



PATENTS ACT 1977

PARTIES William Duff and Joseph Brown

PROCEEDINGS Reference under sections 8 and 12 and
an application under section 13(3)
of the Patents Act 1977 in respect of
patent application numbers
GB 0419912.1 and PCT/GB2004/003785

HEARING OFFICER S M WILLIAMS

DECISION

Introduction

- 1 International patent application number PCT/GB2004/003785 published as WO/2005/026485 names Joseph Brown as applicant. Joseph Brown and William Duff are named as inventors.
- 2 Patent application number GB 0419912.1 published on 20 April 2005 as GB 2407118 names Joseph Brown and William Duff as joint patent applicants and joint inventors. Following publication of the patent application, the claims were revised to fully reflect the technical contribution of the invention.
- 3 William Duff has filed a reference and application under sections 8(1)(a), 12(1)(a) and 13(3) of the Patents Act 1977 to the effect that he ought to be named as sole patent applicant and sole inventor in respect of the GB and PCT applications.
- 4 In a joint statement signed by Mr Brown and Mr Duff, they both agree that revised claims 9 and 10 should be removed from the patent applications and that Mr Brown's name should be removed as applicant and inventor.
- 5 In a subsequent declaration signed by Mr Brown and Mr Duff, both agree that 'William Duff is the applicant and has now full entitlement and is successor in title to the following patent applications GB 0321627.2, GB 0321643.9, GB 405225.1, GB 0419912.1 and PCT/GB2004/003785'. In due course, each of the GB applications were assigned to Mr Duff as requested.

The law

- 6 The proceedings have been brought under sections 8(1)(a), 12(1)(a) and 13(3) of the Act, the relevant parts of which read:

Section 8

8.(1) At any time before a patent has been granted for an invention (whether or not an application has been made for it) –

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent;

(b) ..

and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.

Section 12

12.(1) At any time before a patent has been granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention (whether or not an application has been made) –

(a) any person may refer to the comptroller the question whether he is entitled to be granted (alone or with any other persons) any such patent for that invention or has or would have any right in or under any such patent or an application for such a patent; or

(b) [not relevant]

and the comptroller shall determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination.

Section 13

13.(3) Where a person has been mentioned as sole 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.

- 7 I note that section 12(1) of the Act provides the comptroller with broad powers and that a question of inventorship can be raised in section 12 proceedings.

Conclusion

- 8 On the basis of the written information provided by both parties, I conclude that Mr Duff and Mr Brown agree that claims 9 and 10 can be removed from patent application numbers GB 0419912.1 and PCT/GB2004/003785, and that William Duff should be named as sole patent applicant and sole inventor.

Findings and order

- 9 Given the agreement of the parties to the removal of the revised claims 9 and 10 from patent application number GB 0149912.1 and the assignment of the application to Mr Duff, there is no finding for me to make in relation to the

reference filed under section 8.

- 10 With regard to the section 13(3) application, I find that Joseph Brown should not be mentioned as a joint inventor in any subsequent patent granted for the invention. This decision, issued in accordance with section 13(3), serves as a certificate to this effect. As such I direct that claims 9 and 10 be removed from the patent application as requested by Mr Duff.
- 11 In terms of the section 12 reference, I am not entirely clear whether the international patent application has been amended to include the revised claims 9 and 10 or any equivalent claims. However, I declare that William Duff is entitled to the invention the subject of international patent application number PCT/GB2004/003785 and as such should be named as sole patent applicant. He should also be recorded as sole inventor for each jurisdiction designated for the same reasons as outlined above in relation to patent application number GB 0419912.1. Mr Duff may use this declaration in support of a request to the International Bureau on this matter or to any national and /or regional authority in respect of any national and/or regional phase application(s) the international application matures into.

S M WILLIAMS

B3 Head of Litigation Section, acting for Comptroller