

## **PATENTS ACT 1977**

IN THE MATTER OF a reference under Section 12(1)(a) by Robert W Cameron in respect of European Patent Application No 95306593.5 (published as EP0764936) in the name of Stanley Grossman

### **FINAL DECISION**

#### **Introduction**

- 1 This decision arises from an earlier decision I issued on 30 March 2001 relating to the reference by Robert W Cameron to the comptroller asking that he should replace Stanley Grossman as the sole applicant for European patent application number 9506593.5, published as EP0764936.
- 2 In that decision I concluded that Mr Grossman was not entitled to any rights to the patent application, but I was not satisfied that Mr Cameron had discharged the onus on him to prove that he was entitled to grant of the patent. This was because Mr Cameron's own evidence identified a number of individuals and bodies with whom Mr Cameron had entered into agreements and partnerships who, prima facie, may well have had more rights in the patent application than Mr Cameron.
- 3 Accordingly, I ordered the reference, statements of case and my decision to be sent to a number of individuals and bodies, giving them the opportunity to oppose Mr Cameron's claim. Replies were received from two of them, Scott Plastics and Sam Satya, the latter on behalf of the Cameron Group Acquisition Corporation. Scott Plastics expressly stated that they did not dispute Mr Cameron's right to the whistle patent. The Cameron Group wrote in terms which implied an intention to oppose Mr Cameron's claim, but their response was not in the form of a counter-statement. They were therefore given a further period in which to lodge a formal opposition, but in the event nothing further was received from them. I have no option, therefore, but to conclude they do not wish to oppose Mr Cameron's claim after all. It follows that I am now satisfied Mr Cameron has discharged the onus that was on him.

#### **Relief**

- 4 Mr Cameron asked me to order that "Mr Cameron replaces Mr Grossman as a sole applicant" for the patent in question. I do not think that is an appropriate form of relief, for the simple reason that this is a European, not a UK, patent application and the comptroller does not have the power to execute such an order in respect of a European application. Rather, I think the appropriate relief would be a declaration

that reflects the wording of Article 61 of the European Patent Convention. If Mr Cameron wants more than this, he will have to come back to me.

- 5 Accordingly I hereby declare that Robert W Cameron is solely entitled to grant of any patent resulting from European patent application number 95306593.5.

### **Costs**

- 6 Both sides have asked for costs and have made written submissions on the question. They are content for me to decide costs on the basis of those submissions.

- 7 Mr Cameron has won and is therefore in principle entitled to his costs. The award of costs by the comptroller is contributory, not compensatory, and unless there is good reason, according to a laid-down scale. In the present case, it is the scale for proceedings commenced prior to 22 May 2000 that applies. Applying that scale, and bearing in mind the relatively-modest amount of evidence that Mr Cameron had to submit and the fact that he did not incur the costs of personally coming over from the US to attend the hearing, I would have ordered Mr Grossman to pay £900 to Mr Cameron.

- 8 However, there is another factor. Mr Grossman argues that he has incurred considerable costs in prosecuting the patent application so far - £4622 in official fees and £2417 in attorney's fees - and that as these are costs which Mr Cameron would have incurred had he filed the application initially, he should now be reimbursed. I have some sympathy with this argument in the particular circumstances of this case because - even ignoring the disputed allegations made by Mr Grossman in a letter dated 19 July - I am satisfied that during the period when most of these costs were being incurred, Mr Cameron was fully aware of the patent application and was in regular communication with Mr Grossman about the invention. As I observed in my original decision, there was a delay of at least 3 years before Mr Cameron launched the present claim, and only part of this delay can be attributed to attempts to settle the dispute amicably. Mr Cameron must have been aware that throughout this period Mr Grossman was clocking up costs to keep the patent application going. If I were to ignore this, that might encourage claimants in entitlement disputes to hold back as long as possible in order to get the other side to carry the costs that they themselves would normally have had to carry.

- 9 Equally, it would not be fair for Mr Grossman to get a full reimbursement of his costs in prosecuting the patent application when Mr Cameron is only getting a modest contribution to his costs in prosecuting this claim. Taking this into account, I have come to the conclusion that the fairest result would be to make no order for costs - ie each side bears their own costs. Mr Cameron is, of course, now released from the requirement to provide £900 security for costs.

- 10 I should add that in reaching this conclusion, I have not attached any weight to Mr Cameron's argument that he has lost out by being kept out of the European market, because I am far from satisfied that the evidence establishes this.

## **Appeal**

- 11 As this order does not relate to matters of procedure, the period within which any appeal to the Patents Court must be lodged is six weeks.

Dated this 30<sup>th</sup> day of November 2001

**P HAYWARD**

Divisional Director, acting for the Comptroller

**THE PATENT OFFICE**