

6 August 2007

PATENTS ACT 1977

BETWEEN

R S Brookhouse Engineering (Evesham) Limited Claimant

and

Pro-Tek Engineering Limited Defendant

PROCEEDINGS

Reference under section 12(1) and application under sections 13(1) and 13(3)
of the Patents Act 1977 in respect of
patent application number EP 1123774

HEARING OFFICER

R C Kennell

DECISION

Background

- 1 The claimant filed the above reference and application on 23 December 2002, accompanied by a statement. In the absence of any counter-statement from either the defendant or the named inventors the Patent Office wrote to the parties on 29 August 2003 proposing to treat the reference and application as unopposed.
- 2 However, the claimant informed the Office that the parties were negotiating a settlement. The claimant wrote on 4 December 2003 to confirm that a settlement had been reached and (since there were parallel proceedings before the court involving other intellectual property items) that a consent order had been sent to the court for sealing.
- 3 However, although a consent order, containing an assignment of intellectual property including the application in suit, was eventually made on 10 August 2004 and sealed on 18 August 2004, difficulty arose in giving effect to the order because the application had lapsed for failure to pay renewal fees. From the

correspondence on file it appears that the claimant thinks it was misled by the defendant over the status of the application. The claimant had therefore sought advice as to the legal remedies available to it and advice from the European Patent Office (EPO) as to what rights might still be available in respect of the application. Until this was clarified the claimant was unwilling to withdraw the reference and application, and the proceedings before the comptroller have therefore been stayed.

- 4 The EPO's Legal Division wrote to the claimant on 30 April 2007 stating that the application had been deemed withdrawn with legal effect on 2 September 2003 and closed on 14 April 2004. It advised that, provided the claimant had been recognised by a final decision of the Patent Office as the person entitled to the grant of a European patent on the original application, the claimant could file a new application for the same invention under *Art 61(1)(b) EPC* by providing the relevant evidence even though the original application was no longer pending before the EPO. The relevant parts of Art 61 read:

“(1) If by a final decision it is adjudged that a person referred to in Article 60, paragraph 1, other than the applicant, is entitled to the grant of a European patent, that person may, within a period of three months after the decision has become final, provided that the European patent has not yet been granted, in respect of those Contracting States designated in the European patent application in which the decision has been taken or recognised, or has to be recognised on the basis of the Protocol on Recognition attached to this Convention: ...

(b) file a new European patent application in respect of the same invention,”

- 5 The defendant's patent attorney had already written to the Patent Office on 14 December 2005 stating his understanding that the application had been assigned from the defendant to the claimant, and confirming that neither he nor the defendant had any further interest in it. He noted in addition his understanding that the application had been deemed withdrawn in October 2003 for failure to pay an annual renewal fee.

The agreement between the parties

- 6 In the light of the above I am satisfied that the rights of the parties are determined by the above-mentioned consent order, a copy of which has been sent to the Patent Office by the claimant.
- 7 The schedule of agreed terms which forms part of the order includes an undertaking by the defendant to assign to the claimant, amongst other things, all the property and intellectual property rights in the application and to consent to the rectification, alteration and/or amendment of the relevant register to record the claimant as proprietor.
- 8 An annex to the schedule contains the actual assignment, which is stated to be in full and final settlement of the outstanding disputes between the parties including the above reference under section 12 and application under section 13 of the Act. The assignment has been signed for and on behalf of both parties.

- 9 The inventors mentioned in the application in suit are Kevin Alan Radbourne, Zdzislaw Leon Drewnicki, John Simon Eastham and Keith Vickery. However the defendant undertakes in the schedule of agreed terms to consent to the rectification, alteration and/or amendment of the relevant register to record the true inventors of the invention in the application as Roger Brookhouse, David Spencer, Paul Locke and Christopher Wakefield.

The law

- 10 Section 12(1) of the Act allows any person, at any time before a patent is granted, to refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) a patent for an invention in pursuance of an application made under any treaty or international convention (whether or not that application has been made). The comptroller may make such order as he thinks fit to give effect to his determination of the question.
- 11 Section 13(1) of the Act gives the inventor(s) a right to be mentioned as such in any patent granted for the invention and if possible in any published application for a patent for the invention; and if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document (this document being an addendum or correction under rule 14(5) of the Patents Rules 1995). Where a person has been mentioned as sole or joint inventor, section 13(3) provides that any other person who alleges that the former ought not to have been so mentioned may apply to the comptroller for a certificate to that effect; if the comptroller issues such a certificate, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of section 13(1). Under section 78(2) of the Act so much of section 13(3) as applies to an application for and issue of a certificate applies also to an application for a European patent (UK).
- 12 In respect of entitlement to a European patent the relevant part of Art 61 EPC is set forth above. Art 62 EPC gives the inventor the right, vis-à-vis the applicant or proprietor of a European patent, to be mentioned as such before the EPO and Rule 18(1) EPC gives the person designated as inventor the right to be mentioned as such in the published European patent and the European patent specification (unless he waives his right). Rule 18(2) EPC states:

“In the event of a third party filing with the European Patent Office a final decision whereby the applicant or proprietor of a patent is required to designate him as the inventor, the provisions of paragraph 1 shall apply.”

Determination

- 13 In the light of the agreement between the parties I determine in accordance with section 12(1) of the Act that the claimant R S Brookhouse Engineering (Evesham) Limited is entitled to the grant of a European patent for the invention in European application no 1123774. It is accordingly open to the claimant to make a new application for a European patent for the invention pursuant to Art 61 EPC.

- 14 In respect of the designation of inventors, I am satisfied that the parties are agreed that Roger Brookhouse, David Spencer, Paul Locke and Christopher Wakefield, and not Kevin Alan Radbourne, Zdzislaw Leon Drewnicki, John Simon Eastham and Keith Vickery, are the inventors of the invention in European application no 1123774. I therefore certify under section 13(3) that Kevin Alan Radbourne, Zdzislaw Leon Drewnicki, John Simon Eastham and Keith Vickery ought not to have been mentioned as inventors in application no 1123774 for a European patent (UK). This decision constitutes the certificate prescribed by section 13(3).
- 15 However, although it follows that Roger Brookhouse, David Spencer, Paul Locke and Christopher Wakefield ought to be mentioned as inventors in any new application filed under Art 61 EPC, I do not think that section 13 gives me any power to require such designation for the purposes of Rule 18(2) EPC. It will be for the claimant to provide such further information and evidence as the EPO may require in this matter.

Costs

- 16 Paragraph 4 of the consent order specifies that no order be made for costs. I do not therefore think it appropriate to make any award for costs in respect of the proceedings before the comptroller.

Appeal

- 17 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

R C KENNEL

Deputy Director acting for the Comptroller