



PATENTS ACT 1977

BETWEEN

Paul Kelly

Claimant

and

Packexe (Holdings) Limited

Defendant

PROCEEDINGS

Reference under section 8 and
application under section 13 in respect of
patent application GB0916691.9

HEARING OFFICER

H Jones

DECISION

Introduction

- 1 The patent application relates to a method of avoiding injuries caused by shattered glass at the scene of a road traffic accident. It was filed by Packexe (Holdings) Limited on 23rd September 2009 and names Mr Andrew Harry Orchard, the Managing Director of Packexe (Holdings) Limited (“Packexe”), as the sole inventor - Packexe derive the right to be granted a patent by virtue of Mr Orchard’s employment with the company. The application claims a priority date of 9th May 2009 and was published as GB2470085 on 10th November 2011.
- 2 The application has not yet been granted, and there would appear little prospect of it proceeding to grant as a consequence of Packexe’s failure to respond the second examination report issued on 9th July 2010 with a date for reply of 9th May 2011. Although the application appears to have been abandoned by Packexe, they have not formally requested for it to be withdrawn.
- 3 On 7th July 2011, Mr Paul Kelly initiated entitlement proceedings under sections 8 and 13 of the Patents Act 1977, claiming that he is the sole inventor and that the patent application should be granted to him. Packexe dispute this.
- 4 On 13th September 2012, Mr Stephen Probert, who was acting as Hearing Officer at the time, issued a Preliminary Evaluation setting out his non-binding view of the issues. It is common practice for the Office to issue such Evaluations as a way of focussing the minds of the parties on the key issues and thereby guiding the proceedings through to resolution as efficiently as possible. In his evaluation, Mr Probert identified at least two distinct ideas necessary for the development of the invention described in the application, and suggests that both Mr Kelly and Packexe

could lay claim to being the originator of one or more of these ideas either separately or in collaboration. In his view, the proceedings were likely to require a more detailed assessment of who contributed what in the development of the invention, and that, on a prima facie view, a likely conclusion was that the current application could be amended to exclude any inventive concepts made by Mr Kelly and that Mr Kelly would likely be given leave to file a new application for the aspects of the invention made by him.

- 5 Packexe dispute the novelty of some of the ideas claimed to be conceived by Mr Kelly. In his Written Evaluation, Mr Probert addresses this point by reference to the Court of Appeal's judgment in *Markem*¹, which says that proceedings under section 8 cannot turn into a full-scale inquiry into validity unless there was a clear and unarguable case for doing so. He mentioned this not least because of the fact that the patent application has not yet been refused or granted, and that even if the comptroller were to decide in favour of one party or the other on entitlement, the issue of validity might be so clear that the application could be refused and would leave nothing for the parties to fight over. In Mr Probert's words, which paraphrase those of Jacob LJ in *Markem*, the parties may have to decide for themselves whether there is (or was, or might have been) a bone to be fought over.
- 6 The usual evidence rounds followed and the matter was due to come before me at a hearing scheduled for 5th February 2013. However, as neither side wished to cross-examine witnesses, it was agreed that skeleton arguments would be submitted and that the matter would be decided on the basis of the papers on file. Skeleton arguments for Mr Kelly were received from Mr Lionel Clarke of Gill Jennings Every LLP, and for Packexe from Mr Michael Brown of Alpha & Omega.

Summary of arguments

- 7 In his statement of case, Mr Kelly says that he was employed as a part time fire fighter by Bedfordshire and Luton Fire and Rescue Service ("the Fire Service") from May 2005, and as part of his job was expected to attend vehicle crash sites and to rescue crash victims from their vehicles. This, he explains, regularly involved the removal of glass from vehicles so that crash victims could be removed safely, a process he describes as glass management. At the time of his employment as a fire fighter, Mr Kelly says that he was also involved in part-time painting and decorating services, and as a consequence became aware of an existing Packexe product which was used to adhere to and thereby protect carpets during decoration - he describes the product as a roll of film with low-tack adhesive attached to one side for covering and protecting domestic carpets during decoration.
- 8 In late 2007, Mr Kelly says that he had the idea that modifications could be made to the decorating film in order to produce an effective film for improving the breaking and extraction of windows and windshields from motor vehicles. This initial idea involved the application of an adhesive film to the windows and windshield of a vehicle so that any glass fragments would adhere to the film and would be less of a danger at the scene of a road traffic accident. Mr Kelly says that he experimented with some of the existing Packexe film-roll and developed some modifications for the film. He then approached Packexe to discuss what developments could be made to produce a film that would work in a fire and rescue environment rather than a domestic or construction environment. He says that discussions with Packexe began

¹ *Markem Corp v Zipher Ltd* [2005] EWCA Civ 267

in December 2007 and that various employees of Packexe visited Bedford Fire Station early in 2008 to discuss development of a working product. It was during these visits that Mr Kelly claims to have made the following four suggestions for modifying the existing Packexe film:

- a) the existing film could generally be used in glass management in crash situations;
- b) the width dimensions of the film should be reduced in order to approximate the width of car windows and windshields;
- c) the film should be deliverable from an applicator; and
- d) the adhesive used to attach the film to the glass be made more adherent so that it would adhere in wet weather conditions and that the glass did not come free of the film during extraction of the glass.

9 In their amended counter-statement, Packexe allege that the general principle of using adhesive-backed tape or film to manage glass in road vehicle rescues was known as far back as 2001. They admit that they were contacted by the Fire Service in 2007 and were asked to supply samples of their film in a narrower width for testing and evaluation purposes. They claim that on their own initiative, they also included some samples wound onto a longer core so that the ends of the core could be used as handles. They say that the person who contacted them was a Mr Allan Roberts, who was a crew manager with the Fire Service at the time and was later employed by Packexe.

10 Packexe employees visited the Fire Service in March 2008 to see the film in use and to get feedback on its performance. It is from here onwards that Packexe's account of events differs to that of Mr Kelly's. Packexe say that after receiving feedback on the performance of their film, they decided to produce three sample films with different adhesive strengths and these were sent to the Fire Service for further testing. Following further development work at Packexe, Mr Orchard proposed adding perforations to the film at set intervals along its length to make it easier to detach the roll from the applied film without the need for a cutter. Packexe say that feedback on this particular development was not favourable.

11 Packexe say that they already produced a dispenser for the application of their existing film roll prior to 2007. They say that in February 2009, Mr Roberts visited Packexe in Exeter to show Mr Orchard a training video produced by the Fire Service, and it was during this visit that Mr Roberts said that it was unfortunate that the existing Packexe dispenser was not suitable for applying film to vehicles. Packexe say that they then developed a modification of their original dispenser that would make it more suitable for applying film to vehicles. This adaptation involved replacement of the existing rollers with foam-covered rollers to apply the film more securely to glass. After further feedback from the Fire Service, the film and dispenser were launched as commercial products at the International Firex exhibition in May 2009, and Mr Roberts was invited to help in a paid capacity on the stand.

12 Packexe deny that Mr Kelly is the originator of any of the improvements to their existing products. They say that the improvements that were initiated, specified, developed and perfected by Mr Orchard are as follows:

- a) the narrower film;
- b) the film wound onto a longer core;

- c) the adhesive formulation to provide adhesion to vehicles;
- d) the perforated film; and
- e) the dispenser with padded rollers.

The evidence

- 13 The evidence consists of i) a statement of case from Mr Paul Kelly along with four exhibits documenting his role in the development of the invention, ii) a first witness statement from Mr Andrew Orchard together with a single exhibit providing a chronological outline of the development of the invention, iii) witness statements from Mr Andrew Shrehane and Mr Stuart Brereton, both of whom are colleagues of Mr Kelly in the Fire Service, and iv) a second witness statement from Mr Andrew Orchard in reply to Mr Kelly's evidence, together with five exhibits which are said to demonstrate that tapes and plastic films have been in use for many years for managing broken glass in various industries including the Fire Service.
- 14 In his skeleton argument, Mr Kelly requests that the new evidence submitted by Packexe, namely the five exhibits and any information based on them, should not be admitted into proceedings as they were filed very late and are not strictly in reply to the claimants own evidence. He also argues that the delay in submitting this evidence should be borne in mind when deciding costs. To the extent that the new evidence relates to the question of whether the general principle of using adhesive-backed tape or film to manage glass in road vehicles is new, which Packexe assert in their amended counter-statement filed on 24th November 2011, I believe that the correct approach is to admit the evidence into proceedings and to deal with any inconvenience to Mr Kelly in any order for costs.

