

0/48197

PATENTS ACT 1977

IN THE MATTER OF references under section 8(1)(a) by 1) Helmut Schiller, 2) Robin Hamilton, 3) Edward Kershaw and 4) Advanced Safe Sustainable Energy Technology Limited in respect of GB Patent Application 9523362.3 in the name of Advanced Safe Sustainable Energy Technology Limited

DECISION

GB Patent Application 9523362.3 was filed on 16 November 1995 by Advanced Safe Sustainable Energy Technology Limited ("ASSET"). The application has not yet been published. On 26 February 1996 Helmut Schiller referred to the Comptroller under section 8(1)(a) of the Act the question of whether he (either alone or jointly with one Wolfgang Wojtowicz) is entitled to the benefit of the application and to the proprietorship of any patent granted in pursuance of it. The order sought by Helmut Schiller was opposed by ASSET. At the same time, ASSET and two individuals, Robin Hamilton and Edward Kershaw each filed a further reference under section 8(1)(a) in respect of the same patent application.

For the purposes of this decision, I do not need to go into the details of the references or the relationships between them, nor do I need to go into the details of the odd situation that has resulted in the patent applicants filing a reference in respect of their own application. Suffice it to say that the proceedings on the four references have been consolidated and that my decision applies to all four of them.

Running in parallel with these four references is a High Court action in which Helmut Schiller seeks delivery up of certain property and other relief from ASSET, Robin Hamilton and Edward Kershaw. In this High Court action, the three defendants have

contested Helmut Schiller's claim and have counterclaimed *inter alia* for an order that Helmut Schiller cooperate to secure for ASSET the ownership of the patent application and any patent resulting from it. As is apparent from the counterclaim, the issues arising in the High Court proceedings are closely related to the issues arising in the four references to the Comptroller.

The present proceedings have been delayed, partly because under rule 8(2)(b) of the Patents Rules 1995 the Comptroller had to send copies of the reference to Wolfgang Wojtowicz and there was some difficulty in contacting him, and partly because the parties themselves were trying to decide how best to proceed. However, we have now reached the position in which, firstly, I am satisfied Wolfgang Wojtowicz does not wish to become a party to the proceedings and, secondly, all the parties would now like me to use the provisions of section 8(7) and decline to deal with the references.

Section 8(7) reads:

"If it appears to the comptroller on a reference of a question under this section that the question involves matters which would more properly be determined by the court, he may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, or any declaratory jurisdiction of the court in Scotland, the court shall have jurisdiction to do so."

I am satisfied from the information the parties have given me about the High Court action that the underlying issues that need to be resolved in that action and the present ones are essentially the same, or at least, very closely related. It would clearly be undesirable for the parties to have to litigate the same or closely related issues before both the Comptroller and the High Court, and it therefore seems to me that this is a situation where it is appropriate to use the provisions of section 8(7). Indeed, whilst I recognise that a decision under section 8(7) is one for the comptroller to make of his own motion, it would be perverse of him to insist on maintaining his jurisdiction against the wishes of all sides unless there were some compelling reason to do so.

Accordingly, under the provisions of section 8(7) I decline to deal with the four references under section 8(1)(a) by 1) Helmut Schiller, 2) Robin Hamilton, 3) Edward Kershaw and 4) Advanced Safe Sustainable Energy Technology Limited in respect of GB Patent Application 9523362.3. Under the Rules of the Supreme Court, it is now open to any of the parties to apply within 28 days to the court to determine the questions raised in these references.

All the parties have asked me to refer to the court the question of the costs of these proceedings before the comptroller. I do not think section 8(7) gives me the power to refer questions to the court, but as I understand it, the parties are at liberty to raise the question of these costs in whatever court proceedings ensue. Accordingly, I simply make no order as to costs.

As this is a procedural matter, any appeal against this decision must be lodged within 14 days.

Dated this 14th day of March 1997

P HAYWARD

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE