

**PATENTS ACT 1977**

IN THE MATTER OF a reference  
under section 37 by Dicon Safety  
Products Inc and an application under  
section 13 by Gary Lennartz in respect  
of UK Patent No 2269494 in the name  
of Derbyshire Maid Limited.

**DECISION**

The application for this patent was filed on 14 September 1993, claiming priority from an earlier application filed on 19 September 1992. The patent was granted on 25 January 1995. It relates to a mains smoke alarm with a back-up capacitor in case of mains failure, and claim 1 as granted, reads :-

A smoke alarm of the mains operated or mains low voltage types, incorporating a control circuit having a capacitor back-up facility to provide, immediately and automatically, a secondary power supply to power the smoke alarm, in both the stand-by and alarm modes, in the event of a mains failure, with restoration of mains power firstly commencing immediate and automatic re-charging of the capacitor back-up facility until maximum capacitance is reached, and secondly and simultaneously re-establishing mains power to the smoke alarm, wherein the control circuit incorporates a diode and a resistor, the incoming mains power to charge or re-charge said capacitor being fed via the diode and via said resistor to said capacitor back up facility, and between the resistor and the capacitor back-up facility is a power output lead to the smoke alarm.

The patent was granted to Derbyshire Maid Ltd with Mr Roy Clegg named as the sole inventor. However, Derbyshire Maid's entitlement to the patent, and Mr Clegg's right to be named as the inventor, have both been challenged. Dicon Safety Products Inc. claim that they should be registered as proprietor of the patent, and have asked the Comptroller under section 37 to decide who is or are the true proprietor or proprietors of the patent,

whether the patent should have been granted to Derbyshire Maid and whether any right in or under the patent should be transferred or granted to them. Mr Gary Lennartz, in an action under section 13, claims that he was the inventor of the invention which is the subject of the patent and accordingly has a right to be mentioned as such and that Mr Clegg ought not to have been mentioned as the sole inventor. The two actions are related because Mr Lennartz is an employee within the group of companies to which Dicon belong, and his claim to inventorship forms the basis of Dicon's claim to entitlement. The actions have therefore been consolidated.

The reference under section 37 and the application under section 13 have been opposed by Derbyshire Maid, and accordingly the matters came for hearing before me on 30 January 1997 when Mr Stuart Geary of Venner Shipley & Co. appeared as Agent for the referrers/applicant and Mr Clegg appeared on behalf of the patentees.

It is worth noting at the outset that at the relevant time Derbyshire Maid were distributors of smoke alarms supplied by Dicon's parent company, Disys Corporation, so the two sides had a business relationship. Further, Disys themselves filed a patent application for the idea of a smoke alarm with a capacitor back-up in Canada three weeks before Derbyshire Maid lodged the application for the present patent. Because Disys used the Canadian application as a priority document for a European application No 0594288 A1, that European application falls in the section 2(3) field so far as the present patent is concerned and was cited against it under section 1(1)(a) during prosecution of the application. As a result, the claims of the present patent were restricted to an arrangement in which the capacitor is charged via a diode and a resistor. I think it is fairly clear that without this restriction, the present patent could not have been granted. Dicon do not claim that Mr Lennartz devised this particular arrangement, but Mr Geary considered it was not inventive and that, following the judgement in *Norris's Patent [1988] RPC 159*, it is only the key idea of replacing the battery back-up by a capacitor, not the precise formulation of the claims, that I need to consider.

In essence, Mr Geary's case was: Mr Lennartz conceived this idea; it was passed to John Walsh, the Managing Director of Dicon International Ltd; Mr Walsh told Mr Clegg about

it in confidence; Mr Clegg then went ahead and filed the patent application in the name of his own company, Derbyshire Maid, naming himself as inventor. In his response on behalf of Derbyshire Maid, Mr Clegg denies that he got the idea from Mr Walsh and says he conceived it himself.