The law

- 15 Determination of questions about entitlement to the grant of a UK patent and the right to be mentioned as inventor are governed by sections 8 and 13 of the Patents Act respectively. The relevant parts of the Act are set out below:

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

8(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) where the reference was made by two or more persons, order that the application shall proceed in all their names jointly;

(c) refuse to grant a patent in pursuance of the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred;
(d) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.

8(3) Where a question is referred to the comptroller under subsection (1)(a) above and -

(a) the comptroller orders an application for a patent for the invention to which the question relates to be so amended;
(b) any such application is refused under subsection 2(c) above before the comptroller has disposed of the reference (whether the reference was made before or after the publication of the application); or
(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.

13(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned 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.

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.

16 Section 7, which governs the right to apply for and obtain a patent, is also relevant:

7(1) Any person may make an application for a patent either alone or jointly with another.

7(2) A patent for an invention may be granted -

(a) primarily to the inventor or joint inventors;
(b) in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;
(c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned; and to no other person.

7(3) In this Act "inventor" in relation to an invention means the actual deviser of the invention and "joint inventor" shall be construed accordingly.

17 Further guidance regarding the issue of entitlement to an invention is provided at paragraphs 101 to 104 of *Markem*. One of the first questions to answer is what is the invention, and Jacob LJ says that "...the word "invention" cannot mean just what is in each claim". He elaborates by saying:

“...one is driven to the conclusion that section 8 is referring essentially to information in the specification rather than the form of the claims. It would be handy if one could go by the claims, but one cannot. Section 8 calls for identification of information and the rights in it. Who contributed what and what rights if any they had in it lies at the heart of the inquiry, not what monopolies were actually claimed.”

“A claim-by-claim approach is not appropriate in proceedings under s.8. The proper approach is to identify what information was used which should not have been used or should not have been used solely by the applicant and use that to formulate the appropriate consequential order.”

- 18 The Court of Appeal also addressed the issue of validity in entitlement proceedings, with Jacob LJ saying at paragraphs 87 and 88 that:

“Mr Thorley accepted that section 8 proceedings cannot turn into a full-scale inquiry into validity in a difficult case but that where an unanswerable case of validity was raised the comptroller can act upon it.”

“We have no doubt that Mr Thorley is right. If the patent or part of it is clearly and unarguably invalid, then we see no reason why as a matter of convenience, the comptroller should not take it into account in exercising his wide discretion. The sooner an obviously invalid monopoly is removed, the better from the public point of view. But we emphasise that the attack on validity should be clear and unarguable. Only when there is self-evidently no bone should the dogs be prevented from fighting over it.”

Arguments and analysis

Entitlement

- 19 The invention as defined by the claims concerns a method of protecting a surface (or structure) by applying an adhesive coated plastic film to the surface (or structure) using two spaced resilient rollers and, once the desired length has been unwound, rupturing the plastic film along a row of perforations. There are also claims to a dispenser comprising two spaced resilient rollers and a core, onto which is wound a plastic film with an adhesive coating and rows of perforations. However, in the light of *Markem*, the invention needs to be assessed from the point of view of the information in the specification and not the form of the claims, and in my view there are four separate concepts disclosed in the patent application.

The use of an adhesive film in glass management

- 20 Packexe admit that they received a telephone call from the Fire Service explaining that a fireman had been using their 625mm wide self-adhesive film to manage glass in vehicle extrications. They were asked if they could supply film in narrower widths, and they agreed to supply films in 312.5mm widths free of charge. Mr Orchard says that on their own initiative, they also included some samples wound onto narrower and longer cores (38mm x 535mm) so that the protruding ends could be used as handles; Mr Orchard says that the 38x535 core was a standard Packexe component used for pallet-wrapping film. Although Packexe allege that the general principle of using adhesive-backed tape or film to manage glass in road-vehicle rescues is not new, there is no evidence to suggest that they were aware of the general principle before they were approached by the Fire Service. On the basis of the evidence before me, I find that all of the development work undertaken by Packexe stemmed from the initial approach by the Fire Service, and that it was Mr Kelly, not Packexe,

who proposed using an adhesive film (that he had previously used to protect carpets during decoration work) to improve the management of glass.

