



PATENTS ACT 1977

BETWEEN

Open Energi Limited	Claimant
and	
Andrew Nicholas Dames	Defendant

PROCEEDINGS

Reference under section 7 and section 8 of
the Patents Act 1977 in respect of patent application GB 2467159

HEARING OFFICER Phil Thorpe

DECISION

Introduction

1. Patent application GB 2467159 was filed on 26th January 2009 by Mr Andrew Nicholas Dames with Mr Dames being also the only named inventor.
2. On 18th March 2013 Open Energi Limited filed a reference under sections 7(2)(b) and 8(1)(a) of the Patents Act seeking an order that the application belongs to Open Energi Limited and that further the application be deemed to have been filed by Responsiveload Limited and that its change of name to Open Energi Limited be duly recorded.
3. A copy of the reference was sent to Mr Dames on 2nd April 2013. Mr Dames was invited to file a counter-statement by 14th May 2013 if he wished to object to the reference. No response has been received. Therefore as required by rule 77(9) of the Patents Rules 2007, I must treat him as supporting the claimant's case. Rule 77(9) says:

77(9) Where-

(a) a person was notified under paragraph (1) or (2); and

(b) that person fails to file a counter-statement under paragraph (6) or (8), the comptroller shall treat him as supporting the claimant's case.

4. On 22nd May 2013, the Office wrote to Mr Dames and advised him that in the absence of a counter-statement he was not considered a party to these proceedings.

The law

5. These proceedings have been brought under section 8 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.

(2) ...

6. Also relevant is section 7, which reads:

Section 7

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

*(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)

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

(4) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under

subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

Argument and discussion

7. According to the Statement of Case Open Energi's business is assisting energy suppliers to balance electricity generation and consumption to maximise the efficiency of the electricity supply. In late 2008 Responsiveload Limited (RLL), which is the former name of Open Energi, began exploring opportunities to create intellectual property in the field of connecting electric vehicles to the electricity grid. A number of patent applications resulted. Details of these, some of which claim priority from the application in issue here, are set out in the Statement of Grounds.
8. Mr Dames was engaged by RLL through his company Attigi Limited to work on a number of projects in relation to what became known as the "vehicle to grid" or "V2G" project. The claimant has provided a witness statement from Mr Dames which confirms that it was his understanding that any intellectual property that he created whilst working for RLL would belong to RLL. He notes that the basis for this arrangement was a verbal agreement he had with Andrew Howe, the Chief Executive of RL Tec and a subsequent written agreement which he signed on behalf of Attigi. RL Tec is the trading name for Responsiveload Limited. Responsiveload Limited was renamed as Open Energi Limited in October 2012.
9. A copy of the written agreement has been submitted as evidence. The agreement is a contract for services between Responsiveload Limited (RLL) and "a developer". The name of the developer has not been entered. The agreement is however signed by Mr Dames for one side and by a Director and the Secretary of Responsiveload. The signatures are all dated 7th January 2009. The agreement notes that any intellectual property "made, created or discovered or registered by the Developer ... will belong to and be the absolute property of RLL".
10. According to Mr Dames, he filed the application in issue here on 26th January 2009. He was apparently not sure how to complete the forms so as to name RL Tec as the applicant so he filed it in his name. He notes that he expected the patent attorney to sort it out later. He further notes that he cannot recall when the invention set out in the patent application was made but thought it was in January 2009.
11. It is clear that there is really no dispute that Open Energi is entitled to be granted alone a patent for the invention set out in GB 2467159.
12. However Open Energi is not only seeking an order that the application should proceed in its name. It also wants me to order that the application should have been deemed to have been filed by Responsiveload Limited and that its change of name to Open Energi Limited be duly recorded. The reason why it is requesting such an order is so as to assist it in substantiating a claim to priority from the application in issue here in at least one further application.

13. This raises two points. The first is whether I have the power to make such an order and secondly, if I do is it appropriate to exercise that power in this case. On the first point the claimant refers me to the decision of the Comptroller's Hearing Officer in *Lancaster University Business Enterprises Limited and the University of Lancaster*¹. In that case the Hearing Officer in a reference under section 12 (though the wording of that section so far as is relevant here, mirrors that of section 8) declared that the application had been filed by the party whom she had determined was entitled to the invention.
14. I do not have the benefit of knowing what precisely it was that the Hearing Officer in that case was asked to determine or what were the facts and arguments upon which she made the order referred to.
15. However it appears to me that the wording of section 8(1) is quite clear that the comptroller has broad powers in terms of what orders he may make. However section 8(1) also makes it clear that any order that the comptroller makes under this section must be in respect of giving effect to his determination. That determination follows on from what he has been asked to determine. Under Section 8(1)(a) the comptroller can be asked to determine whether any person is entitled to be granted (alone or with any other persons) a patent for an invention or has or would have any right in or under any patent so granted or any application for such a patent. This determination does not in my view extend to the question of whether a further application is able to claim priority from the application for the patent that is the subject of the section 8 reference. That is in my opinion a separate issue which must be decided on the facts of the case as they exist. It would not be right for me to attempt to sway that issue by "deeming" something to have happened when it clearly didn't happen. The application in issue was filed by Mr Dames. To the extent that this causes problems with priority claims in subsequent applications then that may be unfortunate but it is not a matter for me here. I would add that from the material before me, responsibility for any such difficulties lies squarely with the claimant.

Findings and order

16. In view of the absence of any counter-statement, I accept the facts of the case as set out in the Statement of Grounds filed by Open Energi. I therefore find that Open Energi is entitled to be named as the sole patent applicant in respect of the application GB 2467159.
17. I am not however prepared to make the requested order that the application should have been deemed filed by ResponsiveLoad Ltd and that its name has subsequently been changed to Open Energi.
- 18. I therefore order that patent application number GB 2467159 GB should proceed in the name of Open Energi as sole patent applicant.**

¹ BL O/040/09

Costs

19. No request has been made as to costs and hence I make no such order.

Appeal

20. Any appeal must be lodged within 28 days

Phil Thorpe

Deputy Director acting for the Comptroller