Both sides have filed evidence to support their version of events, and I will start with the referrers'/applicant's. Their evidence comprises an affidavit from Mr Walsh, an affidavit from John Angus McAlister (director of Ploybrook Limited, a distributor of smoke alarms for Dicon International Limited), an affidavit from Mr Lennartz who at the relevant time was employed by Disys Corporation, and an affidavit from Elizabeth Cox, Office Manager at Dicon International Limited in 1991. Dicon International Limited, Disys Corporation and the present referrers, Dicon Safety Products Inc, are or were all part of the same group of companies. The relationship between them is not entirely clear to me, but for the moment, I can regard them as a single entity and shall refer to them collectively as "Dicon".

Mr Lennartz states that he first conceived the idea of using a capacitor as back-up power supply for a smoke alarm in the mid-80s when another company, NEC, developed double layer electrolytic capacitors. The subsequent design on which he began working during the first half of 1991 was, he says, routine. He told John Mallory, president of Dicon, about the idea in or about June 1991. His first written reference to the idea was in a memo dated 27 August 1991 which refers to evaluating cost/performance of four options for various back-up power sources of which three are battery arrangements and the fourth is: "Use large value capacitor (approx 0.5F) providing minimum required back-up. No replacement required." He then says he ordered samples of back-up capacitors (of larger capacitance than those mentioned in the memo) on 16 December 1991. In March 1992 he met a patent agent to whom he disclosed his invention and this eventually resulted in the Canadian patent application.

The rest of the story comes from Messrs Walsh and McAlister. Mr Walsh states that he was aware in 1991 that Mr Lennartz was developing a new ac powered smoke alarm with capacitor back-up, and that he disclosed this development in confidence at at least one

meeting with Mr Clegg and Mr McAlister during 1991. He says he kept Mr Clegg abreast of the progress being made with this new product throughout 1991 and early 1992. Mr McAlister states that, before 9 July 1991, he was present at at least one meeting with Mr Walsh and Mr Clegg. The purpose of these meetings was in part to enable Mr Walsh to discuss in confidence Disys's range of smoke alarms, and in the course of them he and Mr Clegg were informed of the capacitor back-up idea. The significance of the 9 July date is that on that date he discussed the practicality of the capacitor back-up idea with a Mr Stevenson, so he knows he must have learned about it before then. I note that Mr McAlister does not expressly say Mr Clegg was also told about the idea before then, though I assume this is the inference I am being invited to draw.

These are the key elements of the applicants'/referrer's story. They are backed up by other, supporting evidence including:

- A copy of the 16 December 1991 order for capacitors.
- An entry from Mr McAlister's diary confirming the date of his meeting with Mr Stevenson. Photocopied with the diary entry is a manuscript note bearing the same date which appears to relate to the capacitor back-up idea. Whilst I presume I am being invited to infer that Mr McAlister wrote this note in connection with the meeting, I observe Mr McAlister does not actually say he wrote the note, so it is not the most satisfactory piece of evidence.
- Pages from Mr Walsh's diary which show some contact with Mr Clegg on 14 February 1991 and with Mr Clegg and Newey & Eyre on 21 May 1991, though giving no indication of what was discussed on either occasion. Elizabeth Cox, who was acting as Mr Walsh's secretary, says he had meetings with Mr Clegg at other times too, though it is not clear why these are not in the diary.
- A letter from Mr Walsh to Mr Clegg dated 25 October 1991 which reads ". . . You are well aware developments in both the mains powered arena and the special units field position Dicon and therefor (sic) you for a very exciting future" - though I observe the letter fails to indicate the nature of those developments.

Finally, the evidence includes a second letter from Mr Walsh to Mr Clegg dated 28

September 1992 (ie after both sides had already filed their patent applications), following examination of a conversion by Derbyshire Maid of one of Dicon's smoke alarms, in which Mr Walsh writes "Whilst admiring your enterprise in attempting to create your own version of a mains with capacitor back up smoke alarm, which you knew Dicon had been working on for the last two years, I cannot say we are happy with your results . . . As to your concern that we might steal your ideas on the type of capacitor, you might be interested to know that we have been in touch with Panasonic for the last two years your model showed us nothing new."

I now turn to the patentees' evidence. This comprises an affidavit from Mr Clegg, another from Mr N Blanter, a Special Needs Manager with Langbaugh on Tees Borough Council, and a later supplementary affidavit from Mr Clegg. Mr Clegg says he met Mr Blanter on 16 May 1991 to discuss the installation and maintenance of smoke alarms and as a result of these discussions, with limited technical ability, he developed the idea of using capacitors as a back-up facility. This led to a conversation on 28 May 1991 with FAW Electronics to discuss back-up power supplies. On 3 June 1991 Mr Chris Dodd of Modern Vitalcall offered him technical information on capacitors and sources of supply and on 17 June 1991 Mr Clegg phoned Mr Steve Ambrose of ECO Distributors enquiring about Panasonic capacitors. On 27 August 1991 a meeting was arranged with Nigel Cheetham of HB Electronics on 5 September 1991 to discuss supplies of capacitors. Mr Clegg approached FAW Electronics Ltd to ask them to make a prototype using the capacitor samples and an existing Dicon mains with battery back-up smoke alarm and confidential field trials followed in early 1992.

The patentees' story is backed up by the following supporting evidence:

- Confirmation from Mr Blanter that he did have a meeting or meetings with Mr Clegg in the Spring of 1991. However, it is difficult to know what to make of this confirmation, partly because Mr Blanter refers rather confusingly to meeting Mr Clegg "and others from Modern Vitalcall Limited", and partly because he starts off referring to a single meeting in April 1991 and then goes on to say "during the course of these discussions an on site visit was made to Ayton Court", implying there was a whole series of meetings, not just one meeting. I also note

that Mr Blantern does not suggest Mr Clegg discussed the capacitive back-up idea with him.

- Five extracts from Derbyshire Maid's telephone call book relating to the various discussions mentioned above. Three give no indication one way or the other as to whether capacitor back-ups were discussed. The notes for 3 June 1991 include two references to high-value (10 Farad) capacitors in the context of a "memory guard" or "memory back-up". The notes for 17 June refer to Steven Ambrose sending sample capacitors.
- What are said to be Nigel Cheetham's visit notes, though their content is not very informative.

Mr Clegg also says he did not receive any knowledge of capacitor back-up smoke alarms from Dicon and that he was unaware of the existence of Mr Lennartz before the present actions were launched. Further, whilst he agrees he met Mr Stanton of Newey & Eyre on 21 May 1991, he claims Mr Walsh was not present.

Neither version of events was tested by cross-examination, but each side presented arguments as to why I should prefer their version rather than the other, and I now need to look at these.

Mr Geary criticised the patentees' case because, he said, the supporting evidence does not indicate that smoke alarms were discussed on the dates quoted and therefore is of no probative value one way or the other. I agree the supporting evidence is weak, but I would not go so far as to say it had no probative value whatsoever. For example, it provides some support for Mr Clegg's claim that he was discussing suitable (ie high value) capacitors on 3 June 1991. Moreover, I observe that Mr Geary's own supporting evidence is just as weak. For example, it does not tell us what the capacitors ordered on 16 December 1991 were for, or what developments were under consideration in October 1991. Thus if I were, as he suggested, to reject the patentees' supporting evidence for being too weak I would have to reject the referrers'/applicant's too.

Mr Geary raised another argument. During the proceedings, the referrers/applicant had

requested discovery of Roy Clegg's business diary for the period from 1 May to 30 June 1991, Derbyshire Maid's telephone call book for that period, and notes made by Roy Clegg in developing the idea of the capacitor back-up during that period. Derbyshire Maid voluntarily supplied the telephone call book, stated that the diary was not available and simply did not supply any notes. The request for discovery was not pursued, but at the hearing Mr Geary submitted that it was reasonable to assume that either 1) the diary and notes did not exist, in which case the absence of the notes in particular did not support the patentees' case that Mr Clegg made the invention, or 2) that they do exist but were not supplied because they are prejudicial to Derbyshire Maid's case. In other words, I should infer from the failure to supply the diary and notes that Mr Clegg's case was flawed. I cannot draw that inference because the request for discovery was not pursued, and I do not know what might have emerged had it been. It became clear at the hearing that Mr Geary may not have fully appreciated his right to pursue the discovery request, notwithstanding a clear Official letter asking both sides whether they wished to seek further directions in respect of this request. Nevertheless, he eventually agreed at the hearing that he did not wish to pursue the matter at that stage.

