

PATENTS ACT 1977

IN THE MATTER of an application
under Section 13(3) in respect
of patent No 2197376
in the name of Hago Products Ltd

DECISION

This concerns an application made under Section 13(3) of the Patents Act 1977 by Murgitroyd and Company, who are the agents acting for patent applicants Hago Products Ltd. The Section 13(3) application was made on Patents Form No 6/77 filed on 30 April 1990, in which it is declared that one Timothy Watts ought not to have been mentioned in pursuance of Section 13(1) as joint inventor of the invention which is the subject of patent application 8723671.7, and a certificate is thereby applied for to that effect.

The facts are as follows. Patent application 8723671.7 was filed on 8 October 1987 in the name of Hago Products Limited. The statement of inventorship made on Patents Form No 7/77 cited two inventors, Aftab Alam and Timothy Watts. The application proceeded through search to publication under Section 16(1) on 18 May 1988 with the serial number 2197376A and that publication duly mentioned as inventors Aftab Alam and Timothy Watts. Substantive examination was carried out and in his first report under Section 18(3) the examiner objected that two inventions were claimed in the application contrary to Section 14(5)(d). In response to that objection certain subject matter was excised from the application and made the subject of a new or "divisional" application under the provisions of Section 15(4): this application was lodged on 21 December 1989, being given the application number 8928971.4, and subsequently published under the serial number 2227272. The only inventor cited on Patents Form No 7/77 for the divisional application, and mentioned in the application published under Section 16(1), is Timothy Watts.

In their statement of case, the agents for the applicants state that the subject matter removed from the "parent" application, the application in suit, and filed as the divisional application, was invented by Timothy Watts, and they state that the parent application was thereafter left only with subject matter invented by Aftab Alam. In accordance with the procedure set out in Rule 14 of the Patents Rules 1982 a copy of the application under Section 13(3), and the applicants' statement of case, was sent to both inventors and to the applicants for the patent. That communication makes clear that three months are available for a counter-statement to be filed by any person who wishes to make objections: that period has elapsed without any such counter-statement having been filed. In view of this, the present application is uncontested and I therefore propose to accept the statements made by the applicants in support of their case without further enquiry beyond ascertaining that those statements are consistent with the facts apparent from the files of the two patent applications concerned. It is clear from those files that the subject matter excised from the parent application relates to the second of two embodiments, that which was shown in Figures 4 and 5 of the application as originally filed, and to a series of claims numbered as Claims 8 to 14 in the application as originally filed which would embrace that second embodiment. It is noted that this second embodiment was not present in the priority document, patent application 8624302, which cites Aftab Alam as sole applicant and inventor. These facts are consistent with Timothy Watts being the inventor of the second embodiment. It is further noted that, at the time of filing of the divisional application, the parent application was thoroughly revised to exclude all disclosure and claims relating to the second embodiment. I am therefore satisfied that Murgitroyd and Company's representations as to the inventorship of the subject matter now remaining in the parent specification can be accepted.

It remains to be decided what corrective action should be taken. Section 13 is concerned with mentions of the inventors and it is necessary to read Section 13(3) in conjunction with Section 13(1)

to conclude that the mentions which may be rectified under Section 13(3) are those "in any patent granted for the invention" and "in any published application for a patent for the invention". At the time of filing the application under Section 13(3), no patent had been granted on either parent or divisional application, although publication of the parent application under Section 16 had taken place; and there was some implication in the statement supporting the Section 13(3) application that amendment of the statement of inventorship on Patents Form No 7/77 was being sought. Patents were subsequently granted on both applications on 14 November 1990, that is, before consideration of the application under Section 13(3) had been completed, and the published specification for the parent case (serial number 2197376B) continues to mention both Aftab Alam and Timothy Watts as inventors.

In these circumstances I conclude therefore that:

(a) the mention of both inventors in the published patent application 2197376A was correct having regard to the content of the application at that time, and issue of a certificate under Section 13(3) in respect of that application would not therefore be appropriate;

(b) the mention of both inventors in the published, granted patent 2197376B was incorrect having regard to the excision of subject matter that took place on division of the application, and issue of a certificate under Section 13(3) in respect of that parent is therefore appropriate; and

(c) amendment of Patents Form No 7/77 is not appropriate to proceedings under Section 13 and is furthermore unnecessary as it would have no practical consequences now.

These conclusions were communicated to Murgitroyd and Company as a preliminary finding in an Official letter dated 17 December 1990 and their response dated 17 January 1991 provides assent to those conclusions.

Under the terms of Section 13(3) of the Patents Act 1977 I therefore certify that Timothy Watts ought not to have been mentioned as joint inventor in granted Patent No 2197376B. The issuance of this decision shall serve as the issuance of the certificate provided for in Section 13(3).

The Comptroller is now obliged under the terms of Section 13(3) to rectify any undistributed copies of the granted patent. I therefore order that any undistributed copies of granted patent 2197376 B be rectified to show Aftab Alam as sole inventor at Section (72) of the front page; this rectification to be made by re-printing the front page to form a C document.

Dated this 18 day of MARCH 1991



B G HARDEN

Superintending Examiner, acting for the Comptroller