A glass management film having an adhesive coating capable of adhering to the surface upon which it is placed

- 21 With regard to the adhesive film itself, Packexe acknowledge that they provided a number of samples to the Fire Service for further testing. These tests were undertaken by the Fire Service, and according to the chronology of events provided by Packexe, the Fire Service informed them in Spring 2008 that the existing “low-tack” adhesive on the film was not performing well on wet or highly-polished surfaces. Packexe say that they decided to produce three sample films with different adhesive strengths and sent them to the Fire Service for further testing. The realisation that the existing adhesive was unsuitable for its new purpose could only have been made by the Fire Service, as it was they who had undertaken the task of testing the film. The solution to the problem of the adhesive not being tacky enough was, as Mr Kelly says in his statement of case, quite obviously to make it more sticky, but the Fire Service had to rely on the technical skills of Packexe in order to produce the stickier films.
- 22 There is no suggestion in the specification that there is any ingenuity in the adhesive composition used for the film, merely that it needs to meet certain performance characteristics to overcome problems associated with sticking film to particular surfaces. It was only through experimentation by the Fire Service that the deficiencies in the existing film became apparent. In his statement of case, Mr Kelly states that he was involved in testing the film at the Fire Service and that he mentioned the need to increase the strength of the adhesive to employees of Packexe during one of their site visits. The fact that Mr Kelly was involved in testing the product and that he had realised that the adhesive needed to be stickier is corroborated by the witness statements of Andrew Shrehane and Stuart Brereton. On the basis of the evidence before me, I find that Mr Kelly was at least an, if not the, originator of the idea of using an adhesive film capable of adhering to the surfaces of a vehicle. It was Packexe who devised the adhesive formulation to meet the performance requirements specified by the Fire Service.

An adhesive plastic film having rows of perforations

- 23 In his statement of case, Mr Kelly says that he was aware of Packexe’s unperforated film through his part-time painting and decorating work. He does not say at this point that it was he who devised the idea of providing rows of perforations in the film to assist in tearing a portion of film away from the main roll. Packexe say in their amended counter-statement of 25th November 2011 that it was Mr Orchard who devised the idea of perforations, and Mr Orchard repeats this claim in his first witness statement dated 21st November 2012: Mr Orchard says that in October 2008, he proposed “adding perforations to the film at set intervals along its length to make it easier for one man to detach the roll from the applied film without the need for a cutter.” He says that feedback on this idea from Mr Allan Roberts was unfavourable.
- 24 In a letter dated 23rd November 2012, it is said that Mr Kelly disputes the claim by Mr Orchard that he devised the idea of perforated film and suggests that the idea was originally discussed during the testing period of the film and that it was much debated. The letter says that Mr Roberts suggested it might not be appropriate to

include perforations due the possibility that miniscule particles of glass could penetrate the film. I note that the letter does not say that it was Mr Kelly who initiated the idea of adding perforations to the film (merely that it was suggested to Packexe as a possible modification by him), and there is nothing in his statement of case or the witness statements of Mr Brereton and Mr Shrehane to suggest that he did any more than convey the idea to Packexe. I can find nothing in the evidence to suggest that Mr Kelly was the originator of the idea of having rows of perforations in the film. Furthermore, the onus is on Mr Kelly to show that, on the balance of probabilities, Mr Orchard was not the deviser of the perforated film. On the basis of the evidence before me, I do not consider that this onus has been met.

An adhesive film dispenser having two spaced resilient rollers

- 25 In the letter dated 23rd November 2012 responding to Packexe's amended counter-statement, it is said that "Mr Kelly has not made any claim to the dispenser. The dispenser was already in the public domain (for flooring purposes) and is just a smaller version than was previously used." On the basis of this and the evidence before me, I am satisfied that Mr Orchard devised the particular film dispenser having two spaced rollers.

Validity

- 26 As I have noted above, the Court of Appeal in *Markem* said that proceedings under section 8 cannot turn into a full-scale inquiry into validity unless there was a clear and unarguable case for doing so. Packexe have stated that the use of plastic film for glass management purposes was known prior to the cooperation between Packexe and the Fire Service, and they have supplied evidence, in the form of five exhibits, to support this assertion. They have also provided the names of two companies they believe to be involved in the marketing of such products. The patent application has also been subject to search and examination before the Office, and the arguments presented by the examiner also need to be taken into account in deciding whether there is an unarguable case for taking validity into account.
- 27 The prior art documents identified by the examiner during the course of search and examination disclose various improvements to adhesive films and to tape dispensers, but none in the context of vehicle glass management as in the present invention. The documentary evidence provided by Packexe as part of these proceedings show the use of duct tape in containing broken glass from vehicles, a plastic film for retro-fitting to vehicles to prevent glass shattering and a glass repair film used in boarding up broken windows. I do not consider that any of these documents present an unarguable and clear case for assessing validity in these proceedings. Some or all of these documents may well be relevant in assessing validity in pre-grant proceedings, but I do not believe that there is a clear case for me to undertake that assessment in this entitlement dispute.

