

PATENTS ACT 1977

01/15/94

IN THE MATTER OF a reference under Section 8 by Kedah Limited in respect of Patent Application No 9009662.9 in the name of Kitelane Limited

DECISION

GB Patent Application No 9009662.9 entitled "Ball Pen Inks" was filed on 30 April 1990 in the name of Thomas Hanrahan as sole applicant and sole inventor. The application was published on 27 November 1991 under serial number GB 2244280 ('280).

Subsequently, the Office was notified, on Form 21/77 filed on 2 April 1991, of a purported assignment application dated 26 October 1990 by Mr Hanrahan to Kitelane Limited ("Kitelane") . Details of this assignment were entered on the register of patents on 2 December 1991.

On 5 June 1992, Kedah Limited ("Kedah") referred to the Comptroller under section 8(1)(a), the question whether the application should proceed in their name, instead of in the name of Kitelane.

Copies of the statement accompanying the reference were sent with official letters dated 26 August 1992 to Kitelane under rule 7(2)(b) and to Mr Hanrahan under rule 7(2)(d). Similarly, copies of a supplementary statement filed on 20 July 1992 were sent to Kitelane and Mr Hanrahan with official letters dated 10 August 1992. Following confirmation from Kedah's agent that they were holding £700 by way of security for costs, Kitelane and Mr Hanrahan were each informed in further official letters dated 18 August 1992 that they were allowed a period of two months in which to file a counter-statement under section 7(3) setting out grounds for opposition to the reference.

The period for filing a counter-statement was subsequently extended under rule 110(1) to 18 December 1992 at the request of Kitelane's agents, Beresford & Co. However, no counter-statement was filed within this extended time limit. Instead, in a letter dated 18 December 1992, the comptroller was informed by Beresford & Co that they were unable to continue to act for Kitelane and that further correspondence should be directed to "Mr Hanrahan of Kitelane Limited".

Consequently, Kitelane were advised in an official letter dated 24 December 1992 that the proceedings would be treated as uncontested subject to any comments they wished to make within 14 days from the date of the letter. No response to this was received from Kitelane. However, in a facsimile transmission dated 30 December 1992, Mr Hanrahan advised that all future correspondence should be sent to "Jean-Jacques Delors of Francois Charles Oberthur ("Oberthur") 102, Boulevard Malesherbes 75017 Paris". In the light of this response, Kitelane and Oberthur were advised in a further official letter dated 21 January 1993 that since no counter-statement had been filed the proceedings would be treated as uncontested, subject to any request for a preliminary hearing to consider the matter. No such request having been received, the Office issued an official letter dated 18 March 1993 to Kedah (copied to Kitelane and Oberthur) confirming that the proceedings were being treated as uncontested.

Evidence in support of the referrers' case, in the form of statutory declarations from Anthony James Murrells and David Houghton, was filed on 15 June 1993 and on 9 July 1993.

A substitute statement combining the original and supplementary statements was then filed by the referrers on 3 August 1993. This reads as follows:

"1. In 1983 the Company Stratabord Limited, then of Thorp Arch Trading Estate, Boston Spa, Wetherby, Yorkshire, lodged Application for Patent under number 8319258 and dated 15 July 1983 for an invention related to "Powdered Ink", the inventor of which was one of its employees, Mr H. G. Clewer. A copy of the Specification of Application Number 8319258 forms Annex 1 hereto.

2. Subsequent to the filing of the said Application Stratabord Limited entered into discussions with Gestetner Limited, and under which Stratabord Limited disclosed its invention, the subject matter of the said Application, affording Gestetner a sight of the text of the Patent Application, and providing a number of example compositions within the invention.

3. To enable it to consider its possible interest in the invention, Gestetner Limited arranged for one of its employees Thomas Hanrahan, to discuss the invention with relevant personnel of Stratabord Ltd, and Mr Hanrahan produced a report for his employers dated 16 April 1984 to enable Gestetner Limited to decide whether or not to enter full licence negotiations. A copy of Mr Hanrahan's report forms Annex II hereto. The outcome was that Gestetner Limited chose not to become involved.

4. On 29 April 1988 Stratabord was struck from the Register of Companies, and all of its residual assets reverted to the Treasury Solicitor, inclusive of the benefit of the invention the subject of Application Number 8319258, not having previously been disposed of.

5. On 21 January 1992 Kedah Limited of 20 Upper Fitzwilliam Street, Dublin 2, Ireland, negotiated the Assignment from the Treasury Solicitor of all the residual assets of Stratabord Limited, inclusive of the benefit of the invention the subject of Application Number 8319258. A certified copy of the Assignment document forms Annex III hereto.

6. On 30 April 1990 an Application for Patent was filed under Number 9009662 by the said Thomas Hanrahan and naming himself as the inventor. This Application, the Application in suit, was subsequently published under Number 2244280, a copy of which forms Annex IV hereto. In all of its essential respects, the invention as defined in Application Number 2244280 is the same invention as was previously defined in Application 8319258, and the particular examples listed in the Application are in their essential respects substantially the same as those examples given to Mr Hanrahan during his discussions with Stratabord Limited. Consequently the subject of matter of Application 2244280 is substantially in its entirety the subject

matter handed to Mr Hanrahan whilst he was employed by Gestetner Limited and negotiating with Stratabord Limited on his employers' behalf.

7. Having due regard to the manner by which Mr Hanrahan acquired knowledge of the invention, there can be no justification for any claim by him that he could be the proprietor of any Patent granted on the Application, and neither can there be any justification for any claim by him to be the true and first inventor.

8. We pray that an order be made in accordance with the provisions of Section 8(2)(a) that the Application shall proceed in the name Kedah Limited.

9. We have been made aware of an Assignment of the Application from Mr Hanrahan to Kitelane Limited. It is maintained that Mr Hanrahan had no title to the Application.

10. We further pray that an order be made declaring that the Assignment of the Application from Mr Hanrahan to Kitelane Limited is without force and effect."

A copy of this amended statement was set under the cover of official letters dated 12 August 1993 to Kitelane and Mr Hanrahan and to M. Delors. The recipients were again informed in these letters that the proceedings were being treated as uncontested and that a hearing officer acting for the comptroller would determine the matter.

In response to observations by an examiner to whom the reference had been passed for preliminary consideration, the referrers filed on 16 November 1993 further evidence in support of their case in the form of statutory declarations from Peter George Meredith and Harry Grenville Clewer and a second statutory declaration from Mr Murrells.

Having considered the uncontested evidence in support of the referrers' case, I am satisfied that the invention which was the subject of GB application 8319258 ('258) was made by Harry Grenville Clewer and that he made the invention during his employment initially by

Research Consultants Limited ("Research") and subsequently, by Stratabord Limited ("Stratabord").

I am also satisfied in the absence of any suggestion to the contrary that the invention was made in the course of Mr Clewer's normal duties as an employee at Research and Stratabord.

In the light of the evidence of both Mr Meredith and Mr Clewer that all of Research's assets including knowhow were sold to Stratabord in 1982, I am satisfied that the invention of '258 filed 15 July 1983 belonged to Stratabord and was correctly filed in their name.

I am also satisfied that following the reversion of Stratabord's assets to the Treasury Solicitor, this invention was assigned to Kedah by an assignment made 21 January 1992 between the Treasury Solicitor and Kedah, a copy of this assignment having been furnished as Annex III to the referrer's statement.

However, the reference in suit is in respect of '280 not '258. Both of these applications relate to coloured compositions comprising a dye and a resin for making inks for ballpoint pens. However, an essential feature of '258 is the use of a "reactive oil", preferably a fatty acid oil. In contrast, in '280 the use of a fatty acid oil, referred to as a "plasticising oil" in the description, is an optional feature and is not included in claim 1. In the light of the evidence of Mr Murrells in his second declaration and of Mr Clewer, I am satisfied that the fatty acid oils described as "plasticising oils" in '280 are the same as the "reactive oils" in '258.

I therefore find that the referrers have established their entitlement to the particular invention disclosed in the application in suit but not in the invention as broadly set out in Claim 1. In particular, entitlement has been established to the invention when the composition contains a fatty acid oil.

Pursuant to these findings, I order under section 8(2)(a) that the application in suit, restricted to compositions containing a fatty acid oil, shall proceed in the sole name of Kedah Limited. However, this order is without prejudice to the possibility of amendment, as to the nature

and/or composition of that oil, in the course of substantive examination subject to the provisions of, inter-alia, section 76.

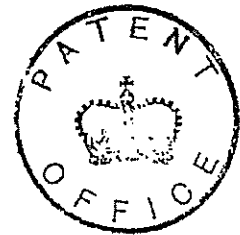
It follows, from my findings and order, that the assignment from Mr Hanrahan to Kitelane is without effect since no proper title was vested in Mr Hanrahan in the first place.

A reply to a report under section 18(3) on the application in suit is outstanding. I extend the period for responding to that report until 21 April 1994. When responding to that report I direct that Kedah Limited shall restrict the application to the invention I have found they are entitled.

Finally, it also follows that I find that Harry Grenville Clewer is the sole inventor of '280 as restricted in accordance with my order above. I accordingly order that an appropriate entry as to inventorship be made in the register of patents and that Mr Clewer be so mentioned in any patent granted for this invention.

Signed this 12 day of January 1994

B G HARDEN  
Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE