that once the patent had been drawn to the attention of Bestplate the company inevitably had to take action.

32. Mr Lishman ended by drawing my attention to the fact that McNamee had mentioned that Dear worked most of his time at home when he was not out selling plates to customers. He also reminded me that Dear did other things relating to the invention when he was not at home, like

going to the Blackpool and Birmingham meetings and arranging with Boden to get the further prototype made, on the companies time.

33. For the proprietor, Mr Roughton drew my attention to section 39(1)(a) of the Act saying that it is not relevant because there is no evidence to show that the invention was made in the course of Dear's duties with Bestplate. The invention may have been made at home, and probably was since it was something that was shown to the employers.

34. Mr Roughton further submitted that the wording of section 39(1) does not support the view that anything the employee does at home, even if it would have formed the subject matter of his duties, then he is necessarily liable to account for it. In any case, the normal duties of Dear were not to invent this product; he only produced two apparatus devices and a number of ideas between 1993 and 1997 and, although McNamee had given no real answers, Dear would not have been fired if he had not produced any of these. Mr Roughton put it to me that on any view of McNamee's evidence it is quite clear that Dear was not operating in the course of his duties and neither could he reasonably be expected to do so.

35. Mr Roughton drew my attention to nine reported patent cases concerning ownership including Harris' Patent [1985]RPC19 and Greater Glasgow Health Board's Application [1996]RPC 207. He pointed out that in Harris' Patent, which involves a sales employee making an invention where the employer was not an innovative company, having no research laboratory and never undertaking any creative design activity, the hearing officer's decision that the employer was not entitled to the invention was affirmed in the Patents Court, Falconer J. saying at line 25 of page 33

"...Harris was not employed to design or invent. As I see it his primary function was concerned with obtaining sales and giving after sales service. The examples to which my attention has been directed seem all of them to have involved nothing more than simple known engineering practice or techniques, requiring no inventive ingenuity."

Mr Roughton put it to me that Dear had invented only two things between 1993 and 1997, hardly indicative of an obligation to create inventions.

36. With regard to the Greater Glasgow case, which Mr Roughton explained to me was essentially about whether a doctor working in hospital was obliged to account under section 39 for an invention he had made at home, while he was working for exams, for a piece of medical apparatus which enabled him to do his job better, Justice Jacob said at line 7 - 22 of page 223

I think that argument breaks down as soon as you look at the conclusion. It leads to the conclusion that it is the duty of this doctor, and probably every other registrar in the country, to devise if he can new ways of diagnosing and treating patients, because his duty is to treat patients.

I therefore think that the Superintending Examiner, whose reasoning essentially adopted Mr. Hamer's argument, was wrong in law.

I also think has was wrong on the second limb of section 39(1)(a). This refers to the circumstances being such that an invention might reasonably be expected to result from the carrying out of the employee's duties. Falconer J. pointed out that the circumstances referred to were not the general circumstances of employment but the particular circumstances surrounding the making of the invention. He said that at page 29. The particular circumstances in which this invention was made were nothing to do with Dr. Montgomery carrying out his duties. He was at home. He was doing his exams.

37. As far as Sandhurst being named as applicant at the time the application was made, Mr Roughton put it to me that this was not really relevant. He stated that he accepted that at the time the invention was conceived, Sandhurst was not in existence and so in a strict legal sense Sandhurst ought not to have been the patentee, but it did not result in the public being misled.

38. Mr Roughton submitted that I should bear in mind that there has been very little challenge of the proprietor's evidence in cross examination and that it has not been suggested or shown that Dear did any of these things as part of his normal duties. He also put it to me that only the evidence of Dear, Sanders, McNamee and Davies had been tested by cross examination, and that it would be wrong for a tribunal to give any weight to any evidence which goes to an important issue in the case where no opportunity has been given to cross examine on that evidence. Mr Roughton reminded me that he had asked for certain of the other side's witnesses, including other area managers who could have been asked about what they did and what input they had, to be called and they had not come to the hearing. He also drew my attention to the fact that the suggestion that Dear worked from home only came out in cross examination and was not challenged, adding that there is no suggestion in any of the evidence heard that Dear created the invention whilst at home working for his employer; the suggestion was not even made to Dear.

Evaluation

39. Bestplate has not sought to show that at the time the invention was made any specific duties outside his normal duties were assigned to Dear or that because of the nature of his duties and the particular responsibilities arising from the nature of his duties Dear had a special obligation

to further the interests of Bestplate's undertaking. Thus, section 39(1)(a) is pertinent, but section 39(1)(b) is not as I have previously stated and, accordingly, as far as Dear is concerned, I have to consider whether or not the invention was made in the course of his normal duties with Bestplate, or duties specifically assigned to him.

40. The latter point is readily dealt with. I have already established that the invention was in broad terms made before Bestplate had their attention drawn to it. It thus cannot have been produced by any duties specifically assigned to Dear.

41. The fact that Dear may have done his normal work at home on occasions, frequently or not and at various times of day, is of no relevance, since I do not know when or where the invention was made. It may not have been made at Dear's house but at Sanders' house or at some neutral venue, such as a hotel or park or street café, and at an hour when Dear could not be reasonably expected to be doing duties for Bestplate. Thus, it seems to me that it has not been established that the invention was made in the course of Dear's normal duties, whatever his normal duties may have been.

42. As a result, I do not have to decide what constituted Dear's normal duties. However, I would comment that the evidence provided about Dear's normal duties is conflicting and would not have led me easily to establish the limits of his normal duties. Since Dear was paid considerably more than the other area managers, it is unlikely that had they been cross examined the other area managers' version of their duties would have established Dear's normal duties, even though they were known by the same title as him.

43. As far as the conflicting evidence is concerned, on the one hand, the following go in favour of Bestplate being the true owner of the invention rather than Dear - (i) Dear told and showed McNamee and Davies the apparatus of the invention without requesting confidentiality, mentioning entitlement or informing them that Sanders had also been involved in the making of the invention, as one could have reasonably expected him to do if he and Sanders had made the invention when he was not working for his employer, (ii) Dear said that he had shown Bestplate the invention because he was employed by Bestplate and had previously told Bestplate about his ideas and apparatus changes, one apparatus change at least having been taken up by Bestplate, which could be taken to indicate that Dear felt he had some duty to tell Bestplate, (iii) Dear was paid substantially more than the other area managers and this higher payment suggests that his normal duties may have gone beyond sales and after sales matters, (iv) Dear performed duties in connection with the invention, such as going to the meeting in Blackpool and arranging with Boden to make the further prototype, in Bestplate's time, and (v) Dear said that Davies may have

suggested putting the roller inside the housing, which is disclosed in the patent, as well as Sanders.

44. On the other hand, the following go in Dear's favour - (i) both McNamee and Davies said that there was no written list of Dear's agreed duties, (ii) it is not fully clear that Dear was paid a higher salary than the other area managers on entry into employment with Bestplate for any other reason than being a better calibre person (iii) Bestplate was only able to come up with a very limited number of examples of significant ideas and apparatus changes initiated by Dear during his four years employment with Bestplate, which seems surprising if Dear had been obliged to come up with such ideas and apparatus changes as part of his normal duties, (iv) Bestplate is not a particularly innovative company, McNamee being unable to identify the few patents that he claimed Bestplate holds, and so the inventiveness of its employees may not be important to it and developmental duties may not have been part of the normal duties of any of its employees, and (v) McNamee did not seem to regard the personalised number plate idea of Dear's as being produced by an employee.

45. I find the balance of the argument to lie with Dear. Since the onus rests with Bestplate, it would seem that they have not come close to making their case.

46. I would agree with Mr Roughton that the matter of Sandhurst naming itself as applicant when the patent application was made is not relevant. Clearly, an incorrect statement was made on Form 7/77 about how Sandhurst came to have the right to be named as applicant, and Sandhurst should not have been so named, but it is of little significance now since the two inventors Dear and Sanders are free to choose whatever proprietor they wish to own their invention.

Findings

47. Since Bestplate has not established that section 39(1) applies I find that Bestplate is unsuccessful in its reference under section 37(1). Given as earlier stated, that I additionally found that Bestplate had additionally been unsuccessful in its application under section 13(3), I find that Dear and Sanders should remain as co-inventors and Sandhurst as proprietor.

Costs

48. At the hearing Mr Roughton asked whether I was going to make a standard award of costs and I stated that I was anticipating making a standard award, adding that I was willing to listen to submissions there and then. Mr Roughton made no further comment and Mr Lishman said that

perhaps it was a bit premature to say anything, but he could not see any particular reason why the standard award would not be appropriate. On further reflection I cannot, either, and so I order Bestplate to pay Sandhurst, who must be taken to be the winner in this rather unsatisfactory action, the sum of £950.

Appeal

49. Since this is a substantive matter, any appeal should be filed within six weeks of the date of this decision.

Dated this 7th day of September 2000.

G M BRIDGES

Divisional Director, acting for the Comptroller

THE PATENT OFFICE