Conclusions

- 28 There are four inventive concepts disclosed in the patent specification. On the balance of the evidence before me, I have found that they were devised by the following individuals:
- a) the use of an adhesive film in glass management was devised by Mr Paul Kelly,

- b) a glass management film having an adhesive coating capable of adhering to vehicle surfaces was devised by Mr Paul Kelly,
- c) an adhesive plastic film having rows of perforations was devised by Mr Andrew Orchard, and
- d) an adhesive film dispenser having two spaced resilient rollers was devised by Mr Andrew Orchard.

- 29 The claims of the application are directed to concepts c) and d), namely to the perforated film and the adhesive film dispenser, both of which were devised by Mr Andrew Orchard, the Managing Director of Packexe. Mr Orchard is quite rightly named as an inventor in the application, and Packexe are entitled to apply for a patent in respect of Mr Orchard's contribution.
- 30 Mr Kelly is the deviser of concepts a) and b), namely the use of an adhesive film in glass management and a film having an adhesive coating capable of adhering to the surface of vehicles. The prior art evidence before me does not suggest that these concepts are clearly and unarguably invalid, so Mr Kelly deserves, at the very least, to be recognised for his inventive contribution.
- 31 In his Written Evaluation, Mr Probert suggested that both Mr Kelly and Packexe (by virtue of Mr Orchard's employment) had the right to apply for a patent in respect of one or more of the inventive concepts described in the patent application. I find that I am in agreement with his non-binding assessment. Mr Probert also suggested that the proceedings would likely be concluded with the comptroller ordering under section 8(2)(c) that the current application be amended to exclude any inventive concepts made by Mr Kelly and to allow a new application to be filed under section 8(3) for any or all of the matter excluded from the earlier application. I shall deal with this under possible remedies.

Remedies

- 32 Mr Kelly is seeking an order under section 8(2)(a) for the application to proceed in his name. He requests that he be identified as the sole inventor and that the application be granted to him in accordance with section 7(2)(a). He also requests that he be added as inventor under rule 10(2) and that Mr Orchard's name be removed as inventor under section 13(3). He has asked for an award of costs in his favour.
- 33 Packexe ask for these proceeding to be dismissed and for an award of costs in their favour.
- 34 Given my findings above regarding who devised which of the inventive concepts disclosed in the application, it seems to me that I cannot grant sole ownership to the patent application or identify a sole inventor in what appears from the evidence to be a collaborative project. Mr Orchard refers in his second written statement to the added complication that the concepts devised by Mr Kelly are admitted as having been made during his employment with the Fire Service, which would suggest that it would be the Fire Service, not Mr Kelly, who would be entitled to any patents derived from his inventive contributions. The Fire Service is not a party to current proceedings, and there is nothing before me that specifies the contractual terms of Mr Kelly's employment with the Fire Service. Section 7(2) says that a patent for an invention may be granted primarily to the inventor or joint inventor unless there is an over-riding enactment, law, treaty or agreement between the inventor and another

person before the invention was made. Mr Kelly's contract of employment may well include such an agreement, but I do not have any evidence before me to suggest that it does.

- 35 As far as entitlement is concerned, I find that Mr Kelly has discharged the onus on him of proving that he was the deviser of certain inventive concepts and that, therefore, he is primarily entitled to apply for and obtain a patent under section 7(2)(a). It is up to other parties to prove that he is not entitled to be granted a patent by virtue of any agreement made before the invention was made, and Mr Orchard's suggestion that Mr Kelly's employment by the Fire Service is evidence of such an agreement is insufficient - this is not surprising given that the only parties who would have the information necessary to prove a transfer of entitlement by virtue of employment are Mr Kelly and the Fire Service, not Mr Orchard. As I have said above, the Fire Service is not a party to these proceedings, so there is a question as to whether they ought to be, or whether enquiries ought to be made regarding the terms of Mr Kelly's employment before I decide on his entitlement to apply for and obtain a patent. However, as is pointed out in Mr Kelly's skeleton argument, this is an issue for the Fire Service to raise with Mr Kelly and to initiate their own proceedings if necessary, rather than for Packexe to raise as a defence during these proceedings.
- 36 It seems to me that the most equitable remedy in this case would be the one suggested by Mr Probert in his Written Evaluation, that is to allow Mr Kelly to make a new application under section 8(3) based on the subject matter I have identified above as having been devised by him. Mr Kelly has indicated that he would be prepared to accept such an outcome.
- 37 As deviser of the concepts identified above, Mr Kelly has the right to be named as inventor and is entitled to apply for a patent unless another person can show otherwise by virtue of an over-riding enactment, rule of law or agreement. I make no assessment here regarding the validity of such a patent - Mr Kelly will need to decide for himself whether he wishes to pursue his application through the pre-grant search and examination process based on what he knows of the prior art presented as part of these proceedings.
- 38 A new application can be made under section 8(3) either when the comptroller orders the application (to which the reference under section 8 is made) to be amended, or if the application is refused or withdrawn before the comptroller has disposed of the reference under section 8. The present application appears to have been abandoned by Packexe but has not yet been formally refused or withdrawn, so the only mechanism for allowing Mr Kelly to file a new application under section 8(3) is to order Packexe to amend, even though it would appear that they have no interest in pursuing the application. If Packexe do wish to pursue their application, and can convince the comptroller to allow a late filed response to the examiner's report issued in July 2010, then it is only at this point that they would need to put such an order into effect. The application would need to be amended to exclude any suggestion that the features devised by Mr Kelly were devised by them. Given that the claims already focus on aspects devised by Mr Orchard then I consider that the amount of amendment will be minimal.

Costs

- 39 *Tribunal Practice Notice (TPN) 4/2007*² explains how costs are to be determined in proceedings before the comptroller. It includes the standard scale that is usually applied, and also provides guidance concerning situations when the comptroller may award costs off the scale, for example the conduct of the parties in the proceedings.
- 40 Mr Kelly has requested off scale costs in its favour. He argues that Packexe have engaged in delaying tactics throughout proceedings, have failed to comply with the normal requirements for a counter-statement, have filed their evidence very late in proceedings and have supplied erroneous and irrelevant information. Packexe have not addressed the scale of costs to be awarded in their favour
- 41 Whilst it is the case that Packexe were asked to submit an amended counter-statement because of deficiencies in the original, this appears to be the only instance where they did not respond fully to the timetable for the proceedings set by the Office. Although the five exhibits of prior art were submitted in reply to Mr Kelly's evidence and not before, Packexe did raise the issue of the use of an adhesive backed film to manage glass being known in their amended counter-statement, thus giving Mr Kelly sufficient notice that they considered this a relevant argument. The further evidence provided by Packexe was potentially relevant to the issue concerned.
- 42 Taking full account of the conduct of both parties in these proceedings, I am satisfied that there has been no wider breaches or rules, delaying tactics or unreasonable behaviour on either side in these proceedings that would justify off-scale costs.
- 43 It is customary to award costs to the successful party, but in this case I am not able to say that one party has been any more successful than the other: I have found Mr Kelly to be the deviser of two out of the four concepts disclosed in the application and Mr Orchard to be the deviser of the other two. For this and the reasons discussed above, I am not making any order as to costs in these proceedings.

ORDER

- 44 I order that the application be amended in such a way that it excludes any suggestion that the features devised by Mr Kelly (as set out above) were devised by Packexe.
- 45 In accordance with rules 20(3)(a) and (b), Mr Kelly has three months from the date of this order to make a new application under section 8(3) for the features devised by him (as set out above), subject to the requirements of section 76 (added matter). The new application will be treated as having been filed on the filing date of the present application, namely 23rd September 2009. If an appeal is brought against this decision, the date for filing the new application under section 8(3) will be extended to three months from the day on which it is finally disposed.

² <http://www.ipo.gov.uk/pro-types/pro-tm/t-law/t-tpn/t-tpn-2007/t-tpn-42007.htm>

Appeal

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

H Jones

Deputy Director, acting for the Comptroller