

PATENTS ACT 1977

IN THE MATTER OF a reference under
Section 37(1) by Formula Systems Ltd in
respect of Patent No 2254916 in the name of
John Trett

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DECISION

Patent Application No 9107981.4, entitled "Detection Systems", was filed on 15 April 1991 by John Trett naming himself as sole inventor. The application was published as 2254916 on 21 October 1992.

On 6 December 1993 Formula Systems Ltd (the "referrers") referred to the Comptroller under section 8(1)(a) the question of whether they owned the rights in the then application in suit. The patent was granted on 22 December 1993. Accordingly the parties were informed in an official letter to Mr Trett dated 24 December 1993, copied to the referrers, that by virtue of section 9, the matter was being treated as having been referred under section 37.

The reference was accompanied by a statement under rule 8(1) as follows:

"John Trett was appointed a Director of Formula Systems Ltd (hereinafter referred to as the "COMPANY") on 5 January 1984 and on 1 November 1993 resigned as Managing Director of the COMPANY. Throughout the period from 5 January 1984 to 1 November 1993, John Trett was a full time Director of the COMPANY having overall responsibility for, inter alia, research, development and sales. John Trett was paid a monthly salary for his services to the COMPANY.

During his period with the COMPANY, John Trett was responsible for numerous inventions. A number of patent applications were filed in the name of Formula Systems Ltd all naming John Trett as inventor or co-inventor.

The main business of the COMPANY is the design, development and manufacture of electronic safety systems for doors particularly elevator doors and John Trett's previous experience in this field was used to develop new products in this area of technology for the company to manufacture and sell.

In 1991, John Trett created a new invention relating to an electronic detection system for an elevator door and instructed the firm of Patent Agents Saunders & Dolleymore, in his capacity of Managing Director of the COMPANY, to file a patent applications in his name solely. Saunders & Dolleymore complied with his request, filed an application which was accorded the serial number 9107981.4 and understood that the patent application would, in due course, be assigned and most probably to the COMPANY.

Saunders & Dolleymore were asked to bill the COMPANY for their services in this matter and their bills for the British application, and numerous foreign applications corresponding to the British application, were settled by Formula Systems Ltd.

John Trett, whilst Managing Director of the COMPANY, was responsible for setting up a new manufacturing line within the company of a product which falls within the scope of the claims of the present patent application number 9107981.4.

It is the COMPANY'S contention that the invention, which is the subject of the present application, was created by John Trett in the course of his duties to the COMPANY, that it was created in the COMPANY'S time using the COMPANY'S materials and equipment and the services of the COMPANY'S Patent Agents and therefore rightly belongs to the COMPANY. It is the COMPANY'S further contention that John Trett was holding the patent application in trust for the COMPANY.

The Comptroller is respectfully requested, under Section 8(2)(a), to order that the application be transferred from John Trett to Formula Systems Ltd of Witan Park, Avenue 2, Station Lane Industrial Estate, Witney, Oxfordshire OX8 6FH. The

Comptroller is also requested to order John Trett to pay the COMPANY'S costs in this matter.

In the alternative, the Comptroller is requested to order, under Section 8(2)(d), that the COMPANY be granted a licence under the patent, when granted, on such terms as the Comptroller considers appropriate."

In accordance with rule 54(2), a copy of the reference and statement was sent to Mr Trett on 31 January 1994 allowing a period of two months in which to file a counter-statement opposing the reference in accordance with rule 54(3).

This period was subsequently extended until 31 July 1994. On 18 July 1994 the referrers wrote to the Office enclosing a statutory declaration by John Trett dated 10 June 1994 which reads as follows:

1. I am the sole inventor of the invention (herein after referred to as "the Invention") described in Patent No 2254916 (hereinafter referred to as "the Patent").
2. At the date of the Invention, I was an employee of Formula Systems Ltd of Witan Park, Avenue 2, Station Lane Industrial Estate, Witney, Oxon OX8 6FH with responsibility for development and research into photoelectric and other detection systems for elevators and the like.
3. The application for the Patent was filed in my name and was held in trust by me for Formula Systems Ltd.
4. I confirm that the beneficial owner of all rights to and arising out of the invention, is Formula Systems Ltd.
5. I no longer have any objection to Formula Systems Ltd's application under Section 37 of the Patents Act and will raise no objection to any order by the Comptroller General Patents vesting the Patent or the patent application from which it derives in the name of Formula Systems Ltd."

In their accompanying letter, the referrers state:

"Since John Trett now admits that the beneficial ownership lies with Formula Systems Ltd, we request that the Comptroller commutes further proceedings in this matter by issuing an order to the effect that the Patent be retrospectively granted to Formula Systems Ltd."

In addition, on 9 August 1994, the agents for Mr Trett informed the Office that the patent in suit had been assigned to the referrers and that no counter-statement would be filed.

In response to this and a letter from the referrers dated 24 August 1994 requesting that the patent be reissued in their name, the Office wrote to the referrers and Mr Trett on 16 September 1994 in the following terms:

"No counter-statement having been filed, the Office proposes, subject to any comments received within 14 days of the date of this letter, to issue a decision directing that the referrers be registered as proprietors in place of Mr Trett.

The referrers are advised that, in such Section 37 proceedings, it is the practice merely to record the change of proprietorship on the register and not to "re-issue" the patent.

Additionally, both parties are alerted to the fact that no assignment such as is referred to in the opponents' letter of 9 August 1994 has yet to be registered. However, if Mr Trett was not in fact entitled in the first place to any rights to and arising out of the invention (as his statutory declaration would appear to suggest), the nature of the rights assigned is not clear."

No response to these official letters has been received from either the referrers or Mr Trett.

In the absence of any opposition by Mr Trett and having regard to the confirmation in paragraph 4 of his statutory declaration that the referrers are the beneficial owners of all

rights to and arising out of the invention, I am satisfied that the referrers are the true proprietors of the patent in suit.

Accordingly, I hereby order under section 37(1) that the referrers, Formula Systems Ltd, be registered as proprietors in place of John Trett.

The referrers requested in their statement that John Trett pay the Company's costs in the matter. No objection to this request has been made by John Trett or on his behalf. I accordingly award costs to the referrers to be paid by John Trett in the sum of £100 in line with the Comptroller's customary practice as to the quantum of costs.

Dated this 25 day of October 1994



B G Harden
Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE