

PATENTS ACT 1977

BETWEEN

Mr Russell Taylor

Claimant

and

AQ+ Plc

Registered Proprietor

PROCEEDINGS

Reference under section 8 of the Patents Act 1977 in
respect of patent application number GB 2430371A

HEARING OFFICER

Stephen Probert

DECISION ON THE PAPERS

- 1 This reference under section 8 (entitlement) is now uncontested, and the facts can be stated briefly. Mr Russell Taylor applied for a patent (GB 0409725.9) in May 2004. This priority application was never published, and it was terminated a year later in May 2005. Two days before the priority application was terminated, the present application (GB 2430371A) was filed in the name of AQ+ Plc, a company incorporated by Mr Taylor in 2000. Mr Taylor was a director of AQ+ Plc until 2004 when he resigned, but stayed with the company as “Consultant Emeritus”.
- 2 The application relates to compositions for use in controlling the gender of [animal] progeny. When it was examined in July 2008, many serious objections were raised — not least of which was a lack of novelty on the basis of a significant body of prior art. By this time Mr Taylor was completely out of the picture, having been hospitalised in June 2008 as a result of a serious heart condition, and the company was being run by the remaining directors (including a Managing Director). The applicant, AQ+ Plc, did not respond to the examination report, and consequently the application was refused on 10th July 2009, immediately after the end of the compliance period for putting the application in order.

3 It was not until January 2010 that Mr Taylor fully realised what had happened with the application. In April 2010, he applied to reinstate the application, but was informed that a request for reinstatement can only be made by the patent applicant — which in this case is AQ+ Plc. To complicate matters further, AQ+ Plc went into administration on 2 September 2008, and a liquidator was appointed a year later in September 2009.

4 Mr Taylor launched these entitlement proceedings in September 2010, requesting that patent application GB2430371A should be put in his name. Mr Taylor said:

“I do not know who changed the name of the applicant from mine to AQ+ Plc and I was not aware that had happened.”

5 In fact, the official file shows that the application was originally filed in the name of AQ+ Plc, and has remained in that name ever since. I presume Mr Taylor was thinking about the priority application (GB0409725.9), which was filed in his personal name.

6 The liquidator, Stephen Evans of Antony Batty & Company LLP, did initially file a counterstatement stating that the books and records of AQ+ Plc in his possession do not show any alternative ownership to the patents other than AQ+ Plc. He requested that AQ+ Plc remain as the registered proprietor (of the terminated patent application).

7 However, on 24 January 2012 Mr Evans wrote to the Patent Office to advise that he had ceased to act as liquidator of AQ+ Plc in October 2011. He added that the company was likely to be dissolved on 3 February 2012, and that the Bona Vacantia Division of the Treasury Solicitor’s Department would be responsible for any residual assets. (A quick check of the company details on the database of Companies House shows that AQ+ Plc was indeed dissolved on the date indicated by Mr Evans.) I am therefore treating this reference as unopposed.

The Law

8 The present proceedings have been brought under section 8 of the Act, which gives me the jurisdiction to determine entitlement to the patent application in this dispute. The relevant parts of section 8 read as follows:

Determination before grant of questions about entitlement to patents, etc.

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; or

(b) any of two or more co-proprietors of an application for a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person;

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

(2) Where a person refers a question relating to an invention under subsection (1)(a) above to the comptroller after an application for a patent for the invention has been filed and before a patent is granted in pursuance of the application, then, unless the application is refused or withdrawn before the reference is disposed of by the comptroller, the comptroller may, without prejudice to the generality of subsection (1) above and subject to subsection (6) below -

(a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant;

(b)

(3) Where a question is referred to the comptroller under subsection (1)(a) above and -

(a)

(b)

(c) any such application is refused under any other provision of this Act or is withdrawn before the comptroller has disposed of the reference, (whether the application is refused or withdrawn before or after its publication)

the comptroller may order that any person by whom the reference was made may within the prescribed period make a new application for a patent for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier application, subject in either case to section 76 below, and in either case that, if such a new application is made, it shall be treated as having been filed on the date of filing the earlier application.

9 From this it can be seen that the Comptroller's power under section 8(2) to order that the application shall proceed in Mr Taylor's name, only exists up until the time when the application was refused or withdrawn.

10 Nevertheless, I have come to the conclusion, on the balance of probabilities, and on the basis of the documents on the official file, that the matter in the terminated patent application belongs to Mr Taylor.

11 I note from Mr Taylor's statement of case that he instigated the filing of all the relevant patent applications, including the present application, and that he also paid for all the work associated with them. He instructed a well known firm of Patent Attorneys to prepare and file the application on his behalf, but (on the limited information available to me) it appears that the patent attorney may have assumed that Mr Taylor was acting on behalf of AQ+ Plc; whereas in fact Mr Taylor maintains that he always intended that the patent application should be filed in his personal name.

12 I cannot say how such a misunderstanding may have occurred. The 'evidence' that there may have been a misunderstanding is thin. For example, the present application could only benefit from the priority date of the earlier application if the applicant (AQ+ Plc) was the successor in title to Mr Taylor. But I have not seen any record or evidence of a transfer of rights in respect of the matter in the earlier application from Mr Taylor to AQ+ Plc. Furthermore, Mr Taylor says that he was not an employee of AQ+ Plc at any stage, and at no time did he receive any payment.

- 13 For all these reasons, I consider that the matter in patent application GB2430371A belongs to Mr Taylor. If the application had not already been refused, I would have ordered (under section 8(2)) that the application should proceed in his name. But clearly I cannot do that now because the application has been refused; so strictly speaking I am rejecting Mr Taylor's specific request.
- 14 However, although Mr Taylor has not explicitly sought relief under section 8(3), it appears to me that he is entitled to an order allowing him to file a new patent application with the same date of filing as the terminated application. In view of the major obstacles to patentability in the path of Mr Taylor's invention — as detailed in the examination report issued on the terminated application (GB2430371A) — I would not want anyone to think that I am recommending that Mr Taylor files another application for the same matter.

ORDER

- 15 On the basis of the facts pleaded in the statement and the other documents provided by the claimant (all of which are now unchallenged in these proceedings), I am satisfied that the matter comprised in patent application GB 2430371A belongs to Mr Russell Taylor. **In accordance with section 8(3), Mr Russell Taylor may make a new application for the whole or any part of any matter comprised in GB 2430371A subject to section 76 (added matter). If such a new application is made, it shall be treated as having been filed on the date of filing of GB 2430371A. Any such application must be made within three months from the date of this decision or, where an appeal is brought, from the day on which the appeal is finally disposed of.**

Appeal

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

S PROBERT

Deputy Director acting for the Comptroller