For his part, Mr Clegg emphasised at the hearing that the referrers/applicant can point to no specific dates on which meetings had been held to establish a link between Mr Lennartz telling the President of Disys of his invention in or about June 1991 and Mr Walsh informing Mr Clegg of the invention before 9 July 1991. I must agree that the absence of specific dates in this critical period is a weakness in the referrers'/applicant's case, particularly since they have been able to provide evidence of specific meetings before this period. He also pointed out that the statement in Mr Walsh's letter of 28 September 1992 that Dicon had been working on a capacitor back-up smoke alarm for the last two years did not concur with the dates given by Mr Lennartz. I agree there is an inconsistency here, though it may be no more than a slip.

Mr Clegg also suggested the referrers'/applicant's case was implausible. Mr Lennartz tells the President of Dicon in Canada about the capacitor back-up idea in or about June 1991, but puts nothing in writing until August, when the idea was to him still merely one of four possible suggestions, and does not start work on a prototype until December. We

are nevertheless expected to believe that the President of Dicon recognised this particular idea as sufficiently important when he was first told about it that he passed it on pretty well immediately to Mr Walsh, who in turn also recognised its importance and passed it on equally quickly to Mr Clegg. *Prima facie*, I agree this does not seem very plausible, notwithstanding the evidence of Mr McAlister.

The burden of proof rests with the referrers/applicant. Having considered all the evidence and arguments, in my judgement they have not discharged it. Their own version of events is less specific and less convincing than the patentees'. Further, whatever may have happened before 3 June 1991, there is some reasonably-convincing evidence that Mr Clegg was pursuing the idea of a capacitor back-up by then, and Dicon's evidence neither refutes this nor provides grounds for supposing Mr Walsh told Mr Clegg about the idea before this date. They have failed to establish the necessary chain of events linking Mr Lennartz devising his invention and Derbyshire Maid filing their patent application using information about Mr Lennartz's invention given to them in confidence by Mr Walsh. It may well be that Mr Lennartz and Mr Clegg were independently pursuing the idea of a smoke alarm with a capacitive back-up in mid-1991, but that is not sufficient for the present reference/application to succeed.

There are two other points on which I ought to comment. Firstly, in arriving at the decision above I have assumed Mr Geary was right when he argued that I could, for the purposes of these proceedings, ignore the fact that the claims require the capacitor to be charged via a diode and resistor. This point was not argued in detail at the hearing, and in view of my finding above I do not need to decide it now. However, I must observe that I have some difficulty with the notion that the decision in Norris's Patent *supra* means I need not look for any contribution from the referrers/applicant to the very feature which distinguishes the claims in the present patent from the prior art. Secondly, Dicon Safety Products Inc have not actually provided any evidence of how they claim to derive their right to the invention from Disys, who were Mr Lennartz' employers. Even if my decision had gone the other way, I would have needed such evidence before I could have found in Dicon's favour.



In summary, I find that the true proprietors of the patent are Derbyshire Maid Limited and that Dicon Safety Products Inc do not have any rights in or under the patent. Further, I find that Gary Lennartz has no right to be mentioned as the or an inventor.

All parties have asked for costs and, since I have found in favour of Derbyshire Maid, I direct that they should be paid the sum of £550 by the referrers, Dicon Safety Products Inc, and £150 by the applicant, Mr Lennartz, by way of contribution to their costs.

Any appeal from this decision must be lodged within six weeks.

Dated this 26<sup>th</sup> day of February 1997

**P HAYWARD**

Superintending Examiner, acting for the Comptroller



**THE PATENT OFFICE**